UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLATWING PHARMACEUTICALS, LLC and
MYLAN PHARMACEUTICALS, INC.,
Petitioners,

v.

ANACOR PHARMACEUTICALS, INC.,
Patent Owner.

Case No. IPR2018-00168
(Joined with IPR2018-01358)

U.S. Patent No. 9,549,938

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE[1]

February 8, 2019

[1] Corresponding oppositions to Patent Owner's motions to exclude filed in related proceedings IPR2018-00169 (U.S. Patent No. 9,566,289, joined with IPR2018-01359), IPR2018-00170 (U.S. Patent No. 9,566,290, joined with IPR2018-01360), and IPR2018-00171 (U.S. Patent No. 9,572,823, joined with IPR2018-001361) are substantially the same as this opposition, with citations adjusted to cite correctly the record in each proceeding.

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INTRODUCTION

Patent Owner's Motion To Exclude, Paper 23 (hereinafter "*PO Mot. Excl.*") asserts an erroneous and contradictory standard. Patent Owner at various points contends that rebuttal evidence must both (1) be exactly the same as the evidence offered in support of the petition and (2) must not have been previously known to the petitioner. Neither is correct. Rebuttal evidence simply expounds upon evidence from the petition that established a prima facie case, in rebuttal to those parts of the case to which Patent Owner has chosen to respond. For the reasons explained below, the entirety of Dr. Murthy's testimony (Ex. 1048) is proper rebuttal testimony and no part of it should be excluded.

DISCUSSION

I. PATENT OWNER'S MOTION EXCEEDS THE SCOPE OF ANY OBJECTIONS.

As a preliminary matter, Patent Owner's motion is procedurally improper because it encompasses testimony to which Patent Owner never objected in the first place. Patent Owner's motion seeks to exclude ***all*** of Dr. Murthy's rebuttal testimony by seeking to exclude all of Ex. 1048. (*PO Mot Excl.* at 2, Paper 23.) But Patent Owner objected only to certain particular paragraphs in Dr. Murthy's rebuttal testimony declaration, specifically ¶¶ 2–5, 10, 12, and 17–19. (*Patent Owner's Objections To Petitioner's Evidence* at 2, Paper 20 (hereinafter "*PO Obj*".).) Patent Owner never objected to ¶¶ 1, 6–9, 11, 13–16, and 20.

Here Patent Owner objected to only ten (10) specifically identified paragraphs out of twenty (20) paragraphs in the declaration, but now seeks to exclude all twenty, including those to which it never objected. This is not a situation where a party is calling on the Board to "attempt to sort proper from improper portions of the reply." *See* Office Patent Trial Practice Guide, 77 Fed.Reg. 48,756, 48,767 (Aug. 14, 2012). Nothing here requires or supports wholesale exclusion of the entire declaration. *E.g.*, *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) ("Nothing in the Guide requires wholesale exclusion in such circumstances."). Unlike a situation where the Board may decline to consider certain paragraphs specifically cited, e.g., *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 775 (Fed. Cir. 2018) ("The Board did not abuse its discretion in declining to consider the cited paragraphs in Dr. Karger's reply declaration."), it would be contrary to regulation and an abuse of discretion to exclude testimony to which Patent Owner did not make ***any*** objection on the record. 37 C.F.R. § 42.64(c) ("The motion must identify the objections in the record in order and must explain the objections."); *see also, Nintendo of America Inc. v. Motion Games, LLC*, No. IPR2014-00164, 2015 WL 2395487, *15 (P.T.A.B. May 15, 2015) ("Patent Owner's Motion to Exclude also is deficient procedurally.").

Moreover, Patent Owner has cited nothing in the Federal Rules of Evidence

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