

Paper No. \_\_\_\_\_

Filed: March 10, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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TEVA PHARMACEUTICALS USA, INC.,  
Petitioner

v.

MONOSOL RX, LLC,  
Patent Owner

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Case IPR2016-00281 (Patent 8,603,514 B2)  
Case IPR2016-00282 (Patent 8,017,150 B2)<sup>1</sup>

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**DECLARATION OF MICHAEL I. CHAKANSKY**

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<sup>1</sup> Per Order, Paper 8 (281 IPR) and Paper 7 (282 IPR), fn. 1, Patent Owner hereby attests, in connection with this paper, that it is filing the word-for-word identical paper in each proceeding identified in the heading.

I, Michael I. Chakansky, hereby declare as follows:

1. I am a partner at the law firm of Hoffmann & Baron LLP (“Hoffmann”), resident in the Parsippany, New Jersey office located at 6 Campus Drive, Parsippany, NJ 07054. I am registered to practice before the United States Patent and Trademark Office (Reg. No. 31,600), and am back-up counsel of record in proceedings IPR2016-00281 (8,603,514 B2) (“281 IPR”) and IPR2016-00282 (8,017,150 B2) (“282 IPR”).
2. On Monday, December 7, 2015, Hoffmann received three banker boxes delivered by FedEx to the Syosset, New York office of the Hoffmann firm, located at 6900 Jericho Turnpike, Syosset, NY 11791. The boxes were opened for docketing purposes as described in the Declaration of Daniel Doran, and after the contents were identified as involving, *inter alia*, Hoffmann client MonoSol Rx LLC, I was notified about the boxes. That day, I instructed that the three boxes with their complete contents be resealed, and sent to me in the Parsippany office by overnight delivery. I received the three boxes in the Parsippany office on Tuesday, December 8, 2015.
3. The FedEx tracking numbers for the three boxes I received are: 7751 1902

8582; 7751 1902 8983; and 7751 1902 9203. See Exhibit 2001 for true and correct copies of the shipping labels.

4. The boxes and their contents remained undisturbed until on or about December 14, 2015, when I went through the contents of the three boxes and discovered several deficiencies in the alleged service of the petitions.
5. In connection with IPR2016-00282 (8,017,150 B2), service was materially incomplete in that, *inter alia*: (a) there was no copy of the IPR Petition for the 8,017,150 B2 patent; (b) there was no copy of Exhibit 3 (Expert Declaration of Nandita Das); and (c) the Certificate of Service wrongly stated that it was served on December 3, 2015 by FedEx, even though, as discussed below, on-line FedEx Tracking histories (Ex. 2001) and a telephone conversation with FedEx established that the bankers' boxes were not tendered to FedEx until the next day, December 4, 2015.
6. In connection with IPR2016-00281 (8,603,514 B2), service was materially incomplete in that, *inter alia*: (a) there was no copy of Exhibit 3 (Expert Declaration of Jayanth Panyam); (b) the Certificate of Service wrongly stated that it was served on December 3, 2015 by FedEx, even though, as discussed below, on-line FedEx Tracking histories (Ex. 2001) and a telephone conversation with FedEx established that the bankers' boxes were

not tendered to FedEx until the next day, December 4, 2015; and (c) several documents were not stamped with Exhibit bates stamp markings.

7. On Tuesday, December 15, 2015, I accessed the FedEx Tracking history on-line for each of the three tracking numbers identified in ¶ 3 above. A true and correct copy of each of the three FedEx Tracking histories is included in Ex. 2001. As shown in Ex. 2001, the three boxes were a three-piece shipment under “Master tracking number 775119028582.” The “Ship date” for each of the three pieces is listed as “Fri 12/04/2015.” Ex. 2001. The “Travel History” for each piece includes an entry “Picked up Tendered at FedEx Office” at “3:02 am” on “12/04/2015-Friday” and an entry “Left FedEx origin facility at “11:19 pm” on “12/04/2015-Friday.”
8. Later that day, December 15, 2015, I placed a call to FedEx. FedEx confirmed that the three boxes having the tracking numbers identified in ¶ 3 above were part of the same shipment, and that each box was delivered to a 24-hour FedEx facility located at 60 West 40th Street, New York City on December 4, 2015.
9. Also on December 15, 2015, I contacted the Patent Trials and Appeal Board (“PTAB”) at 571-272-7822 for guidance regarding the incomplete service and spoke with Mr. Eric Hawthorne, whom I believe is a Supervisory

Paralegal Specialist. Mr. Hawthorne suggested that we request guidance from the PTAB in an email to Trials.gov. Before I could send an email, I learned that filing dates had been accorded to IPR2016-00281 and IPR2016-00282. By reviewing Paper No. 3 at the PTAB for each of IPR2016-00281 and IPR2016-00282, respectively, I learned that the date afforded to each was December 4, 2015.

10. Papers No. 3 in each of IPR2016-00281 and IPR 2016-00282 (as well as IPR2016-00280) noted defects in the documents and Certificates of Service that Petitioner had filed with the PTAB.
11. Papers No. 3 also instructed Patent Owner to file a Mandatory Notice within 21 days of service of the petition. Therefore, that day, December 15, 2015, I contacted Paul Sullivan of the PTAB at 571-272-0338, as instructed in Papers No. 3, to request guidance as to how to deal with the incomplete service and to ask when Patent Owner's Mandatory Notices would be due as a result of the incomplete service. Mr. Sullivan suggested that I write to Trials.gov, explain the situation and copy the Petitioner.
12. That day, December 15, 2015, we decided we should meet and confer with Petitioner to comply with PTAB rules before making any formal request to the PTAB, which we did (see below) and that we also should first put in an

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