

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

\* \* \* \* \*

MYLAN PHARMACEUTICALS INC., ET AL. :  
 PETITIONERS :  
 v. :  
 JANSSEN ONCOLOGY, INC, :  
 PATENT OWNER :  
 Case No. IPR2016-01332 :  
 U.S. Patent No. 8,822,438 :

\* \* \* \* \*

AUDIO VISUAL DEPOSITION OF MARC B. GARNICK, M.D.,  
 a witness called on behalf of the Patent Owner,  
 pursuant to the provisions of the U.S. Patent and  
 Trademark Office, and applicable Rules of Civil  
 Procedure, before Lisa McDonald Valdario, (CSR  
 #130093), a Registered Professional Reporter,  
 Certified Realtime Reporter, and Notary Public in and  
 for the Commonwealth of Massachusetts, held at the  
 Eliot Hotel, 370 Commonwealth Avenue, Boston,  
 Massachusetts 02115, on Monday, April 24, 2017,  
 commencing at 9:33 a.m.

Veritext Legal Solutions  
 Mid-Atlantic Region  
 1250 Eye Street NW - Suite 350  
 Washington, D.C. 20005

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1 APPEARANCES:  
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 20  
 21 ALSO PRESENT: Christopher Coughlin, videographer  
 22  
 23  
 24  
 25

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1 I N D E X  
 2 WITNESS DIRECT CROSS REDIRECT RECROSS  
 3 MARC B. GARNICK, M.D.  
 4 BY MS. DONOVAN 5  
 5  
 6  
 7 E X H I B I T S  
 8 No. Description Page  
 9 EXHIBIT JSN 2160 Notice of Taking Deposition 4  
 10 EXHIBIT JSN 2161 Clinicaltrials.gov Study 75  
 11 re: COU-AA-003  
 12 EXHIBIT JSN 2162 Clinicaltrials.gov Study 75  
 13 re: COU-AA-004  
 14 EXHIBIT JSN 2163 NEJM article, 9/24/87 106  
 15 EXHIBIT JSN 2164 Dr. Garnick's '017 patent 136  
 16  
 17  
 18 \*\*\*PREVIOUSLY MARKED EXHIBITS THAT WERE REFERENCED IN THE  
 19 DEPOSITION -- 1104, 1091, 1096, 1117, 1107, 1065, 1002,  
 20 1003, 1004, 2015, 2014  
 21  
 22  
 23  
 24  
 25

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1 P R O C E E D I N G S  
 2 (Document marked Exhibit JSN 2160 for  
 3 identification.)  
 4 VIDEO OPERATOR: We are now on the record.  
 5 My name is Chris Coughlin and I'm the videographer  
 6 for Veritext. Today's date is April 24, 2017 and  
 7 the time is 9:33 a.m. This video deposition is  
 8 being held in Boston, Massachusetts in the matter  
 9 of Mylan Pharmaceuticals Inc. et al versus Janssen  
 10 Oncology Inc., Patent Owner, in reference to  
 11 Patent Number 8,822,438 B2.  
 12 The deponent is Dr. Marc B. Garnick. Will  
 13 counsel please identify yourselves for the record  
 14 and state who you represent.  
 15 MS. DONOVAN: Bindu Donovan on behalf of  
 16 Patent Owner, Janssen Oncology, and with me is  
 17 Alyssa Monsen, and we are both from Sidley Austin,  
 18 LLP.  
 19 MR. BEEL: Bryan Beel from Perkins Coie on  
 20 behalf of Petitioner, Mylan Pharmaceuticals.  
 21 VIDEO OPERATOR: The court reporter is Lisa  
 22 M. Valdario and she will now swear in the witness.  
 23 MARC B. GARNICK, M.D.  
 24 A witness called for examination, having been  
 25 duly sworn, testified as follows:

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1 D I R E C T E X A M I N A T I O N  
 2 BY MS. DONOVAN:  
 3 Q Morning, Dr. Garnick.  
 4 A Good morning.  
 5 Q Could you please state your full name and home  
 6 address for the record.  
 7 A Marc Bennett Garnick, G A R N I C K, 289  
 8 Marlborough Street, Boston, Massachusetts 02116.  
 9 Q And you've had your deposition taken before today,  
 10 correct?  
 11 A Yes, I have.  
 12 Q And in fact, you were previously deposed in this  
 13 proceeding in February of this year, is that  
 14 right?  
 15 A I believe so. I can't remember the specific date.  
 16 Q Okay. Well, just for background, you're generally  
 17 familiar with the deposition procedure, sir?  
 18 A Yes, I am.  
 19 Q I'd just like to remind you of a couple of items.  
 20 I am going to be asking you questions. If  
 21 there is a question you don't understand, then  
 22 please ask me to repeat it, or let me know if  
 23 there is something you don't understand and I will  
 24 clarify it. If you answer a question, I'm going  
 25 to assume that you have heard and understood the

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1 question. Is that okay?

