

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2016-00204¹
Patent No. RE 38,551

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

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

I. Introduction

In accordance with 37 C.F.R. § 42.64(c) and the Scheduling Order (Paper No. 20) as modified by the Joint Notice of Stipulation Concerning Schedule (Paper No. 50), Patent Owner Research Corporation Technologies, Inc. moves to exclude Petitioners' Exhibit 1003, which was cited by Petitioners in support of their Petition for *Inter Partes* Review under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.* ("Petition," Paper No. 2), filed on November 23, 2015, and Petitioners' Exhibits 1048-1213, and deposition testimony from Exhibit 1050 at 243:3-271:21 and Exhibit 2035 at 246:22-254:1, which were cited by Petitioners in support of their Petitioner Reply in Support of Petition for *Inter Partes* Review ("Reply," Paper No. 52), filed on November 14, 2016. This motion to exclude is based on grounds listed in Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(b)(1) ("Patent Owner's First Objections," Paper No. 22) and Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(b)(1) ("Patent Owner's Second Objections," Paper No. 53), which were timely filed and served on Petitioners on June 7, 2016 and November 21, 2016, respectively. This motion to exclude is also based on grounds identified during the depositions of Dr. William Roush and Dr. Binghe Wang. *See, e.g.*, Ex. 1050 at 243:18-19; Ex. 2035 at 248:11-18. Patent Owner's motion is based on the Federal Rules of Evidence

("FRE"), relevant case law, and the PTAB's rules as codified in the Code of Federal Regulations, Title 37, at Part 42.

II. Argument

A. Exhibit 1003 – Declaration of Dr. Clayton Heathcock – Should Be Excluded

Petitioners submitted Exhibit 1003 as evidence in their November 23, 2015 Petition. As identified in Patent Owner's First Objections, Exhibit 1003 should be excluded as inadmissible hearsay under FRE 801(c) and FRE 802.

Exhibit 1003 purports to be the declaration of Dr. Clayton Heathcock from IPR2014-01126—a different IPR proceeding with different petitioners. *See* Ex. 1003, p. 1. Petitioners in this proceeding supported their Petition in part with Exhibit 1003. *See* Petition, p. 5.

Exhibit 1003 is inadmissible hearsay under FRE 801 and FRE 802 because it is offered as evidence of what it asserts. *See* Petition, p. 5. Exhibit 1003 is an entire expert declaration submitted by an expert who is not participating in this proceeding. Consequently, Patent Owner did not have an opportunity to depose Dr. Heathcock or adequately challenge his opinions.

The hearsay exception for former testimony does not apply to Exhibit 1003. *See* FRE 804(b)(1). As this Board has already explained, "the petition in the earlier case [(i.e., IPR2014-01126)] raises different arguments." *See* Institution Decision (Paper No. 19), p. 9 n.7. Consequently, it cannot be shown that Patent

Owner had “an opportunity and *similar motive*” to develop Dr. Heathcock’s testimony by cross-examination. *See* FRE 801(b)(1)(B) (emphasis added). Thus, Exhibit 1003 should be excluded as inadmissible hearsay.

B. Exhibits 1048-1213 – Exhibits Filed With Petitioners’ Reply – Should Be Excluded

Exhibits 1048-1213 filed with Petitioners’ Reply should be excluded because they were not served on Patent Owner with the Reply as required by 37 C.F.R. § 42.51(b)(1)(i). None of Exhibits 1048-1213 was timely served with the Reply on the November 14, 2016 due date as set forth in the Joint Notice of Stipulation Concerning Schedule (Paper 50). *See* Ex. 2189 (email communication from Matthew Dowd at 11:50 PM on November 14, 2016 indicating that the exhibits would be served the following day); *see also* Ex. 2190 (letter dated November 15, 2016 for hand delivery of USB drive with “documents as filed yesterday”).² The Certificate of Service included with the Exhibit List filed and

² The November 14, 2016 email communication (Ex. 2189) included attachments identified as “Final Draft Davis Declaration_signed.pdf,” “McDuff Declaration - 20161114.pdf,” and “Wang Declaration Final Declaration-11-14-16[2].pdf,” However, none of the documents attached to Ex. 2189 included any exhibit labels or markings, and it is not Patent Owner’s burden or responsibility to determine (continued...)

served on November 14, 2016 made reference only to the Exhibit List itself, and did not identify any of Exhibits 1048-1213, for which a Certificate of Service has not ever been filed or served.

Under Board rules, a request for an extension of time, or an excuse for late action, must be supported by a showing of good cause. 37 C.F.R. § 42.5(c). Any alleged lack of prejudice to Patent Owner is not a substitute for a showing of good cause why Petitioner did not even attempt to serve the voluminous exhibits—165 in total—timely with the Reply. The fact that Petitioners did not complete the filing of their Reply and associated exhibits until after 11:00 PM on November 14, 2016 does not provide “good cause” for late service of the exhibits, particularly when Patent Owner agreed to extend the Due Date 2 deadline as a demonstration of reasonableness and professional courtesy to accommodate the change in law firms of lead counsel for Petitioners. Paper 50, p. 1.

Moreover, Petitioners’ untimely service method was prejudicial to Patent Owner. Not surprisingly, Petitioners’ 11:50 PM email communication (Ex. 2189) was not read by Patent Owner until the next business day, November 15, 2016, but the email communication did not specify when or how “the volume of the _____ whether these documents are the same as those marked as exhibits and served the following day.

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