

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. and LUPIN PHARMACEUTICALS INC.,

Petitioner

v.

SENJU PHARMACEUTICAL CO., LTD.,

Patent Owner

Case IPR2015-01099 (Patent 8,669,290 B2)

**PATENT OWNER'S RENEWED MOTION TO EXPUNGE
UNDER 37 C.F.R. § 42.56**

I. Statement of Relief Requested

Pursuant to 37 C.F.R. § 42.56, Patent Owner requests that the Board reconsider its decision regarding the expungement from the record the confidential versions of Ex. 1181, for the reasons stated herein.

II. Background

On October 17, 2016, Patent Owner filed a Motion to Expunge Under 37 C.F.R. § 42.56, requesting expungement of certain confidential versions of Papers and Exhibits, including Ex. 1181. Ex. 1181 is a transcript of the expert cross examination of Mr. Hofmann. The Board did not refer to Ex. 1181 in its Final Written Decision of September 12, 2016.

On October 26, 2016, the Board granted-in-part Patent Owner's Motion, expunging confidential versions of all the requested Papers and Exhibits, except Ex. 1181. The Board did not grant Patent Owner's request to expunge Ex. 1181 because Patent Owner had not obtained the consent of Petitioner Lupin. *See* Order 80 at 2. The Board, however, preserved the sealed status of Ex. 1181 pending appeal and authorized Patent Owner to renew its request to expunge Ex. 1181 within ten business days after the time for filing a notice of appeal expires, or if an appeal is taken, ten business days after a final disposition of such appeal.

Petitioner Lupin informed the Board by email on September 2, 2016 that this IPR has settled. Moreover, on November 9, 2016, Petitioner Lupin informed Patent

Owner that it does not oppose Patent Owner's motion to expunge Ex. 1181.

Having gained the consent of Petitioner Lupin and because no appeal will be taken, Patent Owner now renews its request to expunge Ex. 1181.

III. Reasons for the Relief Requested

In the Board's Order of September 15, 2016, the Board noted that, with respect to confidential information not cited in the Final Written Decision, a party seeking to maintain the confidentiality of such information may file a motion to expunge the information from the record prior to it becoming public. (*See* Paper No. 71 at 6.) Accordingly, Patent Owner now renews its request that Ex. 1181 having been sealed by the Board, but not referred to in the Board's Final Written Decision, be expunged from the record.

Because the public has access to all the materials relevant to the merits of this proceeding, either through publicly filed papers and exhibits or through redacted, public versions of Papers and Exhibits filed October 17, 2016, and given the sensitive and confidential nature of the sealed information in Ex. 1181, good cause exists for the Board to expunge Ex. 1181 pursuant to 37 C.F.R. § 42.56.

Moreover, Patent Owner submits that the Ex. 1181 continues to contain confidential information and that expunging it from the record will not hamper the public interest of maintaining a complete and understandable file history for public

notice purposes. Patent Owner therefore requests that Ex. 1181 be removed from the record.

Patent Owner contacted counsel for Petitioner Lupin and they do not oppose this renewed motion to expunge Ex. 1181.

IV. Conclusion

For the reasons set forth above, Petitioner requests that the Board grant this renewed motion and expunge confidential versions of Exhibit 1181 from the record.

Dated: December 1, 2016

By: /Joshua L. Goldberg/
Joshua L. Goldberg, Back-up Counsel
Reg. No. 59,369
Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Joint Stipulation and Counsel Certification Regarding Confidential Information Cited in Final Written Decision** were served on December 1, 2016, via email directed to counsel of record for the Petitioner at the following:

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