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UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.,  
Petitioner,

v.

GENENTECH, INC.,  
Patent Owner.

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Case IPR2017-02031  
Patent No. 6,407,213

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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Genentech, Inc. ("Patent Owner" or "Genentech") submits this Preliminary Response to the Petition that Boehringer Ingelheim Pharmaceuticals, Inc. ("Petitioner" or "Boehringer") filed challenging certain claims of U.S. Patent No. 6,407,213 ("the '213 patent") (Paper 2).

## I. INTRODUCTION

On December 1, 2017, the Board instituted four IPRs in which Celltrion, Inc. (IPR2017-01373 and IPR2017-01374) and Pfizer, Inc. (IPR2017-01488 and IPR2017-01489) have challenged numerous claims of the '213 patent (based on a total of 32 separate grounds). Patent Owner's responses in those proceedings are due on February 15, 2018.

More than three months after Celltrion and Pfizer filed their now-instituted petitions, Boehringer filed the present Petition (and a second petition in IPR2017-02032). The Board should deny institution of the Boehringer petitions under 35 U.S.C. § 325(d) for at least two reasons.

*First*, Boehringer copied Grounds 1-3 and 5 of this Petition from IPR2017-01374 (Celltrion) and IPR2017-01488 (Pfizer), and copied Grounds 1-5 of IPR2017-02032 from IPR2017-01373 (Celltrion) and IPR2017-01489 (Pfizer)—without seeking joinder with those earlier-filed proceedings. Boehringer thus asks the Board to institute its IPRs on the *same* grounds *already instituted* in the Celltrion and Pfizer proceedings—but on a schedule trailing those proceedings by

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