

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIPLA LIMITED,
Petitioner,

v.

GILEAD SCIENCES INC.,
Patent Owner.

IPR2025-00033
Patent 11,744,802 B2

Before GRACE K. OBERMANN, SUSAN L. C. MITCHELL, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Granting Request for Additional Briefing
37 C.F.R. § 42.5

Cipla Limited (“Petitioner”) requests leave to file a reply to Patent Owner’s preliminary Response pursuant to 37 C.F.R. § 42.108(c) to address discretionary denial issues raised by Patent Owner. *See* Ex. 3001, 3. Petitioner asserts that its request is based on the rescission of former Director Vidal’s guidance memorandum titled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” after the filing of the Petition. *See id.*; Ex. 1060 (“former Director Vidal’s Memorandum”). Petitioner asserts that it relied on former Director Vidal’s “directive that institution cannot be denied under *Fintiv*¹ if a Petition presents compelling merits or presents a *Sotera*² stipulation.” Ex. 3001, 3.

Petitioner further asserts the following.

Petitioner seeks leave to reply to the POPR to address Patent Owner’s *Fintiv* analysis under the earlier Board precedent of *Apple v. Fintiv* (“*Fintiv*”) and *Sotera v. Masimo* (“*Sotera*”). *See e.g.*, Paper 15 at 14-37 (reliance on *Fintiv*), 25-26 (discussing *Sotera* stipulation). In particular, Petitioner requests a 10-page reply to Section V of the POPR (Paper 15 at 13-38) to respond to Patent Owner’s arguments under *Fintiv* factors 1-6, which includes reliance on its [§] 325(d) denial request (*id.* at 38-48 (Section VI)) as part of its factor 6 analysis (*id.* at 37-38 (Section V.F.3)). Petitioner respectfully submits that it has good cause based on the intervening agency decision to rescind former Director Vidal’s binding guidance.

Ex. 3001, 3.

Gilead Science Inc. (“Patent Owner”) opposes Petitioner’s request questioning why Petitioner waited three weeks after rescission of former Director Vidal’s Memorandum with no explanation for the delay, and why Petitioner did

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020) (“*Fintiv*”).

² *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A.).

not address the *Fintiv* factors in its Petition “especially given the advanced stage of the district court litigation and complete overlap of issues between the two proceedings.” Ex. 3001, 2. If Petitioner’s request for briefing is granted, Patent Owner asserts that five pages should be sufficient and asks for a commensurate sur-reply. *Id.*

Petitioner responds that it does not oppose Patent Owner’s request for a sur-reply and reasserts the need for a 10-page reply. Ex. 3001, 1.

In light of the intervening rescission of former Director Vidal’s Memorandum, we determine that Petitioner has shown good cause for its requested briefing and such briefing may be helpful to the panel in resolving issues for the institution decision. In doing so, we encourage the parties to consider the recent guidance presented by Acting Director Stewart in stating “[p]arties to post-grant proceedings should refer to Patent Trial and Appeal Board (PTAB) precedent for guidance, including [*Fintiv and Sotera*]”³ and guidance presented in Chief Judge Boalick’s Memorandum issued on March 24, 2025 titled “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’”.⁴ Therefore, we authorize such briefing as set forth below in the Order. We do not find that a call is necessary at this time.

³ Acting Director Stewart’s Guidance may be found at the following web page: <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

⁴ Chief Judge Boalick’s Memorandum may be found on the PTAB resources page and is also hyperlinked at the web page set forth in footnote 3.

ORDER

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a reply brief limited to the issues set forth above is *granted*;

FURTHER ORDERED that the Patent Owner is authorized to file a sur-reply to respond to Petitioner's reply;

FURTHER ORDERED that each party will be limited to ten pages for the reply and sur-reply;

FURTHER ORDERED that any reply filed by Petitioner is due by no later than Thursday, Wednesday, April 2, 2025; and

FURTHER ORDERED that any sur-reply filed by Patent Owner to Petitioner's reply is due no later than Wednesday, April 9, 2025.

IPR2025-00033
Patent 11,744,802 B2

For PETITIONER:

Andrew Larsen
MERCHANT & GOULD P.C.
ciplabictegraviripr@merchantgould.com
alarsen@merchantgould.com

PATENT OWNER:

Meg Fasulo
BARTLIT BECK LLP
meg.fasulo@bartlitbeck.com