

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC., APOTEX CORP., and
ARGENTUM PHARMACEUTICALS LLC,
Petitioners

v.

NOVARTIS AG,
Patent Owner

Case IPR2017-00854¹
U.S. Patent No. 9,187,405

PATENT OWNER'S LIST OF PROPOSED MOTIONS

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

August 23, 2017

¹ Case IPR2017-01550 has been joined with this proceeding.

Pursuant to the Patent Trial and Appeal Board’s Office Patent Trial Practice Guide, and in advance of the initial conference call scheduled for Friday, August 25, 2017 at 1 PM, Patent Owner Novartis AG hereby provides a list of the proposed motions it presently anticipates filing in the above-captioned *inter partes* review (“IPR”) proceeding. Patent Owner has not listed those motions which are automatically authorized by the Board, such as motions to exclude evidence. The “[s]ubmission of [this] list [does] not preclude the filing of additional motions not contained in the list.” See 77 Fed. Reg. 48,756, 48,765 (Aug. 14, 2012).

List of Proposed Motions

1. A motion to amend the claims of the ’405 Patent pursuant to 37 C.F.R. § 42.121.
2. A motion for a protective order and motion(s) to seal confidential information pursuant to 37 C.F.R. § 42.54.
3. A motion to extend Patent Owner’s word limits pursuant to 37 C.F.R. § 42.24(a)(2).
4. A motion to terminate Ground 3 as outside of 35 U.S.C. § 311 limiting institution of an *inter partes* review to “a ground that could be raised under

section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”

5. A motion to dismiss this proceeding as violating the U.S. Constitution by seeking to extinguish private property rights through a non-Article III forum without a jury or a fair opportunity to be heard, or alternatively a motion to stay this proceeding pending the outcome of review by the U.S. Supreme Court of the *Oil States Energy Services, LLC v Greene’s Energy Group LLC*, cert. granted (from IPR2014-00215) case.

Respectfully Submitted,

/Jane M. Love, Ph.D./

Jane M. Love, Ph.D., Reg. No. 42,812
Lead Counsel for Patent Owner

GIBSON, DUNN & CRUTCHER LLP
200 Park Avenue
New York, NY 10166
Jlove@gibsondunn.com
Tel.: 212-351-3922

Dated: August 23, 2017

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 4.26, the undersigned hereby certifies that a true and correct copies of Patent Owner's List of Proposed Motions was served by email upon Petitioner's counsel of record:

For Apotex:

Steven W. Parmelee: sparmelee@wsgr.com

Michael T. Rosato: mrosato@wsgr.com

Jad. A. Mills: jmills@wsgr.com

Wilson Sonsini Goodrich & Rosati
701 Fifth Avenue, Suite 5100
Seattle, WA 98104
Telephone: 206-883-2542

For Argentum:

Teresa Stanek Rea: trea@crowell.com

Deborah H. Yellin: dyelling@crowell.com

Shannon M. Lentz: slentz@crowell.com

Tyler C. Liu: TLiu@agpharm.com

Crowell & Moring LLP
Intellectual Property Group
1001 Pennsylvania Ave, NW
Washington, DC 20004-2595
(202) 624-2620

via electronic mail and secure file transfer, pursuant to agreement of the parties, on the date hereof.

Dated: August 23, 2017

/Jane M. Love, Ph.D./

Jane M. Love, Ph.D., Reg. No. 42,812

Lead Counsel for Patent Owner

GIBSON, DUNN & CRUTCHER LLP

200 Park Avenue

New York, NY 10166

Jlove@gibsondunn.com

Tel.: 212-351-3922

Dated: August 23, 2017