Paper No. ___
Date Filed: Dec. 22, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOCKHARDT BIO AG,

Petitioner

v.

JANSSEN ONCOLOGY, INC.,

Patent Owner.

CASE IPR2016-01582

Patent 8,822,438

JANSSEN ONCOLOGY INC.'S SURREPLY TO PATENT OWNER PRELIMINARY RESPONSE

Wockhardt's reply fails to acknowledge – much less address – the discussions between Patent Owner's counsel, Ms. Reda, and Wockhardt's V.P. of Global IP, Dr. Dhanorkar, that demonstrate that Wockhardt and Amerigen are jointly controlling their IPR filings for their mutual benefit. Wockhardt does not dispute that Dr. Dhanorkar touted Wockhardt's [redacted] Instead, Wockhardt relies on the declaration of a different person from a different Wockhardt company in New Jersey – Wockhardt USA's V.P. of Business Development, Mr. Venkatesan. But his conclusory and irrelevant statements fail to refute Janssen's showing. Moreover, there is no indication of what (if any) investigation Mr. Venkatesan undertook, or whether he even bothered to talk with Dr. Dhanorkar or anyone at Amerigen.

Wockhardt also attempts to evade the admissions of Dr. Dhanorkar by attempting to invoke Fed. R. Evid. 408, even though that rule does not apply to the RPI issue present here.

Wockhardt bears the burden of justifying its omission of Amerigen as an RPI, but has not done so. Given the undisputed statements of Dr. Dhanorkar,

Wockhardt should not be allowed to avoid identifying Amerigen as an RPI. To do so would create a loophole for others to exploit, thereby encouraging the very behavior the RPI requirements were intended to deter – harassment and "second bites."

I. Wockhardt Does Not Credibly Contradict its Own Statements Demonstrating that Amerigen Is an RPI

At this preliminary stage, the "petitioner bears the burden of showing compliance with the threshold requirement of § 315(b)." *Johnson Health Tech Co. Ltd. v. Icon Health & Fitness, Inc.*, IPR2014-01242, Paper 16 at 4 (Feb. 11, 2015). But Wockhardt has not done so. Instead, Wockhardt counters with a host of largely irrelevant and unsupported allegations about formal corporate relationships and the supposed absence of "financial dealings" or contracts between itself and Amerigen. But this ignores the fact that "control" with respect to the RPI inquiry need not be "overt." Instead, "control" can be established by circumstantial evidence. *See* Patent Owner Prelim. Response (Paper 13) at 9.

Here the ***undisputed*** evidence demonstrates that Wockhardt and Amerigen are more than just "codefendants" (Reply to Prelim. Response (Paper 22) at 1) in a patent lawsuit. Dr. Dhanorkar's own statements indicate that Wockhardt and Amerigen [redacted] Ex. 2003 (Reda Dec.) at ¶¶ 3-10. [redacted]

[redacted], Amerigen clearly exercised control over the present proceeding. Whether the relationship between Amerigen and Wockhardt was formalized in a written agreement is irrelevant.

Indeed, the declaration of Wockhardt USA's[1] Mr. Venkatesan raises more questions than it answers. It fails to explain the nature of Wockhardt's [redacted], or why Dr. Dhanorkar [redacted] if there were no relationship between the parties with respect to this IPR. Mr. Venkatesan's declaration also fails to explain what sort of investigation he conducted before signing the declaration, and whether he even spoke to Dr. Dhanorkar. And noticeably absent from Wockhardt's submission is any declaration from Dr. Dhanorkar himself.

Dr. Dhanorkar's e-mails and communications with Patent Owner's counsel are clear on their face and show that Amerigen is an RPI that should have been identified in this proceeding. Mr. Venkatesan's declaration fails to refer to these communications or even acknowledge them. The declaration should therefore be accorded no weight.

II. Wockhardt's Attempts to Evade the Impact of its Statements to the Patent Owner Are Unavailing

None of Wockhardt's three excuses has any merit.

[1] http://www.healthnetworkcommunications.com/conference/affordable-medicines/speaker-gopalakrishnan-VENKATESAN.stm.

First, Wockhardt's reliance on Fed. R. Evid. 408 is misguided. (Paper 22 at 6). As previously pointed out (Paper 13 at 5, n. 4), Patent Owner is not offering the communications "to prove or disprove the validity or amount of a disputed claim," as proscribed by Rule 408. Nor are the communications being offered for purposes of impeachment of the testimony of Dr. Dhanorkar or anyone else. Instead, the sole purpose here is to demonstrate Wockhardt's noncompliance with the RPI requirement. Rule 408 simply does not apply. *See Amneal Pharms. LLC v. Jazz Pharms., Inc.*, IPR2015-00545, Paper 38 at 5-6 (Sept. 18, 2015).

Second, Wockhardt argues that the communications between Dr. Dhanorkar and Ms. Reda do not demonstrate that Amerigen and Wockhardt "funded" each other's IPRs. (Paper 22 at 6). But this is irrelevant. Financing an IPR is not the same as controlling one. Evidence of financing is not a requirement for determining that an unidentified party is an RPI. *See Paramount Home Entertainment Inc. v. Nissim Corp.*, IPR2014-00961, Paper 11 at 7-11 (Dec. 29, 2014). Likewise, the argument that Amerigen and Wockhardt are "separate corporate entities" is irrelevant. The RPI inquiry does not turn on the "relationship between parties." *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13 at 11 (Feb. 20, 2015). What matters is control. Wockhardt's bald denial of control, supported only by Mr. Venkatesan's declaration, is simply not

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.