2 A Yes.

3 Q Okay. And just as a reminder, we have a court  
4 reporter who is transcribing your answers, and I'd  
5 request that you answer your questions orally. Do  
6 you understand that, sir?

7 A Yes, I do.

8 Q And we'll take a break every hour. If you need a  
9 break, please do request one, and the only thing I  
10 request is that we -- you finish answering a  
11 question and then we will take a break. Okay?

12 A Yes.

13 Q Okay. Is there any reason why you can't give  
14 complete and accurate testimony today, sir?

15 A Not to my knowledge.

16 Q What did you do to prepare for your deposition  
17 today?

18 A I've done an enormous amount of things in  
19 preparation for the deposition. Specifically, I  
20 reviewed the response that Dr. Rettig provided,  
21 basically going through his declaration and the  
22 Exhibits that he provided. I formulated almost a  
23 point by point response to his response to my  
24 initial declaration and portions of my deposition.  
25 I reviewed information that I was aware of to help

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1 support and buttress my opinions, and I met with  
2 counsel from Perkins Coie.

3 Q Okay.

4 A As well as preparing my declaration.

5 Q And in terms of your meetings with counsel from  
6 Perkins Coie, when did you meet with them in  
7 preparation for your deposition today?

8 A Well, I met on numerous occasions, either  
9 telephonically and yesterday in person. But  
10 telephonically, basically we've had meetings  
11 really since I received Dr. Rettig's declaration  
12 in response to my initial declaration and  
13 deposition.

14 Q How many telephonic meetings have you had since  
15 you received Dr. Rettig's declaration?

16 MR. BEEL: I'm going to object just for a  
17 moment and just counsel Dr. Garnick not to reveal  
18 the content of our communications. Go ahead.

19 A TNTC, too numerous to count.

20 Q Well, I would love an estimate, sir.

21 A I can't give you an exact estimate, but I could  
22 provide that information.

23 Q You can't give me an estimate right now?

24 A Well, if you give me the date -- I could give  
25 that, I could give that a very reasonable estimate

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1 if I knew the exact date that I received Dr.  
2 Rettig's declaration.

3 Q Okay.

4 So Dr. Rettig's -- the patent owner response  
5 and Dr. Rettig's declaration was submitted on  
6 March 8 of this year, so if you can tell me, sir,  
7 about how many telephonic meetings you had with  
8 Perkins Coie from March 8 to the present in  
9 preparation for your deposition.

10 A Well, assuming that I received Dr. Rettig's  
11 declaration probably sometime within that week or  
12 10 days thereafter, a guesstimate, I would say, so  
13 that would essentially be about five weeks. I  
14 would say we had telephonic conversations at least  
15 twice per week, and in the last week, almost  
16 daily.

17 Q Okay. And in the last week when you spoke almost  
18 daily, about how long did your conversations last?

19 A Well, on one day, essentially, I set aside the  
20 entire day as there were -- as I was finalizing my  
21 declaration.

22 Q Okay.

23 A So there were stops and starts. So it was  
24 essentially a full day with stops and starts.

25 Q And other meetings?

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1 A They could be several minutes to an hour.

2 Q And you said you -- did you say you met with  
3 counsel yesterday?

4 A Yes, I did.

5 Q How long did you meet with counsel for yesterday?

6 A All day. All day.

7 Q And who did you meet with?

8 A I met with the young gentleman sitting to my  
9 right, Attorney Beel.

10 MR. BEEL: You left out handsome. But go  
11 ahead.

12 A And Brandon White, Attorney Brandon White.

13 Q Other than counsel, did you meet with anyone else  
14 in preparation for your deposition today?

15 A I don't understand the question.

16 Q Did you have any in-person meeting with anyone  
17 else other than counsel in preparation for your  
18 deposition today?

