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1 UNITED STATES PATENT AND TRADEMARK OFFICE
 2 BEFORE THE PATENT TRIAL AND APPEAL BOARD
 3
 4 PRAXAIR DISTRIBUTION, INC.
 5 Petitioner
 6 v.
 7 INO THERAPEUTICS, LLC,
 8 Patent Owner
 9 Case IPR2015-00529
 10 U.S. Patent No. 8,846,112 B2
 11
 12 The deposition of GEOFFREY L. ROSENTHAL,
 13 M.D., Ph.D., was held on Tuesday, January 5, 2016,
 14 commencing at 9:30 a.m., at the Law Offices of Latham
 15 and Watkins, 555 Eleventh Street, N.W., Suite 1000,
 16 Washington, D.C. 20004, before Steven Poulakos, RPR,
 17 Notary Public.
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 19
 20
 21
 22
 23
 24
 25 REPORTED BY: Steven Poulakos, RPR

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1 APPEARANCES:
 2
 3 ON BEHALF OF PRAXAIR DISTRIBUTION, INC.
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 12 ON BEHALF OF INO PHARMACEUTICALS, LLC:
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 23
 24 ALSO PRESENT: Kenneth D. Goetz, Esquire. In-house
 25 counsel for Mallinckrodt Pharmaceuticals

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 3 January 5, 2016
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1 PROCEEDINGS
 2 ---
 3
 4 Whereupon,
 5 GEOFFREY L. ROSENTHAL, M.D., Ph.D.,
 6 called as a witness, having been first duly sworn to
 7 tell the truth, the whole truth, and nothing but the
 8 truth, was examined and testified as follows:
 9 MS. KERRANE: Sara Kerrane on behalf of
 10 Petitioners, Praxair Distribution, Inc.
 11 MR. SCHULER: Ken Schuler from Latham &
 12 Watkins, on behalf of the witness and the respondent.
 13 MR. ZUBICK: Marc Zubick, also with Latham
 14 & Watkins, on behalf of the witness and respondent.
 15 MR. GOETZ: Ken Goetz on behalf of
 16 Mallinckrodt.
 17 EXAMINATION BY MS. KERRANE
 18 Q Good morning, Dr. Rosenthal.
 19 A Good morning.
 20 Q Could you please state your full name for
 21 the record?
 22 A My name is Jeffrey Lynn Rosenthal.
 23 Q Could you please state your address for the
 24 record?
 25 A 1024 Rustling Oaks Drive, Millersville,

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1 **Maryland.**
2 Q Thank you.
3 Have you ever been deposed before,
4 Dr Rosenthal?
5 A **I have been deposed previously.**
6 Q And what circumstances was that?
7 A **I was deposed in a case related to a**
8 **hostile work environment charge.**
9 Q Okay. And other than that incident, have
10 you ever been deposed?
11 A **That's the only deposition that I've had.**
12 Q Have you ever testified at trial?
13 A **I have testified at trial once previously.**
14 Q Okay. And what were the circumstances for
15 that?
16 A **I was an expert witness. I was the**
17 **treating physician in a sexual assault case.**
18 Q And what aspects of medicine were you -- if
19 you can, what aspects of medicine were you providing
20 expert testimony on?
21 A **I was asked to review the medical**
22 **documentation from an emergency room visit for the**
23 **subject, for the patient, and testify as to my physical**
24 **exam findings.**
25 Q And other than those two experiences, have

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1 you ever been asked to provide live testimony in any
2 circumstances?
3 A **I have not.**
4 Q I'm going to go over a few ground rules
5 with you, which you may already be familiar with.
6 First, obviously, I'm going to be asking
7 you a series of questions. If you could please wait
8 until my question is done before you provide the
9 answer. Also, if you could please make sure your
10 answers are all verbal answers so the court reporter is
11 able to write them down. If there's any questions that
12 you don't understand, please let me know so that I can
13 make sure to rephrase them for you and so that we can
14 make sure that the answers you're providing are
15 truthful answers and accurate.
16 If you need a break at any time, please let
17 me know, and we can do that, but I ask that you first
18 answer any pending questions that may be presented
19 before you request a break.
20 Do you have any questions?
21 A **I don't. I understand what you've just**
22 **said.**
23 Q Great.
24 And, also, do you understand that on any of
25 the breaks, if you discuss any subject matter that

