

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**MYLAN PHARMACEUTICALS INC.,**  
Petitioner

v.

**JANSSEN ONCOLOGY, INC.,**  
Patent Owner

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*Inter Partes* Review No. IPR2016-01332

U.S. Patent No. 8,822,438

**REPLY IN SUPPORT OF MYLAN'S MOTION FOR JOINDER  
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**

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The Board should institute Mylan's IPR2016-01332, challenging the patentability of U.S. Patent No. 8,822,438 ("438 patent"), and join it to the trial instituted in *Amerigen Pharms. Ltd. v. Janssen Oncology, Inc.*, IPR2016-00286.

Mylan's petition, which is not time-barred, establishes the unpatentability of the '438 patent, on the same grounds as the Amerigen petition and for the same reasons. Boiled down, Janssen's complaint is its need to take the deposition of one expert, Dr. Marc Garnick,<sup>1</sup> an internationally-renowned expert in medical oncology and urologic cancer at Beth Israel Deaconess Medical Center and a professor at Harvard Medical School, who has dedicated his career to developing new therapies for the treatment of prostate cancer.

Dr. Garnick's testimony as an unquestionable authority in the field of prostate cancer is valuable in resolving the unpatentability of the '438 patent. Mylan offered every reasonable arrangement to Janssen to join these petitions in an efficient manner.<sup>2</sup> Yet Janssen refused these offers, apparently favoring two trials

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<sup>1</sup> The Declaration of Scott Serels supports Amerigen's petition. Dr. Serels is surely highly qualified, but he is not Mylan's expert and, as of this filing, Amerigen has not agreed that Mylan can retain Dr. Serels. Thus, Mylan would not today be in a position to compel Dr. Serels to appear for cross examination.

<sup>2</sup> Mylan agreed that it would not seek additional briefing or additional pages in any briefing, that it would work with Amerigen to speak with one voice in any [cont.]

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