

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner

Case No. IPR2018-01675
U.S. Patent No. 8,603,044

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO CORRECT**

Petitioner’s (“Mylan”) motion should be denied because the requested change to the Petition is substantive and would prejudice Patent Owner (“Sanofi”) by depriving Sanofi of the opportunity to respond. Alternatively, should the Board permit the correction, Sanofi requests authorization to file an amended Preliminary Response, limited to addressing the proposed correction, in order to mitigate the prejudice to Sanofi.

I. REASONS FOR DENYING THE MOTION

In determining whether to permit corrections to a petition, the Board has considered the following non-exclusive factors: (1) the nature of the error, whether the party requesting relief provides adequate explanation for how the error occurred, and how the error was discovered; (2) the length of time elapsed between learning of the error and bringing the error to the Board’s attention; (3) prejudice to the other party by allowing the proposed corrections; and (4) whether the proposed corrections impact the proceeding. *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180, Paper 14 at 9 (P.T.A.B. Dec. 6, 2018). Here, all four factors favor denial.

1. The nature of the error, and whether the party requesting relief adequately explains how the error occurred, including how the error was discovered

The nature of the error weighs against granting the motion. As Mylan admits, and stated in Sanofi’s Preliminary Response, the original citation on page 25 of the Petition did not support the argument for which it was proffered. *See* Ex. 1036, 7:18-

23. Other than a conclusory statement in its expert's declaration, Mylan cited no evidence supporting the argument. Thus, though the error's origin appears to be typographical, Mylan's proposed correction would substantively change the Petition by providing different evidence to support an argument that previously had none.¹

That Mylan did not discover the error until Sanofi's Preliminary Response alerted Mylan to it, even though Mylan filed a separate petition in IPR2019-00122 on October 29, 2018 with an identical citation (*see* IPR2019-00122, Paper 2 at 28), further favors denying the motion. *Ivantis*, Paper 14 at 11.

2. The length of time elapsed between learning of the error and bringing the error to the Board's attention

Mylan received Sanofi's Preliminary Response on January 3, 2019, but did not bring the error to the Board's or Sanofi's attention prior to the conference call on January 15. Mylan does not explain its failure to bring the alleged error to the Board's attention for nearly two weeks, which impacted Sanofi's ability to discuss the issue on the call. *See* Ex. 1036, 11:21-12:17. Thus, this factor favors denial.

3. Prejudice to Patent Owner by allowing the correction

The proposed correction would be prejudicial because Sanofi has already filed a Preliminary Response. As Mylan admits, Sanofi's Preliminary Response addressed

¹ Should the correction be permitted, Sanofi will explain in an Amended Preliminary Response why the revised citation also fails to support the argument.

the original citation by correctly noting that it does not relate to the subject matter for which it was cited. Paper 12 at 38, n. 9; Ex. 1036, 7:18-23. Permitting the correction would deprive Sanofi of an opportunity to rebut the new citation. *See, e.g.,* 77 Fed. Reg. 48,680, 48,699 (Aug. 14, 2012) (the Board will consider “any effect on the patent owner’s ability to file a preliminary response”). Because Mylan bears the burden of providing supporting evidence in its Petition, Sanofi, “in formulating its Preliminary Response, should be able to rely on the Petition ... as being correct.” *Ivantis*, Paper 14 at 13. Thus, the prejudice to Sanofi favors denial.

For the same reasons, Sanofi should be allowed to file an amended Preliminary Response if Mylan’s motion is granted. Indeed, Sanofi should not be deprived of the ability to fully respond to the Petition due to an error and lack of diligence by Mylan.

4. Impact on the proceeding

As set forth above, the proposed change would substantively change the content of the Petition without providing Sanofi with an opportunity to rebut the newly cited evidence. Thus, this factor favors denial.

II. CONCLUSION

For the above reasons, the Board should deny Mylan’s motion. In the alternative, Sanofi should be permitted to file an amended Preliminary Response to address the correction if the Board chooses to grant the motion.

Dated: February 6, 2019

Respectfully submitted,

/Elizabeth Stotland Weiswasser/

Elizabeth Stotland Weiswasser
(Reg. No. 55,721)

Anish R. Desai (Reg. No. 73,760)

Sudip K. Kundu (Reg. No. 74,193)

Kathryn M. Kantha (Reg. No. 70,371)

Weil, Gotshal & Manges LLP

767 Fifth Avenue

New York, NY 10153

Phone: 212-310-8000

elizabeth.weiswasser@weil.com

anish.desai@weil.com

sudip.kundu@weil.com

kathryn.kantha@weil.com

William S. Ansley (Reg. No. 67,828)

Matthew D. Sieger (Reg. No. 76,051)

Weil, Gotshal & Manges LLP

2001 M Street NW, Ste. 600

Washington, D.C. 20036

Phone: 202-682-7000

sutton.ansley@weil.com

matthew.sieger@weil.com

Adrian C. Percer (Reg. No. 46,986)

Brian C. Chang (Reg. No. 74,301)

Weil, Gotshal & Manges LLP

201 Redwood Shores Parkway

Redwood Shores, CA 94065

Phone: 650-802-300

adrian.percer@weil.com

brian.chang@weil.com

Sanofi.IPR.Service@weil.com

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.