

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2

3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Amerigen Pharmaceuticals Limited and

6

Argentum Pharmaceuticals LLC

7

Petitioners

8

v.

9

Janssen Oncology, Inc.

10

Patent Owner

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12

Case IPR2016-00286

Patent 8,822,438 B2

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VIDEOTAPED DEPOSITION OF MARK J. RATAIN, M.D.

18

January 23, 2017

19

Chicago, Illinois

20

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22

GOLKOW TECHNOLOGIES, INC.

23

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6 The videotaped deposition of MARK J. RATAIN, M.D.,
7 called by the Patent Owner for examination, taken
8 before CORINNE T. MARUT, C.S.R. No. 84-1968,
9 Registered Professional Reporter and a Certified
10 Shorthand Reporter of the State of Illinois, at the
11 offices of Sidley Austin LLP, Suite 3800, One South
12 Dearborn Street, Chicago, Illinois, on
13 January 23, 2017, commencing at 8:57 a.m.
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1 THE VIDEOGRAPHER: We are now on the record.
2 My name is Terry Kupperman. I am a
3 videographer for Golkow Technologies.
4 Today's date is January 23, 2017. The
5 time is now 8:57 a.m.
6 This video deposition is being held in
7 Chicago, Illinois in the matter of Amerigen
8 Pharmaceuticals Limited vs. Janssen Oncology, Inc.,
9 for the United States Patent and Trademark Office.
10 The deponent's name is
11 Dr. Mark J. Ratain.
12 Will counsel please identify yourselves
13 for the record.
14 MR. KRAUSE: Todd Krause of Sidley Austin
15 representing Patent Owner, Janssen.
16 MR. CASIERI: Chris Casieri of McNeely, Hare &
17 War representing the Petitioners and with me is
18 William Hare.
19 THE VIDEOGRAPHER: Will the Court Reporter
20 please identify yourself and swear in the witness.
21 THE REPORTER: My name is Corinne Marut.
22 (WHEREUPON, the witness was duly
23 sworn.)

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1 MARK J. RATAIN, M.D.,
 2 called as a witness herein, having been first duly
 3 sworn, was examined and testified as follows:
 4 EXAMINATION
 5 BY MR. KRAUSE:
 6 Q. Good morning, Dr. Ratain.
 7 A. Good morning.
 8 Q. Can you please state your name and home
 9 address for the record.
 10 A. Sure. Mark Jeffrey Ratain. 1040 West
 11 Oakdale, Chicago, 60657.
 12 Q. Have you ever been deposed before?
 13 A. Yes.
 14 Q. There are a few points I'd like to
 15 review before we get started.
 16 If I ask a question that's not clear or
 17 you didn't hear me, please let me know so I can ask
 18 the question again. If you answer, I'll assume you
 19 understood and heard my question. Okay?
 20 A. Okay.
 21 Q. We have a Court Reporter taking down
 22 your answers to my questions. So, please try to
 23 give verbal answers to my questions. Okay?
 24 A. Yes.

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1 Q. We'll try to take breaks about every
 2 hour or so, but please let me know if you need a
 3 break. I'll finish whatever question I'm on and we
 4 can take a break.
 5 Is there any reason you can't give
 6 complete and accurate testimony here today?
 7 A. No.
 8 Q. I've handed you a document that's been
 9 previously marked Amerigen Exhibit DX 1091.
 10 Do you recognize this document?
 11 A. Yes.
 12 Q. And is this your declaration in this
 13 matter?
 14 A. Yes.
 15 Q. And is that your signature on the first
 16 page of the declaration?
 17 A. Yes.
 18 Q. Is this declaration an accurate
 19 statement of the opinions that you've reached in
 20 this case?
 21 A. Checking to make sure there is no
 22 missing pages.
 23 Q. Sure.

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1 Q. Are there any errors in your declaration
 2 that you're aware of?
 3 A. Well, I was reviewing it in preparation
 4 for this. I note that Exhibit A is missing and
 5 never was apparently -- I thought counsel was doing
 6 that. That's my error. And I -- there is some
 7 parentheses missing in some places but nothing --
 8 no substantive errors.
 9 Q. When were you first asked to provide
 10 opinions on the subject matter in your declaration?
 11 A. It would have been sometime in the fall.
 12 Q. Can you -- a month maybe, November,
 13 December, early fall, late?
 14 A. It would have been October or November.
 15 Q. Okay. When did you begin working on the
 16 opinions that you have expressed in your
 17 declaration?
 18 A. That was probably in November.
 19 Q. About how many hours total did you spend
 20 working on the declaration from the very beginning
 21 of the time until you signed it?
 22 A. Until? I'm sorry.
 23 Q. Until you signed it.
 24 A. Well, let's see. I've invoiced about 40

