

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED,
Petitioner

v.

NOVARTIS AG
Patent Owner

Case IPR2017-01592
U.S. Patent No. 8,410,131

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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FRE 1068

West-Ward Pharmaceuticals International Limited (“West-Ward” opposes Patent Owner Novartis AG’s (“Novartis”) Motion To Exclude (Paper No. 61).

Novartis moves to exclude or strike the following seven categories of evidence:

- (1) Exhibits and paragraphs of Dr. Pantuck’s declarations not cited in the Petition or Reply (Mot. ¶ a. at 1 and 4);
- (2) Paragraphs of Dr. Pantuck’s declarations not specifically identified or discussed in detail in the Petition or Reply (Mot. ¶ b. at 1 and 4-6);
- (3) Exhibits (both cited in the Petition or Reply and not cited in the Petition or Reply) that Novartis alleges Petitioner has failed to prove are prior art, and paragraphs of Dr. Pantuck’s declarations that rely on these exhibits (Mot. ¶ c. at 1-2 and 6-8);
- (4) Exhibits that were first cited in Petitioner’s Reply or in Dr. Pantuck’s Reply Declaration (Mot. ¶ d. at 2-3 and 8-10);
- (5) Paragraphs in Dr. Pantuck’s Reply Declaration citing to Dr. Burris’s testimony as “incomplete and misleading” or considering portions of Exhibits 1126 and 1130 (Mot. ¶ e. at 3 and 10-12);
- (6) Paragraphs in Dr. Pantuck’s Reply Declaration concerning the results of a “SciFinder” search because Dr. Pantuck did not personally carry out the search (Mot. ¶ f. at 3 and 12); and
- (7) Exhibits 1011, 1060, and 1147 on the basis that Ex. 1101 is unauthenticated and that none of these exhibits includes information sufficient to establish that these exhibits were publicly available as of the stated dates (Mot. ¶ g. at 3-4 and 13-14).

Finally, Novartis includes a vague and generic request to exclude evidence that does not appear in instituted grounds other than evidence used for the limited

purposes of describing the state of the art or reinforcing the meaning of a prior art reference included in the instituted grounds. Mot. at 14.

For the reasons discussed below, Novartis fails to establish that any evidence should be excluded and Novartis's motion should be denied.

I. The Board Should Deny Novartis's Motion To Exclude Paragraphs Of The Pantuck Declarations And Exhibits Not Cited In The Petition Or Reply

Novartis seeks to exclude portions of exhibits and expert testimony that are not directly cited in Petitioners' Petition or Reply. There is no requirement that Petitioner directly cite every exhibit that an expert witness used to form his/her considered opinions or cite each paragraph of an expert declaration.

Moreover, the exhibits cited by Novartis are cited or referred to in Dr. Pantuck's Declaration (Ex. 1010) or Reply Declaration (Ex. 1159). *See, e.g.*, exhibits cited in the Pantuck Declaration (Ex. 1010) (Exs. 1028 at ¶ 8, 1029, n.2 at p. 9, 1030 at ¶ 25, 1031 at ¶ 29, 1032 at 39, 1033-1034 at ¶ 53, 1035 at ¶ 57, 1036-38 at ¶ 61, 1040 at ¶ 63, 1041-1042 at ¶ 72, 1043-1044 at ¶ 123, 1045-108 at ¶ 95, 1049-1052 at ¶ 96, 1053-54 at ¶ 97, 1056-1057 at ¶ 98, 1058 at ¶ 99, 1060-106 at ¶ 100, 1062-1067 at ¶ 102, 1068 n.4, p. 47, 1070-1071 at ¶ 107, 1072 at ¶ 108, 1073 at ¶ 109, 1074-1076 at ¶ 110, 1077 at ¶ 111, 1078 at ¶ 113, 1079-1083 at ¶ 114, 1084 at ¶ 115, 1086-1087 at ¶ 117, 1088-1089 at ¶ 118, 1090-1091 at ¶ 120, 1092 at ¶ 121, 1093-1099 at ¶ 122, 1100-1101 at ¶ 123, 1102-1103 at ¶ 140, 1104-

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