

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOPHARMA LICENSING, INC., INNOPHARMA LICENSING LLC,
INNOPHARMA INC., INNOPHARMA LLC,
MYLAN PHARMACEUTICALS INC., and MYLAN INC.,
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD., BAUSCH & LOMB, INC., and
BAUSCH & LOMB PHARMA HOLDINGS CORP.,
Patent Owner.

Case IPR2015-00902 (Patent 8,669,290 B2)
Case IPR2015-00903 (Patent 8,129,431 B2)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Expunging Exhibit 2277 Filed Without Authorization
37 C.F.R. § 42.5(a)

¹ IPR2015-01871 has been joined with IPR2015-00903. This Order addresses issues common to both cases identified in the caption.

IPR2015-00902 (Patent 8,669,290 B2)

IPR2015-00903 (Patent 8,129,431 B2)

On April 13, 2016, Patent Owner filed Updated Mandatory Notices (“Notices”) pursuant to 37 C.F.R. § 42.8(b)(2). Paper 79.² One purpose of the Notices, according to Patent Owner, is to update the Board on the status of co-pending district court litigation related to the instant *inter partes* reviews. Paper 79, 2. Specifically, Patent Owner states in the Notices that a bench trial was held in a related district court action on April 4, 2016. *Id.* With the Notices, Patent Owner filed Exhibit 2277, which consists of a 1319-page trial transcript of the related district court proceeding. *Id.* (“the trial transcript is combined as filed as Exhibit 2277”).

Petitioner sent an email to the Board on April 14, 2016, objecting to Patent Owner’s filing of Exhibit 2277. Ex. 3001. That email goes beyond identifying the issue at hand, by improperly including factual and legal argument—in essence, an unauthorized brief on the issue. *Id.* **The parties are not authorized to submit email communications to the Board that contain factual or legal arguments.** Email communications with the Board shall be limited to identifying the issue at hand, without argument, and requesting a conference call with the panel or other relief.

Exhibit 2277 is a 1319-page transcript of the entire trial transcript from related district court litigation. Patent Owner directs us to no authority, in our rules or governing statute, which permits the filing of Exhibit 2277 without Board preapproval. *Id.* at 2–3. Patent Owner filed Exhibit 2277 without requesting and receiving Board authorization to do so.

² Substantially identical papers were filed in both proceedings. For convenience, we refer to the paper filed in IPR2014-00902. The exhibit as issue (Exhibit 2277) bears the same number in both proceedings.

IPR2015-00902 (Patent 8,669,290 B2)

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Although our rules contemplate a motion for late submissions of supplemental information, “more than one month after the date the trial is instituted,” a party contemplating such a motion “must request authorization to file a motion to submit the information.” 37 C.F.R. § 42.123(b). The rule relating to updated mandatory notices is not an alternative vehicle by which a party may introduce supplemental information into the record. 37 C.F.R. § 42.8.

Accordingly, Exhibit 2277 shall be expunged from the record of these proceedings.

It is

ORDERED that Exhibit 2277 shall be expunged from the record in IPR2015-00902;

FURTHER ORDERED that Exhibit 2277 shall be expunged from the record in IPR2015-00903; and

FURTHER ORDERED that the parties shall refrain from submitting email communications to the Board that contain factual or legal arguments.

IPR2015-00902 (Patent 8,669,290 B2)
IPR2015-00903 (Patent 8,129,431 B2)

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