

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 IPR2016-00089 (Patent 8,754,131 B2)
Case IPR2016-00090 (Patent 8,871,813 B2)
Case IPR2016-00091 (Patent 8,927,606 B1)¹

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

OBERMANN, *Administrative Patent Judge*.

ORDER

*Modifying Patent Owner's Time for
Filing an Opposition to the Motion for Joinder
37 C.F.R. §§ 42.5(c)(1); 42.25(a)(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.”

IPR2016-00089 (Patent 8,754,131 B2)
IPR2016-00090 (Patent 8,871,813 B2)
IPR2016-00091 (Patent 8,927,606 B1)

During a telephone conference held on December 11, 2015, Patent Owner requested, and the Board granted, an extension of time for filing an opposition to the Motion for Joinder (Paper 3, “Motion”)² in each proceeding. Patent Owner shall file any opposition to the Motion concurrently with any Preliminary Response or Waiver of Preliminary Response filed in each proceeding. In the event that no Preliminary Response or Waiver of Preliminary Response is filed, the opposition shall be due on February 9, 2016, the statutory due date of the Preliminary Response.

Patent Owner retained a court reporter for the telephone conference. Patent Owner agreed to file, in due course, a transcript of the telephone conference as an exhibit in each proceeding. The reasons supporting Patent Owner’s request for an extension of time for filing the opposition to the Motion 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 Patent Owner shall file any opposition to the Motion for Joinder concurrently with any Preliminary Response or Waiver of Preliminary Response filed in each proceeding; and

² Paper numbers are identical in each proceeding.

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FURTHER ORDERED that, in the event that no Preliminary Response or Waiver of Preliminary Response is filed, Patent Owner's opposition to the Motion for Joinder in each proceeding shall be due on February 9, 2016, the statutory due date of the Preliminary Response.

PETITIONER:

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PATENT OWNER:

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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, IPR090, 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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