

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 IPR2021-00816
Patent 9,220,631

**[PROPOSED] ORDER FOR APPOINTMENT OF COMMISSIONERS AND
DIRECTION OF SUBMISSION OF HAGUE CONVENTION
APPLICATION**

On March 1, 2022, Patent Owner Novartis Pharma AG, Novartis Pharmaceuticals Corporation, and Novartis Technology LLC (collectively, “Novartis”) and Petitioner Regeneron Pharmaceuticals, Inc. (“Regeneron”) filed a joint motion requesting an order appointing certain counsel as commissioners to take the voluntary oral depositions under oath via video conference in Switzerland of two Novartis witnesses, Marie Picci and Juergen Sigg.

Novartis seeks authorization from a competent Swiss authority to conduct voluntary depositions under oath via videoconference of Ms. Picci and Dr. Sigg, whom Regeneron seeks to depose, and who either live or work in Switzerland. The Swiss Penal Code provides that attorneys attempting to take a deposition or carry out other activities on behalf of a foreign state in Switzerland outside of authorized methods are subject to arrest on criminal charges. *See, e.g.*, Article 271 of the Swiss Penal Code, available at <https://www.admin.ch/opc/en/classified-compilation/19370083/index.html>. Thus, the parties represent they must comply with the Hague Convention in seeking testimony in this proceeding in order to comply with Swiss law.

The Board finds that the evidence the parties seek is reasonably necessary to fully investigate the patentability of U.S. Patent No. 9,220,631 in this *inter partes* review. Accordingly, the following listed counsel for Novartis and Regeneron are duly appointed as commissioners under Article 17 of the Hague Convention of 17

March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters:

Counsel at Weil, Gotshal & Manges LLP (located at 767 Fifth Avenue New York, New York 10153; and 2001 M Street, Suite 600 Washington, DC 20036) for Plaintiff Regeneron (Regeneron Pharmaceuticals, Inc., located at 777 Old Saw Mill River Road, Tarrytown, New York 10591, USA): Anish Desai; Elizabeth Weiswasser; Robert Vlaisis; Christopher Pepe; Matthew Sieger and Andrew Gesior

Counsel at Allen & Overy LLP (located at 1221 Avenue of the Americas New York, NY 10020; and 1101 New York Ave, N.W. Washington, D.C. 20005) for Defendant Novartis (Novartis Pharma AG, Forum 1, Novartis Campus, 4056 Basel, Switzerland; Novartis Pharmaceuticals Corporation, One Health Plaza, East Hanover, New Jersey, 07936, USA and Novartis Technology LLC, One Health Plaza, East Hanover, New Jersey, 07936, USA): Elizabeth Holland; William James and Daniel Margolis.

Counsel at Bär & Karrer AG (located at Brandschenkestrasse 90, 8027 Zurich, Switzerland) for Defendant Novartis (Novartis Pharma AG, Forum 1, Novartis Campus, 4056 Basel, Switzerland; Novartis Pharmaceuticals Corporation, One Health Plaza, East Hanover, New Jersey, 07936, USA and Novartis Technology LLC, One Health Plaza, East Hanover, New Jersey, 07936, USA): Dr. Andreas Länzlinger; and Martina Athanas; and

This Order shall be given to counsel at Bär & Karrer AG who will file it together with the necessary application for authorization from the relevant Swiss authorities.

ORDER

IT IS SO ORDERED this ____ day of _____, 2022.