

From: [Trials](#)

Sent: Wednesday, 9 November 2022 10.37.39

To: [Mills, Jad](#)

Cc: [Trials Hasford, Justin](#); [Diner, Bryan](#); [Goldberg, Joshua](#); [O'Connell, Caitlin](#); [Torczon, Richard](#); [Stafford, Nicole](#); [Gregory, Dennis](#); [Kim, Kyu Yun](#)

Subject: RE: Mylan Pharmaceuticals Inc. v. Bausch Health Ireland Ltd., IPR Nos. 2022-01102, -01103, -01104, -01105

Response requested: Yes

Importance: High

Sensitivity: Normal

EXT - trials@uspto.gov

Counsel:

Having considered the parties' positions in their joint email, the panel has determined that there is good cause for a reply brief on issue (1) (Patent Owner's §325(d) arguments), but not issue (2) (legal standard for obviousness/lead compound). Therefore, in each of the above-referenced proceedings, Petitioner is authorized to file a reply brief addressing issue (1) to which Patent Owner is authorized to file a sur-reply brief. Petitioner's reply briefs are due by November 15, 2022 and Patent Owner's sur-reply briefs are due by November 22, 2022. Each paper is limited to no more than 6 pages and no new exhibits are authorized.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Mills, Jad <jmills@wsgr.com>

Sent: Friday, November 4, 2022 12:10 PM

To: Trials <Trials@USPTO.GOV>

Cc: Hasford, Justin <Justin.Hasford@finnegan.com>; Diner, Bryan <bryan.diner@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; O'Connell, Caitlin <Caitlin.O'Connell@finnegan.com>; Torczon, Richard (External) <rtorczon@wsgr.com>; Stafford, Nicole <nstafford@wsgr.com>; Gregory, Dennis <dgregory@wsgr.com>; Kim, Kyu Yun <KyuYun.Kim@finnegan.com>

Subject: RE: Mylan Pharmaceuticals Inc. v. Bausch Health Ireland Ltd., IPR Nos. 2022-01102, -01103, -01104, -01105

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Honorable Board,

Counsel for Petitioner Mylan Pharmaceuticals Inc. and counsel for Patent Owner in the above-referenced proceedings submit this joint e-mail providing both parties' positions pursuant to the Board's Oct. 31, 2022 instructions. Counsel for Petitioner and Patent Owner met and conferred on Nov. 2, 2022.

Petitioner's Position:

Petitioner has requested pre-institution reply briefing of 10 pages in each of the above-referenced proceedings to address (1) Patent Owner's §325(d) arguments; and (2) Patent Owner's heightened legal standard for obviousness, including its "lead

preliminary responses that were not anticipated. Petitioner believes that 10 pages of briefing is appropriate because of the fact-specific nature of Patent Owner's §325(d) arguments and fact-specific application of Patent Owner's erroneous legal standard for obviousness in the preliminary response.

Petitioner is amenable to Patent Owner receiving authorization to file a sur-reply brief in each case of the same length as the authorized reply. Petitioner proposes filing its replies within 5 business days of receiving Board authorization, with Patent Owner's sur-replies being due within 10 business days of Petitioner's filings.

Counsel for Petitioner is available for a conference call with the Board after 3:00pm Eastern on Monday, November 6, before 1:00pm Eastern on Wednesday, November 9, and at the Board's convenience on Thursday, November 10 or Friday, November 11.

Patent Owner's Position:

During the meet and confer, Petitioner indicated that it seeks 6 pages to address Patent Owner's §325(d) arguments and 4 pages to address what Petitioner alleges is a "heightened legal standard for obviousness." Patent Owner opposes any reply briefing by Petitioner with respect to Petitioner's alleged "heightened legal standard for obviousness." Contrary to Petitioner's argument, Petitioner simply has manufactured a disagreement with Patent Owner as to the application of Federal Circuit law to the facts here. Patent Owner did not apply any "heightened legal standard for obviousness" in its Patent Owner Preliminary response, Patent Owner did not mischaracterize anything, and tellingly Petitioner could not identify a single case during the meet and confer indicating that a pre-institution reply would be warranted based on Petitioner's mere disagreement with the application of Federal Circuit law to the facts here.

Turning to §325(d), Patent Owner does not oppose additional briefing, but 6 pages is excessive. In a related case, IPR2022-00722, involving the same parties, the Board authorized Petitioner to submit pre-institution reply briefing totaling 5 pages to address both (1) §325(d) arguments and (2) Real-Party in Interest issues. Here, for the 325 (d) arguments alone, 2-3 pages should be sufficient.

