

Ferenc, Christopher B.

From: Ferenc, Christopher B.
Sent: Thursday, April 25, 2019 4:57 PM
To: Feldstein, Mark; McCurdy, Barbara; Sommers, Erin; DeRoo, Pier; BMWWhite@perkinscoie.com; EGreb@perkinscoie.com
Cc: Sodikoff, Brian
Subject: FW: IPR2019-00789

FilingDate: None

Counsel:

Sawai states that "if joined to the Mylan IPR (IPR2018-01403), Sawai does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case." Sawai will file its Reply in the normal course, and absent hearing otherwise, Sawai plans to indicate in its Reply that it has contacted Mylan but not received a response on the declaration situation.

Furthermore, Sawai has no objection to the panel revisiting the declarant situation should it become an issue when deciding Sawai's Motion for Joinder.

To the extent you have anything to add, please respond to this email.

Best regards,

Chris Ferenc
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

Christopher B. Ferenc
Associate
Katten Muchin Rosenman LLP
2900 K Street NW, North Tower - Suite 200 / Washington, DC 20007-5118 p / +1.202.625.3647 f / +1.202.339.6044
christopher.ferenc@kattenlaw.com / www.kattenlaw.com

-----Original Message-----

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, April 24, 2019 3:17 PM
To: Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; BMWWhite@perkinscoie.com; EGreb@perkinscoie.com; Sodikoff, Brian <brian.sodikoff@kattenlaw.com>
Subject: RE: IPR2019-00789

Counsel:

The panel has received Sawai's Motion for Joinder. The panel understands that, if joined to the Mylan IPR (IPR2018-01403), Sawai does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case. In this situation, the panel advises Sawai to file its Reply in the normal course, and to indicate in the Reply that it has contacted Mylan but not received a response, if that remains the case. The panel can

revisit the matter should the declarant situation become an issue when deciding Sawai's Motion for Joinder. A teleconference is not necessary if the above is agreeable to the parties.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

-----Original Message-----

From: Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com>
Sent: Friday, April 19, 2019 7:44 AM
To: Trials <Trials@USPTO.GOV>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; BMWhite@perkinscoie.com; EGreb@perkinscoie.com; Sodikoff, Brian <brian.sodikoff@kattenlaw.com>
Subject: Re: IPR2019-00789

Dear PTAB,

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

We are following up on the Board's April 12th correspondence (below) requesting Sawai to check back in with the Board regarding Sawai's request for a telephone conference with the Board. It is Sawai's understanding that the panel for IPR2019-00789 would be the same as the Mylan IPR. Thus, Sawai requests a telephone conference between the parties and Judges Snedden, Chagnon and Hawlow, the panel assigned to IPR2018-01403. As explained in Sawai's motion for Joinder in IPR2019-00789 (Paper 2), Sawai seeks Mylan's permission to use the same experts Mylan used in IPR2018-01403. Over the past few weeks, Sawai has made numerous efforts (including emails and voice mails to Mylan's counsel) to get Mylan's position on whether Mylan will allow Sawai to use its experts. Mylan has refused to answer one way or another. (Sawai is willing to provide the PTAB with copies of its email correspondence to counsel for Mylan upon request of the PTAB.)

Sawai requests a conference with Judges Snedden, Chagnon and Hawlow, and asks the panel to Order Mylan to provide its answer. Sawai needs this information so that it can properly respond in its Reply to Patent Owner's Opposition to Motion for joinder. As stated in Sawai's previous emails to the PTAB, during any conference call with the PTAB, Sawai welcomes any additional instructions from the PTAB regarding the Motion for Joinder.

Best regards,

Chris Ferenc
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

Christopher B. Ferenc
Associate
Katten Muchin Rosenman LLP
2900 K Street NW
Suite 200

Washington, DC. 20007
(202) 625-3647
christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com>

On Apr 12, 2019, at 10:37 AM, Trials <Trials@uspto.gov<mailto:Trials@uspto.gov>> wrote:

Counsel: We do not have a panel for this case yet. Please check back this time next week.

