

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**AMERIGEN PHARMACEUTICALS LIMITED**

**and**

**ARGENTUM PHARMACEUTICALS LLC,**

**Petitioners**

**v.**

**JANSSEN ONCOLOGY, INC.,**

**Patent Owner**

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**Case IPR2016-00286<sup>1</sup>**

**Patent 8,822,438 B2**

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**PETITIONERS' OPPOSITION TO PATENT OWNER'S**

**MOTION TO EXCLUDE EVIDENCE**

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<sup>1</sup>Case IPR2016-01317 has been joined with this proceeding.

Petitioners, Amerigen Pharmaceuticals Limited and Argentum Pharmaceuticals LLC, oppose Patent Owner's, Janssen Oncology, Inc., Motion to Exclude Evidence submitted by Petitioners.

**I. Declarations and related Exhibits of Deforest McDuff (economic expert).**

Patent Owner argues that all the evidence submitted by Petitioners concerning commercial success should be excluded. As Patent Owner correctly points out, commercial success can be relevant to the issue of obviousness of a patent claim. In this instance, the Patent Owner itself attempted to claim commercial success as an objective indicia of non-obviousness in Patent Owner's Response. (See Patent Owner's Response at p. 60).

There is no basis in law or common sense suggesting that Patent Owner can attempt to establish non-obviousness with evidence of commercial success in the course of prosecuting a patent, and then again during an IPR proceeding, but that Petitioners are prohibited from addressing such, commenting upon, and offering its own evidence on the issue. Tellingly, Patent Owner cites to no regulation or case law on the issue.

Patent Owner's issue with Dr. McDuff's first declaration (Exh. 1017) seems to be that it was offered prior in time to Patent Owner's Response and is therefore not technically a "rebuttal." Dr. McDuff's first declaration was necessitated by the

original prosecution record leading to the issuance of the '438 Patent in the first instance. Patent Owner overlooks that critically, in the case of the '438 Patent, patentees were only able to overcome compelling prior art rejections based on "commercial showings." Dr. McDuff's Declaration necessarily addresses the original prosecution record. Patent Owner cannot expect Petitioners and the Board to not consider the grounds on which the '438 patent issued in the first instance. Again, Patent Owner offers no case law to support this notion that such evidence must be offered in the Reply as opposed to the Petition itself.

Finally, Patent Owner claims that Dr. McDuff's second declaration (currently labeled Exh. 1152) is not cited in Petitioners' Reply. As is known to the Patent Owner, Dr. McDuff's second declaration was inadvertently labeled as Exhibit 1152. However, the second McDuff Declaration is cited as Exhibit 1096 in Petitioners' Reply brief and Exhibits 1149, 1150, 1151 and 1190 are cited in the second McDuff declaration. Petitioners have approached the Board to correct the clerical error. There has been no prejudice to Patent Owner in this regard, as counsel fully considered Dr. McDuff's second declaration and exhibits, and indeed deposed him on it. Exh. 1191. During the deposition of Dr. McDuff the Patent Owner did not make any objections that the testimony was irrelevant. It is illogical

that Patent Owner has objected to Dr. McDuff's Declaration but did not object to Dr. McDuff's deposition based upon his declaration.

## **II. Certain of Petitioners' Exhibits to Its Reply Brief Filed and Served After Midnight.**

Patent Owner admits that Petitioners' Reply brief and four expert declarations accompanying its Reply brief were timely filed but complains that the exhibits were filed after midnight. Patent Owner relies solely on *Teva Pharmaceuticals USA, Inc. v. Monosol RX, LLC*, IPR2016- 00281, -00282, Papers 21 and 19 (PTAB May 23, 2016) for the notion that the exhibits should be stricken. Patent Owner fails to mention that Teva however missed a statutory bar for the filing of a Petition. There is no such bar here, and in the interest of justice the exhibits should not be stricken.

The Patent Owner does not make an actual claim of prejudice and there was none. First, Petitioners note that January 16, 2017 was a national holiday, the USPTO was officially closed, and Patent Owner received all exhibits prior to open of business on the morning of the first business day following the holiday. Second, the Patent Owner took all of the depositions of Petitioners' experts as scheduled. Patent Owner did not request additional time to prepare or otherwise object until after it took each of the depositions. Further, Patent Owner elected not to use more than half of its allotted time for each deposition.

Finally, Patent Owner's subtle suggestion of gamesmanship is unwarranted. Petitioners experienced technical problems during the filing which caused the delay. Petitioners have always cooperated with Patent Owner including giving Patent Owner two extensions totaling approximately five weeks (August 31 to October 4) to file its Preliminary Response and working with Patent Owner to schedule depositions of the four experts relied upon in Petitioners' Reply in advance of filing the Reply. With regard to the five hour delay in filing the exhibits to the Petitioners' Reply, Petitioners, in response to Patent Owner's Objection served on January 23, 2017, have requested that the Patent Owner stipulate to an extension of the deadline from January 16 to January 17 but Patent Owner rejected such a stipulation.

**III. Paragraphs of Petitioners' Reply Declarations Not Explicitly Recited in Petitioners' Reply.**

Patent Owner, citing no statute, regulation, or case law, complains that any paragraph of an expert declaration not explicitly cited in Petitioners' Reply brief should be stricken. There is simply no legal basis for striking these paragraphs.

Patent Owner's sole basis for arguing irrelevance is the lack of citation in the Reply brief. Patent Owner did not examine the substance of any paragraphs it moved to exclude. That is, Patent Owner failed to consider that the paragraphs at

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