

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,

and

LUPIN LTD. and LUPIN PHARMACEUTICALS, INC.
Petitioners,

v.

HORIZON THERAPEUTICS, INC.,
Patent Owner.

Case IPR2015-01117¹
Patent 8,642,012

**PETITIONER'S UNOPPOSED
MOTION TO FILE PREVIOUSLY SERVED
OBJECTIONS TO EVIDENCE OUT OF TIME UNDER 37 C.F.R. § 42.5(C)**

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¹ Case IPR2015-00283, instituted on a petition filed by Lupin Ltd. and Lupin Pharmaceuticals, Inc., has been joined with this proceeding.

INTRODUCTION

Petitioner Par Pharmaceutical, Inc. (“Petitioner”) moves to file its previously served objections to evidence presented in Patent Owner Horizon Therapeutics, Inc. (“Patent Owner”) Response (“Patent Owner’s Response”) out of time. There is good cause to grant the requested relief because Petitioner timely served its objections within the proscribed five-day period, the deadline to file motions to exclude evidence is over six weeks away and Patent Owner does not oppose Petitioner’s motion. In addition, the late filing of Petitioner’s objections will promote the interests of justice by having evidentiary disputes decided on the merits.

STATEMENT OF FACTS

On April 29, 2015, Petitioner filed its Petition for *Inter Partes* Review of U.S. Patent No. 8,642,012 (“the ’012 patent”). (Paper No. 2.) On November 4, 2015, the Patent Trial and Appeal Board (“the Board”) issued a decision instituting *inter partes* review of the ’012 patent. (Paper No. 13.) On March 28, 2016, Patent Owner filed a response to the petition (“Patent Owner’s Response”) and exhibits thereto. (Paper Nos. 25-26, Ex. Nos. 2011-2028.)

On April 4, 2016, Petitioner served objections under 37 C.F.R. § 42.64 to evidence submitted in the Patent Owner’s Response. (*See* Exhibit 1034.)

Petitioner did not concurrently file the objections on the case docket. On April 23,

2016, Petitioner discovered that Petitioner had inadvertently failed to file its objections to evidence presented in Patent Owner's Response. On April 25, 2016, Petitioner notified Patent Owner of this oversight, and further requested Patent Owner's position in regards to the present motion. (*See* Exhibit 1036.) On April 26, 2016, Patent Owner informed Petitioner that it would not oppose the present motion. (*Id.*)

The deadline for Petitioner to file a motion to exclude evidence presented in Patent Owner's Response is June 16, 2016. (Paper Nos. 14 and 19.)

ARGUMENT

Petitioner seeks to file its previously served objections out of time to correct a procedural oversight and preserve Petitioner's right to move to exclude evidence presented in Patent Owner's Response at a future time by making the same objections part of the record. *See* 37 C.F.R. § 42.64(b)(1). The Board has authority to excuse a late action on "a showing of good cause" or where "consideration on the merits would be in the interests of justice." 37 C.F.R. § 42.5(c)(3). Here, both good cause and the interests of justice favor allowing Petitioner to file its objections out of time.

I. GOOD CAUSE EXISTS TO ALLOW PETITIONER TO FILE ITS PREVIOUSLY SERVED OBJECTIONS OUT OF TIME.

Petitioner served its objections to evidence presented in Patent Owner's Response within five business days of the filing of Patent Owner's Response. (Exhibit 1034 at 7.) Petitioner inadvertently complied with a pre-amendment version of the regulation requiring only that the objections be "served."² Because Petitioner's motion seeks to file precisely the same objections as those timely served on April 4, 2016, there is no prejudice to Patent Owner by allowing a late filing. In fact, Patent Owner does not oppose the present motion. (Exhibit 1036.) Furthermore, the filing of Petitioner's objections out of time will not burden the Board or compound proceedings because the deadline to file motions to exclude evidence is June 16, 2016. (Paper Nos. 14 and 19.)

Petitioner recognizes that the regulation, as amended May 19, 2015, requires that evidentiary objections be concurrently filed and served. 37 C.F.R. § 42.64(b)(1). The spirit of the regulation, as amended, remains placing the opposing party on notice of the objection, and the added requirement that

² In confirming that the prior version of the regulation did not require that objections be filed in the record, the Board stated that the regulation "d[id] not require, nor ha[d] [the Board] authorized, the parties to file objections to evidence with the Board" and "[s]uch objections . . . are only to be filed with the Board in the event they later become the basis of a Motion to Exclude Evidence." Order at 2, *Mitsubishi Plastics, Inc. v. Celgard, LLC*, Case No. IPR2014-00524 (PTAB October 15, 2014) (Paper No. 17).

objections be filed in the record was designed to fill a procedural gap in the requirements for filing a motion to exclude evidence. *See* 80 Fed. Reg. 28563 (“The Office Patent Trial Practice Guide states that a motion to exclude evidence requires a party to identify where in the record the objection originally was made, but 37 C.F.R. § 42.64(b)(1) merely requires service, which does not make such objections of record.”). Thus, the purpose of the “filing” requirement is to ensure that a later-filed motion to exclude evidence is based on an objection that is identified in the record. Here, Petitioner served its objections, identified a procedural oversight and promptly sought to rectify its mistake over six weeks before the deadline for filing a motion to exclude evidence. Accordingly, good cause exists to grant Petitioner’s motion to file its objections out of time.

II. ALLOWING PETITIONER TO RELY ON ITS PREVIOUSLY SERVED OBJECTIONS PROMOTES THE INTERESTS OF JUSTICE.

The interests of justice favor considering Petitioner’s objections, if asserted in a motion to exclude, based on the record the parties have fully developed, rather than a procedural ground. 37 C.F.R. § 42.5(c). *See also, e.g., Kucik v. Yamaha Motor Corp., U.S.A., C.A. No. 08-cv-161, 2009 WL 3401978 at *2 (N.D. Ind. Oct. 16, 2009)* (“the Court prefers to resolve cases on their merits and to rule on motions with the benefit of all relevant evidence and argument, as an approach that best serves the interests of justice.”) (citation omitted). For example, Petitioner

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