

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOPHARMA LICENSING, INC., INNOPHARMA LICENSING LLC,
INNOPHARMA INC., INNOPHARMA LLC, MYLAN PHARMACEUTICALS
INC., and MYLAN INC.
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD.
Patent Owner.

Case IPR2016-00090 (Patent 8,871,813)

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

I. PRELIMINARY STATEMENT OF RELIEF REQUESTED

Patent Owner Senju opposes the motion for joinder submitted on November 2, 2015, by the InnoPharma petitioners (“InnoPharma”) concurrently with its corresponding IPR petition on USP 8,871,813. *InnoPharma Licensing, Inc. v. Senju Pharm. Co., Ltd.*, IPR2015-00090 at Paper 3. The ’813 patent represents one of five patents-in-suit between Senju and InnoPharma, as well as Lupin in parallel District Court proceedings, of which the Board is well aware. The ’813 patent was issued before InnoPharma was sued in District Court by Senju *et al.* and long before InnoPharma filed two other IPRs on two other patents-in-suit. *See* IPR2015-00902; IPR2015-00903. Allowing InnoPharma to join Lupin’s instituted IPR2015-01105 on the ’813 patent (“the Lupin IPR”) would unduly prejudice Senju with piecemeal filings of IPRs designed by InnoPharma to harass Senju. This is particularly true given that InnoPharma has deliberately delayed and staggered its filing of this and two other IPRs, IPR2015-00089 and IPR2015-00091, and has also dragged its feet in pursuing a potential resolution on the joinder issue to the point where it no longer makes sense to join them. In fairness, InnoPharma’s petition should independently go forward or not based the Board’s consideration of that petition in light of Senju’s Preliminary Response. Indeed, joining InnoPharma would not only prejudice Senju, but also condone InnoPharma’s intentional gaming of the system solely to harass Senju.

InnoPharma will argue that it just recently submitted, after almost three months of delay and at the eleventh hour, an email to the Board agreeing to “accept a back-seat, ‘understudy’ role in the joined proceedings.” (Ex. 2007.) But InnoPharma has not actually implemented what it says it agrees to do. Moreover, the lack of specificity in InnoPharma’s “back-seat role” email just creates more questions than it answers, including additional pages for briefing, procedures for conducting depositions, or contingencies in the event of settlement by Lupin. For example, InnoPharma says that it will cease to take a back-seat role should Lupin drop out of the proceedings. What InnoPharma does not address is, if that contingency were to occur, whether InnoPharma would go forward with Lupin’s position and Lupin’s expert or instead seek to resurrect its own positions and its expert who opined on those positions. Shortly before InnoPharma sent its belated “back-seat role” email to the Board, Senju specifically asked InnoPharma to provide its basis for reaching a potential resolution on joinder. InnoPharma ignored Senju’s request and sent its “back-seat role” email to the Board instead.

At this late stage of this phase of the proceeding, InnoPharma’s gamemanship just further prejudices Senju from focusing on the tasks at hand, including preparing for depositions of Lupin’s expert and filing a Patent Owner’s Response in IPR2015-01105, as well as preparing for the upcoming trial in the District Court proceeding. Senju therefore respectfully requests that InnoPharma’s

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motion for joinder be denied and that this proceeding independently move to the Board's combined consideration of InnoPharma's petition and Senju's Preliminary Response on the question of institution.

II. BACKGROUND

In November 2014, Senju sued InnoPharma for infringement of the '813 patent; InnoPharma filed its Answer on January 23, 2015. (Ex. 2002; Ex. 2003.) The '813 patent claims, among other things, formulations of bromfenac for ophthalmic administration, sold under the name Prolensa[®], specifically for treatment of pain and inflammation in patients undergoing cataract surgery. (Ex. 2002 at ¶¶ 18-20.) The '813 patent is related to four other patents also directed to formulation of bromfenac—all five of which are involved in IPR proceedings. In March 2015, InnoPharma filed two IPRs against Senju's U.S. Patent No. 8,129,431 (IPR2015-00903) and Senju's U.S. Patent No. 8,669,290 (IPR2015-00902). Lupin later filed for review of the '431 patent (IPR2015-01871, which is now joined with the -00902 proceeding) and the '290 patent (IPR2015-01099).

A. InnoPharma's IPR challenges of Senju's related patents are a piecemeal approach designed to harass Senju.

After filing its first two petitions, InnoPharma sat by and watched while its competitor Lupin initiated an IPR challenging the '813 patent ("the Lupin IPR") on two grounds. IPR2015-01105, Paper 1 (filed April 23, 2015). Lupin also filed challenges against two other members of this patent family, U.S. Patent No.

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8,754,131 (subject of the Lupin’s IPR2015-01097) and U.S. Patent No. 8,927,606 (subject of Lupin’s IPR2015-01100). The Board instituted the Lupin IPR on October 27, 2015, on a single ground of unpatentability. IPR2015-01105, Paper 9 at 16.

But InnoPharma waited in the wings nearly a full year, until after the Lupin IPR was instituted, to initiate its own IPR challenging the ’813 patent (“the InnoPharma IPR”) and request joinder with the Lupin IPR.¹ IPR2016-00090, Paper 3. Despite having access to the Board’s Institution Decision in the Lupin IPR, InnoPharma did not file a “copycat” petition, as petitioners often do in connection with a request for joinder with an instituted petition. Instead, InnoPharma relied on three grounds that were worded differently than Lupin’s two grounds, but in fact relied on the same prior art. InnoPharma also complicated matters by relying on a different expert, Dr. Paul Laskar.

B. InnoPharma made overtures toward working on a plan to join the Lupin IPR, but did not follow the Board’s advice from December 11.

Shortly after InnoPharma filed its motion for joinder, the parties discussed a consolidated schedule including potential schedule extensions to accommodate the newly-filed, second round of InnoPharma IPRs. But, in the December 9, 2015, email from the Board and in the Board’s December 11 Conference Call with the

¹ InnoPharma also filed IPRs challenging the ’131 patent and the ’606 patent.

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