

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
Petitioner

v.

ALMIRALL, LLC,  
Patent Owner

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Case IPR2019-01095  
Patent 9,517,219

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**PATENT OWNER'S PRELIMINARY RESPONSE**

**TABLE OF CONTENTS**

	<b>Page</b>
PATENT OWNER’S EXHIBIT LIST .....	iii
I. INTRODUCTION.....	1
II. THE GENERAL PLASTIC FACTORS DEMONSTRATE THAT THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(A) .....	3
A. Factor 1: Whether the Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent.....	5
B. Factor 2: Whether at the Time of Filing of the First Petition the Petitioner Knew of the Prior Art Asserted in the Second Petition or Should Have Known of It .....	7
C. Factor 3: Whether at the Time of Filing of the Second Petition the Petitioner Already Received the Patent Owner’s Preliminary Response to the First Petition or Received the Board’s Decision on Whether to Institute Review in the First Petition .....	8
D. Factor 4: Elapsed Time .....	9
E. Factor 5: Whether the Petitioner Provides Adequate Explanation for the Time Elapsed Between the Filings of Multiple Petitions Directed to the Same Claims of the Same Patent. ....	10
F. Factors 6 & 7: The Finite Resources of the Board and the One-Year Final Decision Requirement .....	10
G. Weighing the Factors .....	11
III. CONCLUSION .....	11

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Abiomed, Inc. v. Maquet Cardiovascular, LLC</i> , IPR2017-02134, Paper 7 (PTAB April 16, 2018).....	<i>passim</i>
<i>Abiomed, Inc. v. Maquet Cardiovascular, LLC</i> , IPR2017-02150, Paper 11 (PTAB March 12, 2018).....	4
<i>Almirall, LLC v. Amneal Pharmaceuticals Inc.</i> , No. 19-658-LPS, Dkt. No. 8 (D. Del. May 1, 2019).....	6
<i>Apple Inc. v. Immersion Corp.</i> , IPR2017-01371, Paper 7 (PTAB Nov. 21, 2017) .....	5
<i>Arris Grp, Inc. v. Cirrex Sys. LLC</i> , IPR2015-00530, Paper 12 (PTAB Jul. 27, 2015) .....	10
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-01301, Paper 7 (PTAB Oct. 13, 2017) .....	11
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) .....	<i>passim</i>
<i>Novartis Pharms. Corp. v. Amneal Pharmaceuticals, LLC, Amneal- Agila, LLC, Mylan, Inc., and Mylan Institutional Inc.</i> , No. 2:14-cv-07557-SDW-SCM, Dkt. No. 7 (D.N.J. Jun. 9, 2015).....	6
<i>Samsung Elecs. Co., Ltd. v. Rembrandt Wireless Techs., LP</i> , IPR2015-00555, Paper 20 (PTAB June 19, 2015).....	11
<i>Valve Corp. v. Electronic Scripting Prods., Inc.</i> , IPR2019-00062, -00063, -00084, Paper 11 (Apr. 2, 2019) .....	<i>passim</i>
<b>STATUTES</b>	
35 U.S.C. §314(a).....	<i>passim</i>
35 U.S.C. § 316(a)(11) .....	4

**PATENT OWNER'S EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
2001	Declaration of Elizabeth B. Hagan in Support of Patent Owner Almirall, LLC's Motion for Admission <i>Pro Hac Vice</i>

...

Pursuant to 37 C.F.R. § 42.107(a), Patent Owner Almirall, LLC (“Almirall”) submits the following Preliminary Response to the Petition for *Inter Partes* Review of U.S. Patent No. 9,517,219 (“the ’219 Patent”) submitted by Petitioner Mylan Pharmaceuticals Inc. (“Mylan”). The Board should deny the Petition and decline to institute trial.

## I. INTRODUCTION

Patent Owner respectfully requests that the Board employ its discretion under 35 U.S.C. § 314(a) to deny institution.

The Board should exercise its discretion under 35 U.S.C. §314(a) to refuse to institute this follow-on petition, which presents the precise potential for abuse warned against in *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, Case IPR2016–01357, Paper 19 (PTAB Sept. 6, 2017), which arises when information from a prior Board proceeding is available for a subsequent proceeding. The factors set forth in *General Plastic* weigh heavily in support of denial. The Petitioner challenges the same claims of the same patent previously challenged by Amneal Pharmaceuticals LLC and Amneal Pharmaceuticals of New York, LLC (collectively, “Amneal”) in IPR2019-00207, asserting the same prior art references. Indeed, Petitioner admits that its “Petition is the *same as the Amneal IPR*: it involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations) as the Amneal IPR” and “identical

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