

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES INC.,
Petitioner,

v.

HORIZON PHARMA USA, INC. and NUVO PHARMACEUTICALS
(IRELAND) DESIGNATED ACTIVITY COMPANY,¹
Patent Owners.

Case IPR2018-01341¹
Patent 9,393,208 B2

Before TONI R. SCHEINER, MICHELLE N. ANKENBRAND, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

¹ Pozen Inc. ("Pozen") was initially identified as a patent owner in this proceeding. *See, e.g.*, Paper 1, caption. On October 18, 2018, we suspended all deadlines in this proceeding after Pozen filed a Suggestion of Bankruptcy (Paper 8). Paper 10. On January 4, 2019, the parties submitted in a related proceeding an order from the bankruptcy court approving the sale of certain of Pozen's assets, including U.S. Patent No. 9,393,208 B2 ("the '208 patent"), which lifted the automatic stay of this proceeding. *See* Case IPR2017-01995, Ex. 1051. On January 16, 2019, we received Mandatory Notices identifying Nuvo Pharmaceuticals (Ireland) Designated Activity Company ("Nuvo") as a real party-in-interest in this proceeding. Paper 11. Nuvo also filed an Amended Power of Attorney appointing certain practitioners "to transact all business in the [Office] associated with *inter partes* review of [the '208 patent]." Paper 12, 1. Accordingly, we modify the original case caption to reflect the change in ownership of the '208 patent. The parties shall use the modified caption for filings in this proceeding from this date forward.

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

A conference call in this proceeding, as well as Case IPR2017-01995 and Case IPR2018-00272, was held on January 24, 2019, between respective counsel for the parties and Judges Scheiner, Ankenbrand, and Dennett. The purpose of the conference in relation to this proceeding was to discuss: (1) a date for Horizon Pharma USA Inc. (“Horizon”) and Nuvo (collectively, “Patent Owners”) to file a Preliminary Response to the Petition; and (2) Horizon’s request for authorization to file a motion to terminate this proceeding (and other related proceedings).

Preliminary Response Due Date

As we explained during the conference, we suspended the due date for Patent Owners’ Preliminary Response to the Petition in view of the automatic stay as a result of the bankruptcy proceeding. Because the automatic stay has been lifted, Patent Owners may file a Preliminary Response on or before January 31, 2019.

Motion to Terminate

In advance of the conference, the Board received an email communication from Horizon seeking authorization to file a motion to terminate this proceeding and related proceedings Case IPR2017-01995 and Case IPR2018-00272. Attachment 1 (copy of email). During the conference, Patent Owners represented that Dr. Reddy’s Laboratories Inc. (“Petitioner”) argued in the co-pending district court litigation that the claims of the ’208 patent are invalid as indefinite, and that the district court agreed, granting summary judgment of invalidity. Patent Owners contended that Petitioner should not be permitted to take an opposing position in

this proceeding. Thus, Patent Owners argued that they should be permitted to file a motion to terminate this proceeding.

Petitioner opposed Patent Owners' request, pointing to the Petition and our Decision on Institution in related Case IPR2018-00272, which both applied the asserted prior art to the challenged claims of the '208 patent. Petitioner also pointed out that Patent Owners had not yet stated whether they would appeal the district court's decision and argued that it would be inappropriate to terminate this proceeding if Patent Owners were to appeal the district court's decision because that decision would not be final.

After having considered the parties' arguments, and based upon the facts and circumstances presented, we *grant* Patent Owners' request for authorization to file the motion, subject to the following deadlines and page limits. Patent Owners' may file a motion to terminate, of no more than ten (10) pages, by close of business (5:00 PM ET) on February 8, 2019. Petitioner may file a response to the motion, of no more than ten (10) pages, by close of business (5:00 PM ET) on February 22, 2019.

ORDER

It is

ORDERED that Patent Owners may file a Preliminary Response to the Petition by January 31, 2019;

FURTHER ORDERED that Patent Owners may file a motion to terminate, of no more than ten (10) pages, by close of business (5:00 PM ET) on February 8, 2019; and

FURTHER ORDERED that Petitioner may file a response to the motion to terminate, of no more than ten (10) pages, by close of business (5:00 PM ET) on February 22, 2019.

IPR2018-01341
Patent 9,393,208 B2

For PETITIONER:

Allan Pollack
Louis Weinstein
BUDD LARNER PC
apollack@buddlerner.com
lweinstein@buddlerner.com

For PATENT OWNER:

Thomas A. Blinka, Ph.D.
COOLEY LLP
TBlinka@cooley.com

Margaret J. Sampson, Ph.D.
BAKER BOTTS LLP
Margaret.Sampson@bakerbotts.com