IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner

Case PGR2019-00028
U.S. Patent No. 10,052,338

PATENT OWNER'S OBJECTIONS TO PETITIONER'S REPLY EVIDENCE

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner hereby submits the following objections to the evidence Petitioner filed with its Reply dated January 13, 2020. Patent Owner's objections apply equally to Petitioner's reliance on these Exhibits in any subsequently filed documents in this proceeding.

Ex. 1040

Patent Owner objects that this document constitutes evidence having no tendency to make a fact of consequence more or less probable than it would be without the evidence. Petitioner concedes that it is not relying on Internet publication of Varenna 2011 (Ex. 1006) and is instead "relying on the actual printing and circulation of the journal issue to establish Varenna 2011 as prior art." (Reply, 11 n. 3.) This document states nothing about actual printing or circulation, nor does it suggest anything about whether or how a person of ordinary skill in the art could have located Varenna 2011 (Ex. 1006) before the priority date. This document is therefore irrelevant under Fed. R. Evid. 401 and inadmissible under Fed. R. Evid. 402.

Alternatively, if the document is deemed relevant, Patent Owner objects to it as untimely evidence that Petitioner could have included with the Petition, in that it purports to establish facts necessary for Petitioner to make a prima facie showing that Exhibit 1006 qualifies as a "printed publication" under 35 U.S.C. § 102.

Petitioner elected to present no argument and no evidence with the Petition to show that Varenna 2011 was disseminated before the priority date. It is a violation of the rules and the Consolidated Trial Practice Guide for Petitioner to present such evidence and argument for the first time in its Reply. 37 C.F.R. 42.23(b); Guide, 73-75. This document should be excluded or disregarded accordingly.

Ex. 1043

Patent Owner objects that this document constitutes evidence having no tendency to make a fact of consequence more or less probable than it would be without the evidence. The declarant's retrieval of the reference (Ex. 1007) from a library in December 2017, many years after the priority date for the patent at issue, has no bearing upon whether Ex. 1007 was disseminated or otherwise available to the public such that persons of ordinary skill in the art exercising reasonable diligence could have located it before the priority date. In addition, the declarant represents himself to be a specialist in "document retrieval and delivery of medical and biomedical articles obtained from the National Institutes of Health National Library of Medicine" and does not purport to convey any information about the ability of reasonably diligent persons of ordinary skill in the art pertaining to the patent at issue, and lacking his level of research expertise. The declarant does not purport to be a person having ordinary skill in the art of the patent at issue, or to

have an understanding of the knowledge of such a person. Furthermore, the ability to locate or retrieve a reference by name is not relevant to whether a person of ordinary skill in the art researching the subject matter could have located the reference before the priority date. The declarant provides no information to suggest that he or any other person could have located the reference using a subject matter search. The declarant does not testify that the NLM was a resource to which persons of ordinary skill in the art would have turned before the priority date when researching the subject matter of the patent at issue. The declarant does not provide any information about the library's cataloguing and indexing system other than to state that he "requested the specific issue containing Muratore." None of this information tends to make it any more likely that Muratore was accessible before the priority date such that persons of skill in the art could have located it when researching the subject matter. This document is therefore irrelevant under Fed. R. Evid. 401 and inadmissible under Fed. R. Evid. 402. To the extent deemed relevant, the document is inadmissible under Fed. R. Evid. 403 because its probative value is substantially outweighed by a danger of unfair prejudice, confusing the issues, or misleading the Board.

Patent Owner objects that the testimony presented in this document includes matters beyond the witness's personal knowledge. The declarant speculates at ¶ 7,

for example, as to the meaning of the library's markings applied to the reference. The declarant admits his testimony is based on inference and not on first-hand information. The declarant does not state, for example, that he has worked for the library, or read any of its policies vis-à-vis date stamps and intake and shelving, or had any conversations with any person having such knowledge. It is pure speculation to then declare that Muratore or other date-stamped materials are "added to the NLM's General Collection—and therefore available and accessible to the public … within 7-10 days of receipt of the publication." Such testimony is made without personal knowledge and is inadmissible under Red. R. Evid. 602.

Alternatively, if the document is deemed relevant and the testimony based on personal knowledge, Patent Owner objects to it as untimely evidence that Petitioner could have included with the Petition, in that it purports to establish facts necessary for Petitioner to make a prima facie showing that Exhibit 1007 qualifies as a "printed publication" under 35 U.S.C. § 102. Petitioner elected to present no argument and no evidence with the Petition to show that Muratore was disseminated or otherwise made available before the priority date such that reasonably diligent and interested persons of skill in the art could have located it. It is a violation of the rules and the Consolidated Trial Practice Guide for Petitioner to present such evidence and argument for the first time in its Reply. 37 C.F.R.

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