

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC,
Petitioner,

v.

JANSSEN ONCOLOGY, INC.,
Patent Owner.

Case No. IPR2016-01317
Patent No. 8,822,438

PETITIONER'S MOTION FOR JOINDER
42.122(b)

I. STATEMENT OF PRECISE RELIEF REQUESTED

Argentum Pharmaceuticals LLC (“Argentum” or “Petitioner”) submits, concurrently with this motion, a petition for *inter partes* review (“Petition”) of claims 1-20 of U.S. Patent No. 8,822,438 (“the ’438 patent”) to Auerbach *et al.* (“the ’438 patent”) (Ex. 1001), which is assigned to Janssen Oncology, Inc. (“Janssen”). Argentum respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petition with a pending *inter partes* review filed by Amerigen Pharmaceuticals, Ltd. (“Amerigen”), *Amerigen Pharmaceuticals, Ltd. v. Janssen Oncology, Inc.*, IPR2016-00286 (“Amerigen IPR”). 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 Amerigen IPR.

Argentum’s request for joinder is timely under 37 C.F.R. § 42.122(b), because it is submitted within one month of May 31, 2016, the date of the Board’s institution decision in IPR2016-00286.

II. BACKGROUND

On December 4, 2015, Amerigen filed a petition for *inter partes* review challenging claims 1-20 of the ’438 patent, which was assigned Case No. IPR2016-00286. On May 31, 2016, the Board instituted review on claims 1-20 on two grounds: (1) Claims 1–20 as obvious under 35 U.S.C. § 103 over

O'Donnell and Gerber; and (2) Claims 1–4 and 6–11 as obvious under 35 U.S.C. § 103 over Barrie and Gerber. The accompanying Petition presents only the identical grounds on which the Amerigen IPR was instituted.

III. ARGUMENT

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am.Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder.

1. Joinder is Appropriate

Joinder with IPR2016-00286 is appropriate because the Petition is limited to the same grounds instituted in the IPR2016-00286 petition. It also relies on the same prior art analysis and expert testimony submitted by Amerigen. Indeed, the Petition is nearly identical with respect to the grounds raised in the IPR2016-00286 petition, and does not include any grounds not raised in that petition.

In order to further simplify the proceeding, Argentum will rely on the same expert as Amerigen, should Amerigen permit it. If Amerigen allows Argentum to retain the same expert, then Argentum will withdraw its expert declaration of Dr. Devalingam Mahalingam and rely solely on the declaration and testimony of Amerigen's expert, Dr. Scott R. Serels. The Board has previously acknowledged that such concessions on the part of a party seeking to join are sufficient to minimize the impact on the original proceeding (see *SAP America Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13, page 4).

Joinder is also appropriate because it will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of validity of the challenged claims of the '438 patent. For example, a final written decision on the validity of the '438 patent has the potential to minimize issues and

potentially resolve any litigation—current or future—altogether with respect to the '438 patent.

2. No New Grounds Are Presented

The Petition does not present any new ground of unpatentability. As mentioned above, the Petition presents for review only grounds from the petition in IPR2016-00286 that have been instituted. The present Petition is based on the same prior art analysis and expert testimony submitted by Amerigen. *See, e.g., Hyundai*, IPR2014-01543, Paper No. 11 at 2-4; *Sony Corp. of Am. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00495, Paper No. 13 at 5-9 (Sep. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013- 00385, Paper No. 17, at 6-10 (Jul. 29, 2013); *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256, Paper 10 at 4-10 (June 20, 2013).

3. Joinder Will Not Negatively Impact the IPR2016-00286 Trial Schedule

Because the Petition essentially copies grounds raised in the IPR2016-00286 petition, including the prior art analysis and expert testimony provided by Amerigen, joinder will have no substantial effect on the parties, or prevent the Board from issuing a final written decision in a timely manner. Moreover, as discussed below, Argentum anticipates participating in the proceeding in a limited capacity as an understudy, absent termination of Amerigen as a party. Accordingly, Argentum does not believe that any extension of the trial schedule

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.