

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

JANSSEN ONCOLOGY, INC.,
Patent Owner.

Case IPR2016-01332
Patent 8,822,438 B2

Before LORA M. GREEN, RAMA G. ELLURU, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

IPR2016-01332
Patent 8,822,438 B2

On June 30, 2016, Mylan Pharmaceuticals Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,822,438 B2 (Ex. 1001, “the ’438 patent”) pursuant to 35 U.S.C. §§ 311–319. Concurrently with its Petition, Petitioner filed a Motion for Joinder (Paper 3, “Mot.”), seeking to join this case, under 35 U.S.C. § 315(c), with the *inter partes* review in *Amerigen Pharmaceuticals, Ltd. v. Janssen Oncology, Inc.*, Case IPR2016-00286 (“the Amerigen IPR” and Petitioner “Amerigen”), which was instituted on May 31, 2016. *See* IPR2016-00286, slip op. at 34–35 (PTAB May 31, 2016) (Paper 14) (decision instituting review of claims 1–20 of the ’438 patent).

Patent Owner Janssen Oncology, Inc. (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 9, “Opp.”). Petitioner filed a Reply in Support of its Motion for Joinder (Paper 10, “Reply”).

Petitioner requested a telephone conference with the Board to discuss Petitioner’s Motion for Joinder and Patent Owner’s due date to file a preliminary response. We held a conference call on August 22, 2016. On the call were all members of the present panel, counsel for Petitioner and Patent Owner, counsel for Amerigen, and counsel for Argentum Pharmaceuticals LLC (Petitioner in IPR2016-01317, also involving the ’438 patent). During the conference call, we heard the parties’ views of both sides on the matter.

Petitioner, during the call, presented its case for joinder, reiterating many of the same arguments presented in its Motion for Joinder and its Reply. Given the schedule of this proceeding and the schedule in the Amerigen IPR, Petitioner requested that Patent Owner’s due date for filing its Patent Owner Preliminary Response be expedited, and effectively, that

IPR2016-01332
Patent 8,822,438 B2

we consider Petitioner's Motion for Joinder in advance of the September 20, 2016 due date for the Patent Owner Response in the Amerigen IPR.

IPR2016-00286, Paper 22.

Patent Owner presented its case against joinder, reiterating many of the same arguments presented in its Opposition. Patent Owner opposed expediting the due date for filing its Patent Owner Preliminary Response.

We have the authority to expedite a preliminary response under 37 C.F.R. § 42.5(c)(1) ("Times set by rule . . . may be modified by order."). For the following reasons, we decline to grant Petitioner's request to expedite Patent Owner's Preliminary Response.

The parties do not appear to dispute that the issues in IPR2016-01332 are largely the same as the issues in IPR2016-00286. Patent Owner, however, expressed its concern about Petitioner's reliance on the testimony of a different expert than the expert retained by Amerigen in the Amerigen IPR, and about Petitioner's submission of additional evidence not presented by Amerigen in the Amerigen IPR. Patent Owner argued that it would be unfair and prejudicial to have to analyze and respond to new evidence and address Petitioner's expert's testimony. Petitioner argued, during the call, that there are no new issues and no undue burden on Patent Owner if the due date for filing Patent Owner's Preliminary Response is expedited. Considering the arguments presented during the call, and the additional evidence and testimony relied upon by Petitioner in its Petition, however, we decline to shorten Patent Owner's time to file its Preliminary Response.

Patent Owner has filed its Opposition, and confirmed during the conference call that it opposes the Motion for Joinder in IPR2016-01332. Patent Owner also has represented that it plans to file its Patent Owner

IPR2016-01332
Patent 8,822,438 B2

Preliminary Response, no later than the October 12, 2016 due date. Paper 9, 3. Because Patent Owner has not waived the Patent Owner Preliminary Response or agreed to file the Patent Owner Preliminary Response prior to the three month default time period for filing such Response, and because Patent Owner opposes the Motion for Joinder, we determine that we will not expedite action on the Motion for Joinder. We will consider the Petition, the Motion for Joinder, the Opposition, and the Reply after the Patent Owner has filed or waived its Preliminary Response.

If the parties stipulate to a modified schedule for IPR2016-01332 in which Patent Owner's Preliminary Response is waived or submitted earlier than the October 12, 2016 deadline, the parties are encouraged to submit the same to the Board at their earliest convenience.

ORDER

In view of the foregoing, it is hereby:

ORDERED that the deadline for filing the Patent Owner Preliminary Response remains October 12, 2016.

IPR2016-01332
Patent 8,822,438 B2

FOR PETITIONER:

Brandon M. White
Crystal Canterbury
bmwhite@perkinscoie.com
CCanterbury@perkinscoie.com

FOR PATENT OWNER:

Dianne Elderkin
delderkin@akingump.com

Ruben Munoz
rmunoz@akingump.com

Barbara Mullin
bmullin@akingump.com