

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC,
PAR PHARMACEUTICAL, INC., and WOCKHARDT BIO AG
Petitioners,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00547¹
Patent 7,765,107

**PETITIONERS PAR PHARMACEUTICAL, INC.'S AND AMNEAL
PHARMACEUTICALS LLC'S MOTION TO ALLOW LATE FILING OF
EVIDENCE OBJECTIONS UNDER 37 C.F.R. § 42.5(c)**

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¹ Case IPR2015-01820 has been joined with this proceeding.

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I. INTRODUCTION

Petitioners Par Pharmaceutical, Inc. and Amneal Pharmaceuticals LLC (collectively, “Petitioners”) respectfully request the Board consider their Motion to Exclude (Paper No. 56), despite the fact that Petitioners filed their evidence objections more than five business days after certain exhibits were filed in the Patent Owner Response (Paper No. 46).

II. STATEMENT OF FACTS

Patent Owner Jazz Pharmaceuticals, Inc. (“Jazz”) filed its Patent Owner Response to the Petition on November 6, 2015. On November 13, 2015, Petitioners timely served—but inadvertently did not file—their objections to the evidence Jazz submitted in connection with its Response. *See* Paper No. 55, Certificate of Service. Jazz thereafter served Petitioners with supplemental evidence under 37 C.F.R. § 42.64(b)(2) on November 30, 2015, via e-mail. *See* Ex. 1059. Importantly for this Motion, by rule the supplemental evidence must be responsive to the objections, thus indicating that Jazz had actual notice of Petitioners’ objections here. *See* 37 C.F.R. § 42.64(b)(2).

In preparing their Motion to Exclude, Petitioners discovered that 37 C.F.R. § 42.64(b)(1) had been changed in May of 2015 to require filing of evidence objections, rather than mere service of the objections on the opposing party as required under the previous version of the rule. Upon discovering their error,

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Petitioners e-mailed Jazz’s counsel, requesting that Jazz not object to Petitioners filing their previously-served evidentiary objections. Ex. 1060 at 5. Jazz refused on the sole grounds that the request was untimely. *See id.* at 4. Petitioners then sent an e-mail to the Board requesting they be permitted to file their objections late. *See id.* at 3. After requesting and receiving comment from Jazz’s counsel, the Board permitted Petitioners to file their Motion to Exclude and the instant Motion. *See id.* at 1, 3.

III. ARGUMENT

Under 37 C.F.R. § 42.5(c), “a late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” Here, good cause exists for the late action because it does not harm Jazz or the Board, and allowing the late action is in the interests of justice because it promotes resolution of the objected-to evidence on the merits, rather than on procedural grounds.

A. Good cause exists to allow Petitioners to file their evidence objections.

Petitioners do not deny that their evidence objections should have been filed within five business days of Jazz’s Patent Owner Response. Petitioners’ error, however, was simply complying with an outdated version of 37 C.F.R. § 42.64(b)(1), rather than the revised version that was promulgated in May of 2015, after the filing of the Petition. Petitioners’ failure to file the evidentiary objections

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that were served on Patent Owner was not done with deceptive intent or to delay the proceedings, and good cause exists to consider Petitioners' Motion to Exclude, despite the late filing of the objections.

The purpose of filing evidence objections, rather than solely serving them, is to make them of record in the proceeding. *See* 80 Fed. Reg. 28563 (“The Office Patent Trial Practice Guide states that a motion to exclude evidence requires a party to identify where in the record the objection originally was made, but 37 C.F.R. § 42.64 (b)(1) merely requires service, which does not make such objections of record.”). The Board, recognizing this purpose, has allowed parties who timely served their evidence objections under the prior rule to file them with a motion to exclude after promulgation of the new rule. *See* Final Decision at 3, n.5, *TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, No. IPR2014-01348, 2016 WL 212791 (P.T.A.B. Jan. 15, 2016).

Good cause also exists to extend a deadline where delay is due to an attorney error and the extension causes no prejudice. *See Bronner v. Unum Life Ins. Co. of Am.*, No. C 03-05742 JF (RS), 2008 WL 4951031, at *2 (N.D. Cal. Nov. 18, 2008). Despite not being filed with the Board, Petitioners' objections were otherwise properly served on Patent Owner. In response to Petitioners' properly served objections, Jazz served four new exhibits (Exhibits 2058–2061) as supplemental evidence. Because the parties otherwise followed the rules and procedures set forth

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