

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

IPR2021-00880 (Patent 9,669,069 B2)
IPR2021-00881 (Patent 9,254,338 B2)¹

Before ERICA A. FRANKLIN, JOHN G. NEW, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

NEW, *Administrative Patent Judge*.

ORDER

Authorizing Petitioner's Unopposed Motion to Amend its Mandatory Notices
37 C.F.R. § 42.8

¹ This Order addresses the same issue for the above-identified proceedings. Therefore, we exercise our discretion to issue one order to be filed in each proceeding. The parties are not authorized, however, to use this style heading in any subsequent papers.

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Mylan Pharmaceuticals Inc. (“Petitioner”) has filed an unopposed Motion to Amend its Mandatory Notices in both of the captioned proceedings. Paper 12.

Specifically, Petitioner seeks to add Janssen R&D LLC as a real party-in-interest, without altering the May 5, 2021 filing date. Paper 12, 1–2. Petitioner asserts that, upon discovering the omission of Janssen R&D LLC as a real party-in-interest, it promptly informed Patent Owner Regeneron Pharmaceuticals, Inc. (“Patent Owner”), and offered to update its mandatory notices.

Patent Owner does not oppose Petitioner’s Motion, or allege that there is any prejudice caused by the delay in disclosing Janssen R&D LLC as a real party-in-interest. Paper 12, 2.

“[I]f a petition fails to identify all real parties in interest under [35 U.S.C.] § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest.” *Mayne Pharma Int’l Pty. Ltd. v. Merck Sharp & Dohme Corp.*, 927 F.3d 1232, 1240 (Fed. Cir. 2019); *see also Proppant Express Invs., LLC v. Oren Techs., LLC*, No. IPR2017-01917, Paper 86 at 6–7 (P.T.A.B. Feb. 13, 2019) (precedential); *Adello Biologics LLC v. Amgen Inc.*, No. PGR2019-00001, Paper 11 at 3 (P.T.A.B. Feb. 14, 2019) (precedential). The Board considers the following factors when deciding whether to allow a petitioner to amend its identification of real parties in interest while maintaining the filing date: (1) attempts to circumvent the 35 U.S.C. § 315(b) bar or estoppel rules; (2) bad faith by the petitioner; (3) prejudice to the patent owner caused by the delay; and (4) gamesmanship by the petitioner. *Proppant Express*, IPR2017-01917, Paper 86 at 6–7.

Having considered these factors in view of Petitioner’s unopposed arguments, and finding that none of the factors exist here, we grant

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Petitioner's Unopposed Motion to Amend its Mandatory Notices in each of the captioned proceedings to include Janssen R&D LLC as a real party-in-interest while maintaining the original filing date.

ORDER

Petitioner's Unopposed Motion to Amend its Mandatory Notices is GRANTED for each of the captioned proceedings, as specified in this Order.

Petitioner's Amended Mandatory Notices are to be filed no later than October 1, 2021.

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