IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC. 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.: <u>IPR2020-00040</u>

Petitioner's Reply to Patent Owner's Preliminary Response

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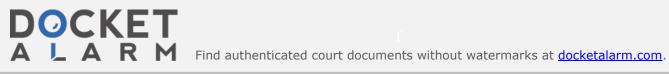


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I. INSTITUTION SHOULD NOT BE DENIED BASED ON §325(D)

A. Petitioner's Asserted Grounds Were Not Considered During Prosecution (*Becton* Factors (a-e)).

There is no dispute that the Examiner never put forth any prior art rejection during prosecution of the '708 patent, including the grounds advanced in the Petition. Instead, Merck's entire argument is premised on three facts: (1) an IDS listing the '871 patent and WO '498; (2) a hurried account of WO '498 in the specification of the '708 patent; and (3) Merck's speculations as to the Examiner's actions. Even Merck concedes that the Examiner did not initial the listing of WO '498 on the IDS. POPR at 17, EX1010 at 157. Absent the Examiner's initials, as the IDS explicitly states, WO '498 was not considered. Id. ("Initial if reference considered."). To address any confusion, in minutes, Merck could have resubmitted an IDS with WO '498, filed an RCE with an IDS, or simply called the Examiner. Merck did not. Instead, without explanation, Merck asks that its inaction be excused and institution of Mylan's petition be denied. Finally, as Merck admits, the specification of the '708 patent discusses WO '498 but not the '871 patent. POPR 14-15. It is not incumbent upon the Examiner to link the '871 patent and WO '498.

"The Board has consistently declined to exercise its discretion under §325(d) based on the mere citation of references in an IDS that were not applied by the Examiner." *Apotex, Inc. v. UCB Biopharma, SPRL*, IPR2019-00400, Paper 17 at 24 (July 15, 2019); *Amgen Inc. v. Alexion Pharmaceuticals Inc.*, IPR2019-00740,



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