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Subject: IPR2016-01624, -00383, -00460
Date: Wednesday, February 17, 2016 1:45:58 PM

Counsel,

We are reaching out to you for two reasons.

First, we observed that the trial institution decision in IPR2016-01624 that issued recently was authored by APJ Christopher Paulraj. Prior to then, we had no knowledge Judge Paulraj would be participating in this or any other proceeding involving the '415 patent. Judge Paulraj was an associate at Sidley Austin LLP between 2005 and 2006, at which time Sidley was representing Genentech in the reexamination of the '415 patent that is at issue in the '01624 proceeding. Sidley has reviewed its records, and has determined that Judge Paulraj billed approximately 10 hours of time to work on the '415 patent reexamination matter. We believe we are required to bring this to the attention of the panel, and seek their guidance on how to proceed.

Second, your client Sanofi is a real party in interest in three different petitions against the '415 patent. The first one has resulted in institution of a trial (i.e., IPR2015-01624). The second (IPR2016-00383) and third (i.e., IPR2016-00460) petitions remain pending before the Board. The '460 petition is essentially identical to the petition Sanofi filed in the '1624 proceeding. We assume your motivation in filing the '460 petition was to preserve your ability to participate in the trial based on the '1624 petition on behalf of Sanofi and its subsidiary Genzyme. To do that, we anticipate you will file a motion for joinder of the '460 petition to the '1624 proceeding soon.

You must certainly appreciate that conducting multiple proceedings on a single patent, particularly on different schedules, is burdensome not only on the patent owners but also on the Board. We therefore invite you to consider filing a joinder motion for your '460 proceeding to the '1624 proceeding, and withdrawing your '383 petition. If you do so before patent owners are required to file their preliminary response to the '383 petition and you agree to adhere to the grounds and schedule of the '1624 proceeding as instituted, Patent Owners would not oppose your joinder motion. If you are interested in this type of arrangement, please let us know at your earliest convenience.

Please let us know at what times on Thursday, Friday and next Monday you would be available for a call with the Board to discuss the issue concerning Judge Paulraj. If you accept our proposal on the joinder motion, we would propose to also raise that issue with the Board on the call.

Sincerely,

JEFFREY KUSHAN

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