

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

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

Case IPR2023-01347
U.S. Patent No. 10,633,344

PATENT OWNERS' RESPONSE

LIST OF EXHIBITS

Exhibit Number	Description
2001	Declaration of Taylor Burgener in support of Motion for <i>Pro Hac Vice</i> Admission
2002	Declaration of Jacqueline T. Moran, Ph.D. in support of Motion for <i>Pro Hac Vice</i> Admission
2003	Disclaimer in U.S. Patent No. 10,633,344 Under 37 C.F.R. § 1.321(a), Dated June 5, 2024

Patent Owner is in the process of disclaiming claim 16 of U.S. Patent No. 10,633,344 (the “’344 patent”) under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a) by submission of an appropriate disclaimer, a copy of which is included as Exhibit 2003. The Board instituted *inter partes* review on claim 16 of the ’344 patent. Paper No. 8, Decision, at 19-20 (March 13, 2024). Pursuant to 37 C.F.R. § 1.321(a), Patent Owner has disclaimed all interest in claim 16.

The present statutory disclaimer does not constitute an admission or acquiescence by Patent Owner as to the Petition. Rather, Patent Owner disagrees with Petitioner’s arguments in the Petition and makes the present disclaimer without prejudice to Patent Owner’s ability to rebut such arguments (including characterizing and distinguishing the references cited in the Petition) with respect to any patents and/or patent applications assigned to Patent Owner in any forum. No adverse inferences result from the disclaimer and the disclaimer has no effect on the other claims of the ’344 patent. *See Raytheon Techs. Corp. v. General Electric Co.*, 993 F.3d 1374, 1379 n.4 (Fed. Cir. 2021). Patent Owner is not seeking an adverse judgment as to the disclaimed claims. Patent Owner is not disclaiming the ’344 patent or any of the remaining claims challenged in the petition submitted in IPR2023-01346 under 37 C.F.R. § 42.73(b). To be clear, Patent Owner asserts that the challenged claims in IPR2023-01346 remain valid and patentable. Patent Owner believes a termination under 37 C.F.R. § 42.72 is

appropriate and will be asking the Board for permission to file a motion to terminate.

Respectfully submitted,

Date: June 5, 2024

/Michael J. Kane/

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CERTIFICATION UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Response to Petition totals 268, which is less than the 14,000 allowed under 37 CFR § 42.24(b)(1).

Respectfully submitted,

Date: June 5, 2024

/Michael J. Kane/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on June 5, 2024, a complete and entire copy of this Patent Owners' Response and its supporting exhibits were provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

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