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1 hours so far, but I haven't invoiced for my recent
 2 work. So, and that's -- recently it's been at
 3 least a day a week. So, I don't know. A lot of
 4 time.
 5 Q. A day a week since when?
 6 A. I would have last invoiced sometime in
 7 December. I don't -- I just don't remember.
 8 Q. Sure.
 9 A. I've obviously put in time since I've
 10 signed it as well.
 11 Q. Do you regularly invoice in the
 12 beginning of the month or the end of the month?
 13 A. There is no regularity to that.
 14 Q. Okay. How did you gather the
 15 information that you relied on in your declaration?
 16 A. First of all, I knew a lot of it and,
 17 second of all, I was asked to primarily respond to
 18 Dr. Rettig. So, I reviewed his declaration. I
 19 reviewed his deposition transcript.
 20 And then I did my own independent review
 21 of what I as a physician and professor call the
 22 literature but you in the law call the prior art.
 23 So, I looked at both literature before the filing

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1 and expectation of success and then I looked at
 2 more recent literature in the context of his
 3 opinions regarding unexpected results.
 4 And I used the standard approach I use
 5 in my daily professional work as a professor,
 6 physician and investigator and used searches with
 7 PubMed and Google Scholar.
 8 Q. And how did you decide which references
 9 you would identify in your declaration based on the
 10 searches that you performed?
 11 A. Well, as I said, I was asked to respond
 12 to Dr. Rettig and so, you know, I cited references
 13 that -- that supported my opinions.
 14 Q. Did you read every page of every
 15 reference that you cite in your declaration?
 16 A. I think so. It's conceivable there is a
 17 book cited that I didn't read every page of, but I
 18 read every page of any article or book chapter that
 19 was relevant.
 20 Q. Did you speak with anyone other than
 21 Petitioner's counsel in preparing the opinions that
 22 you've expressed in your declaration?
 23 A. No.
 24 Q. You didn't speak with any other

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1 colleagues?
 2 A. No.
 3 Q. No other experts?
 4 A. No.
 5 Q. And I believe you mentioned that you
 6 read Dr. Rettig's deposition transcript, is that
 7 right?
 8 A. Yes.
 9 Q. You don't identify Dr. Rettig's
 10 deposition transcript in your declaration, do you?
 11 A. Well, in theory it would have been in
 12 Exhibit A because I certainly reviewed it. I do
 13 note -- I guess it's not cited as specifically, but
 14 there are certainly, you know, for example,
 15 paragraph 29, I say, "I first note that Dr. Rettig
 16 admitted in his deposition that he did not perform
 17 a review of any literature other than that provided
 18 to him by counsel for Janssen."
 19 So, you are technically correct in that
 20 my declaration doesn't cite the exhibit number that
 21 would be associated with his deposition transcript,
 22 but I presume that the basis for that sentence
 23 would be clear to the Board.

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1 relied on in your declaration that you did not
 2 identify in your declaration?
 3 A. I would have to go through and sit here
 4 and go through it word by word to make sure there
 5 is nothing else missing.
 6 Q. Was there ever a draft Exhibit A?
 7 A. Not that I saw.
 8 Q. Did you keep a list of the references
 9 that you were reviewing in the preparation of your
 10 declaration?
 11 A. Not -- not in a formal way, no. I was
 12 relying on counsel for -- to legalize my
 13 declaration, so to speak.
 14 Q. What do you mean by that?
 15 A. To get the references in the proper
 16 legal format.
 17 Q. Did you actually draft your declaration?
 18 A. Yes.
 19 Q. About how many hours did you spend
 20 drafting your declaration?
 21 A. I can't tell you that because I spend a
 22 lot of time reviewing the literature and
 23 formulating my opinions and communicating my
 24 opinions with counsel and making sure they

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1 understood what my opinions were and making sure
 2 that my -- that we were on the same page as how my
 3 opinions would fit into the case legally.
 4 And I was not asked to provide any
 5 opinions on primary obviousness, only to respond to
 6 Dr. Rettig, and that's therefore the scope of my
 7 declaration.
 8 Q. And when was your declaration completed?
 9 A. It was completed on January 16.
 10 Q. Did you read any deposition transcripts
 11 other than Dr. Rettig's?
 12 A. Yes.
 13 Q. What other deposition transcripts did
 14 you read?
 15 A. I read Dr. Auchus' deposition. I read
 16 Dr. Chodak's deposition. I read Dr. Serels'
 17 deposition. I read Dr. McDuff I believe, is the
 18 economist, his deposition. I don't remember if I
 19 reviewed the other economist's, the one that your
 20 client has retained. And then I've reviewed the
 21 deposition transcripts that have been obtained
 22 since I filed this declaration.
 23 Q. And what transcripts are those?

