

From: [Greb, Emily J. \(Perkins Coie\)](#)
To: [Feldstein, Mark](#); [White, Brandon \(Perkins Coie\)](#); Tecfidera@perkinscoie.com
Cc: [Sommers, Erin](#); [DeRoo, Pier](#); [McCurdy, Barbara](#)
Subject: RE: Mylan v. Biogen, IPR2018-01403
Date: Monday, May 6, 2019 10:38:38 AM

EXTERNAL Email:

Mark,

I address each of your questions in turn. First, with respect to Biogen's request that Mylan seek a subpoena for Mr. Butler, given that Biogen is the party seeking to depose Mr. Butler, it is our view that Biogen should be the party responsible for seeking any subpoena to compel Mr. Butler to testify, not Mylan. Second, with respect to your request for Mylan's position on a motion to exclude, it is our understanding that Biogen is permitted, under the scheduling order, to file any motion to exclude of its choosing on Due Date 4. To the extent Biogen is seeking to file an additional or different motion to exclude, Mylan opposes such a request and moreover will not agree to withdraw his affidavit. Third, while Biogen's request below regarding a motion to compel is unclear, to the extent Biogen is seeking Mylan's position regarding a motion to compel a deposition of Mr. Butler, Mylan opposes that request as well. Affidavits from Mr. Butler have been routinely accepted by the Board in *inter partes* review proceedings without any testimony from Mr. Butler and Biogen has not explained any specific need for it in this case.

Regards,
Emily

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From: Feldstein, Mark <mark.feldstein@finnegan.com>
Sent: Wednesday, May 1, 2019 9:38 AM
To: White, Brandon (WDC) <BMWhite@perkinscoie.com>; *Tecfidera <Tecfidera@perkinscoie.com>; Greb, Emily J. (MSN) <EGreb@perkinscoie.com>
Cc: Sommers, Erin <Erin.Sommers@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>
Subject: RE: Mylan v. Biogen, IPR2018-01403

Counsel,

We are writing to follow up on issues discussed with Emily Greb at the April 26, 2019, Corboy deposition.

We had asked if Mylan would agree to seek a subpoena to compel Mr. Butler's testimony, as we

understand Mylan otherwise cannot make him available. We also asked, to the extent Mylan is not willing to seek a subpoena for Mr. Butler, whether Mylan would agree to withdraw his declaration or consent to Biogen filing a motion to exclude that declaration. Additionally, we would like Mylan's position on whether it would oppose Biogen filing a motion to compel and/or exclude in regard to Mr. Butler's declaration and cross-examination.

Please advise at your earliest convenience so that we may respond to the Board's April 23rd message and avoid any delays that could affect the schedule.

Regards,

Mark Feldstein
Attorney at Law

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From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, April 23, 2019 12:52 PM
To: White, Brandon (Perkins Coie) <BMWhite@perkinscoie.com>
Cc: Greb, Emily J. (Perkins Coie) <EGreb@perkinscoie.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>; Tecfidera@perkinscoie.com
Subject: RE: Mylan v. Biogen, IPR2018-01403

EXTERNAL Email:

Counsel:

To the extent Patent Owner seeks authorization to file a Motion for Authorization to Compel Testimony of Mr. Christopher Butler under 37 C.F.R. § 42.52(a), the panel requests that the parties confer on the matter and indicate whether Petitioner will oppose the motion.

To the extent Patent Owner seeks to address the proper weight the Board should give to the Christopher Butler Declaration (Ex. 1012), it may do so in its Patent Owner Response and/or Sur-Reply.

Striking evidence subject to routine discovery is an exceptional remedy that the Board expects will be granted rarely. Nonetheless, if Patent Owner seeks authorization to file a Motion to Strike Ex. 1012, the panel requests that the parties confer on the matter and indicate whether Petitioner will oppose the motion.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: White, Brandon (Perkins Coie) <BMWhite@perkinscoie.com>
Sent: Tuesday, April 23, 2019 7:43 AM
To: Trials <Trials@USPTO.GOV>
Cc: Greb, Emily J. (Perkins Coie) <EGreb@perkinscoie.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>; Tecfidera@perkinscoie.com
Subject: RE: Mylan v. Biogen, IPR2018-01403

Dear Board,

Counsel for Mylan is available except on Friday, April 26 to the extent a teleconference is required. We are also generally available next week.

Respectfully,

Brandon White
Counsel for Petitioner

Brandon White | Perkins Coie LLP

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From: McCurdy, Barbara <barbara.mccurdy@finnegan.com>
Sent: Monday, April 22, 2019 8:52 PM
To: Trials <Trials@USPTO.GOV>
Cc: White, Brandon (WDC) <BMWhite@perkinscoie.com>; Greb, Emily J. (MSN) <EGreb@perkinscoie.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>
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To the Honorable Board:

Patent Owner Biogen writes to renew its request to compel the cross-examination testimony of Mr. Christopher Butler, a declarant relied upon by petitioner Mylan in Exhibit 1012. Today, Mylan

represented to Biogen: "Mylan cannot make Mr. Butler available."

The Board authorized Patent Owner to renew this request during a conference call with the parties on April 12, 2019. See Biogen Ex. 2041, at 35-36 (Transcript of April 12, 2019, teleconference). Biogen wishes to discuss with the Board the process for compelling the cross-examination of Mr. Butler, striking his declaration, or according it no weight.

Biogen is generally available for a call with the Board this week, other than Wednesday afternoon. We have inquired of Mylan's availability and have not received a response.

Sincerely,

Barbara C. McCurdy
Reg. No. 32,120

Counsel for Patent Owner Biogen MA Inc.

Barbara Clarke McCurdy
Partner

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