Paper No. 47
Filed: March 25, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS VI LLC

PETITIONER

V.

CELEGENE CORPORATION

PATENT OWNER

Case IPR2015-01102
Patent 6,315,720

PETITIONER'S REPLY IN SUPPORT OF MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURUSUANT TO 37 C.F.R. § 42.123(a)

Where a party has sought to submit information that confirms the public accessibility of a prior art reference at issue in the trial, the Board has repeatedly found such evidence to be proper supplemental information. See, e.g., *Biomarin*, IPR2013-00534, Paper 80 at 5 (granting motion under stricter standard of § 42.123(b)); *Valeo North Am., Inc. v. Magna Elecs, Inc.*, IPR2014-01204, Paper 26 at 2-5 (Apr. 10, 2015); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 2-5 (Feb. 5, 2014); *Motorola Sol'ns, Inc. v. Mobile Scanning Techs, LLC*, IPR2013-00093, Paper 39 at 2 (Jul. 16, 2013). As the Board has recognized, "a trial is, first and foremost, a search for the truth." *Edmund Optics, Inc., v. Semrock, Inc.*, IPR2014-00599, Paper 44 at 4 (May 5, 2015) (granting motion to submit supplemental information) (citing *TechSearch LLC v. Intel Corp.*, 286 F.3d 1360, 1378 (Fed. Cir. 2002)).

A party seeking to submit supplemental information under 37 C.F.R. § 42.123(a) must show that it is "relevant to a claim for which the trial has been instituted." Patent Owner incorrectly argues that "that, for supplemental information regarding the alleged public availability of a reference to be "relevant to a claim for which the trial has been instituted," the Board must have actually instituted trial on that reference." (Paper 43 at 1.) To the contrary, the Board has repeatedly granted motions to submit supplemental information regarding the public availability or reliability of background references upon which the Board

did not actually institute trial. *See Apple Inc. v. VirnetX, Inc.*, IPR2015-00810, Paper 21 at 6 (Nov. 2, 2015) (granting motion to submit supplemental information "proffered solely on the limited issue of whether Aventail Connect was publicly available prior to the effective date," where the Aventail Connect reference was not a reference upon which the Board instituted trial in that IPR (*see* Paper 8 at 23, Sept. 11, 2015)); *Shire Dev. LLC v. Lucerne Biosciences, LLC*, IPR2014-00739, Paper 23 at 3 (Mar. 12, 2015) (granting motion to submit supplemental information regarding FDA approval of a drug"); *Edmund Optics, Inc.*, IPR2014-00599, Paper 44 at 4 (granting motion to submit supplemental information regarding the reliability of a reference upon which the Board instituted trial). Similarly, here, Exhibits 1012-14—for which Petitioner seeks to submit supplemental information as to their public availability—are used to explain the state of the art which would have led a POSA to combine the references upon which the Board instituted trial. Thus, the supplemental information the Petitioner seeks to admit is "relevant to a claim for which the trial has been instituted."

Patent Owner additionally argues that "CFAD's motion lacks merit because the supplemental information cannot 'confirm[] public accessibility/availability,' as CFAD mistakenly alleges" because "the submission of a reference as part of an IDS does not constitute an admission that a cited reference is prior art." (Paper 43 at 3.) However, Petitioner does not suggest that the submission of an IDS is an

admission that a cited reference is material prior art. Instead, Petitioner relies upon the IDS citations for Patent Owner's admissions of fact in those citations concerning the CDC Minutes (Ex. 1014) and the NIH Minutes (Exs. 1012-13).[1]

While the mere citation of a reference in an IDS is not an admission that the cited references are material prior art—a number of cases illustrate that admissions of fact made in an IDS—submitted pursuant to a duty of candor, good faith, and honesty upon which the public is entitled to rely—are relevant and bind the applicant to the facts admitted. See, e.g., *Stamps.com Inc. v. Endicia, Inc.*, 437 Fed.

[1] Patent Owner makes much over the fact that, of the information Petitioner seeks to submit, "[t]wo documents are information disclosure statements ("IDS") that were submitted to the Patent and Trademark Office ("PTO") in 2011—more than a decade after the patent at issue in this IPR, U.S. Patent No. 6,045,501 (the "'501 patent"), was filed—in connection with other patents that are not at issue in this IPR." (Paper 43 at 1.) However, Patent Owner's argument omits critical information. For instance, one IDS that Petitioner submits—Ex. 1074—was submitted by Patent Owner for a patent relating back to the '501 patent. The other IDS relates back to U.S. Patent No. 6,315,720, which is an improvement over the '501 patent. Moreover, these IDS citations are Patent Owner admissions regarding Exhibits 1012-14, regardless of the time when Patent Owner filed its IDSs.

Appx. 897, 903 (Fed. Cir. 2011) (finding printed publication based in part on IDS statement, as well as absence of evidence rebutting IDS statement); *In re Lister*, 583 F.3d 1307, 1313–17 (Fed. Cir. 2009) (finding reference publicly available based on IDS statements; ultimately holding IDS statements at issue did not admit date of availability); *Clock Spring v. Wrapmaster, Inc.*, 560 F.3d 1317, 1326 (Fed. Cir. 2009) (IDS statements of fact regarding a public presentation admit facts for alleged prior public use); *Glaxo Wellcome, Inc. v. Impax Labs., Inc.*, 356 F.3d 1348, 1355–56 (Fed. Cir. 2004) (statements of fact in IDS including titles of references applied against patentee as factual evidence showing patentee's knowledge of the IDS facts admitted).

Specifically, Patent Owner disputes that each "exhibit is what Petitioner claims it is," as well as "any alleged public accessibility/availability of the exhibits." (Paper 23 at 1.) However, in the IDSs that Petitioner seeks to submit as supplemental information, the Patent Owner acknowledges that the exhibits are in fact what the Petitioner states they are. Thus, the supplemental IDS citations help to confirm the public accessibility of two prior art references at issue in the trial.

Similarly, the Federal Register citation that Petitioner seeks to submit also helps to confirm the public accessibility of the CDC Minutes reference at issue. While Patent Owner argues that the Federal Register citation should not be allowed because it, *by itself*, is insufficient to confirm the public accessibility of the CDC

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