

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS II LLC
Petitioner

v.

NPS PHARMACEUTICALS, INC.
Patent Owner

Case IPR2015-01093
Patent 7,056,886

**PATENT OWNER'S MOTION TO DEEM THE FILING OF PATENT
OWNER'S EXHIBITS 2042-2055, 2057-2074, & 2076-2149 AS TIMELY**

I. Statement of Precise Relief Requested

Patent Owner NPS Pharmaceuticals, Inc. (“NPS”) requests the Board to deem the filing of Exhibits 2042-2055, 2057-2074, & 2076-2149 (“the Public Exhibits”) filed in support of Patent Owner’s Response (Paper 31) as timely.¹ Petitioner has advised that it does not oppose this motion.

II. Statement of Material Facts

1. Matthew Hu, NPS counsel’s paralegal, began filing NPS’s Response and Ex. 2040-2149 on January 20, 2016, at about 11:30 p.m.. Ex. 2161, ¶ 2.

2. Realizing that the filing would not be completed prior to the 12:00 a.m. deadline, NPS’s counsel instructed Mr. Hu to proceed first with filing, in IPR2015-00990, (1) the Response, (2) supporting expert declarations (Ex. 2040, 2041 (unredacted) and Ex. 2148, 2149 (redacted)), (3) confidential material filed under seal (Ex. 2056, 2075), (4) Patent Owner’s Combined Motion to File Under Seal and for Entry of Protective Order, and (5) the Protective Order (Ex. 2050²) so

¹ Patent Owner is filing a similar motion in related proceeding IPR2015-00990. In this case, IPR2015-01093, the Public Exhibits include redacted expert declarations Ex. 2148-49, which were timely filed in IPR2015-00990.

² Patent Owner has since realized that the Protective Order was inadvertently labeled and filed as Ex. 2050, but it was referenced in the Motion as Ex. 2150.

Patent Owner, therefore, requests that the Board renumber Ex. 2050 as Ex. 2150.

that all non-public documents were timely filed. *Id.* at ¶ 3-4.

3. Mr. Hu completed filing the documents in ¶ 2 prior to 12:00 a.m. on January 21, 2016. *Id.* at ¶ 5; Ex. 2152; Ex. 2153; Ex. 2154.

4. NPS's counsel then instructed Mr. Hu to file the corresponding documents in IPR2015-01093 to ensure timely filing there. Ex. 2161, ¶ 6.

5. Mr. Hu completed the filing of these documents prior to 12:00 a.m. on January 21, 2016, with the exception that the redacted declarations in IPR2015-01093 were filed at 12:02 a.m. *Id.* at ¶ 7; Ex. 2155; Ex. 2156; Ex. 2157.

6. Once the documents described above in ¶ 2 & 4 were filed, NPS's counsel then instructed Mr. Hu to file the Public Exhibits in both IPRs. *Id.* at ¶ 8.

7. Mr. Hu completed the filing of the Public Exhibits in IPR2015-00990, which took more than two hours and required separating certain exhibits into multiple parts due to size constraints at the Board's site, at 2:25 a.m. on January 21, 2016. *Id.* at ¶ 9-10.; Ex. 2159.

8. Mr. Hu completed the filing of the Public Exhibits in IPR2015-01093 at approximately 3:50 a.m. on January 21, 2016; *Id.* at ¶ 12; Ex. 2158.

9. Patent Owner has indicated it does not oppose the requested relief.

III. Statement of Reasons for Relief Requested

NPS began filing its Response, Motion, and associated exhibits prior to the filing deadline. Further, NPS timely filed its Response, Motion, and all non-

publicly available exhibits. Unfortunately, the filing of the Public Exhibits was not completed for approximately two and half hours in IPR2015-00990 and three hours and fifty minutes in IPR2015-01093 after the filing deadline.

This late filing did not, result in any prejudice to Petitioner; indeed, Petitioner does not oppose this motion. On January 21, 2016, NPS provided Petitioner with an electronic drop box containing copies of all filings and mailed via overnight delivery hard copies of all filings, after a discussion with Petitioner's counsel, in order to mitigate any possibility of prejudice to Petitioner. Ex. 2161, ¶13-14; Ex. 2160, ¶ 2-3. NPS's counsel also told Petitioner's counsel that if Petitioner perceived any prejudice, NPS would agree to an equivalent extension for Petitioner's responsive filing now due April 4, 2016. Ex. 2160, ¶ 4. Petitioner's counsel responded that such an extension may be requested since Petitioner's response is due the Monday after The 94th Annual Dinner in Honor of the Federal Judiciary on Friday, April 1, 2016, at the Waldorf Astoria New York Hotel, which will be likely attended by many members of the judiciary (including members of the Board) and possibly Petitioner's counsel. *Id.* at ¶ 5. On the other hand, the Board's failure to consider the Public Exhibits, which support arguments and testimony in the Response and associated expert declarations, respectively, would result in severe prejudice to NPS. Accordingly, NPS submits that it is in the interest of justice for the Board to deem the Public Exhibits as being timely.

The filing deadline for a patent owner response is not a statutory requirement but rather an intermediate one that was implemented by the Board's Scheduling Order and subsequently modified per the parties' stipulation. *See* Papers 29, 31. Accordingly, 37 C.F.R. § 42.5(c)(3) permits the Board to excuse NPS's late filing "upon a Board decision that consideration on the merits would be in the interests of justice." In considering the totality of the circumstances to determine whether the interests of justice support excusing a late action, the Board weighs the actual prejudice to the non-filing party with the prejudice to the filing party by not considering the documents. *See Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2014-1102, Paper 26, 2 ("Upon weighing the prejudice to the Patent Owner of the one day late filing versus the prejudice to the Petitioner if we do not consider, on the merits, the replies and exhibits, we determine that it is in the interests of justice to consider the late-filed documents"); *Standard Innovation Corp. v. Lelo, Inc.*, Case IPR2014-00148, Paper 19, 3 (granting opposed timeliness motion after weighing prejudice to petitioner from a minimal filing delay against prejudice to patent owner of not considering its response); *Pacific Market International, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 40, 3-4 (granted timeliness motion after balancing the "severe prejudice" to the filing party with "essentially no prejudice" to the other.); *see also Callidus Software Inc. v. Versata Software, Inc. et al.*, CBM2013-00052, Paper 39, 2.

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