

No. 2021-2369

In the United States Court of Appeals
For the Federal Circuit

NIPPON SHINYAKU CO., LTD.,
Plaintiff-Appellant

v.

SAREPTA THERAPEUTICS, INC.,
Defendant-Appellee

On Appeal from the
United States District Court for the District of Delaware
Case No. 1:21-CV-01015, Honorable Leonard P. Stark

MOTION TO EXPEDITE ISSUANCE OF MANDATE

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CERTIFICATE OF INTEREST

Case Number 2021-2369

Short Case Caption *Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.*

Filing Party/Entity Appellant Nippon Shinyaku Co., Ltd.

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Dated: March 11, 2022 /s/ William R. Peterson
William R. Peterson
Counsel for Appellant
Nippon Shinyaku Co., Ltd.

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. <input checked="" type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. <input checked="" type="checkbox"/> None/Not Applicable
Nippon Shinyaku Co., Ltd.	Not Applicable	None

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable

Jitsuro Morishita
(Morgan, Lewis &
Bockius LLP)

Michael T. Sikora
(Morgan, Lewis &
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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable

Pursuant to Federal Rules of Appellate Procedure 27 and 41, Appellant Nippon Shinyaku respectfully requests that this Court grant expedited issuance of the mandate.

Counsel for Nippon Shinyaku has conferred with counsel for Sarepta, and Sarepta opposes all relief sought in this motion. Given the time-sensitive nature of the relief sought, Nippon Shinyaku requests that the 10-day period for response to this motion be shortened. Fed. R. App. P. 27(a)(3)(A).

BACKGROUND

This appeal concerns seven IPRs filed in violation of a forum-selection clause. The PTAB instituted all IPRs around the time of oral argument on January 11. Opinion 7 (ECF No. 51). On February 8, 2022, this Court held that Sarepta breached the forum-selection clause by filing the IPRs, that Nippon Shinyaku would suffer irreparable harm if forced to defend against the IPRs, and that the other requirements for issuance of a preliminary injunction were satisfied. Opinion 16 (ECF No. 51). The Court thus reversed the district court's judgment and remanded for entry of a preliminary injunction in Nippon Shinyaku's favor that would require Sarepta to seek to terminate the pending IPRs. *Id.*

Although Nippon Shinyaku requested expedited issuance of the mandate in its brief and at oral argument, this Court did not expressly address the request, and

the judgment contains ordinary language stating that the mandate will “issue in due course.” Judgment (ECF No. 52).

After this Court entered its decision, on February 24, the PTAB granted Nippon Shinyaku and Sarepta’s joint request to stay proceedings for up to two months, until April 24. *See* Order Suspending Proceedings (Ex. A).

Despite this Court’s unambiguous judgment, Sarepta has argued to the district court that additional briefing and argument will be necessary before any injunction can be entered. Joint Status Report (Ex. B), at 2. Nippon Shinyaku asked the district court to address these arguments now so that a preliminary injunction could be entered immediately after the mandate issues. *Id.* The district court denied the request, making clear that some additional briefing (and delay) will occur between the mandate and an injunction. *Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.*, No. 1:21-cv-01015-MN, Dkt. 95 (D. Del.) (“[E]ven if the Court did have jurisdiction over the preliminary injunction issues, the Court would exercise its discretion to defer further letter briefing until the Federal Circuit issues its mandate.”).

Now that Sarepta has sought rehearing, issuance of the mandate will likely be delayed significantly, and it is likely that no injunction would be entered before expiration of the PTAB’s stay. To avoid continuing the irreparable harm to Nippon

Shinyaku recognized by the panel, Nippon Shinyaku respectfully requests expedited issuance of the mandate.

ARGUMENT

To mitigate the continued irreparable harm to Nippon Shinyaku, which has been forced to defend against seven IPR proceedings that never should have been filed, Nippon Shinyaku respectfully requests that this Court expedite issuance of the mandate, allowing swift entry of an injunction in the district court (before the expiration of the PTAB's stay) and swift termination of the IPRs.