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1 is -- pertains to this particular deposition, I can ask
2 you about it and you would have to answer it?
3 A **Yes, I understand that. I've been**
4 **instructed by counsel to not speak about any matters**
5 **that are being discussed today during any of the**
6 **breaks.**
7 Q Okay. Great.
8 Is there any reason that you can't testify
9 today?
10 A **No.**
11 Q And is there any medications or anything
12 that you take now that would affect your testimony?
13 A **No.**
14 Q Now, have you ever provided a report or a
15 declaration in any legal proceeding before this one?
16 A **No.**
17 Q Okay. And have you ever been a consultant
18 or an expert witness, other than the one that you just
19 mentioned, in the medical case, for any legal
20 proceeding?
21 **MR. SCHULER:** Let me just say, I don't
22 represent you in any of those other matters, but to the
23 extent that you have confidentiality agreements with
24 any third party, I just remind you to think about
25 those.

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1 **THE WITNESS:** Thank you.
2 I have provided expert review in medical
3 malpractice cases infrequently in my time.
4 **BY MS. KERRANE:**
5 Q Okay. And have those been in conjunction
6 with attorneys?
7 A **I've worked with -- I've been asked to**
8 **provide expert review by attorneys representing one**
9 **side or the other.**
10 Q And have you ever been involved in a patent
11 dispute?
12 A **No, I have not.**
13 Q Have you ever been paid to evaluate or
14 opine on a patent before?
15 A **Before the '112 patent?**
16 Q Before any patents relating to this
17 proceeding.
18 A **No.**
19 Q Okay. Before this proceeding, had you ever
20 read a patent?
21 A **I'm sorry, your question?**
22 Q Before this proceeding, had you ever read a
23 patent before?
24 A **Yes, I had.**
25 Q And in what circumstances did you read a

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1 patent?

2 **A I have read a number of patents previously,**

3 **related to invention interests of people in my family**

4 **and some related to colleagues at work.**

5 Q Are you a named inventor on any patents?

6 **A I am not.**

7 Q When were you first retained for this

8 matter?

9 **A I was first retained perhaps 11, 10 or 11**

10 **months ago.**

11 Q Okay.

12 **A By the law firm Fitzpatrick.**

13 Q And do you recall who contacted you?

14 **MR. SCHULER:** And let me counsel you that

15 whenever you're answering questions about contact with

16 attorneys for carrying a --

17 (Reporter clarifies.)

18 **MR. SCHULER:** You can identify the person,

19 et cetera, but don't divulge the contents of any

20 communications.

21 **THE WITNESS:** Okay. So the person who I

22 spoke most frequently with was Melinda Roberts.

23 **BY MS. KERRANE:**

24 Q Okay. And do you understand why you're

25 here today?

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1 **A Yes, I do.**

2 Q I see in front of you, you have what looks

3 like a copy of your declaration that you provided in

4 this case; is that correct?

5 **A Yes, that's correct.**

6 Q And is that something that you just walked

7 in with?

8 **A Yes, I just walked in with it.**

9 Q Do you have any notations on that?

10 **A I have no notations on this document.**

11 Q But I see that you've folded some pages

12 over.

13 **A I folded pages over that correspond to the**

14 **major headings in the table of contents.**

15 Q Kind of as a road map for yourself?

16 **A Well, just to -- so I'm not fumbling**

17 **around.**

18 Q What did you do to prepare for this

19 deposition?

20 **MR. SCHULER:** And, again, you can describe

21 actions you took, but don't divulge the contents or

22 communications with anyone.

23 **THE WITNESS:** I reviewed information

24 related to the patent, and I discussed elements of the

25 declaration with counsel.

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1 **BY MS. KERRANE:**

2 Q How many days did you meet with your

3 counsel?

4 **A I don't know the exact number of days that**

5 **I met with counsel. A handful of times, perhaps.**

6 Q All in preparation for this deposition?

7 **A In one way or another, yes, all in**

8 **preparation for the deposition.**

9 Q What attorneys did you meet with?

10 **A I primarily met with Marc Zubick.**

11 Q And how long would you say you spent

12 preparing for this deposition?

13 **A Roughly 200 hours, perhaps, in terms -- if**

14 **we include review of documents and other information**

15 **that's relevant to the declaration.**

16 Q Does that include the time you spent

17 preparing the declaration?

18 **A Yes, it does.**

19 Q And how long did you spend specifically

20 after submitting the declaration and preparing for just

21 the deposition?

22 **A I'm not sure exactly. Maybe half that**

23 **time. So maybe a hundred hours.**

24 Q Did you discuss the deposition with anyone

25 other than your attorneys?

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1 **A No, I've not.**

2 Q Did you review any documents while

3 preparing for your deposition?

