

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS GENE THERAPIES, INC. &
NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioners

v.

GENZYME CORPORATION,
Patent Owner.

Case: IPR2023-00608
Patent No. 9,051,542

**PATENT OWNER'S SURREPLY TO PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

Novartis tactically omitted addressing *Fintiv* in its Petition and delayed filing its *Sotera* stipulation in order to learn Genzyme's POPR *Fintiv* arguments. By omitting mention of *Fintiv*, despite it being an entirely foreseeable issue, Novartis violated a cardinal standard of IPRs. Novartis's Reply cannot remedy this failure. If the Board allows Novartis's delayed *Sotera* stipulation to overcome the *Fintiv* issue, it will also reward gamesmanship disadvantaging Genzyme.

I. Novartis's Reply Cannot Cure Its Petition's Failure to Address *Fintiv*

The Reply is Novartis's first attempt to address the longstanding *Fintiv* precedent. Genzyme's arguments were entirely foreseeable when Novartis filed its Petition. POPR, 61-67. When a discretionary denial issue is foreseeable "it [i]s incumbent upon Petitioner to identify...*in its Petition*" arguments opposing discretionary denial. *SEKO S.p.A. v. CM2W JSC*, IPR2020-01636, Paper 9 at 9-10 (PTAB Jan. 7, 2021) (emphasis added); *Siemens Gamesa v. General Elec. Co.*, IPR2022-01279, Paper 9 at 3-5 (PTAB Feb. 2, 2023). The Board has held that a Petitioner lacks good cause for a Reply when it "ma[kes] the decision not to address" a foreseeable discretionary denial argument "or the facts relevant to that analysis in its Petition." *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 10 at 5 (PTAB May 12, 2020); Paper 7 at 3 (PTAB Mar. 23, 2020). Novartis failed to identify—and Genzyme is unaware of—any precedent to support its argument that the requirement to address foreseeable discretionary denial issues in a Petition does not apply to

Fintiv. Ex. 2016, 8:1-9:18. Indeed, the Board held that discretionary denial based on parallel litigation under precedential decision *NHK Spring* must be addressed in the Petition. *Google*, IPR2020-00115, Paper 10 at 5-6. Novartis should be held to the requirement that the Petition must address foreseeable discretionary denial issues.

II. Consideration of the Late Stipulation Will Reward Gamesmanship

Novartis benefitted from omitting *Fintiv* by dedicating more of its Petition to merits arguments. In contrast, Genzyme dedicated six pages of its POPR to preserve its *Fintiv* argument at the expense of merits arguments. If the Board finds Novartis's stipulation to obviate *Fintiv*, Novartis will have unfairly benefited from its delay while prejudicing Genzyme. The Board declined to grant Genzyme relief through additional briefing on the merits. Ex. 2016, 10:20-11:1, 12:24-13:22. Rewarding Novartis's tactics will encourage gamesmanship by Petitioners who can file *Sotera* stipulations only after reviewing the POPR. Novartis's failure to address *Fintiv* is not analogous to Genzyme's disclaimer. Ex. 2016, 8:15-25. While Novartis was obliged to address discretionary denial in its Petition, Genzyme was not required to preemptively disclaim claims. Novartis controlled its decision to file Petitions, when to file, the Petitions' content—including omitting any *Fintiv* arguments—and which claims to challenge. Novartis should not be allowed to cure its omission now.

Dated: July 19, 2023

Respectfully submitted,
/Blaine M. Hackman/
Blaine M. Hackman, Reg. No. 67,479
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that today in:

*Novartis Gene Therapies, Inc. & Novartis Pharmaceuticals Corporation v.
Genzyme Corporation, IPR2023-00608 (U.S. Patent 9,051,542)*

I caused to be served a copy of:

**PATENT OWNER'S SURREPLY TO PETITIONER'S REPLY TO PATENT
OWNER'S PRELIMINARY RESPONSE**

upon:

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Dated: July 19, 2023

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