Expedited issuance of the mandate would prevent Sarepta from, as Professor Dennis Crouch has hypothesized, using its motion for rehearing to “run-out the clock,” nullifying this Court's decision. Dennis Crouch, *Contractually Agreeing to Not Petition for Inter Partes Review*, PATENTLY-O (Feb. 8, 2022), <https://patentlyo.com/patent/2022/02/contractually-agreeing-petition.html>.

This relief would not prejudice Sarepta. In the unlikely event that the panel decision is reversed, Sarepta could seek to refile the IPRs within the statutory period. Nippon Shinkyaku would not oppose refiling by Sarepta if this Court's decision were reversed.

1. This Court Should Expedite Issuance of the Mandate.

Federal Rule of Appellate Procedure 41(b) states that this Court “may shorten or extend the time” in which its mandate issues. This Court has previously expedited

issuance of its mandate to avoid delay. *See, e.g., Armstrong v. United States*, No. 2021-2141, 2021 WL 59943731, at *1 (Fed. Cir. Dec. 15, 2021) (ordering that the mandate issue concurrently with the Court’s order dismissing the appeal); *Senate Manor Props., LLC v. U.S. Dep’t of Hous. & Urban Dev.*, 315 F. App’x 235, 239 (Fed. Cir. 2008) (ordering that, absent the filing of a motion for rehearing, the mandate issue seven days after issuance of the Court’s order remanding the case).

Good cause exists for expediting issuance of the mandate in this case. If no petition for rehearing is filed, the mandate issues “7 days after the time to file a petition for rehearing expires.” Fed. R. App. P. 4(b)(1). If Sarepta had not sought rehearing, the mandate would have issued on March 17. This would have provided ample time for any additional briefing in the district court¹ and entry of the injunction by April 24, when the stay entered by the PTAB will expire.

But now that Sarepta has filed a petition for rehearing, the mandate will not issue until 7 days after the entry of the order denying rehearing. Fed. R. App. P. 4(b)(1). Even if no response to Sarepta’s petition is requested, issuance of the mandate could easily be delayed by 30 days or more. *See Packet Intelligence LLC v. NetScout Systems, Inc.*, No. 19-2041 (Fed. Cir. 2020) (petitions for rehearing filed on September 14; no response requested; petitions denied on October 16).

¹ To be clear, Nippon Shinkyaku strongly disagrees with Sarepta’s suggestion that additional briefing is necessary.

If a response is requested (which requires only a single judge), the delay could easily be extended by another month. *See The Chamberlain Group, Inc. v. Techtronic Industries Co. Ltd.*, No. 18-2103 (Fed. Cir. 2019) (petition for rehearing filed October 23, 2019; response requested October 29; response filed November 12; petition denied on December 17, 2019). And if any judge were to write in response to the petition, delay could be even longer. *See Berkheimer v. HP Inc.*, No. 17-1437 (Fed. Cir. 2018) (petition for rehearing filed March 12; response requested March 15; response filed March 29; petition denied on May 31).

The district court cannot give effect to this Court's decision until the mandate has been issued. And Sarepta has already indicated that issuance of the mandate will not immediately avert Nippon Shinyaku's irreparable injuries because—despite this Court's unambiguous judgment instructing that an injunction should be entered—it intends to oppose entry of the injunction in the district court. Specifically, Sarepta claims it is entitled to submit additional briefing on bond and the scope of the injunction—indicating that Nippon Shinyaku should anticipate an extended fight in district court even after this Court's mandate issues. Joint Status Report (Ex. B), at 2.

At minimum, then, even if no response were requested and the mandate issues on April 17 (assuming 30 days of delay), it would seem to be highly unlikely that the district court would enter an injunction before expiration of the PTAB's stay.

