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Paper 14
Date: August 20, 2020

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.

IPR2019-00207[1]
Patent 9,517,219 B2

Before SUSAN L. C. MITCHELL, CHRISTOPHER G. PAULRAJ, and RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

CONDUCT OF THE PROCEEDING
Expunging Unauthorized New Evidence
37 C.F.R. § 42.7

[1] Cases IPR2019-00207 and IPR2019-01095 have been joined in this proceeding. Herein, we refer to both joined cases.

A Final Decision was entered in this *inter partes* review on May 29, 2020. Paper 58. Subsequent thereto, Patent Owner filed a Request for Rehearing under 37 C.F.R. § 42.71(d) (Paper 61, "Request for Rehearing"), and therewith new Exhibits 2071 and 2072. The Board denied Patent Owner's Request for Rehearing. Paper 62.

By email on May 21, 2020, Petitioner requested that these two aforementioned exhibits be expunged from the record, stating:

> In view of the Board's Decision Denying Patent Owner's Request for Rehearing, Petitioners respectfully request that the Board expunge Exhibits 2071 and 2072 from the record. Exhibits 2071 and 2072 were not of record at the time Patent Owner filed its Request for Rehearing on June 29, 2020, and Patent Owner has not made a showing of "good cause" to admit this new evidence into the record. Because Exhibits 2071 and 2072 were filed out-of-time and Patent Owner did not follow the proper procedure for admitting new evidence with its Request for Rehearing, Petitioners respectfully request that Exhibits 2071 and 2072 be expunged. We contacted counsel for Patent Owner on Thursday, July 23 and Friday, July 24 to inquire whether Patent Owner intended to oppose Petitioners' request. Patent Owner did not respond.

Ex. 3002. To which Patent Owner responded via a second email to the Board, stating:

> In response to Petitioners' July 27, 2020 and August 13, 2020 e-mails, Patent Owner respectfully submits that the Board should not expunge Exhibits 2071 and 2072 from the IPR Record. First, Exhibits 2071 and 2072 should not be considered "new evidence" since they are cites to a public record, which were attached Patent Owner's Request for Rehearing as Exhibits for the Board's convenience. Second, the Request for Rehearing made a showing of "good cause." Exhibits 2071 and 2072 were submitted at first opportunity, and Patent Owner's Request for Rehearing established the relevance of these Exhibits to Patent

> Owner's argument in support thereof. Thank you kindly in advance for your attention and consideration here.

Id.

At this stage in the proceeding, as well as at the time Patent Owner filed its Request for Rehearing and submitted Exhibits 2071 and 2072, no further evidence was authorized by the Board.

> Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue "good cause" exists for admitting the new evidence. Alternatively, a party may argue 'good cause' exists in the rehearing itself.

Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC, IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019) (precedential). Absent a showing of "good cause" prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted. *Id*.

Patent Owner did not request a conference call with the Board, or otherwise request authorization to file new evidence with its Request for Rehearing prior to filing the evidence at issue. Furthermore, Patent Owner did not otherwise show that good cause exists for admitting the new evidence. *See* Request for Rehearing; *see also* Ex. 3002 (Patent Owner's email). We conclude that Exhibits 2071 and 2072 are not evidence needed in the interest-of-justice in this proceeding.

Under the Board's authority to manage the record, we may expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized. 37 C.F.R. § 42.7(a) (2019). Therefore, we expunge from the record Exhibit 2071 and Exhibit 2072.

Accordingly, it is:

ORDERED that Exhibit 2071 and Exhibit 2072 are each expunged from the record.

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