Thank you,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com>>
Sent: Friday, April 12, 2019 10:27 AM
To: Trials <Trials@USPTO.GOV<mailto:Trials@USPTO.GOV>>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com<mailto:mark.feldstein@finnegan.com>>; McCurdy, Barbara <barbara.mccurdy@finnegan.com<mailto:barbara.mccurdy@finnegan.com>>; Sommers, Erin <Erin.Sommers@finnegan.com<mailto:Erin.Sommers@finnegan.com>>; DeRoo, Pier <Pier.DeRoo@finnegan.com<mailto:Pier.DeRoo@finnegan.com>>; BMWhite@perkinscoie.com<mailto:BMWhite@perkinscoie.com>; EGreb@perkinscoie.com<mailto:EGreb@perkinscoie.com>; Sodikoff, Brian <brian.sodikoff@kattenlaw.com<mailto:brian.sodikoff@kattenlaw.com>>
Subject: RE: IPR2019-00789

Dear PTAB,

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

We are following up on the Board's March 26th correspondence (below) requesting Sawai to check back in with the Board regarding Sawai's request for a telephone conference with the Board. Specifically, Sawai requests a telephone conference between the parties and Judges Snedden, Chagnon and Hawlow, the panel assigned to IPR2018-01403. As explained in Sawai's motion for Joinder in IPR2019-00789 (Paper 2), Sawai seeks Mylan's permission to use the same experts Mylan used in IPR2018-01403. Over the past few weeks, Sawai has made numerous efforts (including emails and voice mails to Mylan's counsel) to get Mylan's position on whether Mylan will allow Sawai to use its experts. Mylan has refused to answer one way or another. (Sawai is willing to provide the PTAB with copies of its email correspondence to counsel for Mylan upon request of the PTAB.)

Sawai requests a conference with Judges Snedden, Chagnon and Hawlow, and asks the panel to Order Mylan to provide its answer. Sawai needs this information so that it can properly respond in its Reply to Patent Owner's Opposition to Motion for joinder. As stated Sawai's email to the PTAB on March 26th, during any conference call with the PTAB, Sawai welcomes any additional instructions from the PTAB regarding the Motion for Joinder.

Best regards,

Chris Ferenc
Counsel for Sawai USA, Inc. and Sawai

Christopher B. Ferenc
Associate
Katten Muchin Rosenman LLP

2900 K Street NW, North Tower - Suite 200 / Washington, DC 20007-5118 p / +1.202.625.3647 f / +1.202.339.6044
christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com> /
<https://gcc01.safelinks.protection.outlook.com/?url=www.kattenlaw.com&data=02%7C01%7Ctri%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666330595&data=5s2vnxGbf8ozsYtlv2f8kwarCq5y8%2BQ6s1TE%2FpfUKQ%3D&reserved=0><<https://gcc01.safelinks.protection.outlook.com/?url=http%3A%2F%2Fwww.kattenlaw.com&data=02%7C01%7Ctri%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666340599&data=Tr08HDI%2Fme67ferRwLvcGaQyBPARIKERRYkB1pnKZ2Q%3D&reserved=0>>

From: Trials <Trials@USPTO.GOV<mailto:Trials@USPTO.GOV>>

Sent: Tuesday, March 26, 2019 12:46 PM

To: Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com>>; Trials <Trials@USPTO.GOV<mailto:Trials@USPTO.GOV>>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com<mailto:mark.feldstein@finnegan.com>>; McCurdy, Barbara <barbara.mccurdy@finnegan.com<mailto:barbara.mccurdy@finnegan.com>>; Sommers, Erin <Erin.Sommers@finnegan.com<mailto:Erin.Sommers@finnegan.com>>; DeRoo, Pier <Pier.DeRoo@finnegan.com<mailto:Pier.DeRoo@finnegan.com>>; BMWhite@perkinscoie.com<mailto:BMWhite@perkinscoie.com>; EGreb@perkinscoie.com<mailto:EGreb@perkinscoie.com>; Sodikoff, Brian <brian.sodikoff@kattenlaw.com<mailto:brian.sodikoff@kattenlaw.com>>
Subject: RE: IPR2019-00789

