



**CONTENTS**

	<b>Page</b>
<b>I. The 1998 Horwitz Agreement Is Not An Assignment.....</b>	<b>3</b>
A. The Language of the Horwitz Agreement Is Not an Assignment Under Controlling Federal Circuit Law.....	3
B. <i>IpVenture</i> Does Not “Call[] for Relying on Extrinsic Evidence of the Parties’ Intent” .....	5
C. The “Extrinsic Evidence” Does Not Prove There Was An Assignment .....	6
<b>II. Inventors Epstein, Monsell, Marsh, And Ozturk Assigned The ’083 Patent To A Group Of Related Companies.....</b>	<b>8</b>
A. The Plain Language of the Agreements Makes Clear that “COMPANY” Means What the Agreements Say “COMPANY Means”.....	8
1. The Definition of “COMPANY” Supports Defendants’ Interpretation.....	8
2. The Definition of “Affiliates” Supports Defendants’ Interpretation .....	10
3. The Confidentiality and Non-Compete Provisions Require a Broad Definition of “COMPANY” .....	11
B. Janssen, J&J, and Other J&J Companies Have Repeatedly Interpreted “COMPANY” to Mean More than Just the Employer .....	12
C. J&J’s Prior Positions Should Estop Janssen in This Case .....	15
D. Janssen’s No-Definition Definition of “COMPANY” Does Not Pass Muster .....	17
E. Janssen’s “Extrinsic Evidence” Cannot Be Used to Alter the Plain Words of the Contract.....	18
1. Janssen’s Declarations Are Entitled to No Weight.....	19
2. Janssen’s Remaining Extrinsic Evidence Cannot Be Used to Modify the Terms of the Employment Agreements .....	24
<b>III. Conclusion .....</b>	<b>28</b>

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Abbott Point of Care, Inc. v. Epocal, Inc.</i> , 666 F.3d 1299 (Fed. Cir. 2012).....	13, 26
<i>Abraxis Bioscience, Inc. v. Navinta LLC</i> , 625 F.3d 1359 (Fed. Cir. 2010).....	12
<i>Advanced Video Techs., LLC v. HTC Corp.</i> , 103 F. Supp. 3d 409 (S.D.N.Y. 2015), <i>aff'd</i> 2017 WL 745727 (Fed. Cir. Feb. 27, 2017) .....	13
<i>Alps S., LLC v. Ohio Willow Wood Co.</i> , 787 F.3d 1379 (Fed. Cir. 2015), <i>cert. denied</i> , 136 S. Ct. 897 (2016).....	35
<i>Arachnid v. Merit Indus., Inc.</i> , 939 F.2d 1574 (Fed. Cir. 1991).....	10, 11, 12, 14
<i>Assisted Living Assocs. of Moorestown, L.L.P. v. Moorestown Twp.</i> , 31 F. Supp. 2d 389 (D.N.J. 1998) .....	16, 31
<i>Bd. of Tr. of the Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.</i> , 583 F.3d 832 (Fed. Cir. 2009), <i>aff'd</i> , 131 S.Ct. 2188 (2011) .....	11, 12, 31
<i>Burkhart v. Washington Metro. Area Transit Auth.</i> , 112 F.3d 1207 (D.C. Cir. 1997).....	27
<i>City of Madison, Joint Sch. Dist. No. 8 v. Wisconsin Employment Relations Comm'n</i> , 429 U.S. 167 (1976).....	34
<i>In re Colonial Mortg. Bankers Corp.</i> , 324 F.3d 12 (1st Cir. 2003).....	23
<i>Columbia Data Prod., Inc. v. Autonomy Corp., Ltd.</i> , No. 11-12077, 2012 WL 6212898 (D. Mass. Dec. 12, 2012).....	27
<i>Contour Design, Inc. v. Chance Mold Steel Co.</i> , 794 F. Supp. 2d 315 (D.N.H. 2011).....	26
<i>Conway v. 287 Corporate Center Assocs.</i> , 901 A.2d 341 (N.J. 2006).....	25, 26
<i>DDB Techs., L.L.C. v. MLB Advanced Media, L.P.</i> , 517 F.3d 1284 (Fed. Cir. 2008).....	11, 12

*Dubrosky v. Colonial Life & Acc. Ins. Co.*,  
129 F. App’x 691 (3d Cir. 2005) .....16

*Dureiko v. United States*,  
209 F.3d 1345 (Fed. Cir. 2000).....13

*FilmTec Corp. v. Allied-Signal Inc.*,  
939 F.2d 1568 (Fed. Cir. 1991).....10, 11

*Fonar Corp. v. Johnson & Johnson*,  
No. 82-2751, 1985 WL 186693 (D. Mass. Aug. 20, 1985) .....27

*Freedom Wireless, Inc. v. Boston Commc’ns Grp., Inc.*,  
220 F. Supp. 2d 16 (D. Mass. 2002) .....9, 11

*Friedheim v. Walter H. Hildic Co.*,  
89 S.E. 358 (S.C. 1916) .....16

*Gabriel v. Jackson Nat. Life Ins. Co.*,  
No. 11-12307-MLW, 2015 WL 1410406 (D. Mass. Mar. 26, 2015), *appeal*  
*dismissed* (Aug. 24, 2015) .....34

*Gellman v. Telular Corp.*,  
449 F. App’x 941 (Fed. Cir. 2011) .....8, 9, 11, 14

*Guay v. Burack*,  
677 F.3d 10 (1st Cir. 2012).....23

*Hoffman-La Roche Inc. v. Teva Pharm. USA*,  
No. 09-5283, 2011 WL 6028583 (D.N.J. Dec. 2, 2011).....31

*Int’l Union, United Auto., Aerospace & Agr. Implement Workers of Am., U.A.W.*  
*v. Skinner Engine Co.*,  
188 F.3d 130 (3d Cir. 1999).....30

*IpVenture v. ProStar Computer, Inc.*,  
503 F.3d 1324 (Fed. Cir. 2007).....10, 12, 14

*Karp v. CIGNA Healthcare, Inc.*,  
882 F. Supp. 2d 199 (D. Mass. 2012) .....27

*In re Lernout & Hauspie Sec. Litig.*,  
222 F.R.D. 29 (D. Mass. 2004).....27

*Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*,  
692 F.3d 983 (9th Cir. 2012) .....23

<i>N. Light Tech. v. N. Lights Club</i> , 97 F. Supp. 2d 96 (D. Mass. 2000) .....	27
<i>New Hampshire v. Maine</i> , 532 U.S. 742 (2001).....	23
<i>Ortho Pharm. Corp. v. Genetics Inst., Inc.</i> , 52 F.3d 1026 (Fed. Cir. 1995).....	35
<i>Patriot Cinemas, Inc. v. Gen. Cinemas Corp.</i> , 834 F.2d 208 (1st Cir. 1987).....	23
<i>Perez v. Volvo Car Corp.</i> , 247 F.3d 303 (1st Cir. 2001).....	30
<i>Prima Tek II, L.L.C. v. A-Roo Co.</i> , 222 F.3d 1372 (Fed. Cir. 2000).....	35
<i>RFF Family P’ship, LP v. Ross</i> , 814 F.3d 520 (1st Cir. 2016).....	19, 22, 23
<i>Speedplay, Inc. v. Bebop, Inc.</i> , 211 F.3d 1245 (Fed. Cir. 2000).....	10, 11, 12
<i>State v. Prob. Ass’n of New Jersey</i> , No. A-5864-04T5, 2006 WL 1716129 (N.J. Super. Ct. App. Div. June 23, 2006) .....	26
<i>Thore v. Howe</i> , 466 F.3d 173 (1st Cir. 2006).....	22, 23
<i>Unleashed Doggie Day Care, LLC v. Petco Animal Supplies Stores, Inc.</i> , No. 10-10742, 2011 WL 6812642 (D. Mass. Dec. 28, 2011).....	30
<b>Rules</b>	
Fed. R. Civ. P. 30(b)(6).....	7, 15, 22
<b>Other Authorities</b>	
37 C.F.R. § 3.54 .....	31
CHISUM ON PATENTS, § 9200 (2017) .....	12

