

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 IPR2015-01097 (Patent 8,754,131 B2)
Case IPR2015-01099 (Patent 8,669,290 B2)
Case IPR2015-01100 (Patent 8,927,606 B1)
Case IPR2015-01105 (Patent 8,871,813 B2)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Modifying Due Date 7 of the Scheduling Order
37 C.F.R. § 42.5(c)(1)

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in each proceeding. The parties are authorized to use this style heading when filing a single paper in multiple proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

IPR2015-01097 (Patent 8,754,131 B2)
IPR2015-01099 (Patent 8,669,290 B2)
IPR2015-01100 (Patent 8,927,606 B1)
IPR2015-01105 (Patent 8,871,813 B2)

During a telephone conference held on December 11, 2015, Patent Owner requested a modification of Due Date 7, the date set for final hearing in each proceeding. *See* Paper 10² (Scheduling Order, setting Due Date 7 as June 6, 2016). We granted that request and changed Due Date 7, the date for final hearing, if requested and granted, from June 6, 2016, to June 9, 2016.

Patent Owner retained a court reporter for the telephone conference. Patent Owner agreed to file, in due course, the transcript of the telephone conference as an exhibit in each proceeding. The reasons supporting Patent Owner's request for a modification of Due Date 7 are reflected in that transcript, which shall serve as the official record of the telephone conference.

For completeness of the record, we attach to this Order copies of email communications that prompted the telephone conference. Attachments A, B, C, and D.

It is

ORDERED that Due Date 7 set in the Scheduling Order (Paper 10) is changed in each proceeding from June 6, 2016, to June 9, 2016.

² Paper numbers are identical in each proceeding.

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ATTACHMENT A

Counsel: Please the first line of this e-mail should be IPR089 not IPR809.
Thank you,
Maria

From: Vignone, Maria **On Behalf Of** Trials
Sent: Wednesday, December 09, 2015 2:30 PM
To: Diner, Bryan; Trials
Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Dyellin@crowell.com; jlindsay@crowell.com; Hasford, Justin; Goldberg, Joshua; Ferrill, Elizabeth
Subject: RE: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Re:
IPR2015-00902 (IPR902)
IPR2015-00903 (IPR903)
IPR2015-01097 (IPR097)
IPR2015-01099 (IPR099)
IPR2015-01100 (IPR100)
IPR2015-01105 (IPR105)
IPR2015-01871 (IPR871)
IPR2016-00089 (IPR089)
IPR2016-00090 (IPR090)
IPR2016-00091 (IPR091)

Counsel:

Patent Owner's (Senju's) time for filing any opposition to InnoPharma's motions for joinder in IPR809, IPR900, and IPR091 is extended from December 11, 2015, to December 18, 2015.

The parties are requested to address the following matters during the telephone conference set for December 11, 2015, at 2 pm EST, pertaining to the alleged "agreed upon proposed schedule that would apply to all ten (10) IPRs" ("Proposed Global Schedule"). Email to Board from Mr. Bryan Diner ("Diner Email") (transmitted December 4, 2015).

1. IPR902 is not the subject of a motion for joinder. The panel shall not disturb the hearing date set in IPR902.
2. IPR903 is the subject of a motion for joinder filed in IPR871. Should the petition and motion for joinder be granted in IPR871, the joined proceeding in IPR903 shall proceed on the schedule currently set in IPR903. See IPR871 (Paper 10) (reflecting agreement to conditions of joinder

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that will not increase the complexity of IPR903 to a degree warranting a change in the schedule set in IPR903).

3. The parties should address the Proposed Global Schedule as it relates to the remaining seven (7) IPRs identified in the Diner Email, keeping in mind that the Board shall enter no schedule in any IPR before determining that the petition warrants institution.

4. Regarding the motions for joinder that are pending in IPR089, IPR090, and IPR091, please address the following issues: a) To facilitate our consideration of the motions, will InnoPharma agree to proceed in IPR097, IPR100, and IPR105 based only upon the arguments and evidence advanced by Lupin in those earlier-filed actions and accept a back-seat, “understudy” role in the joined proceedings, without any right to separate or additional briefing or discovery, much as Lupin has agreed in connection with the motion for joinder pending in IPR871 (*see* Paper 10); b) In the event that the petitions and joinder motions are granted, will Lupin permit InnoPharma to rely upon its declarant(s) in the joined proceedings.; and (c) in this scenario, would Senju oppose joinder.

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

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