

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METRICS, INC.
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD.
Patent Owner.

U.S. Patent No. 8,129,431 to Sawa *et al.*
Issue Date: March 6, 2012
Title: Aqueous Liquid Preparation Containing 2-Amino-3-(4-bromobenzoyl)
Phenylacetic Acid

Inter Partes Review No.: IPR2014-01041

**PETITIONER'S OPPOSITION TO INNOPHARMA'S MOTION FOR
JOINDER AND PROPOSED SCHEDULING ORDER FILED
IN IPR2015-00903**

I. RELIEF REQUESTED

Pursuant to the Board's Order of April 17, 2015 (*see* Paper 31), Petitioner Metrics, Inc. ("Metrics") submits this Opposition to InnoPharma Licensing Inc., InnoPharma Licensing LLC, InnoPharma Inc., InnoPharma LLC, Mylan Pharmaceuticals Inc., and Mylan Inc.'s (collectively, "InnoPharma") Motion for Joinder (*see* IPR2015-00903, Paper 0) ("Motion for Joinder") and Proposed Scheduling Order (*see* IPR2015-00903, Paper 9) ("Proposed Scheduling Order").

InnoPharma requests that the Board grant joinder of IPR2015-00903 with the currently instituted proceeding, and submits its Proposed Scheduling Order extending the current trial schedule. For the reasons set forth below, the Board should reject InnoPharma's Motion for Joinder because joining the schedules and granting joinder will unduly delay Metrics' already progressing instant proceeding and unduly prejudice Metrics. To the extent that the Board is inclined to grant InnoPharma's Motion for Joinder, either in whole or in-part, Metrics requests that the Board adjust and adopt the schedule proposed below in order to minimize the disruption to the instant proceeding and maintain the scheduled oral hearing in this instituted trial proceeding.

II. PROCEDURAL BACKGROUND

On June 26, 2014, Metrics filed an Abbreviated New Drug Application ("ANDA") with the Food and Drug Administration, including a Paragraph IV

Certification asserting, *inter alia*, that the claims of U.S. Patent No. 8,129,431 (“the ’431 Patent”) are invalid. The ’431 Patent is currently the subject of a patent infringement suit pending in the U.S. District Court for the District of New Jersey against Metrics which was filed by Patent Owner in response to Metrics’ ANDA filing. (See *Senju Pharmaceutical Co., Ltd., et al. v. Metrics, Inc., et al.*, C.A. No. 1:14-cv-03962-JBS-KMW (D.N.J.)). Metrics can receive final approval for its ANDA by showing that the ’431 Patent is invalid. In order to prove invalidity and secure final approval of its ANDA, Metrics filed its Petition for *Inter Partes Review* challenging each of the claims of the ’431 Patent on June 26, 2014. (See Papers 1, 6, and 9). On November 20, 2014, Patent Owner filed its Preliminary Response. (See Paper 13). The Board instituted trial in its Decision of February 19, 2015 (*see* Paper 19) and issued its Scheduling Order on the same day (*see* Paper 20) (“Scheduling Order”).

On March 19, 2015, InnoPharma filed its Petition for *Inter Partes Review* of the ’431 Patent in IPR2015-00903 (*see* IPR2015-00903, Paper 2), which was accompanied by its Motion for Joinder. By Order, Patent Owner’s Preliminary Response in InnoPharma’s proceeding is due May 26, 2015. (See Paper 31, 3). On May 19, 2015, InnoPharma, based on its request for joinder, filed its Proposed Scheduling Order to amend the current schedule in the instant proceeding, including delaying the oral hearing date from November 12, 2015 to January 21,

2016. (*See* IPR2015-00903, Paper 9, 4). Based on the current trial schedule,¹ Patent Owner's Response (Due Date 1) is due on June 26, 2015. The Parties are currently working on scheduling the deposition of Metrics' expert in the next three (3) weeks.

III. DISCUSSION

A. Metrics Will Be Prejudiced If The Board Grants Joinder Because Additional Expert Discovery Will Be Required

The instant proceeding is sufficiently advanced that permitting joinder with IPR2015-00903 proceeding will cause undue delay to Metrics because additional discovery will be required which will result in delaying the current trial schedule by at least two months, as shown in the Proposed Scheduling Order.² (*See* IPR2015-00903, Paper 9, 2-4). The additional discovery is necessitated because InnoPharma is relying on a different expert than the expert used by Metrics in the current proceeding. If joinder is granted, Patent Owner will seek to depose InnoPharma's expert as well as Metric's expert. The delay caused by this

¹ On April 23, 2015, the Parties filed a Notice of Stipulation Adjusting Due Dates 1 through 3 in the instant proceeding. (*See* Paper 33).

² At the hearing held on April 15, 2015, Patent Owner indicated its intention to seek a longer delay of the oral hearing date if the Board was inclined to grant joinder. (*See* Exhibit 2026, 16:14-21).

additional expert discovery will delay the ultimate resolution of the invalidity of the '431 Patent and thereby unduly delay the final approval of Metrics' ANDA and subsequent ability to enter the market. Because joinder of IPR2015-00903 with the current proceeding will not help "secure the just, speedy, and inexpensive resolution" of the issues in the current proceeding, the Board should exercise its discretion and deny InnoPharma's Motion for Joinder. (*See* 37 C.F.R. § 42.1(b)).

B. InnoPharma Filed Its IPR Within One-Year Of Being Sued For Infringement And Thus Is Not Time-Barred And Will Therefore Not Be Prejudice If Joinder Is Denied. In The Event That The Board Grants The Motion For Joinder, The Schedule Should Be Modified

A request for joinder pursuant to 35 U.S.C. § 315 affects certain deadlines under the AIA. Normally, a petitioner is barred from filing a petition for *inter partes* review more than one year after the petitioner is served with a complaint alleging infringement of a patent. (35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b)). Here, InnoPharma is not time-barred as its Petition for *Inter Partes* Review was filed well within the one-year statutory bar date. Accordingly, InnoPharma will not be prejudice if joinder is denied. To the extent that the Board is inclined to grant InnoPharma's Motion for Joinder, Metrics requests that the Board adjust the current schedule and adopt the schedule below in all four proceedings (IPR2014-01041, IPR2014-01043, IPR2015-00902, and IPR2015-00903). This schedule maintains the current oral argument date of November 26, 2015, avoiding ultimate

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