

U.S. Patent No. 9,187,405

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC., APOTEX CORP., ARGENTUM PHARMACEUTICALS LLC,
ACTAVIS ELIZABETH LLC, TEVA PHARMACEUTICALS USA, INC., SUN
PHARMACEUTICAL INDUSTRIES, LTD., SUN PHARMACEUTICAL
INDUSTRIES, INC., AND SUN PHARMA GLOBAL FZE,

Petitioners,

v.

NOVARTIS AG,

Patent Owner.

Case IPR2017-00854¹

U.S. Patent No. 9,187,405

CORRECTED CONTINGENT MOTION TO AMEND

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office

¹ Cases IPR2017-01550, IPR2017-01946, and IPR2017-01929 have been joined
with this proceeding.

P.O. Box 1450
Alexandria, VA 22313-1450

U.S. Patent No. 9,187,405

TABLE OF CONTENTS

	Page
I.....	P
RELIMINARY STATEMENT	1
II.....	F
ACTS	4
A. Proposed Amendments to Claims 1, 3 and 5	4
B. Disclosure of GB 0612721.1, Filed June 27, 2006	6
C. Claims of the '405 Patent	8
D. The Instituted Grounds	8
E. The Federal Circuit Reverses the Burden of Persuasion: <i>Aqua Products, Inc.</i>	9
III.....	A
ARGUMENT	9
A. The Contingent Nature of the Motion	9
B. The Proposed Substitute Claims Are Supported in the Application(s)	10
C. Proposed Amendments Do Not Enlarge the Scope of the Claims.....	12
D. Proposed Amendments Respond to Petitioners' Grounds	13

U.S. Patent No. 9,187,405

1. The Proposed Amendments Respond to Ground 113

2. The Proposed Amendments Respond to Ground 216

3. The Proposed Amendments Respond to Ground 317

IV..... C

ONCLUSION18

APPENDIX A: CLAIM LISTING PURSUANT TO 37 C.F.R. §42.121(B)
PROPOSED SUBSTITUTE CLAIMS19

CERTIFICATE OF COMPLIANCE.....26

CERTIFICATE OF SERVICE.....27

U.S. Patent No. 9,187,405

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Aqua Products, Inc. v. Matal</i> , 872 F.3d 1290 (Fed. Cir. 2017)	1, 9, 13
<i>Corning Optical Communications RF, LLC v PPC Broadband, Inc.</i> , Case No. IPR2014-00441 (P.T.A.B. Oct. 30, 2014)	10
<i>In re Crish</i> , 393 F.3d 1253 (Fed. Cir. 2004)	12
<i>Ex Parte Davis & Tuukkanen</i> , 80 U.S.P.Q. 448 (Bd. App. 1948).....	12
<i>In re Gray</i> , 53 F.2d 520 (C.C.P.A. 1931).....	12
<i>Mannesmann Demag Corp. v. Engineered Metal Prod. Co.</i> , 793 F.2d 1279 (Fed. Cir. 1986)	12
Statutes	
35 U.S.C. § 102.....	17
35 U.S.C. § 112.....	9, 11, 17, 18
35 U.S.C. § 311(b).....	17
Regulations	
37 C.F.R. § 42.121	1, 4, 10

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.