

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES, INC. and
DR. REDDY'S LABORATORIES, LTD.,
Petitioner,

v.

NOVO NORDISK A/S,
Patent Owner.

IPR2024-00009
Patent 10,335,462 B2

Before JOHN G. NEW, SUSAN L. C. MITCHELL, and ROBERT A. POLLOCK,
Administrative Patent Judges.

MITCHELL, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On March 22, 2024, Petitioner contacted the Board by email requesting authorization to file into the record of this proceeding a *Sotera*¹ stipulation, referenced in its Reply Brief, and Petitioner also asserts it will file the same stipulation in the parallel district court litigation should the Board institute an *inter partes* review. Petitioner represented that Patent Owner “objects to the filing of the stipulation, which differs in scope from the one set forth in Petitioner’s Reply Brief, and which would be the third stipulation by Petitioner in this IPR.” Patent Owner requested a call in the event the Board was inclined to grant the request and also requested briefing to respond to the filing.

On Wednesday, March 27, 2024, the Board held a conference call with the parties for which Judges Mitchell, Pollock, and New were present, and the parties were represented by their respective counsel. Petitioner explained that it seeks to file this *Sotera* stipulation to respond to Patent Owner’s assertions that, as a joining party, Petitioner may argue that any estoppel based on grounds that “could have reasonably been raised” is a nullity. *See* Patent Owner Sur-Reply 2–3. Petitioner asserts that the additional language in the stipulation agreeing that it is estopped to the same extent as the Petitioner in the original case to which it seeks joinder resolves any ambiguity on this point. Petitioner also stated that it would not present any invalidity arguments in the parallel district court litigation based on 35 U.S.C. §§ 102 or 103.

Patent Owner responds that this is Petitioner’s “third bite at the apple” to file an appropriate stipulation to respond to Patent Owner’s concerns. Patent Owner asserts that because such a stipulation was not presented with the Petition, Patent

¹ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) (discussing Petitioner’s broad stipulation to limit invalidity grounds in district court).

Owner has spent time and effort responding to Petitioner's changing position, and has thus been prejudiced.

Upon consideration of these arguments presented by the parties, we found good cause to grant Petitioner's request to file its *Sotera* declaration to limit its ability to present certain invalidity arguments in the parallel district court litigation. We also authorized additional briefing for Patent Owner to address discretionary denial issues in view of this stipulation.

Petitioner also sought authorization to file an Order by the District Court in the parallel litigation moving the trial date from September to December. We granted such authorization to file the Order as an exhibit in this proceeding.

ORDER

Accordingly, it is

ORDERED that by no later than March 28, 2024, Petitioner will file as exhibits: (1) its *Sotera* stipulation; and (2) the District Court Order changing the trial date;

ORDERED that by no later than April 3, 2024, Patent Owner will file any additional briefing, not to exceed three pages, addressing discretionary denial issues in view of Petitioner's *Sotera* declaration.

IPR2024-00009
Patent 10,335,462 B2

PETITIONER:

Jovial Wong
Scott Border
WINSTON & STRAWN LLP
jwong@winston.com
sborder@winston.com

PATENT OWNER:

Jon Baughman
Megan Raymond
GROOMBRIDGE, WU, BAUGHMAN & STONE LLP
steve.baughman@groombridgewu.com
megan.raymond@groombridgewu.com