Janssen has shifted positions so much in order to avoid the plain meaning of its agreements that, at this point, its own positions cannot be squared even with one another. For example, Janssen criticizes Defendants for allegedly “[i]gnoring” the fact that the agreements are “ambiguous” (Dkt. 520 at 1), but then it immediately calls them “clear” and “leav[ing] no serious doubt” as to their meaning. *Id.* Then Janssen flip-flops yet again and asks the Court to look at well over 100 pages of purported “extrinsic evidence,” which would be unnecessary for an unambiguous agreement. As for the meaning “COMPANY” in the employee secrecy agreements when standing was initially challenged, Janssen argued that it “can only mean Centocor.” Dkt. 445 at 5. Then it advocated its “traveling” interpretation of the agreements, saying that “COMPANY” means “any company to which I become transferred,” allowing the agreement to “travel with the employee.” 2/8/17 Hr’g Tr. at 47. Subsequently, Janssen pressed for even more briefing on the standing issues, despite the six briefs the parties filed in January and December (Dkt. 414, 445, 460, 471, 481, 484, 486 at 1–2), and reworked its theory yet again. Now, Janssen’s Rule 30(b)(6) witness posits that the meaning of “COMPANY”

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *Id.* at 167:8–168:13; Dkt. 522-1 at 2, 4, 8, 12. Janssen’s positions have only

become more nonsensical with time.

The correct outcome regarding Dr. Horwitz’s 1998 agreement is straightforward. Under controlling Federal Circuit law, an agreement is a present assignment of patent rights only if the

words of the contract “expressly undertake the *assigning act* at the time of the agreement;” if they “leave [the assigning act] to some future date,” it is not a present assignment. *Gellman v. Telular Corp.*, 449 F. App’x 941, 944 (Fed. Cir. 2011). The 1998 Horwitz agreement did not assign the ’083 patent to Janssen because the agreement expressly states that Dr. Horwitz “*will ... assign*” his inventions to Janssen in the future. Janssen hangs its hat on the statement that Dr. Horwitz’s inventions “are” the property of Janssen, but numerous cases confirm that such language is not a present undertaking of the “assigning act.” No case supports Janssen’s view.

The correct outcome regarding the other ’083 patent inventors’ agreements is simple as well—the agreements expressly define the term “COMPANY” broadly and contrary to Janssen’s varying interpretations. Janssen proffers a host of purported “extrinsic evidence,” but the Court must disregard it because Janssen does not use it to shed light on the meaning of the agreements, but rather to change what they plainly say. Indeed, Defendants have now obtained numerous documents demonstrating that Janssen, J&J, and other J&J subsidiaries have advanced (including in litigation) the same interpretation of “COMPANY” that Defendants advocate here. For example, J&J subsidiaries, represented by the same counsel representing Janssen in this case, argued to a Massachusetts state court that “COMPANY” in an agreement just like the ones at issue here, means precisely what the agreements say: it “include[s] *not only* [the employer] *but also* ‘JOHNSON & JOHNSON and any of their successors or assigns, purchasers, acquirers, and any of their existing and future subsidiaries, divisions or affiliates.’” Dkt. 525-2 at 8 (emphasis added). Janssen may not use “extrinsic evidence” to argue for a different meaning of the very same language in this Court. This is particularly true given that Janssen’s “extrinsic evidence” consists of self-serving, *post hoc* attorney argument in declaration or “agreement” form, and is the result of selective waiver of privileged information. The Court should not permit Janssen to

treat its agreements like a piece of clay, molding them to suit Janssen's particular needs at the time.

## **I. The 1998 Horwitz Agreement Is Not An Assignment**

### **A. The Language of the Horwitz Agreement Is Not an Assignment Under Controlling Federal Circuit Law**

Janssen acknowledges there is a “well-established rule of Federal Circuit case law” governing whether an agreement is a present assignment. Dkt. 520 at 2–3. Specifically, the Federal Circuit “has consistently required that present assignments of future rights expressly undertake the *assigning act* at the time of the agreement, and not leave it to some future date.” *Gellman*, 449 F. App'x at 944. Thus, “[i]n order for a pre-invention assignment contract to create a present assignment of an expectant interest in an invention that automatically vests by operation of law into an actual assignment upon conception, the contract must contain *words of present conveyance* and must require ‘no further act once an invention comes into being.’” *Freedom Wireless, Inc. v. Boston Commc'ns Grp., Inc.*, 220 F. Supp. 2d 16, 19 (D. Mass. 2002).

But the 1998 Horwitz agreement uses the language, “I agree I ... *will assign*,” which leaves assignment to some future date. Dkt. 446-3 at JANREM0098777 (emphasis added). The situation is almost identical to *IpVenture, Inc. v. ProStar Computer, Inc.*, as explained in Defendants' opening brief. See Dkt. 508 at 5–6, Appx. A. In *IpVenture*, the Federal Circuit evaluated the “assignment” language in view of the *Arachnid*, *Film-Tec* and *Speedplay* cases. *IpVenture v. ProStar Computer, Inc.*, 503 F.3d 1324, 1326–27 (Fed. Cir. 2007). In *Arachnid*, the Federal Circuit found that the language “[a]ny inventions ... shall be the property of” *Arachnid* and “will be assigned” to *Arachnid* was a promise to assign in the future. *Arachnid v. Merit Indus., Inc.*, 939 F.2d 1574, 1576 (Fed. Cir. 1991). In the *Film-Tec* and *Speedplay* cases, on the other hand, the Federal Circuit had held that “does hereby grant” and “hereby ... assigns,”



respectively, effected a present assignment. *FilmTec Corp. v. Allied-Signal Inc.*, 939 F.2d 1568, 1573 (Fed. Cir. 1991); *Speedplay, Inc. v. Bebop, Inc.*, 211 F.3d 1245, 1253 (Fed. Cir. 2000).

In *IpVenture*, the agreement stated that inventions “are the sole property of HP” and that the inventor would “assign them” and “execute all documents” necessary to do so. *IpVenture*, 503 F.3d at 1326-7. The Federal Circuit concluded that

the agreement in this case tracks that of *Arachnid*, not that of *FilmTec*. The *FilmTec* usage “does hereby grant” is not present; nor is the *Speedplay* usage “hereby ... assigns.” Instead, the Hewlett-Packard agreement says “agree to assign.”

*IpVenture*, 503 F.3d at 1327. Thus, based on the language of the agreement and “[i]n accordance with *Arachnid*, 939 F.2d at 1579, Hewlett-Packard was not an assignee” when suit was filed. *Id.*

The instant case is analogous to *IpVenture* and *Arachnid*. As in *IpVenture*, the 1998 Horwitz agreement states that inventions “are the property of CENTOCOR” and that the employee “will ... assign to CENTOCOR” and “will ... execute all documents necessary” to do so. Dkt. 521-8 at JANREM0098777. The 1998 Horwitz agreement lacks any “does hereby grant” or “hereby assigns” language, like that found to be a present act of assignment in *FilmTec* or *Speedplay*. *FilmTec*, 939 F.2d at 1570; *Speedplay*, 211 F.3d at 1253; see also *Bd. of Tr. of the Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 583 F.3d 832, 841–42 (Fed. Cir. 2009), *aff’d*, 131 S.Ct. 2188 (2011) (“I will assign and **do hereby assign**”) (emphasis added); *DDB Techs., L.L.C. v. MLB Advanced Media, L.P.*, 517 F.3d 1284, 1290 (Fed. Cir. 2008) (“agrees to and **does hereby grant and assign**”) (emphasis added). Notably, Janssen has not cited a single case in which language like “are the property of” or “shall be the property of” was found to be an assignment.<sup>1</sup>

