

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**REGENERON PHARMACEUTICALS, INC.,**  
Petitioner

v.

**NOVARTIS PHARMA AG,  
NOVARTIS TECHNOLOGY LLC,  
NOVARTIS PHARMACEUTICALS CORPORATION,**  
Patent Owner

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**Case IPR2021-00816**  
Patent 9,220,631

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**JOINT MOTION FOR THE APPOINTMENT OF COMMISSIONERS AND  
DIRECTION OF SUBMISSION OF HAGUE CONVENTION  
APPLICATION**

Pursuant to the parties' teleconference with the Board on February 24, 2022, Patent Owner Novartis Pharma AG, Novartis Pharmaceuticals Corporation, and Novartis Technology LLC (collectively, "Novartis") and Petitioner Regeneron Pharmaceuticals, Inc. ("Regeneron") jointly move the Board for entry of an order duly appointing as Commissioners the counsel for Novartis and Regeneron for the purpose of taking the voluntary testimony by oral deposition under oath via videoconference in Switzerland of two (2) Novartis witnesses, Marie Picci and Juergen Sigg, whom Regeneron intends to notice for deposition, who either live or work in Switzerland pursuant to Article 17 of the Hague Convention of 18 March 1970 on Taking Evidence Abroad in Civil or Commercial Matters (the "Hague Convention"). The Board has authority to issue the requested order appointing commissioners under 37 C.F.R. §42.53(b). Testimony obtained from these two Novartis witnesses may also be used in the related proceeding, *Novartis Pharma AG, et al. v. Regeneron Pharm., Inc.*, No. 3:20-CV-00690-DNH-CFH (N.D.N.Y.). Novartis has agreed to voluntarily obtain the Swiss authorization for the two Novartis witnesses in order for the parties to proceed pursuant to Article 17 of the Hague Convention.

Novartis has submitted declarations from Ms. Picci (Ex. 2002) and Dr. Sigg (Ex. 2206), Novartis employees, in support of its Patent Owner Response (Paper

35) and Contingent Motion to Amend (Paper 37). Regeneron has accordingly requested their depositions.

Article 17 of the Hague Convention provides that “[i]n a civil or commercial matter, a person duly appointed as a commissioner for the purpose may, without compulsion, take evidence in the territory of a Contracting State in aid of proceedings commenced in the courts of another Contracting State if – (a) a competent authority designated by the State where the evidence is to be taken has given its permission either generally or in the particular case; and (b) he complies with the conditions which the competent authority has specified in the permission.

Therefore, under Article 17 of the Hague Convention, the voluntary testimony, by deposition, of a witness located in Switzerland can be conducted by U.S. counsel as commissioners duly appointed by a U.S. court and authorized to proceed by the competent Swiss authorities. *See Swiss Federal Office of Justice’s Guidelines*, at p. 29,

<https://www.rhf.admin.ch/dam/rhf/en/data/zivilrecht/wegleitungen/wegleitung-zivilsachen-e.pdf.download.pdf/wegleitung-zivilsachen-e.pdf>. The parties jointly request an order from the Board appointing counsel for the Parties as Commissioners to take the voluntary testimony of Novartis’s witnesses.

Swiss law can prohibit the taking of evidence in Switzerland for purposes of a foreign civil proceeding absent compliance with treaties or international

agreements. *See, e.g., U.S. Embassy in Switzerland and Liechtenstein*, <https://ch.usembassy.gov/u-s-citizen-services/local-resources-of-u-s-citizens/living-in-ch/judicial-information/obtaining-evidence/> (last visited October 12, 2021). Indeed, the Swiss Penal Code provides that: “any person who carries out activities on behalf of a foreign state on Swiss territory without lawful authority, where such activities are the responsibility of a public authority or public official, any person who carries out such activities for a foreign party or organisation, any person who facilitates such activities, is liable to a custodial sentence not exceeding three years or to a monetary penalty, or in serious cases to a custodial sentence of not less than one year.” *See, e.g., Article 271 of the Swiss Penal Code*, <https://www.admin.ch/opc/en/classified-compilation/19370083/index.html>. In particular, the Swiss Federal Office of Justice's Guidelines state that: "the conduct of a hearing by a foreign authority or foreign lawyers by video conference of witnesses or parties who are physically located in Switzerland constitutes an act by a public authority on Swiss territory, and as such is therefore illegal unless authorised." *See Swiss Federal Office of Justice's Guidelines*, at p. 33, <https://www.rhf.admin.ch/dam/rhf/en/data/zivilrecht/wegleitungen/wegleitung-zivilsachen-e.pdf.download.pdf/wegleitung-zivilsachen-e.pdf>. An act will be deemed “authorized” under the Swiss Penal Code if it is permitted under the law or

a treaty concluded by Switzerland. In particular, acts performed within the framework of the Hague Convention, to which both the United States and Switzerland are parties (*see* Hague Conf. on Private Int'l Law, *Status Table*, [http://www.hcch.net/index\\_en.php?act=conventions.status&cid=82](http://www.hcch.net/index_en.php?act=conventions.status&cid=82) (last updated June 2021)) are ipso facto deemed “authorized.” Thus, to comply with Swiss law, Novartis must follow the Hague Convention in providing testimony in this matter with the prior authorization of the Swiss competent authorities.

The parties respectfully request that the Board issue an order appointing the following counsel for Novartis and counsel for Regeneron as Commissioners pursuant to Article 17 of the Hague Convention:

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 Petitioner Regeneron (Regeneron Pharmaceuticals, Inc., located at 777 Old Saw Mill River Road, Tarrytown, New York 10591, USA): Anish Desai; Elizabeth Weiswasser; Robert Vlasis; 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 Patent Owner Novartis (Novartis Pharma AG, Forum 1, Novartis Campus, 4056 Basel, Switzerland; Novartis Pharmaceuticals Corporation, One Health

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