

Trenchard, Robert W.

From: Parmelee, Steve <sparmelee@wsgr.com>
Sent: Tuesday, March 6, 2018 8:31 PM
To: Trenchard, Robert W.; Love, Jane M.; Rosato, Michael; Mills, Jad; TRea@crowell.com; DYellin@crowell.com; SLentz@crowell.com; TLiu@agpharm.com; spark@winston.com; cklein@winston.com; snaqi@winston.com; ahollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com
Subject: RE: IPR2017-00854 - Corrected Motion to Amend

Hi Bob,

We do not object to you making your typo argument in your Reply to the Motion to Amend. We will thoughtfully evaluate the arguments you make in your Reply. Ultimately, the Board will decide how to address the arguments you include in your Reply.

-Steve

From: Trenchard, Robert W. [mailto:RTrenchard@gibsondunn.com]
Sent: Tuesday, March 06, 2018 9:52 AM
To: Parmelee, Steve; Love, Jane M.; Rosato, Michael; Mills, Jad; TRea@crowell.com; DYellin@crowell.com; SLentz@crowell.com; TLiu@agpharm.com; spark@winston.com; cklein@winston.com; snaqi@winston.com; ahollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com
Subject: RE: IPR2017-00854 - Corrected Motion to Amend

Hi Steve. Petitioners' brief makes clear that they knew this was a typo. That's why Petitioners' brief contains extensive argument on the assumption that the compound in the amended claims is the same as in the existing claims. In any event, we would be willing to correct the typo on reply only if Petitioners agree not object to the correction, and that our correction on reply will be the end of the issue.

If, however, Petitioners plan to object to the correction of this obvious typo, then we need to know now to tee the issue up with the Board. If Petitioners currently plan to object, we do urge Petitioners to reconsider that position. Petitioners' papers brought the typo to our attention, so the passage of time you cite is irrelevant. Petitioners could have bring the typo to our attention before briefing the issue. Petitioners extensively briefed issues relevant only if the proposed amendment is construed as containing a typo. We think the Board would appreciate the parties working the issue out themselves rather than having to bring another procedural issue to the Board.

In that regard, the *Microsoft Corp v. Surfcast, Inc.*, IPR2013-00292 (Paper 77 June 4, 2014), opinion permitted corrections to a motion to amend even after briefing was completed, and *Zodiac Pool Systems, Inc. v. Aqua Products, Inc.* PTAB-IPR2013-00159 (Paper 37 Feb. 14, 2013), allowed corrections to typos in the proposed amended claims. So we believe that ample support exists to correct the motion.

Given *In re Aqua*, we believe that it is paramount that the Board address a motion to amend on the merits, not based on typos. Please let us know, by the end of today, Petitioners' position on either of the two paths forward:

1. Agreeing that Patent Owner can correct the typo on reply without objection; or
2. Permitting a correction now and affording Petitioners an opportunity to address the corrected claims in a prompt amended brief (by March 16) that deletes the argument based on the typo, if Petitioners want to do

Best, Bob and Jane.

Robert Trenchard

GIBSON DUNN

Gibson, Dunn & Crutcher LLP
200 Park Avenue, New York, NY 10166-0193
Tel +1 212.351.3942 • Fax +1 212.351.5242
RTrenchard@gibsondunn.com • www.gibsondunn.com

From: Parmelee, Steve [<mailto:sparmelee@wsgr.com>]

Sent: Monday, March 5, 2018 9:10 PM

To: Love, Jane M. <JLove@gibsondunn.com>; Rosato, Michael <mrosato@wsgr.com>; Mills, Jad <jmills@wsgr.com>; TRea@crowell.com; DYellin@crowell.com; SLentz@crowell.com; T Liu@agpharm.com; spark@winston.com; cklein@winston.com; snagi@winston.com; ahollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com; Trenchard, Robert W. <RTrenchard@gibsondunn.com>

Subject: RE: IPR2017-00854 - Corrected Motion to Amend

Jane,

Because it's now been 16 weeks since you filed the Patent Owner's Motion to Amend, and more than two weeks since we filed our Opposition, we think it's more appropriate for P.O. to address this issue in its Reply brief. None of the cases you have cited appears to involve facts similar to the situation here. Your proposal to submit a Corrected Motion to Amend and engage in additional briefing does not seem appropriate at this stage.

-Steve

From: Love, Jane M. [<mailto:JLove@gibsondunn.com>]

Sent: Saturday, March 03, 2018 5:46 AM

To: Parmelee, Steve; Rosato, Michael; Mills, Jad; TRea@crowell.com; DYellin@crowell.com; SLentz@crowell.com; T Liu@agpharm.com; spark@winston.com; cklein@winston.com; snagi@winston.com; ahollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com

Cc: Love, Jane M.; Trenchard, Robert W.

Subject: IPR2017-00854 - Corrected Motion to Amend

Hello Counsel.

Petitioners' opposition to Novartis's motion to amend identifies a clerical error (a typo) in the motion. Novartis intends to ask the Board for permission to correct the typo via a corrected motion to amend. Per Board practice, we are writing to ask Petitioners to agree to the motion. We understand such consent is usually routine, including to correct clerical errors in the proposed amended claims. *See, e.g., McWane v. Waugh*, IPR2016-00266 (Paper 24 September 3, 2016); *Microsoft Corp v. Proxyconn, Inc.*, IPR2012-00026 and IPR2013-00109 (Paper 43 June 20, 2013); *Zodiac Pool Systems, Inc. v. Aqua Products, Inc.* PTAB-IPR2013-00159 (Paper 37 Feb. 14, 2013). We would prefer not to burden the Board again with a contested issue, though we note that the Board has resolved such motions on a contested basis before in favor of permitting a correction. *See Microsoft Corp v. Surfcast, Inc.*, IPR2013-00292 (Paper 77 June 4, 2014).

In the event that Petitioners would like to amend their response to the motion to amend in view of the correction, we would have no objection in concept so long as we received an amended response by March 14, 2018.

Please let us have Petitioners' views by the end of the day on Monday, March 5th.

Best, Jane and Bob

This message may contain confidential and privileged information. If it has been sent to you in error, please reply to advise the sender of the error and then immediately delete this message.

This email and any attachments thereto may contain private, confidential, and privileged material for the sole use of the intended recipient. Any review, copying, or distribution of this email (or any attachments thereto) by others is strictly prohibited. If you are not the intended recipient, please contact the sender immediately and permanently delete the original and any copies of this email and any attachments thereto.