

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)¹

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

MAJORS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authorizing Motion to File Request for Certificate of Correction
37 C.F.R. §§ 1.323, 42.5, 42.20

¹ Petitioners in IPR2020-01045, IPR2020-01060, and IPR2020-01072 were joined as parties to this proceeding. *See* Papers 44–46.

On November 6, 2020, the Board held a conference call with the parties to discuss Patent Owner's request for authorization to file a motion seeking leave to file a certificate of correction. A court reporter was present for the call; the parties are instructed to file a transcript when available.

Patent Owner's request for leave to file a certificate of correction relates to claims 5–7 of U.S. Patent 7,326,708 B2 (“the ’708 patent”). Claims 5–7 are not challenged in this proceeding. As discussed during the conference call, Patent Owner contends that claims 5–7 include an evident mistake by the patent applicant that is correctable under 35 U.S.C. § 255. As such, Patent Owner requests authorization to file a motion before the Board, requesting that the Board cede jurisdiction over the ’708 patent specific to claims 5–7 so that Patent Owner may petition the Director for a certificate of correction on those claims. Petitioner objects, arguing the alleged mistake is not correctable and points to colloquy and an oral order from claim construction proceedings in a related district court case, in which it was alleged the court determined claims 5–7 were indefinite and could not be corrected by the court.

Upon hearing preliminary argument from the parties at the conference call, we authorize Patent Owner's request for leave to file its motion. Whether the relief Patent Owner seeks from the Board is justified will be decided after receiving the motion and authorized briefing (detailed below). *See generally Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349–50 (Fed. Cir. 2019) (explaining the steps and showing required by patent owner seeking a certificate of correction under 35 U.S.C. § 255 for a patent undergoing post-grant proceedings before the Board).

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Accordingly, it is:

ORDERED that Patent Owner is authorized to file a Motion to File Request for Certificate of Correction of Claims 5–7, which motion will be no more than ten (10) pages and will be filed no later than November 17, 2020; Patent Owner will also file the relevant transcript from related district court proceedings, discussed above, as an exhibit to its motion;

FURTHER ORDERED that Petitioner may file an Opposition to Patent Owner’s authorized motion, which Opposition will be no more than ten (10) pages and will be filed no later than December 4, 2020; and

FURTHER ORDERED that Patent Owner may file a Reply in support of Patent Owner’s authorized motion, which Reply will be no more than three (3) pages and will be filed no later than December 11, 2020.

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