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1 UNITED STATES PATENT AND TRADEMARK OFFICE
-----X
2 AMERIGEN PHARMACEUTICALS LIMITED,
3 Petitioner,
4 -against-
5 JANSSEN ONCOLOGY, INC.,
6 Patent Owner.
7 Case IPR2016-00286
-----X
8
9 787 Seventh Avenue
New York, New York
10
11 September 1, 2016
12 9:02 a.m.
13 DEPOSITION of DeFOREST McDUFF, Ph.D.,
14 taken before Sadie L. Herbert, a Registered
15 Professional Reporter and Notary Public of the
16 States of New York and New Jersey.
17
18
19
20
21
22 THE MCS GROUP, INC.
23 1601 Market Street, 8th Floor
24 Philadelphia, PA 19103
25 (215) 405-8178

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22 **DAVID SHERECK, Videographer**
23
24
25

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3 DeFOREST McDUFF, Ph.D. MR. OLSON 6
4 MR. HARE 76
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12 (EXHIBITS TO BE PRODUCED)
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1 PROCEEDINGS
2 (Janssen Exhibit 2032, Patent
3 Owner's Notice of Deposition of
4 DeForest McDuff, Ph.D., was
5 pre-marked for identification.)
6 THE VIDEOGRAPHER: Okay. This
7 is -- sorry.
8 The time is approximately
9 9:02 a.m. This is the video --
10 today's date is Thursday,
11 September 1st, 2016. This is the
12 video deposition of Dr. DeForest
13 McDuff, Ph.D. in the matter of
14 Amerigen Pharmaceuticals versus
15 Janssen Oncology, Incorporated.
16 Case Number is IPR2016-00286, in
17 the United States Patent and
18 Trademark Office.
19 My name is David Shereck,
20 certified legal videographer with
21 Shereck Video, in association with
22 Deitz Reporting of Rockville
23 Centre, New York.
24 We're located today at the
25 office of Sidley Austin, LLP at

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1 787 Seventh Avenue, New York,
2 New York.
3 Will counsels please voice
4 identify yourselves and whom you
5 represent.
6 MR. OLSON: Isaac Olson with
7 Sidley Austin representing Patent
8 Owner, Janssen Oncology, Inc.
9 MR. HARE: Bill Hare, McNeely,
10 Hare & War, representing Amerigen
11 Pharmaceuticals, Limited.
12 MS. REDA: Jennifer Reda
13 representing Janssen Oncology.
14 THE VIDEOGRAPHER: Thank you.
15 The court reporter today is
16 Sadie Herbert, also with Deitz
17 Reporting. Would you please swear
18 in the witness.
19 DeFOREST McDUFF, Ph.D., the witness herein,
20 having first been duly sworn by a Notary
21 Public of the State of New York, was
22 examined and testified as follows:
23 CROSS-EXAMINATION
24 BY MR. OLSON:
25 **Q Before we start. I'd just like to**

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1 **state on the record that I've marked the**
2 **notice of deposition that we served for**
3 **Dr. McDuff as Janssen Exhibit 2032. Set**
4 **that there, but we don't really need to do**
5 **anything with it.**
6 **Could you please state your full**
7 **name for the record.**
8 A Robert DeForest McDuff.
9 **Q Have you had your deposition taken**
10 **before today?**
11 A Yes.
12 **Q Approximately how many times?**
13 A Around 20 or 25.
14 **Q Were any of those prior depositions**
15 **in patent proceedings?**
16 A Yes.
17 **Q How many?**
18 A I would have to look to get you an
19 exact figure. I would ballpark, more than
20 15.
21 **Q Of those 15, were any of those**
22 **depositions in inter partes review**
23 **proceedings?**
24 A No.
25 **Q Approximately how many of those**

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1 **prior depositions in patent proceedings**
2 **involved pharmaceutical products?**
3 A I would have to go back and look to
4 get an exact figure. Sitting here, I would
5 estimate around ten.
6 **Q And of those ten, did -- did any of**
7 **those ten depositions involve anticancer**
8 **treatments?**
9 A I don't believe so.
10 **Q Did you testify as an expert**
11 **witness in those prior proceedings?**
12 A Yes.
13 **Q Have you testified at trial?**
14 A Yes.
15 **Q Approximately how many times have**
16 **you testified at trial?**
17 A I believe it has been six times.
18 **Q And those six times, were those in**
19 **patent proceedings?**
20 A Some were; some were not.
21 **Q Approximately how many were in**
22 **patent proceedings?**
23 A I would think of four of them as
24 patent proceedings and one of them related
25 to patent valuation methodologies, though

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1 not a patent proceeding as I would think of
2 it.

3 **Q What was the -- the general issue**
4 **presented in that case that -- involving**
5 **patent valuation?**

6 A It was a bankruptcy hearing where
7 the plaintiff was seeking a remedy based on
8 a patent portfolio valuation.

9 **Q Okay. Now, if you don't understand**
10 **a question I ask today, please let me know.**
11 **If you do not do so, can I assume that you**
12 **understand the question?**

13 A Okay.

14 **Q Okay.**
15 **(Amerigen Exhibit 1017,**
16 **Declaration of DeForest McDuff,**
17 **Ph.D., having been previously**
18 **marked, was introduced into the**
19 **record.)**

20 **Q If you could please look at what's**
21 **previously been marked as Amerigen**
22 **Exhibit 1017.**
23 **Do you recognize this document?**

24 A (Document review.)
25 Yes, it appears to be the

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1 declaration I submitted in December of 2015.

