

In the Matter Of:
NOVARTIS V. GENZYME

TELECONFERENCE

July 11, 2023



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TELECONFERENCE

IN THE MATTER OF:

NOVARTIS V. GENZYME

Time: 11:00 a.m.

Date: July 11, 2023

Before:

Judge Sheridan K. Snedden

Judge Jeffrey Fredman

Judge James Tartal

APPEARANCES OF COUNSEL:

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1 THE COURT: This is Judge Snedden. I
2 have with me on the call Judges Fedman and
3 Tartal. This is the conference from IPR --
4 teleconference for IPR 202300608 and 00609.
5 Let's just make sure we have everyone here. Who
6 do I have on the line for petitioner?

7 MR. WEINGARTEN: Yes, Your Honor, David
8 Weingarten from Finnegan on behalf of the
9 petitioner, and joining with me is John
10 Livingstone and Yieyie Yang.

11 THE COURT: All right. Sorry, one more
12 time, your name.

13 MR. WEINGARTEN: David Weingarten.

14 THE COURT: Weingarten. Okay.

15 MR. WEINGARTEN: Yes, sir.

16 THE COURT: And who do we have on the
17 line for patent owner?

18 MR. HACKMAN: Yes, Your Honor, Blaine
19 Hackman from Dechert, LLP, and I'm joined by my
20 colleague Amanda Antons.

21 THE COURT: All right. Well, welcome.

22 MR. HACKMAN: Thank you.

23 THE COURT: All right. And do we have
24 a court reporter on the line?

25 THE REPORTER: Yes, Calvin Addison with

1 Esquire, Your Honor.

2 THE COURT: Okay. I would ask the party
3 who requested the reporter to please add this
4 transcript as an exhibit at the end when it's
5 ready into the file.

6 MR. HACKMAN: Yes, Your Honor.

7 THE COURT: Okay. Okay. Mr. Hackman,
8 I believe you requested -- no, let's see here.
9 Yes, it was Mr. Weingarten. You would have
10 requested the teleconference. We'll let you
11 begin.

12 MR. WEINGARTEN: Yes, Your Honor. We
13 request authorization to file a one-page reply
14 brief which effectively is to put the office on
15 notice of petitioner's Sotera stipulation which
16 has been filed before the Court.

17 THE COURT: So my understanding is it's
18 filed and entered. Is there any reason or
19 expectation that they wouldn't?

20 MR. WEINGARTEN: Your Honor, I don't
21 believe an entry is going to be necessary. It's
22 already on the docket. It's a stipulation which
23 was entered on the docket as a notice. And so I
24 don't think there's going to be further action.
25 But there's no reason to believe that the Court

1 would in any way deny it if they're actually
2 necessary.

3 THE COURT: All right. And just one
4 question: Is it true Sotera stipulation
5 includes all the necessary language, including
6 the language or could have reasonably been
7 raised, or is it to some lesser extent?

8 MR. WEINGARTEN: Yes, Your Honor. It
9 stipulates to not to pursue in the parallel
10 District Court proceeding the same grounds as a
11 petition or any grounds that could reasonably be
12 raised in the petition.

13 THE COURT: Okay. All right. So your
14 request is just a one-page reply brief and entry
15 of the Sotera stipulation?

16 MR. WEINGARTEN: Yes, Your Honor.

17 THE COURT: Understood. Okay. Anything
18 else before I pass the floor to Mr. Hackman?

19 MR. WEINGARTEN: Not at this time, Your
20 Honor.

21 THE COURT: All right. Mr. Hackman, the
22 floor is yours.

23 MR. HACKMAN: Thank you, Your Honor.
24 So we emphasize that patent owner's objection to
25 the reply relates to the timing of filing the

1 stipulation after the preliminary response which
2 under the facts here opens the door to potential
3 gamesmanship by petitioners. So because of
4 petitioner's delay in addressing Fintiv until
5 the reply stage, which is the very first time in
6 these cases that the petitioner did anything in
7 the record to address -- did anything to address
8 Fintiv. Patent owner has been put in a
9 disadvantage in addressing the merits at the
10 preliminary response. So the petition did not
11 address Fintiv at all despite the Fintiv issue
12 being reasonable foreseeable. And the
13 preliminary response lays forth the facts that
14 were in place at the time of the petition in
15 terms of the trial calendar. And we think those
16 established Fintiv was reasonably foreseeable
17 when the petition was filed. But by not
18 addressing Fintiv in the petition, the petition
19 was able to dedicate additional space to its
20 merits argument; whereas in contrast because
21 Fintiv was still a live issue at the time of the
22 preliminary response, the patent owner committed
23 six pages of its reprise to establishing why the
24 petition should be considered under Fintiv. And
25 because -- this is where the concern of

