

From: [Andrew O. Larsen](#)
To: [Meg Fasulo](#); [Trials](#)
Cc: [CiplaBictegravirIPR](#); [Mailing List - BIC 802 IPR](#)
Subject: RE: IPR2025-00033 - Petitioner Request for Leave to Submit Preliminary Reply
Date: Monday, March 24, 2025 1:54:28 PM

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Dear Board,

For the record, Petitioner received counsel's response to its March 19th e-mail with a timestamp at 11:55a ET today (approximately 10 mins prior to Petitioner's e-mail to the Board when Petitioner was finalizing its content), and the undersigned did not see counsel's e-mail until after Petitioner's request was sent.

Petitioner will not oppose Gilead's request for a sur-reply if leave is granted. As for the page limit, the litigation proceeding parallel to this IPR is a Hatch-Waxman suit and Petitioner's reply request involves additional context to be explained on a conference call.

Counsel for Petitioner is available at the times proposed by Gilead's counsel below.

Regards,

Andrew

Andrew O. Larsen

he/him/his

Attorney at Law

Merchant & Gould P.C.

500 Fifth Ave

Suite 4100

New York, NY 10110

USA

From: Meg Fasulo <meg.fasulo@bartlitbeck.com>
Sent: Monday, March 24, 2025 12:28 PM
To: Andrew O. Larsen <ALarsen@merchantgould.com>; Trials <Trials@USPTO.GOV>
Cc: CiplaBictegravirIPR <CiplaBictegravirIPR@MerchantGould.com>; Mailing List - BIC 802 IPR <802ipr@bartlitbeck.com>
Subject: Re: IPR2025-00033 - Petitioner Request for Leave to Submit Preliminary Reply

CAUTION - External.

Dear Board,

Contrary to the suggestion below, counsel for Gilead responded to Cipla's request prior to Cipla's email to the Board.

Gilead opposes Cipla's request. Cipla waited more than three weeks after the USPTO rescinded the *Fintiv* memo and more than a month after Gilead's preliminary patent owner response to request a reply brief. Cipla does not attempt to justify why its request was delayed. Nor does the memo's rescission relieve Cipla of the obligation to have addressed the *Fintiv* factors in its petition, especially given the advanced stage of the district court litigation and complete overlap of issues between the two proceedings.

To the extent that the Board grants Cipla's request for a reply brief, Gilead believes that five pages should be sufficient to address the issues Cipla raises in its email. In addition, in those circumstances, Gilead requests a sur-reply of the same length.

Counsel for Gilead can be available for a call at the following times:

- March 26 from 1-4 pm ET
- March 27 from 1-4 pm ET
- March 28 from 2-4 pm ET

Best,
Meg

Meg E. Fasulo
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From: Andrew O. Larsen <ALarsen@merchantgould.com>
Date: Monday, March 24, 2025 at 10:07 AM
To: Trials <Trials@USPTO.GOV>
Cc: Meg Fasulo <meg.fasulo@bartlitbeck.com>, CiplaBictegravirIPR <CiplaBictegravirIPR@MerchantGould.com>
Subject: IPR2025-00033 - Petitioner Request for Leave to Submit Preliminary Reply

Caution: External Message

Dear Board,

I am lead counsel for Petitioner Cipla Limited (“Petitioner” or “Cipla”) in the above captioned *Inter Partes* Review proceeding. Petitioner hereby requests leave to reply to Patent Owner Preliminary Response (Paper 15, “POPR”) under 37 C.F.R. § 42.108(c). Petitioner’s request is based on the changing circumstances for discretionary denial under *Fintiv* after USPTO’s recent rescission of former Director Vidal’s 2022 memo “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (EX-1060, “Vidal Memo”).

Cipla’s Petition (Paper 3) was filed on October 28, 2024 when the Vidal Memo was binding on the PTAB, including that “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” Ex. 1060 at 3-5. Petitioner could not have foreseen its rescission when it filed its Petition, and instead proceeded in view of Vidal’s directive that institution cannot be denied under *Fintiv* if a Petition presents compelling merits or presents a *Sotera* stipulation. *Id.* at 9; see also Paper 3 at 70.

Petitioner seeks leave to reply to the POPR to address Patent Owner’s *Fintiv* analysis under the earlier Board precedent of *Apple v. Fintiv* (“*Fintiv*”) and *Sotera v. Masimo* (“*Sotera*”). See e.g., Paper 15 at 14-37 (reliance on *Fintiv*), 25-26 (discussing *Sotera* stipulation). In particular, Petitioner requests a 10-page reply to Section V of the POPR (Paper 15 at 13-38) to respond to Patent Owner’s arguments under *Fintiv* factors 1-6, which includes reliance on its 325(d) denial request (*id.* at 38-48 (Section VI)) as part of its factor 6 analysis (*id.* at 37-38 (Section V.F.3)). Petitioner respectfully submits that it has good cause based on the intervening agency decision to rescind former Director Vidal’s binding guidance.

If the Board wishes to schedule a teleconference to discuss this request, Petitioner is available at the following times:

- Wednesday, March 26th from 12-2p and 3-5p
- Thursday, March 27th from 11a-4p
- Friday, March 28th from 11a-5p
- Monday, March 31st from 11a-5p

Lead Counsel for Patent Owner Gilead Sciences, Inc. (“Patent Owner”) is included on this communication. Petitioner contacted lead counsel on Wednesday, March 19th and again on Saturday, March 24th, asking if Gilead will oppose this request and seeking its availability for a Board teleconference. Patent Owner has yet to respond.

Respectfully submitted,
Andrew Larsen (Reg. No. 59,315)
Counsel for Petitioner Cipla

Andrew O. Larsen

he/him/his

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Operating as Merchant & Gould, LLP, in California.

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