2 **Q Okay. So Amerigen Exhibit 1017 is**
3 **your December 4th, 2015 declaration; is that**
4 **correct?**

5 A It appears to be, yes.

6 **Q When did you last review your**
7 **declaration?**

8 A Most recently, yesterday.

9 **Q When were you first approached**
10 **about getting involved in this case?**

11 A Sometime in the middle of 2015.

12 **Q Do you recall who approached you?**

13 A Mr. Hare.

14 **Q How many in-person meetings did you**
15 **have with your attorneys related to the**
16 **preparation of this declaration?**

17 A Related to the preparation of the
18 declaration, none.

19 **Q Did you have teleconferences with**
20 **the attorneys representing Amerigen related**
21 **to the preparation of this declaration?**

22 A Yes.

23 **Q Approximately how many?**
24 A I don't recall specifically.
25 Perhaps around three to six.

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1 **Q Did you write your declaration**
2 **yourself?**

3 A Yes.

4 **Q About how much time in total did**
5 **you spend in the preparation of your**
6 **declaration?**

7 A I don't have a specific figure.
8 It's probably more than 30 hours, probably
9 less than 60. And hours were also spent by
10 members of my staff working at my direction.

11 **Q Okay. Who from your staff worked**
12 **on the preparation of this declaration?**

13 A I would have to go back and look,
14 though I believe Mr. Matthew Brundage was a
15 primary person working on this. Possibly,
16 as well, Mr. Ryan Andrews.

17 **Q Other than Mr. Brundage and**
18 **Mr. Andrews, do you recall anyone else who**
19 **worked on the preparation of your**
20 **declaration?**

21 A I don't believe so.

22 **Q Approximately how much time did you**
23 **spend reviewing materials for your**
24 **declaration?**

25 A Would you mind clarifying what you

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1 mean?

2 **Q Sure -- well, I'll give you a**
3 **better question.**
4 **The -- you said that you spent**
5 **approximately 30 to 60 hours preparing your**
6 **declaration. Was that 30 to 60 hours**
7 **drafting the declaration or 30 to 60 hours**
8 **overall?**

9 A I had in mind more of an overall
10 amount, so that would include my research,
11 analysis, discussions with my staff,
12 drafting the declaration, things of that
13 nature.

14 **Q Okay. Approximately how much of**
15 **the 30 to 60 hours spent in the preparation**
16 **of the declaration was spent on research**
17 **related to the declaration?**

18 A I don't remember specifically.

19 **Q Approximately how much time did you**
20 **spend drafting the declaration?**

21 A I don't have a specific
22 recollection or a breakdown for you. I
23 think of it as a process that involves all
24 of those activities and don't separately
25 track them.

1 **Q How much in total expert fees have**
2 **you billed on this matter?**
3 A I believe it's around 80,000, more
4 or less.
5 **Q Would you please turn to**
6 **Attachment A-1 of your declaration.**
7 A Okay.
8 **Q Do you recognize Attachment A-1?**
9 A Yes.
10 **Q Attachment A-1 is your CV; correct?**
11 A As of December 2015, yes.
12 **Q When did you last update your CV?**
13 A Last week, maybe even earlier this
14 week.
15 **Q Do you consider Attachment A-1 to**
16 **be generally reflective of your professional**
17 **background?**
18 A (Document review.)
19 I do, although, I do have more
20 cases and testimony that has occurred since
21 December 2015, and I would also include
22 those as part of my professional background.
23 **Q And what are those additional**
24 **cases?**
25 A There are a number of them. I'm

1 not sure I could remember all of them
2 sitting here, yet if you'd like, I'd be
3 happy to try to remember some.
4 **Q Sure.**
5 A One is a case relating to the
6 evaluation of the drug MULTAQ or the
7 compound dronedarone in the District of
8 Delaware, an evaluation of commercial
9 success.
10 Another is an evaluation of
11 commercial success relating to the drug
12 AMPYRA, compound is aminopyridine.
13 **Q Is the AMPYRA case in federal**
14 **court?**
15 A I believe so, yes.
16 **Q Do you know which district it's in?**
17 A It's in the District of Delaware.
18 **Q Delaware.**
19 A Another case is Art Cohen and
20 plaintiffs similarly situated versus
21 Donald J. Trump in the Southern District of
22 California relating to class action damages.
23 There may be a few others.
24 **Q Okay.**
25 A Those are the ones that come to

