

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS, LLC,
Petitioner,

v.

ENDO PHARMACEUTICALS INC.,
Patent Owner.

Case IPR2014-00361
Patent 8,309,122 B2

Before TONI R. SCHEINER, FRANCISCO C. PRATS, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

INTRODUCTION

A telephone conference was held on May 7, 2014, between respective counsel for the parties, and Judges Bonilla, Scheiner, and Prats. Petitioner requested the call to seek authorization to file a reply to Patent Owner’s preliminary response regarding an alleged time-bar under 35 U.S.C. § 315(b). The call addressed Petitioner’s request in this proceeding, as well as a similar request in IPR2014-00360. In this case, in its preliminary response (Paper 7, 1-11), Patent Owner argued, *inter alia*, that Petitioner was barred under § 315(b) from pursuing an *inter partes* review for U.S. Patent No. 8,309,122 B2 (“the ’122 patent”) because Petitioner was served a complaint alleging infringement of the ’122 patent more than one year before filing its petition (Paper 1).

DISCUSSION

During the call, Petitioner argued that Patent Owner’s preliminary response presents factual inaccuracies relevant to the alleged § 315(b) bar. Petitioner requested authorization to file a reply to the preliminary response to address such inaccuracies. Patent Owner opposed Petitioner’s request.

Under the particular circumstances of these cases, we are persuaded that additional briefing is warranted on the issue of whether Petitioner was “served with a complaint” alleging infringement of the ’122 patent more than one year before the petition was filed—i.e., more than one year before January 16, 2014. 35 U.S.C. § 315(b). Specifically, we request that the parties address Patent Owner’s contention that it served Petitioner with a

relevant complaint on November 20, 2012, when Patent Owner served Petitioner an amended complaint (Ex. 2002; Ex. 2003). *See* Paper 7, 8-9.

We authorize Petitioner to file a 5-page reply addressing the § 315(b) bar issue raised in Patent Owner’s preliminary response. We also authorize Patent Owner to file a 5-page sur-reply that responds to points raised in Petitioner’s reply.

The parties are directed to *Motorola Mobility LLC v. Arnouse*, IPR2013-00010, Paper 20 (PTAB Jan. 30, 2013), regarding the meaning of “served” in the context of § 315(b). The parties’ briefs should address how and when Petitioner was served with a relevant complaint in the corresponding district court litigation pursuant to the applicable Federal Rules of Civil Procedure. The parties may submit evidence, but not testimony, with their briefs.

Accordingly, it is hereby

ORDERED that Petitioner is authorized to file, by Thursday, May 15, 2014, a reply limited to five pages, addressing the issue of when Petitioner was “served with a complaint” alleging infringement of the ’122 patent under 35 U.S.C. § 315(b); and

FURTHER ORDERED that Patent Owner is authorized to file, by Thursday, May 22, 2014, a responsive sur-reply limited to five pages.

Case IPR2014-00361
Patent 8,309,122 B2

For PETITIONER:

Eldora L. Ellison
Dennies Varughese
STERN, KESSLER, GOLDSTEIN & FOX P.L.L.C.
ellison-PTAB@skgf.com
dvarughe-PTAB@skgf.com

For PATENT OWNER:

Joseph A. Mahoney
Erick J. Palmer
MAYER BROWN LLP
jmahoney@mayerbrown.com
ejpalmer@mayerbrown.com