UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER, INC., and
SAMSUNG BIOEPIS CO., LTD.,[1]
Petitioners,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-01489
Patent 6,407,213

PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE PURSUANT TO PAPER NO. 57[2]

[1] Samsung Bioepis Co. Ltd.'s IPR2017-02140 has been joined with this proceeding. (IPR2017-02140, Paper 40.)

[2] All emphases within are added.

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Other Authorities

I. INTRODUCTION

PO asserts that Petitioners have changed the bases for their position that the prior art disclosed use of a "consensus" sequence. That is incorrect. Petitioners did not "pivot" to relying "for the first time in their Reply" on Foote 1989, Reichmann 1988, and Kurrle for this limitation. Much of the evidence PO seeks to exclude—including evidence that Riechmann's CAMPATH antibody was made using the "consensus" approach, and that Kurrle teaches use of a "consensus" sequence in its humanization method—was squarely raised in the Petition and/or supporting declaration of Dr. Foote. In fact, PO deposed Dr. Foote about it before filing its POR. The evidence and argument PO seeks to exclude also is legitimate reply, as it responds directly to the inaccurate description of the state of the art, and flawed secondary considerations arguments, PO and its expert presented in the Response. PO also waived its objection to the Foote and Wilson deposition testimony, and the Foote 1989 reference discussed therein. PO's counsel did not raise timely objections during the depositions as 37 C.F.R. § 42.64(a) requires.

II. FACTUAL BACKGROUND

Challenged claims 4, 33, 62, 64 and 69 of the '213 patent recite a "consensus" sequence element. Pet. at 13, 15. The Petition cited either Queen 1990, or Queen 1989 in view of Kabat 1987, as disclosing or rendering obvious the "consensus" sequence element in the recited invalidity grounds. Pet. at 31-38, 55-56, 60. The

Petition and supporting expert declaration ***also*** showed use of "consensus" sequences in humanizing antibodies was otherwise known. For example, the Petition cited Dr. Foote's testimony that the prior art CAMPATH antibody Riechmann 1988 described was made using "***a 'consensus' sequence***." Ex. 1503, ¶ 103 (cited Pet. at 8) (describing use of a consensus sequence "in which relatively uncommon residues in certain positions were substituted with more commonly found ones," where "[j]udgment of whether a residue type was common or uncommon at a particular position was based on the Kabat database, 1983 edition"). Dr. Foote also explained that, in Kurrle's method, when humanizing an antibody with a given human framework, one should "consider changing the chosen human framework residue ***with the consensus human residue at that position***." *Id.*, ¶ 123.

During Dr. Foote's deposition ***before PO submitted its Response***, PO's counsel questioned him extensively about both of these issues. Ex. 2039 at 77:18–88:23; 293:16–304:25. Dr. Foote explained without objection that Riechmann's CAMPATH "consensus" sequence was derived from his own "anti-lysozyme" construct described in Foote 1989. *Id.* at 79:12–80:7, 83:17–16. That reference was subsequently submitted as an exhibit and discussed on redirect, again without objection. *Id*. at 327-332. Indeed, PO's counsel questioned Dr. Foote on Foote 1989 during re-cross. *Id.* at 349:22–350:20. PO's counsel also questioned Dr. Foote regarding Kurrle's choice of a framework, and Dr. Foote testified (again without

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.