

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC.
Petitioner,

v.

UCB BIOPHARMA SPRL,
Patent Owner.

Case IPR2019-00400
Patent 8,633,194

**PATENT OWNER'S REQUEST FOR ORAL ARGUMENT
UNDER 37 C.F.R. § 42.70(a)**

Pursuant to 37 C.F.R. § 42.70(a) and the Board’s October 7, 2020 Revised Scheduling Order (Paper 21), Patent Owner UCB Biopharma Sprl (“Patent Owner”) respectfully requests oral argument in IPR2019-00400, which Patent Owner understands is currently scheduled for April 22, 2020.

Pursuant to 37 C.F.R. § 42.70(a), Patent Owner respectfully requests up to thirty (30) minutes of oral argument per side on all issues raised. These issues include, but are not limited to, the following:

1. The scope and content of the prior art.
2. The patentability of claims 1-11 of U.S. Patent No. 8,633,194 in view of Ground 1: The combination of WO 2004/050094 (“WO ’094”) in view of the Handbook of Pharmaceutical Excipients, Third Edition (the “Handbook”) under 35 U.S.C. § 103.
3. The patentability of claims 1-11 of U.S. Patent No. 8,633,194 in view of Ground 2: The combination of European Patent Application No. 0605203 A2 (“EP ’203”) in view of the Handbook and U.S. Patent No. 5,698,558 (“the ’558 patent”) under 35 U.S.C. § 103.
4. The issues raised in Petitioner’s Request for Oral Argument (Paper 39).
5. Any issues raised by the Petitioner at the oral argument.

6. Any other issues raised in papers filed in this proceeding, including issues to be raised in papers not yet filed or filed concurrently, such as Motions to Exclude or Strike.
7. Additional issues on which the Board seeks information or clarification.

Subject to the Board's approval, Patent Owner intends to use demonstrative exhibits during the oral argument. Such demonstrative exhibits will be served in due course according to 37 C.F.R. § 42.70(b). Patent Owner also requests the use of audio-visual equipment during its presentation, including a computer, projector, and screen on which to display demonstrative exhibits. Patent Owner does not anticipate that more than five (5) individuals will attend the argument on its behalf.

Dated: March 5, 2020

Respectfully submitted,

FENWICK & WEST LLP
/s/ Robert E. Counihan (electronically signed)
James S. Trainor, Reg. No. 52,297
Lead Counsel

Robert E. Counihan, Reg. No. 61,382
Back-Up Counsel

FENWICK & WEST LLP
902 Broadway, Suite 14
New York, NY 10010
(212) 430-2600
jtrainor@fenwick.com
rcounihan@fenwick.com

IPR2019-00400
Patent 8,633,194

Erica R. Sutter, Reg. No. 77,450
Back-Up Counsel

FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
(650) 988-8500
esutter@fenwick.com

*Counsel for Patent Owner UCB Biopharma
Sprl*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on March 5, 2020, the foregoing document is being served by filing this document through the Patent Trial and Appeal Board End to End System, as well as by delivering a copy via electronic mail upon the following counsel of record for the Petitioner:

jitty.malik@kattenlaw.com
alissa.pacchioli@kattenlaw.com
joe.janusz@kattenlaw.com
lance.soderstrom@kattenlaw.com

Date: March 5, 2020

Respectfully submitted,

/Robert E. Counihan/

Robert E. Counihan
Reg. No. 61,382
Phone: (212) 430-2600