

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

GLAXOSMITHKLINE BIOLOGICALS SA,
Patent Owner.

Case IPR2018-01229 (Patent No. 8,753,645)
Case IPR2018-01236 (Patent No. 8,753,645)
Case IPR2018-01234 (Patent No. 9,265,839)
Case IPR2018-01237 (Patent No. 9,265,839)¹

Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5 and 42.123(a)

¹ This Order addresses issues that are common to all four cases. We, therefore, issue a single Order that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the caption.”

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Inter partes reviews in the above-referenced proceedings were instituted on December 18, 2018. Paper 13.² On January 17, 2019, Petitioner requested, via e-mail, authorization to file a motion to submit supplemental information in each of the above-referenced proceedings. That request was discussed during the initial conference call on January 22, 2019. We authorized Petitioner to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123, and Patent Owner to file an opposition to that motion. Paper 16. Petitioner thereafter filed its Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) (“Pet. Mot.,” Paper 17) in each of the above-referenced proceedings, and Patent Owner filed its Opposition to Petitioner’s Motion to Submit Supplemental Information (Paper 19).

DISCUSSION

37 C.F.R. § 42.123(a) 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.

In determining whether to grant a motion to submit supplemental information, we are guided by the principle of ensuring “the efficient

² Paper numbers in this Order refer to papers filed in IPR2018-01229.

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administration of the Office, and the ability of the Office to timely complete [instituted IPR] proceedings.” 35 U.S.C. § 316(b); *see Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (“Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this [§ 316(b)] mandate and alter the intended purpose of IPR proceedings.”).

Petitioner complied with subpart (1) of Section 42.123(a) by making its request within one month of institution.

As to subpart (2) of Section 42.123(a), Petitioner seeks to submit ten documents identified as Exhibits 1063 to 1072. Papers 17, 1–8; 18, 5–6. The alleged relevance of these exhibits is based on filings and/or arguments made by Patent Owner in foreign proceedings, and Patent Owner’s *anticipated* reliance on those arguments in these proceedings. Pet. Mot. 4–7. We find here that, regardless of whether any of the documents sought to be submitted are “relevant to a claim” under 37 C.F.R. § 42.123(a)(2), the submission of those documents based on anticipated arguments arising from foreign proceedings, or to preemptively rebut anticipated arguments, would not comport with our obligation to ensure “the efficient administration of the Office, and the ability of the Office to timely complete [instituted IPR] proceedings.” *See* 35 U.S.C. § 316(b).

Under Board procedures, a petitioner is allowed to submit evidence with its reply to rebut an argument raised in the patent owner response. *See, e.g.*, Office Patent Trial Practice Guide, August 2018 Update, 14, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (“a petitioner may submit directly responsive rebuttal evidence in support of its reply”). Accordingly, Petitioner may submit directly responsive rebuttal evidence in support of its reply, and any

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such rebuttal evidence may (depending on Patent Owner's Response) include one or more of the documents Petitioner now seeks to submit.

For the reasons given, it is hereby:

ORDERED that Petitioner's Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) is DENIED.

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