

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC. and PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner.

IPR2018-01675, IPR2018-01676 (Patent 8,603,044 B2)
IPR2018-01678, IPR2018-01679, IPR2019-00122 (Patent 8,992,486 B2)
IPR2018-01680, IPR2018-01682 (Patent 9,526,844 B2)
IPR2018-01684 (Patent 9,604,008 B2)¹

Before LYNNE H. BROWNE, HYUN J. JUNG,
BART A. GERSTENBLITH, and JAMES A. TARTAL, *Administrative
Patent Judges.*

JUNG, *Administrative Patent Judge.*

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

¹ This Order is entered into each case. The parties are not authorized to use this joint heading and filing style in their papers. Also, Pfizer Inc., who filed petitions in IPR2019-00977, IPR2019-00978, IPR2019-00980, IPR2019-00981, IPR2019-00982, IPR2019-00987, IPR2019-01022, and IPR2019-01023, has been joined as a petitioner in these proceedings.

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In an email dated November 26, 2019, to the Board, Patent Owner requested authorization, in view of *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), to file a one-page, non-argumentative statement in each of the above-listed proceedings to purportedly preserve Patent Owner’s right to raise Appointments Clause challenges on appeal. A conference call was held on December 11, 2019, between Mr. Torczon, counsel for Mylan Pharmaceuticals Inc. (“Mylan”); Mr. Wong, counsel for Pfizer Inc. (“Pfizer”); Messrs. Chang, Desai, Goetz, and Darby, counsel for Sanofi-Aventis Deutschland GmbH (“Patent Owner”); and Judges Browne, Jung, Gerstenblith, and Tartal.² Petitioner provided a court reporter for the conference and a transcript of the conference is to be entered as an exhibit in the record of each case, reflecting additional details of the conference not described below.

During the conference, Patent Owner indicated that its proposed one-page, non-argumentative statement would cite *Arthrex*. Upon questioning, Patent Owner was not able to provide a clear legal basis for authorizing its request, agreed that an argument based on the Appointments Clause was not made previously in any of the above-listed proceedings,³ and

² None of the above-listed proceedings have an expanded panel, but the judges constituting the panels of all of these proceedings participated in the conference call. During the conference call, the parties confirmed their understanding that the presence of four judges on the call did not mean there was an expanded panel in any of these proceedings.

³ Patent Owner’s sole basis for its request was that it wants to “preserve” an argument directed to the Appointments Clause. As discussed, however,

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agreed that *Arthrex* prompted Patent Owner's request. Patent Owner also agreed that raising any other substantive argument in these proceedings after Patent Owner sur-replies had been filed would normally be considered new argument and, thus, deemed waived.

Mr. Torczon, on behalf of both Mylan and Pfizer, responded, *inter alia*, that Patent Owner's request would be a waste of resources, that a "non-argumentative" statement or reference to *Arthrex* is not an argument, that an argument based on the Appointments Clause was not previously made in these proceedings, that issues related to the Appointments Clause were well-known prior to *Arthrex*, that Patent Owner has not shown any good cause for additional briefing under Rule 42.5, and that Patent Owner's request is an improper attempt to exceed the briefing-size limitations in these matters. Mylan and Pfizer also argued that they would potentially be prejudiced by Patent Owner's request.

Based on the parties' arguments and representations, we deny Patent Owner's request to file a one-page, non-argumentative statement in each of the above-listed proceedings. We agree with Mylan and Pfizer that good cause has not been shown to authorize additional briefing under Rule 42.5, and Patent Owner did not identify any clear legal basis for authorizing its request. We also agree with Mylan and Pfizer that the issues related to the Appointments Clause were previously identified and, thus, determine that Patent Owner could have, but chose not to, include an argument in its authorized briefing. Furthermore, the transcript of our teleconference that is

because Patent Owner did not raise such an argument, there is no argument to "preserve."

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to be filed in the record of each of these cases will sufficiently reflect the parties' positions regarding the concerns raised by Patent Owner with respect to *Arthrex* and the Appointments Clause, and therefore, good cause for additional briefing is not shown.

ORDER

In view of the foregoing, it is:

ORDERED that Patent Owner's request to file a one-page, non-argumentative statement in each of the above-listed proceedings concerning *Arthrex* and the Appointments Clause is *denied*.

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