

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner,

v.

HORIZON THERAPEUTICS, INC.,
Patent Owner.

Case IPR2015-01117 (Patent 8,642,012 B2)
Case IPR2015-01127 (Patent 8,404,215 B1)¹

Before TONI R. SCHEINER, DEBORAH KATZ, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in both cases. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2015-01117 (Patent 8,642,012 B2)

Case IPR2015-01127 (Patent 8,404,215 B1)

With respect to the “first” matter discussed in the attached email from Patent Owner, Patent Owner is authorized to file, within five (5) business days of the date of this Order, corrected Patent Owner Responses in IPR2015-01117 and IPR2015-01127, for the sole purpose of correcting the citations to Exhibit 2012 in each case.

Petitioner is authorized to file, within five (5) business days of the date of Patent Owner’s corrected Patent Owner Responses, a reply, not to exceed three (3) pages, for the sole purpose of responding to Patent Owner’s arguments based on the correct citations to Exhibit 2012. Arguments not directed to Patent Owner’s corrected citations will not be considered. No other briefing on Petitioner’s part is authorized. No other briefing on Patent Owner’s part is authorized.

With respect to the “second” matter discussed in Patent Owner’s email, Patent Owner is not authorized to file any other papers. The Board will determine what arguments, if any, are improper.

It is

ORDERED that Patent Owner is authorized to file, within five (5) business days of the date of this Order, corrected Patent Owner Responses in IPR2015-01117 and IPR2015-01127, for the sole purpose of correcting citations to Exhibit 2012;

FURTHER ORDERED that Petitioner is authorized to file, within five (5) days of the date of Patent Owner’s corrected Patent Owner Responses, a reply, not to exceed three (3) pages, for the sole purpose of responding to Patent Owner’s arguments based on the correct citations to Exhibit 2012; and

FURTHER ORDERED that no other briefing is authorized.

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ATTACHMENT

From: Emer Simic [<mailto:esimic@greengriffith.com>]
Sent: Wednesday, June 08, 2016 3:02 PM
To: Trials <Trials@USPTO.GOV>
Cc: Robert Green <rgreen@greengriffith.com>; Dennis Bennett <dennisbennett@globalpatentgroup.com>; Lauren Stevens <LStevens@horizonpharma.com>; Matt Phillips <matthew.phillips@renaissanceiplaw.com>; Burgy, Aziz <aburgy@axinn.com>; Silverstein, David H. <DSilverstein@axinn.com>; Holland, Elizabeth J. <EHolland@goodwinprocter.com>; Hardman, Cynthia <CHardman@goodwinprocter.com>; Jessica Tyrus <jtyrus@greengriffith.com>
Subject: RE: IPR2015-01117 (joined with IPR2016-00283) and IPR2015-01127 (joined with IPR2016-00284)

To the Board:

I write on behalf of Patent Owner to respectfully request a teleconference with the Board to address two separate matters.

First, it has come to our attention upon receipt of Petitioner's Reply that the Patent Owner Responses submitted in IPR2015-01117 and IPR2015-01127 inadvertently cite to an earlier version of Petitioner's expert, Dr. Sondheimer's transcript (Sondheimer Transcript 3.10.16) and not his final transcript, Exhibit 2012. However, the earlier version of Dr. Sondheimer's transcript and the final version were provided to Petitioner prior to filing of the Patent Owner Response. In its Reply, Petitioner indicates that it was aware of a global problem with citation to Exhibit 2012 in the Patent Owner Response (*see* Petitioner's Reply in IPR2015-01127 at pp. 1-2, 4) but did not seek clarification on this issue from Patent Owner or the Board. To clarify the record, Patent Owner requests leave from the Board to file corrected Patent Owner Responses for the sole purpose of correcting the citation to Exhibit 2012. Attached to this email are Patent Owner's corrected Responses that have been redlined to indicate the corrected citations. In addition, we attach the earlier version of the Sondheimer transcript, to which the Patent Owner Responses currently cite and Exhibit 2012, to which the corrected Patent Owner Responses cite, both of which have been highlighted to show the corresponding citations in the original and corrected responses. Patent Owner does not believe Petitioner will be prejudiced by the filing of the corrected Patent Owner Responses; however, Petitioner has objected to filing of the attached corrected responses on grounds of prejudice. Patent Owner apologizes for the additional burden placed on the Board in addressing this issue.

The second matter Patent Owner seeks to raise with the Board relates to Petitioner's Reply in IPR2015-01117 (Paper No. 30, filed May 27, 2016), which includes multiple arguments (listed below) that exceed the proper scope of the Reply and/or are improperly raised for the first time in Reply:

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- Petitioner improperly relies on the Simell reference (Ex. 1005) for its alleged teaching of incomplete conversion of PAA to UPAGN in violation of 37 C.F.R. § 43.23(b). *See* Reply at 1, 6-7.
- Petitioner improperly introduces new and previously undisclosed arguments in support of its claim construction position in violation of 37 C.F.R. § 43.23(b). *See* Reply at 3-4.
- Petitioner improperly introduces a new and previously undisclosed argument relating to the coefficient of variation in support of its argument that a POSA would have been motivated to combine Brusilow '91 with other prior art references in violation of 37 C.F.R. § 43.23(b). *See* Reply at 20.

In view of Petitioner's violation of 37 C.F.R. § 42.23(b), Patent Owner requests leave from the Board to file a Motion to Strike Petitioner's Reply. In the alternative, Patent Owner seeks leave from the Board to file a document identifying with particularity the improper arguments raised in Petitioner's Reply and/or seeks leave to file a Sur-reply to respond to the new subject matter in the Reply.

The Parties have met and conferred regarding the aforementioned matter but have been unable to reach agreement. The Parties are available for a teleconference with the Board the afternoon of June 10, 2016. Please let us know the Board's availability for a teleconference.

Sincerely,

Emer L. Simic

Member

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