

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BIOCON PHARMA LIMITED,  
Petitioner,

v.

NOVARTIS PHARMACEUTICALS CORPORATION,  
Patent Owner.

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IPR2020-01263  
Patent 8,101,659 B2

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Before ERICA A. FRANKLIN, ROBERT A. POLLOCK, and  
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

ORDER

*Granting Petitioner's Request for Additional Briefing*  
*37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)*

On November 30, 2020, counsel for Biocon Pharma Limited (“Petitioner”) contacted the Board via e-mail to request a conference call seeking authorization to file a Preliminary Reply to Novartis Pharmaceuticals Corporation’s (“Patent Owner’s”) Preliminary Response in the above-identified proceeding. *See* Ex. 3001. Petitioner seeks authorization to file a Preliminary Reply addressing Patent Owner’s arguments under 35 U.S.C. § 325(d). *Id.* In its e-mail, Petitioner states that, although it addressed § 325(d) in its Petition, “Patent Owner has crystalized” its § 325(d) arguments in its Preliminary Response, and Petitioner seeks a “short 3 page Reply.” *Id.* Petitioner states further that Patent Owner opposes Petitioner’s request, because “Biocon has not established good cause, as required by 37 C.F.R. § 42.108(c), and replies are not automatically granted absent such a showing.” *Id.* According to Petitioner, Patent Owner also opposes because “[Petitioner] had the opportunity to and did address 35 U.S.C. § 325(d) in its Petition.” *Id.* Petitioner states that it “has no objection to Patent Owner receiving a 3 page Sur-Reply in response.” *Id.*

The panel has conferred and determined that a conference call is not necessary. The panel determines that it would be helpful for the parties to provide additional briefing on the applicability of 35 U.S.C. § 325(d) to the particular facts of this proceeding. Thus, we authorize Petitioner to file a Preliminary Reply and Patent Owner to file a Preliminary Sur-Reply, if desired. *See* 37 C.F.R. §§ 42.20(d), 42.108(c). Specifically, Petitioner is authorized to file a three-page Preliminary Reply no later than 5:00 PM Eastern Time, one week from the date of this Order. Petitioner’s Preliminary Reply is limited to responding to the § 325 issues raised in

Patent Owner's Preliminary Response. If desired, Patent Owner is authorized to file a three-page Preliminary Sur-Reply, responding to Petitioner's §325(d) arguments. If Patent Owner elects to file a Preliminary Sur-Reply, it shall be filed no later than 5:00 PM Eastern Time, one week from the date of Petitioner's Preliminary Reply. No additional briefing and no new evidence from either party are authorized at this time. Any portion of the briefing that is not responsive to this Order will not be considered.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a Preliminary Reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that the Preliminary Reply is limited to addressing the 35 U.S.C. § 325(b) issues raised in Patent Owner's Preliminary Response;

FURTHER ORDERED that the Preliminary Reply may be no more than three (3) pages in length;

FURTHER ORDERED that Petitioner shall file the Preliminary Reply by 5:00 PM Eastern Time, within one week from the date of this Order;

FURTHER ORDERED that, if desired, Patent Owner is authorized to file a Preliminary Sur-Reply of no more than three (3) pages in length, addressing Petitioner's 35 U.S.C. § 325(b) arguments;

FURTHER ORDERED that Patent Owner shall file any such Preliminary Sur-Reply by 5:00 PM Eastern Time, within one week from the date of the Preliminary Reply;

FURTHER ORDERED that the parties may not submit new evidence;  
and

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FURTHER ORDERED that no additional briefing is permitted.

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