

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELI LILLY AND COMPANY
Petitioner

v.

TEVA PHARMACEUTICALS INTERNATIONAL GMBH
Patent Owner.

Case IPR2018-01422 (Patent No. 9,340,614 B2)
Case IPR2018-01423 (Patent No. 9,266,951 B2)
Case IPR2018-01424 (Patent No. 9,346,881 B2)
Case IPR2018-01425 (Patent No. 9,890,210 B2)
Case IPR2018-01426 (Patent No. 9,890,211 B2)
Case IPR2018-01427 (Patent No. 8,597,649 B2)
Case IPR2018-01710 (Patent No. 8,586,045 B2)
Case IPR2018-01711 (Patent No. 9,884,907 B2)
Case IPR2018-01712 (Patent No. 9,884,908 B2)¹

Before JENNIFER MEYER CHAGNON, JAMES A. WORTH, and
RICHARD J. SMITH, *Administrative Patent Judges*.

Per Curiam

DECISION
Denying Patent Owner's Request on Rehearing
37 C.F.R. § 42.71(d)

¹This Order addresses issues that are common to all nine 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."

IPR2018-01422 (Patent No. 9,340,614 B2)
IPR2018-01423 (Patent No. 9,266,951 B2)
IPR2018-01424 (Patent No. 9,346,881 B2)
IPR2018-01425 (Patent No. 9,890,210 B2)
IPR2018-01426 (Patent No. 9,890,211 B2)
IPR2018-01427 (Patent No. 8,597,649 B2)
IPR2018-01710 (Patent No. 8,586,045 B2)
IPR2018-01711 (Patent No. 9,884,907 B2)
IPR2018-01712 (Patent No. 9,884,908 B2)

I. INTRODUCTION

On November 8, 2019, Patent Owner, Teva Pharmaceuticals International GmbH (“Teva”), emailed the Board to request a conference call to seek authorization to submit supplemental briefing addressing the effects of the Federal Circuit’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) (“*Arthrex*”) on the proceedings, and further requesting a stay of the proceedings to provide time for the requested supplemental briefing. *See* Ex. 2274², 2–3. By return email, we denied Patent Owner’s request for supplemental briefing and a stay, stating “no stay or briefing is required, and the hearings will proceed as scheduled. Any Appointments Clause concerns have been addressed by the Federal Circuit in *Arthrex*.” *Id.* at 1. Subsequently, on November 21, 2019, Patent Owner filed a Request for Rehearing of our decision. *See* Paper 69 (“Req. Reh’g”).³

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing

² For convenience, we refer herein to Papers and Exhibits filed in IPR2018-01422. Substantially the same documents have been filed in each of the captioned proceedings.

³ Patent Owner also requested Precedential Opinion Panel (POP) review of the requests for rehearing. *See* Ex. 3002; Req. Reh’g 3, 15. Patent Owner’s request for POP review has been denied. *See* Paper 77.

IPR2018-01422 (Patent No. 9,340,614 B2)
IPR2018-01423 (Patent No. 9,266,951 B2)
IPR2018-01424 (Patent No. 9,346,881 B2)
IPR2018-01425 (Patent No. 9,890,210 B2)
IPR2018-01426 (Patent No. 9,890,211 B2)
IPR2018-01427 (Patent No. 8,597,649 B2)
IPR2018-01710 (Patent No. 8,586,045 B2)
IPR2018-01711 (Patent No. 9,884,907 B2)
IPR2018-01712 (Patent No. 9,884,908 B2)

“must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.* With this in mind, we address the arguments presented by Patent Owner.

III. ANALYSIS

In its Request for Rehearing, Patent Owner argues that “[i]n denying Teva authorization to file supplemental briefing addressing *Arthrex* and a motion to stay (Ex. 2274 at 1), the panel misapprehended or overlooked the limitations of [the] *Arthrex* remedy and the constitutional issues that remain to be addressed.” Req. Reh’g 5. We disagree that we overlooked Patent Owner’s argument in this regard. Instead, we declined to consider Patent Owner’s constitutional arguments, as the issue has been addressed by the Federal Circuit in *Arthrex*. *See* Ex. 2274, 1. Additional briefing from the parties was not necessary to come to the decision to decline consideration of these constitutional arguments.

