

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*.

KINDER, *Administrative Patent Judge*.

DECISION
Dismissing Motion to Exclude as Moot
37 C.F.R. §§ 42.64(c), 42.61(a)

Along with its Reply to Patent Owner's Response, Petitioner submitted additional evidence, including Exhibit 1105 (Reply Declaration of Horst Koller) and Exhibit 1108 (Declaration of Joel Cohen, M.D.). Patent Owner then filed a Motion to Exclude Evidence (Paper 101), seeking to exclude Exhibit 1108 in its entirety and paragraphs 28–29 of Exhibit 1105 because this evidence was outside the scope of a proper reply, untimely, and prejudicial. Paper 101, 4–8. Petitioner filed an Opposition to Patent Owner's Motion to Exclude (Paper 104), and in turn, Patent Owner filed a Reply in Support of its Motion to Exclude (Paper 110).

Patent Owner seeks to exclude two paragraphs from Mr. Koller's Reply Declaration (Ex. 1105 ¶¶ 28–29) relating to the potential contact between Parylene-C and a VEGF antagonist. Patent Owner also seeks to exclude Dr. Cohen's Declaration (Ex. 1108). Dr. Cohen is a toxicologist testifying on behalf of Petitioner regarding the potential compatibility of Parylene-C with a VEGF antagonist. More specifically, the evidence that Patent Owner seeks to exclude relates to whether a person of ordinary skill in the art would not have been motivated to use a Parylene-C coating in a prefilled syringe because of toxicological concerns.

In our Final Written Decision, issued concurrently herewith, we do not rely on the embodiments in the prior art using Parylene-C as a coating. Accordingly, we do not rely on or reference Exhibit 1105 ¶¶ 28–29 or Exhibit 1108 to support our Decision. Therefore, Patent Owner's Motion to Exclude (Paper 101) is dismissed as moot.

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ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Exclude Evidence
(Paper 101) is *DISMISSED AS MOOT*.

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