UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ANACOR PHAMACEUTICALS, INC.,
Patent Owner.

Case No. IPR2018-00170[1]
U.S. Patent No. 9,566,290

AMENDED REPLY IN SUPPORT OF
PATENT OWNER'S MOTION TO EXCLUDE

[1] Case No. IPR2018-01360 has been joined with this proceeding

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Anacor is *not* insisting, as FlatWing contends, that reply evidence "be exactly the same" as the evidence cited in a petition. Nor is it Anacor's position that reply evidence "must not have been previously known" to a petitioner. Anacor's position is simply that, pursuant to 37 C.F.R. § 42.23(b), reply evidence must be "responsive." FlatWing's opposition (Paper 32, "Opp.") states that Dr. Murthy's reply declaration (Ex. 1048) "elaborate[s]" or "expounds" upon the arguments raised in FlatWing's petition. Opp. at 1, 6. But regardless of how FlatWing now attempts to characterize it, FlatWing was required to provide its explanation of its grounds for invalidity with its petition, which makes Dr. Murthy's reply declaration an improper attempt to supplement his prior opinions. Anacor's motion to exclude (Paper 25, "Mot.") should be granted.

ARGUMENT

I. Dr. Murthy's Reply Declaration Is Not Responsive

FlatWing's own characterization of Dr. Murthy's rebuttal testimony admits that it "elaborate[s]" and "expounds upon [FlatWing's] prima facie case." Opp. at 6. But, FlatWing and its declarants were required state their case fully as part of FlatWing's petition for *inter partes* review. Their failure to do so renders such evidence untimely and improper supplementation. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016).

That Dr. Murthy cites to Dr. Lane's testimony to frame his rebuttal testimony does not establish that his opinions are responsive. *See* Opp. at 7–9. In its Patent Owner's Response, Anacor and its experts explained that the cited art teaches away from the 5% limitation and that a POSA would have understood experimentation with boron-containing compounds to be anything but routine due to boron's "unique" chemistry and the lack of experience in the art. *See* Lane Decl. (Ex. 2014) ¶¶ 71–79; Reider Decl. (Ex. 2013) ¶¶ 72–75. Instead of responding to either of these points, Dr. Murthy reiterated the ranges in the cited art and for the first time asserted that Anacor's own work was evidence supporting his earlier opinions regarding "routine experimentation." Murthy Reply Decl. (Ex. 1048) ¶¶ 5, 10, 12; *id.* ¶¶ 17–19 (providing a new discussion of Exhibit 1040). In other words, Dr. Murthy did not engage the opinions of Anacor's experts, but instead introduced new concepts in an effort to buttress his previous opinions.

FlatWing seeks to justify Dr. Murthy's improper supplementation by relying on the proposition that "[e]vidence admitted in rebuttal to respond to the patent owner's criticisms will commonly confirm the prima facie case." *Belden, Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). But *Belden* does not give petitioners carte blanche to supplement the evidentiary record, *see Intelligent Bio-Systems*, 821 F.3d at 1369–70, and in fact illustrates the granular level of detail that can be generally expected of proper reply evidence. *See Belden*, 805 F.3d at 1078

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