### UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_

### BEFORE THE PATENT TRIAL AND APPEAL BOARD

\_\_\_\_\_

## REGENERON PHARMACEUTICALS, INC., Petitioner

V.

### NOVARTIS PHARMA AG, NOVARTIS TECHNOLOGY LLC, NOVARTIS PHARMACEUTICALS CORPORATION,

Patent Owner

\_\_\_\_

**Case IPR2020-01317** 

Patent 9,220,631

\_\_\_\_\_

NOVARTIS PHARMA AG, NOVARTIS TECHNOLOGY LLC, AND NOVARTIS PHARMACEUTICALS CORPORATION'S PATENT OWNER SUR-REPLY



## **TABLE OF CONTENTS**

I.	The <i>Fintiv</i> Factors Compel Denial of Institution		
	A.	Factor 1: There Is No Prospect of a Stay in the ITC Proceeding or in Regeneron's District Court Litigation.	2
	В.	Factor 2: The ITC Will Issue a Final Written Decision on Validity Before the Projected Date for the Board's Final Written Decision.	3
	C.	Factor 3: The Parties and the ITC (ALJ and Staff Attorney) Have Already Invested Significant Resources in the ITC Proceeding.	5
	D.	Factor 4: There Is Substantial Overlap of Issues Between the Petition and the ITC Proceeding.	7
	E.	Factors 5, 6, and Conclusion: The Parties Are Identical, and the Factors as a Whole Overwhelmingly Favor Denying Institution	8
II.	Insti	tution Should Also Be Denied Under 35 U.S.C. § 325(d)	10
	A.	Becton Dickinson Factors (a)–(c) Support Denying Institution	11
	В.	Becton Dickinson Factors (d)–(f) Support Denving Institution	14



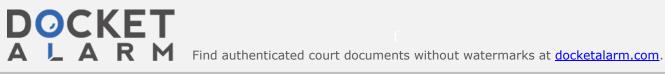
## **TABLE OF AUTHORITIES**

Page(s)

Cases
Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (P.T.A.B. May 13, 2020)
Fitbit, Inc. v. Koninklijke Philips N.V., IPR2020-00772, Paper 14 (P.T.A.B. Oct. 19, 2020)2, 4, 6, 9
Garmin Int'l, Inc. v. Koninklijke Philips N.V., IPR2020-00754, Paper 11 (P.T.A.B. Oct. 27, 2020)2, 6, 9
Google LLC et al. v. Agis Software Development, LLC, IPR2020-00873, Paper 16 (P.T.A.B. Nov. 25, 2020)
Google LLC v. EcoFactor, Inc., IPR2020-0968, Paper 10 (P.T.A.B. Nov. 18, 2020)2, 9, 10
Google LLC v. Personalized Media Comm'cns, LLC, IPR2020-00719, Paper 16 (P.T.A.B. Aug. 31, 2020)
Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc., (IPR2020-00919) (P.T.A.B.)9
Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc., IPR2020-00919, Paper 9 (P.T.A.B. Nov. 16, 2020)
Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc., IPR2020-00921, Paper 9 (P.T.A.B. Nov. 16, 2020)4
SK Innovation Co. v. LG Chem, Ltd., IPR2020-00991, Paper 14 (P.T.A.B. Nov. 30, 2020)
VMware v. Intellectual Ventures I LLC, IPR2020-00470, Paper 13 (P.T.A.B. Aug. 13, 2018)8
Statutes
35 U.S.C. §§ 102-1035



35 U.S.C. § 3	514	1
35 U.S.C. § 32	325(d)	1, 10



## **Patent Owner's Exhibit List**

Exhibit	Description
Ex. 2001	Declaration of Karl R. Leinsing, PE
Ex. 2002	Order No. 8: Procedural Schedule, ITC Inv. No. 337-TA-1207
Ex. 2003	Regeneron's Initial Invalidity Contentions in ITC Inv. No. 337-TA-1207, Exhibit A: Invalidity of U.S. Patent No. 9,220,631 Under 35 U.S.C. §§ 102-103
Ex. 2004	Regeneron's Initial Invalidity Contentions in ITC Inv. No. 337-TA-1207, Exhibit A1: Invalidity Claim Chart of Sigg, alone or in combination with any of Boulange, Lam, Reuter, Scypinski, Metzner, Shah, Fries, Schoenknecht, Chacornac, Nema, D'Souza, Furfine, Badkar, Macugen, Eylea, Lucentis, Stewart, USP789, Liu, Hioki, DC365, Hagen, Khandke, Wittland, Shams, Dixon, and/or Cormier against U.S. Patent No. 9,220,631.
Ex. 2005	Regeneron's Initial Invalidity Contentions in ITC Inv. No. 337-1207, Exhibit A2: Invalidity Claim Chart of Boulange, alone or in combination with any of Sigg, Lam, Reuter, Scypinski, Metzner, Shah, Fries, Schoenknecht, Chacornac, Nema, D'Souza, Furfine, Badkar, Macugen, Eylea, Lucentis, Stewart, USP789, Liu, Hioki, DC365, Hagen, Khandke, Wittland, Shams, Dixon, and/or Cormier against U.S. Patent No. 9,220,631.
Ex. 2006	Edwin Chan, et al., Syringe Siliconization Process Investigation and Optimization, PDA JOURNAL OF PHARMACEUTICAL SCIENCE AND TECHNOLOGY, 136-158 (2012) ("Chan")
Ex. 2007	Sophie J. Bakri, M.D. and Noha S. Ekdawi, M.D., <i>Intravitreal Silicone Oil Droplets After Intravitreal Drug Injections</i> , RETINA 28:996-1001 (2008) ("Bakri")
Ex. 2008	Mehmet Selim Kocabora, Kemal Turgay Ozbilen and Kubra Serefoglu, Letter to the Editor: Intravitreal silicone oil droplets following pegaptanib injection, ACTA OPHTHALMOLOGICA e44-e45



# DOCKET

## 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.

