

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., DR. REDDY'S LABORATORIES, INC.,
DR. REDDY'S LABORATORIES, LTD., and SUN PHARMACEUTICALS
INDUSTRIES LTD.¹

Petitioner,

v.

MERCK SHARP & DOHME CORP.

Patent Owner.

U.S. Patent No. 7,326,708 to Cypes *et al.*

Issue Date: February 5, 2008

Title: Phosphoric Acid Salt of a Dipeptidyl Peptidase-IV Inhibitor

Inter Partes Review No.: IPR2020-00040

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64**

¹ Dr. Reddy's Laboratories, Inc. and Dr. Reddy's Laboratories, Ltd. were joined as a party to this proceeding via a Motion for Joinder in IPR2020-01060; and Sun Pharmaceuticals Industries Ltd. was joined as a party to this

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Merck and its expert Dr. Matzger—not Mylan—introduced and relied upon Dr. Chyall’s work in EX2225. Specifically, Dr. Matzger relied on (1) the methanol experiment of which Merck now complains (EX2103, ¶126 (citing EX2225, ¶¶23-25)) and (2) a solubility study related to pH (EX2103, ¶131 (citing EX2225 at ¶69)). Dr. Matzger fully understood Dr. Chyall’s methanol experiments since he even provided a brief summary. EX2103, ¶126. Mylan’s expert Dr. Chorghade’s reliance on the *same* methanol experiments that Merck relied on is entirely proper. EX1035, ¶10; *see also* EX1035, ¶¶11-44. What is good for the goose is good for the gander.

Merck’s effort to exclude only *Mylan’s* use of Dr. Chyall’s experiments while unabashedly contending that it have unfettered discretion to rely on those experiments smacks of unfairness. Merck’s Motion to Exclude (“Motion”) at 15 (“The Board should exclude the portions of EX2225 on which only Mylan relies, and should limit its consideration of EX2225 to the non-hearsay uses in Merck’s submissions.”). The PTAB has refused to entertain Patent Owner’s wielding of the proverbial sword while shielding Petitioner’s use of the same material. *Caterpillar, Inc. v. Wirtgen Am., Inc.*, IPR2018-01091, Paper 49, at 71 (P.T.A.B. Nov. 27, 2019) (“We will not endorse Patent Owner’s attempt to use the transcript as a sword for its purposes, and our rules as a shield to prevent Petitioner from using the same transcript to rebut Patent Owner’s contentions.”); *Cephalon, Inc. v. Watson Pharm., Inc.*, 769 F. Supp. 2d 761, 772 (D. Del.), *aff’d*, 446 F. App’x 306 (Fed. Cir. 2011)

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