

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES S.A. and DR. REDDY'S
LABORATORIES, INC.,
Petitioners,

v.

INDIVIOR UK LIMITED,
Patent Owner.

Case IPR2019-00328 (Patent No. 9,687,454 B2)
Case IPR2019-00329 (Patent No. 9,687,454 B2)¹

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and RICHARD J.
SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

¹This Order addresses issues that are common to both cases. We, therefore, issue a single Order that has been entered in both cases. 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."

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Petitioners Dr. Reddy's Laboratories S.A. and Dr. Reddy's Laboratories, Inc. filed two Petitions on November 13, 2018, identifying Indivior UK Limited as Patent Owner. Paper 1 ("Pet." or "Petitions").² The Petitions request *inter partes* review of claims 1–3 and 5–14 of U.S. Patent No. 9,687,454 B2 ("the '454 patent," Ex. 1001) (IPR2019-00328) and claims 1–5 and 7–14 of the '454 patent (IPR2019-00329). Both Petitions identified Dr. Reddy's Laboratories S.A. and Dr. Reddy's Laboratories, Inc. as the real parties in interest. Pet. 61. Both Petitions were accompanied by a Declaration of Nandita Das, Ph.D. ("Das Declaration").³ Ex. 1003.

In its Preliminary Response (Paper 12, "Prelim. Resp.") in both cases, Patent Owner argued that the respective Petitions should be denied because Petitioners failed to identify LTS Lohmann Therapy Systems, Corp. ("LTS") as a real party in interest ("RPI"). Prelim. Resp. 50–52. Patent Owner also argued in its Preliminary Responses that the Das Declaration is deficient because it failed to include the statement required by 37 C.F.R. § 1.68. *Id.* at 53. In its Preliminary Response in IPR2019-00328, Patent Owner argued that the Petition should be denied under 35 U.S.C. § 325(d) because the same or substantially the same prior art or arguments presented in the Petition were previously considered by the Office.⁴ *Id.* at 1–29.

² Paper numbers in this Order refer to papers filed in IPR2019-00328, although this applies primarily to page numbers because, in both cases, the respective Petitions are Paper 1, the Preliminary Responses are Paper 12.

³ A corrected version of the Das Declaration was submitted by Petitioners (without opposition by Patent Owner) on March 26, 2019, as a substitute for the original Das Declaration. ("Corrected Das Declaration," Ex. 1003).

⁴ The arguments advanced by Patent Owner regarding the RPI issue and the Das Declaration issue are the same in both IPR2019-00328 and IPR2019-00329. The Section 325(d) argument was only advanced in IPR2019-00328.

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In an e-mail to the Board on March 29, 2019, Petitioners requested a telephone conference with the Board to seek authorization to file replies to address the RPI issue, the Das Declaration issue, and the Section 325(d) issue advanced in the Preliminary Responses. Patent Owner opposed Petitioners' request to file replies regarding those issues. A conference call was held between and among counsel for the parties and Judges Zhenyu Yang and Richard J. Smith on April 16, 2019, to discuss Petitioners' request.

During the conference call, the parties were given the opportunity to present their arguments in support of their positions. Counsel for Patent Owner stated during the call that the issue regarding the Das Declaration was rendered moot by the filing of the Corrected Das Declaration. Petitioners' counsel was also advised that its pending motions to admit Robert Frederickson III *pro hac vice* (Paper 7) were denied without prejudice for failure of the accompanying declaration to include the statement required by 37 C.F.R. § 1.68 or 28 U.S.C. § 1746.

Based on our consideration of the parties' positions, we authorized Petitioners to file a single reply addressing the RPI issue and the Section 325(d) issue, and to file a single 2-page declaration accompanying the reply, and further authorized Patent Owner to file a single sur-reply, limited to a response to Petitioners' reply, as set forth below.

For the reasons given, it is hereby:

ORDERED that Petitioners may file a single reply brief of no more than six pages, that shall be filed in both IPR2019-00328 and IPR2019-00329, to address Patent Owner's real party in interest arguments and Section 325(d) arguments, within six business days after April 16, 2019; and

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FURTHER ORDERED that Petitioners may file a 2-page declaration with its reply brief that is limited to addressing Patent Owner's real party in interest arguments as advanced in its Preliminary Responses; and

FURTHER ORDERED that Patent Owner is authorized to file a single sur-reply of no more than six pages, that shall be filed in both IPR2019-00328 and IPR2019-00329, that is limited to a response to the arguments raised in Petitioners' reply brief, within six business days after service of Petitioners' reply brief; and

FURTHER ORDERED that Petitioners' Unopposed Motion for *Pro Hac Vice* Admission of Robert Frederickson III under 37 C.F.R. § 42.10(c), filed in both IPR2019-00328 and IPR2019-00329 (Paper 12), is denied without prejudice.

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