

JOHN D. LIVINGSTONE
404.653.6449
john.livingstone@finnegan.com

June 28, 2023

Sharon Gagliardi
Dechert LLP
Cira Centre 2929 Arch Street
Philadelphia, PA 19104

VIA EMAIL

RE: *Genzyme Corporation et al. v. Novartis Gene Therapies, Inc. et al.*,
No. 21-1736-RGA (D. Del)

Counsel:

Novartis has filed *inter partes* review (IPR) petitions (IPR2023-00608 and IPR2023-00609) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1, 2, 5, and 6 of U.S. Patent No. 9,051,542 ("the '542 Patent"). The tables in attached Appendix A list the grounds asserted in IPR2023-00608 and IPR2023-00609 against the challenged claims. Genzyme subsequently filed a statutory disclaimer of claims 1 and 2.

I write to inform you that Novartis hereby stipulates that if the PTAB institutes IPR2023-00608, Novartis will not assert invalidity on grounds that were raised or reasonably could have been raised in that IPR against the '542 Patent in the parallel district court proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-0109, Paper 12 (PTAB Dec. 1, 2020). Novartis further stipulates that if the PTAB institutes IPR2023-00609, Novartis will not assert invalidity on grounds that were raised or reasonably could have been raised in that IPR against the '542 Patent in the parallel district court proceeding. *Id.*

Sincerely,



John D. Livingstone

JDL/AKM/YY
Enclosure: Appendix A

Appendix A – Grounds Raised in IPR2023-00608 and IPR2023-00609

IPR2023-00608

Ground	Claim(s)	Basis	References
1	1, 5, and 6	§ 103	Evans in view of Huang and Mingozi
2	2	§ 103	Evans and Wright in view of Huang and Mingozi
3	1, 2, 5, and 6	§ 103	Frei in view of Huang and Mingozi

IPR2023-00609

Ground	Claim(s)	Basis	References
1	1, 2, 5, and 6	§ 103	Liu in view of Huang and Mingozi
2	1, 2, 5, and 6	§ 103	Lochrie in view of Huang, Mingozi, Johnson, and Liu