

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICRO LABS LIMITED AND MICRO LABS USA INC.  
Petitioners,

v.

SANTEN PHARMACEUTICAL CO., LTD. AND ASAHI GLASS CO., LTD.  
Patent Owners.

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Case IPR2017-01434  
U.S. Patent No. 5,886,035

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**PATENT OWNERS' MOTION TO EXCLUDE**

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## I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64 and the Scheduling Order governing this proceeding (Paper No. 12), Patent Owners Santen Pharmaceutical Co., Ltd. ("Santen") and Asahi Glass Co., Ltd. ("AGC") (together, "Patent Owners") respectfully move to exclude at least the following evidence submitted by Petitioners Micro Labs Limited and Micro Labs USA Inc. (together, "Petitioners") in connection with the present *Inter Partes* Review proceeding concerning U.S. Patent No. 5,886,035 ("the '035 Patent"): (1) ¶¶ 6-8, 10-71, 75-98 of Ex. 1031; (2) ¶¶ 20-33, 36-41, 48-73 of Ex. 1032; (3) Exs. 1033-1035, 1037-1038, 1040-1043, 1045-1060; (4) testimony in ¶¶ 16, 39, 43, 49, 50, 55, 57, 59, 69, 81, 82, 83, 85, and 86 of Ex. 1031 relating to Exs. 1040 and 1045-1060; (5) testimony in ¶¶ 24, 26, 27, 41, 44, 47, 49, 56, 57, 59, and 60 of Ex. 1032 relating to Exs. 1033-1035, 1037-1038, and 1040-1043; and (6) testimony at 117:23-118:23 of Ex. 2062.

## II. ARGUMENT

A. **¶¶ 10-70, 75-88, 91-98 of Ex. 1031 (Supplemental Declaration of Dr. deLong) and ¶¶ 23-28, 31-33, 36-41, 48-53, 55-62, 67-73 of Ex. 1032 (Supplemental Declaration of Dr. Rose) Should Be Excluded As Improper Incorporation By Reference**

In a transparent and improper attempt to supplement their deficient Petition, while avoiding the word-count limits for their Reply, Petitioners incorporate by reference into the Reply wide swaths of arguments and discussions found only in

the Supplemental Declarations of Dr. deLong (Ex. 1031) ("deLong Declaration") and Dr. Rose (Ex. 1032) ("Rose Declaration"). Paper 27 at 1-2 (Patents Owners' timely objections). Such incorporation by reference is improper. *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document."); 37 C.F.R. § 42.104(b)(5) ("The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge."); 37 C.F.R. § 42.61(a) ("Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible."); *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 7-10 (PTAB Aug. 29, 2014) (informative) (explaining that Rule 42.6(a)(3) prohibits incorporating by reference arguments from supporting declarations).

Notably, the deLong and Rose Declarations total 102 pages compared to Petitioners' 23-page Reply. The Board should not condone Petitioners' plain attempt to circumvent the word limit through improper incorporation of arguments from the Supplemental Declarations. *See* 37 C.F.R. § 42.24(c); *Conopco, Inc. v. Procter & Gamble Co.*, IPR2013-00510, Paper 9 at 8 (PTAB Feb. 12, 2014) ("We decline to consider information presented in a supporting declaration, but not discussed in a petition, because among other reasons, doing so would encourage the use of declarations to circumvent the page limits that apply to petitions.").

For the foregoing reasons and the reasons set forth below, at least ¶¶ 10-70, 75-88, and 91-98 of the deLong Declaration and ¶¶ 23-28, 31-33, 36-41, 48-53, 55-62, and 67-73 of the Rose Declaration should be excluded under 37 C.F.R. § 42.6(a)(3), 37 C.F.R. § 42.104(b)(5), and 37 C.F.R. § 42.61(a).<sup>1</sup>

1. ¶¶ 10-16, 75 of the deLong Declaration (Ex. 1031); ¶¶ 48-53 of the Rose Declaration (Ex. 1032)

At page 2 of the Reply, Petitioners contend that "Klimko's data shows that compound C has longer-lasting efficacy than the comparison compounds A, B and D." Petitioners' purported support for their argument is limited to two short paragraphs directly following that statement. Reply at 3. Petitioners, however, seek to improperly supplement their Reply by citing to 8 paragraphs of the deLong Declaration (¶¶ 10-16, 75)—spanning 8 pages—and 6 paragraphs of the Rose Declaration (¶¶ 48-53)—spanning 4 pages—which contain numerous arguments and discussions not found in the Reply.

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<sup>1</sup> Patent Owners submit that given the pervasiveness of Petitioners' improper incorporation by reference of arguments from the Declarations into the Reply, the Board should disregard Petitioners' Reply and Supporting Declarations in their entirety. As the Office Patent Trial Practice Guide states: "[T]he Board will not attempt to sort proper from improper portions of the reply." 77 Fed. Reg. 48,767 (Aug. 14, 2012).

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