And given the possibility of a request for a response and the anticipated additional delay in the district court, Sarepta's request for rehearing raises the specter—already recognized by Professor Dennis Crouch—that Sarepta may use the request for rehearing to “run-out the clock,” nullifying this Court's decision and preventing its decision from ever taking effect. Crouch, *supra*.

To avoid nullification of this Court's decision and to avoid the irreparable harm to Nippon Shinyaku already recognized in the panel opinion, this Court should issue the mandate no later than March 17, 2022, allowing the district court to enter an injunction before expiration of the PTAB's stay.

2. Delay in Issuing the Mandate Would Significantly Harm Nippon Shinyaku, and Expedited Issuance Would Not Prejudice Sarepta.

Further delay would significantly harm Nippon Shinyaku. This Court has already recognized that Nippon Shinyaku is irreparably harmed when “deprived of its bargained-for choice of forum and forced to litigate its patent rights in multiple jurisdictions.” Opinion 15 (ECF No. 51) (citing *Gen. Protecht Grp., Inc. v. Leviton Mfg. Co.*, 651 F.3d 1355, 1363 (Fed. Cir. 2011)). In addition to the time and attention of witnesses and lawyers and the disadvantages of litigating in multiple jurisdictions, the cost to Nippon Shinyaku of this continued delay would be substantial.

This Court has already refused to diminish Nippon Shinyaku's contract rights to preserve Sarepta's improperly filed IPR petitions. *See id.* at 14 (“[T]he practical

effect that Sarepta's IPRs will now be time barred is irrelevant to determining the parties' intent at the time they included the forum selection clause in the MCA."'). Expedited issuance of the mandate will ensure that Nippon Shinyaku receives the remedy it is entitled to under the MCA and this Court's judgment.

The next deadline for Nippon Shinyaku in the IPRs is the filing of the Patent Owner's Response. This is the single most important filing by the Patent Owner in the expedited IPR proceeding. The time and expense of preparing the Patent Owner's response in all seven pending IPRs would be significant. Counsel anticipates that the costs would exceed \$400,000, and work on these responses would need to begin in earnest no later than the week of April 4, 2022. Expedited issuance of the mandate—and withdrawal of the IPRs—is the only way to avert this harm to Nippon Shinyaku from IPRs that never should have been filed in the first place.

Issuance of the mandate would not prejudice Sarepta. As an initial matter, the petition is highly unlikely to succeed. The panel's decision was unanimous, and because it is precedential, the opinion has already been circulated to every active member of the Federal Circuit. Federal Circuit Internal Operating Procedure #10, ¶ 5. Nonpanel members have already had the opportunity to comment on the decision and, if necessary, to request an *en banc* poll. *Id.* Moreover, Sarepta's petition for rehearing primarily concerns a question of state law, an issue eminently

unsuitable for en banc review. Seeking rehearing almost certainly serves no purpose other than delay.

Perhaps more importantly, issuance of the mandate (and withdrawal of the IPRs) will not moot Sarepta's petition for rehearing. Even if the pending IPRs were withdrawn, in the unlikely event that Sarepta were to prevail in a successful motion for rehearing and reverse the panel's decision, Sarepta would still be entitled to refile its IPR petitions by July 13, 2022 (up to one year after July 13, 2021, when Nippon Shinyaku served its complaint alleging infringement, Appx475-506). Nippon Shinyaku represents that it would not oppose Sarepta's refiling of any withdrawn IPR petitions by July 13, 2022, in the unlikely event that this Court reverses the panel's decision on rehearing. Issuance of the mandate will also not prevent Sarepta from pursuing its rehearing request.

This Court's expedited issuance of the mandate would not prejudice Sarepta but would avoid irreparable harm (including significant unnecessary time and expense) to Nippon Shinyaku. Issuance of the mandate is warranted.

3. Nippon Shinyaku Has Acted Expeditiously to Preserve Its Rights.

Throughout this appeal, Nippon Shinyaku has acted expeditiously throughout this appeal to preserve its rights and avoid harm, including filings its briefs on an extraordinarily expedited schedule. Nippon Shinyaku filed its opening brief on October 4, only 10 days after entry of the order denying the preliminary injunction,

and it filed its reply brief on November 9, only 7 days after filing of the Appellee's Brief.

