

Filed on behalf of Samsung Bioepis Co., Ltd.

Filed: November 27, 2017

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD., Petitioner,

v.

GENENTECH, INC., Patent Owner.

United States Patent No. 6,407,213

Case No.: IPR2017-02139

**PETITIONER'S REPLY TO PATENT OWNER'S
OPPOSITION TO MOTION FOR JOINDER WITH IPR2017-01488**

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.23, Petitioner Samsung Bioepis Co., Ltd. (“Bioepis” or “Petitioner”) submits this Reply to Patent Owner Genentech, Inc.’s (“Genentech” or “Patent Owner”) Opposition to Petitioner’s Motion for Joinder with pending IPR2017-01488 regarding U.S. Patent No. 6,407,213 (the “’213 patent”).

Pfizer Inc. (“Pfizer”) filed IPR2017-01488 and IPR2017-01489 on May 25, 2017, regarding the ‘213 patent. Genentech filed preliminary responses to the petitions on September 5, 2017. The Board has not yet issued its decision on whether to institute *inter partes* review based on Pfizer’s petitions.

On September 29, 2017, Bioepis filed IPR2017-02139 and IPR2017-02140 on the same grounds raised by Pfizer in IPR2017-01488 and IPR2017-01489, respectively, and concurrently moved for joinder. Pfizer did not file an opposition to the motion for joinder. However, Genentech filed an opposition on October 27, 2017, arguing that Bioepis must abide by certain conditions, allegedly to “ensure that [the IPR] runs efficiently, that any prejudice to Patent Owner is minimized, and that misunderstandings regarding Bioepis’s role are kept to a minimum.” (IPR2017-02139, Paper No. 7). In other words, Genentech did not oppose joinder *per se*. Rather, it seeks to limit Bioepis’s role in the proceeding for so long as the Pfizer IPR remains pending.

As explained in its motion for joinder, Bioepis has agreed to take a secondary role in the IPR and will coordinate with Pfizer for so long as Pfizer remains a party to the IPR. Accordingly, joinder will not impact trial or otherwise prejudice Genentech. To the contrary, joinder will promote efficiency and minimize the burden on Genentech and the Board, as compared to a distinct proceeding involving expert depositions and a separate oral hearing.

Genentech's proposed conditions for joinder are also unnecessary, and inappropriate, in light of Bioepis's proposed role in the proceedings. For example, Bioepis does not anticipate any additional filings and has already agreed that it will not rely on its own experts unless Pfizer's experts become unavailable. Joinder therefore should not have any impact on discovery deadlines or the oral hearing. Moreover, Genentech does not identify any specific "prejudice" or "misunderstandings" that could result absent implementation of its proposed conditions, and none are apparent. If anything, Genentech's proposed conditions would deter petitioners from seeking joinder in future proceedings, which in turn can be expected to reduce significantly the overall efficiency of proceedings before the Board.

For the foregoing reasons, Bioepis respectfully requests that the Board institute IPR2017-02139 on the same grounds as in IPR2017-01488, and that this proceeding be joined with IPR2017-01488.

Dated: November 27, 2017

Respectfully submitted,

/s/ Dimitrios T. Drivas

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Counsel to Petitioner

Samsung Bioepis Co., Ltd.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6 and 42.105, I hereby certify that on this 27th day of November, 2017, the foregoing Reply to Patent Owner's Opposition to Motion for Joinder with IPR2017-01488 was served via electronic mail to Lead and Backup Counsel in this IPR, and on Lead and Backup Counsel for Petitioner in IPR2017-01488 at the following E-mail addresses:

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Signed,

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