---

<sup>1</sup> Janssen nitpicks cases contrary to its position as “non-precedential” or as resting on “alternative grounds.” Dkt. 520 at 7–8. For example, Janssen asks the Court to distinguish between “inventions...shall be and remain the exclusive property” in *Gellman* and “inventions are the property” in the 1998 Horwitz agreement. *Id.* This is a

Lacking case law support, Janssen argues that there is “no linguistic explanation” for the words “INVENTIONS are the property of CENTOCOR” not equating to an assignment. Dkt. 520 at 2. That argument has no merit. Under the case law, these words establish *equitable* title to the inventions, *i.e.*, a right to obtain an assignment in the future. *See Gellman*, 449 F. App’x at 944 (“remain the property of” “indicates that ... inventions ‘remained’ in equitable status until such time as” assignments or other transfer documents necessary to vest title were executed). In fact, it is Janssen’s reading that leaves entire provisions of the agreement without explanation. If “INVENTIONS are the property of CENTOCOR” was a present act of assignment, the language “I will ... assign” and “I will ... execute all documents necessary to carry out the above” would be “surplusage without relevant meaning.” *Id.* A present assignment “must require ‘no further act once an invention comes into being.’” *Freedom Wireless*, 220 F. Supp. 2d at 19. Because the 1998 Horwitz agreement required at least three further acts once any invention came into being (“disclos[ing]” it, “assign[ing]” it, and “execut[ing] all documents necessary”), the 1998 Horwitz agreement was not a present assignment.

**B. *IpVenture* Does Not “Call[] for Relying on Extrinsic Evidence of the Parties’ Intent”**

Janssen argues that *IpVenture* requires consideration of extrinsic evidence. *See* Dkt. 520 at 5–7. That is incorrect. The question of “whether an assignment of patent rights in an agreement such as the one in this case is automatic, requiring no further act on the part of the assignee, or merely a promise to assign *depends on the contractual language.*” *DDB Techs.*, 517 F.3d at 1290 (Fed. Cir. 2008) (citing *Arachnid* and *Speedplay*); *accord* 16B-III CHISUM ON

---

distinction without a difference; neither form “expressly undertake[s] the assigning act at the time of the agreement” like the words “hereby assign” and “hereby grant.” *Gellman*, 449 F. App’x at 944. Janssen also claims that in *Freedom Wireless*, the employer “did not appear in the matter and took no position on the issue.” Dkt. 520 at 8. The parties in *Freedom Wireless* did take discovery from the employer relevant to the employment agreement (*see* Ex. 2 (offer of proof)), but the Court did not need extrinsic evidence to reach its conclusion based on the language of the agreement, consistent with *Arachnid*. *See Freedom Wireless*, 220 F. Supp. 2d at 19–20.

PATENTS, § 9200 (2017). *IpVenture*—decided before *DDB Technologies*—cannot and does not change that rule. Although in *IpVenture* the Court considered HP’s argument that it had never asserted ownership in the patent, the Court simply noted that this fact “support[ed]” the conclusion the Court had reached based on the language of the agreement itself, “in accordance with *Arachnid*.” *IpVenture*, 503 F.3d at 1327. Further, consistent with *DDB Technologies*, Federal Circuit cases citing *IpVenture* do not require consideration of extrinsic evidence and describe *IpVenture* simply as “interpreting ‘agree to assign’ as ‘an agreement to assign,’ requiring a subsequent written instrument.” *Roche Molecular Sys.*, 583 F.3d at 841; *see also Abraxis Bioscience, Inc. v. Navinta LLC*, 625 F.3d 1359, 1365 (Fed. Cir. 2010) (same). As this Court has correctly noted once already, the determination of whether or not Dr. Horwitz’s 1998 agreement was an assignment must be based on “the contractual language.” *DDB Techs.* 517 F.3d at 1290; 3/29/17 Hr’g Tr. at 5:1–4, 33:5–9.<sup>2</sup> No case Janssen cites “calls for” courts to turn to extrinsic evidence in these scenarios.

### C. The “Extrinsic Evidence” Does Not Prove There Was An Assignment

Even if it were to be considered (and it should not be), Janssen’s proffered extrinsic evidence would not change the clear meaning of the 1998 Horwitz agreement. Janssen argues that Dr. Horwitz’s February 6, 2017 statement that he “understood that any inventions [he] made in the course of my employment were the property of Centocor” means that there was already an assignment. Dkt. 520 at 5–6; Dkt. 521-8 at ¶ 3. This is incorrect. First, even assuming Dr. Horwitz did believe his 1998 employment agreement to have been an assignment, “believing does not make it so.” *Advanced Video Techs., LLC v. HTC Corp.*, 103 F. Supp. 3d 409, 424

---

<sup>2</sup> *Dureiko v. United States*, 209 F.3d 1345 (Fed. Cir. 2000) and *Abbott Point of Care, Inc. v. Epocal, Inc.*, 666 F.3d 1299 (Fed. Cir. 2012), cited by Janssen, are inapposite. *Dureiko* involved claims of breach of contract and Fifth Amendment violations and had nothing to do with patent assignment. 209 F.3d at 1347–50, 1356–57. *Abbott* did not involve a determination of future versus present assignment, applied state law, and moreover, found the agreement unambiguous and declined to give weight to extrinsic evidence. 666 F.3d at 1302–04.

(S.D.N.Y. 2015), *aff'd* 2017 WL 745727 (Fed. Cir. Feb. 27, 2017). “[I]ntentions that do not crystallize into acts recognized by law as sufficient to transfer title do not convey title.” *Id.* Second, as noted in Defendants’ opening brief, Janssen ignores that Dr. Horwitz states that he “understood that, based on the Employee Agreement, Centocor might ask [him] to sign additional documents relating to patents in the future” and that he “signed *such an assignment document* in 2015 relating specifically to the ’083 patent.” Dkt. 521-8 at ¶¶ 6–7 (emphasis added). This demonstrates that the “assignment document” to which Dr. Horwitz refers—which was executed in July 2015, after Janssen filed its first complaint against Defendants, and is “attached [to the declaration] as Exhibit C” (*id.*)—is the only assignment Dr. Horwitz executed.

Janssen’s further argument that Dr. Horwitz’s August 2015 “assignment” (not to be confused with the July 2015 assignment) supports its position fares no better.<sup>3</sup> *See* Dkt. 520 at 6. The August 2015 “assignment” posits that Dr. Horwitz “by virtue of, *inter alia*, [his] employment agreement, assigned his entire right, title, and interest in the invention described in” the ’083 patent. Dkt. 520 at 6. But for the reasons already stated, this document cannot change the actual legal effect of the 1998 Horwitz agreement under controlling Federal Circuit law. The only thing the July 2015 assignment and August 2015 “confirmatory assignment” demonstrate is that the 1998 Horwitz agreement was *not* an assignment.

Finally, neither Dr. Horwitz’s declaration nor his August 2015 “confirmatory assignment” are “disclaimer[s] of ownership” akin to the disclaimer by HP in *IpVenture*, as Janssen asserts. Dkt. 520 at 6. In *IpVenture*, the statement by HP, which was not a party to the litigation, was made “to honor” a pre-existing “verbal pre-employment agreement” that the “invention would not belong to HP.” Dkt. 521-1 at 4. The statements at issue here were not for

---

<sup>3</sup> Despite being responsive to Defendants’ discovery requests (Ex. 3 (excerpt from Req. for Prod.)), Janssen did not produce any of the six August 2015 “assignments” during fact discovery. Instead, Janssen first produced these documents with its opposition to Defendants’ motion to dismiss in March of this year.

the purpose of memorializing a prior oral agreement. They are *post hoc* statements arguing for Janssen’s interpretation of the 1998 Horwitz agreement, obtained almost two decades after execution of the agreement, in the midst of the parties’ dispute over ownership of the ’083 patent. Moreover, Dr. Horwitz did not “disclaim” rights in the ’083 patent or make any statement against his interest. Under the law, the 1998 Horwitz agreement conveyed equitable title to Dr. Horwitz’s interest in the ’083 patent and Dr. Horwitz had promised to execute necessary documents to convey legal title. *See Gellman*, 449 F. App’x at 944–45 (“[A]n equitable claim to title ... could be converted to legal title if and when Mr. Seivert actually assigns or, if necessary, through legal action.”); *Arachnid*, 939 F.2d at 1581.

