

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTAIRE PHARMACEUTICALS, INC.,
Petitioner,

v.

PARAGON BIOTECK, INC.,
Patent Owner.

Case PGR2015-00011
Patent 8,859,623

PARAGON'S OBJECTIONS TO UNTIMELY REPLY EVIDENCE

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Paragon BioTeck, Inc.

(“Paragon”) objects to Exhibit 1025 (Declaration No. 3 of Assad Sawaya), Exhibit 1027 (TMQC# 247-01), Exhibit 1028 (TMQC# 247-00), Exhibit 1029 (Declaration of Rashid Zaman), Exhibit 1030 (STU0346), Exhibit 1031 (Transmittal letter from M. Sawaya to L. Bluett), Exhibit 1032 (Declaration No. 2 of Michael Sawaya), Exhibit 1033 (Email from L. Bluett to M. Sawaya), and Exhibit 1035 (Orange Book listing for U.S. Patent No. 8,859,623), all as filed by Petitioner Altaire Pharmaceuticals, Inc. (“Petitioner”) with Petitioner’s Reply on May 6, 2016, because each identified Exhibit is untimely, irrelevant, unduly prejudicial, and improper under the Board’s rules governing the conduct of the present proceeding.

The above-identified Exhibits were filed with Petitioner’s Reply on May 6, 2016 in violation of 37 C.F.R. § 42.204(b), including § 42.204(b)(5), which requires, *inter alia*, that all evidence relied on to support a ground of challenge in a PGR be identified in the Petition. *See also* 35 U.S.C. § 322(a)(3) (same). The untimely filing of the above-identified Exhibits is further in violation of 37 C.F.R. § 42.23(b) which requires that all arguments be made in the Petition and limits the permissible scope of Reply. *See also* 77 Fed. Reg. 48612, 48620 (Aug. 14, 2012) (“Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and *not merely new evidence that could have been presented earlier* to support the movant’s

motion.” (emphasis added). The above-identified Exhibits, including the three declarations containing new testimonial evidence, are improper because they address issues that were required to be addressed in Petitioner’s Petition. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, No. 2015-1693, slip op at 16 (Fed. Cir. May 9, 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.’ 35 U.S.C. § 312(a)(3). ‘All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition or patent owner response.’ 37 C.F.R. § 42.23(b).”).

Paragon further objects to the above-identified Exhibits as irrelevant and inadmissible under Fed. R. Evid. 401/402, because they do not have any tendency to make any fact of consequence in this proceeding more or less probable than it would be without the evidence, including because they were not timely submitted. Patent Owner further objects to the above-identified Exhibits under Fed. R. Evid. 403, to the extent determined relevant, because any probative value is substantially outweighed by a danger of unfair prejudice, confusing the issues, undue delay, and wasting time and resources, including because they were not timely submitted.

Case PGR2015-00011

Patent 8,859,623

Respectfully submitted,

Date: May 13, 2016

/ Michael T. Rosato /

Michael T. Rosato, Lead Counsel

Reg. No. 52,182

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PARAGON'S OBJECTIONS
TO UNTIMELY REPLY EVIDENCE was served on May 13, 2016 on the
Petitioner at the correspondence address of the Petitioner as follows:

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Respectfully submitted,

Date: May 13, 2016

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
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