

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' OPPOSITION TO PATENT OWNERS'
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I. Introduction

Patent Owners' purported "motion to exclude" is an improper and belated attempt to make a procedural objection to Petitioners' alleged non-compliance with the word count limit, based on the erroneous premise that Petitioners somehow incorporated "arguments" by reference. Patent Owners did not identify a single argument that is allegedly incorporated by reference as there are none. Further, any objection that a paper does not comply with the word limit must be promptly raised with the Board; such an objection is not the proper basis for a motion to exclude *evidence*. Patent Owners' motion should be denied.

II. Petitioners' reliance on expert declaration testimony evidence in their Reply does not incorporate arguments by reference.

Patent Owners' purported "motion to exclude" is wrong on the merits and should be denied. Petitioners relied on their expert declarations as evidence in support of the arguments made in Petitioners' Reply. Such reliance on expert declaration testimony is proper because "[d]eclaration testimony generally is regarded as evidence, not argument. . . . There is no meaningful occasion to consider whether a declaration has been 'effectively incorporated by reference.' Impermissible incorporation by reference . . . applies to non-evidentiary papers." *Research in Motion Corp. v. Multimedia Ideas LLC*, IPR2013-00036, Paper 15 at 7 (PTAB Mar. 18, 2013).

Further, Patent Owners failed to comply with Rule 42.64(b)(1), which

requires the grounds for their objection be stated “with sufficient particularity to allow correction in the form of supplemental evidence.” 37 C.F.R. § 42.64 (b)(1).

Patent Owners did not point out, in their objections (Paper 27) or their motion (Paper 32), a single argument that is allegedly incorporated by reference in the Reply. Instead, Patent Owners generally assert that there are arguments in Petitioners’ declarations that are not in their Reply. (*See, e.g.*, Paper 32, at 5.)

Such vague and conclusory assertions are insufficient for Patent Owners to meet their burden. *See Research in Motion Corp.*, Paper 15 at 8 (rejecting “the patent owner conten[tion] that . . . the declaration testimony contains numerous arguments in addition to factual support for arguments made in the petition. . . . [when] patent owner has not identified separately the factual portions of the declaration apart from the argument portions and thus has not established that the argument portion exceeds [the page limit]”); 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”)

A. ¶¶ 10–70, 75–88, 91–98 of Ex. 1031 and ¶¶ 23–28, 31–33, 36–41, 48–53, 55–62, 67–73 of Ex. 1032.

Contrary to Patent Owners’ assertion, Petitioners made their arguments explicitly in the text of their Reply and cited to specific supporting expert testimony for their arguments. Petitioners’ use of terms like “as explained in his declaration,” does not mean that arguments are incorporated by reference. Nor do Petitioners’ citations to several paragraphs of supporting expert testimony amount

to impermissible incorporation by reference. *See Chervon v. Milwaukee*, IPR2015-00597, Paper 79 at 18–19 (PTAB July 28, 2016) (refusing to find petitioner’s citations to expert declarations to support arguments made in its reply improper incorporation by reference when petitioner cites 10–15 paragraphs of expert declarations).

Patent Owners’ reliance on two Board decisions, *Cisco* and *Conopco*, is mistaken. In *Cisco Sys. Inc. v. C-Cation Techs., LLC*, the petitioner, in an effort to compact five asserted grounds for unpatentability into only seven pages, the petitioner used five footnotes to cite large portions of expert declarations, including pages of claim charts, to support either topical section headings or broad legal conclusions, without any explanation of those cited portions. IPR2014-00454 Paper 12 at 7–8 (PTAB Aug. 29, 2014) (informative). But here, Petitioners made every one of their arguments explicitly in their Reply, and every argument cites to the specific expert declaration testimony that supports the argument. Nowhere does Petitioners’ Reply in this proceeding cite to declaration testimony in connection with broad legal conclusions or topical headings. Patent Owners’ reliance on *Cisco* is therefore misplaced.

Conopco, Inc. v. Procter & Gamble Co., IPR2013-00510, Paper 9 at 8 (PTAB Feb. 12, 2014) is also inapposite. The issue in that case was whether the claimed “charge density” limitation was inherently disclosed by “Reid,” an

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