

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)**

Patent Owner first questions why Petitioner “could not have submitted the four new documents with its Petition.” (Paper 44 at 1.) However, Petitioner submitted its request to file a motion to submit supplemental information within one month of institution pursuant to 37 C.F.R. § 42.123(a). (Paper 37 at 1.) “[U]nder 37 C.F.R. § 42.123(a), unlike 37 C.F.R. § 42.123(b), Petitioner need not “show why the supplemental information reasonably could not have been obtained earlier.” *Apple Inc. v. VirnetX, Inc.*, IPR2015-00810, Paper 21 at 5 (Nov. 2, 2015). Thus, Patent Owner’s complaint about the timeliness of Petitioner’s request to submit supplemental information is misplaced.

Next, Patent Owner objects to the relevance of Petitioner’s requested supplemental information. (Paper 44 at 1-3.) Petitioner seeks to submit four exhibits as supplemental information that confirms the public accessibility of a prior art reference at issue in the trial. (Paper 37 at 2.) 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)).

Patent Owner’s argument that because “[t]he Board or Patent Owner did not challenge the public accessibility/availability of Menill,” Petitioner’s “motion is baseless,” flies in the face of the Board’s prior rulings. (Paper 44 at 1-2). For instance, in *Valeo*, the Board rejected this exact argument:

Petitioner contends that because Broggi’s prior art status was sufficient for institution it was unforeseeable that additional proof regarding that status would be required (citing *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, Case CBM 2012-00010, slip op. at 37 (PTAB Feb. 24, 2014) (Paper 59).

Petitioner’s reliance on *Liberty Mutual* is misplaced because there the Board dealt with the admissibility of evidence (authentication under F.R.E. 902) and not the sufficiency of the proof of publication of a reference. *Id.* at 37-38. Further, **our institution decision explicitly states that the Board has not made a final determination on patentability of any challenged claim.** ... Accordingly, it is ORDERED that Petitioner’s Motion to Submit Exhibits 1026–1031 as Supplemental Information under 37 C.F.R. § 42.123(a) is granted.

Valeo North Am., Inc. v. Magna Elecs, Inc., IPR2014-01204, Paper 26 at 3-5 (Apr. 10, 2015) (citations omitted) (emphasis added).

Just as in *Valeo*, because the Board’s institution decision here explicitly states that “the Board has not yet made a final determination of the patentability of any of claims 1–32 of the ’720 patent,” Petitioner’s request to submit supplemental information to confirm the public accessibility/availability of Menill—a reference included in the ground upon which the Board instituted trial—is proper. (Paper 21 at 24.)

Respectfully submitted,

March 25, 2016

/Sarah E. Spires/

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CERTIFICATE OF SERVICE

I hereby certify that on March 25, 2016, a copy of this Motion was served
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