

Vignone, Maria

From: Malik, Jitty <Jitty.Malik@alston.com>
Sent: Thursday, February 04, 2016 7:34 AM
To: Trials
Cc: Skelton, Bryan; Soderstrom, Lance; Dyellin@crowell.com; jlindsay@crowell.com; Hasford, Justin; Goldberg, Joshua; Ferrill, Elizabeth; Mukerjee, Deepto; Diner, Bryan
Subject: Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Dear PTAB:

I am counsel for Petitioners InnoPharma *et al.* in IPR2016-00089, IPR2016-00090, and IPR2016-00091. In connection with those IPRs, InnoPharma has filed motions to join IPR2015-01099, IPR2015-01100 and IPR2015-01105, filed by Lupin. Following the conference with the Board (see email correspondence below), the parties have continued to discuss issues related to joinder.

In connection with those continuing discussions, and in the interests of facilitating joinder, InnoPharma will agree to proceed in IPR2015-01097, IPR2015-01100, and IPR2015-01105 based only upon the arguments and evidence advanced by Lupin in its earlier-filed actions and accept a back-seat, "understudy" role in those joined proceedings, without any right to separate or additional briefing or discovery, unless authorized by the Board upon a request to address an issue that is unique to InnoPharma. Only if Lupin drops out of the proceedings for any reason, will InnoPharma cease its understudy role. The conditions are the same as to what Lupin agreed to in connection with its corresponding motion for joinder to join InnoPharma's IPR (IPR2015-00903), which the Board granted. *See, e.g.*, IPR2015-0187 (Paper 13). Moreover, InnoPharma has contacted Lupin, and Lupin has agreed to permit InnoPharma to rely upon its declarant (Dr. Lawrence) in the joined proceedings.

InnoPharma is available to have a conference with the Board should the Board have any other questions or concerns.

Counsel for Patent Owner and Lupin have been copied on this email.

Respectively,

Jitty Malik
Lead Counsel for Petitioner InnoPharma *et al.*

JITENDRA "JITTY" MALIK PH.D. | PARTNER | ALSTON + BIRD LLP

4721 Emperor Boulevard, Suite 400

Durham, North Carolina 27703-8580

Direct: (919) 862-2210; Fax: (919) 862-2260

jitty.malik@alston.com | www.alston.com

Atlanta | Charlotte | Dallas | Research Triangle | New York | Los Angeles | Palo Alto | Washington, DC

From: Vignone, Maria [mailto:Maria.Vignone@USPTO.GOV] **On Behalf Of** Trials

Sent: Wednesday, December 9, 2015 2:20 PM

To: Diner, Bryan; Trials

Cc: Malik, Jitty; Skelton, Bryan; 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 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

From: Diner, Bryan [<mailto:bryan.diner@finnegan.com>]

Sent: Tuesday, December 08, 2015 8:29 AM

To: Trials

Cc: Malik, Jitty; EXT- bryan.skelton@alston.com; Soderstrom, Lance; Dyellin@crowell.com; [jlindsay@crowell.com](mailto:jilindsay@crowell.com); Diner, Bryan; Hansford, Justin; Goldberg, Joshua; Ferrill, Elizabeth

Subject: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Subject: Unopposed Second Request for Extension of Time to File Oppositions to Motion for Joinder (IPR2016-00089; IPR2016-00090; IPR2016-00091)

Your Honors:

Patent Owner Senju's Oppositions to InnoPharma's Motions for Joinder in IPR2016-00089, IPR2016-00090, and IPR2016-00091 are currently due on Friday, December 11, 2015. The Board and the parties also are scheduled to discuss the global coordinated schedule in the above-mentioned IPRs, among others, on December 11, 2015. Should the Board eventually adopt the parties' proposed global coordinated schedule, then Senju would not need to file these Oppositions.

In view of the scheduled call with the Board, Patent Owner Senju requests a further extension of time to file its Oppositions until Friday, December 18 or until two business days after the Board rules on the parties' global coordination proposal. Petitioner InnoPharma does not oppose this request.

Respectfully,

Bryan Diner, Reg. No. 32,409

Lead Counsel for Patent Owner

Bryan C. Diner

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

901 New York Avenue, NW, Washington, DC 20001-4413

202.408.4116 | fax: 202.408.4400 | bryan.diner@finnegan.com | www.finnegan.com

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

NOTICE: This e-mail message and all attachments may contain legally privileged and confidential information intended solely for the use of the addressee. If you are not the intended recipient, you are hereby notified that you may not read, copy, distribute or otherwise use this message or its attachments. If you have received this message in error, please notify the sender by email and delete all copies of the message immediately.