

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC and AMNEAL
PHARMACEUTICALS OF NEW YORK, LLC
Petitioners,

v.

ALMIRALL, LLC,
Patent Owner.

IPR2019-00207¹
Patent 9,517,219 B2

Before SUSAN L. C. MITCHELL, CHRISTOPHER G. PAULRAJ, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

CONDUCT OF THE PROCEEDING
Denying Authorization for Patent Owner
Motion to file Supplemental Information
37 C.F.R. § 42.5(a); § 42.123(b)

¹ Cases IPR2019-00207 and IPR2019-01095 have been joined in this proceeding. When referring herein to “this case” or “this proceeding” or variants of these, we refer to both joined cases.

In this proceeding, trial was instituted on May 10, 2019 (Paper 13), Patent Owner filed a Response (Paper 20), Petitioner filed a Reply thereto (Paper 28), and Patent Owner filed a Sur-reply thereto (Paper 37). A final hearing was conducted on February 7, 2020. *See* Paper 55. On May 5, 2020, we issued an order adjusting the one-year pendency due to joinder for this proceeding such that our Final Written Decision shall be issued no later than June 5, 2020. Paper 56.

On May 21, 2020, Patent Owner emailed the Board, stating:

Patent Owner (Almirall) respectfully requests authorization to file a motion [to] submit Petitioner's (Amneal's) claim construction briefing recently served in a related litigation concerning U.S. Patent No. 9,517,219, *Almirall, LLC v. Amneal Pharmaceuticals LLC*, C.A. No. 1:19-cv-00658-GJP (D. Del.), as supplemental information pursuant to 37 CFR 42.123(b).

Petitioner has indicated that it opposes the requested relief. Should the Board desire a conference call, counsel for both parties are mutually available for a conference at the Board's nearest convenience.

Ex. 3001. We note, neither party has previously identified the above-referenced district court case as related to this proceeding. *See* Paper 20; Paper 5; Paper 7; Paper 16; Paper 31. Under 37 C.F.R. § 42.8(a)(3), Mandatory Notices, including identification of related matters, must be updated "within 21 days of a change of the information" previously noticed under the Section.

Given the late stage of this the proceeding, and our impending issuance of a Final Written Decision, no further evidence or briefing is authorized, and we deny Patent Owner authorization to file a motion to submit supplemental evidence.

37 C.F.R. § 42.123(b) states:

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

Patent Owner has not previously sought any claim constructions in this proceeding. *See* PO Resp. 28. We conclude that the supplemental information identified by Patent Owner is not evidence needed to resolve any issues in this proceeding, and thus its submission in this proceeding would not be in the interests-of-justice.

Accordingly, it is:

ORDERED that Patent Owner is not authorized to file a motion to submit supplemental information.

IPR2019-00207
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