

From: [Trials](#)

Sent: Monday, August 21, 2023 2:06:32 PM

To: [Trials](#) [Yang, Yieyie](#) [Antons, Amanda](#)

Cc: [Helm, Katherine](#) berghoff@mbhb.com lovsin@mbhb.com vinarov@mbhb.com [Hackman, Blaine](#) [Novartis-Zolgensma-542IPR](#) [Livingstone, John](#) [Murphy, Amanda](#) [Holt, Cora](#) [Weingarten, M. David](#) [Weber, Christopher](#)

Subject: RE: IPR2023-00608 and IPR2023-00609 - Novartis v. Genzyme

Importance: Normal

Sensitivity: None

[EXTERNAL EMAIL]

Counsel:

From the Board –

In consideration of Petitioner's request for leave to file a motion and reply seeking routine and additional discovery, under the circumstances presented, the Panel determines Petitioner's request is premature at this stage of the proceeding. Routine and additional discovery are typically available to the Parties only after institution of an *inter partes* review. Petitioner may renew its request if *inter partes* review is instituted. Additionally, in view of the above, a teleconference is unnecessary at this time.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Yang, Yieyie

Sent: Tuesday, August 15, 2023 2:36 PM

To: Trials ; Antons, Amanda

Cc: Helm, Katherine ; berghoff@mbhb.com; lovsin@mbhb.com; vinarov@mbhb.com; Hackman, Blaine ; Novartis-Zolgensma-542IPR ; Livingstone, John ; Murphy, Amanda ; Holt, Cora ; Weingarten, M. David ; Weber, Christopher

Subject: RE: IPR2023-00608 and IPR2023-00609 - Novartis v. Genzyme

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To the honorable Board,

The parties are available for a teleconference with the Board at the following times:

August 22 (Tuesday) 10am to 1:00pm

Genzyme Ex. 2033
Sarepta Therapeutics, Inc. v. Genzyme Corporation
Page 1 of 4

August 23 (Wednesday) 9:30am to 2pm

August 24 (Thursday) 9:30am to 11am

Best regards,

Yieyie

Yieyie Yang, Ph.D.

Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

901 New York Avenue, NW, Washington, DC 20001-4413

202.216.5170 | fax: 202.408.4400 | yieyie.yang@finnegan.com | www.finnegan.com

FINNEGAN

From: Trials <Trials@USPTO.GOV>

Sent: Friday, August 11, 2023 11:02 AM

To: Antons, Amanda <Amanda.Antons@dechert.com>; Yang, Yieyie <Yieyie.Yang@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Helm, Katherine <khelm@dechert.com>; berghoff@mbhb.com; lovsin@mbhb.com; vinarov@mbhb.com; Hackman, Blaine <Blaine.Hackman@dechert.com>; Novartis-Zolgensma-542IPR <Novartis-Zolgensma-542IPR@finnegan.com>; Livingstone, John <John.Livingstone@finnegan.com>; Murphy, Amanda <Amanda.Murphy@finnegan.com>; Holt, Cora <Cora.Holt@finnegan.com>; Weingarten, M. David <M.David.Weingarten@finnegan.com>; Weber, Christopher <Christopher.Weber@finnegan.com>

Subject: RE: IPR2023-00608 and IPR2023-00609 - Novartis v. Genzyme

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\cbpat7EXTERNAL Email:

Counsel:

In regard to Petitioner's request for a teleconference, the Board requests that Petitioner ascertain and inform the Board of the availability of both Parties for a call during the week of August 21, 2023, including at least two alternative days and times that week for the call.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Antons, Amanda <Amanda.Antons@dechert.com>

