

Arnold B. Calmann (abc@saiber.com)  
Katherine A. Escanlar (kae@saiber.com)  
**SAIBER LLC**  
One Gateway Center, 10th Floor, Suite 1000  
Newark, New Jersey 07102  
Telephone: (973) 622-3333

Douglas H. Carsten (dcarsten@wsgr.com)  
Elham Firouzi Steiner (esteiner@wsgr.com)  
Nathaniel R. Scharn (nscharn@wsgr.com)  
Alina L. Litoshyk (alitoshyk@wsgr.com)  
James P.H. Stephens (jstephens@wsgr.com)  
**WILSON SONSINGOODRICH & ROSATI P.C.**  
12235 El Camino Real  
San Diego, California 92130  
Telephone: (858) 350-2300

*Attorneys for Defendant Mylan GmbH.*

**IN THE UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY**

SANOFI-AVENTIS U.S. LLC, SANOFI-  
AVENTIS DEUTSCHLAND GMBH, and  
SANOFI WINTHROP INDUSTRIE,

Plaintiffs,

v.

MYLAN GMBH,

Defendant.

C.A. No. 17-cv-09105-SRC-CLW

**MYLAN GMBH'S INVALIDITY CONTENTIONS**

Pursuant to Local Patent Rules 3.3 and 3.6, Defendant Mylan GmbH hereby submits its Invalidation Contentions (“Invalidity Contentions”) to Plaintiffs Sanofi-Aventis U.S. LLC, Sanofi-Aventis Deutschland GmbH, and Sanofi Winthrop Industrie (collectively, “Sanofi” or “Plaintiffs”).

These Invalidation Contentions are made in response to Sanofi’s Complaint (filed October 24, 2017 (Dkt. No. 1)) and Disclosure of Asserted Claims (served December 26, 2017)

## 7. Obviousness Combinations

Pursuant to Local Patent Rule 3.3(b), Mylan GmbH identifies the combinations of prior art included in the attached claim charts as the combinations that render the claims obvious. Many of the prior art references disclosed therein disclose or render obvious asserted claims on their own, but to the extent Sanofi contends the prior art lacks any certain limitation of the patents-in-suit, the POSA would have been motivated to combine any given primary reference with other disclosed references to arrive at the claimed invention.

This case is in the early stages, with most discovery still upcoming, and the close of fact discovery is still eight months away. The Court has not construed any claims, and expert reports are not due until sometime after the Court's claim construction order. Further, Sanofi has only recently disclosed its validity and infringement contentions, but may seek leave to amend its contentions in the future. As a result, Mylan GmbH reserves the right to supplement and/or amend these Contentions in response to positions taken by Sanofi with additional selections from the cited prior art, as well as with additional prior art references.

In addition, Sanofi's Responses to Invalidity Contentions generically deny that many limitations are present in the prior art, and do so without explanation. *See, e.g.*, Infringement Contentions, Exhibit C at 36-37. As a result, Mylan GmbH is unable to further narrow the range of combinations that it may rely on at trial. Additional disclosure is also premature, as Mylan GmbH is not required to provide its expert report on invalidity until after claim construction. In the spirit of cooperation, however, while reserving the right to rely on any combination described in the attached claim chart for this patent, Mylan GmbH hereby identifies exemplary combinations that it may be more likely to rely on:

- Judson, alone or in combination with Steinfeldt-Jensen, Atterbury, Møller, Burroughs, Bechtold, Bendek, Chanoch, Frezza, Giambattista '095, Giambattista.

'794, Haber '160, Haber '528, Harris '895, Harris '896, Hjertman, Horstman, Kirchhofer '023, Kirchhofer '224, Kovelman, Polzin, Roe, Sams '591, Wilkens, Balkwill, Sams '152, Haber '609, Michel, Gabriel, Pawelka, Walters '495, Kirchofer '698, Bush, and Walters '471;

- Steinfeldt-Jensen, alone or in combination with Judson, Atterbury, Møller, Burroughs, Bechtold, Bendek, Chanoch, Frezza, Giambattista '095, Giambattista '794, Haber '160, Haber '528, Harris '895, Harris '896, Hjertman, Horstman, Kirchhofer '023, Kirchhofer '224, Kovelman, Polzin, Roe, Sams '591, Wilkens, Balkwill, Sams '152, Haber '609, Michel, Gabriel, Pawelka, Walters '495, Kirchofer '698, Bush, and Walters '471;
- Burroughs, alone or in combination with Judson, Steinfeldt-Jensen, Atterbury, Møller, Bechtold, Bendek, Chanoch, Frezza, Giambattista '095, Giambattista '794, Haber '160, Haber '528, Harris '895, Harris '896, Hjertman, Horstman, Kirchhofer '023, Kirchhofer '224, Kovelman, Polzin, Roe, Sams '591, Wilkens, Balkwill, Sams '152, Haber '609, Michel, Gabriel, Pawelka, Walters '495, Kirchofer '698, Bush, and Walters '471;
- Møller, alone or in combination with Judson, Steinfeldt-Jensen, Atterbury, Burroughs, Bechtold, Bendek, Chanoch, Frezza, Giambattista '095, Giambattista '794, Haber '160, Haber '528, Harris '895, Harris '896, Hjertman, Horstman, Kirchhofer '023, Kirchhofer '224, Kovelman, Polzin, Roe, and Sams '591, Wilkens, Balkwill, Sams '152, Haber '609, Michel, Gabriel, Pawelka, Walters '495, Kirchofer '698, Bush, and Walters '471;

Dated: April 25, 2018

**SAIBER LLC**

By: s/ Arnold B. Calman

Arnold B. Calmann ([ACalmann@saiber.com](mailto:ACalmann@saiber.com))

Katherine Escanlar ([KEscanlar@saiber.com](mailto:KEscanlar@saiber.com))

One Gateway Center, Suite 1000

Newark, New Jersey 07102

Telephone: (973) 622-3333

OF COUNSEL:

WILSON SONSINI GOODRICH &

ROSATI

Douglas H. Carsten ([dcarsten@wsgr.com](mailto:dcarsten@wsgr.com))

Elham Firouzi Steiner ([esteiner@wsgr.com](mailto:esteiner@wsgr.com))

Nathaniel R. Scharn ([nscharn@wsgr.com](mailto:nscharn@wsgr.com))

Alina L. Litoshyk ([alitoshyk@wsgr.com](mailto:alitoshyk@wsgr.com))

12235 El Camino Real

San Diego, CA 92130-3002

Phone: (858) 350-2300

Fax: (858) 350-2399

*Attorneys for Defendant Mylan GmbH.*