

Mills, Jad

From: Parmelee, Steve
Sent: Wednesday, March 07, 2018 9:15 AM
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 providing justification in your Reply for making the change to your Motion to Amend that you have proposed. Until you brief the issue in your Reply, we cannot take a position on whether your (as yet unwritten and unreviewed) briefing justifies making the change. It will be unfortunate if you choose to burden the Board needlessly when we have already agreed not to object to you addressing this issue in your Reply.

-Steve

From: Trenchard, Robert W. [mailto:RTrenchard@gibsondunn.com]
Sent: Wednesday, March 07, 2018 7:20 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. It sounds as if Petitioners are reserving their right to object to a correction to the typo on reply, but also not agreeing to a corrected motion now. Please confirm or correct our understanding by 2 pm EST today. Assuming our understanding is correct, we plan thereafter to seek guidance from the Board. Best, Bob and Jane.

Robert Trenchard

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From: Parmelee, Steve [mailto:sparmelee@wsgr.com]
Sent: Tuesday, March 6, 2018 8:31 PM
To: Trenchard, Robert W. <RTrenchard@gibsondunn.com>; 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; 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; T Liu@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 so. Petitioners would of course be free to use that space for anything else they want to say.

Best, Bob and Jane.

Robert Trenchard

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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; snaji@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; snaji@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

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