

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEPTUNE GENERICS, LLC,
APOTEX INC., APOTEX CORP., TEVA PHARMACEUTICALS,
FRESENIUS KABI USA, LLC, and
WOCKHARDT BIO AG,

PETITIONERS,

V.

ELI LILLY & COMPANY,

PATENT OWNER.

Case IPR2016-00240¹
Patent 7,772,209

PETITIONER'S REQUEST FOR ORAL ARGUMENT

¹ Cases IPR2016-01191, IPR2016-01337 and IPR2016-01343 have been joined with the instant proceeding.

Pursuant to 37 C.F.R. § 42.70(a), and the Scheduling Order entered on June 17, 2016, IPR2016-00237 Paper 15 at 3; IPR2016-00240 Paper 15 at 3, Petitioner Neptune Generics, LLC (“Neptune”) respectfully requests the oral argument as currently scheduled for March 7, 2017.

Without intending to waive any issue not specifically identified, Neptune identifies below the issues to be argued:

1. The ground of unpatentability instituted in IPR2016-00237: Claims 1-22 of U.S. Patent No. 7,772,209 (“the ’209 patent”) as being obvious under 35 U.S.C. § 103 over Niyikiza (Ex. 1008) in view of the ’974 Patent (Ex. 1009) and further in view of the European Patent Application No. 0 595 005 (“EP 005”) (Ex. 1010), together with the knowledge of the Person of Ordinary Skill in the Art (“POSA”). Paper 13 at 19.

2. The ground of unpatentability instituted in IPR2016-00240: Claims 1-22 of the ’209 patent as being obvious under 35 U.S.C. § 103 on the following ground Rusthoven (Ex. 1011) in view of EP 005 (Ex. 1010), together with the knowledge of the POSA. Paper 14 at 19.

3. Any issues, exhibits, or factual matters raised in Petitioner’s IPR2016-00237 Petition for an IPR of the ’209 patent. Paper 1.

4. Any issues, exhibits, or factual matters raised in the Board’s Decision to institute IPR2016-00237. Paper 13.

5. Any issues, exhibits, or factual matters raised in Patent Owner's Opposition in IPR2016-00237. Paper 33.
6. Any issues, exhibits, or factual matters raised in Petitioner's IPR2016-00240 Petition for an IPR of the '209 patent. Paper 1.
7. Any issues, exhibits, or factual matters raised in the Board's Decision to institute IPR2016-00240. Paper 14.
8. Any issues, exhibits, or factual matters raised in Patent Owner's Opposition in IPR2016-00240. Paper 32.
9. Neptune's Motion to Exclude in IPR2016-00237 and IPR2016-00240 and any opposition by Patent Owner Eli Lilly and Company ("Lilly") thereto.
10. Pursuant to the teleconference held January 25, 2017, any issues, exhibits, or factual matters raised in Lilly's Sur-Reply, which is due on February 14, 2017.
11. Any issues specified by Lilly in a Request for Oral Argument, but only to the extent the Board grants Lilly's Request on those issues.

The '209 patent is also at issue in IPR2016-00318, which was filed by Sandoz Inc. ("Sandoz") and also has an oral argument scheduled for March 7, 2017. IPR2016-00318, Paper 15 at 6. Neptune requests that the arguments for the Neptune IPRs and Sandoz IPR be scheduled as separate sequential arguments rather than as a combined oral hearing. Neptune believes the arguments should be

treated separately because Neptune is not a party to IPR2016-00318. Further, the Sandoz IPR was instituted on different grounds, specifically, obviousness of claims 1-22 based on: (i) Calvert (Ex. 1007), Niyikiza I (Ex. 1006), Worzalla (Ex. 1013), European Patent Application No. 0 595 005 (“EP 005”) (Ex. 1033), and the ’974 Patent (Ex. 1005); and (ii) Calvert (Ex. 1007), Niyikiza I (Ex. 1006), Hammond I (Ex. 1015), EP 005 (Ex. 1033), and the ’974 Patent (Ex. 1005) (IPR2016-00318, Paper No. 14, at 21). The Sandoz IPR also involves different evidence, including testimony from three different experts who did not present testimony in the Neptune IPRs. Thus, given the differences in the parties, grounds, and evidence between IPR2016-00237 and -00240 on one hand and IPR2016-00318 on the other, Neptune believes that separate sequential arguments are appropriate.

Because of the technical complexity of the issues in dispute, Neptune, individually, requests sixty (60) minutes of time to address the issues. Should Lilly be granted more time for IPR2016-00237 and -00240, Neptune requests an equal amount of time as Lilly be allocated for Neptune.

Neptune reserves the right for rebuttal. Neptune will inform the Board of its specific allocation of time for its opening and rebuttal at the beginning of the oral argument.

Neptune also requests the ability to use computers at counsel's table to display demonstrative exhibits, and respectfully requests that PTAB provide a projector with VGA and HDMI connections for that purpose.

February 14, 2017

Respectfully Submitted,

/Sarah E. Spires/

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