

By: Matthew L. Fedowitz, Esq.
Daniel R. Evans, Esq.
MERCHANT & GOULD P.C.
1900 Duke Street, Suite 600
Alexandria, VA 22314
mfedowitz@merchantgould.com
devans@merchantgould.com
Main Telephone: (703) 684-2500
Main Facsimile: (703) 684-2501

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRECKENRIDGE PHARMACEUTICAL, INC.
Petitioner

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.
Patent Owner

Case No. To Be Assigned
Patent No. RE38,551

**MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**

TABLE OF CONTENTS

I.	STATEMENT OF THE PRECISE RELIEF REQUESTED	1
II.	STATEMENT OF MATERIAL FACTS.....	2
III.	STATEMENT OF REASONS FOR RELIEF REQUESTED	6
	A. Joinder is Appropriate	8
	B. Joinder will not impact the Board’s Ability to complete the Review in a Timely Manner.....	9
	C. Joinder will promote Efficiency by consolidating Issues and preventing Inconsistencies	14
	D. Without Joinder, Breckenridge may be prejudiced	14
	E. Joinder will not prejudice Patent Owner or Argentum and will benefit the Interests of the Public	15
IV.	CONCLUSION.....	15

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Breckenridge Pharmaceutical, Inc. (“Breckenridge” or the “Petitioner”) respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the above-captioned *inter partes* review directed to Claims 1-13 of U.S. Patent No. RE38,551 (hereinafter “Breckenridge IPR”) with the pending *inter partes* review concerning the same patent and the same grounds of invalidity in *Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.*, Case No. IPR2016-00204 (hereinafter “Argentum IPR”), which was instituted on May 23, 2016 (Paper No. 19).¹

The instant Motion for Joinder on behalf of Breckenridge is consistent with the substance of Motion for Joinder of Claims 1-13 of the '551 patent filed on behalf of Mylan Pharmaceuticals Inc. in IPR2016-01101, Paper No. 3 (hereinafter “Mylan IPR”). To the extent the Motion for Joinder (Paper No. 3) filed on behalf of Mylan Pharmaceuticals Inc. in IPR2016-01101 is granted, Breckenridge requests this Motion for Joinder of Claims 1-13 also be granted, as the arguments and substance are essentially the same. Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent and will not prejudice any of the parties to the instituted Argentum IPR (IPR2016-

¹ U.S. Patent No. RE38,551 (hereafter "the '551 patent") is purportedly assigned to Research Corporation Technologies, Inc. ("Patent Owner").

00204) or the pending Mylan IPR (IPR2016-01101). This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of May 23, 2016, the date of institution of the Argentum IPR. (IPR2016-00204).

II. STATEMENT OF MATERIAL FACTS

1. Breckenridge is not aware of any reexamination certificates concerning the '551 patent, which is the subject of the Argentum IPR (IPR2016-00204), the Mylan IPR (IPR2016-01101), and the present Breckenridge IPR petition. However, Breckenridge is aware of *Ex Parte* Reexamination Control No. 90/013,709 involving the '551 patent that was recently ordered.

2. On July 10, 2013, Patent Owner and others filed a complaint accusing Breckenridge of infringing the '551 patent. *UCB, Inc., UCB Pharma GmbH, Research Corporation Technologies, Inc., and Harris FRC Corporation v. Breckenridge Pharmaceutical, Inc. and Vennoot Pharmaceuticals, LLC*, C.A. No. 1:3-cv-01211-UNA (D. Del.).

3. On July 10, 2014, Breckenridge (as a co-Petitioner) filed a petition for an *inter partes* review of claims 1–13 of the '551 patent on different grounds than those in the instant Breckenridge IPR petition. *Actavis, Inc., Actavis Laboratories FL, Inc., Actavis Pharma, Inc., Amneal Pharmaceuticals, LLC, Amneal Pharmaceuticals of New York, LLC, Aurobindo Pharma LTD., Aurobindo Pharma USA, Inc., Breckenridge Pharmaceuticals, Inc., Vennoot Pharmaceuticals,*

LLC, Sandoz Pharma Global FZE, and Sun Pharmaceutical Industries, LTD. v. Research Corporation Technologies, Inc., IPR2014-01126 ("the Actavis IPR").

4. On January 9, 2015, the Board declined to institute a review on the grounds pursued in IPR2014-01126. The grounds that were declined institution differ from the grounds on which joinder is sought in this motion.

5. On November 23, 2015, Argentum filed its petition for *inter partes* review of the '551 patent. (Argentum IPR, IPR2016-00204).

6. The Argentum IPR petition (IPR2016-00204) included eight grounds for challenging the validity of the '551 patent:

Ground 1A: Claims 1 and 3-8 are Invalid under 35 U.S.C. § 102 on the Ground That They Are Anticipated by LeGall;

Ground 1B: Claims 2 and 9 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious Over LeGall and the '729 patent;

Ground 2A: Claims 1-9 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious Over Choi and Kohn 1991;

Ground 2B: Claims 10-13 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious Over Choi, Kohn 1991, and the '729 patent;

Ground 3A: Claims 1-9 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious Over Kohn 1991 and Silverman;

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.