In sharp contrast to Nippon Shinyaku's speed, Sarepta has failed to act with any urgency. Sarepta took 29 days to file its appellee's brief (significantly longer than the 17 days spent by Nippon Shinyaku spent writing both of its briefs combined), and Sarepta has now filed its rehearing petition on the last possible day. This Court should not reward Sarepta's dilatory tactics and should issue the mandate—to minimize the continued irreparable harm to Nippon Shinyaku—as soon as possible.

CONCLUSION

For the reasons set forth above, Nippon Shinyaku respectfully requests that this Court expedite issuance of the mandate, preferably no later than March 17, 2022.

Dated: March 11, 2022

Respectfully submitted,

By: /s/ William R. Peterson

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**In the United States Court of Appeals
For the Federal Circuit**

NIPPON SHINYAKU CO., LTD.,
Plaintiff–Appellant

v.

SAREPTA THERAPEUTICS, INC.,
Defendant–Appellee

On Appeal from the
United States District Court for the District of Delaware
Case No. 1:21-CV-01015, Honorable Leonard P. Stark

**DECLARATION OF AMANDA S. WILLIAMSON IN SUPPORT OF
MOTION TO EXPEDITE ISSUANCE OF MANDATE**

I, Amanda S. Williamson, declare as follows:

1. I am a Partner with the law firm of Morgan, Lewis & Bockius LLP. I am lead counsel for Patent Owners Nippon Shinyaku Co. Ltd. and National Center of Neurology and Psychiatry (collectively, “Patent Owners”) in the pending IPRs.² I have personal knowledge of all the facts set forth herein and they are true and correct. I am authorized to make this Declaration on behalf of Patent Owners.

² The case numbers for the seven pending IPRs are as follows: IPR2021-01134, 01135, -01136, -01137, -01138, -01139, and -01140.

2. On February 24, 2022, the PTAB granted Patent Owners’ and Petitioner’s joint request to stay the pending IPRs. *See* Order Suspending Proceedings (Ex. A). The Order states “that all due dates in this proceeding are suspended for up to two months,” or until April 25, 2022.³ *Id.* at 4. Per the Order, the parties are to “jointly contact the Board at the earliest of (i) two months from the date of this order or (ii) within 10 business days of the issuance of a preliminary injunction to discuss the posture of the affected cases and how to proceed.” *Id.*

3. The next deadline in the IPRs will be the filing of the Patent Owners’ Responses. While that deadline is currently suspended, Patent Owners anticipate that the PTAB will set the date for the Patent Owners’ Responses no earlier than four to six weeks from the date of resumption of the proceedings. Should the PTAB resume the proceedings on April 25, 2022, the Patent Owners’ Responses would be due sometime between the weeks of May 23 and June 6, 2022.

4. The Patent Owners’ Response is the single most important filing by a Patent Owner in an IPR proceeding. The time and expense of taking the deposition(s) of Petitioner’s expert, preparing the Patent Owners’ Responses in all seven pending IPRs, including the time and expense needed to prepare supporting

³ April 24, 2022 falls on a Sunday. *See* 35 U.S.C. § 21(b) (“When the day, or the last day, for taking any action . . . in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken . . . on the next succeeding secular or business day.”)

expert declarations, are significant. Counsel estimates that the costs could easily exceed \$400,000. And, assuming the proceedings resume on April 25, 2022, work on Patent Owners' Responses would need to begin no later than the week of April 4, 2022.

5. I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing information is true and correct within my personal knowledge.

Executed on March 11, 2022

/s/ Amanda S. Williamson _____
Amanda S. Williamson

CERTIFICATE OF COMPLIANCE

This motion complies with the type-volume limitation of Fed. R. App. P. 27(d)(2)(A) because, excluding the parts of the document exempted by Fed. Cir. R. 32(f), the motion contains 1,966 words.

