

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PFIZER INC.,  
Petitioner,

v.

NOVO NORDISK A/S,  
Patent Owner

Case IPR2020-01252  
Patent No. 8,114,833B2

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

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
*Submitted Electronically via the PTAB E2E System*

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**I. STATEMENT OF PRECISE RELIEF REQUESTED**

Petitioner Pfizer Inc. (“Petitioner”) respectfully moves for joinder and/or consolidation of its today-filed petition for *Inter Partes* Review (“IPR”) of claims 1-31 of U.S. Patent No. 8,114,833 B2 (“the ’833 patent”) with a previously instituted and currently pending IPR, captioned *Mylan Institutional LLC. v. Novo Nordisk A/S*, No. IPR2020-00324 (the “Mylan IPR”).

The Mylan IPR was instituted on June 23, 2020, on the same patent and the same claims as Petitioner’s Petition (the “Petition”) filed today. Further, Petitioner here asserts that the same claims are anticipated and/or obvious over the same prior art based on the same arguments presented in the Mylan IPR.

As of the date of this motion, Mylan has consented to Petitioner’s request to join the Mylan IPR provided that joinder does not impact the timing for a final written decision in the Mylan IPR.

Joinder will not add any new substantive issues to the proceedings or otherwise cause any delay in the resolution of the Mylan IPR. Joinder, therefore, is appropriate because it will promote the efficient and consistent resolution of the same patentability issues with respect to the ’833 patent, it will not delay the Mylan IPR trial schedule, and the parties in the Mylan IPR will not be prejudiced.

Petitioner also agrees to abide by and adopt all of the actions and proceedings in the Mylan IPR that may occur prior to the Board reaching its decision on the instant Petition and motion for joinder.

## II. STATEMENT OF MATERIAL FACTS

1. Novo Nordisk A/S (“Patent Owner”) purportedly owns the ’833 patent.

2. Petitioner identifies the following previously completed litigation and *inter partes* review related to the ’833 patent:

- The ’833 patent was asserted in *Novo Nordisk Inc. et al. v. Teva Pharmaceuticals USA, Inc.*, No. 1:17-cv-00227 (D. Del.), and in *Novo Nordisk Inc. et al. v. Mylan Institutional LLC*, No. 1:19-cv-00164 (N.D.W. Va.).

3. Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ’833 patent. The following litigation or *inter partes* reviews related to the ’833 patent are pending:

- On June 23, 2020, the Board granted institution of *inter partes* review in the Mylan IPR. Mylan IPR, Paper 12.
- The ’833 patent has been asserted in *Novo Nordisk Inc. et al. v. Mylan Institutional LLC*, No. 1:19-cv-01551 (D. Del.), *Novo Nordisk Inc. et al. v. Sandoz, Inc.*, No. 1:20-cv-00747 (D. Del.), and *Novo Nordisk Inc. et al. v. Sandoz, Inc.*, No. 1:20-cv-06842 (D.N.J.).

4. The Board instituted the Mylan IPR on three grounds: (1) Claims 1-15 as anticipated under 35 U.S.C. § 102(b) by Flink; (2) Claims 1-15 as obvious under 35 U.S.C. § 103(a) over Flink; and (3) Claims 1-31 as obvious under 35 U.S.C. § 103(a) over Flink and Betz.

5. Along with its Motion for Joinder, Petitioner here has simultaneously filed a Petition for *Inter Partes* Review, No. IPR2020-01252, which argues, *inter alia*, that the same claims of the '833 patent are anticipated and/or obvious over the same grounds and for the same reasons set forth in the Mylan IPR. The Petition is also supported by the expert declaration of Dr. Laird Forrest, who is the same expert supporting the Mylan IPR. The opinions set forth in Dr. Forrest's declaration are identical to the opinions set forth in his declaration filed in the Mylan IPR (Mylan IPR Ex. 1002).

The grounds proposed in the present Petition are therefore the same grounds of unpatentability on which the Board instituted the Mylan IPR, and the Petition does not contain any additional arguments or evidence in support of the unpatentability of claims 1-31 of the '833 patent.

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

#### **A. Joinder is timely.**

Pursuant to 37 C.F.R. §§ 42.22, 42.122(b), this motion for joinder is timely because it is submitted within one month of the date the Mylan IPR was instituted.

The Mylan IPR was instituted on June 23, 2020, and this motion has been filed on July 22, 2020.

