
From: Trials <Trials@USPTO.GOV>
Sent: Friday, March 18, 2016 3:50 PM
To: Frank Calvosa
Cc: Frese, Bradford C.; Nick Cerrito; Eric Stops; Evangeline Shih; John V. Biernacki; 'Matt Ruedy'; 'Steve Maddox'; pgallagher@duanemorris.com; Garellek, Jordana; Carlan, Janine; Berman, Richard; Lyndsey Przybylski
Subject: RE: IPR2015-00545, -00546, -00547, -00548, -00551, and -00554

Counsel:

The Board authorizes Petitioners to file a Motion pursuant to 37 CFR Section 42.5(c)(3), to excuse Petitioners' late filing of objections under 37 CFR Section 42.64(b)(1), by next Friday March 25th. Petitioners' motion must make a showing of good cause to support their request and explain why "consideration on the merits would be in the interests of justice." Petitioners' motion and Patent Owner's opposition are each limited to 7 pages, and a reply is not authorized at this time. Patent Owner's opposition will be due one week after Petitioners' motion is filed.

Petitioners should file their proposed Motion to Exclude today in accordance with the Scheduling Order, pending a decision on the motion outlined above.

Sincerely,

Eric Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Frank Calvosa [mailto:FrankCalvosa@quinnemanuel.com]
Sent: Thursday, March 17, 2016 1:54 PM
To: Trials <Trials@USPTO.GOV>
Cc: Frese, Bradford C. <Bradford.Frese@arentfox.com>; Nick Cerrito <NickCerrito@quinnemanuel.com>; Eric Stops <EricStops@quinnemanuel.com>; Evangeline Shih <EvangelineShih@quinnemanuel.com>; John V. Biernacki <jvbiernacki@jonesday.com>; 'Matt Ruedy' <MRuedy@meiplaw.com>; 'Steve Maddox' <smaddox@meiplaw.com>; pgallagher@duanemorris.com; Garellek, Jordana <JGarellek@duanemorris.com>; janine.carlan@arentfox.com; richard.berman@arentfox.com; Lyndsey Przybylski <lyndseyprzybylski@quinnemanuel.com>
Subject: RE: IPR2015-00545, -00546, -00547, -00548, -00551, and -00554

Dear PTAB,

I write on behalf of Patent Owner ("Jazz") in response to Petitioners' email. Under 37 C.F.R. 42.64(b)(1), Petitioners should have filed their objections in November 2015. Petitioners do not dispute that they failed to do so. Instead, they argue only that Jazz would not be prejudiced by Petitioners' late filing. As an initial matter, prejudice is irrelevant under the rule. See *Nintendo of Am. v. Motion Games LLC*, IPR2014-00164, Paper 51 at 26-27 (finding Patent Owner's untimely objections waived and refusing to allow an exception based on Patent Owner's argument that Petitioner suffered no prejudice). Moreover, as discussed below, Petitioners are incorrect - Jazz would be substantially prejudiced.

Petitioners fail to inform the Board that Jazz timely emailed Petitioners ten business days after they served their objections and put Petitioners on notice that their objections were waived. Specifically, Jazz stated that it “reserves the right to argue that Petitioners have waived their objections” just in case this exact scenario arose. (See attached email.) Despite Jazz’s email, Petitioners waited another four months—from November 2015 until March 2016—to seek to correct their error. In planning their case, Jazz relied upon Petitioner’s failure to timely file their objections or to even timely attempt to cure their failure after Jazz put Petitioners on notice. Specifically, Jazz would have served additional supplemental evidence had Petitioners timely filed their objections. For example, Petitioners objected to several third-party depositions and declarations. Had Jazz thought that the rules would not be enforced, and that Petitioners would be able to belatedly file their objections, it would have sought to correct any alleged deficiencies in that evidence by seeking the Board’s authorization for subpoenas. Jazz also would have sought to serve other supplemental evidence in response to other of Petitioners’ objections. But Jazz relied on the rules and Petitioners’ failure to comply with them. If Petitioners are allowed to circumvent the rules now, Jazz will be severely prejudiced.

