

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ELI LILLY AND COMPANY,  
Petitioner,

v.

TEVA PHARMACEUTICALS INTERNATIONAL GMBH,  
Patent Owner.

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Case IPR2018-01710 (Patent 8,586,045 B2)

Case IPR2018-01711 (Patent 9,884,907 B2)

Case IPR2018-01712 (Patent 9,884,908 B2)<sup>1</sup>

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

WORTH, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order addresses issues that are common to all three 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.”

IPR2018-01710 (Patent 8,586,045 B2); IPR2018-01711 (Patent 9,884,907 B2); IPR2018-01712 (Patent 9,884,908 B2)

The Board held oral argument in these cases on January 8, 2020.

On December 18, 2019, the U.S. Court of Appeals for the Federal Circuit issued an opinion in *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 2019 WL 6884530 (Fed. Cir. 2019), after the filing of the principal briefs in these cases. In *Fox Factory*, the court “address[ed] the Board’s application of the presumption of nexus” to certain claims at issue. *Id.* at \*5. In so doing, the court reached a conclusion as to whether the patent owner’s products were “coextensive” with the claims. *Id.*

In its Patent Owner Response, Patent Owner argues that “[t]he challenged claims have a presumption of nexus to the objective indicia of nonobviousness.” Paper 21, 55.<sup>2</sup> Petitioner disagrees. *See* Paper 32, 21–27.

In view of the court’s opinion in *Fox Factory*, the panel has decided that supplemental briefing is warranted to allow the parties to explain the applicability, if any, of *Fox Factory* to the issues argued by the parties. The panel is not re-opening the evidentiary record at this time. Accordingly, the parties’ positions in their supplemental briefs are requested to relate back to evidence already of record.

Accordingly, it is

ORDERED that Petitioner and Patent Owner are each authorized to file a supplemental brief, no longer than seven pages, that addresses the above-identified issues no later than Friday, January 24, 2020;

FURTHER ORDERED that Petitioner and Patent Owner are each authorized to file a responsive supplemental brief, no longer than five pages,

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<sup>2</sup> Where the same or similar papers have been filed in multiple proceedings, we refer herein to the papers filed in Case IPR2018-01710.

IPR2018-01710 (Patent 8,586,045 B2); IPR2018-01711 (Patent 9,884,907 B2); IPR2018-01712 (Patent 9,884,908 B2)

that is responsive to the other party's supplemental brief no later than Friday, January 31, 2020;

FURTHER ORDERED that no additional evidence may be filed at this time.

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