

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.
Petitioner,

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

IPR2020-00040 (Patent 7,326,708 B2)

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Supplemental Briefing on Discretionary Denial
35 U.S.C. §314(a); 37 C.F.R. § 42.5

The Board, *sua sponte*, requests supplemental briefing from the parties on the subject matter below.

In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”), the Board discussed potential applications of *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”), as well as a number of other cases dealing with discretionary denial under § 314(a). *Fintiv* identifies a non-exclusive list of factors parties may consider addressing, particularly where there is a related, parallel district court action and whether such action provides any basis for discretionary denial under *NHK*. *Fintiv* at 5–16.

Those factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 5–6. We recognize that the parties have addressed, at least indirectly, some of these factors already in their existing briefing. We, nevertheless, invite the parties to address directly in supplemental briefing the *Fintiv* factors listed above.

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Accordingly, it is:

ORDERED that Petitioner and Patent Owner are each authorized to submit a supplemental brief of up to three (3) pages addressing the factors from *Fintiv* set forth above;

FURTHER ORDERED that each party's supplemental brief, if filed, shall be due on April 14, 2020; and

FURTHER ORDERED that the filing of limited additional evidence (only that which is absolutely necessary) to address the *Fintiv* factors is authorized; no other new evidence is permitted.

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For Petitioner:

Jitendra Malik

Alissa M. Pacchioli

Christopher W. West

Heike S. Radeke

KATTEN MUCHIN ROSEMAN LLP

jitty.malik@kattenlaw.com

alissa.pacchioli@kattenlaw.com

christopher.west@katten.com

heike.radeke@katten.com

For Patent Owner:

Stanley E. Fisher

Jessamyn S. Berniker

Shaun P. Mahaffy

Anthony H. Sheh

WILLIAMS & CONNOLLY LLP

sfisher@wc.com

jberniker@wc.com

smahaffy@wc.com

asheh@wc.com