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Paper 19
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENZYMOTEC LTD. and ENZYMOTEC USA, INC.
Petitioner

v.

NEPTUNE TECHNOLOGIES & BIORESROUCES, INC.
Patent Owner

Case IPR2014-00556
Patent 8,278,351

Before LORA M. GREEN, JACQUELINE WRIGHT BONILLA, and SHERIDAN K. SNEDDEN, *Administrative Patent Judges.*

SNEDDEN, *Administrative Patent Judge*.

DECISION
Enzymotec's Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Petitioners Enzymotec Ltd. and Enzymotec USA, Inc. (collectively, "Enzymotec") filed a Petition (Paper 1) ("Pet.") to institute an *inter partes* review of claims 1-6, 9, 12, 13, 19-29, 32, 35, 36, and 42-46 of Patent 8,278,351 (the "'351 patent") pursuant to 35 U.S.C. § 311–319, as well as a Motion for Joinder with Case IPR2014-00003 (Paper 4) ("Mot."). Patent Owner Neptune Technologies & Bioresrouces, Inc. ("Neptune") filed an Opposition to Enzymotec's Motion. IPR2014-00003, Paper 45 ("Opp."). Aker Biomarine AS ("Aker"), Petitioner in IPR2014-00003, did not file an opposition. Aker and Enzymotec jointly filed a stipulation as how the two Petitioners would cooperate in the joined proceeding, if joinder was granted. Paper 14. For the reasons that follow, Enzymotec's motion for joinder is *granted*.

II. DISCUSSION

A. Related Case IPR2014-00003

On October 1, 2013,Aker, which is a different Petitioner than the Petitioner in the instant proceeding (Enzymotec), filed a Petition to institute an *inter partes* review of claims 1-94 of the '351 patent, the same patent at issue in this case. IPR2014-00003, Paper 6. The parties in IPR2014-00003 filed a Joint Motion to Limit Petition to limit the petition to claims 1-6, 9, 12, 13, 19-29, 32, 35, 36, and 42-46 of the '351 patent. IPR2014-00003, Paper 18. Thereafter, this panel granted the Joint Motion to Limit Petition. IPR2014-00003, Paper 21. On March 24, 2014, we instituted *inter partes* review of claims 1-6, 9, 12, 13, 19-29, 32, 35, 36, and 42-46 of the '351 patent on two grounds—an anticipation and an obviousness ground. IPR2014-00003, Paper 22. In the previous case, we did not institute review of claims 2, 3, 25 and 26 based on an anticipation ground. IPR2014-00003,

Papers 22 and 45. In a Decision instituting *inter partes* review in the current case, decided concurrently with this Motion for Joinder, we grant the Petition with respect to Enzymotec's anticipation challenge of claims 2, 3, 25, and 26. All other grounds on which we institute trial in the instant proceeding are identical to those in which we instituted trial in IPR2014-00003.

In the current case, Enzymotec filed a Request for Joinder on April 4, 2014, within one-month of institution in IPR2014-00003, as set forth in 37 C.F.R. § 42.122(b). As Enzymotec concedes, absent joinder with the other proceeding, Enzymotec's Petition for *inter partes* review is barred under 35 U.S.C. § 315(b). Mot. 4.

B. Legal Framework

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA") permits the joinder of like proceedings. 35 U.S.C. § 315. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. Specifically, § 315(c) provides (emphasis added):

> JOINDER. – 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.

35 U.S.C. § 315(b) also establishes a one-year bar from the date of service of a complaint alleging infringement for requesting *inter partes* review, but specifies that the bar does not apply to a request for joinder under § 315(c). Section 315(b) reads (emphasis added):

> PATENT OWNER'S ACTION. – An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. *The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).*

The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including "the breadth or unusualness of the claim scope" and claim construction issues). When considering whether to grant a motion for joinder, the Board is 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* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). As such, any motion for joinder must be filed "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b).

As the moving party, Enzymotec has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15, 4 (Apr. 24, 2013); Frequently Asked Question H5 on the Board's website at http://www.uspto.gov/ip/boards/bpai/prps.jsp.

C. Analysis

Enzymotec asserts that joinder is appropriate because it will be unduly prejudiced if joinder is denied because its Petition is otherwise barred under § 315(b). Mot. 4-5. Enzymotec also contends neither Aker (petitioner in IPR2014-00003) nor Neptune (patent owner in both cases) will suffer prejudice if joinder is granted. *Id*. Enzymotec further asserts that its Petition presents the identical anticipation and obviousness grounds involving the same subset of claims of the '351 patent at issue in IPR2014-00003. *Id.* at 5. Enzymotec contends that, while its Petition additionally asserts that claims 2 and 25 are anticipated, this argument is based on the same evidence already of record in IPR2014-00003. *Id.*

Enzymotec asserts further that joinder would have little impact on the trial schedule in IPR2014-00003 because both Aker and Enzymotec will address the same prior art and using the same experts. *Id.* at 6, *see also* Paper 14 (stipulating how Petitioners Enzymotec and Aker will cooperate in the event of joinder). Enzymotec agrees to cooperate with Aker to simplify briefing and discovery, and will allow Aker to "take lead at depositions." *Id.* Thus, no additional depositions will be needed. According to Enzymotec, given the fact that joinder will require no change to the existing trial schedule and the fact that Enzymotec agrees to using the same experts and following Aker's lead in any depositions of those experts, the procedural impact of joinder on the existing proceeding will be minimal. *Id.* Enzymotec contends that this weighs in favor of joinder. *Id.*

Neptune opposes joinder on the basis that the Petition asserts an anticipation ground concerning claims 2, 3, 25, and 26 that would effectively allow Enzymotec to broaden the scope of IPR2014-00003, despite its filing of the Petition in the current case after the one-year limit under 35 U.S.C. § 315(b). Opp. 8-9.

As an initial matter, we note that § 315(b) expressly states that the one-year

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