

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 IPR2015-01117*
Patent 8,642,012

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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

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I. INTRODUCTION AND RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.64 and the Board's Scheduling Order, Patent Owner moves to exclude portions of the re-examination testimony of Dr. Neal Sondheimer elicited at his March 10-11, 2016 deposition ("the Sondheimer Deposition," Ex. 2012), because such testimony is outside the scope of Dr. Sondheimer's cross-examination testimony and/or Dr. Sondheimer's direct testimony. Patent Owner also moves to exclude documents offered by Petitioner during re-examination of Dr. Sondheimer as outside the scope of his cross-examination testimony, untimely, irrelevant, and/or lacking foundation and/or authenticity. Petitioner should be precluded from using such documents and the portions of Dr. Sondheimer's testimony identified below at any hearing or in any paper such as, without limitation, a brief, motion, or observation on cross-examination.

Specifically, Patent Owner moves to exclude the following portions of Dr. Sondheimer's re-examination testimony in Exhibit 2012 as well as the documents not previously of record but offered by Petitioner as Exhibits 1031-1033:

- 218:17-224:19;
- 269:15-283:14;
- 225:1-231:1;
- 242:2-242:16;

- 243:15-244:19;
- 249:22-251:6;
- 252:10-254:14;
- 259:5-260:9;
- 261:7-265:2;
- 266:14-267:6; and
- 289:9-21.

Patent Owner's objections to the testimony that is the subject of this Motion are included in the citations referenced above.

II. PROCEDURAL POSTURE AND BACKGROUND

To preserve its right to exclude evidence based on objections timely made as required by 37 C.F.R. § 42.64(c), Patent Owner is filing this motion seeking to exclude certain deposition testimony and documents offered at the Sondheimer Deposition because such testimony and documents are directed to matters outside of the scope of Dr. Sondheimer's cross-examination testimony and his direct testimony. As required by 37 C.F.R. § 42.64(a), Patent Owner raised timely objections during the Sondheimer Deposition, and therefore preserved its right to seek the exclusion of such testimony and the use of such documents.

In its Reply (Paper No. 0030), Petitioner has not attempted to rely upon the portions of Dr. Sondheimer's deposition transcript or the documents Patent Owner

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