

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. and LUPIN PHARMACEUTICALS INC.

Petitioners

v.

SENJU PHARMACEUTICAL CO., LTD.

Patent Owner

IPR2015-01871
Patent 8,129,431

OPPOSITION TO MOTION FOR JOINDER

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I. PRELIMINARY STATEMENT OF RELIEF REQUESTED

Patent Owner Senju opposes the motion for joinder submitted by the Lupin Petitioners (“Lupin”), which presents new claim construction positions and new evidence, including a new declaration, that would require burdensome additional discovery and expert testimony, unduly prejudicing Senju and unduly burdening the Board. In the alternative, should the Board grant joinder, the Board should exercise its discretion under 35 U.S.C. § 316(a)(11) and extend the schedule in the joined proceedings to account for the additional complexity in these proceedings.

In December 2013, Lupin sent a Notice Letter informing Senju that Lupin had filed an Abbreviated New Drug Application (“ANDA”) with a Paragraph IV Certification challenging Senju’s U.S. Patent No. 8,129,431 (“the ’431 patent”). The ’431 patent covers the highly successful drug Prolensa[®] for treatment of pain and inflammation in patients undergoing cataract surgery. (EX2001.) Senju sued Lupin for infringement of the ’431 patent on January 31, 2014, and the waiver of service of summons was filed on February 21, 2014. (EX2002; EX2003.)

Lupin then sat by and watched while other companies initiated IPRs challenging the ’431 patent. Metrics, Inc. (“Metrics”) initiated IPR2014-01041 challenging the ’431 patent (“the Metrics IPR”) on June 26, 2014. *Metrics, Inc. v. Senju Pharm. Co., Ltd.*, IPR2014-01041, Paper 1. A group of InnoPharma petitioners (“InnoPharma”) then initiated IPR2015-00903 challenging the ’431

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