## **II. Inventors Epstein, Monsell, Marsh, And Ozturk Assigned The ’083 Patent To A Group Of Related Companies**

Janssen asks the Court to interpret the definition of “COMPANY” in the employee secrecy agreements of named inventors Epstein, Monsell, Marsh, and Ozturk by reading the agreements “as a whole in a fair and common sense manner.” Dkt. 520 at 10. But the “fair” and “common sense” reading is based on the plain language, and is confirmed by Janssen and J&J companies’ *own* past interpretation of them: namely, that “COMPANY” means exactly what the agreements say “COMPANY means.” Dkt. 522-1.

### **A. The Plain Language of the Agreements Makes Clear that “COMPANY” Means What the Agreements Say “COMPANY Means”**

#### **1. The Definition of “COMPANY” Supports Defendants’ Interpretation**

Each of the relevant employment agreements has a definitions section, which includes a definition of “COMPANY.” Dkt. 522-1. In two of the agreements, this section is labeled “DEFINITIONS.” Dkt. 522-1 at JANREM0098796, -98813. All four agreements state:

*As used in this Agreement:*

the COMPANY means CENTOCOR *and* JOHNSON & JOHNSON *and* any of their successors or assigns, purchasers, acquirers, *and* any of their existing and future subsidiaries, divisions or affiliates, including any such subsidiary, division or affiliate of Johnson & Johnson to which I may be transferred or by which I may be employed in the future.

Dkt. 522-1 at JANREM0098796, JANREM0098813 (emphasis added). Thus, each agreement plainly states what “the COMPANY means” “[a]s used in this Agreement.” Not surprisingly, J&J employment law attorney Anne Martinson, who was Janssen and J&J’s Rule 30(b)(6) witness related to the interpretation of the employment agreements, admitted that she [REDACTED]

[REDACTED] Ex. 1  
(Martinson Dep. Tr.) at 173:8–24. [REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]

[REDACTED] *Id.* at 29:17–23, 79:16–80:7, 83:18–84:18, 171:19–23, 173:8–15.

Janssen criticizes Defendants for allegedly “focus[ing] their argument on a single sentence” of the secrecy agreements. Dkt. 520 at 10. This is senseless—that sentence defines the term “COMPANY.” Janssen, by contrast—at least according to the arguments advanced in its most recent brief—unabashedly rewrites the definition of “COMPANY” by arguing that it means “not all J&J companies, but one that might be selected in the future, namely, any J&J company ‘to which I may be transferred or by which I may be employed in the future.’” Dkt. 520 at 11. As Defendants showed in their opening brief, there is no support for Janssen’s reworking of the definition. *See* Dkt. 508 at 14–15. It violates the “elementary rule[] of construction” requiring that all of the words of a contract “must have some meaning.” *Friedheim v. Walter H. Hildic Co.*, 89 S.E. 358, 359 (S.C. 1916); *see also Dubrosky v. Colonial Life & Acc. Ins. Co.*, 129 F. App’x

691, 693 (3d Cir. 2005) (it is a “cardinal principle that each term of a contract should be given meaning so that no term is superfluous”).

Janssen’s argument also makes no sense because if the drafter wanted to convey that “COMPANY,” in the context of patent assignments, meant only the employer, or the employer plus someone else, he “could have easily done so in just those words, without resorting to the circumlocutions they now ask this Court to adopt.” *Assisted Living Assocs. of Moorestown, L.L.P. v. Moorestown Twp.*, 31 F. Supp. 2d 389, 400–01 (D.N.J. 1998). In fact, since the execution of the form employment agreements at issue, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

The agreements at issue, by contrast, do not work that way.

## **2. The Definition of “Affiliates” Supports Defendants’ Interpretation**

The definition of “affiliates” in the employment agreements also does not support Janssen’s interpretation. *First*, Janssen argues that Defendants’ interpretation of the “affiliates” clause is “incoherent” (Dkt. 520 at 12), but it is not. It creates three categories of “affiliates”—entities owned collectively 50% or more by multiple J&J subsidiaries, entities owned 50% or more by J&J, and entities owned 50% or more by any one J&J subsidiary. Dkt. 522-1. *Second*, Janssen argues that “by Defendants’ reading of the agreements, the same result would be accomplished by the word ‘COMPANY’ standing alone.” Dkt. 520 at 12. But Janssen’s interpretation would also result in some redundancy: if “Affiliates of [Centocor] are any corporation, entity or organization at least 50% owned [1] by [Centocor], [2] by Johnson & Johnson or [3] by any subsidiary of Johnson & Johnson,” as Janssen argues, the first clause is

subsumed within, and thus redundant of, the third, because Centocor is a subsidiary of J&J. *Third*, the purported impact of the definition of “[a]ffiliates,” according to Janssen, is belied by J&J companies’ prior interpretations of the same language. Janssen and J&J companies have previously interpreted “COMPANY” broadly, consistent with Defendants’ interpretation, even in agreements containing the same definition of “affiliates” as in the agreements at issue in this case. *See* Part II.B., *infra*; Appx. B.

### **3. The Confidentiality and Non-Compete Provisions Require a Broad Definition of “COMPANY”**

The confidentiality provisions in the “secrecy” agreements also support that “COMPANY” means the J&J family. It is beyond dispute that every J&J family company has an interest in protecting confidential information relevant to its business. Also, under Paragraph 4 of the employment agreements, employees must not “disclose to the COMPANY or induce the COMPANY to use any secret, proprietary or confidential information or material belonging to others including my former employers, if any.” Dkt. 522-1 at JANREM0098780, -98808, -98797, -98814. [REDACTED], and it only makes sense, that employees must not disclose others’ confidential information to any company within the J&J family, not just a person’s employer or the J&J companies that have, over time, employed them. [REDACTED]

Janssen argues that the secrecy provisions of the agreements actually support Janssen’s interpretation because the definition of “CONFIDENTIAL INFORMATION” includes “information about the products, processes, machines, customers, clients and services of *affiliates of the COMPANY* acquired by me during my employment by the COMPANY.” Dkt. 520 at 13–14. This sentence cannot support Janssen’s definition of “COMPANY,” however, because (as the Court already recognized) while it appears in two of the employment agreements



(Marsh and Ozturk), it does not appear in two others (Epstein and Monsell). *Compare* Dkt. 522-1 at JANREM0098796, -98813 *with id.* at -98780, -98807.

Finally, Janssen argues that the definition of “CONFLICTING PRODUCT” supports a narrow interpretation of “COMPANY” because the definition includes products “about which I become knowledgeable as a result of employment with the ‘COMPANY.’” Dkt. 520 at 14. This definition makes no reference to “affiliates” and thus is not inconsistent with “COMPANY” including J&J and affiliates. Dkt. 522-1 at JANREM0098807, -98796, -98813. Also, this “conflicting product” provision, like the definition of “CONFIDENTIAL INFORMATION” mentioning “affiliates,” does not appear in all of the agreements, and thus cannot support Janssen’s arguments. *See* Dkt. 522-1 at JANREM0098780–81.

