UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIQUIDIA TECHNOLOGIES, INC.,

Petitioner

v.

UNITED THERAPEUTICS CORPORATION,

Patent Owner

Inter Partes Review No. IPR2020-00770

U.S. Patent No. 9,604,901

PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL EVIDENCE

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I. RELIEF REQUESTED

Petitioner Liquidia Technologies, Inc. ("Liquidia") respectfully moves to submit, as supplemental information, the transcript and order from the *Markman* hearing that occurred on June 4, 2021 in *United Therapeutics Corporation v. Liquidia Technologies, Inc.*, C.A. No. 20-755 (RGA) (District Court for the District of Delaware). The *Markman* hearing involved construction of claim terms from U.S. Patent No. 9,604,901 that are also at issue in the instant proceeding, and the transcript contains statements relevant to inconsistencies in Patent Owner United Therapeutic Corporation ("UTC")'s positions between the tribunals.

II. LEGAL STANDARD

A motion to submit supplemental information may be filed under § 42.123(b) when more than one month has passed from the date the trial is instituted and "[t]he supplemental information [is] relevant to a claim for which the trial has been instituted." 37 C.F.R. § 42.123(a)-(b). A party seeking to submit supplemental information under § 42.123(b) bears the burden of showing: first, that the information reasonably could not have been obtained earlier, and second, that consideration of the supplemental information would be in the interests of justice. *Id.*

For claim construction documents from other tribunals, "[n]ormally, the Board will permit such information to be filed, as long as the final oral hearing has

not taken place." PTAB Consolidated Trial Practice Guide (Nov. 2019) ("Guide"), 48. This is because the "Board, in its claim construction determinations, will consider statements regarding claim construction made by patent owners and by a petitioner filed in other proceedings, if the statements are timely made of record." *Id.* (citing *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360–61 (Fed. Cir. 2017) (extending the prosecution disclaimer doctrine to include patent owner's statements made in a preliminary response that was submitted in a prior AIA proceeding)). The "Board may take into consideration statements made by a patent owner or petitioner about claim scope." *Id.*

Accordingly, the Board has advised that "[p]arties should submit a prior claim construction determination by a federal court . . . as soon as that determination becomes available." *Id.*, 47. In fact, submission of a prior claim construction determination is mandatory under 37 C.F.R. § 42.51(b), if it is "relevant information that is inconsistent with a position advanced by the party during the proceeding." *Id.*

III. ARGUMENT

A. The *Markman* Hearing Transcript and Order Could Not Have Been Obtained Earlier

The *Markman* hearing occurred on June 4, 2021, and Petitioner received the oral hearing transcript on June 9, 2021. Petitioner then promptly communicated with Patent Owner on June 10, 2021, which indicated that it will oppose this Motion. Petitioner subsequently requested authorization from the Board to file this Motion

on June 11, 2021. On June 15, 2021, the parties filed a proposed claim construction order based on district Judge Andrews's rulings at the hearing. EX1054. The oral argument in this proceeding is scheduled for June 23, 2021, so Petitioner has moved to submit this supplemental information now, to give the parties adequate time to brief the Motion and to make sure the information is submitted before the hearing. Petitioner requests permission to file the district court's final claim construction order as soon as it is entered by the Court—which is likely to occur on or before June 21, 2021, when Patent Owner's opposition to this Motion is due.

B. Adding the *Markman* Hearing Transcript and Order to the Record for the Board's Consideration is in the Interests of Justice

The Board regularly accepts filing of *Markman* documents when the same claim terms are at issue in the proceeding before the Board. *See, e.g.*, *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01199, Paper 11 at 2 (P.T.A.B. Nov. 19, 2019); *GoPro, Inc. v. Contour IP Holding LLC*, IPR2015-01080, Paper 74 at 5 (P.T.A.B. Feb. 14, 2019) (citing *Knowles Elecs. LLC v. Iancu*, 886 F.3d 1369, 1376 (Fed. Cir. 2018) ("[I]n some circumstances, previous judicial interpretations of a disputed claim term may be relevant to the PTAB's later construction of that same disputed term. . . . While 'the [PTAB] is not generally bound by a previous judicial interpretation of a disputed claim term[, this] does not mean . . . that it has no obligation to acknowledge

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