

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERIGEN PHARMACEUTICALS LIMITED and
ARGENTUM PHARMACEUTICALS LLC,
Petitioner,

v.

JANSSEN ONCOLOGY, INC.,
Patent Owner.

Case IPR2016-00286¹
Patent 8,822,438 B2

Before LORA M. GREEN, RAMA G. ELLURU, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

¹ Case IPR2016-01317 has been joined with this proceeding.

Upon authorization, Patent Owner moves to file three exhibits, Exhibits 2033–2035, that were “mistakenly omitted from Patent Owner’s October 4, 2016 filing” of its Patent Owner Response. Paper 49 (“Mot.”), 1. The Board authorized limited briefing on the issue of whether to grant Patent Owner’s request for “authorization to correct a clerical error and file Exhibits 2033, 2034, and 2035, which were inadvertently omitted from Patent Owner’s October 4, 2016 filing.” Paper 48. Petitioner filed an opposition. Paper 51 (“Opp.”).

Patent Owner argues that these exhibits were introduced and marked Exhibits 2033, 2034, and 2035, and provided to Petitioner’s counsel, during the September 1, 2016 deposition of Petitioner’s declarant Dr. DeForest McDuff. *Id.* Patent Owner represents that Patent Owner’s declarant, Dr. Christopher A. Vellturo, expressly relied on Exhibits 2033–2035 in preparing his declaration, and discussed an Appendix using the Exhibits in the body of his declaration. *Id.* Dr. Vellturo’s first declaration was submitted with the Response on October 4, 2016; a corrected declaration was submitted on October 12, 2016. Ex. 2044. On October 18, 2016, upon notification by Petitioner that Exhibits 2033–2035 were missing, Patent Owner served copies of those Exhibits on Petitioner the same day. Ex. 2121. Patent Owner argues that “(1) Patent Owner’s mistake was inadvertent and clerical, (2) Petitioners will not be prejudiced, and (3) it is in the public interest to maintain a complete and understandable file history for public notice purposes.” Mot. 2.

Petitioner argues that it would be prejudiced by Patent Owner’s late filing of Exhibits 2033–2035 because Petitioners have little leeway to obtain additional time to submit their Reply. Opp. 1. Petitioner acknowledges that Patent Owner’s counsel contacted Petitioner’s counsel on October 7, 2016,

requesting permission to correct calculations in certain Appendices to the Vellturo Declaration (Ex. 2044), but neither original nor replacement version of the Vellturo Declaration describes what Exhibits 2033–2035 are. *Id.* at 2. Petitioner separately wrote to Patent Owner’s counsel advising that these exhibits were missing. *Id.* Petitioner represents that Patent Owner’s counsel attached the exhibits in an email to Petitioner’s counsel two weeks after the Patent Owner’s Response was filed. *Id.* at 3.

Patent Owner’s explanation acknowledges that an error was made, and states that steps have been taken to address the error. The error notwithstanding, Petitioner was given copies of the exhibits during the deposition of Dr. McDuff on September 1, 2016. Patent Owner failed to file the Exhibits with its Response, but referenced them in the Appendices to the Vellturo Declaration. Thus, at an absolute minimum, Petitioner had copies of the Exhibits at issue, and was on notice that Patent Owner intended to rely on these Exhibits at the filing of the Response. The totality of the evidence before us persuades us that Petitioner would not be prejudiced if Exhibits 2033–2035 are placed in the record. We determine that allowing Exhibits 2033–2035 to be filed would be in the interests of justice and in the interests of having a complete record. 37 C.F.R. § 42.5(a), (c)(3).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner may file Exhibits 2033–2035.

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