

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

COALITION FOR AFFORDABLE DRUGS VI LLC  
Petitioner,

v.

CELGENE CORPORATION  
Patent Owner

---

Case IPR2015-01103  
Patent 6,315,720

---

**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 38 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 38 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 ¶¶ 190, 192.) . . . 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 ¶¶ 180-92.)

Paper 1 at 44-45. 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 38 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,

By: /F. Dominic Cerrito (Reg. No. 38,100)/

F. Dominic Cerrito (Reg. No. 38,100)

Andrew S. Chalson (*pro hac vice*)

Eric C. Stops (Reg. No. 51,163)

Frank C. Calvosa (Reg. No. 69,064)

QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

51 Madison Avenue, 22<sup>nd</sup> Floor

New York, NY 10010

Tel: (212) 849-7000

Fax: (212) 849-7100

nickcerrito@quinnemanuel.com

ericstops@quinnemanuel.com

andrewchalson@quinnemanuel.com

frankcalvosa@quinnemanuel.com

Anthony M. Insogna (Reg. No. 35,203)

J. Patrick Elsevier (Reg. No. 44,668)

JONES DAY

12265 El Camino Real

Suite 200

San Diego, CA 92130

Tel: (858) 314-1200

Fax: (858) 314-1150

aminsogna@jonesday.com

jpelsevier@jonesday.com

Gasper J. LaRosa

JONES DAY

222 E 41st Street

New York, NY 10017

Tel: (212) 326-3939

Fax: (212) 755-7306

gjarosa@jonesday.com

*Attorneys for Celgene Corporation*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.