Counsel for Patent Owner is available at the Board's convenience on Thursday, November 10 or Friday, November 11.

Respectfully submitted,

Jad A. Mills
Counsel for Petitioner

From: Trials <Trials@USPTO.GOV>

Sent: Monday, October 31, 2022 12:28 PM

To: Kim, Kyu Yun <KyuYun.Kim@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Hasford, Justin <Justin.Hasford@finnegan.com>; Diner, Bryan <bryan.diner@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; O'Connell, Caitlin <Caitlin.O'Connell@finnegan.com>; Torczon, Richard <rtorczon@wsgr.com>; Stafford, Nicole <nstafford@wsgr.com>; Gregory, Dennis <dgregory@wsgr.com>; Mills, Jad <jmills@wsgr.com>

Subject: RE: Mylan Pharmaceuticals Inc. v. Bausch Health Ireland Ltd., IPR Nos. 2022-01102, -01103, -01104, -01105

EXT - trials@uspto.gov

Counsel:

As the Board recently advised, we expect the parties to meet and confer before approaching the Board with requests. Please meet and confer by November 2nd regarding this request. When you confer, the parties should consider that the panel is generally amenable to requests for reply briefing provided they are limited in scope, do not seek an excessive number of

decision. Once you have conferred, please respond with a joint email that provides both parties' positions after having engaged in a good faith attempt to resolve their differences regarding this request.

Regards,
Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial and Appeal Board
(571) 272-7822

From: Kim, Kyu Yun <KyuYun.Kim@finnegan.com>
Sent: Friday, October 28, 2022 6:44 PM
To: Trials <Trials@USPTO.GOV>
Cc: Hasford, Justin <Justin.Hasford@finnegan.com>; Diner, Bryan <bryan.diner@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; O'Connell, Caitlin <Caitlin.O'Connell@finnegan.com>; Torczon, Richard (External) <rtorczon@wsgr.com>; EXT- nstafford@wsgr.com <nstafford@wsgr.com>; Gregory, Dennis <dgregory@wsgr.com>; Mills, Jad <jmills@wsgr.com>
Subject: RE: Mylan Pharmaceuticals Inc. v. Bausch Health Ireland Ltd., IPR Nos. 2022-01102, -01103, -01104, -01105

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Dear Board:

Patent Owner filed its preliminary responses on October 7. Petitioner waited until October 26, 19 days later, to contact Patent Owner about its planned request for pre-institution replies. On the same day, in less than two hours and without questioning Petitioner's delay, Patent Owner responded to Petitioner that Patent Owner was available to meet and confer on November 2. Patent Owner is still available for a meet and confer at that time, and believes the parties should proceed with this meet and confer to potentially reduce the number of issues for the Board. In the absence of such a meet and confer, Patent Owner must oppose all requested relief.

Respectfully submitted,

Kyu Yun

From: Mills, Jad <jmills@wsgr.com>
Sent: Friday, October 28, 2022 3:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: Hasford, Justin <Justin.Hasford@finnegan.com>; Diner, Bryan <bryan.diner@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; O'Connell, Caitlin <Caitlin.O'Connell@finnegan.com>; Kim, Kyu Yun <KyuYun.Kim@finnegan.com>; Torczon, Richard <rtorczon@wsgr.com>; EXT- nstafford@wsgr.com <nstafford@wsgr.com>; Gregory, Dennis <dgregory@wsgr.com>
Subject: Mylan Pharmaceuticals Inc. v. Bausch Health Ireland Ltd., IPR Nos. 2022-01102, -01103, -01104, -01105

EXTERNAL Email:

Honorable Board:

I represent Petitioner Mylan Pharmaceuticals Inc. in the above-referenced proceedings. All five of Patent Owner's counsel of record are copied on this e-mail.

Petitioner respectfully requests pre-institution reply briefing of 10 pages in each of the above-referenced proceedings to address (1) Patent Owner's §325(d) arguments; and (2) Patent Owner's heightened legal standard for obviousness, including

file a sur-reply brief in each case of the same length as the authorized reply.

Petitioner approached Patent Owner to meet and confer regarding this request, but counsel for Patent Owner informed Petitioner that they would not begin to discuss the request until one full week later. Despite repeated follow-ups by Petitioner, Patent Owner provided no response and failed to explain its delay. As the attorneys for Patent Owner have, in the interim, refused any response to the undersigned, and to avoid any further unexplained delay from Patent Owner, Petitioner seeks relief from the Board.

Counsel for Petitioner is available for a conference call next week at a time convenient for the Board.

Respectfully submitted,



Jad A. Mills

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