Paper No. ___

Filed: June 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELGENX CORPORATION
Petitioner

v.

ICOS CORPORATION
Patent Owner

IPR2016-00678 Patent No. 6,943,166

Patent Owner's Preliminary Response



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TABLE OF AUTHORITIES

Page(s) **Federal Cases** Abbott Labs. v. Baxter Pharm. Prods., Inc., 334 F.3d 1274 (Fed. Cir. 2003).......9 Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111 (Fed. Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd., --F.3d--, 2016 WL 2620512 Merck & Co. v. Teva Pharms. USA, Inc., 395 F.3d 1364 (Fed. Cir. 2005)..... 14, 16 ResQNet.com, Inc. v. Lansa, Inc., 594 F.3d 860 (Fed. Cir. 2010)......9 Patent Trial and Appeal Board Cases Conopco, Inc. v. The Proctor & Gamble Co., IPR2013-00510, Paper 9 (P.T.A.B. Funai Elec. Co. v. Gold Charm Ltd., IPR2015-01491, Paper 15 (P.T.A.B. Dec. 28, Harmonic, Inc. v. Avid Tech., Inc., IPR2013-00252, Paper 12 (P.T.A.B. Sept. 25, Hopkins Mfg. Corp. v. Cequent Performance Prods., Inc., IPR2015-00616, Paper 9 Jiawei Tech. (HK) Ltd. v. Richmond, IPR2014-00937, Paper 22 (P.T.A.B. Dec. 16,



Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co., CBM2013-00003 (P.T.A.B. Oct. 25, 2012)
Medtronic, Inc. v. Lifeport Sci. LLC, IPR2014-00284, Paper 10 (P.T.A.B. June 25, 2014)
Neil Ziegmann, N.P.Z., Inc. v. Stephens, IPR2015-01860, Paper 11 (P.T.A.B. Feb. 24, 2016)
Prism Pharma Co. v. Choongwae Pharma Corp., IPR2014-00315, Paper 14 (P.T.A.B. July 8, 2014)24
Statutes
35 U.S.C. § 312(a)(3)
35 U.S.C. § 314
35 U.S.C. § 325(d)
Other Authorities
H.R. Rep. No. 112-98, pt.1, at 48 (2011)
Regulations
37 C.F.R. § 42.104
37 C.F.R. § 42.108
37 C.F.R. § 42.6
37 CFR 8 42 20



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