

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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ARGENTUM PHARMACEUTICALS LLC, MYLAN PHARMACEUTICALS  
INC., BRECKENRIDGE PHARMACEUTICAL, INC., AND ALEMBIC  
PHARMACEUTICALS, LTD.,  
Petitioners,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,  
Patent Owner.

Case No. IPR2016-00204<sup>1</sup>  
Patent No. RE 38,551

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**PATENT OWNER'S REPLY TO PETITIONERS' OPPOSITION TO ITS  
MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64**

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<sup>1</sup> Case IPR2016-01101, Case IPR2016-01242, and Case IPR2016-01245 have been  
joined with this proceeding.

Patent Owner Research Corporation Technologies, Inc. submits this reply to Petitioners' Opposition to Patent Owner's Motion to Exclude Evidence Pursuant to 37 C.F.R. § 42.64 (Paper 78) filed on January 6, 2017.

**I. Exhibit 1003 should be excluded as inadmissible hearsay under FRE 801(c) and FRE 802**

Exhibit 1003 is not "former testimony" under FRE 804(b)(1) because the alleged grounds of obviousness in IPR2014-01126 were different, and there was no "opportunity" or "similar motive" to develop Dr. Heathcock's testimony by cross-examination as no trial was instituted. It is far from certain that "Patent Owner could have deposed Dr. Heathcock in this proceeding" (Paper 78 p. 2) as any cross-examination would have been outside routine discovery under 37 C.F.R. § 42.51(b)(1)(ii) (requiring affidavit testimony to be "prepared for the proceeding"), necessitating a motion to compel under § 42.52(a) or a motion for additional discovery under § 42.51(b)(2). The fact that Patent Owner and the Board considered Dr. Heathcock's *trial* testimony does not create a hearsay exception for his affidavit testimony. Finally, that "Patent Owner never objected to Dr. Heathcock's affidavit prior to institution" (Paper 78 p. 2) is nonsensical given that objections are filed *after* institution. 37 C.F.R. § 42.64(b)(1).

**II. Exhibits 1048-1213 should be excluded for failure to timely serve**

Petitioners claim that the service of Exhibits 1048-1213 complied with 37 C.F.R. § 42.6(e)(1), but they ignore the very next paragraph. "Each document filed

with the Board, if not previously served, *must be served simultaneously* on each opposing party.” 37 C.F.R. § 42.6(e)(2) (emphasis added). Petitioners argue only compliance with the *mode* of service, and never address the requirements of *time* of service. The requirement in § 42.6(e)(2) for simultaneous service mirrors the requirement in § 42.51(b)(1)(i) that any exhibit “must be served *with* the citing paper or testimony.” 37 C.F.R. § 42.51(b)(1)(i) (emphasis added). It is undisputed that Petitioners filed Exhibits 1048-1213 with the Board on November 14, 2016, but they did not even attempt service of Exhibits 1048-1213 until the next day. *See* Exs. 2189 & 2190. Consequently, Petitioners’ service complied with neither 37 C.F.R. § 42.51(b)(1)(i) nor § 42.6(e)(2).

Petitioners’ untimely service was prejudicial to Patent Owner because it further condensed Patent Owner’s limited time to file objections and to prepare for cross-examination of Petitioners’ witnesses. Petitioners’ offer “to extend the upcoming dates” (*see* Ex. 1215) was an empty gesture; neither party could have extended the deadline under 37 C.F.R. § 42.64(b)(1) to file objections to the admittedly “voluminous [165] exhibits” or modified Due Dates 6 or 7. *See* Paper 20 p. 2. Petitioners have identified no good cause under 37 C.F.R. § 42.5(c)(3) for their late service, particularly given the agreement to extend Due Date 2. Thus, Exhibits 1048-1213 should be excluded for failure to effect timely service.

**III. Exhibit 1050 at 243:3-271:21 (“Roush Testimony”) should be excluded as outside the proper scope of cross-examination**

Petitioners' opposition does not dispute that the '301 patent is outside the scope of Dr. Roush's direct testimony. Petitioners instead suggest that the '301 patent was fair game during cross-examination because Dr. Wang relied on the document. Paper 78 pp. 6-7. However, Petitioners' only support for this argument is from Dr. Wang's second declaration, which was filed more than three weeks *after* Dr. Roush's deposition. *See id.* (citing Ex. 1084 ¶¶ 97-98). Consequently, Petitioners have identified no evidence that the '301 patent was within the proper scope of cross-examination under 37 C.F.R. § 42.53(d)(5)(ii).

Petitioners also argue that Dr. Roush's out-of-scope testimony about the '301 patent should not be excluded because it is relevant to obviousness and because "Dr. Roush did not consider all of the relevant prior art." Paper 78 p. 6. First, the '301 patent is not prior art. *See* 35 U.S.C. § 103(c)(1); Ex. 1050 at 244:6-7; *see also* Paper 73 p. 15. Moreover, Petitioners' concern about the completeness of Dr. Roush's analysis has no bearing on the actual scope of his direct testimony, and thus, is no more than an improper challenge to "the sufficiency of [his] evidence." *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012).

Petitioners finally argue that Patent Owner's objection to Dr. Roush's out-of-scope testimony is an improper mechanism for identifying new reply arguments, which attempts to "nullify the two-page limit" for Patent Owner's identification

paper (Paper 57). Paper 78 pp. 7-8. However, Patent Owner's scope objections were put on the record during Dr. Roush's deposition, more than three weeks before Petitioners filed their reply. *See* Paper 71 p. 5 (citing Ex. 1050 at 243:18-19, 253:5, 256:21-257:4). Patent Owner had no way of knowing that Petitioners' reply would improperly rely on the '301 patent. *See* Paper 57 pp. 1-2. Patent Owner properly and timely objected to the cross-examination testimony because it exceeded the scope of Dr. Roush's direct testimony (*i.e.*, Exhibit 2036). *See, e.g.*, Ex. 1050 at 243:18-19, 253:5, 256:21-257:4. Petitioners' arguments are procedurally and factually incorrect, and the Roush Testimony should be excluded under 37 C.F.R. § 42.53(d)(5)(ii).

**IV. Exhibit 1104 should be excluded under FRE 901, FRE 1001(e) and 1003**

Dr. Wang's declaration (Ex. 1217) is insufficient to authenticate Exhibit 1104 given his testimony that he "did not specifically do the calculation[s]" but Mr. Dowd did. *See* Ex. 2194 at 167:4-17. Petitioners also do not deny that Exhibit 1104 lacks certain data and contains errors. *See* Paper 78 pp. 8-10.

**V. Exhibit 1156 should be excluded as lacking relevance under FRE 402 and as unauthorized evidence under 37 C.F.R. § 42.123**

The Board has already determined that the LeGall thesis is not prior art in this proceeding. Institution Decision (Paper 19) p. 12. This issue should not be re-litigated less than two weeks before oral argument and after Patent Owner has filed its last substantive paper. Since the LeGall thesis is not prior art, Exhibit 1156

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