

Filed: September 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
SAWAI USA, INC., AND
SAWAI PHARMACEUTICAL CO., LTD.,
Petitioner,

v.

BIOGEN MA INC.,
Patent Owner.

IPR2018-01403*
Patent No. 8,399,514

**PATENT OWNER'S REHEARING REQUEST ON INSTITUTION AND
JOINDER OF SAWAI PETITION IN IPR2019-00789**

* Case IPR2019-00789 has been joined with this proceeding and the Board instructed that "all further filings shall be made only in IPR2018-01403." IPR2019-00789, Paper 17, 21.

TABLE OF CONTENTS

	Page(s)
Introduction	1
I. Real Party in Interest Requirement for Institution	3
A. The Board Improperly Applied the RPI Burdens Framework	4
B. The Decision Failed to Properly Consider Sumitomo’s Undisputed “Strategic Alliance” with Sawai	6
C. The Decision Violates Due Process by Preventing Patent Owner from Cross-Examining and Being Heard on the RPI Issue	10
II. Joinder of Otherwise Time-Barred Sawai Was Improperly Granted	10
III. Improper Exercise of Discretion	14
Conclusion	15

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Applications in Internet Time, LLC v. RPX Corp.</i> , 897 F.3d 1336 (Fed. Cir. 2018)	<i>passim</i>
<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , IPR2016-01156, Paper 39 (PTAB Aug. 14, 2017).....	3, 13
<i>General Plastics Indus. Co. v. Canon Kabushiki</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).....	3, 15
<i>Goldberg v. Kelly</i> , 397 U.S. 254 (1970).....	2, 3, 13
<i>Greene v McElroy</i> , 360 U.S. 474 (1959).....	13
<i>Icon Health & Fitness, Inc. v. Strava, Inc.</i> , 849 F.3d 1034 (Fed. Cir. 2017)	5
<i>Lumentum Holdings, Inc. v. Capella Photonics, Inc.</i> , No. IPR2015-00739, Paper 38 (PTAB Mar. 4, 2016).....	9
<i>Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.</i> , IPR2014-00488, Paper 61 (PTAB May 22, 2015)	5
<i>Proppant Express Investments, LLC v. Oren Technologies, LLC</i> , IPR2018-00914, Paper 38 (PTAB Mar. 13, 2019).....	2, 11
<i>Stride Rite Children’s v. Shoes by Firebug</i> , IPR2017-01809, Paper 64 (PTAB Jan. 16, 2019)	14
<i>Unified Patents, Inc. v. Personalized Media Comm’n, LLC</i> , IPR2015-00521, Paper 13 (PTAB Jun. 8, 2015).....	11
<i>Valve Corp. v. Electronic Scripting Prods., Inc.</i> , IPR2019-00062, Paper 11 at 14 (PTAB Apr. 2, 2019).....	14

...

Worlds Inc. v. Bungie, Inc.,
903 F.3d 1237 (Fed. Cir. 2018)*passim*

ZTE Corp. v. Adaptix, Inc.,
IPR2015-01184, Paper 10 (PTAB July 24, 2015).....3, 12

ZTE (USA) Inc. v. Fundamental Innovation Systems Int’l LLC,
IPR2018-01076, Paper 14 at 12 (PTAB Dec. 3, 2018)5

Federal Statutes

5 U.S.C. § 554.....2, 3, 8

5 U.S.C. § 556.....2, 3, 13

35 U.S.C. § 312.....1, 10

35 U.S.C. § 313.....14

35 U.S.C. § 314.....3

35 U.S.C. § 315.....3, 7, 8, 9

35 U.S.C. § 316.....13

35 U.S.C. § 317.....15

35 U.S.C. § 325.....3

Regulations

37 C.F.R. § 42.513, 13

37 C.F.R. § 42.711

37 C.F.R. § 42.108.....3

Other Authorities

PTAB Standard Operating Procedure 2 (Rev. 10).....11

Restatement (Third) of Agency § 1.01, comment c
(Am. Law Inst. 2006).....8

Introduction

Patent Owner respectfully requests rehearing of the Board’s decision of September 12, 2019 (IPR2019-00789, Paper 17) (“Decision” or “Dec.”), which instituted *inter partes* review on Sawai’s petition (IPR2019-00789, Paper 1) and granted the joinder motion (IPR2019-00789, Paper 2). Dec., 2. Rehearing should be granted pursuant to 37 C.F.R. § 42.71(d), and institution and joinder denied.

First, the Decision improperly granted institution by “misapprehend[ing] or overlook[ing],” *id.*, whether the Real Party in Interest (“RPI”) was properly named in the petition. 35 U.S.C. § 312(a)(2). The Board found that Biogen “reasonably br[ought] into question the accuracy of a petitioner’s identification of RPIs” *See* Dec., 13. After finding that Biogen had satisfied its burden of production, however, the Decision erred by holding that *Patent Owner* had “not persuaded” the Board that there were unnamed RPIs. *See id.*, 13, 17. This was contrary to the established framework that *petitioner* always bears the burden of persuasion to establish compliance with the statutory requirement to identify all RPIs. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242-46 (Fed. Cir. 2018).

The Decision’s RPI analysis also overlooked the evidence and argument that Sumitomo Corporation and SCOA (collectively “Sumitomo”) are unnamed RPIs via an “attorney-in-fact” or “implied litigating agent” relationship with Sawai.

IPR2019-00789, Paper 15, 7-9, 12-13; *Applications in Internet Time, LLC v. RPX*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.