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1 reviewed the various petitions, the original
 2 petition I reviewed, the response, the reply. I've
 3 reviewed the declarations of the various experts.
 4 Q. And your declaration doesn't identify
 5 that you reviewed any of those deposition
 6 transcripts, isn't that correct?
 7 A. That would have been in Exhibit A.
 8 Q. Which doesn't exist?
 9 A. Which does not exist.
 10 Actually, my declaration does address
 11 the deposition transcripts. I'm sorry. It
 12 addresses the declarations, paragraph 16 where I
 13 note that I reviewed the declaration or at least I
 14 note that the materials discussed in the
 15 declarations, which would imply that I reviewed the
 16 declarations.
 17 Q. Why would saying the materials discussed
 18 in the declarations would imply that you read the
 19 deposition transcripts?
 20 A. No. The declaration. No, you're
 21 correct.
 22 Q. Oh, I'm sorry.
 23 A. Yeah. No.
 24 And, you know, my understanding was that

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1 also that I reviewed these other documents, but I
 2 haven't cited them with the exception of Rettig's
 3 deposition.
 4 In other words, they're not -- they --
 5 it was of interest to me to understand what
 6 everybody was saying, but it doesn't impact my own
 7 opinions.
 8 Q. But it informs your understanding of the
 9 issues in the case, correct?
 10 A. It informs my understanding of the legal
 11 issues, yes.
 12 Q. And the factual issues, correct?
 13 MR. CASIERI: Object to form.
 14 BY THE WITNESS:
 15 A. I think the factual issues I can -- I
 16 can form my opinions regarding the factual issues,
 17 the scientific medical issues, without reviewing,
 18 for example, the deposition transcript of the
 19 endocrinologists, I mean, because I'm -- I'm not
 20 providing opinions, you know, from their
 21 perspective.
 22 BY MR. KRAUSE:
 23 Q. But it gave you a better understanding

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1 substantive facts in the case. Isn't that fair to
 2 say?
 3 A. I would say it was more for my curiosity
 4 than as being -- my opinions would be no different.
 5 My declaration would be no different if I had never
 6 seen Dr. Auchus' declaration or Dr. Auchus'
 7 deposition transcript, for example.
 8 Q. And how would you know that?
 9 A. I'm just telling you now that I -- I
 10 know a lot of things that -- you could ask me if I
 11 didn't have a particular piece of prior art, how
 12 would that change my opinion. I could give you an
 13 answer to that.
 14 So, I can -- I can say here under oath
 15 that if I had never seen Dr. Auchus' deposition
 16 transcript it wouldn't impact my -- my opinions.
 17 Q. You were referring to paragraph 16 in
 18 your declaration, and this paragraph identifies at
 19 least a portion of what you considered in
 20 formulating your opinion.
 21 This paragraph is the only mention of
 22 the Chodak declaration, is that correct?
 23 A. Yes.
 24 Q. And your declaration provides no

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1 opinions with respect to the opinions expressed by
 2 Dr. Chodak's declaration, is that right?
 3 A. That's correct.
 4 Q. And Dr. Auchus' declaration is also
 5 mentioned in paragraph 16. It's also mentioned in
 6 paragraph 19 of your declaration when you refer to
 7 the standard for a person of ordinary skill that he
 8 applied, and then paragraph 35 where you say
 9 Dr. Dorin will address Dr. Auchus' opinions, is
 10 that right?
 11 That's a pretty loaded question.
 12 So, Dr. Auchus is mentioned in paragraph
 13 16, his declaration. He's also mentioned in 19 and
 14 35.
 15 But I guess my question is: Is there
 16 any other mention of Dr. Auchus in your
 17 declaration?
 18 A. Now I'm going to have -- if you're going
 19 to ask me a question like "Is there any other," I'm
 20 going to have to go through and read it. So, if
 21 you want to represent to me that there isn't,
 22 that's fine. Otherwise --
 23 Q. I'm not aware of any. Are you aware of

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