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Paper 48 (IPR2015-00643)  
Paper 49 (IPR2015-00644)  
Paper 43(IPR2015-00830)  
Entered: February 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC. and AMNEAL  
PHARMACEUTICALS LLC,  
Petitioners,

v.

YEDA RESEARCH & DEVELOPMENT CO. LTD.,  
Patent Owner.

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Case IPR2015-00643 (8,232,250 B2)  
Case IPR2015-00644 (8,399,413 B2)  
Case IPR2015-00830 (8,969,302 B2)<sup>1</sup>

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Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and  
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

DECISION

*Granting-in-Part and Denying-in-Part Patent Owner's Motion to File  
Supplemental Information  
37 C.F.R. § 42.123(b)*

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<sup>1</sup> Case IPR2015-01976 has been joined with Case IPR2015-00643; Case IPR2015-01980 has been joined with Case IPR2015-00644; and Case IPR2015-01981 has been joined with Case IPR2015-00830.

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## I. INTRODUCTION

Patent Owner Yeda Research and Development Co. Ltd. (“Patent Owner”) filed an authorized motion to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 42 (“Mot.”).<sup>2</sup> Specifically, Patent Owner seeks to file nine references cited in the Declaration of Henry G. Grabowski, Ph.D. (Ex. 2133) and a corrected version of Exhibit 2133 that refers to the corresponding supplemental information by exhibit number. *Id.* at 2 n.3 (listing the nine documents). Petitioners Mylan Pharmaceuticals Inc. and Amneal Pharmaceuticals LLC (collectively, “Petitioners”) filed an opposition to Patent Owner’s motion. Paper 46 (“Opp’n”).

## II. BACKGROUND

We instituted trial on August 25, 2015. Paper 13. Patent Owner filed its Patent Owner Response, along with Dr. Grabowski’s declaration, on November 20, 2015. Paper 26. According to Patent Owner, the Grabowski Declaration references several documents that were erroneously not filed as exhibits. Mot. 3. Patent Owner first became aware of the error by a January 12, 2016, letter from Petitioners identifying 51 documents that were cited in Dr. Grabowski’s declaration, but not filed as exhibits. Ex. 2140. Patent Owner now seeks to file nine of the omitted documents that form the basis of Dr. Grabowski’s opinions on the alleged commercial success of the claimed inventions. Mot. 3; Ex. 2139 (describing the nine documents).

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<sup>2</sup> Paper numbers and exhibits cited in this Decision refer to those filed in IPR2015-00643. Similar papers and exhibits were filed in the other proceedings.

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### III. ANALYSIS

Under 37 C.F.R. § 42.123(b), a motion to submit supplemental information more than one month after the date the trial is instituted “must show [(a)] why the supplemental information reasonably could not have been obtained earlier, and [(b)] that consideration of the supplemental information would be in the interests-of-justice.” Under the facts and circumstances of these proceedings, we weigh both factors when determining the outcome of the motion, taking into consideration our mandate to construe the rules to secure the just, speedy, and inexpensive resolution of every proceeding. *See Redline Detection, LLC v. Star Envirotech, Inc.*, No. 2015-1047, slip op. at 11 (Fed. Cir. Dec. 31, 2015) (“The PTAB’s decision to admit supplemental information is also informed by 37 C.F.R. Part 42, Subpart A[, which] requires USPTO regulations ‘be construed to secure the just, speedy, and inexpensive resolution of every proceeding.’”).

According to Patent Owner, the nine documents, which Dr. Grabowski cited in his declaration, “reasonably could not have been submitted earlier due to a filing error that excluded them from being uploaded concurrently with the Patent Owner Responses.” Mot. 1. We are not persuaded. As Petitioners note in its Opposition, Patent Owner was in possession of the supplemental information at the time of filing its Patent Owner Response. Opp’n 1. It also appears that Patent Owner had several opportunities to discover and correct the error, including in response to Petitioners’ Objections to Patent Owner’s Exhibits served on November 30, 2015 (Paper 28, 16), and when correcting Exhibit 2133 in IPR2015-00644

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for the “caption error” (Mot. 3 n.4). Ultimately, it was Petitioners that brought the error to Patent Owner’s attention in a letter on January 12, 2016. Ex. 2140. Thus, Patent Owner’s argument that it reasonably could not have obtained the information earlier is not compelling.

Nevertheless, we must also determine whether consideration of the supplemental information is in the interests of justice. Patent Owner asserts that it is in the interests of justice because “the documents will aid in the administration of the proceeding, will cause no prejudice to and are already in Petitioners’ possession, and, by contrast, Patent Owner would be prejudiced by denying this motion.” Mot. 2. Petitioners respond, stating that Patent Owner’s belated request distinguishes the facts of this case from earlier cases where panels have permitted the late-filing of supplemental information. Opp’n 3–4. Moreover, Petitioners argue that Patent Owner’s last-minute motion will prejudice Petitioners’ ability to prepare their reply, particularly because Patent Owner has not yet served the supplemental information on Petitioners (but has provided Bates numbers from a related district court litigation production, Ex. 1075). Opp’n 4–5. Finally, Petitioners assert that the protective order in the related litigation has prohibited lead counsel for Mylan, who is not involved in that litigation, from accessing “certain of the proposed supplemental information due to a protective order in the related litigations.” *Id.* at 5.

Having considered the parties’ arguments, we grant Patent Owner’s motion in part. Specifically, although we are not impressed by Patent Owner’s lack of diligence in both committing and correcting this error, we find that the interests of justice weigh in favor of considering those

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references that were available to Petitioners without restriction as a result of the related litigation—i.e., those documents that Patent Owner produced in the related litigation and *did not* mark as subject to the protective order (regardless of any permission later granted by Patent Owner). In other words, we are persuaded that Petitioners have had those documents in their possession and, for those documents not marked confidential, even Mylan's lead counsel could view those documents. Thus, we are persuaded that any prejudice to Petitioners with respect to the publicly available documents is minimal.

We do find troubling, however, the fact that Mylan's lead counsel was unable to view any documents marked as subject to the protective order in the related litigation until January 19, 2016, when Patent Owner authorized Petitioners to use the references in these proceedings. Ex. 1075. Thus, to the extent any of the nine documents were marked by Patent Owner as subject to the protective order in the related litigation when originally produced to Petitioners, we are not persuaded that considering those confidential documents would be in the interests of justice given the delay in producing those documents to Petitioners.

#### IV. CONCLUSION

In light of the foregoing, we grant-in-part and deny-in-part Patent Owner's motion to submit supplemental information.

Accordingly, it is

ORDERED that Patent Owner's motion to submit supplemental information under 37 C.F.R. § 42.123(b) is *granted-in-part* as to those

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requested documents that are not subject to the protective order in the related litigation;

FURTHER ORDERED that Patent Owner's motion to submit supplemental information is *denied-in-part* as to those requested documents that are subject to the protective order in the related litigation;

FURTHER ORDERED that Patent Owner shall file the authorized documents as separate, numbered exhibits; and

FURTHER ORDERED that Patent Owner shall file as a replacement exhibit Exhibit 2133 to refer to the exhibits authorized in this Decision.

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