

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,  
Patent Owner.

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Cases

IPR2018-01675 (Patent 8,603,044 B2)  
IPR2019-00122 (Patent 8,992,486 B2)<sup>1</sup>

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Before HYUN J. JUNG, BART A. GERSTENBLITH, and  
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

*Granting Petitioner's Motions to Correct  
37 C.F.R. § 42.104(c)*

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<sup>1</sup> This Decision is entered in each case. The parties are not authorized to use a multiple-case caption.

IPR2018-01675 (Patent 8,603,044 B2)  
IPR2019-00122 (Patent 8,992,486 B2)

## I. BACKGROUND

With prior authorization, Petitioner filed a Motion to Correct the Petition in each of the above-referenced proceedings. IPR2018-01675, Paper 15; IPR2019-00122, Paper 7. In IPR2018-01675, Patent Owner filed an Opposition to Petitioner’s Motion to Correct (Paper 18), but Patent Owner did not oppose Petitioner’s Motion in IPR2019-00122. We conducted a teleconference with counsel for each party on February 13, 2019, during which Petitioner’s Motions were discussed. A transcript of the teleconference was prepared and will be filed as an exhibit in each proceeding.<sup>2</sup>

## II. DISCUSSION

In IPR2018-01675, Petitioner challenges claims 11, 14, 15, 18, and 19 of U.S. Patent No. 8,603,044 B2 (“the ’044 patent”). IPR2018-01675, Paper 2 at 1. In IPR2019-00122, Petitioner challenges claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 of U.S. Patent No. 8,992,486 B2 (“the ’486 patent”). IPR2019-00122, Paper 2 at 1. The ’044 and ’486 patents issued from continuation applications based on U.S. Patent Application No. 12/944,544, and have identical specifications. *Compare* IPR2018-01675, Ex. 1002 at [63], *with* IPR2019-00122, Ex. 1003 at [63] (claiming priority to the same patent application).

Petitioner’s Motions seek to correct one citation to the specification of the respective challenged patent. In particular, on page 25 of the Petition in IPR2018-01675 and on page 28 of the Petition in IPR2019-00122, Petitioner cited to “3:62-64” rather than “3:42-44.” *See* IPR2018-01675, Paper 15 at 1;

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<sup>2</sup> At the time of this Decision, the transcript had not been filed yet.

IPR2018-01675 (Patent 8,603,044 B2)

IPR2019-00122 (Patent 8,992,486 B2)

IPR2019-00122, Paper 7 at 1. Petitioner explains that the error was typographical and that “[t]he accompanying parenthetical and textual context make the nature of the error self-evident . . . .” IPR2018-01675, Paper 15 at 1.

In IPR2018-01675, Patent Owner filed an Opposition to Petitioner’s Motion (Paper 18), in which Patent Owner acknowledges that “the error’s origin appears to be typographical.” Paper 18, 2.

In IPR2019-00122, Petitioner represented, via email on February 1, 2019, that Patent Owner did not oppose Petitioner’s Motion. In its Motion for this proceeding, Petitioner also represented that Patent Owner “has indicated that it does not oppose this correction.” IPR2019-00122, Paper 7, 1. During the teleconference, counsel for Patent Owner confirmed that position—that it does not oppose Petitioner’s Motion in IPR2019-00122 because, in that case, Patent Owner had not yet filed its Preliminary Response.

Our rules provide that “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition.” 37 C.F.R. § 42.104(c). In the two instances before us, it is very clear from the context of the citation and papers filed by the parties that the error was typographical. Additionally, it is also clear that Patent Owner’s primary objection to Petitioner’s correction in IPR2018-01675 is based on timing. In other words, Patent Owner already had filed its Preliminary Response in IPR2018-01675 and was concerned about potential prejudice if it were not permitted to amend its Preliminary Response to respond to the corrected citation. *See, e.g.*, IPR2018-01675, Paper 18 at 2–3; *see also* Transcript of February 13,

IPR2018-01675 (Patent 8,603,044 B2)

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2019, Teleconference. Further, these cases are still at an early stage and Petitioner's correction appears relatively minor.<sup>3</sup>

Accordingly, on the teleconference, we *granted* Petitioner's Motions to Correct. We also ruled that Patent Owner may file an amended preliminary response in IPR2018-01675 and a redline version showing the changes between the first-filed Preliminary Response and amended version as an exhibit by February 20, 2019.

### III. ORDER

It is:

ORDERED that Petitioner's Motions to Correct (IPR2018-01675, Paper 15; IPR2019-00122, Paper 7) are *granted*; and

FURTHER ORDERED that Patent Owner may file an amended preliminary response in IPR2018-01675, along with a redline version showing the changes as compared to Patent Owner's first-filed Preliminary Response (Paper 12), by February 20, 2019.

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<sup>3</sup> Any additional details of the discussion will be reflected in the transcript of the teleconference.

IPR2018-01675 (Patent 8,603,044 B2)

IPR2019-00122 (Patent 8,992,486 B2)

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