

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioners,

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner.

Case IPR2017-01767 (Patent 9,254,278 B2)
Case IPR2017-01768 (Patent 9,095,559 B2)
Case IPR2017-01769 (Patent 9,326,966 B2)¹

Before TONI R. SCHEINER, DEBORAH KATZ, GRACE KARAFFA
OBERMANN, and RAMA G. ELLURU, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

ORDER
Sur-Reply
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in the three cited cases. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2017-01767 (Patent 9,254,278 B2)

Case IPR2017-01768 (Patent 9,095,559 B2)

Case IPR2017-01769 (Patent 9,326,966 B2)

On August 23, 2018, Patent Owner Horizon Therapeutics, LLC (“Horizon”) contacted the Board by e-mail regarding filing sur-replies in response to replies filed by Petitioner Par Pharmaceutical, Inc. (“Par”) in each of the three instant proceedings. According to Horizon, Par’s replies rely, at least in part, on newly submitted declarations by Neal Sondheimer, M.D., Ph.D. Horizon reports that Par does not oppose the filing of sur-replies by Horizon in lieu of motions for observation on cross-examination.

Because Par allegedly presented new testimonial evidence, Horizon is authorized to file sur-replies in the proceedings named above. These sur-replies may rely on the cross-examination testimony of Dr. Sondheimer regarding the declarations Par cites in these proceedings.

In the e-mail, Horizon also sought confirmation that it may discuss and include as an exhibit in its sur-replies, a declaration of Dr. Sondheimer filed by Par in a different proceeding (*Inter Partes* Review of U.S. Patent No. 9,561,197 (IPR2018-01550, Ex. 1002)). Horizon asserted that Dr. Sondheimer’s declaration in that proceeding contains testimony that is relevant to Dr. Sondheimer’s opinions in the instant proceedings. Horizon reports that Par opposes the submission of the Sondheimer declaration from IPR2018-01550 as an exhibit to Horizon’s sur-reply.

Because Horizon will have an opportunity to cross-examine Dr. Sondheimer on the testimony Par presented in the instant proceedings, Horizon has an opportunity to elicit Dr. Sondheimer’s opinions on information relevant to these proceedings. There is no need for Horizon to present prepared testimony from a different proceeding. Accordingly, Horizon’s sur-replies may not be accompanied by new evidence other than the deposition transcript(s) of the cross-examination of Dr. Sondheimer submitted in support Petitioner’s replies.

Case IPR2017-01767 (Patent 9,254,278 B2)

Case IPR2017-01768 (Patent 9,095,559 B2)

Case IPR2017-01769 (Patent 9,326,966 B2)

It is ORDERED that Horizon is AUTHORIZED to file sur-replies in the above proceedings to address arguments made and evidence presented in Par's replies.

It is further ORDERED that any sur-reply be filed by 17 September 2018 and that it not exceed 10 pages.

It is further ORDERED that Horizon is NOT AUTHORIZED to rely on any new evidence, including declarations of witnesses from other proceedings, in its sur-replies.

Petitioner:

David H. Silverstein
Dan Feng Mei
Aziz Burgy
Axinn, Veltrop & Harkrider LLP
dsilverstein@axinn.com
dmei@axinn.com
Ravicti@axinn.com
aburgy@axinn.com

Patent Owner:

Robert Green
Emer Simic
Ann Kotze
Griffith & Borg-Breen, LLP
rgreen@greengriffith.com
esimic@greengriffith.com
akotze@greengriffith.com

Case IPR2017-01767 (Patent 9,254,278 B2)

Case IPR2017-01768 (Patent 9,095,559 B2)

Case IPR2017-01769 (Patent 9,326,966 B2)

Matthew Phillips
Laurence & Phillips IP Law LLP
mphillips@lpiplaw.com

Dennis Bennett
GLOBAL PATENT GROUP, LLC
dennisbennett@globalpatentgroup.com