1 gamesmanship comes in. Because the petitioners
2 know that they can take this wait and see
3 approach to addressing Fintiv after the patent
4 owner files its preliminary response, the
5 petitioners can take advantage of this because
6 the patent owners will be forced to address
7 Fintiv, taking away space from the merits
8 argument. And then by waiting to the reply
9 stage after the patent owner has filed its
10 preliminary response the Sotera stipulation can
11 likely address Fintiv. So we think that given
12 these set of facts that good cause for reply is
13 not established here.

14 MR. WEINGARTEN: Your Honor, if I can
15 respond?

16 THE COURT: Is there anything else from
17 --

18 MR. WEINGARTEN: I'm sorry?

19 THE COURT: Are you finished, Mr.
20 Hackman? Anything else?

21 MR. HACKMAN: Yes. Yes.

22 THE COURT: Yes.

23 Please proceed. You can proceed.

24 MR. WEINGARTEN: Yes, Your Honor. First
25 of all, the allegation of gamesmanship is

1 unfounded here. What petitioner has done is
2 what is normal course of practice which is to
3 file the petitions based upon the issues that
4 are before it which has to do with the grounds
5 of validity, and unless and until the patent
6 owner alleges a Fintiv issue there is no
7 obligation to respond. Now that they have done
8 so, petitioner in view of those comments have
9 made the decision to and have, in fact, now
10 filed the Sotera stipulation. Under the
11 37CFR4211 we now have an obligation to inform
12 the Board of that stipulation under the duty of
13 good faith and candor, and that's what we are
14 required to do.

15 With regard to patent owner dedicating
16 space, I mean that's the normal course of
17 practice. In fact, as patent owner will, I'm
18 sure, admit we had to dedicate space to
19 addressing issues that now are not in play
20 because they have asked for to disclaim certain
21 claims, which, you know, they gained some space
22 on. So if we are going to start counting words,
23 which I don't think we should be doing here, I
24 mean, we addressed the petitions for the grounds
25 which we thought the validity was appropriate.

1 They've raised intent. We've now addressed that
2 in the stipulation.

3 THE COURT: Understood.

4 MR. HACKMAN: Your Honor, if I may,
5 patent owner may respond to petitioner's
6 argument. So where we disagree with what
7 petitioner said there is that under the IPR
8 standard it's required in the petition to
9 address reasonably foreseeable discretionary
10 denial issues. And so our issue here is that
11 it's not incumbent of the patent owner to first
12 bring something up. If an issue is reasonably
13 foreseeable, it should have been addressed in
14 the petition, and that's where -- our argument
15 here is about good cause, is there is no good
16 cause because this is the first time the
17 petitioner is raising anything to do with
18 Fintiv. And so under the standard --

19 THE COURT: Let me ask a question.

20 MR. HACKMAN: Sure.

21 THE COURT: Can you hear me well?

22 MR. HACKMAN: Yeah, it's a little
23 distant, Your Honor.

24 THE COURT: All right. I will try to
25 speak up. I don't know if I can improve it at

1 all.

2 I guess my question here is are you
3 asking us to ignore the Sotera stipulation that
4 has now been entered?

5 MR. HACKMAN: Your Honor, the issue I
6 guess is that it's too late to enter it into the
7 record is our concern. So admittedly there is
8 not -- there's an issue of first impression, but
9 certainly in other instances, for example, an XP
10 which we understand did have different facts and
11 was specific to the facts of that particular
12 decision, but a party did attempt to enter a
13 Sotera stipulation after institution, and the
14 Board essentially was willing to ignore that.
15 Of course there was an institution decision; we
16 understand that distinction. But we think there
17 is a problem here with a petitioner being able
18 to do this sort of strategy to put patent owner
19 at a disadvantage. So our concern is we don't
20 -- you know, well, alternatively if the Board is
21 inclined to allow the reply to be filed, is if
22 there is some sort of alternative relief to
23 allow patent owner to get, for example, five
24 pages of argument on the merits or something
25 that we can account for the fact that this has

1 been taken away by the strategy.

