UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDOZ INC.,
Petitioner,

v.

ELI LILLY AND COMPANY,
Patent Owner.

Case No. IPR2016-00318
Patent No. 7,772,209

PATENT OWNER'S PRELIMINARY RESPONSE UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

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Sandoz's Petition should be denied. Taken on its own terms, the Petition fails to establish a reasonable likelihood that Sandoz would prevail as to at least one claim of U.S. Patent No. 7,772,209 (the "'209 patent"). That alone is reason enough not to institute trial.[1]

The Board should also decline to institute trial for an independent reason: essentially the same arguments—if not the identical arguments—that Sandoz raises concerning the validity of the '209 patent have already been litigated in, and rejected by, a federal district court. This decision involved the same prior art that Sandoz raises in its grounds. Indeed, Sandoz even refers to purported "erroneous legal and factual findings" by the District Court as a reason to institute trial. Pet. at 4. But whether the District Court decision was erroneous is now squarely before the Federal Circuit. The appellate court will in all likelihood issue an opinion many months before any decision on the merits here, should trial be instituted. If Sandoz were correct that the District Court's decision was erroneous, it is for the

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[1] Patent Owner Lilly does not in this Preliminary Response seek to address the merits of Sandoz's Petition, nor, necessarily, does it provide the evidence that it will rely on that shows that Sandoz's contentions are without merit. Should trial be instituted, Lilly will address the merits and the nonobviousness of the '209 patent in its Patent Owner Response.

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