

**From:** Ferenc, Christopher B. <christopher.ferenc@katten.com>  
**Sent:** Monday, May 13, 2024 11:34 AM  
**To:** Megan Raymond; J. Steven Baughman  
**Cc:** Sodikoff, Brian; Novo-Semaglutide-IPR@groombridgewu.com  
**Subject:** RE: IPR2024-00107 – Preliminary Response

Megan,

Sun merely declined to include Novo’s proposed language in the e-mail to the Board because it is unnecessary to place any conditions on an otherwise straight-forward authorization request – adding as an exhibit an as-filed stipulation made of record in the District Court by Sun.

As to the substance of your offer, it is not necessary because the stipulation stands on its own under its plain terms. Sun does not intend to work behind the scenes to advance issues at trial that solely relate to invalidity grounds that it could not pursue subject to the stipulation, but it cannot agree to restrict itself and/or invite future quibbles about the scope of restrictions. As just one example, your proposal presumes that all issues for trial are completely isolatable on all levels (which expert, how the expert spends and documents his time, how the expert expresses his opinions in reports and/or depositions) when that may not be the case. As such, your proposed stipulation goes beyond that and places impractical restrictions on Sun’s ability to prepare its case on issues that it is not estopped from making. Notably, you have failed to cite any authority or precedent that supports Novo’s position.

The sole issue is whether the Board should authorize the submission of the exhibit. Sun cannot agree to the inclusion of any argument in the e-mail to the Board, as it is improper. *See, e.g., Samsung Electronics Co., Ltd., et al. v. Black Hills Media, LLC*, Cases IPR2014-00717 (PTAB, July 10, 2014) (Paper 6) (finding argument in e-mail to the Board “constitutes an unauthorized, off-the-record brief in support of Patent Owner’s request”). We have removed all argument from the e-mail, and the parties are free to raise any arguments regarding this issue during the call with the Board.

We have made a good-faith effort to resolve this dispute and see no reason to continue to hold up this e-mail.

Please send us your edits/approval to the e-mail to the Board by two Eastern. We are available to discuss, if necessary, at 2:30 EST.

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PTAB,

Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together “Sun”) have filed a stipulation in the District Court in the underlying litigation. Petitioners request authorization to submit this stipulation as an exhibit in this proceeding for consideration by the Board.

Patent Owner opposes this request and seeks a 3-page brief to address issues raised by the stipulation.

The parties request a conference call with the Board to discuss this issue.

The parties are available for a call with the Board at the following times: Monday, May 13 from 12-5, or Wednesday, May 15 from 2-5, or otherwise at the Board’s convenience.

Regards,

**Christopher B. Ferenc**

Partner

## Katten

Katten Muchin Rosenman LLP

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direct +1.202.625.3647

[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com) | [katten.com](http://katten.com)

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**From:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>

**Sent:** Sunday, May 12, 2024 11:27 AM

**To:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>

**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; Novo-Semaglutide-IPR@[groombridgewu.com](mailto:groombridgewu.com)

**Subject:** RE: IPR2024-00107 – Preliminary Response

*EXTERNAL EMAIL – EXERCISE CAUTION*

Chris,

Are you saying that Sun does stipulate and confirm that, if Sun’s Petition is instituted, Sun will not contribute to district court litigation of any of the stipulated grounds behind the scenes (*e.g.*, Sun will not pay for experts, participate in expert reports, deposition preparation, etc. in connection with any of the stipulated grounds)? If so, then we can shortcut this by including that agreement in the email and not asking for additional briefing. If not, then what is inaccurate about the representation in my edits?

Megan

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**From:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>

**Sent:** Friday, May 10, 2024 8:37 PM

**To:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>

**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; Novo-Semaglutide-IPR@[groombridgewu.com](mailto:groombridgewu.com)

**Subject:** RE: IPR2024-00107 – Preliminary Response

Megan,

Sun never made the representation referenced in your edits, so we will not include that language in our e-mail to the Board. The e-mail below accurately reflects the compromised language reached by the parties, and expressly requests a conference with the Board to discuss the issue. Please send your approval.

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PTAB,

Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together “Sun”) have filed a stipulation in the District Court in the underlying litigation. This stipulation updates a previously submitted stipulation by Sun made of record in this proceeding (Exhibit 2026).

Petitioners request authorization to submit the updated stipulation as an exhibit in this proceeding for consideration by the Board.

Patent Owner opposes this request. Patent Owner further requests a 3-page brief to address discretionary denial issues, including the sufficiency of the previous and above-mentioned stipulation.

The parties request a conference call with the Board to discuss this issue.

The parties are available for a call with the Board at the following times: Monday, May 13 from 9-5, or Wednesday, May 15 from 2-5, or otherwise at the Board's convenience.

Regards,

**Christopher B. Ferenc**

Partner

**Katten**

Katten Muchin Rosenman LLP  
1919 Pennsylvania Ave., NW., Suite 800 | Washington, DC 20006  
direct +1.202.625.3647  
christopher.ferenc@katten.com | katten.com

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**From:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>

**Sent:** Friday, May 10, 2024 8:05 PM

**To:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>

**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; [Novo-Semaglutide-IPR@groombridgewu.com](mailto:Novo-Semaglutide-IPR@groombridgewu.com)

**Subject:** RE: IPR2024-00107 – Preliminary Response

**EXTERNAL EMAIL – EXERCISE CAUTION**

Chris,

We disagree that the subject of the 3-page brief is argument. To the extent you disagree with its inclusion and think otherwise, you are entitled to reflect your position without argument. Sun's decision to delay raising this issue at all until less than a month before the institution decision is due in this case, and its decision to wait four days to respond to Steve's May 3 email was Sun's own choosing. This could've easily been resolved a week ago had Sun been willing to acknowledge that its Sotera stipulation prevents it from participating behind the scenes in certain invalidity activities if its IPR is instituted.

