

Filed On Behalf Of:

Novartis AG and LTS Lohmann Therapie-Systeme AG

By:

Raymond R. Mandra
ExelonPatchIPR@fchs.com
(212) 218-2100

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**NOVEN PHARMACEUTICALS INC.
AND MYLAN PHARMACEUTICALS INC.,**
Petitioners

v.

NOVARTIS AG AND LTS LOHMANN THERAPIE-SYSTEME AG,
Patent Owners

Inter Partes Review No. 2014-00549¹ (U.S. Patent No. 6,316,023)
Inter Partes Review No. 2014-00550² (U.S. Patent No. 6,335,031)³

**PATENT OWNERS' OBJECTIONS TO
PETITIONERS' DEMONSTRATIVE EXHIBITS**

¹ Case IPR2015-00265 has been joined with this proceeding.

² Case IPR2015-00268 has been joined with this proceeding.

³ Patent Owners attest that the word-for-word identical paper is filed in each proceeding identified in the heading.

As authorized by the Board’s Order for a Consolidated Oral Hearing (Paper 56) and pursuant to 37 C.F.R. § 42.70(a), Patent Owners object to Petitioners’ demonstrative exhibits on the grounds set forth below.

In the Order for a Consolidated Oral Hearing (Paper 56), the Board directed the parties to “*St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB January 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits.” *St. Jude Medical* states that “[a]rguments that have not been made previously cannot be made at the trial hearing, and thus, cannot be in a demonstrative exhibit.” *St. Jude Med.*, IPR2013-00041, Paper 65 at 3; *see also* 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“No new evidence or arguments may be presented at the oral argument.”).⁴ Demonstrative exhibits further cannot “rely on evidence that, although it is in the record, was never specifically discussed in any paper before

⁴ The Office Patent Trial Practice Guide further states that a response to observations on cross-examination “is not an opportunity to raise new issues.” 77 Fed. Reg. at 48,768. Thus, to the extent Petitioners have raised new issues in response to Patent Owners’ observations on cross-examination not raised in the Petition for *Inter Partes* Review (Paper 1) (“Petition”) or Petitioner’s Reply (Paper 31) (“Reply”), Petitioners should not be permitted to raise those issues at the oral argument.

the Board.” *St. Jude Med.*, IPR2013-00041, Paper 65 at 2-3. Demonstrative exhibits thus should identify “how [] arguments were previously presented to the Board.” *Id.* at 4. Because as set forth below, Petitioners’ demonstrative exhibit slides 7, 8, 13, 17, 19, 28, 30, 32, 34-36, 39, 40, 43, 44, 46, 47, 53 and 55 fail to comply with these rules, the Board should exercise its discretion not to allow presentation of such demonstrative exhibits. *See CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 118 at 5 (PTAB Oct. 23, 2013) (“In light of the number of the non-compliant slides involved, and the inefficiencies of sorting through all of the slides, one by one, the Board exercised discretion to not allow presentation of any [slides].”).

I. Petitioners’ Demonstrative Exhibits Improperly Include New Evidence And New Arguments

Slide 7: Petitioners improperly cite Ex. 1011 ¶ 11 and Ex. 1031 ¶¶ 13-14 not previously cited or discussed in the Petition or Reply as support for Slide 7 and thus Slide 7 improperly raises new evidence.

Slide 8: Petitioners improperly cite Ex. 1032 ¶¶ 37-40 and 60-64 not previously cited or discussed in the Petition or Reply as support for Slide 8 and improperly raise a new argument based on Ebert in the third bullet not previously made in the Petition or Reply and thus Slide 8 improperly raises new evidence and new argument.

Slide 13: Petitioners improperly reproduce an excerpt from Ex. 1038, an exhibit not previously cited or discussed in the Petition or Reply, and improperly cite Ex. 1031 ¶ 14 and Ex. 1038 at 6 as support for Slide 13 and thus Slide 13 improperly raises new evidence and new argument.

Slide 17: Petitioners improperly cite Ex. 1011 ¶ 47 not previously cited or discussed in the Petition or Reply as support for Slide 17 and thus Slide 17 improperly raises new evidence.

Slide 19: Petitioners improperly cite Ex. 1032 ¶ 21 not previously cited or discussed in the Petition or Reply as support for Slide 19 and thus Slide 19 improperly raises new evidence.

Slide 28: Petitioners improperly raise a new argument in the third bullet not previously made in the Petition or Reply that a POSA's "reasonable expectation is confirmed by structurally similar compounds" because in their papers, Petitioners previously have only relied on one compound, nicotine, that is allegedly structurally similar to rivastigmine.

Slide 30: Petitioners improperly cite Ex. 1010 ¶¶ 33-35 not previously cited or discussed in the Petition or Reply as support for Slide 30 and thus Slide 30 improperly raises new evidence.

Slide 32: Petitioners improperly cite Ex. 1025 at 180:13-183:6 and Ex. 1026 at 513:1-516:14 not previously cited or discussed in the Petition or Reply as support for Slide 32 and thus Slide 32 improperly raises new evidence.

Slide 34: Petitioners improperly cite Ex. 1031 ¶ 40 not previously cited or discussed in the Petition or Reply as support for Slide 34 and thus Slide 34 improperly raises new evidence.

Slide 35: Petitioners improperly raise a new argument in the fifth bullet of Slide 35 not previously made in the Petition or Reply.

Slide 36: Petitioners improperly cite Ex. 1031 ¶¶ 40 and 50-53 not previously cited or discussed in the Petition or Reply as support for Slide 36 and improperly raise new arguments in the first and third bullets not previously made in the Petition or Reply and thus Slide 36 improperly raises new evidence and new argument.

Slide 39: Petitioners improperly reproduce an excerpt from Ex. 2046, an exhibit not previously cited or discussed in the Petition or Reply, in Slide 39, and thus Slide 39 improperly raises new evidence and any argument Petitioners intend to make concerning Ex. 2046 improperly raises a new argument.

Slide 40: Petitioners improperly cite Ex. 2046, an exhibit not previously cited or discussed in the Petition or Reply, in Slide 40, and thus Slide 40

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.