

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 B2)
Case IPR2017-01160 (Patent 9,326,966 B2)¹

Before DEBORAH KATZ, GRACE KARAFFA OBERMANN, and RAMA G.
ELLURU, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

ORDER
Sur-Reply
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in both cases. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2017-01159 (Patent 9,254,278 B2)

Case IPR2017-01160 (Patent 9,326,966 B2)

On May 18, 2018, the parties contacted the Board requesting a conference call to discuss the filing of sur-replies to Petitioner's Reply. (*See Appendix.*) Upon review of the record, we determine that a conference call is not necessary to decide the issues raised.

Patent Owner Horizon Therapeutics, LLC ("Horizon") requests authorization to file a sur-reply addressing Petitioner Lupin Ltd. And Lupin Pharmaceuticals, Inc. ("Lupin's") argument that, because of the preclusive effect of the Final Written Decision in IPR2016-00829, Horizon is collaterally estopped from contesting the patentability of the patents involved in the current proceedings. Horizon also requests authorization to address Lupin's argument that Horizon failed to present any new evidence in these proceedings that would justify changing our determinations in the Final Written Decision in IPR2016-00829

Because the issues of collateral estoppel and whether Horizon has presented new evidence in the instant proceedings were newly raised in Lupin's Replies to Horizon's Responses and Horizon has not had an opportunity to respond, authorization for Horizon to address these issues in sur-replies is GRANTED.

Lupin further requests authorization to file sur-surreplies to Horizon's sur-replies. At this time, authorization for Lupin to file sur-surreplies to Horizon's sur-reply on the issues above is DENIED because Lupin has already had an opportunity to brief the issues. Authorization may be provided after review of Horizon's sur-reply.

Horizon also requests authorization to address the relevance of the teachings of the Häberle reference (Ex. 2019), which Horizon cited in its Responses. Because Horizon had an opportunity to address the relevance of this reference in its Responses, authorization to address this issue in a sur-reply is DENIED.

Case IPR2017-01159 (Patent 9,254,278 B2)

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It is ORDERED that Horizon may file a sur-reply in each of the instant proceedings addressing only the arguments in Lupin's Petitioner Replies regarding collateral estoppel and whether Horizon has filed new evidence in these proceedings in light of the Final Written Decision in IPR2016-00829. The sur-replies may not exceed five pages and are due by June 8, 2018. No other papers are authorized at this time.

Case IPR2017-01159 (Patent 9,254,278 B2)

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Case IPR2017-01159 (Patent 9,254,278 B2)
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Appendix

From: mphillips@lpiplaw.com [<mailto:mphillips@lpiplaw.com>]

Sent: Friday, May 18, 2018 3:30 PM

To: Trials <Trials@USPTO.GOV>

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Subject: IPR2017-01159 and IPR2017-01160

Dear Board,

The patent owner, Horizon, would like to request permission to file surreplies to address the following aspects of the petitioner's replies filed May 11, 2018 (paper 23 in both cases):

- 1) That Horizon is collaterally estopped from contesting the unpatentability of the '278 and '966 patents and that certain of the Board's findings in its Final Written Decision in IPR2016-00829 should be entitled to preclusive effect.
- 2) That Horizon has not offered any new evidence that justifies changing the Board's findings in the Final Written Decision in IPR2016-00829.
- 3) The relevance of the teachings of the Häberle reference cited by Horizon in its Responses (Ex. 2019).

Horizon does not intend to file any new evidence with its surreplies.

The petitioner does not oppose Horizon's filing of surreplies limited to issue (1) above but does oppose surreplies that would address issues (2) or (3). The petitioner also requests permission to file responses to Horizon's surreplies. Horizon does not agree that sur-surreplies would be necessary or appropriate.

Counsel for the parties are available for a conference call, should the Board desire one, any time of day Tuesday, May 22.

Thank you for consideration of this request.

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