Sent: Friday, August 11, 2023 9:56 AM

Genzyme Ex. 2033
Sarepta Therapeutics, Inc. v. Genzyme Corporation
Page 2 of 4

To: Yang, Yieyie <Yieyie.Yang@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Helm, Katherine <khelm@dechert.com>; berghoff@mbhb.com; lovsin@mbhb.com; vinarov@mbhb.com; Hackman, Blaine <Blaine.Hackman@dechert.com>; Novartis-Zolgensma-542IPR <Novartis-Zolgensma-542IPR@finnegan.com>; Livingstone, John <John.Livingstone@finnegan.com>; Murphy, Amanda <Amanda.Murphy@finnegan.com>; Holt, Cora <Cora.Holt@finnegan.com>; Weingarten, M. David <M.David.Weingarten@finnegan.com>; Weber, Christopher <Christopher.Weber@finnegan.com>

Subject: RE: IPR2023-00608 and IPR2023-00609 - Novartis v. Genzyme

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Dear Honorable Board,

Patent Owner Genzyme opposes Petitioner Novartis's requests leave to file a motion for routine and additional discovery and for a reply. Genzyme takes seriously its duty of candor and fair dealing in all actions before the USPTO and the Board generally, and regarding the '542 patent, including IPR2023-00608 and IPR2023-00609. During the parties meet and confer, Novartis did not point to any specific material documents or information in Genzyme's possession that are inconsistent with any position advanced by Genzyme in the IPR proceedings, including the confidential information alluded to in Novartis's email to the Board.

Genzyme does not think a conference call or further action by the Board is needed but if the Board does decide to hold a teleconference, Genzyme is available at the Board's convenience after 2pm today (Friday) or any time next week.

Respectfully,

Amanda Antons

Reg. No. 65,236

Counsel for Genzyme

Amanda Antons, Ph.D.
Partner

Dechert LLP

312.646.5822
amanda.antons@dechert.com
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From: Yang, Yieyie <Yieyie.Yang@finnegan.com>

Sent: Friday, August 11, 2023 8:11 AM

To: trials@uspto.gov

Cc: Antons, Amanda <Amanda.Antons@dechert.com>; Helm, Katherine <khelm@dechert.com>; berghoff@mbhb.com; lovsin@mbhb.com; vinarov@mbhb.com; Hackman, Blaine <Blaine.Hackman@dechert.com>; Novartis-Zolgensma-542IPR <Novartis-Zolgensma-542IPR@finnegan.com>; Livingstone, John <John.Livingstone@finnegan.com>; Murphy, Amanda <Amanda.Murphy@finnegan.com>; Holt, Cora <Cora.Holt@finnegan.com>; Weingarten, M. David <M.David.Weingarten@finnegan.com>; Weber, Christopher <Christopher.Weber@finnegan.com>

Subject: IPR2023-00608 and IPR2023-00609 - Novartis v. Genzyme

Genzyme Ex. 2033

Sarepta Therapeutics, Inc. v. Genzyme Corporation

Page 3 of 4

To the Honorable Board,

\fi720Petitioner Novartis requested leave to amend its Answer in a parallel district court action to assert inequitable conduct based on the recent discovery of confidential inventor notebooks and other records that expressly contradict arguments made to the PTO to secure allowance of the challenged claims. *See Genzyme Corporation et al. v. Novartis Gene Therapies, Inc. et al.*, No. 21-1736-RGA (D. Del.) at D.I. 250 and 251. This confidential information only became available to Petitioner after Patent Owner submitted its Patent Owner Preliminary Response (POPR).

\fi720

\fi720Patent Owner makes similar contradictory arguments in its POPR. Accordingly, Petitioner reminded Patent Owner of its duty of candor to the Board and its obligation to serve inconsistent information under 37 C.F.R. § 42.51(b)(iii). Patent Owner declined to take further action. Petitioner, therefore, requests leave to file a motion for routine and additional discovery, as well as a short reply, in IPR2023-00608 and IPR2023-00609. As described in D.I. 250 and 251, Petitioner is aware of specific documents containing inconsistent information and wants to ensure that the Board is informed of those documents and their importance to the issues presented in these Petitions for IPR. Patent Owner objects to Petitioner's request. The parties are generally available for a call with the Board today (Friday) and any day next week.

Best Regards,

Yieyie

Yieyie Yang, Ph.D.

Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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