

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN LABORATORIES LIMITED,  
Petitioner,

v.

AVENTIS PHARMA S.A.,  
Patent Owner.

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Case IPR2016-00712  
Patent 8,927,592 B2

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Before BRIAN P. MURPHY, TINA E. HULSE, and  
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
*Filing of Supplemental Information*  
37 C.F.R. § 42.5; 37 C.F.R. § 42.123(a)

## I. INTRODUCTION

On March 15, 2016, Mylan Laboratories Limited (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–5 and 7–30 of U.S. Patent No. 8,927,592 (Ex. 1001, “the ’592 patent”). Paper 3 (“Pet.”). On June 24, 2016, Aventis Pharma S.A. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). We issued our Decision to Institute on September 22, 2016. Paper 9 (“Decision” or “Dec.”).

On October 21, 2016, by email within one month of our Decision, Petitioner renewed its request to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(a). On October 28, 2016, Petitioner filed a Motion to File Supplemental Information pursuant to 37 C.F.R. § 42.123(a), as authorized by the Board. Paper 14, 5–6 (“Motion” or “Mot.”). Petitioner filed the proposed supplemental information as Exhibits 1039 and 1040, for our consideration with the Motion. Mot. 1. Patent Owner filed an Opposition to the Motion. Paper 15 (“Opposition” or “Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 17 (“Mot. Reply”). For the reasons expressed below, Petitioner’s Motion is *granted-in-part* and *denied-in-part*.

## II. ANALYSIS

37 C.F.R. § 42.123(a) concerns supplemental information and states:

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to

submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

Satisfaction of the above-listed requirements for filing the motion, however, does not mean the Board will grant the motion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). Instead, the “guiding principle” for the Board is to “ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.” *Id.* Under this “guiding principle,” the Board has broad discretion in granting or denying motions to submit supplemental information. *Id.*

There is no question that Patent Owner made its request within one month of the date trial was instituted. The relevance of proffered Exhibits 1039 and 1040, however, is disputed. We address each exhibit in turn.

*A. Judge Shipp’s Claim Construction Opinion (Exhibit 1039)*

Exhibit 1039 is an Amended Memorandum Opinion authored by District Court Judge Michael A. Shipp of the District of New Jersey, in which Judge Shipp construes certain limitations in the ’592 patent claims. Ex. 1039 (“Opinion”). Judge Shipp’s Opinion is dated October 7, 2016, approximately two weeks after we issued our Decision on September 22, 2016. *Id.* A portion of Judge Shipp’s Opinion addresses the same issue we addressed in our Decision regarding whether the preamble phrases, “a method for treating a patient” (claim 1) and “a method of increasing the

survival of a patient” (claim 27), are claim limitations or merely statements of intended use. *Compare* Ex. 1039, 8–14 with Dec., 7–10. Although we apply the broadest reasonable interpretation standard to construe claims in unexpired patents undergoing an *inter partes* review, this “does not include giving claims a legally incorrect interpretation.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (quotation omitted). Just as we should consult the patent specification and the patent’s prosecution history when a patent “has been brought back to the agency for a second review” (*id.*), we would be remiss in failing to consider a District Court’s analysis of the same patent claim language, specification, and prosecution history under review. While not binding, such a District Court claim construction analysis is a valuable and relevant resource for consideration during an *inter partes* review proceeding. Patent Owner’s citations to additional Federal Circuit and PTAB decisions are not to the contrary. Opp. 8–9.

We further note Judge Shipp’s Opinion issued approximately two weeks after our Decision. Petitioner’s effort to bring the Opinion to our attention was prompt. Patent Owner will have the opportunity to address the preamble claim construction issue, and our Decision and Judge Shipp’s Opinion regarding that issue, in Patent Owner’s Response. Petitioner may Reply.<sup>1</sup> Under such circumstances, we do not agree with Patent Owner that Petitioner’s reliance on Exhibit 1039 is “improper bolstering.” *Id.* at 10.

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<sup>1</sup> Pursuant to stipulation of the parties, Patent Owner’s Response is currently scheduled to be filed on December 23, 2016, and Petitioner’s Reply on March 14, 2017. Paper 18.

