

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOPHARMA LICENSING, INC., INNOPHARMA LICENSING LLC,
INNOPHARMA INC., INNOPHARMA LLC, MYLAN
PHARMACEUTICALS INC., and MYLAN INC.,
Petitioner,
v.
SENJU PHARMACEUTICAL CO., LTD.,
Patent Owner.

Case IPR2016-00089 (Patent 8,754,131 B2)
Case IPR2016-00090 (Patent 8,871,813 B2)
Case IPR2016-00091 (Patent 8,927,606 B1)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

*Modifying Patent Owner's Time for
Filing an Opposition to the Motion for Joinder
37 C.F.R. §§ 42.5(c)(1); 42.25(a)(1)*

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in each proceeding. The parties are authorized to use this style heading when filing a single paper in multiple proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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During a telephone conference held on December 11, 2015, Patent Owner requested, and the Board granted, an extension of time for filing an opposition to the Motion for Joinder (Paper 3, “Motion”)² in each proceeding. Patent Owner shall file any opposition to the Motion concurrently with any Preliminary Response or Waiver of Preliminary Response filed in each proceeding. In the event that no Preliminary Response or Waiver of Preliminary Response is filed, the opposition shall be due on February 9, 2016, the statutory due date of the Preliminary Response.

Patent Owner retained a court reporter for the telephone conference. Patent Owner agreed to file, in due course, a transcript of the telephone conference as an exhibit in each proceeding. The reasons supporting Patent Owner’s request for an extension of time for filing the opposition to the Motion are reflected in that transcript, which shall serve as the official record of the telephone conference.

For completeness of the record, we attach to this Order copies of email communications that prompted the telephone conference. Attachments A, B, C, and D.

It is

ORDERED that Patent Owner shall file any opposition to the Motion for Joinder concurrently with any Preliminary Response or Waiver of Preliminary Response filed in each proceeding; and

² Paper numbers are identical in each proceeding.

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FURTHER ORDERED that, in the event that no Preliminary Response or Waiver of Preliminary Response is filed, Patent Owner's opposition to the Motion for Joinder in each proceeding shall be due on February 9, 2016, the statutory due date of the Preliminary Response.

PETITIONER:

Jitendra Malik
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Hidetada James Abe
james.abe@alston.com

Lance Soderstrom
lance.soderstrom@alston.com

PATENT OWNER:

Bryan C. Diner
bryan.diner@finnegan.com

Justin J. Hasford
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Joshua L. Goldberg
joshua.goldberg@finnegan.com

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ATTACHMENT A

Counsel: Please the first line of this e-mail should be IPR089 not IPR809.

Thank you,
Maria

From: Vignone, Maria **On Behalf Of** Trials
Sent: Wednesday, December 09, 2015 2:30 PM
To: Diner, Bryan; Trials
Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Dyellin@crowell.com; jlindsay@crowell.com; Hasford, Justin; Goldberg, Joshua; Ferrill, Elizabeth
Subject: RE: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Re:

IPR2015-00902 (IPR902)
IPR2015-00903 (IPR903)
IPR2015-01097 (IPR097)
IPR2015-01099 (IPR099)
IPR2015-01100 (IPR100)
IPR2015-01105 (IPR105)
IPR2015-01871 (IPR871)
IPR2016-00089 (IPR089)
IPR2016-00090 (IPR090)
IPR2016-00091 (IPR091)

Counsel:

Patent Owner's (Senju's) time for filing any opposition to InnoPharma's motions for joinder in IPR809, IPR090, and IPR091 is extended from December 11, 2015, to December 18, 2015.

The parties are requested to address the following matters during the telephone conference set for December 11, 2015, at 2 pm EST, pertaining to the alleged "agreed upon proposed schedule that would apply to all ten (10) IPRs" ("Proposed Global Schedule"). Email to Board from Mr. Bryan Diner ("Diner Email") (transmitted December 4, 2015).

1. IPR902 is not the subject of a motion for joinder. The panel shall not disturb the hearing date set in IPR902.
2. IPR903 is the subject of a motion for joinder filed in IPR871. Should the petition and motion for joinder be granted in IPR871, the joined proceeding in IPR903 shall proceed on the schedule currently set in IPR903. See IPR871 (Paper 10) (reflecting agreement to conditions of joinder

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that will not increase the complexity of IPR903 to a degree warranting a change in the schedule set in IPR903).

3. The parties should address the Proposed Global Schedule as it relates to the remaining seven (7) IPRs identified in the Diner Email, keeping in mind that the Board shall enter no schedule in any IPR before determining that the petition warrants institution.

4. Regarding the motions for joinder that are pending in IPR089, IPR090, and IPR091, please address the following issues: a) To facilitate our consideration of the motions, will InnoPharma agree to proceed in IPR097, IPR100, and IPR105 based only upon the arguments and evidence advanced by Lupin in those earlier-filed actions and accept a back-seat, “understudy” role in the joined proceedings, without any right to separate or additional briefing or discovery, much as Lupin has agreed in connection with the motion for joinder pending in IPR871 (see Paper 10); b) In the event that the petitions and joinder motions are granted, will Lupin permit InnoPharma to rely upon its declarant(s) in the joined proceedings.; and (c) in this scenario, would Senju oppose joinder.

