

From: Trials

Sent: Thursday, October 05, 2017 4:16 PM

To: Love, Jane M. <JLove@gibsondunn.com>

Cc: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; trea@crowell.com; Yellin, Deborah <DYellin@crowell.com>; slentz@crowell.com; TLiu@agpharm.com; SPark@winston.com; CKlein@winston.com; SNaqi@winston.com; amanda.hollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com; Trenchard, Robert W. <RTrenchard@gibsondunn.com>; 'Parmelee, Steve' <sparmelee@wsgr.com>

Subject: RE: IPR2017-00854 - Request for Conference Call re: In re Aqua

Counsel:

In light of the Federal Circuit's decision in *In re Aqua Products*, and Patent Owner's consideration of a motion to amend, Due Date 1 is postponed by 4 weeks to Friday, November 10. All other due dates will be adjusted accordingly to avoid inconveniencing either party. A revised scheduling Order setting new dates for the remainder of this proceeding will issue shortly. A conference call is not necessary at this time.

Regards,

Eric Hawthorne

Supervisory Paralegal Specialist

Patent Trial and Appeal Board

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

Sent: Thursday, October 05, 2017 3:54 PM

To: Trials <Trials@USPTO.GOV>

Cc: Mills, Jad <jmills@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; trea@crowell.com; Yellin, Deborah <DYellin@crowell.com>; slentz@crowell.com; TLiu@agpharm.com; SPark@winston.com; CKlein@winston.com; SNaqi@winston.com; amanda.hollis@kirkland.com; Love, Jane M. <JLove@gibsondunn.com>; egoryunov@kirkland.com; greg.springsted@kirkland.com; Trenchard, Robert W. <RTrenchard@gibsondunn.com>; 'Parmelee, Steve' <sparmelee@wsgr.com>

Subject: RE: IPR2017-00854 - Request for Conference Call re: In re Aqua

To the Patent Trial and Appeal Board in IPR2017-00854:

We misunderstood Petitioners' offer to speak about an extension within the existing schedule, for which we apologize to the Board and Mr. Parmelee.

We do think an extension of the entire schedule is called for in this unusual circumstance, as we explained in the email Mr. Parmelee attached to his email to the Board.

We believe that a meet and confer to adjust due dates within the existing schedule will not suffice, and will simply delay resolution further.

We thus respectfully request an expedited phone conference with the Board to address the issue.

Respectfully submitted,
Jane M. Love (Lead Counsel for Patent Owner)

Jane M. Love, Ph.D.

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From: Parmelee, Steve [<mailto:sparmelee@wsgr.com>]
Sent: Thursday, October 05, 2017 3:39 PM
To: 'Trials'
Cc: Mills, Jad; Rosato, Michael; trea@crowell.com; Yellin, Deborah; slentz@crowell.com; T Liu@agpharm.com; SPark@winston.com; CKlein@winston.com; SNaqi@winston.com; amanda.hollis@kirkland.com; egoryunov@kirkland.com; greg.springsted@kirkland.com; Trenchard, Robert W.; Love, Jane M.
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Dear Trials,

We object to Patent Owner's email below for misrepresenting the parties' correspondence on this issue. This is a recurring issue in this IPR.

It is Petitioner's view that the *Aqua Products* decision does not require an extension of Patent Owner's deadlines to file its patent owner response or motion to amend, and certainly is not good cause for waiving the statutory requirement that the IPR trial be completed within one year of institution. We believe any time adjustments can be accommodated under the current schedule by stipulations between the parties.

As to the issue of stipulated extensions of time, we did offer to discuss an extension of Patent Owner's filing dates as a matter of professional courtesy. The parties have not yet had that discussion, and a two-week extension was never discussed--contrary to Patent Owner's statements below. The parties' correspondence on this issue is memorialized in the attached email chain.

We believe the Board should direct the parties to meet and confer on this issue, and explore whether they can obviate the need to burden the Board. Of course, we can be available at the Board's convenience to discuss case schedule with the Board should a conference call be deemed appropriate.

Respectfully,

Steven W. Parmelee

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From: Love, Jane M. [<mailto:JLove@gibsondunn.com>]
Sent: Thursday, October 05, 2017 11:16 AM
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Subject: IPR2017-00854 - Request for Conference Call re: In re Aqua

To the Patent Trial and Appeal Board in IPR2017-00854:

As the Board is likely aware, yesterday the Federal Circuit decided *In re Aqua*. The Circuit overturned the PTAB's existing rules regarding burdens of proof in motions to amend.

The Board will recall that Patent Owner Novartis AG is actively considering a motion to amend in this proceeding. Currently, Novartis AG's Patent Owner's response and accompanying motion to amend are due Friday, October 13, 2017.

We request a teleconference with the Board to seek an extension of the entire schedule in this and all consolidated IPRs by one month. That will allow time to digest the decision, assess its impact on a possible motion to amend, and address with Petitioners how to deal with such a motion from a procedural perspective.

In emails last night, Petitioners graciously offered to extend our time to file by two weeks, but within the current schedule. We appreciate the offer but believe that the issues will require more time to work out, including the shape and nature of the record that must accompany the application for amended claims, as well as the schedule for briefing on those claims. Our goal is to have enough time for the parties to try to reach agreement on all issues and then present them to the Board. An agreed-upon framework of course would reduce the risk of procedural error.

Given the timing of Patent Owner's impending due date, we respectfully request that any conference occur on an expedited basis.

Respectfully submitted,
Jane M. Love, Ph.D.
Lead Counsel for Patent Owner

Copy to: Petitioners' Counsel

Jane M. Love, Ph.D.

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