

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' UPDATED EXHIBIT LIST

In accordance with the Patent Trial and Appeal Board's November 29, 2017 Order (Paper No. 11), pp. 5–6, n.1, n.2, Petitioners submit two new exhibits, Ex. 1029 and Ex. 1030.

The content of Exhibit 1029 is the same as Ex. 1006 (“Ueno”), except for the addition of two new declarations at the end in compliance with 37 C.F.R. §§ 1.68 and 42.63(b). One declaration is sworn by the same person who submitted the original certification, Hannah Mendoza, the project manager for the translation. The second declaration is sworn by a member of the translation team personally attesting to the accuracy of the translation, Frank McGee.

The content of Exhibit 1030 is the same as Ex. 1007 (“Bezuglov 1982”), except for the addition of two new declarations at the end in compliance with 37 C.F.R. §§ 1.68 and 42.63(b). One declaration is sworn by the same person who submitted the original certification, Sarah Faup (whose last name has since become Hall), the project manager for the translation. The second declaration is sworn by a member of the translation team personally attesting to the accuracy of the translation, Keith Blasing.

Petitioners provide an updated exhibit list below:

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	Document
1001	U.S. Patent No. 5,886,035 to Shirasawa <i>et al.</i> (issued March 23, 1999).
1002	File History of U.S. Patent No. 5,886,035.
1003	EP0639563A2 to Klimko <i>et al.</i> (published February 22, 1995).
1004	EP0471856A1 to Kishi <i>et al.</i> (published February 26, 1992).
1005	U.S. Patent No. 5,292,754 to Kishi <i>et al.</i> (issued March 8, 1994).
1006	JP-A-7070054 to Ueno Japan <i>et al.</i> (published March 14, 1995).

1007	Bezuglov, V. V. & L. D. Bergelson, "Fluoroprostaglandins—A New Class of Biologically Active Analogues of Natural Prostaglandins" in Lipids of Biological Membranes (L.D. Bergelson, ed., 1982).
1008	Bezuglov, Vladimir V. "Fluorodeoxy Prostaglandins, Synthesis and Perspectives" in Prostaglandins and Cardiovascular Diseases (Takayuki Ozawa et al. eds., 1986).
1009	Camras et al. "Reduction of intraocular pressure in normal and glaucomatous primate (<i>Aotus trivirgatus</i>) eyes by topically applied PGF ₂ □," <i>Curr. Eye Res.</i> 1:205-209 (1981).
1010	Stjernschantz, J.W. "From PGF ₂ □-Isopropyl Ester to Latanoprost: A Review of the Development of Xalatan," <i>Investig. Ophthalm. & Vis. Sci.</i> 42(6):1134-1145 (2001).
1011	Nixon, D. "Hyperemia in Glaucoma Patients," (2008) available online at http://www.medscape.org/viewarticle/577054 .
1012	PCT/US97/20671 to Klimko et al. (published May 22, 1998).
1013	U.S. Provisional Patent Application No. 60/030,519 to Klimko et al. (made accessible as of May 22, 1998).
1014	Alm A 1989 <i>Progress in Clin and Biological Research</i> pg 447-458.
1015	Stjernschantz J 1992 <i>Drugs of the Future</i> 691-704.
1016	Product Details for NDA 020597 (XALATAN) available online at https://www.accessdata.fda.gov/scripts/cder/ob/results_product.cfm?Appl_Type=N&Appl_No=020597 .
1017	Patent and Exclusivity for: N202514 (ZIOPTAN) available online at https://www.accessdata.fda.gov/scripts/cder/ob/patent_info.cfm?Product_No=001&Appl_No=202514&Appl_type=N .
1018	Lee, P.Y. et al., "The effect of prostaglandin F ₂ alpha on intraocular pressure in normotensive human subjects," <i>Invest. Ophthalmol. Vis. Sci.</i> Oct. 29(10):1474–1477 (1988).
1019	Camras, C.B. et al., "Maintained reduction of intraocular pressure by prostaglandin F ₂ alpha-1-isopropyl ester applied in multiple doses in ocular hypertensive and glaucoma patients," <i>Ophthalmology</i> Sep. 96(9):1329–1337 (1989).

1020	Nilsson, S.F. et al., "Increased uveoscleral outflow as a possible mechanism of ocular hypotension caused by prostaglandin F2 alpha-1-isopropylester in the cynomolgus monkey," <i>Exp. Eye Res.</i> May 48(5):707-716 (1989).
1021	Pederson, J.E. et al., "Laser-induced primate glaucoma. I. Progression of cupping," <i>Arch. Ophthalmol.</i> Nov. 102(11):1689-92 (1984).
1022	Radius, R.L. et al., "Laser-induced primate glaucoma. II. Histopathology," <i>Arch. Ophthalmol.</i> Nov. 102(11):1693-8 (1984).
1023	Lee, P.Y. et al., "Pharmacological testing in the laser-induced monkey glaucoma model," <i>Curr. Eye Res.</i> Jul. 4(7):775-81 (1985).
1024	Bito, L.Z. "Species differences in the responses of the eye to irritation and trauma: a hypothesis of divergence in ocular defense mechanisms, and the choice of experimental animals for eye research," <i>Exp. Eye Res.</i> Dec. 39(6):807-29 (1984).
1025	U.S. Patent No. 3,914,265 to Middleton (issued October 21, 1975).
1026	Nelson, N.A. "Prostaglandin Nomenclature," <i>J. Med. Chem.</i> 17(9):911-918 (1974).
1027	Declaration of Mitchel deLong, Ph.D
1028	Declaration of Aron D. Rose, M.D.
1029	Exhibit 1006 (JP-A-7070054 to Ueno Japan et al. (published March 14, 1995) ("Ueno")) with affidavits in compliance with 37 C.F.R. §§ 42.63(b) and 1.68, as required by the Board in its November 29, 2017 Order (Paper No. 11), pp. 5-6, n.1.
1030	Exhibit 1007 (Bezuglov, V. V. & L. D. Bergelson, "Fluoroprostaglandins—A New Class of Biologically Active Analogues of Natural Prostaglandins" in <i>Lipids of Biological Membranes</i> (L.D. Bergelson, ed., 1982) ("Bezuglov 1982")) with affidavits in compliance with 37 C.F.R. §§ 42.63(b) and 1.68, as required by the Board in its November 29, 2017 Order (Paper No. 11), p. 6, n.2.

Dated: December 11, 2017

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