

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELI LILLY AND COMPANY
Petitioner

v.

TEVA PHARMACEUTICALS INTERNATIONAL GMBH
Patent Owner.

Case IPR2018-01422 (Patent No. 9,340,614)
Case IPR2018-01423 (Patent No. 9,266,951)
Case IPR2018-01424 (Patent No. 9,346,881)
Case IPR2018-01425 (Patent No. 9,890,210)
Case IPR2018-01426 (Patent No. 9,890,211)
Case IPR2018-01427 (Patent No. 8,597,649)¹

Before JENNIFER MEYER CHAGNON, JAMES A. WORTH, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹This Order addresses issues that are common to all six cases. We, therefore, issue a single Order that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the caption.”

IPR2018-01422 (Patent No. 9,340,614) IPR2018-01423 (Patent No. 9,266,951)
IPR2018-01424 (Patent No. 9,346,881) IPR2018-01425 (Patent No. 9,890,210)
IPR2018-01426 (Patent No. 9,890,211) IPR2018-01427 (Patent No. 8,597,649)

Inter partes review was instituted in the above-referenced cases on February 19, 2019 (IPR2018-01422, -01423, -01424) and February 25, 2019 (IPR2018-01425, -01426, -01427). Paper 14.² Patent Owner filed a Response (Paper 24) to each Petition, and Petitioner filed a Reply (Paper 39, “Reply”) to each Response.

In an e-mail to the Board on September 17, 2019, Patent Owner requested authorization to file a motion to strike certain exhibits, testimony, and arguments submitted or advanced in connection with each Reply, or alternatively, sought other relief the Board deems appropriate. Petitioner opposed Patent Owner’s request. A conference call was held between counsel for the parties and the Board (Judges Chagnon, Worth, and Smith) on September 19, 2019, to discuss Patent Owner’s request.³

During the conference call, counsel for the parties and the Board discussed Patent Owner’s request, giving the parties the opportunity to present their arguments and explanations to support their positions. Patent Owner argued that certain exhibits, testimony, and arguments submitted or advanced in connection with each Reply should have been presented in the Petition or otherwise exceeded the scope of a proper reply. Petitioner presented opposing arguments in response to each of Patent Owner’s arguments.

Based on our consideration of the parties’ positions, it is hereby:

ORDERED that Patent Owner may file a 5-page paper, in each of the above-referenced *inter partes* reviews, on or before September 30, 2019,

² Paper numbers in this Order refer to papers filed in IPR2018-01422.

³ The transcript of the call should be made of record as soon as possible.

IPR2018-01422 (Patent No. 9,340,614) IPR2018-01423 (Patent No. 9,266,951)
IPR2018-01424 (Patent No. 9,346,881) IPR2018-01425 (Patent No. 9,890,210)
IPR2018-01426 (Patent No. 9,890,211) IPR2018-01427 (Patent No. 8,597,649)

identifying the exhibits, testimony, and arguments that it contends exceed the scope of a proper reply;

FURTHER ORDERED that Petitioner may file a 5-page reply in response to Patent Owner's paper, in each of the above-referenced *inter partes* reviews, on or before October 9, 2019; and

FURTHER ORDERED that no declaration or other evidence may be submitted with Patent Owner's paper or Petitioner's reply.

IPR2018-01422 (Patent No. 9,340,614) IPR2018-01423 (Patent No. 9,266,951)
IPR2018-01424 (Patent No. 9,346,881) IPR2018-01425 (Patent No. 9,890,210)
IPR2018-01426 (Patent No. 9,890,211) IPR2018-01427 (Patent No. 8,597,649)

PETITIONER:

William B. Raich
Erin M. Sommers
Pier D. DeRoo
Yieyie Yang
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
william.raich@finnegan.com
erin.sommers@finnegan.com
pier.deroo@finnegan.com
yieyie.yang@finnegan.com

Sanjay M. Jivraj
Mark J. Stewart
ELI LILLY AND COMPANY
jivraj_sanjay@lilly.com
stewart_mark@lilly.com

PATENT OWNER:

Deborah A. Sterling
Robert C. Millonig
Gaby L. Longsworth
Jeremiah B. Frueauf
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
dsterling-ptab@sternekessler.com
bobm-ptab@sternekessler.com
glongs-ptab@sternekessler.com
jfrueauf-ptab@sternekessler.com