Dated: March 11, 2022

/s/ William R. Peterson

William R. Peterson

ADDENDUM

Ex.	Description
A	Order Suspending Proceedings (Paper 28), Entered February 24, 2022
B	Joint Status Report (ECF No. 94), Filed February 10, 2022

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAREPTA THERAPEUTICS, INC.,
Petitioner,

v.

NIPPON SHINYAKU CO., LTD. &
NATIONAL CENTER OF NEUROLOGY AND PSYCHIATRY,
Patent Owner.

IPR2021-01134 (US 9,708,361)
IPR2021-01135 (US 10,385,092)
IPR2021-01136 (US 10,407,461)
IPR2021-01137 (US 10,487,106)
IPR2021-01138 (US 10,647,741)
IPR2021-01139 (US 10,662,217)
IPR2021-01140 (US 10,683,322)¹

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN,
CHRISTOPHER G. PAULRAJ, and ROBERT A. POLLOCK,
*Administrative Patent Judges.*²

POLLOCK, *Administrative Patent Judge.*

ORDER
Suspending Proceedings
37 C.F.R. § 42.5

¹ Parties are not authorized to use this style of caption.

² This is not a joined proceeding.

IPR2021-01134 (US 9,708,361)
IPR2021-01135 (US 10,385,092)
IPR2021-01136 (US 10,407,461)
IPR2021-01137 (US 10,487,106)
IPR2021-01138 (US 10,647,741)
IPR2021-01139 (US 10,662,217)
IPR2021-01140 (US 10,683,322)

The above-listed proceedings are suspended for the reasons set forth below.

In its Preliminary Response to the Petition (Paper 10, “Prelim. Resp.”) Patent Owner argued that we should exercise our discretion to deny institution under § 314(a) because of a Mutual Confidentiality Agreement between the parties. Prelim. Resp. 66–67.¹ In particular, Patent Owner argued that filing a petition for *inter partes* review violates the Agreement’s forum selection clause, which requires all potential actions to be filed in the United States District Court for the District of Delaware. *Id.* at 67–68 (citing Ex. 2026 § 10). Patent Owner acknowledged that the District of Delaware had denied Patent Owner’s Motion for Preliminary Injunction seeking withdrawal of this and related petitions due to the Agreement, but noted that the District Court’s Order was on appeal to the Federal Circuit. *See id.* at 61–62. Considering the particular facts before us, we declined to exercise our discretion and instituted trial in each of the above proceedings. *See* Paper 17, 25–26, 44 (Institution Decision dated January 7, 2022).

On February 8, 2022, the Federal Circuit reversed the decision of the district court, and remanded for entry of a preliminary injunction enjoining Petitioner from proceeding with its IPR petitions. *See Nippon Shinyaku Co.*,

¹ For convenience, we cite to IPR2021-01134. Similar papers and exhibits are filed in each of the seven affected cases.

IPR2021-01134 (US 9,708,361)
IPR2021-01135 (US 10,385,092)
IPR2021-01136 (US 10,407,461)
IPR2021-01137 (US 10,487,106)
IPR2021-01138 (US 10,647,741)
IPR2021-01139 (US 10,662,217)
IPR2021-01140 (US 10,683,322)

LTD., v Sarepta Therapeutics, Inc., No. 2021-2369, slip op. at 16 (Fed. Cir. Feb. 8, 2022). That same day, we received an email from Patent Owner requesting a conference call “to discuss terminating the IPRs, vacating the institution decisions, or, at the very least, suspending the captioned proceedings pending any petition(s) by Petitioner.” Ex. 3005. In response, Petitioner noted that “[n]o preliminary injunction has been entered and the Federal Circuit has not issued a mandate.” Ex. 3004 (further noting that Patent Owner had failed to meet and confer prior to emailing the Board). We denied Patent Owner’s request for a conference call as premature but invited Patent Owner “to renew its request for a conference call after the entry of the preliminary injunction, and after it confers with Petitioner regarding how to proceed.” Ex. 3007.

