

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN LABORATORIES LTD.  
Petitioner,

v.

JANSSEN PHARMACEUTICA NV,  
Patent Owner.

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IPR2020-00440  
Patent 9,439,906

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*Before* JOHN G. NEW, KRISTINA M. KALAN, and ROBERT A.  
POLLOCK, *Administrative Patent Judges*.

PER CURIAM

ORDER  
Granting Petitioner's and Patent Owner's Requests for Authorization for  
Additional Briefing  
*37 C.F.R. § 42.5*

In response to an email request by Petitioner Mylan Laboratories Ltd. (“Mylan”), a telephonic conference was held on June 30, 2019 at 1:00 p.m. EDT. Present were counsel for both Mylan and Patent Owner Janssen Pharmaceuticals N.V. (“Janssen”). A preliminary transcript of the call was filed as Exhibit 1048.

Mylan requests authorization to file a Reply Brief in Response to Janssen’s Preliminary Response (Paper 8). Specifically, Mylan seeks authorization to respond to Janssen’s arguments with respect to 35 U.S.C. §§ 314(a) and 325(d) in view of the factors set forth in the Board’s recent decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (March 20, 2020) (precedential). Mylan also seeks authorization to respond to Janssen’s arguments with respect to whether Janssen’s patent-in-suit can claim the priority benefit of Janssen’s U.S. Provisional Application No. 61/014,918 (the “918 application”). Mylan requests ten pages to brief these issues, to be submitted one week subsequent to an order authorizing the briefing.

Janssen does not oppose Mylan’s request with respect to the §§ 314(a)/325(d) issue, but opposes additional briefing with respect to the priority issue. However, if Mylan’s request is granted, Janssen seeks authorization to also file a Sur-Reply in response to Mylan’s submitted Reply Brief.

Having considered the arguments presented by both sides in the conference, we determine that further briefing would be useful for our determination whether to institute trial. Accordingly we authorize Mylan’s request to file a Reply with respect to both issues and we likewise authorize Janssen’s request to file a Sur-Reply to address both issues. The Reply and Sur-Reply briefings on both issues are limited to a combined ten-page limit

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for each, and subject to the requirements of 37 C.F.R. § 42.6(a). Mylan's Reply shall be submitted no later than one week following the issuance of this order, and Janssen's Sur-Reply shall be filed no later than one week subsequent to the filing of Mylan's Reply.

### ORDER

It is therefore,

ORDERED that Mylan's request to file a Reply Brief on both issues is authorized, said Reply Brief not to exceed ten pages, and to be filed no later than July 10, 2020, and

FURTHER ORDERED that Janssen is authorized to file a Sur-Reply in response to Mylan's Reply, said Sur-Reply not to exceed ten pages, and to be filed no later than July 17, 2020.

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