

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUN PHARMACEUTICAL INDUSTRIES, LTD., SUN
PHARMACEUTICAL INDUSTRIES, INC., and
SUN PHARMA GLOBAL FZE,
Petitioner,

v.

NOVARTIS AG,
Patent Owner.

Case IPR2017-01929
Patent US 9,187,405 B2

Before LORA M. GREEN, CHRISTOPHER M. KAISER, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION

Instituting *Inter Partes* Review and Granting Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE (collectively, “Sun”) filed a Petition requesting an *inter partes* review of claims 1–6 of U.S. Patent No. 9,187,405 B2 (“the ’405 patent”). Paper 2 (“Pet.”). Along with the Petition, Sun filed a Motion for Joinder to join this proceeding with IPR2017-00854. Paper 3 (“Mot.”). Sun filed its Petition and Motion for Joinder on August 16, 2017, within one month after we instituted trial in IPR2017-00854. Patent Owner, Novartis AG, (“Novartis”) has not filed a Preliminary Response to the Petition, and any such response is due November 25, 2017.

As explained further below, we institute trial on the same grounds as instituted in IPR2017-00854 and grant Sun’s Motion for Joinder.

II. DISCUSSION

In IPR2017-00854, Apotex, Inc. and Apotex Corp. (collectively, “Apotex”) challenged claims 1–6 of the ’405 Patent on the following grounds:

Ground	Claims	References	Basis
1	1–6	Kovarik ¹ and Thomson	§ 103

¹ Kovarik and Appel-Dingemans, WO 2006/058316, published June 1, 2006.

Ground	Claims	References	Basis
2	1–6	Chiba, ² Kappos 2005, ³ and Budde ⁴	§ 103
3	1–6	Kappos 2010 ⁵	§ 102

After considering the Petition and Patent Owner’s Preliminary Response, we instituted trial in IPR2017-00854 on each of the three asserted grounds. IPR2017-00854, Paper 11, 27. On August 9, 2017, we instituted *inter partes* review on those same grounds in IPR2017-01550 and granted Petitioner Argentum Pharmaceuticals LLC’s motion for joinder with IPR2017-00854. IPR2017-00854, Paper 10, 5. On September 11, 2017, we similarly instituted *inter partes* review on those same grounds in IPR2017-01946 and granted Petitioner Actavis Elizabeth LLC and Teva Pharmaceuticals USA, Inc.’s (collectively, “Teva’s”) motion for joinder with IPR2017-00854. IPR2017-00854, Paper 23, 5.

As with Argentum’s and Teva’s Petitions, Sun’s Petition is substantively identical to Apotex’s Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2017-01929, Paper 2, *with* IPR2017-00854, Paper 2. For the same reasons stated in our Decision on Institution in IPR2017-00854, we institute trial in this proceeding on the same three grounds.

² Chiba et al., US 6,004,565, issued Dec. 21, 1999. Ex. 1006.

³ Kappos et al., “*FTY720 in Relapsing MS: Results of a Double-Blind Placebo-Controlled Trial with a Novel Oral Immunomodulator*,” 252 (Suppl 2) J. NEUROLOGY Abstract O141 (2005).

⁴ Budde, et al., “*First Human Trial of FTY720, a Novel Immunomodulator, in Stable Renal Transplant Patients*,” 13 J. AM. SOC. NEPHROLOGY 1073-1083 (2002).

⁵ Kappos et al., “*A Placebo-Controlled Trial of Oral Fingolimod in Relapsing Multiple Sclerosis*,” 362(5) N. ENGL. J. MED. 387–401.

Having determined that institution is appropriate, we now turn to Sun's Motion for Joinder. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that "[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311." *Id.* When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Sun's motion for joinder is unopposed by all concerned parties. The time for Novartis to oppose the motion has expired. *See* 37 C.F.R. § 42.25(a)(1)). Further, Sun informs us that Apotex, Argentum, and Actavis do not oppose the motion. *See* Mot. 2 & n.1; Ex. 3001 (email communication from Samuel S. Park, dated September 29, 2017).

Under the circumstances of this case, we determine that joinder is appropriate. Sun raises no new grounds of unpatentability from IPR2017-00854 and contends that there will be no impact on the trial schedule previously set in that case. Mot. 8; *see* IPR2017-00854, Paper 12. As Sun notes, the Petition in IPR2017-00854 is substantively identical to the grounds, analysis, exhibits,⁶ and expert declarations relied on in the instant proceeding. Mot. 2, 5, 6. Sun agrees to "coordinate with Apotex regarding questioning at depositions and at the oral hearing," and suggests that

⁶ Sun notes that, as compared to the Apotex Petition, it "added one additional exhibit (EX1041) which is a copy of the Federal Circuit Decision of April 12, 2017 affirming the Final Written Decision in IPR2014-00784, an IPR related to the present proceeding." Mot., 5–6.

“[b]ecause the Sun IPR is substantively identical to the Apotex IPR, the Board may adopt procedures similar to those used in other cases to simplify briefing and discovery during trial.” Mot. 9. With respect to such procedures, “Sun agrees to the same conditions as set forth in Paper 23 of IPR2017-00854.” Ex. 3001.

In view of the foregoing, we find that joinder based upon the conditions stated in Sun’s Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined. Thus, without opposition to the Motion for Joinder from any of the parties, the Motion is granted, subject to the same conditions previously set forth with respect to the Petitioners joined in IPR2017-00854, Paper 23,

III. ORDER

Accordingly, it is
ORDERED that *inter partes* review is instituted in IPR2017-01929 on the following grounds:

Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Kovarik and Thomson;

Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Chiba, Kappos 2005, and Budde;

Claims 1–6 under 35 U.S.C. § 102 as anticipated by Kappos 2010.

FURTHER ORDERED that Sun’s Motion for Joinder with IPR2017-00854 is granted, subject to the same conditions previously set forth with respect to the Petitioners joined in IPR2017-00854, Paper 23;

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FURTHER ORDERED that IPR2017-01929 is terminated and joined to IPR2015-00854, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2017-00854 (Paper 12) shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2017-00854;

FURTHER ORDERED that the case caption in IPR2017-00854 for all further submissions shall be changed to add Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE as named Petitioners after Apotex, Argentum, and Teva, and to indicate by footnote the further joinder of IPR2017-001929 to that proceeding, as indicated in the attached sample case caption;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2017-00854.

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Sample Case Caption

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¹ Cases IPR2017-01550, IPR2017-01946, and IPR2017-01929 have been joined with this proceeding.