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. IPR2018-00171[1]
U.S. Patent No. 9,572,823

REPLY IN SUPPORT OF PATENT OWNER'S MOTION TO EXCLUDE

[1] Case No. IPR2018-01361 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 30, "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. Under these circumstances, the exclusion of Dr. Murthy's reply declaration in its entirety is an appropriate remedy. Anacor's motion to exclude (Paper 23, "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 of the record. *See Intelligent*

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Bio-Systems, Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim." (quoting 35 U.S.C. § 312(a)(3)).

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. As explained in Anacor's motion, Dr. Murthy's opening declaration in support of FlatWing's petition asserted that a person of ordinary skill in the art ("POSA") would have combined Austin and Brehove or Freeman with Samour because "Samour teaches . . . similar concentration ranges of active antifungal ingredient as taught in Austin and Brehove [and Freeman]." Murthy Decl. (Ex. 1005) ¶¶ 138, 194. According to FlatWing and Dr. Murthy, this would have motivated a POSA to "substitute [tavaborole] . . . for the higher molecular weight compound disclosed in the Samour formulation." *Id.* ¶¶ 140, 196. Dr. Murthy also opined that "[f]ormulating pharmaceutical compositions involves nothing more than routine experimentation based on well-known protocols." *Id.* ¶¶ 138, 194. In 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"

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