19 A When you refer to counsel, you mean Attorney Beel  
20 and White?

21 Q I mean a lawyer.

22 A Did I have an in-person meeting with another  
23 lawyer from Perkins Coie?

24 Q No, with someone other than an attorney.

25 A About this matter?

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1 Q That's correct?  
2 A No, I haven't.  
3 Q Okay.  
4 A In person.  
5 Q Let's start with in person.  
6 A Okay.  
7 Q Did you have any meetings with anyone other than  
8 an attorney in preparation for your deposition  
9 today?  
10 A No.  
11 Q Did you speak -- well, did you have any -- strike  
12 that.  
13 Did you have any meeting with anyone other  
14 than counsel in any other form in preparation for  
15 your deposition today?  
16 A I don't understand what you mean of counsel. Does  
17 that mean any attorney within Perkins Coie? Does  
18 that mean any attorney outside of Perkins Coie?  
19 Q You know, it's not a difficult question.  
20 A Well, I find it -- I'm sorry, I find you --  
21 Q Let's do it again.  
22 A All right. Fine.  
23 Q All right. I'm asking whether you had any  
24 meetings with individuals who were not lawyers  
25 that were also not in person in preparation for

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1 your deposition today.  
2 A Well, it's a difficult question for me because  
3 there were certain telephone conversations in  
4 which other people were on the telephone call, and  
5 I do not know if they were or were not attorneys.  
6 Q Okay. Let me ask you this, did you -- are you  
7 aware Mylan has submitted declarations from  
8 someone named Dr. Ian McKeague in this?  
9 A Yes, I am aware.  
10 Q Did you have any discussions with Dr. McKeague in  
11 the context of preparing your declaration?  
12 A No, I did not.  
13 Q And in preparation for your deposition today, did  
14 you have any discussions with Dr. McKeague?  
15 A No, I did not.  
16 Q And are you aware Mylan has also submitted a  
17 declaration from Doctor John Bantle in this  
18 matter?  
19 A Yes, I am.  
20 Q Did you have any discussions with Dr. Bantle in  
21 the course of preparing your declaration for this  
22 matter?  
23 A No, I did not.  
24 Q And in the context of preparing for your  
25 deposition, did you have any conversations with

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1 Dr. Bantle?  
2 A No, I did not.  
3 Q And are you aware Mylan has submitted a  
4 declaration from Doctor Ivan Hofmann in this case?  
5 A Yes, I am.  
6 Q In preparing your declaration, did you have any  
7 discussions with Dr. Hofmann?  
8 A No, I did not.  
9 Q During the course of this matter, have you had any  
10 discussions with Dr. Hofmann?  
11 A No, I have not.  
12 Q And in preparation -- that includes in preparation  
13 for your deposition today, is that right?  
14 A That is correct.  
15 Q Okay. Have you spoken in the course of preparing  
16 your reply declaration or -- strike that.  
17 In the course of your work on this matter,  
18 have you spoken to anyone at Mylan?  
19 A Not to my knowledge.  
20 Q Dr. Garnick, I've placed in front of you an  
21 Exhibit that we had the court reporter mark  
22 earlier for your convenience. It's JSN 2160. It  
23 is the Patent Owner's Notice of Deposition of Marc  
24 B. Garnick M.D. Do you see that, sir?  
25 A Yes, I do.

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1 Q Have you seen this document before today, sir?  
2 A No, I have not.  
3 Q Do you understand that you are testifying in this  
4 matter pursuant to the Notice of Deposition that I  
5 have -- that has been marked as JSN 2160?  
6 A Well, I knew I was being deposed for this  
7 deposition and I assumed there was a document to  
8 state such, but I had not seen this document prior  
9 to today.  
10 Q Okay. All right. Let me hand you a document  
11 that's been marked as Mylan Exhibit 1104. Have  
12 you seen Mylan Exhibit 1104 before today, sir?  
13 A Yes, I have.  
14 Q Could you tell me, please, what Mylan Exhibit 1104  
15 is?  
16 A It's my declaration in support of Mylan and  
17 essentially a response to Dr. Rettig's  
18 declaration.  
19 Q And if you could please turn to page 69 of Mylan  
20 Exhibit 1104, sir.  
21 A Okay, yeah. Yes.  
22 Q Is that your signature that appears on page 69,  
23 sir?  
24 A Yes, it is.  
25 Q Okay. Does Mylan Exhibit 1104 contain an accurate

