

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOCKHARDT BIO AG,
Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-01815
Patent 7,765,106 B2

Before JACQUELINE WRIGHT BONILLA, SUSAN L. C. MITCHELL, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner Wockhardt Bio AG (“Wockhardt”) filed a Petition requesting *inter partes* review of claims 1–8 of U.S. Patent No. 7,765,106 B2 (“the ’106 patent”). Paper 1 (“Petition” or “Pet.”). The Petition was accorded a filing date of August 27, 2015. Paper 5. Wockhardt also filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) requesting joinder of the present proceeding with *Anneal Pharms., LLC and Par Pharm., Inc. v. Jazz Pharms., Inc.*, Case IPR2015-00546. Paper 4 (“Mot.”). IPR2015-00546 also concerns claims 1–8 of the ’106 patent owned by Jazz Pharmaceuticals, Inc. (“Patent Owner”). We instituted trial in IPR2015-00546 on July 28, 2015, on a single ground of obviousness of claims 1–8 over the same “Advisory Committee Art” (Exs. 1003–1006) relied upon by Wockhardt in the instant Petition. IPR2015-00546, Paper 25. Wockhardt’s assertion of obviousness of claims 1–8 over the Advisory Committee Art in the Petition is the only ground on which Wockhardt seeks institution of *inter partes* review. Pet. 11. Wockhardt filed the Petition and Motion for Joinder in the present proceeding on August 27, 2015, within one month after we instituted trial in IPR2015-00546. 37 C.F.R. § 42.122(b).

II. DISCUSSION

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315. Section 315(c) provides, in relevant part, that “[i]f 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.” *Id.* When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential

simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

We convened a conference call on September 14, 2015, among counsel for Wockhardt, Amneal Pharmaceuticals (“Amneal”), Par Pharmaceutical, Inc. (“Par”), and Patent Owner. The subject of the conference call was a discussion of the conditions proposed by Wockhardt in its Motion for Joinder, requesting that we join the present proceeding with IPR2015-00546. We refer to the transcript of the conference call filed by counsel for Wockhardt for the details of the call and representations and agreements made by the parties. Ex. 1033.

Of particular relevance, we note that Wockhardt’s Petition is based only on the identical ground on which we instituted *inter partes* review in IPR2015-00546. Mot. 5. The Petition is based on “the same arguments, evidence, and ground of unpatentability” and is otherwise “identical to the instituted Amneal/Par IPR Petition.” *Id.*; Ex. 1033, 7:2–18. We further note that Wockhardt agreed to, *inter alia*, (i) “adopt any papers submitted by Amneal and Par in the joined IPR proceeding . . . including the testimony from the same expert witness(es) as in the instituted trial;” (ii) “not seek to submit any new expert declarations from those entered by Amneal and Par, except to the extent that . . . Wockhardt is precluded from relying on Amneal and Par’s experts’ declarations, *e.g.*, if Amneal and Par settle with Jazz and contractually bind their experts from continuing in the IPR with Wockhardt;” (iii) “not seek additional time at any deposition and that Amneal and Par will be permitted to ask questions before Wockhardt;” and (iv) “not seek any additional time at any oral argument.” Mot. 8–10. Patent Owner agreed that, if joinder were to be ordered on the conditions set forth in the Motion for Joinder, then Patent Owner would not oppose joinder and would waive filing a preliminary response to the Petition. Ex. 1033, 7:20–9:13. The parties also agreed that the

schedule in IPR2015-00546 would remain in place without requiring any extensions of time. *Id.* at 6:11–22, 8:8–12, 28:11–21.

At the conclusion of the conference call, we asked counsel for Wockhardt, Amneal, and Par to attempt to reach agreement on any remaining issues among them regarding joinder and to inform the Board no later than Friday September 18, 2015, whether agreement was reached, and whether any of the parties intended to file an opposition to Wockhardt’s Motion for Joinder by September 25, 2015. Ex. 1033, 34:12–35:14.

On September 18, 2015, we received an email from counsel for Wockhardt, on which counsel for Amneal, Par, and Patent Owner were copied, indicating there was agreement among Wockhardt, Amneal, and Par, and that none of the parties would oppose the Motion for Joinder based on the conditions proposed in Wockhardt’s Motion, as clarified and agreed during the conference call. In view of the foregoing, we find that joinder based upon the conditions stated by Wockhardt in its Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted ground. Discovery and briefing will be simplified if the two proceedings are joined. Therefore, there being no opposition to Wockhardt’s Motion for Joinder from any of the parties, the Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is

ORDERED that trial is instituted in IPR2015-001815 as to the obviousness of claims 1–8 of the ’106 patent over the Advisory Committee Art, the same ground on which we instituted trial in IPR2015-00546;

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FURTHER ORDERED that Wockhardt's Motion for Joinder with IPR2015-00546 is *granted*;

FURTHER ORDERED that IPR2015-01815 is terminated and joined to IPR2015-00546, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions stated in Wockhardt's Motion for Joinder (Paper 4) as clarified and agreed during the conference call of September 14, 2015 (Ex. 1033);

FURTHER ORDERED that the Scheduling Order in place for IPR2015-00546 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2015-00546;

FURTHER ORDERED that the case caption in IPR2015-00546 for all further submissions shall be changed to add Wockhardt as a named petitioner after Amneal and Par, and to indicate by footnote the joinder of IPR2015-01815 to that proceeding, as indicated in the attached form of caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2015-00546.

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