

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIODELIVERY SCIENCES INTERNATIONAL, INC.,
Petitioner,

v.

RB PHARMACEUTICALS LIMITED,
Patent Owner.

Case IPR2014-00998
Patent 8,475,832 B2

Before TONI R. SCHEINER, JACQUELINE WRIGHT BONILLA, and
ZHENYU YANG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On August 26, 2014, a conference call was conducted between respective counsel for the parties and Judges Scheiner, Bonilla, and Yang. BioDelivery Sciences International, Inc. (“Petitioner”) was represented by counsel, Danielle Herritt. RB Pharmaceuticals Limited (“Patent Owner”) was represented by counsel, James Bollinger and Daniel Ladow. The purpose of the call was to: (1) conduct an initial conference call in related Case No. IPR2014-00325, involving the same parties, where Petitioner challenges the same claims of the ’832 patent at issue in this proceeding (*see* IPR2014-00325, Paper 21), and (2) discuss Petitioner’s request in this proceeding for authorization to file a motion for joinder of this case with IPR2014-00325.

As discussed during the call, joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief.¹ 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* Frequently Asked Question (“FAQ”) H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. We also pointed the parties to guidance in the following cases: *SAP America Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13; *Enzymotec Ltd. v. Neptune Techs. & Bioresrouces, Inc.*,

¹ During the call, Petitioner stated that its Petition in this proceeding is not time-barred under 35 U.S.C. § 315(b), and therefore, a joinder under 35 U.S.C. § 315(c) is not necessary for the Petition to avoid a time-bar under § 315(b).

IPR2014-00556, Paper 19; and *Sony Corp. of America v. Network-1 Security Solutions, Inc.*, IPR2013-00386, Paper 16.

During the call, we authorized Petitioner to file its Motion for Joinder, which Petitioner filed on August 29, 2014 (Paper 6). During the call, we also indicated to the parties that, while we have not considered the Petition or the Motion for Joinder in this case, the parties may wish to confer amongst themselves regarding a possible proposed schedule in the event that the two proceedings are joined. This could be beneficial to Patent Owner in the event that it does not oppose joinder, or would like to work out with Petitioner as how the schedule could be modified in IPR2014-00325, in the event that joinder occurs. We also authorized Patent Owner, if it so wishes, to file a 15-page opposition to Petitioner's Motion for Joinder by the due date for the filing of Patent Owner's preliminary response, i.e., October 1, 2014.

It is

ORDERED that the Petitioner is authorized to file a Motion for Joinder; and
FURTHER ORDERED that Patent Owner is authorized, if it so wishes, to
file a 15-page opposition to Petitioner's Motion for Joinder by October 1, 2014.

Case IPR2014-00998
Patent 8,475,832 B2

PETITIONER:

Danielle L. Herritt
McCarter & English, LLP
dherritt@mccarter.com

Kia L. Freeman
McCarter & English, LLP
kfreeman@mccarter.com

PATENT OWNER:

James M. Bollinger
Troutman Sanders LLP
james.bollinger@troutmansanders.com

Daniel A. Ladow
Troutman Sanders LLP
daniel.ladow@troutmansanders.com