**B. Janssen, J&J, and Other J&J Companies Have Repeatedly Interpreted “COMPANY” to Mean More than Just the Employer**

Documents Janssen produced and that Defendants found reveal that Janssen, J&J, and other J&J companies have repeatedly argued that employment agreements with the same or similar language as the Epstein, *et al.* agreements should be interpreted as Defendants argue. For example, in April 2007, J&J subsidiaries DePuy Spine, Inc. and Johnson & Johnson Regenerative Therapeutics, LLC (“JJRT”) brought a case in Massachusetts state court to enforce provisions of an “Employee Secrecy, Non-Competition and Non-Solicitation agreement” dated July 27, 2005. The agreement contains the same definition of “COMPANY” as the Epstein, *et al.* agreements. Dkt. 525-2 at 27; Dkt. 522-1. Represented by the law firm of Nutter, McClennen & Fish LLP that represents Janssen in this case, DePuy Spine and JJRT argued, applying New Jersey law, that the term “COMPANY” in the agreement:

is defined to include *not only* DePuy Spine *but also* “JOHNSON & JOHNSON and any of their successors or assigns, purchasers, acquirers, and any of their existing and future subsidiaries, divisions or affiliates.”

Dkt 525-2 at 5, 8. The plaintiffs described the agreement as “Ross’s *Agreement with JJRT and DePuy Spine*” and argued that “[t]he *Agreement is enforceable by DePuy Spine and JJRT*,” despite the fact that the employee was an employee of DePuy Spine and there is no indication he was employed by JJRT. *See generally* Ex. 6; *id.* at 5–6 (emphasis added). J&J affiliates have thus interpreted the subject language in the J&J form agreement exactly as it is written and as Defendants assert it should be interpreted here.

And it is not just that one instance. J&J family companies have done this many times, as shown in these additional examples:

- In June 2005, J&J subsidiaries LifeScan, Inc., Diabetes Diagnostics, Inc., and Inverness Medical Ltd. sued a former employee of LifeScan to enforce a “Nondisclosure, Noncompetition and Developments Agreement and an Employee Secrecy Agreement.” Ex. 7 at 3-4. The agreement contains the same definition of “COMPANY” as the Epstein, *et al.* agreements. *Id.* at 24; Dkt. 522-1. The J&J companies, represented again by the Nutter law firm, argued that “*Plaintiffs DDI and Inverness are subsidiaries either directly or indirectly, of Johnson & Johnson, and, therefore, along with LifeScan, are protected by the Secrecy Agreement.*” Ex. 7 at 8 (emphasis added).
- In 2009, J&J and Cordis sued certain former employees of Cordis seeking to enforce employee secrecy agreements containing the same definition of “COMPANY” as the Epstein, *et al.* agreements. Ex. 8 at 3–5, 9; *id.* at Ex. A–C. J&J and Cordis argued that “*[t]he Agreements reasonably protect J&J’s and Cordis’ interest* in their customer relationships and confidential, proprietary and trade secret information...” Ex. 23 (TRP Brief) at 4, 12 (emphasis added); *see also id.* at 24–26 (referring to “J&J’s and Cordis’ right to injunctive relief,” quoting paragraphs from secrecy agreement referring to the “COMPANY”).
- In July 2008, J&J and then-J&J subsidiary Cordis Corporation sued a former employee of Cordis to enforce terms of an “Employee Secrecy, Non-Competition and Non-Solicitation Agreement.” Ex. 9 at 1–2. The agreement is identical or almost identical to the one signed by ’083 patent named inventor Mr. Monsell in July 2001. *See id.*; Dkt. 522-1. J&J and Cordis alleged that the former employee’s new employment would cause “plaintiffs [to] be immediately, irreparable and severely harmed.” Ex. 9 at 12. J&J and Cordis also told the court, in the complaint (verified by a Cordis executive), that “[p]ursuant to Paragraph 1 of the [Secrecy] Agreement, *plaintiffs own all inventions, patentable or not, developed by Park while at plaintiffs.*” *Id.* at 11 (emphasis added).

As further shown in Appendix B, J&J and its subsidiaries have filed various other lawsuits to enforce employment agreements that have same or similar definition of “COMPANY” as the

Epstein, *et al.* agreements, even though the employee at issue was not an employee of each J&J family plaintiff in the case. *See* Ex. 10 (Janssen’s Apr. 12, 2017 list of litigations); Ex. 1 (Martinson Dep. Tr.) at 159:2–160:23; 345:22–347:4; Appx. B.<sup>4,5</sup> Of course, to do so they must interpret “COMPANY” as Defendants do, and directly contrary to what Janssen proposes here.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

---

<sup>4</sup> The citation to “Ex. 5” on page 17 of Defendants’ opening brief (Dkt. 508) should have cited Ex. 11 attached hereto, which is an agreement from the same consolidated case with essentially identical text as Exhibit 5 to the opening brief.

<sup>5</sup> The Court should not permit Janssen to dodge these positions by arguing they are different J&J entities. While Janssen is the named plaintiff in the instant litigation, J&J controls it. The decision-makers with full access to the information and papers in the litigation are J&J personnel. Dkt. 170; Ex. 12 (LinkedIn profiles); *see* Dkt. 170. J&J issues public statements concerning the litigation. Ex. 13 (press release); Dkt. 441-2 at 5 (earnings call transcript).

[REDACTED] . The individual involved in settlement negotiations is a J&J attorney.

[REDACTED] Dkt. 446-4 at 16–17 (annual report excerpt); Ex. 18 at ¶ 31 (H. Grabowski 8/31/16 report excerpts).

[REDACTED]

In view of the above examples, Janssen’s argument that Defendants’ interpretation of “COMPANY” is “[in]conceivable,” “absurd,” or “preposterous” should be flatly rejected. Dkt. 539 at 9; Dkt. 445 at 3, 6–8. Janssen and its parent and sister companies have interpreted the agreements exactly as Defendants argue, time and time again, over more than a decade, including through the same law firm representing Janssen in this case, in the courts of this State. Janssen and J&J’s Rule 30(b)(6) witness Ms. Martinson agreed [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]” *Id.* at 225:3–10, 244:9–14.

**C. J&J’s Prior Positions Should Estop Janssen in This Case**

Janssen and J&J’s arguments in this case should be barred by judicial estoppel in light of J&J’s positions in prior litigation. In the First Circuit, judicial estoppel applies where “(1) the estopping position and the estopped position are directly inconsistent; and (2) the responsible party... succeeded in persuading a court to have accepted its prior position.” *Thore v. Howe*, 466 F.3d 173, 182 (1st Cir. 2006) (internal citation omitted). In addition, some First Circuit cases have held that “the party seeking to assert the inconsistent position must stand to derive an unfair advantage if the new position is accepted by the court.” *RFF Family P’ship, LP v. Ross*, 814 F.3d 520, 528 (1st Cir. 2016). All three factors are met here.

On at least one prior occasion, J&J sought to enforce an employment agreement similar to the Epstein, *et al.* agreements and successfully obtained a temporary restraining order against an employee who planned to leave her position with a J&J subsidiary to work for an alleged competitor. Dkt. 508-4 at 2-5 (order granting PI). J&J argued that the obligations of the

employee under her employment agreement protected not only her employer DePuy Orthopedics, but also J&J, arguing that violations of the agreement would create “significant and unfair competitive advantage over *plaintiffs*” such that “[m]oney damages would not adequately compensate *plaintiffs* for the losses and injuries *they* would suffer”). Ex. 19 (Barney complaint) at ¶ 38 (emphasis added). The court granted the injunction because of the employee’s access to “confidential business information of the DePuy franchise,” which consists of “DePuy Orthopaedics, as well as Depuy Spine, DePuy Mitek (sports medicine) and Codman (neurology).” Dkt. 508-4 at 9, 15 (order granting PI). And it prevented the employee from disclosing “any of *plaintiffs*’ confidential information...as defined in her [agreement] with *plaintiffs*...” *Id.* at 4 (emphasis added).

