

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WOCKHARDT BIO AG,  
Petitioner,

v.

JANSSEN ONCOLOGY, INC.,  
Patent Owner.

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Case IPR2016-01582  
Patent 8,822,438 B2

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

KALAN, *Administrative Patent Judge*.

ORDER

Authorizing Reply and Surreply to Patent Owner Preliminary Response  
*37 C.F.R. § 42.108(c)*

On November 22, 2016, Wockhardt Bio AG (“Petitioner”) sent an electronic message to the Board to seek authorization to file a reply to Patent Owner’s Preliminary Response, and to file a motion to exclude. A telephone conference was held on November 29, 2016, among Judges Kalan, Green, and Elluru, counsel for Petitioner, and counsel for Janssen Oncology, Inc. (“Patent Owner”).

*Reply*

Patent Owner’s Preliminary Response included arguments that Petitioner failed to identify all real parties-in-interest. Paper 12, 7–15. The Preliminary Response was supported by a Declaration by Ms. Jennifer Reda, Assistant General Counsel at Johnson & Johnson (Ex. 2004), and an e-mail chain submitted by Patent Owner (Ex. 2005). During the conference call, Petitioner sought authorization to file a short reply brief to address the real party-in-interest issue raised by Patent Owner in its Preliminary Response. Petitioner also requested the opportunity to depose Ms. Reda. Petitioner requested permission to file a declaration or declarations in support of its reply, and indicated it would make its declarant(s) available for deposition.

Patent Owner indicated that it did not oppose Petitioner’s request for a reply, so long as Patent Owner would be permitted to file a surreply. Patent Owner opposed Petitioner’s request to depose Ms. Reda. Patent Owner requested the opportunity to take a deposition of Petitioner’s declarant if the declarant’s testimony goes beyond the scope of the present record.

“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§42.23 and 42.24(c). Any such request must make a showing of good cause.” 37 C.F.R. § 42.108(c). The question of whether Petitioner has identified all real parties-in-interest is a threshold

issue we must address in our decision on institution. *See* 35 U.S.C. § 312(a)(2) (we may consider a petition for *inter partes* review “only if . . . the petition identifies all real parties in interest”); 37 C.F.R. § 42.8 (requiring Petitioner and Patent Owner to “[i]dentify each real party-in-interest for the party”). After considering the arguments and issues before us, we determine that good cause exists in these circumstances. We grant Petitioner’s request to file a reply and Patent Owner’s request to file a surreply, subject to the details set forth in the order below. No depositions are authorized at this time.

*Motion to Exclude*

During the conference call, Petitioner also requested authorization to file a motion to exclude Exhibits 2004 and 2005 as inadmissible under FRE 408, arguing that those exhibits reflect confidential settlement discussions. Patent Owner opposed, arguing that noncompliance in identifying real parties-in-interest is not an issue of patentability.

Rule 42.64(b)(1) states “[a]ny objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial.” “A motion to exclude evidence must be filed to preserve any objection.” 37 C.F.R. § 42.64(c). Thus, the party relying on the evidence to which an objection is timely served has the opportunity to correct by serving supplemental evidence within ten days of the service of the objection. 37 C.F.R. 42.64(b)(1), (b)(2). The time for filing a motion to exclude is typically several months into a trial. *See, e.g.,* 77 Fed. Reg. 157 at 48,768, App. A.

Petitioner’s request to file a Motion to Exclude is premature, as no trial has been instituted in this matter. To the extent that Petitioner urges the

Board to consider the evidentiary issues as part of our determination to institute a trial, Petitioner's request does not provide us with a reason to deviate from the rules governing *inter partes* review. If we institute trial, Petitioner will have an opportunity to object, consider any supplemental evidence, and file a motion to exclude evidence. Petitioner may, in its reply, present arguments as to why these Exhibits should not be part of the record. Patent Owner may, in its surreply, respond to Petitioner's arguments on this issue. At this stage in the proceeding, however, we deny Petitioner's request to file a Motion to Exclude.

#### ORDER

In view of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that Petitioner's reply is limited to (a) responding to Patent Owner's arguments regarding the issue of the identification of real parties-in-interest as set forth in Patent Owner's Preliminary Response, and (b) arguments as to why Exhibits 2004 and 2005 should not be part of the record;

FURTHER ORDERED that Petitioner's reply is limited to a maximum of seven pages;

FURTHER ORDERED that Petitioner may file two declarations of no more than five pages each, directed solely to the real party-in-interest issue raised in Patent Owner's Preliminary Response;

FURTHER ORDERED that if Petitioner chooses to file a reply, it shall file any such reply by no later than seven business days from the date of this Order;

FURTHER ORDERED that Patent Owner's request for authorization to file a surreply responding to Petitioner's reply is *granted*;

FURTHER ORDERED that Patent Owner's surreply is limited to responding to the arguments Petitioner raises in its reply;

FURTHER ORDERED that Patent Owner's surreply is limited to a maximum of five pages;

FURTHER ORDERED that Patent Owner may file one rebuttal declaration of no more than five pages, directed solely to the arguments raised in Petitioner's reply; and

FURTHER ORDERED that if Patent Owner chooses to file a surreply, Patent Owner shall file said surreply by no later than seven business days from the date of filing of Petitioner's reply.

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