

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.
Petitioner,

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

IPR2020-00040
Patent 7,326,708 B2

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

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

On March 4, 2020, the Board held a conference call with the parties pursuant to Petitioner's request made in an email dated February 25, 2020. Ex. 3001. A court reporter was also present, and the Board instructed the parties to file a transcript of the conference as an exhibit when available.

As indicated during the conference, Petitioner requests authorization to file a Reply to the Patent Owner's Preliminary Response. *See* 37 C.F.R. § 42.108(c). Petitioner seeks to respond to several issues raised in Patent Owner's Preliminary Response. Those issues are the following: whether the claimed invention antedates certain prior art asserted in the Petition; whether the Board should exercise discretion and deny the Petition under 35 U.S.C. § 325(d) because certain prior art was already before, and/or considered by, the examiner during prosecution of the challenged patent; and whether the Board should exercise discretion and deny the Petition under 35 U.S.C. § 314(a) based, among other things, on the status of, and nature of the claims raised in, related district court litigation.

Rule 42.108(c) states: "A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause." 37 C.F.R. § 42.108(c).

Based on the argument made during the conference, we are persuaded that good cause exists here. The parties agree that additional pre-institution briefing should be permitted to address the antedation issue. We find that some matters raised by Patent Owner in the Preliminary Response in favor of discretionary denial (e.g., the number of the grounds implicated by the antedation evidence) were not reasonably foreseeable to Petitioner. And, we conclude on this record that the Board may benefit from further written argument from the parties addressing the discretionary denial issues raised.

Accordingly, the parties will be given an opportunity to address briefly, and in writing, the above issues. We authorize a Reply from Petitioner and a Sur-Reply from Patent Owner. To be clear, the parties' respective papers will be limited to addressing the antedation issue, and the issues of discretionary denial under § 325(d) and § 314(a). No new evidence may be submitted with the authorized Reply and Sur-Reply.

It is

ORDERED that Petitioner's request to file a Reply to the Patent Owner's Preliminary Response is *granted* as provided above;

FURTHER ORDERED that Petitioner is authorized to file, on or before March 13, 2020, a Reply to Patent Owner's Preliminary Response, and that Reply shall be limited to eight (8) pages; and

FURTHER ORDERED that Patent Owner is authorized to file, on or before March 20, 2020, a Sur-Reply to Petitioner's Reply, and any such Sur-Reply shall be limited to eight (8) pages.

IPR2020-00040 (Patent 7,326,708 B2)

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