

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCK SHARP & DOHME CORP.,  
Petitioner,

v.

MAYNE PHARMA INTERNATIONAL PTY LTD.,  
Patent Owner.

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Case IPR2016-01186  
Patent 6,881,745 B2

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Before TONI R. SCHEINER, ERICA A. FRANKLIN, and  
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. §§ 42.5, 42.8*

## I. INTRODUCTION

Merck Sharp & Dohme Corp. (“MSD” or “Petitioner”) filed a Petition requesting an *inter partes* review of certain claims of U.S. Patent No. 6,881,745 B2 (Ex. 1001, “the ’745 patent”). The Petition indicates that “Merck is the real party-in-interest.” Pet. 56. In its Patent Owner Preliminary Response (Paper 8, “Prelim. Resp.”), Mayne Pharma International Pty Ltd. contends that Merck & Co. Inc. (“MCI”), the parent company of Merck Sharpe & Dohme Corp., also should have been named as a real party in interest in the Petition.

## II. ANALYSIS

The Petition indicates that “Merck is the real party-in-interest.” Pet. 56. The Petition further indicates that “Merck has been charged with infringement of the ’745 patent in the parallel litigation *Mayne Pharma International Pty Ltd. v. Merck & Co., Inc.*, Case No. 15-cv-00438 (D. Del.), filed May 29, 2015” (*id.*) and “Petitioner was served with the complaint in that litigation on June 12, 2015” (*id.*). The complete case name of the district court litigation is *Mayne Pharma International Pty Ltd. v. Merck & Co., Inc. and Merck Sharp & Dohme Corp.* Paper 5 (Patent Owner’s Initial Mandatory Notices), 2.

The statute governing *inter partes* proceedings sets forth certain requirements for a petition for *inter partes* review, including that “the petition identif[y] all real parties in interest.” 35 U.S.C. § 312(a); *see also* 37 C.F.R. § 42.8(b)(1) (providing a requirement to identify real parties in interest in mandatory notices). The Board’s precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 5 (PTAB Mar. 4, 2016) (Paper 38), states that “§ 312(a) sets forth

requirements that must be satisfied for the Board to give consideration to a petition, however, a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified.” *See also Elekta, Inc. v. Varian Med. Sys., Inc.*, Case IPR2015-01401, slip op. at 6–10 (PTAB Dec. 31, 2015) (Paper 19) (holding that disclosing additional real parties in interest via an updated disclosure does not mandate a change in petition filing date). In addition, our rules provide that a late action may be excused “upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

The Trial Practice Guide describes the “core functions” of the real party in interest (“RPI”) requirement as follows:

[T]o assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions. The latter, in turn, seeks to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a “second bite at the apple,” and to protect the integrity of both the USPTO and Federal Courts by assuring that all issues are promptly raised and vetted.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012). Absent any indication of an attempt to circumvent estoppel rules, a petitioner’s bad faith, or prejudice to a patent owner caused by the delay, permitting a petitioner to amend a challenged RPI disclosure while maintaining the original filing date promotes the core functions described in the Trial Practice Guide, while also promoting “the just, speedy, and inexpensive resolution of our proceedings.” 37 C.F.R. § 42.1.

Petitioner has agreed to update its Mandatory Notices to add Merck & Co., Inc. as a real party in interest, provided the addition would not change

the Petition’s filing date. *See* Ex. 2063, 15:6–11; Reply 26. We determine that Petitioner may update its Mandatory Notices without a change in the filing date of the Petition. There is no indication of intentional concealment, bad faith on Petitioner’s part, an attempt to circumvent estoppel rules, or any other material benefit to Petitioner in Petitioner’s delay in naming MCI as an RPI. The names “Merck Sharp & Dohme Corp.,” “Merck,” and “Merck & Co., Inc.” all appear in the Petition as originally filed (Pet. 1, 56), reasonably apprising the Board of any potential conflicts. Moreover, Petitioner has provided evidence that “Merck & Co., Inc.,” MSD’s co-defendant in the district court litigation, pledged to “be bound by any estoppel effect flowing from the IPR.” Ex. 1098,<sup>1</sup> 8 n.3. Finally, we perceive no prejudice to Patent Owner—that is, a negative effect on Patent Owner’s ability to challenge the Petition—as a result of the delay. Had MCI, MSD’s co-defendant in the district court litigation, been named as an RPI originally, Patent Owner would have been in the same position it is now.

We determine that permitting Petitioner to update its mandatory notices to include MSD’s parent company, Merck & Co., Inc., as a real party in interest in this matter—without affecting the Petition’s filing date—promotes the core functions described in the Trial Practice Guide with respect to RPIs, and serves the interests of justice.

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<sup>1</sup> Exhibit 1098 is the “Defendant’s Brief in Support of Their Motion to Stay Proceedings Pending an *Inter Partes* Review . . . of U.S. Patent No. 6,881,745,” dated and served January 19, 2017.

### III. ORDER

Accordingly, it is

ORDERED that, within three (3) business days, Petitioner amend its mandatory notices to name Merck & Co., Inc. as a real party in interest in IPR2016-01186; and

FURTHER ORDERED that the filing date accorded to IPR2016-01186 is not changed based on Merck Sharp & Dohme Corp.'s adding Merck & Co., Inc. as a real party in interest.

IPR2016-01186  
Patent 6,881,745 B2

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