

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUROBINDO PHARMA U.S.A. INC.,
Petitioner,

v.

ASTRAZENECA AB,
Patent Owner.

Case IPR2016-01117
Patent RE44,186 E

Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

DECISION
Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.222

Petitioner, Aurobindo Pharma USA, Inc. (“Aurobindo”), filed a Petition requesting *inter partes* review of claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 (the “challenged claims”) of U.S. Patent No. RE44,186 E (Ex. 1001, “the ’186 patent”) (Paper 1, “Pet.”). Concurrently with its Petition, Aurobindo filed a Motion for Joinder (Paper 3, “Mot.”), seeking to consolidate this case, under 35 U.S.C. § 315(c), with the *inter partes* review in *Mylan Pharms., Inc. v. AstraZeneca AB, LLC*, Case IPR2015-01340 (“the Mylan IPR” and Petitioner “Mylan”), which was instituted on May 2, 2016. *See* IPR2015-01340 (Paper 16, 34–35) (rehearing decision instituting review of claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 of the ’186 patent).

Patent Owner AstraZeneca AB (“AstraZeneca”) filed a preliminary response in the present proceeding (Paper 11), and an Opposition to Aurobindo’s Motion for Joinder. Paper 8 (“Opp.”).

For the reasons set forth below, we conclude that Aurobindo has shown that the Petition warrants institution of *inter partes* review of claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 of the ’186 patent. This conclusion is consistent with our institution decision in the Mylan IPR. *See* IPR2015-01340, Paper 16, 34–35. Further, we grant Aurobindo’s Motion for Joinder and exercise our discretion to join Aurobindo as a Petitioner to the Mylan IPR. We further terminate the present proceeding, IPR2016-01117.

I. PETITION FOR *INTER PARTES* REVIEW

Aurobindo indicates that the ’186 patent is the subject of numerous district court cases filed in the U.S. District Court for the District of Delaware. Pet. 17. In addition, the ’186 patent is the subject of pending

inter partes review proceedings, including IPR2016-1029, IPR2016-01122, and IPR2016-01104. The '186 patent also was the subject of the Mylan IPR, as noted above.

In the Mylan IPR, we instituted *inter partes* review of claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 of the '186 patent on the same grounds of unpatentability asserted in the present Petition, reproduced below. Pet 18; Mot. 6–7; IPR2015-01340, Paper 16, 34–35.

Ground	35 U.S.C. Section (pre-3/16/2013)	Claims	Index of References
1	103(a)	1, 2, 4, 6-11, 25-28, 32-35, 39, and 40	Ashworth, Villhauer, Raag and Hanessian
2	103(a)	12-16, 29, 30, 36, 37, 41 and 42	Ashworth, Villhauer, Raag, Hanessian, Bachovchin, and Glucophage® Label
3	103(a)	12, 17, 18, and 22	Ashworth, Villhauer, Raag, Hanessian, Bachovchin, and Xenical® Label
4	103(a)	12, 19, 20, and 21	Ashworth, Villhauer, Raag, Hanessian, Bachovchin, and Mevacor® Label

Pet. 18.

Aurobindo supports its assertions with the same evidence and arguments proffered in the Mylan IPR. Pet. 24–69. Aurobindo notes that its “Petition that accompanies the present Motion for Joinder and accompanying evidence are the same as the instituted Mylan IPR Petition and Petitioner’s Reply to the Patent Owner Response, aside from procedural

sections that, for example, identify Aurobindo, any real parties in interest, and its standing.” Mot. 7. Aurobindo also asserts that it “challenges the same ’186 patent claims based on the same arguments, evidence, and ground of unpatentability on which the Board instituted review in the Mylan IPR.” *Id.*

We incorporate our analysis from our institution decision in the Mylan IPR. IPR2015-01340, Paper 16, 6–32, 34–35. For the same reasons, we determine that Aurobindo has demonstrated a reasonable likelihood that it will prevail with respect to its challenge to claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 of the ’186 patent on the asserted grounds.

II. MOTION FOR JOINDER

In the Motion for Joinder, Aurobindo seeks joinder with the *inter partes* review in the Mylan IPR. Mot. 1–2. Aurobindo filed the present Motion on June 2, 2016, within one month of our decision instituting *inter partes* review in IPR2015-01340, which issued on May 2, 2016. *See* IPR2015-01340, Paper 16; Mot. Therefore, the Motion is timely under 37 C.F.R. § 42.122(b). *See* 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested.”).

The Board, acting on behalf of the Director, has the discretion to join a party to a pending *inter partes* review where the conditions of 35 U.S.C. § 315(c) are met. *See* 35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Specifically, 35 U.S.C. § 315(c) provides:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

As noted above, we have instituted *inter partes* review of claims 1, 2, 4, 6–22, 25–30, 32–37, and 39–42 of the '186 patent in the Mylan IPR. *See generally* IPR2015-01340, Paper 16. In addition, we determined above that Aurobindo has filed a Petition that warrants institution of *inter partes* review of the same claims. Accordingly, the conditions of 35 U.S.C. § 315(c) are satisfied, and we must consider whether to exercise our discretion to join Aurobindo as a Petitioner to the Mylan IPR.

In its Motion for Joinder, Aurobindo asserts that:

[A]llowing Aurobindo to participate in the Mylan IPR will allow Aurobindo and AstraZeneca to resolve the underlying litigation between the parties in a cost effective, expeditious manner should Mylan seek to terminate its participation in the Mylan IPR based on settlement or other factors.

Mot. 9.

Upon authorization, Aurobindo and AstraZeneca filed a joint stipulation explaining the agreement between Petitioners Mylan and Aurobindo, and any other petitioners joined to the Mylan IPR, with respect to the level of cooperation that will be maintained should joinder be granted. Paper 10. Pursuant to the stipulation, Aurobindo agrees “to share the use of Mylan’s experts with Mylan, the ‘Lead Petitioner,’ and all joined petitioners in this IPR proceeding.” *Id.* at 1. Further, as long as Mylan is a party to the proceeding, Aurobindo will “coordinate any communications with Mylan’s

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