

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 OPPOSITION TO PETITIONER'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

Pursuant to 37 C.F.R. § 42.64 and 37 C.F.R. § 42.23, Patent Owner Horizon Therapeutics, Inc. (“Patent Owner” or “Horizon”) files this opposition to Par Pharmaceutical, Inc.’s (“Petitioner” or “Par”) Motion to Exclude Evidence (Paper No. 38). Par’s Motion is legally and substantively defective and should be denied. In its Motion, Petitioner seeks to expunge relevant evidence from the record because it is not favorable to Petitioner’s positions in this *inter partes* review (“IPR”). In addition, under the guise of a motion to exclude evidence, Petitioner improperly supplements its reply brief by arguing that large sections of Horizon’s Patent Owner Response (“POR”) should be excluded because Horizon chose not to file a confirmatory expert declaration. In each instance, Petitioner’s position is meritless, Petitioner fails to demonstrate that it is entitled to the relief requested, and Petitioner has waived its objections to the alleged “evidence;” thus, Petitioner’s Motion should be denied in its entirety. 37 C.F.R. § 42.20(c).

II. EXHIBIT 2027 (SHERWIN ’33) IS RELEVANT AND ADMISSIBLE

Petitioner filed its objection to Exhibit 2027 with the Board more than two months late (Paper No. 34)¹; thus, pursuant to 37 C.F.R. 42.64(c)(1), such objections are not timely and should be deemed waived. Nevertheless, Petitioner’s request to exclude Exhibit 2027 (“Sherwin ’33”) arises not from an evidentiary

¹Par’s Motion to file its objections out of time (Paper 34) is currently pending.

defect but rather from Petitioner's concern that Sherwin '33 discredits Sherwin '19 (Exhibit 1016), one of Petitioner's key prior art references.

In its Motion, Petitioner argues that Sherwin '33 is not relevant because it allegedly does not discredit Sherwin '19; however, such argument only goes to the weight and not the admissibility of the evidence. *See e.g., Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00002, Paper 66 at 61 (P.T.A.B. Jan. 23, 2014) ("A motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay), but may not be used to challenge the sufficiency of the evidence to prove a particular fact."); *Nissan North America, Inc. v. Norman IP Holdings, LLC*, IPR2014-00564, Paper 36 at 34 (P.T.A.B. Aug. 26, 2015) ("[A] motion to exclude addresses the admissibility of evidence, and not how much weight to give an argument."). Petitioner also asserts that Sherwin '33 should be excluded because it allegedly confuses the issues; however, Petitioner fails to provide any support for its position. Thus, Petitioner has failed to meet its burden to demonstrate that Sherwin '33 lacks relevance under FRE 401 or 402 or will confuse the issues under FRE 403, and its motion should be denied. 37 C.F.R. § 42.20(c).

Furthermore, contrary to Petitioner's claim, the questions addressed, the methodologies used, and the studies performed in Sherwin '33 are highly relevant to this proceeding. A key issue in this IPR is whether the prior art, including

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