

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.

---

IPR2021-00816  
Patent 9,220,631 B2

---

Before ERICA A. FRANKLIN, ROBERT L. KINDER, and JAMIE T. WISZ,  
*Administrative Patent Judges.*

*Per Curiam.*

ORDER GRANTING UNOPPOSED MOTION FOR APPOINTMENT OF  
COMMISSIONERS AND DIRECTION OF SUBMISSION OF HAGUE  
CONVENTION APPLICATION

On October 26, 2021, the Patent Trial and Appeal Board of the United States Patent and Trademark Office instituted a trial in this proceeding pursuant to 35 U.S.C. § 314(a), determining that there existed a reasonable likelihood that at least one of the challenged claims of United States Patent No. 9,220,631 B2 would be found unpatentable. Paper 13. Trial was instituted as to all challenges set forth in the Petition. *Id.* at 75. The Petitioner in this proceeding is Regeneron Pharmaceuticals, Inc. (“Regeneron”). The Patent Owner is Novartis Pharma AG, Novartis Pharmaceuticals Corporation, and Novartis Technology LLC (collectively, “Novartis”).

On February 24, 2022, a teleconference was held. Novartis was represented on the call by Elizabeth Holland. Regeneron was represented on the call by Christopher Pepe. Judges Erica A. Franklin, Robert L. Kinder, and Kristi L. R. Sawert<sup>1</sup> participated on the call on behalf of the Patent Trial and Appeal Board. On March 3, 2022, Novartis filed a joint motion seeking entry of an order appointing certain U.S. attorneys as commissioners to take the voluntary oral depositions under oath via video conference in Switzerland of certain Novartis witnesses. Paper 62 (“Mot.”). Novartis and Regeneron request an order to take the voluntary oral depositions under oath via video conference in Switzerland of Juergen Sigg and Marie Picci whereas each witness either lives or works in Switzerland. Mot. 1. Once authorized, Regeneron intends to notice these two witnesses for deposition. *Id.* According to the joint motion, the depositions will be taken pursuant to Article 17 of the Hague Convention of 18 March 1970 on Taking

---

<sup>1</sup> Pursuant to the Order of March 3, 2022 (Paper 57), Administrative Patent Judge Jamie T. Wisz replaces Administrative Patent Judge Kristi L. R. Sawert on the panel.

Evidence Abroad in Civil or Commercial Matters (the “Hague Convention”<sup>2</sup>). *Id.* The parties represent that the Board has authority to issue the requested order appointing commissioners under 37 C.F.R. §42.53(b). *Id.* Further, the Motion explains the significance of each witness to this proceeding and identifies that Novartis has submitted declarations from Ms. Picci (Ex. 2002) and Dr. Sigg (Ex. 2206), both Novartis employees, in support of its Patent Owner Response. Mot. 1–2.

The parties explain that 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. Mot. 3; *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 determines that the evidence the parties seek is reasonably necessary to fully consider the patentability of United States Patent No. 9,220,631 B2 in this *inter partes* review (IPR2021-00816). Further, the parties have explained that under Article 17 of the Hague Convention, the voluntary testimony, by deposition, of a witness located in Switzerland may be conducted by U.S. counsel as commissioners duly appointed by a U.S. court and authorized to proceed by the competent Swiss authorities. Mot. 2.

Accordingly, the following listed counsel for Novartis and Regeneron are duly appointed as commissioners under Article 17 of the Hague Convention:

---

<sup>2</sup> *See also* Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, Oct. 7, 1972, 23 U.S.T. 2555, 847 U.N.T.S. 231, arts. 1 and 15–17.

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 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 Patent Owner 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.

IPR2021-00816  
Patent 9,220,631 B2

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 8th day of March, 2022.

# 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.