Additionally, yesterday afternoon, Jazz contacted counsel for Petitioners, Bradford Frese, to determine what specific objections Petitioners sought to rely upon in a motion to exclude. The reason for Jazz’s request was to more specifically explain the prejudice to Jazz to the PTAB or otherwise potentially resolve this issue. Mr. Frese refused to provide any information in response to Jazz’s inquiry.

Notably, Petitioners’ present request supports Jazz’s substantive arguments in these IPRs. Petitioners appear to be arguing that they were not aware of the change to 37 C.F.R. 42.64(b)(1) that required filing of objections. But that rule change was published in the Federal Register. See 80 Fed. Reg. 28561, 28563 (May 15, 2015). While lack of knowledge of the rule does not excuse Petitioners’ failure to timely file their objections, it does show that persons of skill in the art, even specifically interested persons—here Petitioners’ counsel in the IPRs—do not read the Federal Register for information regarding IPRs. This is the exact substantive point that Jazz made in its briefing. Specifically, a POSA in the above-referenced IPRs would not read the Federal Register and would not have been aware of the advisory committee materials. Petitioners’ actions speak louder than words.

Accordingly, Jazz respectfully requests that the Board deny Petitioners’ request.

Best Regards,

Frank Calvosa

Associate

Quinn Emanuel Urquhart & Sullivan, LLP

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From: Trials [<mailto:Trials@USPTO.GOV>]

Sent: Wednesday, March 16, 2016 2:40 PM

To: Frese, Bradford C.

Cc: Nick Cerrito; Eric Stops; Evangeline Shih; John V. Biernacki; 'Matt Ruedy'; 'Steve Maddox'; Gallagher, Patrick; Garellek, Jordana; Carlan, Janine; Berman, Richard

6/11/15 09:55 AM 09/15/15 09:56 AM 09/17/15 09:57 AM 09/18/15 09:58 AM 09/19/15 09:59 AM

Counsel,

The Board requests that Patent Owner send a brief email responding to Petitioner's comments no later than 3 p.m. tomorrow, Thursday March 17th.

Sincerely,

Eric Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Frese, Bradford C. [<mailto:Bradford.Frese@arentfox.com>]

Sent: Wednesday, March 16, 2016 1:30 PM

To: Trials <Trials@USPTO.GOV>

Cc: Nick Cerrito <NickCerrito@quinnemanuel.com>; Eric Stops <EricStops@quinnemanuel.com>; Evangeline Shih <EvangelineShih@quinnemanuel.com>; John V. Biernacki <jybiernacki@jonesday.com>; 'Matt Ruedy' <MRuedy@meiplaw.com>; 'Steve Maddox' <smaddox@meiplaw.com>; Gallagher, Patrick <PCGallagher@duanemorris.com>; Garellek, Jordana <JGarellek@duanemorris.com>; Carlan, Janine <Janine.Carlan@arentfox.com>; Berman, Richard <Richard.Berman@arentfox.com>

Subject: IPR2015-00545, -00546, -00547, -00548, -00551, and -00554

Dear PTAB:

Petitioners recently discovered that although Petitioners' objections were timely served on Patent Owner, in error, Petitioners did not *file* the objections to evidence Patent Owner Jazz Pharmaceuticals, Inc. submitted in connection with their Patent Owner Response. Petitioners now respectfully request the Board allow Petitioners to file the objections in order to make them of record in the proceeding.

On November 13, 2015—within five business days of Jazz filing its Patent Owner Response—Petitioners served Jazz with objections to evidence Jazz filed with its patent owner response. Jazz served supplemental evidence on November 30, 2015, to which Petitioners served objections on December 4, 2015. Though Petitioners' evidence objections were timely *served* in compliance with the prior rule 37 C.F.R. §42.64(b), they were not filed with the Board at that time, in compliance with the new rule 37 C.F.R. §42.64(b). Petitioners discovered their error in connection with preparing a motion to exclude (due this **Friday, March 18**), which is why Petitioners seek to make the objections of record now.

