

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC and AMNEAL
PHARMACEUTICALS OF NEW YORK, LLC,
Petitioners

v.

ALMIRALL, LLC,
Patent Owner

Case IPR2019-00207
Patent 9,517,219

**PATENT OWNER ALMIRALL, LLC'S SUR-REPLY
PURSUANT TO ORDER [PAPER 9]**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	International Patent Application Publication No. WO 2009/108147 ("Garrett 2")
2002	International Patent Application Publication No. WO 2010/105052 ("Hani")
2003	Redline Comparison of Petitions in IPR2018-00608 and IPR2019-00207
2004	Redline Comparison of Michniak-Kohn Declarations in IPR2018-00608 and IPR2019-00207
2005	Redline Comparison of Gilmore Declarations in IPR2018-00608 and IPR2019-00207
2006	Petitioner's Notice of Paragraph IV Certification to PO (February 22, 2019) (truncated)

The issue before the Board remains whether it should exercise its denial discretion under §§ 314(a) and/or 325(d). This Petition presents the opportunity for the Board to clarify that AIA proceedings are not test-vehicles to be gamed or gimmicked – not least by Petitioners, as here, maintaining parallel validity challenges under the Hatch-Waxman scheme.

Two paramount questions remain unmeaningfully answered by Petitioner: (1) what explains its delay in bringing this Petition relative to the earlier-instituted, virtually identical IPR of its '926 parent?; and (2) where does the Reply “correct” any “admissions in the Petition that Petitioners’ duty of candor [so] obligates”—*i.e.*, the very premise represented to the Board as justifying its extended briefing request? Where made at all, Petitioner’s unresonant responses to these questions solidify the most reasonable inference: that Petitioner *purposefully* staggered the two petitions—identical in Grounds, extensively *verbatim* in supporting argument and evidence, and targeting claims asserted as reciting “identical” compositions. Petitioner clearly did so to gain a tactical advantage at the expense of, and without regard for, the resources or convenience of Patent Owner (“PO”), not to mention the Board (Factor 6). Instituting this IPR “would require the Board to conduct an entirely separate proceeding involving numerous issues that have been considered already... The result would be a significant waste of the Board’s resources.” *NetApp Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9, p. 13 (October 12, 2017).

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