

Patent Owners' Response to Petitioner's Motion for Joinder

Filed on behalf of Patent Owners Genentech, Inc. and City of Hope by:

David L. Cavanaugh
Reg. No. 36,476
Owen K. Allen
Reg. No. 71,118
Heather M. Petruzzi
Reg. No. 71,270
Robert J. Gunther, Jr.
Pro Hac Vice To be Filed
Wilmer Cutler Pickering
Hale and Dorr LLP
1875 Pennsylvania Ave., NW
Washington, DC 20006

Adam R. Brausa
Reg. No. 60,287
Daralyn J. Durie
Pro Hac Vice To Be Filed
Durie Tangri LLP
217 Leidesdorff Street
San Francisco, CA 94111

David I. Gindler
Pro Hac Vice To Be
Filed
Joseph M. Lipner
Pro Hac Vice To Be
Filed
Michael R. Fleming
Irell & Manella LLP
1800 Avenue of the
Stars, Suite 900
Los Angeles, CA
90067

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owners.

Case IPR2017-00047
Patent 6,331,415

**PATENT OWNERS' RESPONSE TO
PETITIONER'S MOTION FOR JOINDER**

On October 11, 2016, Petitioner Merck Sharpe & Dohme Corp. filed the instant petition—which raises the exact same art and arguments as the petition in recently-instituted IPR2016-00710—along with a motion seeking to join the instant petition to IPR2016-00710. Merck's instant petition lacks substantive merit for the same reasons that Patent Owners will detail in their Response to the same grounds asserted in IPR2016-00710, which is currently due in December 2016.

Nevertheless, Patent Owners do not object to Merck's motion to join the present petition to IPR2016-00710, provided that, as a condition to joinder, Merck should not be permitted to proceed with its already-pending petition in IPR2016-01373. Merck filed IPR2016-01373 over three months ago, challenging many of the same claims of U.S. Patent No. 6,331,415 (“the Cabilly ’415 patent”). If the present petition is joined with IPR2016-00710, the final written decision in that consolidated proceeding will estop Merck under 35 U.S.C. § 315(e)(1) on any ground presented in IPR2016-01373. Indeed, for that reason, the present motion for joinder supports denial of institution in IPR2016-01373, as Patent Owners explained in their Preliminary Response in that proceeding (IPR2016-01373, Paper 13 at 28-29).

Because the relief requested in Merck's motion may ultimately result in estoppel of Merck's grounds in IPR2016-01373, Patent Owners proposed to Merck that they would consent to joinder if, as a condition for joinder, Merck withdrew its

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previously-filed petition in IPR2016-01373. After considering Patent Owners' proposal, Merck stated that it would not withdraw its petition in IPR2016-01373, even if Patent Owners agreed to joinder here.

Given the statutory estoppel, Merck cannot actually pursue both the present petition and its petition in IPR2016-01373 to a final written decision. It would be a waste of party and agency resources to allow Merck to pursue two alternative petitions, given the estoppel issue noted above. Accordingly, Patent Owners do not object to Merck's motion to join its present petition to IPR2016-00710, provided that such joinder is conditioned on Merck not being permitted to proceed with its separate petition in IPR2016-01373.

Respectfully submitted,

Date: November 11, 2016

/David L. Cavanaugh/
David L. Cavanaugh
Registration No. 36,476

Counsel for Patent Owners

WILMER CUTLER PICKERING HALE AND DORR LLP
1875 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20006
TEL: 202-663-6000
FAX: 202-663-6363
EMAIL: david.cavanaugh@wilmerhale.com

CERTIFICATE OF SERVICE

I hereby certify that, on November 11, 2016, I caused a true and correct copy of the following materials:

- Patent Owners' Response to Petitioner's Motion for Joinder

to be served by electronic mail on the following attorneys of record:

Raymond N. Nimrod
Matthew A. Traupman
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Ave., 22nd Floor
New York, NY 10010
raynimrod@quinnemanuel.com
matthewtraupman@quinnemanuel.com

Katherine A. Helm
SIMPSON THACHER & BARTLETT LLP
425 Lexington Avenue
New York, NY 10017
khelm@stblaw.com

/Owen K. Allen/
Owen K. Allen
Reg. No. 71,118
Wilmer Cutler Pickering Hale and Dorr LLP
950 Page Mill Road
Palo Alto, CA 94304