I have included our non-argumentative position below. Please send us a revised version if you make further changes to Sun's position so we can consider whether any further adjustment of ours may be appropriate.

PTAB,

Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together "Sun") have filed a stipulation in the District Court in the underlying litigation. This stipulation updates a previously submitted stipulation by Sun made of record in this proceeding (Exhibit 2026).

Petitioners request authorization to submit updated stipulation as an exhibit in this proceeding for consideration by the Board. Patent Owner opposes this request, and requests a call to the extent the Board is inclined to grant it. Patent Owner further requests a 3-page brief to address discretionary denial issues, including the sufficiency of the previous and above-mentioned stipulation in view of Petitioner's assertion to Patent Owner that it may still contribute to district court litigation on any of the stipulated grounds behind the scenes (e.g., Sun may still pay for experts, participate in expert reports, deposition preparation, etc. in connection with any of the stipulated grounds).

The parties are available for a call with the Board at the following times: Monday, May 13 from 9-5, or Wednesday, May 15 from 2-5, or otherwise at the Board's convenience.

Regards,

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**From:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>  
**Sent:** Friday, May 10, 2024 7:21 PM  
**To:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>  
**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; [Novo-Semaglutide-IPR@groombridgewu.com](mailto:Novo-Semaglutide-IPR@groombridgewu.com)  
**Subject:** RE: IPR2024-00107 – Preliminary Response

Megan,

As you conceded, the inclusion of argument in this e-mail is improper. We have assented to that request and the revised e-mail below reflects the parties agreed-upon language to the Board. Novo is free to raise its arguments during any call scheduled by the Board.

Please let us know if you we have your approval to send this evening. We note that Sun filed its stipulation 10 days ago and Novo's unreasonable delay in sending an otherwise ministerial e-mail is unacceptable and prejudicial to the Board's ability to consider the relevant development in this case. Sun reserves all rights.

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PTAB,

Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together "Sun") have filed a stipulation in the District Court in the underlying litigation. This stipulation updates a previously submitted stipulation by Sun made of record in this proceeding (Exhibit 2026).

Petitioners request authorization to submit updated stipulation as an exhibit in this proceeding for consideration by the Board. Patent Owner opposes this request and requests a call to the extent the Board is inclined to grant it. Patent Owner further requests a 3-page brief to address discretionary denial issues, including the sufficiency of the above-mentioned stipulation.

The parties are available for a call with the Board at the following times: Monday, May 13 from 9-5, or Wednesday, May 15 from 2-5, or otherwise at the Board's convenience.

Regards,

--

**Christopher B. Ferenc**

Partner

## Katten

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**From:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>

**Sent:** Friday, May 10, 2024 5:55 PM

**To:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>

**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; [Novo-Semaglutide-IPR@groombridgewu.com](mailto:Novo-Semaglutide-IPR@groombridgewu.com)

**Subject:** RE: IPR2024-00107 – Preliminary Response

**EXTERNAL EMAIL – EXERCISE CAUTION**

Chris,

We've added back our request for a 3-page brief, which seems to have been deleted in your last draft. Also, our position, reflected in our last draft, that attaching the stipulation is improper, stands. We've revised assuming you won't attach the stipulation (see red text). If you plan to attach it, then we'll add an objection to that.

PTAB,

Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together "Sun") have filed a stipulation in the District Court in the underlying litigation. This stipulation updates a previously submitted stipulation by Sun made of record in this proceeding (Exhibit 2026).

Petitioners request authorization to submit updated stipulation as an exhibit in this proceeding for consideration by the Board. Patent Owner opposes this request, and requests a call to the extent the Board is inclined to grant it. Patent Owner further requests a 3-page brief to address discretionary denial issues, including the sufficiency of the previous and above-mentioned stipulation in view of Petitioner's assertion to Patent Owner that it may still contribute to district court litigation on any of the stipulated grounds behind the scenes (e.g., Sun may still pay for experts, participate in expert reports, deposition preparation, etc. in connection with any of the stipulated grounds).

The parties are available for a call with the Board at the following times: Friday, May 10 from 2:30-5, Monday, May 13 from 9-5, or Wednesday, May 15 from 9-5, or otherwise at the Board's convenience.

Regards,

---

**From:** Ferenc, Christopher B. <[christopher.ferenc@katten.com](mailto:christopher.ferenc@katten.com)>

**Sent:** Friday, May 10, 2024 10:25 AM

**To:** Megan Raymond <[megan.raymond@groombridgewu.com](mailto:megan.raymond@groombridgewu.com)>; J. Steven Baughman <[steve.baughman@groombridgewu.com](mailto:steve.baughman@groombridgewu.com)>

**Cc:** Sodikoff, Brian <[brian.sodikoff@katten.com](mailto:brian.sodikoff@katten.com)>; [Novo-Semaglutide-IPR@groombridgewu.com](mailto:Novo-Semaglutide-IPR@groombridgewu.com)

**Subject:** RE: IPR2024-00107 – Preliminary Response

Megan,

We agree that all argument should be removed from the e-mail. A revised e-mail is below. Please let us know if you have any edits by 2 p.m. Eastern.

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