UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOIOS PHARMACEUTICALS LLC,
Petitioner

v.

MEDAC GESELLSCHAFT FUER KLINISCHE SPEZIALPRÄPARATE MBH,
Patent Owner

Case No. IPR2016-01370
Patent Number 8,664,231

Before JACQUELINE WRIGHT BONILLA, TONI R. SCHEINER, and ERICA A. FRANKLIN, *Administrative Patent Judges*

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. §§ 42.62 AND 42.64

Pursuant to 37 C.F.R. §§ 42.62 and 42.64, Patent Owner medac Gesellschaft für Klinische Spezialpräparate mbH ("Medac") moves to exclude certain of Petitioner's exhibits and cross-examination. This motion is timely filed under the Board's Scheduling Order. (Paper 14: Due Date 4). Medac requests that Exhibits 1041-45 and certain cross-examination testimony from Terri Shoemaker (Exhibit 1040) be excluded.

I. Legal Standards

The Federal Rules of Evidence ("F.R.E.") apply to *inter partes* review proceedings. *See* 37 C.F.R. § 42.62(a); Office Patent Trial Practice Guide, 77 Fed. Reg. 48758. Under F.R.E. 402, "irrelevant evidence is not admissible." Furthermore, an out-of-court statement used to prove the truth of the matter asserted is inadmissible hearsay unless otherwise provided by a federal statute, the Federal Rules of Evidence, or other rules prescribed by the Supreme Court. F.R.E. 801-05. Finally, "[t]o satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is." F.R.E. 901.

II. Exhibits 1041-45 Should be Excluded

The Board should exclude Exhibits 1041-45 because those exhibits include evidence that is irrelevant, inadmissible hearsay, and/or improperly authenticated. Medac timely objected to these exhibits, stating the precise grounds why they are

inadmissible.[1] (Paper 38).

A. Exhibit 1041 Should be Excluded

Exhibit 1041 is a copy of e-mail correspondence between counsel of record concerning deposition scheduling for Petitioner's expert witnesses. Medac timely objected to Exhibit 1041 under F.R.E. 401, 402, 403, and 37 C.F.R. § 42.61. (Paper 38 at 2).

Exhibit 1041 is irrelevant to this *inter partes* review and should not be admitted under F.R.E. 401 and 402. E-mail between counsel about deposition scheduling does not relate to the substance of any expert testimony, prior art references, or any other patentability issue in this case. Moreover, admission of the correspondence is entirely unnecessary because it is evident from the record that Medac did not depose Petitioner's experts. No transcripts of such depositions were filed with the Board.

The issue, however, is that Petitioner relies on Exhibit 1041 to argue that Medac "refused" to take the depositions of Petitioner's experts (Drs. Schiff and Miller) due to the "quality" of their opinions. Reply at 1, 3, 20. Such reliance is misleading and unfairly prejudicial to Medac. There are many reasons for deciding

[1] In its objections to Petitioner's Reply exhibits, Medac also objected to Petitioner's incomplete and misleading citations of Dr. Thomas Zizic's deposition testimony. Because the Board addressed those objections during a September 29, 2017 conference call and allowed Medac to file a sur-reply with citations to additional testimony, Medac does not seek exclusion here.

not to depose an expert in an *inter partes* review aside from the alleged "quality" of the opinion. Indeed, the deficiencies of a witness's direct testimony may be evident without cross-examination. Furthermore, here Medac addressed the opinions of Petitioner's experts in multiple expert declarations of its own. Given Petitioner's misleading statements about Exhibit 1041, and its lack of relevance to any substantive issue in dispute, Exhibit 1041 should be excluded under F.R.E. 402 and 403.

B. Exhibit 1042 Should be Excluded

Exhibit 1042 purports to be a website copy of a non-U.S. court decision regarding a U.K. patent that claims the same priority as the challenged patent. Medac timely objected to Exhibit 1042 under F.R.E. 401, 402, 403, 802, 901, and 37 C.F.R. § 42.61. (Paper 38 at 3). Petitioner relies on Exhibit 1042 to imply that because a foreign trial court rejected a U.K. patent with the same priority claim as the '231 patent, the challenged claims of the '231 patent must also be invalid. *See* Reply at 1. These statements and Exhibit 1042 should be excluded.

Exhibit 1042 is irrelevant and should not be admitted under F.R.E. 401, 402, and 403. The U.K. decision recited in Exhibit 1042 involved a different patent with different claims, different parties, different facts and witnesses, and different legal standards than those at issue here. Petitioner insinuates from Exhibit 1042 that the challenged claims of the '231 patent must also be invalid, but there is no

legal or factual basis for this argument. Even if Exhibit 1042 had any probative value here (which it does not), that value would be substantially outweighed by unfair prejudice to Medac because the U.K. patent or its claims and the art relied on in the U.K. decision are not in dispute or part of the record in this proceeding.

Exhibit 1042 should also be excluded as impermissible hearsay pursuant to F.R.E. 802. Petitioner offers that exhibit for the truth of the matters asserted; *i.e.*, the validity of the U.K. patent. No hearsay exception applies, however, to Exhibit 1042.

Exhibit 1042 should further be excluded due to lack of authentication under F.R.E. 901. Exhibit 1042 appears to be a printout of a webpage.

For these reasons, Exhibit 1042 should be excluded.

C. Exhibit 1043 Should be Excluded

Exhibit 1043 purports to be a copy of an online third-party news summary of a non-U.S. court decision regarding a Netherlands patent that claims the same priority as the challenged patent. Medac timely objected to Exhibit 1042 under F.R.E. 401, 402, 403, 802, 901, and 37 C.F.R. § 42.61. (Paper 38 at 4-5). As with Exhibit 1042, Petitioner improperly relies on Exhibit 1043 to imply that a foreign trial court's decision in the context of a Netherlands patent and its claims somehow makes it more likely than not that the challenged claims of the '231 patent are

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.