

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner

Case IPR2019-00977
Patent No. 8,603,044 B2

**REPLY IN SUPPORT OF PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22, 42.122(b)**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via the PTAB E2E System

TABLE OF CONTENTS

I. ADDITIONAL STATEMENT OF MATERIAL FACTS AND PRECISE RELIEF REQUESTED1

II. CONCLUSION2

I. ADDITIONAL STATEMENT OF MATERIAL FACTS AND PRECISE RELIEF REQUESTED

In its response to Petitioner's ("Pfizer") Motion for Joinder, Patent Owner ("Sanofi") indicated that it does not oppose joinder but requested a 1-month extension of the schedule if the Board were to grant joinder. According to Sanofi, an extension is necessary to allow sufficient time to cross-examine Mr. Charles Clemens (Pfizer's expert), and incorporate both his and Mr. Karl Leinsing's (Mylan's expert) testimony into Patent Owner's Response, which is currently due on June 25, 2019.

After Sanofi filed its response, the parties have had discussions to try to resolve any dispute as to joinder and have reached the following agreements such that joinder can be granted without the need for any extension to the schedule:

- Pfizer and Mylan have agreed that Pfizer can co-retain Mylan's expert Mr. Leinsing. As such, and assuming the requested joinder is granted, Pfizer will withdraw its expert declaration of Mr. Clemens as it pertains to all but two of the challenged claims of the '044, '069, '486, '844, and '008 patents, and instead rely on the declaration and testimony of Mylan's expert Mr. Leinsing.¹ See *SAP America Inc. v. Clouding IP*,

¹ Pfizer will withdraw Mr. Clemens' expert declaration as to all challenged claims except for claims 2 and 3 of the '069 patent, which were not challenged by Mylan

LLC, IPR2014-00306, Paper 13 at 4 (PTAB May 19, 2014).

- With Pfizer's withdrawal of Mr. Clemens' expert declaration as described above, Sanofi will not seek to depose Mr. Clemens prior to submitting its Patent Owner's Response on June 25, 2019. Sanofi also does not oppose Pfizer's reliance on Mr. Leinsing's declaration and testimony.

Under the conditions described above, Sanofi has indicated that it does not oppose Pfizer's Motion for Joinder, and also does not require the additional 1-month extension of the schedule. Mylan has indicated that it will not oppose joinder only if there is no change to the schedule, but Mylan seeks further guidance from the Board as to the claim construction standard that will be applied to the joined proceedings.

II. CONCLUSION

Petitioner reiterates its request that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 8,603,044 and join this proceeding with *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, No. IPR2018-01675.

or addressed by Mr. Leinsing. A separate reply has been filed in IPR2019-00979 (U.S. 8,679,069) to withdraw Pfizer's joinder motion as it pertains to claims 2 and 3 of the '069 patent.

Petitioner further submits that no adjustment to the schedule is required for joinder.

Dated: June 24, 2019

Respectfully submitted,

/Jovial Wong/

Jovial Wong

Reg. No. 60,115

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