Paper No. ___
Filed: July 8, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOCKHARDT BIO AG

PETITIONER

V.

ELI LILLY & COMPANY

PATENT OWNER

CASE NO.: UNASSIGNED
PATENT NO. 7,772,209

MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)

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Wockhardt Bio AG ("Wockhardt") moves for joinder of the accompanying *Inter Partes* Review ("IPR") Petition filed concurrently herewith, (*Wockhardt Bio AG, et al. v. Eli Lilly & Company*, Case No. unassigned), with *Sandoz, Inc. v. Eli Lilly & Company,* Case No. IPR2016-00318, for at least the following reasons: (1) joinder is appropriate under the governing law, rules, and precedent of this Board; (2) this Motion for Joinder is timely filed; (3) the two proceedings concern the same parties, same patent, and same prior art; (4) Wockhardt relies in whole on the same evidence and same declaration testimony in both proceedings; (5) joinder would neither complicate the issues nor unduly delay the existing schedule of IPR2016-00318; (6) joinder would significantly simplify briefing and discovery in the two IPRs, and will have no impact on the existing schedule; and (7) joinder will not prejudice any party. Finally, joinder here will secure a just, speedy, and inexpensive resolution in both proceedings, more so than in the absence of joinder, by avoiding having the Board preside over two separate proceedings involving identical and duplicative filings and reviews of the same issues.

I. Statement of precise relief requested

Wockhardt requests joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) of the concurrently-filed petition for IPR of claims 1-22 of U.S. Patent No. 7,772,209 (the "'209 Patent") with the related and instituted IPR,

Sandoz, Inc. v. Eli Lilly & Company, Case No. IPR2016-00318 (the "Sandoz IPR").

II. Governing law, rules and precedent

Title 35 U.S.C. § 315(c) states:

> 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.

Title 37 C.F.R. § 42.122(b) states:

> Joinder may be requested by a patent owner or petitioner. 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 time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.

The Board has repeatedly allowed joinder of IPR proceedings when a second petition raises the same ground(s) of unpatentability as those instituted in a first proceeding. *See, e.g., Mylan Pharms. Inc. v. Novartis AG, et al.*, IPR2015-00268, Paper 17 (PTAB Apr. 10, 2015); *Apple, Inc. v. SmartFlash LLC*, CBM2015-00119, Paper 11 (PTAB Aug. 6, 2015); *LG Elec., Inc. v. Innovative Display Techs. LLC*,

IPR2015-00493, Paper 10 (July 15, 2015); *Cisco Sys., Inc., et al. v. Straight Path IP Grp., Inc.*, IPR2015-01006, Paper 12 (PTAB June 5, 2015).

Indeed, there is a "policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." *See Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 10 (PTAB July 29, 2013) (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right - if an inter partes review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.") (emphasis added)).

That is precisely the situation here. In accordance with the Board's governing law and rules, each of the factors supporting joinder are present in this Motion for Joinder: (1) reasons why joinder is appropriate; (2) the lack of any new grounds of unpatentability being raised in the subsequent petition; (3) what impact (if any) there will be on the trial schedule for the existing review; and (4) how briefing and/or discovery may be simplified to minimize schedule impact. *Kyocera Corp. v. Softview, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB April 24, 2013); *see also Samsung Elecs. Co. Ltd. v. Unifi Sci. Batteries, LLC*, IPR2013-00236, Paper 22 at 3 (PTAB Oct. 17, 2013).

Each of these factors is addressed below.

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