2 MR. WEINGARTEN: Your Honor, if I could
3 just address the NXP decision which the counsel
4 has mentioned?

5 THE COURT: Sure.

6 MR. WEINGARTEN: As counsel will know
7 that that decision as he stated was -- had to do
8 with after institution, uh, an attempt to enter
9 a Sotera stipulation. What the Board and the
10 fact that the director found in that
11 precedential decision was the appropriate time
12 for a petition, you know, to offer a stipulation
13 was prior to the institution for review. It
14 said nothing about having to do with your patent
15 owner response. I just want to make sure that's
16 clear.

17 THE COURT: Understood. Okay.

18 MR. HACKMAN: Your Honor, if I may --
19 sorry.

20 THE COURT: Mr. Hackman, will you
21 confer?

22 MR. HACKMAN: Yeah, if I may respond,
23 Your Honor. Just one quick note. I think our
24 argument is a little bit different than it's
25 being portrayed. Our issue is that -- first,

1 the NXP decision doesn't open the door to filing
2 a Sotera stipulation at any time. It does
3 indicate that there are times when you can file
4 it and times when you cannot, but it is limited
5 to the facts of that particular case.

6 But our issue here is really about good
7 cause for reply. It may be different -- have
8 been different if petitioner had raised the
9 discretionary denial Fintiv issue in its
10 petition, but it didn't do so here, and so
11 that's where our concern comes from is in this
12 particular set of facts, they did not raise it
13 and now they go after the preliminary response
14 is filed, after patent owner has spent space
15 addressing Fintiv and then trying to get the
16 stipulation on to the record. So to clarify,
17 that's our concern.

18 THE COURT: Okay. I believe I
19 understand the concern.

20 I think we'll need some time to confer
21 this to discuss the issue here and then will be
22 back shortly with our decision. Hold, please.

23 (Brief recess.)

24 THE COURT: We have conferred and
25 decided to grant petitioner authorization to

1 file a one-page reply brief and to notify us of
2 the Sotera stipulation that has been entered
3 into the District Court. Now I will ask patent
4 owner if they are requesting a sur-reply or
5 anything?

6 MR. HACKMAN: Your Honor, I think we
7 will -- the question we have for you is will the
8 sur-reply be limited to the scope of the reply?

9 THE COURT: It would be limited to the
10 scope of the reply.

11 MR. HACKMAN: Um --

12 THE COURT: What?

13 MR. HACKMAN: Go ahead. I'm sorry.
14 Your Honor.

15 THE COURT: I think you can raise your
16 -- the objections or refer to the transcript
17 here regarding, you know, the Sotera
18 stipulation, that's fine, but just limit it to
19 the scope of the issue in front of us here
20 today.

21 MR. HACKMAN: Thank you, Your Honor.
22 Yes, we would like a sur-reply.

23 THE COURT: And one page would be
24 sufficient for you?

25 MR. HACKMAN: If possible, Your Honor,

1 we would like a three-page reply -- sur-reply.

2 THE COURT: Okay. Well, if there is --
3 we will grant you two pages for your sur-reply.

4 Is there any objections from the
5 petitioner on that?

6 MR. WEINGARTEN: Your Honor, not under
7 those conditions, there's not.

8 THE COURT: All right. Well, we'll go
9 with that. We will have a one-page reply brief
10 followed by a two-page sur-reply. Let's set due
11 dates.

12 Mr. Weingarten, when can you get your
13 reply brief in?

14 MR. WEINGARTEN: Your Honor, we can
15 have that in today.

16 THE COURT: All right. Well, let's set
17 a deadline for tomorrow, July 12th for the reply
18 brief, and we'll give patent owner a week, to
19 July 19th, to file a sur-reply should they
20 desire to do so. Anything else?

21 MR. WEINGARTEN: Not from patent owner,
22 Your Honor. Thank you.

23 MR. HACKMAN: Not from petitioner.
24 Thank you.

25 THE COURT: Make sure the transcript is

1 ordered. And if there's nothing else, we are
2 adjourned. Thank you, everyone.

3 MR. WEINGARTEN: Thank you.

4 MR. HACKMAN: Thank you, Your Honor.

5 (End time 11:29 a.m.)
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CERTIFICATE OF COURT REPORTER

I, CALVIN ADDISON, a Notary Public for the State of Virginia at Large, hereby certify that I was the Court Reporter in the above-styled matter on July 11, 2023, at the time of the hearing.

I further certify that the foregoing transcript is a true and accurate record of the testimony and other incidents herein.

Given under my hand this 11th day of July, 2023.

A handwritten signature in black ink, appearing to read "Calvin Addison", is written over a horizontal line. Below the line, there are two dashed horizontal lines.

Calvin Addison, RPR, CRR

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