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1 statement of the reply opinions that you've  
2 reached in this case?  
3 A Yes, it does.  
4 Q Do you have any corrections that you wish to make  
5 to your declaration?  
6 A There were one or two typos.  
7 Q Do you wish to correct them at this time?  
8 A No, they were insignificant.  
9 Q Did you write your -- you see the title, sir, it  
10 says: Reply Declaration of Marc Garnick M.D. In  
11 Support of Petition for Inter Partes Review of  
12 U.S. Patent Number 8,822,438?  
13 A Yes, I do.  
14 Q If I refer to this as your reply declaration, will  
15 you understand I'm referring to Exhibit 1104?  
16 A Yes.  
17 Q Did you write your reply declaration yourself,  
18 sir?  
19 A Yes, I did.  
20 Q Did you write the first draft or did a lawyer  
21 write the first draft?  
22 A It was a combination.  
23 Q Okay. What do you mean by combination?  
24 A Well, as you look at my declaration, there is a  
25 whole series of conventions that provide the

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1 citations and the legal way of which I assume a  
2 patent declaration is provided. I did not  
3 provide -- I did not write those areas.  
4 Q I see.  
5 A But the content is mine.  
6 Q Did you prepare a first draft of the declaration?  
7 A I prepared multiple, multiple components of the  
8 first draft.  
9 Q And about how many drafts did you go through?  
10 A Well, there was constant editing of the corpus of  
11 the declaration. I would not consider a, you  
12 know, an alteration in one of the paragraphs as a  
13 new draft. So it was essentially two drafts.  
14 Q Okay.  
15 A But with multiple edits in each of those drafts.  
16 Q Okay. If you could look at page 70 of your reply  
17 declaration, sir. Page 70 is titled: Exhibit A,  
18 correct?  
19 A Yes.  
20 Q Okay. And Exhibit A continues through page 83 of  
21 Exhibit 1104, correct?  
22 A Through 84 you said?  
23 Q I said 83.  
24 A 83, yes.  
25 Q Exhibit A lists the materials you considered in

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1 providing your opinions in your reply declaration,  
2 is that correct?  
3 A Yes, it is.  
4 Q And are there documents that you have considered  
5 in the context of preparing your reply declaration  
6 that are not listed in Exhibit A?  
7 A Yes.  
8 Q What are those?  
9 A There was -- there were several chapters that I  
10 wrote for Scientific American Medicine in the  
11 1980s that we are still looking for source  
12 identification of those chapters.  
13 Q What do you mean by "looking for source  
14 identification of those chapters"?  
15 A Scientific American Medicine basically provided a  
16 textbook of medicine in a notebook format, and  
17 every probably 10 to 12 weeks there was an update  
18 of previous chapters in which you would take from  
19 the binder the chapter and discard that, and put  
20 the new chapter in. And so it's been difficult to  
21 get all of the versions of the things that I wrote  
22 for Scientific American Medicine in the 1980s.  
23 Q I see. Do you have versions of what you wrote in  
24 the 1980s in your possession?  
25 A I may or may not. I just don't know. It may be

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1 stored away in some boxes someplace.  
2 Q So did you review those Scientific American  
3 notebook format submissions in preparing for your  
4 reply declaration?  
5 A I could not review the specific chapters, but I  
6 cite information that was provided in those  
7 chapters in one of the citations here.  
8 Q Okay. Could you find for me please what you're  
9 referring to, where you've cited it in your  
10 declaration?  
11 A Yeah, sure. It's Paulson. And there's one other  
12 thing I need to answer your question with as well.  
13 Q Is that paragraph 23, sir?  
14 A Do you want me to look at the citation portion or  
15 the text?  
16 Q You mentioned Paulson, and paragraph 23 listed  
17 Paulson.  
18 A Yeah, I was just trying to find what the Exhibit  
19 number is.  
20 Q There is 1105. Is that what you're referring to?  
21 A 1105. Wait a second. Yes, correct, 1105.  
22 Q I see, just to be clear, 1105 is marked as an  
23 Exhibit in this matter.  
24 A Yes.  
25 Q So in the -- when you said you have considered

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