

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.

Petitioner

v.

UNITED THERAPEUTICS CORP.

Patent Owner

Patent No. 9,358,240

Issue Date: June 7, 2016

Title: TREPROSTINIL ADMINISTRATION BY INHALATION

Inter Partes Review No. 2017-01621

**PATENT OWNER'S OPPOSITION TO PETITIONER'S COMBINED
MOTION**

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TABLE OF AUTHORITIES

CASES

Garmin Int'l, Inc. v. Cuozzo Speed Techs., LLC, IPR2012–00001 (PTAB Mar. 5, 2013)1, 8

Redline Detection, LLC v. Star Envirotech, Inc., 811 F. 3d 435 (Fed. Cir. 2015)1

Trovan, Ltd. v. Sokymat SA, Irori, 299 F.3d 1292 (Fed.Cir.2002)6

REGULATIONS

37 C.F.R. § 1.47(a).....6

37 C.F.R. § 42.1231

37 C.F.R. § 42.511

EXHIBITS CITED

Exhibit No.	Description
2201	Claims of Abandoned U.S. Application No. 11/748,205
2202	Inventor Oaths filed in U.S. Application No. 12/591,200 (granted as the '240 patent) and U.S. Application No. 13/469,854 (granted as the '507 patent)
2203	Dismissal of Complaint of Dr. Lewis Rubin and Motion for Attorney's Fees
2204	Excerpts from Deposition of Dr. Lewis Rubin

I. INTRODUCTION

Patent Owner opposes Petitioner's request to submit three exhibits as supplemental information and to obtain an unredacted copy of one of the three exhibits. None of the three exhibits is relevant to the issue identified by Petitioner or to a claim for which the trial has been instituted.

II. LEGAL STANDARDS

A party filing a motion to submit supplemental information must show that the supplemental information is "relevant to a claim for which the trial has been instituted." 37 C.F.R. § 42.123. Even if this condition is met, the Board may exercise its discretion and deny the motion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F. 3d 435, 446 (Fed. Cir. 2015).

A party requesting additional discovery bears the burden of demonstrating it is "in the interests of justice." 37 C.F.R. § 42.51. To determine whether to grant the motion, the Board considers the five *Garmin* factors, *i.e.*, whether the request: (1) is based on more than a mere possibility of finding something useful; (2) seeks the other party's litigation positions or the basis for those positions; (3) seeks information that reasonably can be generated without the discovery request; (4) is easily understandable; and (5) is overly burdensome to answer. *Garmin Int'l, Inc. v. Cuozzo Speed Techs., LLC*, IPR2012-00001, Paper 26, 6-7 (PTAB Mar. 5, 2013).

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