

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLAYBACK PHARMA LLC

Petitioner

v.

SUMITOMO DAINIPPON PHARMA CO., LTD

Patent Owner

Case No. IPR2020-01053
U.S. Patent 9,815,827

PETITIONER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70(a) and the Board's Scheduling Order (Paper 8), Petitioner requests oral argument in IPR2020-001053 on U.S. Patent No. 9,815,827 ("the '827 patent").

The parties conferred and agreed it would be appropriate for each side to be allocated a total of 1 hour at the Oral Hearing.

Petitioner requests (without waiving consideration of any issue not listed here) that the following issues be argued:

For Grounds 1 and 2

1. Whether the "manic depressive claims" have written description support in the '927 Provisional;
2. Whether Patent Owner's Response (Paper 15) failed to address written description support in the '927 Provisional of a method with all the limitations of "the specific regimens recited in representative claim 8 and the other manic depressive claims." *See*, Paper 2 (Petition) pp. 27-28, Paper 20 (Petitioner's Reply) pp. 16-17;
3. Whether the single mention of "manic depressive psychoses" in the Background Section of the '927 Provisional is merely a passing reference in a complex field. *See* Paper 20 (Petitioner's Reply) p. 14.

For Ground 3

4. Whether claims 1-75 of the '827 Patent are obvious over Saji Patent (EX-1009) in light of the prior art;
5. Whether Patent Owner failed to establish a nexus between alleged objective indicia of non-obviousness and anything *novel* in the claims of the '827 Patent. *See* Paper 20 (Petitioner's Reply) pp. 27-29;
6. The difference between lack of weight gain "on average" and in "a patient". *See* Paper 20 (Petitioner's Reply) p. 31;
7. Whether Patent Owner conceded that the prior art knew that "SM-13496" was lurasidone. *See* Paper 20 (Petitioner's Reply) pp. 26-27;

For Grounds 1, 2 and 3

8. Whether Dr. Stahl's opinion regarding what Wong (EX-2032) taught to be "necessary" (EX-2131 (Stahl) § 177) undermines Dr. Stahl's credibility as an expert witness. *See* Paper 20 (Petitioner's Reply) p. 30;
9. Any Motions to Exclude or Motions to Strike.

Finally, Petitioner notes that Petitioner has not yet seen Patent Owner's Sur-Reply because it is not due until July 8, 2021. Therefore, at the Oral Argument Petitioner may want to discuss matters included in Petitioner's Sur-Reply.

Dated: July 1, 2021

By: /s/ Louis H. Weinstein
Louis H. Weinstein
Reg. No. 45,205
*Counsel for Petitioner Slayback
Pharma LLC*

CERTIFICATE OF SERVICE

I, Louis H. Weinstein, certify that I caused to be served true and correct copies of public versions of **Petitioner's Request for Oral Argument** by e-mail, as follows:

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Dated: July 1, 2021

By: /s/ Louis H. Weinstein
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