

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioners,

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner.

Case IPR2017-01767 (Patent 9,254,278 B2)
Case IPR2017-01768 (Patent 9,095,559 B2)
Case IPR2017-01769 (Patent 9,326,966 B2)¹

Before TONI R. SCHEINER, DEBORAH KATZ, GRACE KARAFFA
OBERMANN, and RAMA G. ELLURU, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

ORDER
Briefing on Evidence in Sur-Reply
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in the three cited cases.
The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2017-01767 (Patent 9,254,278 B2)

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On August 23, 2018, Patent Owner Horizon Therapeutics, LLC (“Horizon”) contacted the Board by e-mail regarding filing sur-replies in response to replies filed by Petitioner Par Pharmaceutical, Inc. (“Par”) in each of the three instant proceedings. Horizon reported that Par did not oppose the filing of sur-replies by Horizon in lieu of motions for observation on cross-examination.

We authorized Horizon to file a sur-reply in these proceedings. (*See* IPR2017-01767, Paper 37; IPR2017-01768, Paper 36; IPR2017-01769, Paper 37 (“Order authorizing sur-replies”).)

In the e-mail of August 23, 2018, Horizon also sought confirmation that it may discuss and include as an exhibit in its sur-replies, a declaration of Dr. Sondheimer filed by Par in a different proceeding (*Inter Partes* Review of U.S. Patent No. 9,561,197 (IPR2018-01550, Ex. 1002) (“the Sondheimer ’197 declaration”). At that time Horizon asserted that the Sondheimer ’197 declaration contains testimony that is “relevant” to Dr. Sondheimer’s opinions in the instant proceedings. Horizon reported that Par opposes the submission of the Sondheimer declaration from IPR2018-01550 as an exhibit to Horizon’s sur-reply.

We did not authorize Horizon to include the Sondheimer ’197 declaration in its sur-reply because Horizon will have an opportunity to elicit any information relevant to these proceedings when it cross-examines Dr. Sondheimer. (*See* IPR2017-01767, Paper 37; IPR2017-01768, Paper 36; IPR2017-01769, Paper 37.)

On September 6, 2018, Horizon again contacted the Board, this time asserting that the Sondheimer ’197 declaration contains testimony that is “inconsistent” with Dr. Sondheimer’s positions in the instant proceedings. Horizon requested reconsideration of our Order denying authorization to submit the Sondheimer ’197 declaration with its sur-reply.

Case IPR2017-01767 (Patent 9,254,278 B2)

Case IPR2017-01768 (Patent 9,095,559 B2)

Case IPR2017-01769 (Patent 9,326,966 B2)

On September 7, 2018, Par sent an e-mail to the Board asking that Horizon's e-mail, and the attached Federal Circuit opinion, be disregarded as containing improper substantive argument.

Nevertheless, we authorize briefing for the limited purpose of completing the record regarding Horizon's current assertion that the Sondheimer '197 declaration is inconsistent with Dr. Sondheimer's positions in the instant proceedings.

Accordingly, it is ORDERED that Horizon is AUTHORIZED to file a request for reconsideration of our Order authorizing sur-replies, explaining how the Sondheimer '197 declaration is inconsistent with Dr. Sondheimer's positions in the instant proceedings and how this inconsistency is relevant to the issues in dispute between the parties in the instant proceedings;

It is further ORDERED that any request for reconsideration filed by Horizon may not exceed three pages and must be filed by September 11, 2018;

It is further ORDERED that Par is AUTHORIZED to file an opposition to Horizon's request;

It is further ORDERED that any opposition filed by Par may not exceed three pages and must be filed by September 17, 2018;

It is further ORDERED that neither party may file any evidence with the papers authorized herein, including the Sondheimer '197 declaration;

It is further ORDERED that the due date for Horizon's sur-reply is suspended and will be rescheduled when a decision on the parties' briefing is issued; and

It is further ORDERED that no other briefing or argument is authorized at this time.

Case IPR2017-01767 (Patent 9,254,278 B2)

Case IPR2017-01768 (Patent 9,095,559 B2)

Case IPR2017-01769 (Patent 9,326,966 B2)

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