

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. IPR2018-00170
(Joined with IPR2018-01360)

U.S. Patent No. 9,566,290

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S MOTION TO EXCLUDE¹**

February 8, 2019

¹ Corresponding oppositions to Patent Owner's motions to exclude filed in related proceedings IPR2018-00168 (U.S. Patent No. 9,549,938, joined with IPR2018-01358), IPR2018-00169 (U.S. Patent No. 9,566,289, joined with IPR2018-01359), 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.

TABLE OF CONTENTS

Table of Contents i

Table of Authorities ii

Introduction.....1

Discussion.....1

I. Patent Owner’s Motion Exceeds the Scope of Any Objections.....1

II. Dr. Murthy’s Testimony About Obviousness And Routine Experimentation In Dose Ranging Studies Is Proper Rebuttal.3

 A. *Presenting Additional Evidence More Specifically Addressing An Issue That Patent Owner Contests Is Proper Rebuttal.*4

 B. *Dr. Murthy’s Testimony About The Prior Art Disclosures Of Dose Ranges And About Dose Ranging As Routine Experimentation Responds To Testimony From Dr. Lane And Dr. Reider.*.....7

 C. *Patent Owner Has Had A Full And Fair Opportunity To Respond To Dr. Murthy’s Testimony* 10

III. Patent Owner Mischaracterizes Petitioner’s Position Regarding Samour, Which Does Not Teach Away From 5%.11

Conclusion.....13

Certificate of Service.....15

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Acceleration Bay, LLC v. Activision Blizzard Inc.</i> , 908 F.3d 765 (Fed. Cir. 2018)	2
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	2, 4, 6, 10, 11
<i>Nintendo of America Inc. v. Motion Games, LLC</i> , No. IPR2014-00164, 2015 WL 2395487 (P.T.A.B. May 15, 2015)	2
<i>Parrot S.A. v. QFO Labs, Inc.</i> , No. IPR2016-01550, 2017 WL 4315224 (P.T.A.B. Sept. 22, 2017)	3

OTHER AUTHORITIES

Office Patent Trial Practice Guide, 77 Fed.Reg. 48,756 (Aug. 14, 2012)	2, 4, 5, 9
---------------------------------------------------------------------------------	------------

REGULATIONS

37 C.F.R. § 42.62	3
37 C.F.R. § 42.64	2

INTRODUCTION

Patent Owner's Motion To Exclude, Paper 25 (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 25.) 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 22 (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

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.