

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 REPLY IN SUPPORT OF ITS 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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In its Opposition (Paper 44) (“Pet. Opp.”) to Patent Owner’s Motion to Exclude (Paper 36) (“Patent Owner’s Motion”), Petitioner argues the admissibility of testimony it admittedly fails to rely on in any paper submitted to the Board. Thus, Petitioner’s Opposition appears to argue a moot cause. Alternatively, Petitioner opposes Patent Owner’s Motion because it intends to surprise Patent Owner with the use of the objected-to testimony and related exhibits at oral argument. In either case, Petitioner’s Opposition is improper and should be rejected by the Board.

Notwithstanding, Petitioner’s Opposition lacks merit because it mischaracterizes the record in an attempt to avoid exclusion of portions of testimony it improperly elicited and related documents offered during re-examination of Dr. Sondheimer directed to matters squarely outside the scope of Dr. Sondheimer’s cross-examination testimony and/or Dr. Sondheimer’s Expert Declaration (Ex. 1002). For the reasons provided in Patent Owner’s Motion and as explained further herein, exclusion of the portions of Dr. Sondheimer’s re-examination testimony and related documents identified in Patent Owner’s Motion is proper.

I. A MOTION TO EXCLUDE IS THE PROPER VEHICLE TO PRESERVE PATENT OWNER’S TIMELY OBJECTIONS

Patent Owner properly filed its motion to exclude as required to preserve its objections made at Dr. Sondheimer’s deposition to portions of his testimony and

related documents as outside the scope of Dr. Sondheimer's cross-examination and/or direct examination. 37 C.F.R. § 42.64(c). As discussed in Patent Owner's Motion, the scope of cross-examination is limited to the scope of the witness's direct testimony, and likewise, the scope of re-examination is limited to the scope of the witness's cross-examination. 37 C.F.R. § 42.53(d)(5)(ii). Patent Owner's Motion properly identifies the objections made on the record at the Sondheimer Deposition, and explains why the objected-to testimony and documents are inadmissible as being outside the scope of Dr. Sondheimer's cross-examination and/or direct testimony, pursuant to 37 C.F.R. § 42.53(d)(5)(ii).

Petitioner's argument that Patent Owner's Motion is not the proper vehicle for objection to the scope of Dr. Sondheimer's testimony fails because it is based on inapplicable case law concerning improper attempts to challenge the scope of arguments made in a reply paper or the sufficiency of evidence to prove a particular fact. Such case law is irrelevant here because Patent Owner's Motion does not argue the merits of Dr. Sondheimer's testimony or challenge the proper scope of arguments made in Petitioner's Reply (Paper 30), but rather seeks to preserve its timely-made objections to Dr. Sondheimer's testimony as being outside the scope of his cross-examination and/or direct testimony, should Petitioner later attempt to rely upon such evidence.

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