Counsel: We do not have a panel for this case yet. Please check back in a couple of weeks.
Thank you,

Maria King
Deputy Chief Clerk for Trials
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
703-756-1288

From: Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com>>
Sent: Tuesday, March 26, 2019 12:32 PM
To: Trials <Trials@USPTO.GOV<mailto:Trials@USPTO.GOV>>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com<mailto:mark.feldstein@finnegan.com>>; McCurdy, Barbara <barbara.mccurdy@finnegan.com<mailto:barbara.mccurdy@finnegan.com>>; Sommers, Erin <Erin.Sommers@finnegan.com<mailto:Erin.Sommers@finnegan.com>>; DeRoo, Pier <Pier.DeRoo@finnegan.com<mailto:Pier.DeRoo@finnegan.com>>; BMWhite@perkinscoie.com<mailto:BMWhite@perkinscoie.com>; EGreb@perkinscoie.com<mailto:EGreb@perkinscoie.com>; Sodikoff, Brian <brian.sodikoff@kattenlaw.com<mailto:brian.sodikoff@kattenlaw.com>>
Subject: IPR2019-00789

Your Honors:

We represent petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") in the pending inter partes review, Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. v. Biogen MA, Inc., IPR2019-00789. As you are aware, Sawai filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) requesting joinder with a pending inter partes review filed by Mylan Pharmaceuticals, Inc., Mylan Pharmaceuticals, Inc. v. Biogen MA Inc., IPR2018-01403 ("Mylan IPR").

All parties are in the process of setting up a meet and confer to discuss Sawai's pending joinder motion. Ahead of the meet and confer, Sawai wanted to know if the panel had any additional instructions regarding the Motion for Joinder that the parties should discuss during any meet and confer.

Counsel for all parties has been copied on this email and were provided a copy for prior consideration. Without further elaboration, (only) counsel for Biogen responded as follows: "Biogen believes that Sawai's proposed email to the Board is improper at this time."

Best regards,

Chris Ferenc
Counsel for Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd.

Christopher B. Ferenc
Associate
Katten Muchin Rosenman LLP
2900 K Street NW, North Tower - Suite 200 / Washington, DC 20007-5118 p / +1.202.625.3647 f / +1.202.339.6044
christopher.ferenc@kattenlaw.com<mailto:christopher.ferenc@kattenlaw.com> /
<https://gcc01.safelinks.protection.outlook.com/?url=www.kattenlaw.com&data=02%7C01%7Ctri%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666340599&sdata=cMtojmPEIaVKd8dtq%2Fa8SLyAWeayQnL4SnK8b34VaKA%3D&reserved=0>
<https://gcc01.safelinks.protection.outlook.com/?url=http%3A%2F%2Fwww.kattenlaw.com&data=02%7C01%7Ctri%40uspto.gov%7C8fddc872b152437f296708d6c4bc5ec6%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C636912710666340599&sdata=Tr08HDJ%2Fme67ferRwLvcGaQyBPAIKERRYkB1pnK22Q%3D&reserved=0>

=====

CONFIDENTIALITY NOTICE:

This electronic mail message and any attached files contain information intended for the exclusive use of the individual or entity to whom it is addressed and may contain information that is proprietary, privileged, confidential and/or exempt from disclosure under applicable law. If you are not the intended recipient, you are hereby notified that any viewing, copying, disclosure or distribution of this information may be subject to legal restriction or sanction. Please notify the sender, by electronic mail or telephone, of any unintended recipients and delete the original message without making any copies.

=====

NOTIFICATION: Katten Muchin Rosenman LLP is an Illinois limited liability partnership that has



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.