

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
Petitioners,

v.

NOVARTIS A.G.,
Patent Owner

Case No.: IPR2017-01929
Patent No.: 9,187,405

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c)
AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

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Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE, (collectively “Petitioners”) move for joinder of the accompanying *Inter Partes* Review (“IPR”) Petition filed today, *Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE v. Novartis A.G.*, Case No. IPR2017-01929, with *Apotex, Inc. and Apotex Corp. v. Novartis AG*, IPR2017-00854, for at least the following reasons: (1) joinder is appropriate under the governing law, rules, and precedent of this Board; (2) this Motion for Joinder is timely filed; (3) the two proceedings concern the same patent, and same prior art; (4) Petitioner relies in whole on the same evidence and the same declaration testimony in both proceedings; (5) joinder would neither complicate the issues nor unduly delay the existing schedule of IPR2017-00854; (6) joinder would significantly simplify briefing and discovery in the two IPRs, and will have no impact on the existing schedule; and (7) joinder will not prejudice any party. Finally, joinder here will secure a just, speedy, and inexpensive resolution in both proceedings, more so than in the absence of joinder, by avoiding having the Board preside over two separate proceedings involving identical and duplicative filings and reviews of the same issues.

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioners request joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) of the concurrently-filed petition for IPR of claims 1-6 of U.S.

Patent No. 9,187,405 (“the ’405 patent”) with the related and instituted IPR, *Apotex, Inc. and Apotex Corp. v. Novartis AG*, Case No. IPR2017-00854 (“the Apotex IPR”).

Petitioners have notified counsel for Apotex, Inc. and Apotex Corp. (“Apotex”), petitioner in the Apotex IPR, of this Motion. Apotex has indicated that it does not oppose Petitioners’ request for joinder.¹ Further, Apotex and Petitioner have agreed to coordinate in discovery should joinder be granted, with Apotex leading in all discovery matters and hearings before the Board.

II. GOVERNING LAW, RULES AND PRECEDENT

Title 35 U.S.C. § 315(c) states:

If 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a

¹ Petitioners have notified and requested consent from counsel for Patent Owner, Novartis A.G. Counsel for Patent Owner have informed Petitioners that they are discussing Petitioners’ request with their client. Petitioners have also notified counsel for Argentum Pharmaceuticals LLC, petitioner in related IPR *Argentum Pharmaceuticals LLC v. Novartis, A.G.*, Case No. IPR2017-01550, which was joined with the Apotex IPR on August 9, 2017. Argentum has indicated that it does not oppose Petitioners’ request for joinder with the Apotex IPR.

response, determines warrants the institution of an inter partes review under section 314.

Title 37 C.F.R. § 42.122(b) states:

Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under §42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.

The Board has repeatedly allowed joinder of IPR proceedings when a second petition raises the same ground(s) of unpatentability as those instituted in a first proceeding. *See, e.g., Argentum Pharmaceuticals LLC v. Novartis, A.G.*, Case No. IPR2017-01550, Paper 10 (PTAB August 9, 2017); *Wockhardt Bio AG v. Jazz Pharms., Inc.*, IPR2015-01813, Paper 10 (PTAB Oct. 30, 2015); *Mylan Pharms. Inc. v. Novartis AG, et al.*, IPR2015-00268, Paper 17 (PTAB Apr. 10, 2015); *Apple, Inc. v. Smartflash LLC*, CBM2015-00119, Paper 11 (PTAB Aug. 6, 2015); *LG Elec., Inc. v. Innovative Display Techs. LLC*, IPR2015-00493, Paper 10 (July 15, 2015); *Cisco Sys., Inc., et al. v. Straight Path IP Grp., Inc.*, IPR2015-01006, Paper 12 (PTAB June 5, 2015).

Indeed, there is a “policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *See Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 10 (PTAB July 29,

2013) (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added)).

That is precisely the situation here. In accordance with the Board’s governing law and rules, each of the factors supporting joinder are present in this Motion for Joinder: (1) reasons why joinder is appropriate; (2) the lack of any new grounds of unpatentability being raised in the subsequent petition; (3) what impact (if any) there will be on the trial schedule for the existing review; and (4) how briefing and/or discovery may be simplified to minimize schedule impact. *Kyocera Corp. v. Softview, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB April 24, 2013); *see also Samsung Elecs. Co. Ltd. v. Unifi Sci. Batteries, LLC*, IPR2013-00236, Paper 22 at 3 (PTAB Oct. 17, 2013).

Each of these factors is addressed below.

III. STATEMENT OF MATERIAL FACTS

- On February 3, 2017, Apotex requested IPR of claims 1-6 of the ’405 patent under three grounds of unpatentability. *See* IPR2017-00854, Paper 2;

- On May 3, 2017, Novartis filed its Patent Owner Preliminary Response. *See id.*, Paper 8;
- On July 18, 2017, the Board instituted the Apotex IPR on each of the three grounds asserting that claims 1-6 of the '405 patent would have been obvious and/or anticipated over the prior art pursuant to 35 U.S.C. §§ 102 and 103. *See id.*, Papers 11 and 12. These grounds are:
 - 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; and
 - Claims 1–6 under 35 U.S.C. § 102 as anticipated by Kappos 2010.
- The Petition that accompanies the present Motion for Joinder was filed within one month of the July 18, 2017 decision to institute the Apotex IPR, and includes only the same grounds of unpatentability that were instituted in the Apotex IPR; and
- The Petition that accompanies the present Motion for Joinder is substantially identical to the instituted Apotex IPR Petition, and the accompanying evidence is the same as that relied upon in the Apotex IPR Petition. Sun has 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.

IV. ARGUMENT

This Motion for Joinder addresses the criteria identified by the Board in *Kyocera Corp.*, IPR2013-00004, Paper 15. Each factor is addressed below and all compel granting the instant motion.

A. No New Grounds of Unpatentability Are Asserted in the Petition

The Petition does not assert any new grounds of unpatentability additional to those asserted in the Apotex IPR. It challenges the same '405 patent claims based on the same arguments, evidence, expert testimony, and grounds of unpatentability on which the Board instituted review in the Apotex IPR.

B. Joinder is Appropriate Under the Governing Law, Rules, and Precedent

The Board has authority to join a properly-filed IPR petition to an instituted IPR proceeding. *See* 35 U.S.C. § 315(c). Sun's Petition is properly filed under 35 U.S.C. § 311 and timely under 37 C.F.R. § 42.122(b), that is, within one month of the Board's July 18, 2017 decision to institute the Apotex IPR. *See* IPR2017-00854, Paper 11.

Further, joinder is appropriate under the Board's rationale for permitting joinder in previous cases. As discussed above, the Board has granted another request for joinder of IPR proceedings involving the same Apotex IPR and under

circumstances identical to the instant proceeding. On August 9, 2017, the Board granted request of joinder of Argentum Pharmaceutical's petition challenging the same claims on the same grounds as that instituted in the Apotex IPR. *Argentum Pharmaceuticals LLC v. Novartis, A.G.*, Case No. IPR2017-01550, Paper 10 (PTAB August 9, 2017). As discussed above, the Board has also granted numerous other requests for joinder of IPR proceedings under circumstances similar to the instant proceeding. For example, in *LG Elec.*, the Board granted joinder of a second petition challenging the same claims on the same grounds as that instituted in the first proceeding. *See LG Elec.*, IPR2015-00493, Paper 10. This rationale has been applied by the Board in other cases. *See, e.g., ION Geophysical, et al. v. WesternGeco LLC*, IPR2015-00565, Paper 14 at 4-5 (PTAB Apr. 23, 2015) (granting joinder when both patent owner and previous petitioner opposed because it "facilitates scheduling of the joined actions and minimizes delay"); *Wockhardt Bio AG*, IPR2015-01813, Paper 10; *Mylan Pharms.*, IPR2015-00268, Paper 17; *Apple, Inc.*, CBM2015-00119, Paper 11; *Cisco Sys.*, IPR2015-01006, Paper 12.

And the Board's consistent reasoning is equally applicable here: the Petition that accompanies the present Motion for Joinder challenges the same claims at issue in the existing trial; relies on the same prior art as the existing trial; and relies on the same testimony from the same expert witness as in the existing trial. Thus,

in accordance with the Board’s previously applied rationale, joinder of these proceedings is appropriate and will “secure the just, speedy, and inexpensive resolution in every proceeding.” 37 C.F.R. § 42.1(b).

C. Joinder Will Have Minimal Impact on the Trial Schedule and Costs for the Existing IPR

Joinder will have no impact on the trial schedule and costs for the existing Apotex IPR by agreement between Apotex and Petitioners, as well as because Sun’s petition is substantially identical to the Apotex IPR and no new expert testimony or evidence is presented. Based on Petitioners’ review of the papers Apotex has submitted to date in the instant IPR, Petitioners’ substantive interests completely align with Apotex’s, and Petitioners’ foresee no substantive issues or arguments on which it would depart from Apotex’s submissions going forward.

To the extent that a modest schedule adjustment might be required—and Petitioners foresee no such need—Title 35 U.S.C. § 316(a)(11) allows the Director to “adjust the time periods ... in the case of joinder.” *See also*, 37 C.F.R. § 42.100(c). Accordingly, the Board has granted extensions in other trial schedules to accommodate joinder. *See Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2013-00250, Paper 24 at 5 (PTAB Sept. 3, 2013) (“while some adjustments to the schedule have been necessary, there is not undue delay.”); *see also Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 4-5 (PTAB Feb. 25, 2013);

Samsung Elec. Co., Ltd. v. Virginia Innovation Sci., Inc., IPR2014-00557, Paper 10 at 18 (PTAB June 13, 2014).

Finally, any alleged prejudice or burden to Novartis and Apotex—to the extent any exists at all—is outweighed by the public interest in obtaining a speedy and efficient resolution of all the patentability issues of the '405 patent in a single proceeding, with minimal burden on this Board.

D. Procedures to Simplify Briefing and Discovery

Because 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. *See Hyundai*, IPR2014-01543, Paper No. 11 at 5; *Dell*, IPR2013-00385, Paper No. 17 at 8-10; *Motorola*, IPR2013-00256, Paper 10 at 8-10. In those proceedings, the Board required the petitioners to make consolidated filings, for which the first petitioner was responsible, and allowed the new petitioner to file an additional seven-page paper addressing only points of disagreement with points asserted in the consolidated filing. *See Dell*, IPR2013-00385, Paper 17 at 11; *SAP Am.*, IPR2014-00306, Paper 13 at 5. The Board also permitted the patent owner to respond to any separate filing, limiting the page limit to that used in the separate filing. *See Dell*, IPR2013-00385, Paper 17 at 11; *SAP Am.*, IPR2014-00306, Paper 13 at 5. Adopting similar procedures in this case will minimize any delay that could arise from briefing submitted by each party, while at

the same time providing all parties an opportunity to be heard. *See Dell*, IPR2013-00385, Paper 17 at 8.

Moreover, as in the above cases, Sun will coordinate with Apotex regarding questioning at depositions and at the oral hearing, which will not exceed the time allotted by the rules for one party, or as otherwise agreed between Apotex and Patent Owner or as ordered by the Board. *See Dell*, IPR2013-00385, Paper 17 at 12; *SAP Am.*, IPR2014-00306, Paper 13 at 6.

V. CONCLUSION

For the foregoing reasons, Petitioners request that the Petition for IPR of the '405 patent be granted, and that the Board grant this Motion and join this proceeding with the Apotex IPR. Joinder will ensure a just, speedy, and inexpensive resolution in both proceedings, and it will promote efficiency by avoiding duplicative filings and reviews of the same issues.

Dated: August 16, 2017

Respectfully submitted,

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CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e))

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned hereby certifies that the above-captioned **MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)** was served via overnight courier (Federal Express) in its entirety on August 16, 2017, on the Patent Owner by serving the corresponding address of record for the '405 patent:

Novartis Pharmaceutical Corporation
Intellectual Property Department
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East Hanover, NJ 07936-1080

A courtesy copy of the foregoing was also served via email on the counsel of record for the Petitioner and Patent Owner in the Apotex IPR, IPR2017-00854 as follows:

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