The agreement J&J enforced in the DePuy Orthopedics case defined “COMPANY” the same way “COMPANY” is defined in the Epstein, *et al.* agreements. Ex. 19 (Barney complaint) at JANREM0113065. J&J’s position in that case that J&J (and other subsidiaries) were protected by the employment agreement is thus “directly inconsistent” with Janssen and J&J’s position in this case that “COMPANY” does not include J&J or other companies. *Thore*, 466 F.3d at 182. And by obtaining preliminary relief, J&J successfully “persuad[ed] a court to ... accept[] its prior position.” *Id.* Janssen’s attempt here to “deliberately chang[e] positions according to the exigencies of the moment” should be rejected “to protect the integrity of the judicial process.” *New Hampshire v. Maine*, 532 U.S. 742, 743 (2001).<sup>6</sup>

---

<sup>6</sup> The estopped party need not be the exact party involved in the prior proceeding, so long as the two parties are in privity. *Cf. In re Colonial Mortg. Bankers Corp.*, 324 F.3d 12, 19 (1st Cir. 2003) (sister corporations in privity for purposes of more stringent test for res judicata); *see also, e.g., Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, 692 F.3d 983, 998 (9th Cir. 2012) (representations made by executor in privity with beneficiary attributable to beneficiary for purposes of judicial estoppel). J&J controls this litigation and has identity of interests with Janssen. *See* note 5, *supra*. It is thus appropriate for the Court to estop Janssen from asserting positions that are inconsistent with J&J’s prior representations. *See Monroe*, 692 F.3d at 998; *cf. Colonial*, 324 F.3d at 19.

Finally, while estoppel does not require such a showing, “[w]here unfair advantage exists, however, it is a powerful factor in favor of applying the doctrine.” *Guay v. Burack*, 677 F.3d 10, 16–17 (1st Cir. 2012). This consideration is present here. Janssen would derive an unfair benefit by interpreting the very same term both broadly and narrowly in order to receive the outcome most favorable to it in each litigation. “Courts typically invoke judicial estoppel when a litigant tries to play fast and loose with the courts.” *RFF Family P’ship*, 814 F.3d at 527-28 (quotations omitted); *see also Patriot Cinemas, Inc. v. Gen. Cinemas Corp.*, 834 F.2d 208, 214 (1st Cir. 1987) (“If parties feel free to select contradictory positions before different tribunals to suit their ends, the integrity and efficacy of the courts will suffer.”).

**D. Janssen’s No-Definition Definition of “COMPANY” Does Not Pass Muster**

Unable to reconcile or support its previous positions that “‘COMPANY’ can mean only Centocor” (Dkt. 445 at 5), or that the agreement “travel[s] with the employee if he or she is transferred to another J&J company” (2/8/17 Hr’g Tr. at 47:15–20), Janssen now appears to argue that the meaning of “COMPANY” varies depending upon the situation. Its corporate designee, Ms. Martinson testified that [REDACTED]

[REDACTED]

[REDACTED] Ex. 1 (Martinson Dep. Tr.) at 162:22–163:5, 163:16–23. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *Id.* at 173:25–180:25.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Janssen's new, chameleon-like position regarding the meaning of "COMPANY" is not credible. Indeed, it conflicts with Janssen's representation to this Court in February that covering the confidentially of other J&J companies in addition to the employer would be "antithetical to the way this company works." 2/8/17 Hr'g Tr. at 63-64.<sup>7</sup>

This malleable definition is even more untenable in view of Janssen and J&J's interpretation of the updated version of the form employment agreement. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Ex. 1 (Martinson Dep. Tr.) at 29:17-23, 79:16-80:7, 83:18-84:18, 171:19-23.

**E. Janssen's "Extrinsic Evidence" Cannot Be Used to Alter the Plain Words of the Contract**

While Janssen is correct that under New Jersey law, extrinsic evidence is "admissible in aid of the interpretation of an integrated agreement" (Dkt. 520 at 10 (quoting *Conway v. 287 Corporate Center Assocs.*, 901 A.2d 341 (N.J. 2006))), Janssen buries the critical limitation of extrinsic evidence in a footnote: "[t]he admission of evidence of extrinsic facts is not for the purpose of changing the writing, but to secure light by which to measure its actual significance."

---

<sup>7</sup> [REDACTED]

*Id.* at n. 4 (quoting *Conway*, 901 A.2d at 347). Janssen’s crop-quote from *Conway* cuts off its description of the proper role of extrinsic evidence:

Such evidence is admissible only for the purpose of interpreting the writing—*not for the purpose of modifying or enlarging or curtailing its terms*, but to aid in determining the meaning of what has been said. So far as the evidence tends to show, not the meaning of the writing, but an intention wholly unexpressed in the writing, it is irrelevant. The judicial interpretive function is to consider what was written in the context of the circumstances under which it was written, and accord to the language a rational meaning in keeping with the expressed general purpose.

*Conway*, 901 A.2d at 347 (emphasis added). Court have repeatedly applied this principle. See *Abbott Point of Care Inc. v. Epocal, Inc.*, 666 F.3d 1299, 1303 (Fed. Cir. 2012) (“New Jersey law explains that extrinsic evidence is admissible to aid in contract interpretation, but it is not for the purpose of modifying or enlarging or curtailing its terms.”) (internal quotation marks omitted); *State v. Prob. Ass’n of New Jersey*, No. A-5864-04T5, 2006 WL 1716129, at \*4 (N.J. Super. Ct. App. Div. June 23, 2006) (“Evidence of the surrounding circumstances is admissible not to change a contract, but only to interpret it....”). So must this Court.

### **1. Janssen’s Declarations Are Entitled to No Weight**

In support of its contorted interpretation, Janssen submits declarations from two J&J employees: Kenneth J. Dow, Assistant General Counsel for Patents in the J&J Law Department and Vice President Patent Law at Janssen, and Katherine Amos, the Senior Director, Global Transfer Pricing at J&J. Dkt. 522; Dkt. 523. Both declarations are legally improper and neither can change the unambiguous meaning of the agreements.

#### **a) The Dow declaration contains improper legal argument**

Attorney Dow’s declaration is filled with legal argument under the guise of a factual declaration. Dow merely parrots Janssen’s desired reading of the employment agreements, stating that Janssen employees sign agreements under which they “assign[] rights in [their] inventions to Janssen,” that “[b]ased on the agreements...all inventions made by Janssen



employees during their employment are automatically assigned to Janssen,” and that “[a]ll six inventors of the ’083 patent signed such agreements.” Dkt. 522 at ¶¶ 5-6. Critically, though, “[c]ontract interpretation is a question for judicial resolution.” *Prob. Ass'n of New Jersey*, 2006 WL 1716129, at \*3. Because the “interpretation of a contract...is ultimately a question of law for [the] court to decide,” Dow “cannot opine as to the scope of [the agreements].” *Contour Design, Inc. v. Chance Mold Steel Co.*, 794 F. Supp. 2d 315, 321 (D.N.H. 2011).

Courts routinely discount or exclude legal argument and legal conclusions in the form of declarations, including where they relate to contract interpretation. *See, e.g., Karp v. CIGNA Healthcare, Inc.*, 882 F. Supp. 2d 199, 205 n.4 (D. Mass. 2012) (striking declaration to the extent it consisted of legal arguments and conclusions); *N. Light Tech. v. N. Lights Club*, 97 F. Supp. 2d 96, 109 n.14 (D. Mass. 2000) (“To the extent the affidavit offers legal arguments and conclusions, it is inadmissible.”); *Burkhart v. Washington Metro. Area Transit Auth.*, 112 F.3d 1207, 1213 (D.C. Cir. 1997) (“Each courtroom comes equipped with a ‘legal expert,’ called a judge....”).

