

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., MSN LABORATORIES
PRIVATE LTD. and MSN PHARMACEUTICALS INC.,
Petitioners,

v.

BAUSCH HEALTH IRELAND LIMITED,
Patent Owner.

Case No. IPR2022-00722¹
Patent No. 7,041,786 B2

Before: TINA E. HULSE, CYNTHIA M. HARDMAN, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

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

¹ IPR2023-00016 has been joined with this proceeding.

Patent Owner seeks authorization to submit an expert report served by Petitioner in a related district court proceeding (“the Zhou report”) as supplemental information under 37 C.F.R. § 42.123. Ex. 3002 (Email from J. Hasford dated Aug. 9, 2023). Given the timing of this request, Patent Owner “must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b).

On August 17, 2023, the Board held a conference call with the parties to discuss Patent Owner’s request.² After hearing from the parties, we determined that it would not be in the interests-of-justice to allow submission of the Zhou report at this stage of the proceeding. In particular, we noted that much of the information Patent Owner pointed to in the Zhao report is already in the record. Thus, any need for that information is substantially outweighed by the prejudice and burden of allowing Patent Owner to submit a several-hundred-page expert report, along with additional briefing from the parties regarding that report, less than a month before the statutory deadline for our final written decision.

We are also unconvinced that the information could not have been obtained earlier. During the call, Petitioner explained that nearly identical information was served on Patent Owner in Petitioner’s invalidity contentions many months ago, but Patent Owner did not raise this issue with the Board until August 9, 2023. This was several weeks after the Zhou report

² We understand Petitioner arranged for a court reporter to generate a transcript of this call. Petitioner shall file a copy of the transcript as an exhibit. The transcript will provide additional detail regarding the matters discussed herein.

IPR2022-00722
Patent No. 7,041,786 B2

was served on Patent Owner. Patent Owner has not shown that this delay was reasonable, particularly given the late stage of this proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to file supplemental information under 37 C.F.R. § 42.123 is denied.

IPR2022-00722
Patent No. 7,041,786 B2

PETITIONER:

Jad Mills
Richard Torczon
Nicole Stafford
Dennis Gregory
WILSON SONSINI GOODRICH & ROSATI PC
jmills@wsgr.com
rtorczon@wsgr.com
nstafford@wsgr.com
dgregory@wsgr.com

Andrew Larsen
Melissa Hayworth
Christopher Sorenson
MERCHANT & GOULD P.C.
alarsen@merchantgould.com
mhayworth@merchantgould.com
csorenson@merchantgould.com

PATENT OWNER:

Justin Hasford
Bryan Diner
Joshua Goldberg
Caitlin O'Connell
Kyu Yun Kim
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
justin.hasford@finnegan.com
bryan.diner@finnegan.com
joshua.goldberg@finnegan.com
caitlin.oconnell@finnegan.com
kyuyun.kim@finnegan.com