4 **A Yes, I did.**

5 Q Other than your report, do you recall what

6 documents you reviewed?

7 **MR. SCHULER:** Object to the form.

8 You mean his declaration?

9 **MS. KERRANE:** I'm sorry, declaration.

10 **THE WITNESS:** I believe -- the answer to

11 your question is, yes, I have reviewed other documents

12 in addition to the declaration, and those things that

13 I've reviewed appear in paragraph 16 in my declaration.

14 **BY MS. KERRANE:**

15 Q Let's look at that paragraph real quick.

16 **MR. SCHULER:** You're just going to use

17 Exhibit 2020.

18 **MS. KERRANE:** They're the same exhibits,

19 yes.

20 **BY MS. KERRANE:**

21 Q Exhibit 2020 is your declaration, correct?

22 **A Yes, that's the label on the bottom right**

23 **corner of the document.**

24 Q And I believe you referred to paragraph 16

25 in your report; is that correct?

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1 **A** **Yes, that's correct.**
2 **Q** So in this paragraph, I see that you
3 mention that you've reviewed the claims of the '112
4 patent, file history, prior art exhibits that were part
5 of the petition, documents cited by Dr. Beghetti.
6 Is there anything else?
7 **MR. SCHULER:** Objection. The document
8 speaks for itself.
9 **THE WITNESS:** I believe that paragraph 16
10 correctly describes the documents that I reviewed.
11 **BY MS. KERRANE:**
12 **Q** Did you review Dr. Beghetti's declaration?
13 **A** **Yes, I did.**
14 **Q** Okay. And did you review the petition for
15 inter partes review for the '112 patent?
16 **A** **Yes, I did.**
17 **Q** Did you review either patent owner's
18 preliminary response or its response in this
19 proceeding?
20 **MR. SCHULER:** Object to form.
21 **THE WITNESS:** Can you help me by
22 distinguishing between the either/ors? I did review
23 the -- I did review the PTAB decision institute, IPR.
24 Is that what you were asking?
25 **BY MS. KERRANE:**

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1 **Q** No, but that was my next question.
2 So you did review the decision to
3 institute, correct?
4 **A** **Correct.**
5 **Q** And the patent owner, which would be INO
6 Therapeutics, also submitted two documents.
7 Did you review either of those two
8 documents?
9 **A** **It's not clear to me which documents you're**
10 **referring.**
11 **Q** Did you review any documents submitted by
12 patent owner in this proceeding?
13 **A** **I have, yes.**
14 **Q** And do you recall when you did that?
15 **A** **It would have been in early November.**
16 **Q** And do you know if you have seen a final
17 version of that document as it was filed with the PTAB?
18 **MR. SCHULER:** Object to the form.
19 **THE WITNESS:** Again, the document to which
20 you are referring is which?
21 **BY MS. KERRANE:**
22 **Q** You mentioned that you looked at a document
23 in early November; is that correct.
24 **A** **Yes.**
25 **Q** And is that a document that was being

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1 prepared at the time you were preparing your
2 declaration?
3 **A** **Yes, it was.**
4 **MR. SCHULER:** Object to the form.
5 Just make sure to give me time to object.
6 **THE WITNESS:** Okay.
7 **BY MS. KERRANE:**
8 **Q** And my question to you is: Do you know if
9 you have seen a final version of that document as it
10 was filed with the PTAB?
11 **A** **I believe that the version that I saw was a**
12 **final version, yes.**
13 **Q** I see in paragraph 17, you mention that you
14 are being compensated for this proceeding; is that
15 correct?
16 **A** **That is correct.**
17 **Q** And do you own any shares in Ikaria?
18 **A** **I do not.**
19 **Q** In Mallinckrodt?
20 **A** **I do not.**
21 **Q** Or INO Therapeutics?
22 **A** **Again, I do not.**
23 **Q** Does your payment in this matter depend, in
24 any way, on the results of the proceeding?
25 **A** **No, it does not.**

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1 **Q** Prior to being retained in this matter, did
2 you have any relationship with Ikaria?
3 **A** **No.**
4 **Q** Okay. Were you using products from Ikaria?
5 **A** **Yes. I have used inhaled nitric oxide in**
6 **my clinical practice.**
7 **Q** Has Ikaria ever provided you with grants?
8 **A** **It has not.**
9 **Q** Has Ikaria ever hired you or asked you to
10 speak at any function?
11 **MR. SCHULER:** Object to the form.
12 **THE WITNESS:** It has not.
13 **BY MS. KERRANE:**
14 **Q** Prior to this litigation, did you have any
15 relationship with INO Therapeutics?
16 **A** **I have not, no.**
17 **Q** And prior to this proceeding, did you have
18 any relationships with Mallinckrodt Pharmaceuticals?
19 **A** **I have not.**
20 **Q** Have you ever been involved in any studies
21 that were sponsored by Ikaria, INO Therapeutics, or
22 Mallinckrodt?
23 **MR. SCHULER:** Object to the form.
24 **THE WITNESS:** Could you be more specific
25 about what you mean by having been involved?