**b) The Dow declaration effects a waiver of privilege**

Through the Dow declaration, Janssen attempts to advance arguments using selective disclosure of privileged information. These issues are set forth more fully in Defendants’ related Motion to Compel, filed herewith, which explains that Janssen may not use privilege “as ‘both a sword and a shield’ in order to gain an unfair tactical advantage over [Defendants].” *Columbia Data Prod., Inc. v. Autonomy Corp., Ltd.*, No. 11-12077, 2012 WL 6212898, at \*17 (D. Mass. Dec. 12, 2012). Janssen made “knowing disclosure[s]” in the form of attorney Dow’s declaration and exhibits, and also by way of attorney Anne Martinson’s analysis, and as a result its waiver of privilege is “deemed to encompass all other such communications on the same subject.” *In re Lernout & Hauspie Sec. Litig.*, 222 F.R.D. 29, 34–35 (D. Mass. 2004); *see also Fonar Corp. v.*

*Johnson & Johnson*, No. 82-2751, 1985 WL 186693, at \*2 (D. Mass. Aug. 20, 1985). The analysis and related documents Janssen puts forth through attorneys Dow and Martinson must either be ignored, or Janssen must make a complete disclosure on the same subject matter and produce the documents it is withholding.

**c) Statements by Ms. Amos do not apply to the '083 patent**

Janssen's declarant Katherine Amos offers no relevant information. She argues that the J&J family would not share ownership of patents because it would result in tax complexities for J&J in the event it needed to allocate income or revenue associated with a patent. Dkt. 523 at ¶¶ 10-12; *see also id.* at ¶¶ 15-18. But the penultimate paragraph of Amos's declaration admits, critically, that she has "been informed that the '083 patent has not been used in connection with any product that has been sold commercially," and "[i]f the patent were to generate earnings in the future, however, for example through a settlement payment or damages award in this litigation, these earnings would be allocated to Janssen Biotech, Inc., which J&J understands to be the sole owner of the patent." *Id.* at ¶ 22. In short, Amos's parade of horrors is inapplicable to the '083 patent, because it has generated no transactional income.<sup>8</sup> Moreover, how any income would be "allocated" cannot change the meaning of the agreements. The "chaos" that allegedly would be caused by multi-entity ownership also is belied by Janssen's admission that patents must be owned by more than one J&J company in some circumstances, when "employees of [more than one] company participated in the invention." Dkt. 520 at 15, 19.

**d) Janssen's declarants lack firsthand knowledge**

---

<sup>8</sup> Portions of the Dow declaration suffer from a similar problem. Dow claims that joint ownership would be "cumbersome or unnecessarily burdensome" because "the filing of a reissue application requires the consent of all assignees, and that consent must include a showing of ownership by the assignees." Dkt. 522 at ¶ 15. But the '083 patent has never undergone a reissue proceeding. Ex. 20 (Dow Dep. Tr.) at 266:6-15. Nor has it had a petition to correct inventorship filed. *See* Dkt. 522 at ¶¶ 15-16. [REDACTED]

*Id.* at ¶ 17; Ex 20 (Dow Dep. Tr.) at 266:16-23.

Both of Janssen’s declarations should be ignored because the declarants lack firsthand knowledge, and lack any knowledge about the intent of the agreements’ drafters and signatories.

[REDACTED]

Ex. 20 (Dow Dep. Tr.) at 125:10–126:2. But Dow does not have knowledge of the intent or circumstances surrounding the relevant agreements. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Finally, despite relying on a series of documents called “assignments” that the ’083 patent inventors executed in 2015 as purported support for his interpretation (*see* Dkt. 522 at ¶ 9), Dow

Ex. 20 (Dow Dep. Tr.) at 206:7–207:7, 222:12–225:7.

Amos also lacks firsthand knowledge of the employment agreements. She did not join J&J until May of 2016, more than a decade after the agreements were drafted and signed. Dkt. 523 at ¶ 1. The only pertinent portion of Amos’s declaration—the two paragraphs addressing the ’083 patent—suggest that some unnamed person told Ms. Amos what to say. Dkt. 523 at ¶¶ 21–22. Such “evidence” should be disregarded. *See, e.g., Perez v. Volvo Car Corp.*, 247 F.3d 303, 316 (1st Cir. 2001) (“Because the record makes manifest that the relationship began before Gonzalez became Trebol’s general manager, his statements [in an affidavit] about the early years of the Volvo/Trebol/AUM arrangement cannot properly be considered.”); *Unleashed Doggie Day Care, LLC v. Petco Animal Supplies Stores, Inc.*, No. 10-10742, 2011 WL 6812642, at \*7 n.1 (D. Mass. Dec. 28, 2011) (declining to consider “affidavits [that] offer legal conclusions or opinion testimony not based on personal knowledge”).<sup>9</sup>

At bottom, the declarations are self-serving, litigation-driven presentations of Janssen’s arguments regarding how the agreements should be interpreted, and are not the type of extrinsic evidence New Jersey law permits. Janssen “must produce objective facts, not subjective and self-serving testimony, to show that a contract which looks clear on its face is actually ambiguous.” *Int’l Union, United Auto., Aerospace & Agr. Implement Workers of Am., U.A.W. v. Skinner*

<sup>9</sup> *Id.* at 129:20–130:7, 208:9–21. Any effort by Janssen to rely on Ms. Martinson to support its arguments also should be rejected, even aside from the issues related to privilege waiver, as impermissible extrinsic evidence.

*Engine Co.*, 188 F.3d 130, 145 (3d Cir. 1999) (declining to rely on executives’ testimony “as to what they believed the collective bargaining agreements required”) (citation omitted). In *Assisted Living Associates of Moorestown, L.L.P. v. Moorestown Township*, for example, the District of New Jersey found that declarations from the defendant’s executive and attorney “which purport[ed] to state the common intention of the parties” should be discredited as “unpersuasive and self-serving” and as “*post hoc* rationalizations which distort the original language” of the agreement. 31 F. Supp. 2d 389, 400–01. This Court should do the same with the declarations Janssen submits.

**2. Janssen’s Remaining Extrinsic Evidence Cannot Be Used to Modify the Terms of the Employment Agreements**

Janssen’s various additional items of “extrinsic evidence,” each addressed below, are no more helpful than its declarations.

**a) The ’083 patent**

Janssen points to the fact that the ’083 patent identifies Janssen (Centocor) as the assignee (Dkt. 520 at 15–16), but this is entitled to little, if any, weight. The identification of an assignee on the face of a patent is based on the filing of a purported assignment document with the Patent Office; it “is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration.” 37 C.F.R. § 3.54; *see also Hoffman-La Roche Inc. v. Teva Pharm. USA*, No. 09-5283, 2011 WL 6028583 (D.N.J. Dec. 2, 2011) (holding Roche not to be assignee of a patent on which it was identified as assignee); Ex. 21 (cover page of patent at issue in *Roche* case).

**b) Invention disclosure form**

Janssen also cites an invention disclosure form on Centocor letterhead as supporting its narrow definition of “COMPANY,” at least for purposes of the patent assignment provisions of

the employment agreements. Dkt. 520 at 16, Dkt. 522-2. That document simply indicates that the '083 patent inventors were associated with "Centocor." The fact that an invention was disclosed to a particular J&J entity says nothing about the assignee(s) of a patent under the operative assignment agreements. [REDACTED]

[REDACTED] Ex. 20 (Dow Dep. Tr.) at 245:20–246:1, 246:23–247:4. Moreover, this document, which cannot be located in Janssen's document production from fact discovery, was selectively chosen (and redacted) from attorney files. *See* Dkt. 522 at ¶ 8; Dkt. 522-2; Ex. 20 (Dow Dep. Tr.) at 243:21–245:4. As explained more fully in Defendants' Motion to Compel, filed herewith, Defendants do not know what else is contained within J&J's attorney files that might indicate intent for the '083 patent to be owned by entities in addition to Janssen. Lead inventor David Epstein, for example,

[REDACTED] Ex. 16 (Epstein Dep. Tr.) at 256:16–18. It is undisputed that [REDACTED]

[REDACTED] (Ex. 22 (Baumeister Dep. Tr.) at 27:9–25), and [REDACTED] Ex. 20 (Dow Dep. Tr.) at 236:10–24. And when it came time for corporate designees to testify regarding '083 patent prosecution and ownership issues, J&J attorneys were put to the task. Ex. 22 (Baumeister Dep. Tr.) at 20:7–8, 11:23–14:7; Dkt. 522 at 1.