Patent Owner Jazz objects to this Request (shown in the e-mail below), on the sole grounds that filing now would be untimely. But Jazz was not, and cannot, be prejudiced by the late filing of the objections. First and foremost, the lack of filing was solely in error and without deceptive intent, as evidenced by the fact that the objections were served on Jazz in a timely fashion, and that Jazz availed itself of the opportunity to serve supplemental evidence in response to Petitioners' objections. Second, Petitioners are merely seeking to file the same objections it served on Jazz, and not new or amended objections of which Jazz was not on notice under a prior iteration of the rule. Third, Jazz has not identified how it would be prejudiced by making those objections of record before the Board now. Fourth, Jazz has raised no issues with the Board since November to which Petitioners' evidence objections, or Jazz's supplemental evidence, are pertinent, meaning that there has been no need for the Board to consider Petitioners' evidence objections.

As such, Petitioners respectfully request that they be able to correct their error by filing their objections in the record now.

Best regards,

Bradford Frese

Bradford C. Frese
Associate

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From: Frank Calvosa [<mailto:FrankCalvosa@quinnemanuel.com>]
Sent: Wednesday, March 16, 2016 11:23 AM
To: Frese, Bradford C. <Bradford.Frese@arentfox.com>; Nick Cerrito <NickCerrito@quinnemanuel.com>; Eric Stops <EricStops@quinnemanuel.com>; Evangeline Shih <EvangelineShih@quinnemanuel.com>; John V. Biernacki <jvbiernacki@jonesday.com>
Cc: 'Matt Ruedy' <MRuedy@meiplaw.com>; 'Steve Maddox' <smaddox@meiplaw.com>; Gallagher, Patrick <PCGallagher@duanemorris.com>; Garellek, Jordana <JGarellek@duanemorris.com>; XYREM <XYREM@arentfox.com>
Subject: RE: IPR2015-00545, -00546, -00547, -00548, -00551, and -00554

Bradford,

Petitioners failed to comply with 37 C.F.R. § 42.64(b)(1) when they did not timely file their objections on November 13, 2015 to the evidence submitted in the Patent Owner Responses. As such, Jazz objects to Petitioners' attempt to do so now, more than four months after the fact.

To the extent that Petitioners email the Board to seek leave to file their belated objections, please include this email opposing that request.

Regards,

Frank Calvosa
Associate
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From: Frese, Bradford C. [<mailto:Bradford.Frese@arentfox.com>]
Sent: Tuesday, March 15, 2016 8:54 AM
To: Nick Cerrito <NickCerrito@quinnemanuel.com>; Eric Stops <EricStops@quinnemanuel.com>; Evangeline Shih <EvangelineShih@quinnemanuel.com>; Frank Calvosa <FrankCalvosa@quinnemanuel.com>; John V. Biernacki <jvbiernacki@jonesday.com>
Cc: 'Matt Ruedy' <MRuedy@meiplaw.com>; 'Steve Maddox' <smaddox@meiplaw.com>; Gallagher, Patrick <PCGallagher@duanemorris.com>; Garellek, Jordana <JGarellek@duanemorris.com>; XYREM <XYREM@arentfox.com>
Subject: IPR2015-00545, -00546, -00547, -00548, -00551, and -00554

Counsel:

I write in regard to the Petitioners' evidence objections that were served on Jazz on November 13, 2015. Though these objections were served, they were not filed with the Board at that time.

Petitioners wish to rely on these objections in support of a motion to exclude. Please let us know, by no later than noon tomorrow, whether Jazz will object to Petitioners seeking leave to file these evidence objections before the Board and have them considered in connection with a motion to exclude.

Best regards,
Bradford

Bradford C. Frese
Associate

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