

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLATWING PHARMACEUTICALS, LLC and
MYLAN PHARMACEUTICALS INC.,
Petitioners,

v.

ANACOR PHAMACEUTICALS, INC.,
Patent Owner.

Case No. IPR2018-00170¹
U.S. Patent No. 9,566,290

**AMENDED REPLY IN SUPPORT OF
PATENT OWNER'S MOTION TO EXCLUDE**

¹ Case No. IPR2018-01360 has been joined with this proceeding

TABLE OF CONTENTS

ARGUMENT 1

I. Dr. Murthy’s Reply Declaration Is Not Responsive 1

II. The Board Should Exercise its Discretion to Exclude Dr. Murthy’s
Reply Declaration in its Entirety 3

III. FlatWing’s Response Improperly Argues the Merits 5

CONCLUSION 5

TABLE OF AUTHORITIES

| Cases: | Page(s): |
|--|-----------------|
| <i>Belden, Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015) | 2, 4 |
| <i>Dell Inc. v. Realtime Data LLC</i> , IPR2016-00972, Paper 71, 2018 WL 2247172 (P.T.A.B. May 15, 2018) | 4 |
| <i>In re NuVasive, Inc.</i> , 841 F.3d 966 (Fed. Cir. 2016) | 3 |
| <i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)..... | 1, 2 |
| <i>Nintendo of America Inc. v. Motion Games, LLC</i> , 2015 WL 2395487 (P.T.A.B. May 15, 2018) | 4 |
| Statutes: | |
| 35 U.S.C. § 316(e)(8)..... | 3 |
| Rules: | |
| 37 C.F.R. § 42.23(b) | 1, 3 |
| 37 C.F.R. § 42.64 | 4 |

Anacor is *not* insisting, as FlatWing contends, that reply evidence “be exactly the same” as the evidence cited in a petition. Nor is it Anacor’s position that reply evidence “must not have been previously known” to a petitioner. Anacor’s position is simply that, pursuant to 37 C.F.R. § 42.23(b), reply evidence must be “responsive.” FlatWing’s opposition (Paper 32, “Opp.”) states that Dr. Murthy’s reply declaration (Ex. 1048) “elaborate[s]” or “expounds” upon the arguments raised in FlatWing’s petition. Opp. at 1, 6. But regardless of how FlatWing now attempts to characterize it, FlatWing was required to provide its explanation of its grounds for invalidity with its petition, which makes Dr. Murthy’s reply declaration an improper attempt to supplement his prior opinions. Anacor’s motion to exclude (Paper 25, “Mot.”) should be granted.

ARGUMENT

I. Dr. Murthy’s Reply Declaration Is Not Responsive

FlatWing’s own characterization of Dr. Murthy’s rebuttal testimony admits that it “elaborate[s]” and “expounds upon [FlatWing’s] prima facie case.” Opp. at 6. But, FlatWing and its declarants were required state their case fully as part of FlatWing’s petition for *inter partes* review. Their failure to do so renders such evidence untimely and improper supplementation. See *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016).

That Dr. Murthy cites to Dr. Lane’s testimony to frame his rebuttal testimony does not establish that his opinions are responsive. *See* Opp. at 7–9. In its Patent Owner’s Response, Anacor and its experts explained that the cited art teaches away from the 5% limitation and that a POSA would have understood experimentation with boron-containing compounds to be anything but routine due to boron’s “unique” chemistry and the lack of experience in the art. *See* Lane Decl. (Ex. 2014) ¶¶ 71–79; Reider Decl. (Ex. 2013) ¶¶ 72–75. Instead of responding to either of these points, Dr. Murthy reiterated the ranges in the cited art and for the first time asserted that Anacor’s own work was evidence supporting his earlier opinions regarding “routine experimentation.” Murthy Reply Decl. (Ex. 1048) ¶¶ 5, 10, 12; *id.* ¶¶ 17–19 (providing a new discussion of Exhibit 1040). In other words, Dr. Murthy did not engage the opinions of Anacor’s experts, but instead introduced new concepts in an effort to buttress his previous opinions.

FlatWing seeks to justify Dr. Murthy’s improper supplementation by relying on the proposition that “[e]vidence admitted in rebuttal to respond to the patent owner’s criticisms will commonly confirm the prima facie case.” *Belden, Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). But *Belden* does not give petitioners carte blanche to supplement the evidentiary record, *see Intelligent Bio-Systems*, 821 F.3d at 1369–70, and in fact illustrates the granular level of detail that can be generally expected of proper reply evidence. *See Belden*, 805 F.3d at 1078

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.