

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KASHIV BIOSCIENCES, LLC
Petitioner

v.

AMGEN INC.
Patent Owner

Case No. IPR2019-00791
U.S. Patent No. 8,940,878

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

Pursuant to the Board's July 16, 2019 Order (Paper 12), Petitioner Kashiv BioSciences LLC ("Kashiv") submits this Reply to respond to arguments made in Patent Owner's Preliminary Response (Paper 7, "POPR").

I. ARGUMENT

Patent Owner's arguments under 35 U.S.C. § 314(a) are premised entirely on the false allegation that Kashiv has "*unfairly* used Amgen's litigation validity contentions" in preparing its Petitions for *Inter Partes* Review of U.S. Patent No. 9,643,997 (the "997 patent") and 8,940,878 (the "878 patent"). POPR, 8 (emphasis added). These assertions are merely an effort to distract the Board from the substantive merits of Kashiv's Petitions. While institution is discretionary, denying Kashiv access to the efficiencies of this forum, as an alternative to district court litigation, simply because routine, preliminary events had occurred in the co-pending litigation¹ prior to filing the Petitions, would be unfair and in direct contravention of legislative intent and precedent. This is particularly true where Patent Owner likewise has relied upon, and benefited from, the same litigation.²

¹ *Amgen Inc. et al. v. Kashiv BioSciences, LLC, et al.*, Civil Action No. 2:18-cv-03347 (D.N.J.) (filed Mar. 8, 2018) (the "D.N.J. Action").

² In fact, Patent Owner has been honing, adjusting, and irreconcilably changing its positions across *multiple* litigations involving the same patents, each time cherry-picking claim constructions and arguments to suit its litigation goals in each case.

The Board should thus reject Patent Owner's Section 314(a) arguments.

A. Congressional Intent Favors Institution

As a preliminary matter, there is no dispute that the Petitions were timely. *See* Paper 3. Instead, Patent Owner appears to fault Kashiv for filing the Petitions at “the very end of the one-year bar period” following early, routine events³ in the D.N.J. Action. POPR, 2. Yet this is precisely what Congress contemplated by 35 U.S.C. § 315(b) in establishing the one-year bar after service of a complaint:

The final bill extends [the original 6-month] deadline, at proposed section 315(b), *to 1 year*. High-technology companies, in particular, have noted that they are *often sued by defendants asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant's products*. ... [I]t is important that the section 315(b) deadline afford defendants *a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation*.

157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (emphases added). Indeed, where

See, e.g., POPR, 18-19 (attempting to walk back its own declarant's prior statement in another litigation (EX1049) regarding what the term “buffer” means).

³ In this case, and in many courts, preliminary invalidity and validity contentions are routinely due well within a year of the service of a complaint. *See, e.g.*, D.N.J. Civ. R. 26.1, 9.3 (section 3.1); D. Mass. R. 16.6; E.D. Tex. Patent R. 3-1, 3-3.

Patent Owner initially sued Kashiv for infringement of *17* patents and subsequently reduced and shifted its infringement contentions multiple times (including a month before Kashiv filed its Petitions), there was nothing improper about Kashiv's timely filing of its Petitions in March 2019 rather than in October/November 2018 (when preliminary invalidity/validity contentions were exchanged⁴). *See Toshiba America Info. Sys. Inc. v. MSI Comp. Corp.*, IPR2018-01538, Paper 11, 21-22 (it was not "unfair" that "Petitioner, as part of its litigation strategy, chose to file its Petition almost one year after being served with a complaint"); *Mylan Pharm. Inc. v. Biogen MA Inc.*, IPR2018-01403, Paper 12, 46 (timely petition was instituted).

Moreover, to the extent that Kashiv relied on information from Patent Owner's *preliminary* validity contentions in preparing its Petitions, Patent Owner likewise has benefited from, and relied upon, recent and post-Petition information from Kashiv's claim construction briefing and *amended* invalidity contentions, and even from a different litigation against Hospira, Inc., to support its positions. *See, e.g.*, POPR, 18 (citing EX2009), 21 (citing Kashiv's alleged failure to address Patent Owner's litigation arguments as a basis for denying institution); D.N.J. Action, Dkt. 111, 113, 123-24 (post-Petition claim construction briefs). Denying institution under Section 314(a) is thus unwarranted in this case.

⁴ The contentions included the art asserted in Kashiv's Petitions, "amongst others" that are different from Kashiv's Petitions. *See* POPR, 9; EX2001; EX2010.

B. The *General Plastic* Factors Weigh in Favor of Institution

Despite its arguments regarding Section 314(a), Patent Owner does not address any of the factors established by *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19. See POPR, 11-13. This is unsurprising, given that “[t]he *General Plastic* decision was principally directed to prevent the use of *multiple patent office procedures* to harass patent owners, *of which there is no evidence here.*” *Samsung Elecs. Co., Ltd. v. Immersion Corp.*, IPR2018-01499, Paper 11, 16 (emphasis added).

Factors 1-5 apply to the filing of multiple/follow-on/serial petitions. *General Plastic*, Paper 19, 9. These factors thus weigh heavily in favor of institution, because Kashiv has never filed *any* prior petition directed to the claims of the '997 or '878 patents. See *Samsung*, Paper 11, 16-17 (factors 1-5 “strongly favor institution”); *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00084, Paper 14, 17; *Toshiba*, Paper 11, 21. Factors 6-7 also favor institution, because the “finite resources of the Board” would be used to further the “congressional intent” of IPR to “provide an effective and efficient alternative to district court litigation.” *Mylan*, Paper 12, 44. This is particularly true where the litigation is still in its early stages, and “[t]he trial in the related district court case has not occurred, may be delayed, or may not occur at all.” *Samsung*, Paper 11, 16-17 (factor 6 was intended to “conserve *Board* resources from repeat or multiple staggered

petitions”) (emphasis in original); D.N.J. Action, Dkt. 132 (no trial date set).

C. PTAB Precedent Does Not Support Denial of Institution

None of the PTAB decisions⁵ cited by Patent Owner hold that a *first* petition should be denied because of the existence of co-pending litigation. *See* POPR, 8-13. Rather, each case (like *General Plastic*, and unlike this case) involves follow-on petitions or otherwise significantly advanced litigation proceedings. *See Nvidia Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9, 8 (denying institution of *second* petition because filing *serial petitions at the PTAB* could allow Petitioner to unfairly adjust litigation positions “based on either patent owner’s contentions or the Board’s decisions *on prior [PTAB] challenges*”) (emphasis added); *Toyota Motor Corp. v. Cellport Sys., Inc.*, IPR2015-01423, Paper 7, 8-9 (rejecting follow-on petition); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (same); *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752 (“the advanced state of the district court proceeding” weighed against institution).

II. CONCLUSION

For the foregoing reasons and as set forth in its Petition, Kashiv respectfully requests institution of this IPR and cancellation of the challenged claims.

⁵ Patent Owner’s reliance on *TruePosition, Inc. v. Polaris Wireless, Inc.*, 2013 WL 5701529 (D. Del. Oct. 21, 2013) is misplaced as it concerns an entirely different question of whether to stay district court proceedings pending IPR.

Respectfully submitted,

Date: July 19, 2019

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PETITIONER'S
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically in its entirety on July 19, 2019 via electronic mail to the following attorneys of record:

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