

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LUPIN LTD. and LUPIN PHARMACEUTICALS INC.,

Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD.,

Patent Owner.

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Case IPR2015-01099

Patent 8,669,290 B2

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Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and  
GRACE KARAFFA OBERMANN, *Administrative Patent Judge*.

FRANKLIN, *Administrative Patent Judge*.

DECISION

*Granting-in-Part Patent Owner's Motion to Expunge*  
*37 C.F.R. § 42.56*

On October 17, 2016, Patent Owner filed a motion to expunge the sealed versions of the following papers and exhibits:

- Patent Owner’s Response (citing to confidential exhibits), Paper Nos. 22 and 23 (filed February 25, 2016), and 64 (filed July 29, 2016).
- Excerpts of Patent Owner’s New Drug Application: Ex. 2096 (filed July 29, 2016); Ex. 2102 (filed July 29, 2016); Ex. 2103 (filed July 29, 2016); Ex. 2110 (filed July 29, 2016); Ex. 2251 (filed July 29, 2016); Exs. 2291-2293 (filed July 29, 2016).
- Information related to alleged commercial success of Patent Owner’s product from a related district court case: Ex. 2258 (filed February 25, 2016); Ex. 2323 (filed May 5, 2016).
- Materials related to third-party BioScience’s testing procedures: Exs. 2267 [confidential version only]-[22]78, 2294 (filed February 25, 2016) [confidential version only].
- Confidential versions of Expert Declarations: Hofmann (Ex. 1122); Williams (Ex. 2082); Trattler (Ex. 2116); Myers (Ex. 2126); Paulson (Ex. 2128); and Jarosz (Ex. 2130).
- Confidential versions of transcripts of Expert Cross Examinations: Dr. Paulson (Ex. 1123) (filed April 22, 2016); Dr. Trattler (Ex. 1120) (filed April 22, 2016); Dr. Williams (Ex. 1099) (filed April 22, 2016); and Mr. Hofmann (Ex. 1181) (excerpts from transcript) (filed May 18, 2016).

Paper 76, 5–6. Patent Owner states that it “contacted counsel for Petitioner and they do not oppose this motion to expunge.” *Id.* at 7. However, Patent Owner clarifies in a footnote that Petitioner opposes the motion with respect to Exhibit 1181. *Id.* at n.7.

The Rules of Practice for Trial before the Patent Trial and Appeal Board provide that:

Confidential information that is subject to a protective order ordinarily will become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial. There is

an expectation that information will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following a trial. A party seeking to maintain the confidentiality of information, however, may file a motion to expunge the information from the record prior to the information becoming public.

77 Fed. Reg. No. 157, Part V at Section I.E.6. (Aug. 14, 2012); *see also* 37 C.F.R. § 42.56 (“After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.”).

The Board’s Default Protective Order has been entered in this proceeding. Paper 70. Additionally, we granted Patent Owner’s Motions to Seal all or portions of the papers and exhibits that Patent Owner now seeks to expunge. *See* Papers 71 and 72. On September 12, 2016, a Final Written Decision was entered by the Board. Paper 69. Accordingly, in this proceeding, documents filed subject to a protective order would normally be made public 45 days from that date.

Petitioner affirms that of the items that it seeks to expunge, only portions of the following documents were referred to in the Board’s Final Decision:

- Patent Owner’s Response (Paper No. 22),
- Hofmann Declaration (Ex. 1122),
- Ex. 1154
- Williams Declaration (Ex. 2082), and
- Jarosz Declaration (Ex. 2130).

Paper 76, 4. On October 17, 2016, Patent Owner filed a redacted public version of each those documents that will remain in the record if the sealed versions are expunged. *Id.* Thus, Patent Owner asserts that if the requested sealed papers and exhibits are expunged, the public will still “have access to all the materials relevant to the merits of this proceeding.” *Id.* at 6.

Based upon our consideration of those facts, and the arguments presented in Patent Owner’s motion, Patent Owner’s request to expunge confidential versions of Papers 22, 23, and 64, and Exhibits 1099, 1120, 1122, 1123, 1154, 2082, 2096, 2102, 2103, 2110, 2116, 2126, 2128, 2130, 2251, 2258, 2267–2278, 2291–2293, 2294, and 2323 is *granted*.

In consideration of Petitioner’s opposition to expunging Exhibit 1181, we *deny* Patent Owner’s motion with respect to that exhibit. However, the sealed status of Exhibit 1181 shall be preserved pending appeal. Patent Owner is authorized to renew its request to expunge Exhibit 1181 within ten business days after the time for filing a notice of appeal expires, or if an appeal is taken, the time for filing a renewed motion to expunge Exhibit 1181 is extended to ten business days after a final disposition of such appeal.

Accordingly, it is

ORDERED that Patent Owner’s Motion to Expunge with respect to confidential versions of Papers 22, 23, and 64, and Exhibits 1099, 1120, 1122, 1123, 1154, 2082, 2096, 2102, 2103, 2110, 2116, 2126, 2128, 2130, 2251, 2258, 2267–2278, 2291–2293, 2294, and 2323 is *granted*;

FURTHER ORDERED that Patent Owner’s Motion to expunge with respect to Exhibit 1181 is *denied*;

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FURTHER ORDERED that confidential versions of Papers 22, 23, and 64, and Exhibits 1099, 1120, 1122, 1123, 1154, 2082, 2096, 2102, 2103, 2110, 2116, 2126, 2128, 2130, 2251, 2258, 2267–2278, 2291–2293, 2294, and 2323 shall be expunged from the record;

FURTHER ORDERED that the sealed status of Exhibit 1181 shall be preserved pending appeal; and

FURTHER ORDERED that Patent Owner is authorized to renew its request to expunge Exhibit 1181 within ten business days after the time for filing a notice of appeal expires, or if an appeal is taken, the time for filing a renewed motion to expunge Exhibit 1181 is extended to ten business days after a final disposition of such appeal.

**PETITIONER:**

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