**c) 2015 "assignments"**

Janssen's reliance on purported "assignments" executed after the Epstein, *et al.* employment agreements does not make sense. *See* Dkt. 520 at 16. Janssen procured two rounds of post-complaint "assignment" documents in 2015, more than a decade after execution of the employment agreements it now claims "are clear and leave no serious doubt that the '083 patent

belongs to Janssen and Janssen alone.” Dkt. 520 at 1; *see* Dkt. 522-7, 522-8. If Janssen were correct that the original four employment agreements assigned the patent to Centocor alone, the later “assignments” would be meaningless. Indeed, Dow [REDACTED]

[REDACTED]

[REDACTED] Ex. 20 (Dow Dep. Tr.) at 215:12–22.

Tellingly, Mr. Dow [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. All the two rounds of “assignments” procured after Janssen filed suit suggest is that Janssen believed there was a problem and attempted (unsuccessfully) to fix it.

d) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

**e) Annual report**

Defendants do not advocate using J&J's annual report as extrinsic evidence for use in interpreting the employment agreements. It is, like the rest of Janssen's purported "extrinsic evidence," unrelated to the employment agreements and from a time well after they were drafted or executed. Defendants referred to the annual report simply to rebut Janssen's nonsensical argument, which it has abandoned, that "COMPANY" must mean Centocor because "COMPANY" "is singular." Dkt. 508 at 16. "COMPANY" can be (and is) used to refer to the family of companies.

**f) Defendants' documents**

Janssen claims that documents Hospira and Pfizer have recorded with the Patent Office are evidence of the "practices" of "other large sophisticated companies." Dkt. 520 at 15; Dkt. 521-4, 521-5. These documents do not reflect anything about the intent of the parties to the agreements in question, and do not shed light on their meaning. Even if two lone documents were credible evidence of the "practices" of "large sophisticated companies" (they are not), the proper analysis here "must turn on the terms of the [employment agreements at issue], rather than whether [Janssen's] policies comported with prevailing industry practices." *Gabriel v. Jackson Nat. Life Ins. Co.*, No. 11-12307-MLW, 2015 WL 1410406, at \*4 (D. Mass. Mar. 26, 2015), *appeal dismissed* (Aug. 24, 2015).

**g) Janssen - J&J "disclaimer" agreement**

Finally, the "disclaimer" agreement Janssen and J&J executed two days before filing the opposition to Defendants' motion to dismiss should not be given any consideration. *See* Dkt. 520 at 20; Dkt. 521-7. Consisting mostly of restatements of Janssen's positions and arguments in the litigation, it cannot establish what the language of the employment agreements means. Janssen and J&J "agreeing" with one another that "Janssen is the sole owner of the '083 patent and there



has never been any owner of the '083 patent other than Janssen" is no different than Janssen arguing this in its briefs. *See* Dkt. 521-7 at 3; *cf. City of Madison, Joint Sch. Dist. No. 8 v. Wisconsin Employment Relations Comm'n*, 429 U.S. 167, 174 (1976) (It is "ancient wisdom that calling a thing by a name does not make it so."). It is hard to think of anything more litigation-driven and self-serving, and less appropriate for use in construing a contract, than an "agreement" between two interested parties drafted more than ten years after the contracts in question, expressly for the purpose of obtaining a favorable construction of the contracts. *See* Dkt. 521-7 at 3 ("WHEREAS [Defendants] ... have disputed Janssen's sole ownership of the '083 patent based on agreements signed by four co-inventors...").

While J&J and Janssen claim that as a result of the disclaimer agreement, "[t]here is no possibility of multiple suits on th[e '083] patent" (Dkt. 520 at 20; Dkt. 521-7), their "agreement to be bound by all judgments" in this case does not "resolve[] the issue of standing." *Prima Tek II, L.L.C. v. A-Roo Co.*, 222 F.3d 1372, 1381 (Fed. Cir. 2000). "Standing to sue for infringement depends entirely on the putative plaintiff's proprietary interest in the patent, not on any contractual arrangements among the parties regarding who may sue and who will be bound by judgments." *Id.*; *see also Ortho Pharm. Corp. v. Genetics Inst., Inc.*, 52 F.3d 1026, 1034 (Fed. Cir. 1995) ("[A] contract cannot change the statutory requirement for suit to be brought by the 'patentee.'"); *see also Alps S., LLC v. Ohio Willow Wood Co.*, 787 F.3d 1379, 1384 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 897 (2016) ("[N]unc pro tunc assignments are not sufficient to confer retroactive standing.").

### **III. Conclusion**

For the foregoing reasons, the Court should grant Defendants' motion to dismiss.

Respectfully submitted:

Dated: May 22, 2017

/s/ Andrea L. Martin

---

BURNS & LEVINSON LLP  
Dennis J. Kelly (BBO # 266340)  
Andrea L. Martin (BBO #666117)  
125 Summer Street  
Boston, Massachusetts 02110  
[dkelly@burnslev.com](mailto:dkelly@burnslev.com)  
[amartin@burnslev.com](mailto:amartin@burnslev.com)  
Telephone: 617-345-3000  
Facsimile: 617-345-3299

KIRKLAND & ELLIS LLP  
James F. Hurst, P.C. (admitted *pro hac vice*)  
Bryan S. Hales, P.C. (admitted *pro hac vice*)  
Elizabeth A. Cutri (admitted *pro hac vice*)  
300 North LaSalle  
Chicago, IL 60654  
Tel: (312) 862-2000  
Fax: (312) 862-2200  
[james.hurst@kirkland.com](mailto:james.hurst@kirkland.com)  
[bryan.hales@kirkland.com](mailto:bryan.hales@kirkland.com)  
[elizabeth.cutri@kirkland.com](mailto:elizabeth.cutri@kirkland.com)

Jeanna M. Wacker (admitted *pro hac vice*)  
Ryan Kane (admitted *pro hac vice*)  
James H. McConnell (admitted *pro hac vice*)  
601 Lexington Avenue  
New York, NY 10022  
Tel: (212) 446-4800  
Fax: (212) 446-4900  
[jeanna.wacker@kirkland.com](mailto:jeanna.wacker@kirkland.com)  
[ryan.kane@kirkland.com](mailto:ryan.kane@kirkland.com)  
[james.mcconnell@kirkland.com](mailto:james.mcconnell@kirkland.com)

WINSTON & STRAWN LLP  
Charles B. Klein (admitted *pro hac vice*)  
Steffen N. Johnson (admitted *pro hac vice*)  
1700 K Street, N.W.  
Washington, D.C. 20006-3817  
Tel: (202) 282-5000  
Fax: (202) 282-5100  
Email: [cklein@winston.com](mailto:cklein@winston.com)  
Email: [sjohnson@winston.com](mailto:sjohnson@winston.com)

Samuel S. Park (admitted *pro hac vice*)  
Dan H. Hoang (admitted *pro hac vice*)  
35 West Wacker Drive  
Chicago, IL 60601  
Tel: (312) 558-5600  
Fax: (312) 558-5700  
Email: [spark@winston.com](mailto:spark@winston.com)  
Email: [dhoang@winston.com](mailto:dhoang@winston.com)

Melinda K. Lackey (admitted *pro hac vice*)  
1111 Louisiana, 25th Floor  
Houston TX 77002  
Tel: (713) 651-2600  
Fax: (713) 651-2700  
Email: [mlackey@winston.com](mailto:mlackey@winston.com)

*Attorneys for Celltrion Healthcare Co., Ltd.,  
Celltrion, Inc. and Hospira, Inc.*

**CERTIFICATE OF SERVICE**

I, Andrea L. Martin, hereby certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non-registered participants on May 22, 2017.

/s/Andrea L. Martin, Esq.  
Andrea L. Martin, Esq.