Paper No. __
Filed: February 25, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COALITION FOR AFFORDABLE DRUGS VI LLC
Petitioner,

v.

CELGENE CORPORATION
Patent Owner

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Case IPR2015-01102
Patent 6,315,720

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PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

Coalition for Affordable Drugs VI LLC ("CFAD") seeks to introduce four documents as supplemental information. Paper 37 at 2. It alleges that these documents "confirm[] public accessibility/availability of Menill." *Id.* at 3. CFAD alleges that "this supplemental information was neither withheld intentionally nor would it limit or frustrate the Board's ability to complete this proceeding in a timely manner." *Id.* But CFAD fails to explain why it could not have submitted the four new documents with its Petition, or why it is necessary to add these documents at this time. *See*, *e.g.*, *Amazon.com, Inc. v. AC Techs. S.A.*, IPR2015-01801, Paper 9 at 2-3 ("We will not at this time authorize submission of Petitioner's proposed exhibits, which are of marginal relevance and could have been filed with the petition."). Its motion should be denied.

As CFAD admits: "The Board or Patent Owner did not challenge the public accessibility/availability of Menill." Paper 37 at 2. Nor is there any reason to do so. Menill is a reference that CFAD relies upon in a single sentence in its Petition in connection with a single limitation of a single claim (claim 31). Claim 31 is a dependent claim that adds an additional limitation requiring that "said diagnostic testing comprises testing for evidence of the use of said other drug." Ex. 1001 at 20:37-39. CFAD addressed that limitation as follows, relying on Menill:

> Indeed, because it was well known to an ordinarily skilled artisan that, as the National Center on Addiction and Substance Abuse at Columbia University stated in 1994 "people are generally reluctant to

> admit to alcohol or drug abuse and addiction," it would have been obvious to one of ordinary skill in the art that a substance abuse screen in *Dishman* should have comprised "testing for evidence of the use of" alcohol or other drugs, rather than solely relying on patient survey information. (Ex. 1026 [Menill] at 4; Ex. 1027 ¶ 203.) . . . Thus, **Claim 31**'s limitations would have been obvious to one of ordinary skill in the art at the time of the '720 Patent. (Ex. 1027 ¶¶ 190-202.)

Paper 1 at 43-44. Patent Owner does not dispute that the quoted language appears in Menill, nor does Patent Owner base any validity argument for claim 31 on that claim's additional limitation.

Thus, the supplemental information that CFAD seeks to add does not respond to ***any*** arguments Patent Owner has raised. CFAD recognizes this and, therefore, alleges that it seeks to file the supplemental information "out of an abundance of caution," implying that Patent Owner will take some contrary position on Menill in the future. Paper 37 at 2. But "[t]he Board [has] explained that submitting supplemental information under 37 C.F.R. § 42.123(a) as a vehicle to respond to a possible position that another party may take in the future is improper." *Medtronic, Inc. v. Endotach LLC*, IPR2014-00100, Paper 18 at 4 (Apr. 21, 2014). Thus, CFAD's motion is baseless.

Moreover, to the extent that CFAD has filed this motion because it wants to rely on Menill for some other argument in the future, that too is improper. The

Board has been clear that Petitioner cannot submit supplemental information to "raise a new ground of patentability after institution of a trial." *Id.*; *cf. Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (Feb. 5, 2015) (permitting supplemental information because it did "not change the grounds of unpatentability authorized in th[e] proceeding"). Such tactics would force Patent Owner to seek authorization to submit a surreply to address any of CFAD's new arguments based on Menill. This would unnecessarily multiply these proceedings and frustrate "the efficient administration of the Office" and the "ability of the Office to timely complete [the instituted] proceeding[]." 35 U.S.C. § 316(b). The Board should not allow it.

* * *

For these foregoing reasons, the Board should deny CFAD's motion.

Date: February 25, 2016 Respectfully submitted,

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