By email dated February 17, 2022, the parties “now jointly request that the Board suspend all due dates for the captioned IPR proceedings, and propose that the suspension should be reconsidered after (1) the Federal Circuit issues its mandate in Case No. 2021-2369; and (2) the District Court for the District of Delaware thereafter enters an order concerning the preliminary injunction.” Paper 3006 (emphasis removed). The parties “also request guidance as to whether a joint motion needs to be filed or whether this joint email request will suffice,” which we interpret as an implicit request to treat the February 17 email as joint motion. *See id.*

IPR2021-01134 (US 9,708,361)
IPR2021-01135 (US 10,385,092)
IPR2021-01136 (US 10,407,461)
IPR2021-01137 (US 10,487,106)
IPR2021-01138 (US 10,647,741)
IPR2021-01139 (US 10,662,217)
IPR2021-01140 (US 10,683,322)

We instituted trial in the referenced cases between January 7 and January 13 of this year and the Patent Owner's responses are not yet due. Considering the posture of these proceedings and the status of the Federal Circuit mandate, we find the parties' requests reasonable at this time. Accordingly, it is

ORDERED that all due dates in this proceeding are suspended for up to two months;

FURTHER ORDERED that the parties shall jointly contact the Board at the earliest of (i) two months from the date of this order or (ii) within 10 business days of the issuance of a preliminary injunction to discuss the posture of the affected cases and how to proceed.

IPR2021-01134 (US 9,708,361)
IPR2021-01135 (US 10,385,092)
IPR2021-01136 (US 10,407,461)
IPR2021-01137 (US 10,487,106)
IPR2021-01138 (US 10,647,741)
IPR2021-01139 (US 10,662,217)
IPR2021-01140 (US 10,683,322)

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EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NIPPON SHINYAKU CO., LTD.,)
)
 Plaintiff/Counter-Defendant,)
)
 v.) C.A. No. 21-1015 (LPS)
)
 SAREPTA THERAPEUTICS, INC.,)
)
 Defendant/Counter-Plaintiff.)

JOINT STATUS REPORT

Plaintiff/Counter-Defendant Nippon Shinyaku Co., Ltd. (“Nippon Shinyaku”) and Defendant/Counter-Plaintiff Sarepta Therapeutics, Inc. (“Sarepta”) submit this joint status report pursuant to the Court’s February 8, 2022 Oral Order (D.I. 93).

I. PROCEDURAL STATUS

Since the parties’ last status report (D.I. 88), the Federal Circuit has issued its Opinion, reversing this Court’s decision denying Nippon Shinyaku’s request for a preliminary injunction and remanding for entry of a preliminary injunction. D.I. 92-1 at 16. The time to seek further appellate review has not elapsed and no mandate has issued. Sarepta has now answered the operative complaint and filed counterclaims against Nippon Shinyaku as well as affirmative claims against NS Pharma, Inc. *See* D.I. 89. Nippon Shinyaku and NS Pharma, Inc. intend to answer the counterclaims promptly. Initial pleadings will thus be closed shortly.

II. THE PARTIES’ AGREEMENT TO PARTICIPATE IN A RULE 26(F) CONFERENCE

The parties have agreed to participate in a Rule 26(f) conference within seven days of the close of the pleadings.

