

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

BECTON, DICKINSON AND COMPANY,  
Petitioner

v.

ENZO LIFE SCIENCES, INC.  
Patent Owner.

---

Case IPR2017-00181

U.S. PATENT NO. 7,064,197

---

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

## TABLE OF CONTENTS

	<b>Page</b>
I. STATEMENT OF THE PRECISE RELIEF REQUESTED .....	1
II. STATEMENT OF MATERIAL FACTS AND BACKGROUND .....	2
III. STATEMENT OF REASONS FOR RELIEF REQUESTED .....	3
A. Legal Standard.....	3
B. Petitioner’s Request for Joinder Is Timely.....	4
C. Joinder Is Appropriate.....	6
1. Petitioner Asserts Substantively Identical Grounds of Unpatentability.....	6
2. Petitioner Agrees to Consolidated Filings and Discovery.....	7
D. Petitioner’s IPR Raises No New Grounds of Unpatentability .....	8
E. Petitioner’s IPR Will Have No Impact on Trial Schedule.....	9
F. Briefing and Discovery Will Be Simplified.....	9
G. No Prejudice to Enzo if Proceedings Are Joined.....	10
IV. PROPOSED ORDER .....	11
V. CONCLUSION.....	12

**TABLE OF AUTHORITIES**

**Page(s)**

**Federal Cases**

*Apple, Inc. v. VirnetX, Inc.*,  
IPR2016-00062, Paper 14 (P.T.A.B. Jan. 15, 2016) .....6, 7

*Dell Inc. v. Network-1 Security Solutions, Inc.*,  
IPR2013-00385, Paper 17 (P.T.A.B. Jul. 29, 2013) .....5

*Hologic, Inc. v. Enzo Life Sciences, Inc.*,  
IPR2016-00822 (P.T.A.B.) .....*passim*

*Kyocera Corp. v. Softview LLC*,  
IPR2013-00004, Paper No. 15 (P.T.A.B. Apr. 24, 2013) .....1, 4

*Mylan Pharms. Inc. v. Novartis AG*,  
IPR2014-00550, Paper 38 (P.T.A.B. Apr. 10, 2015) .....10

*Microsoft Corp. v. Proxyconn, Inc.*,  
IPR2013-00109, Paper 15 (P.T.A.B. Apr. 24, 2013) .....5

*Qualcomm, Inc. v. Bandspeed, Inc.*,  
IPR2015-01580, Paper 23 (P.T.A.B. Nov. 16, 2015) .....5

*Samsung Elecs. Co., Ltd. v. Raytheon Co.*,  
IPR2016-00962, Paper 12 (P.T.A.B. Aug. 24, 2016) .....4, 5, 10

**Federal Statutes**

35 U.S.C. § 315(b) .....5

35 U.S.C. § 315(c) .....1, 4, 5

35 U.S.C. § 316(b) .....6

35 U.S.C. § 317 .....10

**Regulations**

37 C.F.R. § 42.1(b) .....6

..

37 C.F.R. § 42.22 ..... 1, 4  
37 C.F.R. § 42.101(b) ..... 5, 6  
37 C.F.R. § 42.122(b) ..... 1, 4, 5, 6

## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Becton, Dickinson and Company (“Petitioner,” “BD”) submits the present Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), which authorizes the filing of a “motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Petitioner moves to join its concurrently filed petition for *inter partes* review (“Petitioner’s IPR”) of U.S. Patent 7,064,197 (“the ’197 patent”) with *Hologic Inc. v. Enzo Life Sciences, Inc.*, **IPR2016-00822** (“the Hologic 822 IPR”), which challenges the same claims of the same patent. The Board instituted the Hologic 822 IPR on October 4, 2016. *See* IPR2016-00822, Paper 8, at 1. Petitioner’s IPR and this motion for joinder are timely because they are filed within one month of the decision instituting the Hologic 822 IPR.

Petitioner’s IPR should be joined because it is identical to the Hologic 822 IPR in all substantive respects: Petitioner’s IPR asserts the same grounds on the same claims as those in the Hologic 822 IPR and includes identical exhibits to those in the Hologic 822 IPR. Discovery will not be impacted by joinder of Petitioner’s IPR because Petitioner relies upon the same expert declarant as the Hologic 822 IPR and is not advancing any new evidence. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15, at 4 (P.T.A.B. Apr. 24, 2013). Petitioner is also willing to adopt the same schedule as set for the Hologic 822 IPR. *See*

# 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.