

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. and LUPIN PHARMACEUTICALS INC.,
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD.,
Patent Owner.

Case IPR2015-01871
Patent 8,129,431

Before ERICA A. FRANKLIN and GRACE KARAFFA OBERMANN,
Administrative Patent Judges.

OBERMANN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.54

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By email dated November 12, 2015, counsel for Petitioner (“Lupin”) requested a conference call with the Board to discuss Petitioner’s “motion seeking joinder with IPR2015-00903” (“IPR 903”). Appendix (“Email Request”). That Motion for Joinder was filed in this proceeding on September 9, 2015. *See* Paper 3 (“Joinder Mot.”). IPR 903 involves the same patent challenged here, namely, U.S. Patent No. 8,129,431. IPR 903, Paper 15. The Petition in IPR 903, however, was filed by a different entity (“InnoPharma”). *Id.* We instituted trial in IPR 903 on August 7, 2015. *Id.*

The Email Request also refers to ten (10) “related IPR proceedings” involving Senju as Patent Owner and Lupin or InnoPharma as Petitioner. Appendix (listing ten (10) IPRs involving five (5) different patents). The Email Request conveys that “[t]he parties have met and conferred, including with regard to a proposed global schedule applicable to all of the related IPR proceedings . . . and all now believe a call with the Board is appropriate.” Appendix.

In response to the Email Request, the Board (Judges Franklin and Obermann) conducted a conference call on November 17, 2015. Petitioner was represented by Ms. Deborah Yellin. Patent Owner was represented by Mr. Bryan Diner. InnoPharma was represented by Mr. Jitendra Malik.

A. Proposed Global Schedule Relating to Ten IPRs

The Board and counsel for the respective parties discussed the “proposed global schedule” relating to ten (10) IPRs identified in the Email Request. Appendix. During the course of the discussion, it became apparent that no agreement has been reached among the parties as to the terms of a “proposed global schedule,” and that our involvement at this stage, as to such a schedule, is premature. Appendix. For example, InnoPharma represented that it had received information regarding a “proposed global schedule” only last Thursday, and was

unprepared to discuss it. *Id.* In particular, counsel for InnoPharma argued that more time was needed for InnoPharma and Lupin to confer regarding their respective roles, and the content of the evidence, in any consolidated proceeding involving all ten (10) IPRs identified in the Email Request.

We determined that it was premature to entertain a request for a global schedule relating to the ten (10) IPRs identified in the Email Request. We encouraged all three parties (Lupin, InnoPharma, and Senju) to continue to meet and confer in an effort to clarify their positions as to any proposed global schedule, prior to seeking the Board’s involvement on that issue. Upon questioning from Senju’s counsel, we explained that the Board is not inclined to extend the schedule set in IPR 903, the earliest-filed of the ten (10) IPRs identified in the Email Request, unless we are directed to compelling reasons for doing so.

B. The Motion for Joinder Limited to the Instant Case and IPR 903

The Motion for Joinder solely relates to the instant case and IPR 903. In the Motion for Joinder, Lupin acknowledges that it and InnoPharma “have relied upon testimony from separate experts.” Joinder Mot. 6. Lupin avers, however, that, “in order to further simplify the proceeding, Lupin will rely on the same expert as InnoPharma” in a consolidated proceeding, “should InnoPharma permit it.” *Id.* at 7.

During the course of the telephone conference, Lupin clarified its position regarding the Motion for Joinder. These facts became apparent: InnoPharma and Lupin have reached an agreement, regarding their respective roles and the content of the evidence, should the Board grant the Motion for Joinder. In particular, InnoPharma agrees to permit Lupin to rely on the declaration of InnoPharma’s witness, Dr. Laskar, filed in support of InnoPharma’s Petition in IPR 903. Lupin agrees to accept a back-seat role as an “understudy” in any consolidated

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proceeding, without any right to separate briefing or discovery in IPR 903. To the extent that the instant Petition differs from the Petition filed in IPR 903, Lupin agrees to withdraw all additional arguments in its Petition, as well as its supporting declaration of Dr. Lawrence, and proceed in IPR 903 based on the arguments and evidence provided by InnoPharma in the Petition filed in IPR 903. Lupin agrees to assume a primary role in IPR 903 only if InnoPharma ceases to participate in IPR 903. In other words, via the Motion for Joinder, Lupin requests permission to be added to the case caption as a Petitioner in IPR 903, without any active participation or involvement that is separate from InnoPharma, unless authorized by the Board upon a request pertaining to an issue unique to Lupin alone.

The Board several times requested counsel for Senju to address what additional burdens Senju would bear, should joinder be granted on the above terms agreed to between InnoPharma and Lupin. Counsel for Senju referred to Lupin's alleged delay in filing the instant Petition, given that others, including InnoPharma, had submitted earlier-filed Petitions; advocated that consolidation of all ten (10) IPRs identified in the Email Request would foster consistency and efficiency, while opposing joinder of the first two (2) IPRs identified in that Email Request; averred that extending the statutory due date of a final decision in IPR 903, so that all of the ten (10) IPRs identified in the Email Request can be decided simultaneously, would permit the parties to focus on a trial presently set for April, 2016, in co-pending district court litigation that involves issues similar to those presented here; and argued that the ability of Lupin to request Board pre-authorization to provide separate argument or evidence in IPR 903, on issues unique to Lupin alone, is vague and presents uncertainties that may burden Senju.

C. Conclusions Reached During the Telephone Conference

The parties indicated, and we approved, a plan to continue to “meet and confer” as to a proposed global schedule that would apply to all ten (10) IPRs identified in the Email Request. *See* Appendix (listing ten (10) IPRs involving five (5) different patents). We reminded Senju that any Preliminary Response filed in the instant case may be waived or filed early; and that, if filed, the Preliminary Response should address the arguments and evidence raised in the instant Petition. We shall resolve the Motion for Joinder in due course, when the record is ripe for decision on whether the instant Petition “warrants the institution of an inter partes review.” 35 U.S.C. § 315(c) (the Board will reach the merits of a joinder motion only after a determination is made that the petition accompanying the motion warrants institution of review).

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