

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDOZ INC.,
Petitioner,

v.

PHARMACYCLICS LLC,
Patent Owner.

Case IPR2019-00865
U.S. Patent No. 9,795,604

**PATENT OWNER'S REPLY IN SUPPORT
OF MOTION TO STRIKE**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

The Reply improperly raised new anticipation *theories* based on newly cited evidence. *See* PTAB Trial Practice Guide, 48767. While the Petition acknowledged that anticipation can be shown explicitly or inherently (Pet., 32), Petitioner presented *only* a legally incorrect anticipation theory for claims 4, 13, and 15 (*id.*, 38-39) and relied *solely* on inherency for claims with efficacy limitations (*id.*, 39-40). Patent Owner’s debunking of Petitioner’s original arguments (POR, 16-21) does not justify entirely *new* theories. *See Henny Penny*, 938 F.3d at 1329.

Petitioner’s cited cases do not compel a different conclusion. None of these cases involved new theories of unpatentability. For example, in *Unified Patents*, the Board stated (Paper 51, 50) that each allegedly new argument aligned directly with the Petition. Petitioner here makes no such showing—at best pointing only to an argument about a *different* “base” claim. Paper 26, 3. Further, while the reply arguments and evidence in *Juniper*, *Idemitsu*, and *Hynix* were not formally struck, they were given little to no weight. *Juniper*, 77-78; *Idemitsu*, 1381; *Hynix*, 30-31. The Board should strike, or at a minimum disregard, Petitioner’s new arguments.

Finally, Patent Owner is prejudiced—counsel could not prepare to cross Dr. Ferrara on these issues, and Dr. Koreth had no opportunity to specifically address Petitioner’s new theories of anticipation. EX2055, ¶90 (referencing newly-cited ¶¶[0121] and [0124] only in passing). The Board should not engage in fact-finding without proper expert analysis. *See Idemitsu*, 870 F.3d at 1381.

Respectfully submitted,

Date: June 12, 2020

By: _____ / *William B. Raich* / _____
William B. Raich, Reg. No. 54,386

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Reply in Support of Motion to Strike** was served electronically via email on June 12, 2020, in its entirety on the following:

Kirk T. Bradley
Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, NC 28280
kirk.bradley@alston.com

Siraj M. Abhyankar
Alston & Bird LLP
1201 W. Peachtree Street NE #4900
Atlanta, GA 30309
shri.abhyankar@alston.com

Christopher L. McArdle
Alston & Bird LLP
90 Park Avenue, Suite 1200
New York, NY 10016
chris.mcardle@alston.com

Petitioner has consented to service by email.

Date: June 12, 2020

By: / William Esper /
William Esper
Legal Assistant

Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP