

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INNOPHARMA LICENSING, INC., INNOPHARMA LICENSING LLC,  
INNOPHARMA INC., INNOPHARMA LLC,  
MYLAN PHARMACEUTICALS INC., and MYLAN INC.  
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD., BAUSCH & LOMB, INC., and  
BAUSCH & LOMB PHARMA HOLDINGS CORP.  
Patent Owner.

U.S. Patent No. 8,871,813 to Sawa *et al.*

Issue Date: October 28, 2014

Title: Aqueous Liquid Preparation Containing 2-Amino-3-(4-  
bromobenzoyl) Phenylacetic Acid

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*Inter Partes* Review No.: IPR2016-00090

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

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Patent Trial and Appeal Board

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## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

InnoPharma Licensing Inc., InnoPharma Licensing LLC, InnoPharma Inc., InnoPharma LLC, Mylan Pharmaceuticals Inc., and Mylan Inc. (collectively “InnoPharma”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,871,813 (“the ’813 Patent”) (“Petition”). Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), InnoPharma requests institution of an *inter partes* review and joinder with the *inter partes* review concerning the same patent in *Lupin Ltd. et al. v. Senju Pharmaceutical Co., Ltd.*, Case No. IPR2015-01105 (the “Lupin IPR”), which was instituted on October 27, 2015.

In accordance with the Board’s Representative Order identifying matters to be addressed in a motion for joinder (*Kyocera Corp. v. Softview LLC*, Paper No. 15, IPR2013-00004, April 24, 2013), InnoPharma submits that: (1) joinder is appropriate because it will promote efficient determination of the validity of the ’813 Patent without prejudice to Lupin Ltd. and Lupin Pharmaceuticals Inc. (collectively, “Lupin”) or Senju Pharmaceutical Co., Ltd., Bausch & Lomb, Inc., and Bausch & Lomb Pharma Holdings Corp. (collectively “Senju”); (2) InnoPharma’s Petition includes grounds that are essentially the same as the ground instituted in the Lupin IPR; (3) joinder would not affect the pending schedule in

the Lupin IPR nor increase the complexity of that proceeding, minimizing costs; and (4) InnoPharma is willing to agree to consolidated filings with Lupin to minimize burden and schedule impact.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of the date on which the Lupin IPR was instituted.

## **II. STATEMENT OF MATERIAL FACTS**

1. Senju Pharmaceutical, Co., Ltd., is the owner of the '813 Patent.
2. On November 3, 2014, Senju Pharmaceutical, Co., Ltd., et al. filed a complaint against InnoPharma for infringement of the '813 Patent (the "Underlying Litigation").
3. On April 23, 2015, Lupin filed its petition for *inter partes* review of claims 1-27 of the '813 Patent.
4. On October 27, 2015, a decision instituting *inter partes* review of claims 1-27 of the '813 Patent was entered in the Lupin IPR (Paper No. 9, IPR 2015-01105) on the grounds that claims 1-27 were unpatentable over U.S. Patent No. 5,891,913 ("the '913 patent" or "Sallmann 913") in view of U.S. Patent No. 4,910,225 ("Ogawa" or "the '225 patent") under 35 U.S.C. § 103.
5. Oral argument is currently set for June 6, 2016 in the Lupin IPR.

6. Concurrently with this Motion for Joinder, InnoPharma is filing a petition for *inter partes* review of claims 1-27 of the '813 Patent.

7. The Petition includes grounds that are essentially the same as the ground instituted in the Lupin IPR.

### **III. STATEMENT OF REASONS FOR RELIEF REQUESTED**

The Leahy-Smith America Invents Act ("AIA") permits joinder of like review proceedings, *e.g.*, an *inter partes* review ("IPR") may be joined with another *inter partes* review. 37 C.F.R. § 42.122(a). The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

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

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being "mindful that patent trial regulations, including the

rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of the present Petition with the Lupin IPR is appropriate.

“A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Id.* at 4. Each of these is addressed fully below.

**A. Joinder will not impact the Board's ability to complete the review in a timely manner**

Joinder in this case will not impact the Board's ability to complete its review in a timely manner. 35 U.S.C. § 316(a)(11) and associated rule 37 C.F.R. § 42.100(c) provide that *inter partes* review proceedings should be completed and the Board's final decision issued within one year of institution of the review. In this case, joinder will not affect the Board's ability to issue the decision because InnoPharma will be joining the grounds on which the Lupin IPR has been instituted.

Here, the Board has instituted the Lupin IPR with respect to Lupin's Ground 2, which relies on Sallmann 913 and Ogawa. Ground 1 of the InnoPharma's petition relies on Ogawa and U.S. Patent No. 6,107,343 ("Sallmann" or "Sallmann 343"). Sallmann 343 is based on a divisional application from Sallmann 913 and has the same relevant disclosure. Accordingly, InnoPharma's Ground 1 is essentially the same as the ground instituted in the Lupin IPR.<sup>1</sup>

In addition, InnoPharma respectfully proposes procedures to simplify any further briefing and discovery, which will minimize any potential impact on the schedule or the volume of materials to be submitted to the Board. For example, the petitioners to file consolidated filings, for which the first petitioner was responsible, and allowed the new petitioner to file seven additional pages with corresponding additional responsive pages allowed to the Patent Owner. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 8; *Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8-9. This procedure would minimize any complication or delay caused by joinder. The petitioners in this case can also work together to manage the questioning at depositions and presentations at the hearing to avoid redundancy. Additionally, while InnoPharma

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<sup>1</sup> The Board's Decision to Institute also references both U.S. Patent No. 6,274,609 ("Yasueda") and EP 0 306 984 ("Fu EP984"), which is a European patent publication that corresponds to Australian Patent No. AU-B-22042/88 ("Fu" or "Fu AU88"). *Lupin Ltd. et al. v. Senju Pharma. Co., Ltd.*, IPR2015-01105, Paper 9 at 8.



and Lupin have relied upon testimony from separate experts in their respective petitions, the conclusions and underlying reasoning of the experts are substantially congruent, and therefore present no additional burden on the part of the Patent Owners to address.

**B. Joinder will promote efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies**

InnoPharma would not be time barred from filing the present Petition without a corresponding motion for joinder. However, determining the same validity questions concerning the '813 patent in separate concurrent proceedings would duplicate efforts, and create a risk of inconsistent results and piecemeal review. Proceeding with a consolidated *inter partes* review would avoid inefficiency and potential inconsistency and would result in a final written decision without any delay.

**C. Joinder will not prejudice Senju or Lupin**

Permitting joinder will not prejudice Senju or Lupin. If joinder is granted, InnoPharma will be joining the grounds instituted in the Lupin IPR, thus the primarily issues will already be before the Board, such that joinder would not affect the timing of the Lupin IPR or the content of Senju's Patent Owner response due on January 4, 2016. Moreover, joinder will not affect the timing of the Lupin IPR, and any extension to the schedule that may be required is permitted by law and the applicable rules. 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.100(c). In fact,

joinder is likely more convenient and efficient for Senju by providing a single trial on the '813 patent. By allowing all grounds of invalidity to be addressed in a single proceeding, the interests of all parties and the Board will be well served.

#### **IV. CONCLUSION**

For the foregoing reasons, InnoPharma respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 8,871,813 be granted and that the proceedings be joined with *Lupin Ltd. and Lupin Pharmaceuticals Inc. v. Senju Pharmaceutical Co., Ltd.*, Case IPR2015-01105. Joinder will ensure a just, speedy and inexpensive resolution in both proceedings.

The Patent Trial and Appeal Board is hereby authorized to charge any additional fees associated with this filing to Deposit Account No. 160605 (Customer ID No. 00826).

RESPECTFULLY SUBMITTED,

ALSTON & BIRD LLP

Date: November 2, 2015

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**CERTIFICATION OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the 2<sup>nd</sup> day of November, a complete copy of the foregoing "MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 AND 42.122(b)" and all supporting exhibits were served via UPS® to the Patent Owner by serving the correspondence address of record for the '813 Patent:

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Courtesy copies of the foregoing were also served via UPS® on counsel of record for the Petitioner and Patent Owner in *Lupin Ltd. et al. v. Senju Pharmaceutical Co., Ltd.*, IPR2015-01105 as follows:

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InnoPharma's Motion for Joinder  
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