

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

PLEXXIKON INC.,
Patent Owner.

Case PGR2018-00069
Patent 9,844,539 B2

Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

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

In an email sent to the Board on November 12, 2018, counsel for Petitioner requested a conference call seeking authorization to file a reply to Patent Owner's Preliminary Response (Paper 12, "Prelim. Resp.") to address certain arguments made by Patent Owner. A conference call was held between counsel for the parties and the Board on November 16, 2018 to discuss Petitioner's request.

During the conference call, Petitioner argued that good cause exists to file the requested reply to address Patent Owner's "new" argument that the written description requirement is satisfied by the disclosure of a "core structure" consisting of "a sulfonamide with its nitrogen adjacent to the fluorine in a fluorinated phenyl," and a "uniform overall shape and size" of the claimed chemical compound, which are allegedly the "key features" of the claimed compounds. Patent Owner argued that briefing at the preliminary stage of a post-grant review is typically limited to a petition and patent owner preliminary response and that Petitioner is not entitled to a reply simply to respond to the merits of the Patent Owner's Preliminary Response.

Petitioner may seek authorization to file a reply to the preliminary response, but "must make a showing of good cause." 37 C.F.R. § 42.108(c) (revised April 1, 2016). In consideration of the arguments advanced during the teleconference by both parties, we determine that good cause for authorization to file the requested reply has not been shown. There is no indication that the record lacks sufficient information hindering the panel's ability to scrutinize Patent Owner's contentions related to written description when determining whether the information presented in the petition would

PGR2018-00069
Patent 9,844,539 B2

demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable. 35 U.S.C. § 324(a).

Accordingly, it is hereby:

ORDERED that Petitioner's request to file a reply to Patent Owner's Preliminary Response is *denied*.

PETITIONER:

Robert Underwood
McDermott, Will & Emery LLP
runderwood@mwe.com

PATENT OWNER:

Elizabeth Weiswasser
Derek Walter
Brian Chang
Weil, Gotshal & Manges LLP
elizabeth.weiswasser@weil.com
derek.walter@weil.com
brian.chang@weil.com