Patent Owner further argues that “[t]he panel misapprehended or overlooked that a brief stay until the *Arthrex* mandate issues will conserve agency resources, and will avoid taking further steps in this proceeding while an Appointments Clause violation still exists.” Req. Reh’g 5, 14–15. Regarding Patent Owner’s request for a stay of the proceedings, we disagree that we overlooked Patent Owner’s arguments. Instead, we note that except in cases involving the unique nature of the sovereign immunity right of the

IPR2018-01422 (Patent No. 9,340,614 B2)
IPR2018-01423 (Patent No. 9,266,951 B2)
IPR2018-01424 (Patent No. 9,346,881 B2)
IPR2018-01425 (Patent No. 9,890,210 B2)
IPR2018-01426 (Patent No. 9,890,211 B2)
IPR2018-01427 (Patent No. 8,597,649 B2)
IPR2018-01710 (Patent No. 8,586,045 B2)
IPR2018-01711 (Patent No. 9,884,907 B2)
IPR2018-01712 (Patent No. 9,884,908 B2)

States, *see, e.g., Taiwan Semiconductor Manufacturing Co. v. STC.UNM*, IPR2019-01410, Paper 8 at 2–3 (PTAB Oct. 11, 2019) (cited by Patent Owner at Req. Reh’g 14–15), the Board generally declines to stay proceedings pending an appeal to the Federal Circuit or the Supreme Court. *See, e.g., Askeladden LLC v. Purple Leaf, LLC*, IPR2016-01720, Paper 22 at 2 (PTAB Sept. 11, 2017) (denying authorization to file a motion to stay pending the outcome of an appeal to the Supreme Court).⁴ The present proceedings simply do not fall within the narrow category of cases in which the Board generally entertains a stay pending Federal Circuit review.

Patent Owner also presents several pages of substantive arguments addressing the effects of the Federal Circuit’s decision in *Arthrex*. *See* Req. Reh’g 5–14. As indicated above, we decline to address these constitutional arguments. Further, we could not have misapprehended or overlooked issues not before us in rendering our decision not to authorize supplemental briefing or a stay. *See* 37 C.F.R. § 42.71(d) (indicating that a Request for Rehearing “must specifically identify . . . the place where each matter was previously addressed”).

⁴ The Board also sometimes stays cases involving concurrent bankruptcy proceedings. *See, e.g., Dr. Reddy’s Labs. Inc. v. Pozen Inc.*, IPR2018-01341, Paper 10 (PTAB Oct. 16, 2018) (stay appropriate to allow the bankruptcy court to determine whether the automatic stay under 11 U.S.C. § 362 governing bankruptcy proceedings applies to *inter partes* reviews).

IPR2018-01422 (Patent No. 9,340,614 B2)
IPR2018-01423 (Patent No. 9,266,951 B2)
IPR2018-01424 (Patent No. 9,346,881 B2)
IPR2018-01425 (Patent No. 9,890,210 B2)
IPR2018-01426 (Patent No. 9,890,211 B2)
IPR2018-01427 (Patent No. 8,597,649 B2)
IPR2018-01710 (Patent No. 8,586,045 B2)
IPR2018-01711 (Patent No. 9,884,907 B2)
IPR2018-01712 (Patent No. 9,884,908 B2)

For the foregoing reasons, we are not persuaded that we misapprehended or overlooked Patent Owner's arguments in declining to authorize Patent Owner to submit supplemental briefing addressing the effects of the Federal Circuit's *Arthrex* decision on the proceedings, or in denying Patent Owner's request for a stay. Consequently, Patent Owner's Request for Rehearing is denied in each of the captioned proceedings.

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner's Requests for Rehearing are *denied*.

IPR2018-01422 (Patent No. 9,340,614 B2)
IPR2018-01423 (Patent No. 9,266,951 B2)
IPR2018-01424 (Patent No. 9,346,881 B2)
IPR2018-01425 (Patent No. 9,890,210 B2)
IPR2018-01426 (Patent No. 9,890,211 B2)
IPR2018-01427 (Patent No. 8,597,649 B2)
IPR2018-01710 (Patent No. 8,586,045 B2)
IPR2018-01711 (Patent No. 9,884,907 B2)
IPR2018-01712 (Patent No. 9,884,908 B2)

For PETITIONER:

William B. Raich
Erin M. Sommers
Pier D. DeRoo
Yieyie Yang
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
william.raich@finnegan.com
erin.sommers@finnegan.com
pier.deroo@finnegan.com
yieyie.yang@finnegan.com

Sanjay M. Jivraj
Mark J. Stewart
ELI LILLY AND COMPANY
jivraj_sanjay@lilly.com
stewart_mark@lilly.com

For PATENT OWNER:

Deborah A. Sterling
Robert C. Millonig
Gaby L. Longsworth
Jeremiah B. Frueauf
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
dsterling-ptab@sternekessler.com
bobm-ptab@sternekessler.com
glongs-ptab@sternekessler.com
jfrueauf-ptab@sternekessler.com