1 mind sitting here.
2 **Q All right.**
3 A There have, of course, been some
4 depositions and trial testimony that would
5 be updated on the items listed in my expert
6 testimony.
7 Another case that comes to mind is
8 CH2O versus Maris in the Central District of
9 California relating to patent damages.
10 **Q Okay. Any others that you can**
11 **think of?**
12 A Not sitting here.
13 **Q Okay. Your current position is**
14 **vice presidency -- vice president of**
15 **Intensity Corporation; correct?**
16 A Yes.
17 **Q You state that you are an expert in**
18 **applied business economics; correct?**
19 A Yes.
20 **Q You're not a medical doctor;**
21 **correct?**
22 A Correct.
23 **Q And you don't have a Ph.D. in**
24 **pharmacology, biochemistry or a related**
25 **discipline; correct?**

1 A Correct.
2 **Q And you don't have a Ph.D. in**
3 **pharmaceutical sciences; is that correct?**
4 A Correct.
5 **Q Would you turn to Attachment A-2 in**
6 **your declaration.**
7 A I'm there.
8 **Q And this is a list of materials**
9 **considered, reviewed or relied upon; is that**
10 **correct?**
11 A Yes.
12 **Q Who provided you with the materials**
13 **that are listed in Attachment A-2?**
14 A Some of the materials were provided
15 by Mr. Hare and some of the materials I and
16 members of my staff, working at my
17 direction, collected in our research.
18 **Q Can you identify for me the**
19 **references that you identified -- you and**
20 **your staff identified independent of your**
21 **attorneys?**
22 A I believe my staff and I identified
23 the patents listed on Page 1. And then
24 Mr. Hare pointed me to the versions of those
25 that existed within this proceeding. And my

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1 staff and I identified the items listed
2 under research materials from Pages 2 to 4.
3 **Q Who prepared Attachment A-2?**
4 A Members of my staff working at my
5 direction.
6 **Q Turn to Attachment B-1 of**
7 **Amerigen 1017.**
8 **Do you recognize Attachment B-1?**
9 A Yes.
10 **Q What is Attachment B-1?**
11 A As described here in the title, it
12 is a summary of prosecution filings for the
13 '438 patent.
14 **Q How was Attachment B-1 prepared?**
15 A It was prepared based on review of
16 the documents indicated in the source column
17 and a description of those items was
18 generated and recorded in the description
19 column. And of course, the date was
20 recorded in the date column.
21 **Q Who prepared Attachment B-1?**
22 A A member of my staff working at my
23 direction.
24 **Q How were the source documents**
25 **listed in the source column identified?**

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1 A I'm not sure I understand. Would
2 you mind clarifying.
3 **Q Sure.**
4 **Who identified the source documents**
5 **that are listed in the source column of**
6 **Attachment B-1?**
7 A I believe these were identified
8 based on my and my staff's review of those
9 documents. That's what I recall.
10 **Q Are you or any of the members of**
11 **your staff trained patent attorneys?**
12 A No.
13 **Q Would you turn to Attachment B-2 of**
14 **your declaration.**
15 **Do you recognize Attachment B-2?**
16 A Yes.
17 **Q What is Attachment B-2?**
18 A Attachment B-2 is a list of some of
19 the top selling oncology drugs.
20 **Q How was Attachment B-2 prepared?**
21 A It was prepared based on research
22 on this topic and identification of the
23 source listed under notes and sources. And
24 then information from that source was put in
25 table form.

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1 **Q Who prepared Attachment B-2?**
2 A Members of my staff working at my
3 direction.
4 **Q Zytiga is the only drug listed in**
5 **Attachment B-2 that is indicated for the**
6 **treatment of prostate cancer; correct?**
7 A I would have to go back and look.
8 **Q Did you consider whether any of the**
9 **drugs listed in Attachment B-2 were**
10 **indicated for the treatment of prostate**
11 **cancer in the preparation of your**
12 **declaration?**
13 A I know that some of them are not,
14 yet I'm just not sure sitting here whether
15 all of them are not.
16 **Q Other than Zytiga, none of the**
17 **other drugs listed in Attachment B-2 are**
18 **oral drugs; correct?**
19 A I would have to go back and look.
20 **Q So sitting here today, you don't**
21 **know whether the other drugs listed in**
22 **Attachment B-2 are taken orally or given by**
23 **injection?**
24 A I believe at least some of them are
25 given by injection. I'm not sure sitting

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1 here whether all of them are. That may be
2 true.
3 **Q Can you identify which of the drugs**
4 **listed in Attachment B-2 you believe are**
5 **administered by injection?**
6 A The only one that comes to mind
7 where I have seen confirmation that it's
8 given by injection is Herceptin.
9 **Q In the preparation of your**
10 **declaration in Attachment B-2, did you**
11 **consider the different modes of**
12 **administration for these drugs?**
13 A It is one thing I thought about,
14 yes.
15 **Q In Attachment B-2, you have**
16 **compared Zytiga to non-prostate cancer and**
17 **non-oral drugs; is that correct?**
18 A It is true, as we've been
19 discussing, that some or all of these drugs
20 are non-prostate cancer or non-oral.
21 **Q Can you identify any of the drugs**
22 **listed in Attachment B-2, other than Zytiga,**
23 **that are indicated for the treatment of**
24 **prostate cancer?**
25 A I can't name any sitting here.

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