
From: Vignone, Maria <Maria.Vignone@USPTO.GOV> on behalf of Trials <Trials@USPTO.GOV>
Sent: Monday, March 21, 2016 3:52 PM
To: Malik, Jitty; Trials
Cc: Diner, Bryan; Hasford, Justin; Skelton, Bryan; Abe, James; Janusz, Joe; dyellin@crowell.com; jlindsay@crowell.com; slentz@crowell.com; Ferrill, Elizabeth; Fujiwara, Chiaki; Lebeis, Jessica; Mukerjee, Deepto; Goldberg, Joshua; Rapalino, Emily L. (ERapalino@goodwinprocter.com)
Subject: RE: IPR2015-00902 and -00903 (Request for Sur-Reply)

Counsel: The Board will determine whether, under 37 C.F.R. § 42.23(b), Petitioner's Reply briefs, and related evidence, are outside the scope of a proper reply and evidence, when the panel reviews the record and prepares any final written decision in connection with these proceedings. If there are improper arguments or evidence, or both, presented with the Reply briefs, the panel may exclude such argument and related evidence. Patent Owner's request to file a sur-reply in each proceeding to address allegedly new arguments presented in the Reply briefs is *denied*.

Further, to the extent that either party wishes to request an oral hearing (currently set, if requested, for April 19, 2016 (Due Date 7)), **such request must be filed within five (5) business days of this email.**

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
703-756-1288

From: Malik, Jitty [mailto:Jitty.Malik@alston.com]
Sent: Monday, March 21, 2016 11:20 AM
To: Trials <Trials@USPTO.GOV>
Cc: Diner, Bryan <bryan.diner@finnegan.com>; Hasford, Justin <Justin.Hasford@finnegan.com>; Skelton, Bryan <Bryan.Skelton@alston.com>; Abe, James <James.Abe@alston.com>; Janusz, Joe <Joe.Janusz@alston.com>; dyellin@crowell.com; jlindsay@crowell.com; slentz@crowell.com; Ferrill, Elizabeth <Elizabeth.Ferrill@finnegan.com>; Fujiwara, Chiaki <Chiaki.Fujiwara@finnegan.com>; Lebeis, Jessica <Jessica.Lebeis@finnegan.com>; Mukerjee, Deepto <Deepto.Mukerjee@alston.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Rapalino, Emily L. (ERapalino@goodwinprocter.com) <ERapalino@goodwinprocter.com>
Subject: RE: IPR2015-00902 and -00903 (Request for Sur-Reply)

Dear PTAB,

Petitioner does not agree with Patent Owner's characterizations that the arguments were outside the scope of Patent's Owner's Response. Rather Petitioner's expert, Dr. Laskar (who was Petitioner's original declarant when Petitioner filed its petition) was responding directly to certain arguments made by Patent Owner in its Response and by its experts. That being said, Petitioner InnoPharma (along with joined Petitioner Lupin) are available for a conference call to discuss this matter tomorrow afternoon.

Regards,

Petitioner InnoPharma EX 1154
IPR2015-00902
IPR2015-00903
Page 1Page 2

Jitty Malik
Lead Counsel for Petitioner.

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From: Goldberg, Joshua [<mailto:Joshua.Goldberg@finnegan.com>]

Sent: Monday, March 21, 2016 11:07 AM

To: trials@uspto.gov

Cc: Diner, Bryan; Hasford, Justin; Malik, Jitty; Skelton, Bryan; Abe, James; Janusz, Joe; dyellin@crowell.com; jlindsay@crowell.com; slentz@crowell.com; Ferrill, Elizabeth; Fujiwara, Chiaki; Lebeis, Jessica

Subject: IPR2015-00902 and -00903 (Request for Sur-Reply)

Dear PTAB,

Petitioner included new exhibits, including a new declaration, raising arguments outside the scope of the Petition and Patent's Owner's Response with each of its replies filed on March 18, 2016. To protect Patent Owner's rights, as recently recognized by the Federal Circuit in *Dell v. Accelleron*, Patent Owner requests a sur-reply in each proceeding to address the new arguments in the replies that are based on these exhibits. Petitioner opposes this request. Petitioner and Patent Owner are available for a conference call to discuss this matter tomorrow afternoon.

Best regards,

Joshua L. Goldberg

Reg. No. 59,369

Backup Counsel for Patent Owner

Joshua L. Goldberg

Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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