

Patent Owner's Opposition to Petitioners' Motion to Exclude

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER, INC. AND
SAMSUNG BIOEPIS CO., LTD.,
Petitioners,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-01488¹
U.S. Patent No. 6,407,213

**PATENT OWNER'S OPPOSITION TO
PETITIONERS' MOTION TO EXCLUDE EVIDENCE**

¹ Case IPR2017-02139 has been joined with this proceeding.

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1 Weinstein's Evidence Manual § 16.07 (2018)4

I. PETITIONERS' MOTION IS PROCEDURALLY IMPROPER.

The Board should reject Petitioners' motion to exclude as procedurally improper because it challenges the sufficiency of Patent Owner's evidence but fails to present an evidentiary basis to exclude it. *Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) ("A motion to exclude must explain why the evidence is not *admissible* ... but may not be used to challenge the sufficiency of the evidence to prove a particular fact."); 37 C.F.R. § 42.7(a) (the Board may expunge an improper filing); *see also Apple Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 40, at 36-37 (June 17, 2016).

Petitioners' challenge to Patent Owner's antedation evidence (Ex. 2001-2015) is particularly problematic in this regard. Petitioners focus on whether the inventors' antedation testimony is sufficiently corroborated. (Paper 67 at 1-3, 7-13.) Corroboration, however, is not a binary rule of evidence or an independent basis for excluding evidence. Rather, it is evaluated under a "rule of reason" analysis that examines all pertinent evidence to determine the *credibility* of an inventor's testimony. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1170 (Fed. Cir. 2006). Importantly, "the fact that a notebook entry' or other writing 'has not been promptly witnessed does not necessarily disqualify it in serving as corroboration of conception.'" *Apator Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1297 (Fed. Cir. 2018). Petitioners' corroboration arguments are thus

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