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Case IPR2015-01117, Paper No. 52

Case IPR2015-01127, Paper No. 48

September 9, 2016

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

Held: July 26, 2016

BEFORE: TONI R. SCHEINER, DEBORAH KATZ, and
GRACE KARAFFA OBERMANN, Administrative Patent
Judges.

The above-entitled matter came on for hearing on Tuesday, July
26, 2016, commencing at 10:02 a.m., at the U.S. Patent and
Trademark Office, 600 Dulany Street, Alexandria, Virginia.

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

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

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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1 P R O C E E D I N G S

2 - - - - -

3 JUDGE OBERMANN: Please be seated.

4 Good morning and welcome to the PTAB. This is a
5 consolidated trial hearing in IPR2015-01117 and IPR2015-01127.
6 Petitioner is Par Pharmaceutical, Inc., and Patent Owner is
7 Horizon Therapeutics, Inc. I'm Judge Obermann, Judge Scheiner
8 is on my right, and Judge Katz is on my left.

9 Before we begin, I would just like to remind the parties
10 that the hearing is open to the public, and a full transcript of it
11 will become part of the public record. When you refer to an
12 exhibit on the screen, please state the slide, the exhibit, or the
13 page number to which you are referring for the record. That's
14 important for clarity in the transcript.

15 As you know from our order of July 18th, each party
16 has one hour, in total, to present their argument. Because
17 Petitioner has the burden to show unpatentability of the original
18 claims, there's no motion to amend here, Petitioner will proceed
19 first, followed by Patent Owner. Petitioner's counsel may reserve
20 rebuttal time and divide the hour of time among the cases as it
21 wishes.

22 Now, in order to keep this case focused on the merits, I
23 am going to ask counsel not to interrupt the other side to make
24 objections. Any objections should be discussed during your own
25 allotted argument time.

1 I have two preliminary matters that I wanted to discuss.
2 The first, we sent the parties an email yesterday regarding paper
3 47 in IPR '117 and paper 43 in IPR '127. Those are identified in
4 our filing system as Petitioner's Reply in Support of the Motion to
5 Exclude, but the actual papers appear to be duplicate copies of
6 Petitioner's Supplemental Reply to Patent Owner's Corrected
7 Response.

8 So, as we explained in our email yesterday, Petitioner,
9 you may address that issue in your opening argument if you like,
10 and, Patent Owner, you may respond during your allotted hour of
11 time to the extent that the Petitioner has argued it in their case in
12 chief.

13 The second thing I'd like to do, I want to let you know
14 that the Panel has considered the joint objections to
15 demonstratives that were filed in both cases. We've determined
16 that both parties may use their demonstrative exhibits today. We
17 overrule Patent Owner's objections based on the timing of
18 service. In that regard, we understand that Petitioner did file what
19 they purported to be final exhibits the day before our order
20 issued, but our order does trump the timing in this case. So, we
21 will let the Petitioner use their demonstratives as served five days
22 before.

23 We take under advisement Petitioner's concerns that the
24 Patent Owner's demonstratives include new evidence. We
25 routinely disregard new evidence that's inserted into

1 demonstratives. They're not evidence in the trial, and we will
2 focus only on content that has been made of record during the
3 trial. We're adept at making that distinction. So, for that reason,
4 we are not going to exclude any exhibits.

5 We will also take under advisement Petitioner's second
6 objection to Patent Owner's demonstratives in IPR '127, going to
7 the content of slide 19. We will take that objection into account
8 when we prepare our final written decision, but, again, Patent
9 Owner is free to use slide 19 during the hearing.

10 Do we have any questions from either side on either of
11 those?

12 MS. HOLLAND: No, Your Honor.

13 JUDGE OBERMANN: Okay, thank you. With that,
14 let's take a moment for counsel introductions. Who will be
15 presenting argument for Petitioner today?

16 MS. HOLLAND: Good morning, Your Honor.
17 Elizabeth Holland of Goodwin Procter, LLP. We are actually
18 counsel for Petitioner Lupin in the joint IPR, but I will be arguing
19 today on behalf of both Lupin and Par.

20 JUDGE OBERMANN: Okay. And it's Ms. Holland?

21 MS. HOLLAND: Yes.

22 JUDGE OBERMANN: Thank you very much.

23 And for Patent Owner?

24 MS. SIMIC: Emer Simic from Green Griffith,
25 representing Horizon Therapeutics, Inc.

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