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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 6,407,213

PATENT OWNER'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION OF LUTZ RIECHMANN, PH.D.

Pursuant to the Joint Notice of Stipulation to Revise Schedule (Paper 57), Patent Owner Genentech, Inc. ("Patent Owner") submits the following observations on cross-examination of Lutz Riechmann, Ph.D. with respect to his testimony in support of Petitioner's reply (Paper 53). The complete transcript of this cross-examination is submitted herewith as Exhibit 2064.

1. In Exhibit 2064 at 30:9-18 and 31:19-32:7, Dr. Riechmann admitted that, when applying Queen 1989 (Ex. 1034) or Queen 1990 (Ex. 1050), it is possible to identify a combination of substitutions that does not fall into the '213 patent claims. This testimony is relevant to Petitioners' argument that a person of ordinary skill following the teachings of the asserted references would arrive at a humanized antibody with substitutions that are recited in the claims of the '213 patent with a reasonable expectation of success. (Paper 53, Petitioner Reply at 4-8, 13-14; Paper 2, Petition at 6-8, 16-19, 24-57; Ex. 1143, Riechmann Reply Decl. ¶¶6, 12; Ex. 1003, Riechmann Decl. ¶¶27-36, 114-126, 161-337.)

2. In Exhibit 2064 at 29:11-30:8 and 32:12-22, Dr. Riechmann admitted that none of the 15 substitutions disclosed in the anti-Tac antibody in Queen 1989 (Ex. 1034) are recited in the '213 patent claims and that Queen 1990 (Ex. 1050) and Queen 1989 (Ex. 1034) contain the same experimental example. This testimony is generally relevant to Petitioners' argument that a person of ordinary skill following the teachings of the asserted references would arrive at a humanized

antibody with substitutions that are recited in the claims of the '213 patent with a reasonable expectation of success and/or that the prior art teaches humanized antibodies with the recited substitutions that bind antigen. (Paper 53, Petitioner Reply at 4-8, 13-14; Paper 2, Petition at 6-8, 16-19, 24-57; Ex. 1143, Riechmann Reply Decl. ¶¶6, 12; Ex. 1003, Riechmann Decl. ¶¶27-36, 114-126, 161-337.)

3. In Exhibit 2064 at 38:3-10, Dr. Riechmann admitted that Chothia 1985 (Ex. 1063) does not describe a humanized antibody sequence and that the discussion of 93H in Chothia 1985 is not referring to a substitution in any particular humanized antibody. This testimony is generally relevant to Petitioners' argument that a person of ordinary skill following the teachings of the asserted references would arrive at a humanized antibody with substitutions that are recited in the claims of the '213 patent with a reasonable expectation of success and/or that the prior art teaches humanized antibodies with the recited substitutions that bind antigen. (Paper 53, Petitioner Reply at 4-9, 13-14.) In particular, this testimony is relevant to Dr. Riechmann's testimony in paragraph 25 of his Reply Declaration (Ex. 1143) in which he asserts that "The Prior Art Taught Substitutions at 71H, 73H, 78H, and 93H," "[t]o the extent that the patent identifies 71H, 73H, 78H, and 93H as back mutations . . . the prior art identifies these residues at those positions," and included Chothia 1985 (Ex. 1063) in a chart that "summarizes those substitutions" for residue 93H.

4. In Exhibit 2064 at 11:2-9, 38:14-39:11, 43:12-14 and 44:2-6, Dr. Riechmann testified that the chart in paragraph 25 of his Reply Declaration (Ex. 1143) should list Chothia & Lesk (Ex. 1062) for residue 78H (not Chothia 1985 (Ex. 1063)) and admitted that Chothia & Lesk does not discuss humanized antibodies or identify actual substitutions in any humanized antibody. This testimony is generally relevant to Petitioners' argument that a person of ordinary skill following the teachings of the asserted references would arrive at a humanized antibody with substitutions that are recited in the claims of the '213 patent with a reasonable expectation of success and/or that the prior art teaches humanized antibodies with the recited substitutions that bind antigen. (Paper 53, Petitioner Reply at 4-9, 13-14.) In particular, this testimony is relevant to Dr. Riechmann's testimony in paragraph 25 of his Reply Declaration (Ex. 1143) in which he asserts that "The Prior Art Taught Substitutions at 71H, 73H, 78H, and 93H," "[t]o the extent that the patent identifies 71H, 73H, 78H, and 93H as back mutations . . . the prior art identifies these residues at those positions."

5. In Exhibit 2064 at 50:3-14, 50:20-51:11, 52:1-4, and 66:8-12, Dr. Riechmann admitted that the only humanized antibody in Kurrle (Ex. 1071) with a substitution at 71H and 73H is CIV-4 and that Kurrle does not have any binding data for CIV-4. This testimony is generally relevant to Petitioners' argument that the "up to 3-fold more" binding affinity limitation of claim 65 would have been

obvious. (Paper 53, Petitioner Reply at 15-16.) In particular, this testimony is relevant to Dr. Riechmann's testimony in paragraphs 21-22 of his Reply Declaration (Ex. 1143) in which he states that "a person of ordinary skill in the art would have a reasonable expectation that BMA-EUCIV4 would bind an antigen to some degree."

6. In Exhibit 2064 at 56:19-57:5, Dr. Riechmann admitted that the Table on page 879 of Chothia 1989 (Ex. 1049) does not describe a humanized antibody. This testimony is generally relevant to Petitioners' argument that a person of ordinary skill following the teachings of the asserted references would arrive at a humanized antibody with substitutions that are recited in the claims of the '213 patent with a reasonable expectation of success and/or that the asserted references teach humanized antibodies with the recited substitutions that bind antigen. (Paper 53, Petitioner Reply at 4-9, 13-14.) In particular, this testimony is relevant to Dr. Riechmann's testimony in paragraph 25 of his Reply Declaration (Ex. 1143) in which he asserts that "The Prior Art Taught Substitutions at 71H, 73H, 78H, and 93H," "[t]o the extent that the patent identifies 71H, 73H, 78H, and 93H as back mutations . . . the prior art identifies these residues at those positions," and included Chothia 1989 (Ex. 1049) in a chart that "summarizes those substitutions" for residue 71H.

7. In Exhibit 2064 at 61:4-62:5, Dr. Riechmann admitted that in Jones

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