**B. Joinder is appropriate.**

**1. Legal standard.**

The Board has discretion to, and should, join Petitioner's IPR with the Mylan IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122; *Ariosa Diagnostics v. Isis Innovation Limited*, IPR-2013-00250, 2013 WL 6514079, at \*2 (P.T.A.B. Sept. 3, 2013). In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) new grounds of unpatentability asserted in the petition; (3) the impact (if any) joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Dell Inc. v Network-1 Security Solutions, Inc.*, Decision on Motion for Joinder, IPR2013-00385, Paper 17 at 4 (July 29, 2013); Board's Frequently Asked Questions, at H5 available at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. All of the foregoing factors here weigh in favor of joinder.

**2. Joinder is appropriate because both IPRs present exactly the same grounds and the same evidence of obviousness concerning the same claims.**

Joinder is appropriate here because the Petition asserts exactly the same grounds and relies on the same evidence for unpatentability that formed the basis for institution in the Mylan IPR. Specifically, the Petition relies on the same combinations of prior art references. The arguments in both petitions are the same,

and there are no new grounds of, or evidence supporting, unpatentability asserted in the Petition. Given that grounds are identical in both IPRs, the Board will need to decide the same issues—the Petition will not add any additional dimension to the substantive issues in the Mylan IPR. Also, Petitioner has relied upon the exact same expert testimony as Mylan in their respective petitions.

Since the parties will be presenting, and the Board will be determining, the same issues in both IPRs, joinder is the most efficient and economical manner to proceed. *See, e.g., Ariosa Diagnostics v. Isis Innovation Limited*, IPR2013-00250, 2013 WL 6514079, at \*1 (P.T.A.B. Sept. 3, 2013) (granting motion for joinder where the second petition involved the same parties, the same patent, and much of the same prior art).

### **3. Joinder will not impact the existing trial schedule.**

Joinder will not introduce any new prior art, expert opinions that substantially differ from those previously filed, or grounds of unpatentability into the Mylan IPR, so joining Petitioner's proceeding will not add any procedural complications or delay the progress of resolving the substantive issues already pending in the Mylan IPR. Petitioner will not request any alterations to the schedule in the Mylan IPR based on the requested joinder. Accordingly, joinder will not impact the trial schedule for existing review of the Mylan IPR or otherwise unfairly prejudice the Patent Owner. Additionally, Petitioner has informed the Mylan IPR petitioner that

it will coordinate with the Mylan IPR petitioner, and that it agrees to take an understudy role in these proceedings if joinder is granted.

**4. Joinder would simplify briefing and discovery.**

Since the prior art and grounds for unpatentability in the petitions in both this IPR and the Mylan IPR are the same, the same arguments will be made by both groups of petitioners. Without joinder, largely duplicative briefs and other papers would be filed in parallel IPRs. Joinder would thus eliminate duplicative proceedings and reduce the burdens on the Board and the parties.

Petitioner will coordinate with the Mylan IPR petitioner here to facilitate the elimination of repetitive briefs and testimony. Petitioner has also informed the Mylan IPR petitioner that Petitioner will maintain a secondary role in the proceeding, if joined. Petitioner will assume a primary role only if the Mylan IPR petitioner ceases to participate in the IPR. Petitioner's representations remove any potential "complication or delay" caused by joinder, while providing the parties an opportunity to address all issues that may arise and avoiding any undue burden on Patent Owner, the Mylan IPR petitioner, and the Board. *See, e.g., Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8-9 (P.T.A.B. June 20, 2013). Therefore, briefing and discovery would be significantly simplified if joinder were granted.



#### IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 8,114,833 and join this proceeding with *Mylan Institutional LLC v. Novo Nordisk A/S*, No. IPR2020-00324.

Dated: July 22, 2020

Respectfully submitted,

/Jovial Wong/  
Jovial Wong  
Reg. No. 60,115

## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, I certify that I caused to be served a true and correct copy of the foregoing: Motion for Joinder with Related Instituted *Inter Partes* Review of U.S. Patent 8,114,833 Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.112(b) by Federal Express Next Business Day Delivery on the Patent Owner's correspondence address of record for the subject patent as follows:

Novo Nordisk Inc.  
Intellectual Property Department  
800 Scudders Mill Road  
Plainsboro NJ 08536

and by email to the service addresses for Patent Owner listed in Paper No. 16 in IPR2020-00324:

joelke@fenwick.com  
ryan.johnson@fenwick.com  
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Novo833IPR@fenwick.com

Dated: July 22, 2020

Respectfully submitted,

/Jovial Wong/

Jovial Wong

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