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1 **BY MS. KERRANE:**
2 Q Okay. What does that mean to you?
3 A Well, the reason I asked the question is
4 because I'm not -- there are a number of different
5 possible meanings for that, and I'm trying to
6 understand your question.
7 Q Okay. Have you been -- have you
8 participated in any studies sponsored by Ikaria, INO
9 Therapeutics, or Mallinckrodt?
10 **MR. SCHULER:** Object to the form.
11 **THE WITNESS:** May I ask you a question?
12 **BY MS. KERRANE:**
13 Q Sure.
14 A Are you asking whether I've ever been a
15 principal investigator for such a study, or are you
16 asking some other question?
17 Q I'm not limiting it to principal
18 investigator, but a principal investigator or otherwise
19 participated in one of those -- such a study.
20 A So some of the studies that have taken
21 place in clinical context have involved patients who
22 have been in my care. So I guess to the extent that
23 I've been involved in the care of patients who have
24 been involved in studies, I've had involvement in the
25 studies. But I've not specifically had involvement as

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1 a principal investigator in the study.
2 Q Okay. At any time since being retained in
3 this matter, have you reviewed any information relating
4 to any other proceedings involving Praxair or Praxair
5 distribution?
6 A No, I have not.
7 Q Since submitting your declaration, have you
8 reviewed any materials that have not -- that are not
9 listed in your report?
10 **MR. SCHULER:** Object to the form.
11 **THE WITNESS:** I don't believe so. I
12 believe all of the materials that I've reviewed would
13 fall under the description in paragraph 16.
14 **BY MS. KERRANE:**
15 Q And this declaration includes all of your
16 opinions in this matter; is that correct?
17 A That is correct.
18 Q And as you sit here today, you have no
19 different or new opinion, other than what you have
20 stated in this declaration, correct?
21 **MR. SCHULER:** Object to the form.
22 **THE WITNESS:** No, I have no additional
23 opinions, and these remain my opinions.
24 **BY MS. KERRANE:**
25 Q Have you reviewed any publications other

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1 than those listed in paragraph 16, or referred to in
2 paragraph 16?
3 **MR. SCHULER:** Object to the form.
4 **THE WITNESS:** Can you be more specific in
5 terms of your question, because the reason I'm asking
6 is I review a lot of publications in my role as a
7 physician. I think specifically, you must be asking
8 about a certain type of publication.
9 Can you help me understand --
10 **BY MS. KERRANE:**
11 Q Sure.
12 A -- your question?
13 Q Have you reviewed any publications that
14 relate to the subject matter at issue in this
15 investigation or this inter partes review that are not
16 referred to in paragraph 16?
17 **MR. SCHULER:** Can I have that one back.
18 (Whereupon the following portion of the testimony was
19 repeated by the Court Reporter:
20 "QUESTION: Have you reviewed any
21 publications that relate to the subject matter at issue
22 in this investigation or this inter partes review that
23 are not referred to in paragraph 16?")
24 **MR. SCHULER:** I'll object to the form.
25 **THE WITNESS:** I don't think so.

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1 **BY MS. KERRANE:**
2 Q If you can take a look at paragraph 1 of
3 your report.
4 **MS. KERRANE:** Excuse me, your declaration.
5 **MR. SCHULER:** That's all right. I was just
6 going to say, could we -- you understand that if she
7 says "report," she actually means your declaration?
8 **THE WITNESS:** Yes.
9 **MR. SCHULER:** Then I won't object anymore.
10 **BY MS. KERRANE:**
11 Q And if you could, take a look at the last
12 sentence in there.
13 **MR. SCHULER:** And the reason she does that
14 is that most of the time, an expert gives a report in
15 litigation. And this time, it's your written
16 testimony.
17 **THE WITNESS:** The last sentence in
18 paragraph 1, you're directing me to?
19 **BY MS. KERRANE:**
20 Q That's correct.
21 A (Witness reviewing document.)
22 Okay.
23 Q And my question to you is: What do you
24 mean by the term "neonate"?
25 A What I meant by the term "neonate" is an

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