For the reasons given above, Petitioner's motion to file Exhibit 1039 is granted.

*B. Examiner's Final Office Action in Continuation Application (Exhibit 1040)*

The '592 patent, titled "Antitumoral Use of Cabazitaxel," issued January 6, 2015, from an application filed April 26, 2012. Ex. 1001. Exhibit 1040 is a Final Office Action dated June 9, 2016 from the file history of a continuation application based on the application that issued as the '592 patent (the "continuation case"). By definition, the claims in the continuation case are different from the claims issued in the '592 patent. We also note that examination of the claims in the continuation case remains pending and is not yet concluded. Ex. 1040, 43–44.

Petitioner argues for the relevance of the Final Office Action based on Patent Owner's Preliminary Response argument that relied on the Examiner's actions taken during examination of the '592 patent application. Mot. 9–10. In our Decision, we did not accept Patent Owner's contention that because substantially the same arguments made in the Petition were overcome during Examination of the '592 patent application, we should exercise our discretion and deny institution under 35 U.S.C. § 325(d). Dec., 22–23; Prelim. Resp. 52–53. Therefore, the issue raised by Patent Owner in the Preliminary Response in reliance on the Examiner's actions has been decided, and Patent Owner has not requested a rehearing of the issue.

Of greater significance, Patent Owner has filed Petitioner's IPR Petition and the supporting Declaration of Dr. Seth from this proceeding in the continuation case in accordance with its duty of candor and good faith in

dealing with the Office. Opp. 6; *see* 37 C.F.R. § 1.56(a) (“Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office.”). Patent Owner has not submitted its Preliminary Response, Dr. Sartor’s supporting Declaration (Ex. 2001), or other evidence supporting Patent Owner’s contentions in the continuation case. Opp. 6. Petitioner is attempting to use the Examiner’s view of Dr. Seth’s Declaration, based on a partial record in the still-pending continuation case, weighed against the Rule 132 Declaration submitted by Patent Owner’s expert, Dr. Sartor, to Petitioner’s advantage in this trial proceeding. Mot. 10-11. Having considered the matter, we agree with Patent Owner that any relevance the Final Office Action may have in the present *inter partes* review proceeding is diminished because (1) it is not a final determination of the patentability of the claims at issue in the continuation case, which differ from the instituted claims, (2) the Examiner has not received Patent Owner’s arguments or the declaration of Dr. Sartor submitted with Patent Owner’s Preliminary Response, and (3) the Examiner is not the finder of fact in this proceeding. Opp. 5–7. We will not allow Petitioner to use the Examiner’s views in the continuation case as a shadow proceeding to bolster its Petition in the present trial proceeding. Mot. 11–13.

For the reasons given above, Petitioner’s Motion with respect to Exhibit 1040 is *denied*, and Exhibit 1040 will be expunged. Petitioner will have the opportunity to Reply to Patent Owner’s Response and submit new

evidence, such as Ex. 1040, if the evidence is responsive to Patent Owner's arguments and evidence in the Response.<sup>2</sup>

### III. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion is granted with respect to Exhibit 1039, and Exhibit 1039 will be accepted as an exhibit in this proceeding;

FURTHER ORDERED that Petitioner's Motion is denied with respect to Exhibit 1040, and Exhibit 1040 will be expunged from the record.

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<sup>2</sup> Patent Owner's objections to ten exhibits submitted by Petitioner on the basis that the references were previously considered by the Examiner is duly noted. Mot. 10. If Patent Owner files a motion to exclude any of the exhibits, Petitioner will have an opportunity to respond and submit supporting evidence in accordance with the Scheduling Order. Paper 10, 6-8; Opp. 4 n.1.

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<sup>3</sup> In Patent Owner's Mandatory Notices, Patent Owner indicates an intent to file a motion for the *pro hac vice* admission of Messrs. William E. Solander and Jason A. Leonard. Paper 6. Our review of the docket does not indicate that such a motion with supporting declarations has been filed in this proceeding.