Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO LABS LIMITED AND MICRO LABS USA INC.
Petitioners,

v.

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

Inter Partes Review No. IPR2017-01434
U.S. Patent No. 5,886,035

PETITIONERS' MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(c)

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Petitioners Micro Labs Limited and Micro Labs USA Inc. (together, "Petitioners") move to exclude Exhibits ("Exs.") 2023, 2027, 2034, 2038–2041, 2044, and 2047, in their entirety, and Paragraphs 8–26 of the Supplemental Declaration of Timothy L. Macdonald (Ex. 2028). On March 12, 2018, Petitioners timely objected to these exhibits (Paper No. 23, at 1–6), and Patent Owners failed to cure their deficiencies.

Petitioners further move to exclude Exs. 2056–2060 in their entirety, and portions of Drs. deLong's and Rose's second deposition testimony related to these exhibits to the extent that Patent Owners reply upon them in their forthcoming motion for observations or at oral argument. Patent Owners introduced Exs. 2056–2057, for the ***first*** time, during the July 12, 2018 (second) deposition of Petitioners' Reply expert Dr. deLong, and Exs. 2058–2060 during the July 16, 2018 (second) deposition of Petitioners' Reply expert Dr. Rose. Petitioners note that Exs. 2056–2060 are not part of the record to date. These exhibits and their related cross-examination testimony were outside the scope of Dr. deLong and Dr. Rose's supplemental declarations. Petitioners' counsel properly made objections on the record during each deposition. To the extent Patent Owners seek to enter Exs. 2056–2060 into evidence or otherwise attempt to rely on them in their

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Observations or at oral argument, these exhibits, any related cross-examination testimony, and any argument related to them should be excluded.

II. ARGUMENT

A. Exhibit 2023

Ex. 2023 is U.S. Patent No. 5,977,173 to Wos *et al*. Patent Owners improperly relied on Ex. 2023 as prior art evidence in their Response that, as of December 26, 1996, the POSA knew that prostaglandins bind to multiple receptors to varying degrees. (Paper No. 22 at 10–11.) But on its face, Ex. 2023 states that it was issued November 2, 1999 based on an application filed September 4, 1998, which claims priority to a provisional application filed September 9, 1997. Therefore, Ex. 2023 is not evidence of the level of knowledge of the POSA in December 1996. Ex. 2023 should be excluded under Fed. R. Evid. 401, 402, and 403.

B. Exhibit 2027

Ex. 2027 purports to be a Canadian court opinion in *Alcon Canada Inc. v. Apotex Inc.*, 2014 FC 699 (Fed. Ct. CA, 2014) that appears to make reference to some of Petitioners' expert Dr. deLong's opinions related to the issue of the validity of Canadian Letters Patent No. 2,129,287 ("Canadian '287 patent") under the Canadian Patent Law. Patent Owners relied on paragraphs 11, 47, 122, 233, 314, 315, 357, 432, 434, and 465 of Ex. 2027 in their Response. (*See* Paper No. 22, at 5, 47–50). As explained below, Petitioners move to exclude Ex. 2027, and

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Patent Owners' reference to or reliance thereon in this proceeding, under Fed. R. Evid. 106, 401, 402, 403, 801, 802, 805 and 901.

Ex. 2027 should be excluded in its entirety under Fed. R. Evid. 401 and 402 because it is irrelevant: it is a foreign court decision resolving an issue under foreign law involving a Canadian patent ***unrelated*** to the challenged patent—U.S. Patent No. 5,886,035 ("the '035 patent") —in this proceeding. Neither the Petition nor Dr. deLong's first declaration cited Ex. 2027. To the extent Ex. 2027 is offered by Patent Owners to support an alleged contradiction between Dr. deLong's testimony in this proceeding and his opinion regarding compound C submitted in the Canadian proceeding, Ex. 2027 is wholly irrelevant. This is because the analysis and conclusions in the Canadian proceeding, including Dr. deLong's alleged statements therein, addressed a different issue under foreign law: whether the Canadian '287 patent (a counterpart of Klimko but with ***different*** claims) is a "selection patent," and has novelty ("inventive concept") advantage over or is anticipated by European Patent Application EP 0364417 ("Stjernschantz," Ex. 2017) under the Canadian Patent Act. (*See, e.g.*, Ex. 2027, at ¶¶ 32, 161, 286).

At issue in this case is whether, as of December 1996, compound C would be selected by a person of ordinary skill in the art ("POSA") (defined under the U.S. patent law) as a lead compound *for further modification and development*.

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