III. NIPPON SHINYAKU’S REQUEST FOR PROMPT ENTRY OF A PRELIMINARY INJUNCTION AND SAREPTA’S OPPOSITION TO THAT REQUEST

A. Nippon Shinyaku’s Position

Consistent with the Federal Circuit’s Judgment and Opinion, Nippon Shinyaku requests that this Court promptly enter an order mandating that Sarepta withdraw its previously filed IPR Petitions. Nippon Shinyaku understands Sarepta disputes the scope of the preliminary injunction that should issue and the amount (if any) of a preliminary injunction security bond. While Nippon Shinyaku believes no bond is necessary and that the scope of the injunction is clear, given the parties’ dispute regarding these issues and in the interests of having these issues resolved so that the Court can enter an injunction immediately upon receipt of the Federal Circuit’s mandate (or, in its discretion, prior to entry of the mandate), Nippon Shinyaku requests that the Court enter an expedited briefing schedule to resolve these limited issues as follows:

- Nippon Shinyaku submits opening letter brief not to exceed 3 single-spaced pages by February 14
- Sarepta submits opposition letter brief not to exceed 3 single-spaced pages by February 16; and
- Nippon Shinyaku submits a reply letter brief, not to exceed 1 single-spaced page, by February 17.

Notably, in the *Apple, Inc. v. Samsung Elecs. Co.*, 2012 WL 1987042, at *1 (N.D. Cal. June 4, 2012) cited by Sarepta, the district court did just this—it shortened briefing time for issues relating to a preliminary injunction so that briefing was complete prior to issuance of the circuit

court's mandate. The claims in this case are not stayed and nothing in the case law cited by Sarepta below precludes this Court from ordering the requested briefing. Rather, the Federal Circuit remanded to this Court for entry of the preliminary injunction. *See* D.I. 92-1 at 16. Nippon Shinyaku requests that the Court set a teleconference as soon as possible after the close of briefing to resolve these issues. Nippon Shinyaku respectfully submits that prompt briefing is necessary to prevent further accrual of irreparable harm. Sarepta has informed Nippon Shinyaku that it is assessing its options, including a potential petition for panel rehearing and/or rehearing en banc. Any delays associated with entry of a preliminary injunction further prejudices and irreparably harms Nippon Shinyaku who is now forced to needlessly spend money on IPR proceedings the Federal Circuit has found were commenced in breach of the governing forum selection clause.

B. Sarepta's Position

Sarepta opposes Nippon Shinyaku's request for entry of a preliminary injunction because (1) no mandate from the Federal Circuit has issued; (2) the time to seek review of the Federal Circuit Opinion has not elapsed (e.g., a petition for panel rehearing and/or rehearing en banc is due by March 10, 2022); (3) Nippon Shinyaku has not met the security requirement for issuance of a preliminary injunction and a determination of potential costs and damages associated therewith has not been made. *See* Fed. R. Civ. P. 65(c) ("The court may issue a preliminary injunction or a temporary restraining order only if the movant gives security in an amount that the court considers proper to pay the costs and damages sustained by any party found to have been wrongfully enjoined or restrained."); and (4) the appropriate scope of any preliminary injunction has not been determined.

Sarepta also opposes Nippon Shinyaku's proposal to brief the scope of an injunction and an appropriate bond when the Federal Circuit proceedings are not final, the mandate has not issued, and the case has not been remanded. Sarepta believes that this Court has no jurisdiction over the injunction issues at this time. *E.g.*, *Finberg v. Sullivan*, 658 F.2d 93, 99 (3d Cir. 1980) ("[A]n appellate court's decision is not final until it issues its mandate."); *cf. Apple, Inc. v. Samsung Elecs. Co., Ltd.*, 2012 WL 1987042, at *2 (N.D. Cal. June 4, 2012) ("Apple's motion for a Rule 62(c) injunction, before the Federal Circuit has issued the mandate, seeks to have the Court adjudicate anew the preliminary injunction while the same issue is on appeal before the Federal Circuit. Were this Court to grant the preliminary injunction before the mandate issues, the Court would effectively alter the status quo."). The Federal Circuit's opinion only issued two days ago, and Sarepta is assessing its options, including a potential petition for panel rehearing and/or rehearing en banc. Finally, even if the Court did have jurisdiction to address the remaining issues concerning a preliminary injunction at this time, Nippon Shinyaku's proposed briefing schedule, which includes only a two-day period for Sarepta to submit an opposition letter brief (and only allows three pages), is not realistic or fair.

Respectfully submitted,

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