

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN INSTITUTIONAL LLC and PFIZER INC.,

Petitioners,

v.

NOVO NORDISK A/S,

Patent Owner.

Case No. IPR2020-00324¹

U.S. Patent No. 8,114,833

**REPLY DECLARATION OF LAIRD FORREST, PH.D. IN SUPPORT OF
PETITION FOR INTER PARTES REVIEW OF U.S.
PATENT NO. 8,114,833**

REDACTED VERSION

¹ IPR2020-01252 has been joined with this proceeding.

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CONFIDENTIAL - PROTECTIVE ORDER MATERIAL

1. I, Laird Forrest, Ph.D., have been retained by Mylan Institutional LLC (“Mylan”) in the matter set forth in the caption above. I submitted previously an expert declaration in this matter, dated December 19, 2019, which was designated Exhibit 1002 (“First Declaration”). In that declaration, I showed that claims 1-31 of U.S. Patent No. 8,114,833 to Pedersen et al. (“the ’833 patent”) (Ex. 1001) were either anticipated by the prior art or would have been obvious to a person of ordinary skill in the art at their priority date. *See generally* Ex. 1002.

2. My qualifications, previous testimony, and compensation are provided in my Opening Declaration. An updated *curriculum vitae* is attached hereto as Exhibit A.

3. I submit this reply expert declaration in further support of my opinions regarding the ’833 patent, and in reply to certain opinions set forth in the September 18, 2020 Declaration of Peter M. Tessier, Ph.D. (“Tessier Declaration”), filed on behalf of the Patent Owners, which was designated Exhibit 2022. To the extent I do not expressly address a point made by Dr. Tessier, it does not mean that I agree with it.

4. The scope of my work and compensation remains the same since I submitted my original declarations in this proceeding. I was retained as a technical expert to provide opinions related to the patent at issue. My compensation is not

dependent upon the outcome of the proceedings or my opinions given. I have no current affiliation with Novo Nordisk A/S or the inventors of the patent at issue.

I. LEGAL STANDARDS

5. In addition to the legal principles detailed in my previous declaration, I have been informed by counsel regarding relevant legal principles.

6. Counsel has informed me that an international patent application filed on or after November 29, 2000 but prior to March 16, 2013, that designates the United States, and is published in English under the Patent Cooperation Treaty (PCT) is usable for prior art purposes as of its international filing date. If the international patent application claims priority to one or more U.S. provisional application, the international patent application is usable for prior art purposes as of filing date of the earlier filed provisional application provided at least one claim of the international application is supported by the description of the provisional application.

7. Counsel has also informed me that a patent owner can submit evidence that it invented the claimed invention prior to the earliest date that a reference is usable for prior art purposes (i.e., the earliest priority date). I understand that one way to show prior invention is to demonstrate an actual reduction to practice prior to the earliest priority date. To do so, I understand that Patent Owner must not only show that they had prepared a formulation that meets every limitation of the claimed

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