

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

ALMIRALL, LLC,
Patent Owner.

Case IPR2019-01095
Patent 9,517,219 B2

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

FLAX, *Administrative Patent Judge*.

ORDER

*Authorizing Reply to Preliminary Response to Petitioner
and Sur-reply to Patent Owner
37 C.F.R. § 42.108(c)*

Petitioner emailed the Board on September 12, 2019, stating

. . . Mylan would like to respectfully seek the panel’s permission to submit a short 10 page Reply to Patent Owner’s Preliminary Response (“POPR”). The POPR is exclusively dedicated to raising issues related to 314(a). . . .

In the spirit of compromise, Patent Owner and Mylan have reached an agreement where Patent Owner does not object to Mylan’s Request for a 10 page Reply to the POPR, and Mylan does not object to request by Patent Owner for a 5 page Sur-Reply. Mylan notes that the PTAB granted a similar request in the underlying IPR. *See* IPR2019-00209 (Paper 9). . . .

“A petitioner may seek leave to file a reply to the preliminary response in accordance with [37 C.F.R.] §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.” 37 C.F.R. § 42.108(c). In the Petition, Petitioner devoted very little discussion to any potential denial of the Petition under § 314(a). Paper 1, 66–68. Patent Owner, however, devoted the entirety of its Preliminary Response to argue that institution should be denied under § 314(a). *See generally* Paper 9. The parties appear to agree that there is good cause for authorizing Reply and Sur-reply briefing on this issue and that the requested briefing should be authorized. We find that good cause exists for the requested briefing.

Accordingly, it is:

ORDERED that Petitioner is authorized to file a Reply of no more than ten (10) pages, within five (5) business days after issuance of this Order, responsive to the allegations under 35 U.S.C. § 314(a) as set forth in Patent Owner’s Preliminary Response.

FURTHER ORDERED that following Petitioner’s filing of the aforementioned Reply, Patent Owner is authorized to file a Sur-reply of no

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more than five (5) pages, within five (5) business days, addressing only issues addressed in the Reply.

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