Filed on behalf of Patent Owner Genentech, Inc. by:

David L. Cavanaugh (Reg. No. 36,476)
Lauren V. Blakely (Reg. No. 70,247)
Robert J. Gunther, Jr. (*Pro Hac Vice)*
Lisa J. Pirozzolo (*Pro Hac Vice*)
Kevin S. Prussia (*Pro Hac Vice*)
Andrew J. Danford (*Pro Hac Vice*)
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*)
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLTRION, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-01373
U.S. Patent No. 6,407,213

PATENT OWNER'S MOTION TO STRIKE
PURSUANT TO PAPER NO. 58

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I. INTRODUCTION

Pursuant to the Board's authorization in Paper No. 58, Patent Owner files this motion to strike evidence and argument pertaining to Petitioner's new obviousness theory that a new exhibit, Foote 1989 (Ex. 1193) discloses using a "consensus" sequence as described in the claims of the '213 patent. Patent Owner seeks to strike Exhibit 1193 and the associated arguments and testimony that rely on this exhibit, including the first full paragraph of pages 15 and 21 of the Reply, Ex. 1143 ¶30, and Ex. 1138 at 176:25 to 178:23.

Petitioner chose to file a copycat petition based on the petition filed by Mylan Pharmaceuticals, Inc. in IPR2016-01694 (the "Mylan IPR"). (*Compare* Paper 2 *with Mylan Pharms. Inc. v. Genentech, Inc.*, IPR2016-01694 (Paper 1).) In doing so, Petitioner's experts submitted nearly word-for-word copies of the analysis for the proposed grounds in the declarations from the Mylan IPR. (*See* Ex. 2062 (redline comparing Dr. Riechmann's declaration with Mylan's expert's declaration); Ex. 1004 at ¶4 (Dr. Leonard stating he repeated the statements of Mylan's expert and "revised only as necessary.").) Having made that strategic choice, Petitioner should not now be permitted to deviate from the arguments made in the Petition and shoehorn in a new reference to support its obviousness case and better suit its experts here.

Petitioner's new evidence and argument principally relies on Exhibit 1193 ("Foote 1989")—a publication titled "Humanized Antibodies" authored by Jefferson Foote, the petitioners' expert in the companion cases brought by Pfizer. As set forth in more detail below, Foote 1989 was submitted by Petitioner in reply to backdoor in a new ground for unpatentability and fill in the gaps in its *prima facie* case. Petitioner has no excuse for failing to identify Foote 1989 in the Petition because its own expert, Dr. Riechmann, now claims that Foote 1989 discloses a consensus sequence that Dr. Riechmann himself used in his own work.

II. PETITIONER'S EVOLVING INVALIDITY ARGUMENTS

A. The Petition Relies on Queen 1990 or Queen 1989 in Combination with Kabat 1987 for the "Consensus" Sequence Limitations of Claims 4, 33, 62, 64, and 69.

Claims 4, 33, 62, 64, and 69 require the use of a "consensus" sequence. The '213 patent provides a specific definition of the claimed human "consensus" sequence, "which comprises the most frequently occurring amino acid residues at each location in all human immunoglobulins of any particular subclass or subunit structure." (Ex. 1001, 11:32-38; Paper 16 at 10-11.) The Petition argued that the "consensus" limitation was met by either by Queen 1990's (Ex. 1050) disclosure of "a consensus framework from many human antibodies," or by Queen 1989's (Ex. 1034) supposed teaching "moving towards a consensus framework region" in combination with Kabat 1987 (Ex. 1052) and/or the PDB database. (Paper 2 at 36-

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