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

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ATTACHMENT B

From: Diner, Bryan [<mailto:bryan.diner@finnegan.com>]
Sent: Tuesday, December 08, 2015 8:29 AM
To: Trials
Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Dyellin@crowell.com; jlindsay@crowell.com; Diner, Bryan; Hasford, Justin; Goldberg, Joshua; Ferrill, Elizabeth
Subject: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Subject: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Your Honors:

Patent Owner Senju's Oppositions to InnoPharma's Motions for Joinder in IPR2016-00089, IPR2016-00090, and IPR2016-00091 are currently due on Friday, December 11, 2015. The Board and the parties also are scheduled to discuss the global coordinated schedule in the above-mentioned IPRs, among others, on December 11, 2015. Should the Board eventually adopt the parties' proposed global coordinated schedule, then Senju would not need to file these Oppositions.

In view of the scheduled call with the Board, Patent Owner Senju requests a further extension of time to file its Oppositions until Friday, December 18 or until two business days after the Board rules on the parties' global coordination proposal. Petitioner InnoPharma does not oppose this request.

Respectfully,
Bryan Diner, Reg. No. 32,409
Lead Counsel for Patent Owner

Bryan C. Diner
Partner

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ATTACHMENT C

From: Diner, Bryan [<mailto:bryan.diner@finnegan.com>]

Sent: Friday, December 04, 2015 2:54 PM

To: Trials

Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Diner, Bryan; Goldberg, Joshua; Hasford, Justin; Holtman, Andy; Yellin, Deborah; Lindsay, Jonathan

Subject: IPR2015-00902, IPR2015-00903, IPR2015-01097, IPR2015-01099, IPR2015-01105, IPR2015-01100, IPR2015-01871, IPR2016-00089, IPR2016-00090, IPR2016-00091, - Request for a Conference Call

Subject: IPR2015-00902, IPR2015-00903, IPR2015-01097, IPR2015-01099, IPR2015-01105, IPR2015-01100, IPR2015-01871, IPR2016-00089, IPR2016-00090, IPR2016-00091, - Request for a Conference Call

Your Honors,

Further to the Order issued on November 18, 2015 in IPR2015-01871, InnoPharma, Lupin, and Senju have continued to meet and confer as requested by the Board and now present an agreed upon proposed schedule that would apply to all ten (10) IPRs listed above involving the five (5) different patents:

	Original Schedule for IPR2015- 01097; - 01099; - 01100; -01105	Proposal Coordinated Schedule for all 10 IPRs
Due Date 1: Patent owner's Response to the petition	Jan. 4, 2016	Feb. 1, 2016
Due Date 2: Petitioner's Reply to patent owner's response to petition	Mar. 10, 2016	March 28, 2016

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Due Date 3: Patent owner's Reply to petitioner's opposition to motion to amend	April 11, 2016	N/A
Due Date 4: Motion for observations regarding cross-examination of reply witness Motion to exclude evidence Request for Oral argument	May 2, 2016	May 6, 2016
Due Date 5: Response to observations Opposition to motion to exclude	May 16, 2016	May 18, 2016
Due Date 6: Reply to opposition to motion to exclude	May 23, 2016	May 25, 2016
Oral Argument (if requested)	June 6, 2016	June 6, 2016

Patent Owner Senju does not plan to file a Motion to Amend, therefore DUE DATE 3 does not apply.

Finally, due to a long standing family obligation of lead counsel, Senju respectfully requests that DUE DATE 7 (coordinated oral argument) be moved from Monday, June 6 to at least Thursday, June 9. Counsel for InnoPharma and Lupin do not oppose this request.

In view of the approaching due date for the Patent Owner Response in the IPR2015-00902 and IPR2015-00903, which is December 18, 2015, the parties respectfully request a conference call with the Board next week, if at all possible. To that end, all parties are available for conference call with the Board on Thursday, December 10, after 1:30 p.m. EST, or Friday, December 11, after 1:30 pm EST.

Respectfully,

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Bryan Diner

Bryan C. Diner

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ATTACHMENT D

Counsel: The Board grants Patent Owner's unopposed request for an extension of time, from Dec. 2, 2015, to Dec. 11, 2015, within which to file its Oppositions to the Motions for Joinder in these proceedings.

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

From: Goldberg, Joshua [<mailto:Joshua.Goldberg@finnegan.com>]
Sent: Tuesday, December 01, 2015 10:54 AM
To: Trials
Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Dyellin@crowell.com; jlindsay@crowell.com; Diner, Bryan; Hasford, Justin; Ferrill, Elizabeth
Subject: Unopposed Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Your Honors:

Further to the Board's Order of November 18 in IPR2015-01871, the parties have continued their discussions on the global consolidated schedule involving, among other IPRs, the above-mentioned cases. In each of the above cases, Petitioner InnoPharma has filed a Motion for Joinder. Patent Owner Senju's Oppositions to these motions are due on Wednesday, Dec. 2 for IPR2016-00090 and IPR2016-00091 and on Thursday, Dec. 3 for IPR2016-00089. Should the Board eventually adopt the parties' proposed global consolidated schedule, then Senju would not need to file these Oppositions.

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In view of the continued discussions on the global consolidated schedule, Patent Owner Senju respectfully requests an extension of the Patent Owner's deadline for filing its Oppositions to Friday, December 11, 2015. Petitioner InnoPharma does not oppose.

Respectfully,
Joshua L. Goldberg, Reg. No. 59,369
Backup Counsel for Patent Owner

Joshua L. Goldberg

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