

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,

Petitioner

v.

HORIZON THERAPEUTICS, LLC,

Patent Owner

Case IPR2017-01159

Patent 9,254,278

PATENT OWNER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70(a) and the Board's Scheduling Order (Paper 11), the Patent Owner requests oral argument, which is currently scheduled for July 9, 2018. The Patent Owner expects to argue the following issues at the oral argument:

- (1) Whether the Petitioner has met its burden to show that claims 4-7 and 12-15 of U.S. Patent 9,254,278 ("the '278 patent") would have been obvious over Blau, Simell and the '859 Publication.
- (2) Whether the Petitioner has met its burden to show that claims 1-3 of the '278 patent would have been obvious over the '859 Publication.
- (3) Whether the Petitioner has met its burden to show that claim 8-11 of the '278 patent would have been obvious over Blau, Simell, the '859 Publication and the Brusilow '979 Patent.
- (4) Interpretations of the above-listed claims.
- (5) The level of ordinary skill in the art, the attributes of one of ordinary skill in the art at the time of the inventions claimed in the '278 Patent, and whether the Petitioner's expert, Dr. Vaux, has the requisite qualifications and knowledge of one of ordinary skill in the art of the claimed subject matter.
- (6) The Patent Owner's responses to arguments made by the Petitioner in its Reply (Paper 23), including but not limited to Petitioner's

assertions that the Patent Owner is collaterally estopped from contesting unpatentability of the challenged claims of the '278 patent and that certain findings made by the Board in the Final Written Decision in IPR2016-00829 should be entitled preclusive effect, and that Horizon has not offered any evidence in the instant IPR that justifies deviating from that decision.

- (7) Any other subsidiary issue relevant to issues (1) – (6).
- (8) Any other issues identified by the Patent Owner or the Petitioner for oral argument or any other issues raised in papers filed on or after this date.
- (9) Any other issues the Board deems necessary for issuing a final written opinion.

Respectfully submitted,

Date: May 25, 2018

By: / M. C. Phillips /

Matthew C. Phillips
Registration No. 43,403
Backup Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on May 25, 2018, copies of the foregoing PATENT OWNER'S REQUEST FOR ORAL ARGUMENT and all documents filed with it were served via electronic mail, as agreed to by counsel, upon the following counsel for Petitioner:

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By: *M. C. Phillips*

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