

Date Filed: October 24, 2024

Filed on Behalf of:

Novartis Pharmaceuticals Corporation

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MICHIGAN AND
UNIVERSITY OF SOUTH FLORIDA,
Patent Owners.

Case No. IPR2023-01346
U.S. Patent No. 10,633,344

**PETITIONER'S UNOPPOSED REQUEST FOR ORAL
ARGUMENT PURSUANT TO 37 C.F.R. § 42.70(a)**

Pursuant to the March 19, 2024 Schedule Order (Paper 9) in this proceeding and 37 C.F.R. § 42.70(a), Petitioner Novartis Pharmaceuticals Corporation respectfully requests that the Patent Trial and Appeal Board hear oral argument in this proceeding on the issues below. As set forth in the March 19, 2024 Order, oral argument is scheduled for January 8, 2025. Paper 9 at 11.

Petitioner respectfully requests that the hearing be held in-person at the USPTO headquarters in Alexandria. Patent Owners have also represented to Petitioner that they intend to request an in-person hearing in Alexandria. Petitioner expects to have six individuals attend the in-person hearing.

Petitioner respectfully requests 60 minutes for its argument time. Petitioner further requests the ability to reserve some of its 60 minutes to present rebuttal testimony after Patent Owners' presentation.

Pursuant to 37 C.F.R. § 42.70(a), Petitioner identifies the following oral argument issues, without intent to waive consideration of any issue not requested:

- (1) Lack of written description support in U.S. Application No. 10/378,956 (“the ’956 priority application”), filed March 3, 2003, for challenged

claims 10, 11, and 18 of U.S. Patent No. 10,633,344 (“the ’344 patent”).¹ Absent such support, the earliest possible priority date for the challenged claims is February 13, 2014 (the filing date of U.S. Application No. 14/179,862) and Patent Owners have not disputed that the challenged claims are unpatentable for anticipation and obviousness as of that date based on the art cited in Petitioner’s Grounds 1 and 2.

(2) Lack of enablement support in the ’956 priority application for challenged claims 10, 11, and 18 of the ’344 patent.² Absent such support, the earliest possible priority date for the challenged claims is February 13, 2014 (the filing date of U.S. Application No. 14/179,862) and Patent Owners have not disputed that the challenged claims are unpatentable for anticipation and obviousness as of that date based on the art cited in Petitioner’s Grounds 1 and 2.

¹ Patent Owners have not disputed that U.S. Application No. 60/360,768, filed March 1, 2002, does not provide written description support for the challenged claims.

² Patent Owners have not disputed that U.S. Application No. 60/360,768, filed March 1, 2002, does not provide enablement support for the challenged claims.

- (3) Any motions to exclude evidence that are filed by the parties.
- (4) Any other issues raised by Patent Owners in a request for oral argument, motion to exclude, or any other paper filed by Patent Owners before oral argument.
- (5) Any other issues that the Board deems necessary.

Petitioner respectfully requests that counsel be permitted to use laptops in the hearing room and at counsel table. Petitioner also respectfully requests the ability to use audio-visual equipment to display demonstrative exhibits, including the use of a computer-connectable projector and screen for PowerPoint display.

Dated: October 24, 2024

Respectfully submitted,

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*Lead Counsel for Petitioner, Novartis
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petitioner's Unopposed Request for Oral Argument Pursuant to 37 C.F.R. § 42.70(a) was served on October 24, 2024 via electronic mail on the following counsel of record for the Patent Owners:

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