

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES, INC.
Petitioner

v.

ICOS CORPORATION
Patent Owner

Case No. IPR2017-01757
Patent No. 6,943,166 B1

**PETITIONER'S MOTION FOR JOINDER TO RELATED *INTER PARTES*
REVIEW OF U.S. PATENT NO. 6,943,166 (CASE NO. IPR2017-00323)
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Dr. Reddy's Laboratories, Inc. ("DRL" or "Petitioner") hereby moves the Patent Trial and Appeal Board ("Board") for joinder of its today-filed petition for *inter partes* review ("DRL IPR") with a previously instituted IPR, filed by Mylan, on the same patent and the same ground of invalidity, *Mylan Pharmaceuticals Inc. v. ICOS Corporation*, Case No. IPR2017-00323 ("Mylan IPR"). The DRL IPR and the Mylan IPR are substantially identical. Resolving the two IPRs will necessarily involve consideration of the same issues. Patent Owner ("ICOS") will not be prejudiced by joinder as no new grounds are raised by DRL.

DRL notes that on the previous business day to this Motion, Mylan and Patent Owner filed a Joint Motion to Terminate the Mylan IPR. IPR2017-00323, (Paper18) (July 7, 2017). Therefore, institution of the DRL IPR and joinder with the Mylan IPR will ensure that a petitioner remains to complete Trial at the Board. Joinder here would comport with the Board's decision as to a set of two IPRs where the Board granted joinder of a second IPR just one day before the Board terminated the petitioner of the first IPR: *AT&T Services, Inc. v. Convergent Media Solutions, LLC*, Case IPR2017-01237, (PTAB May 10, 2017) (Paper 10) (granting joinder to second IPR); *Netflix, Inc. v. Convergent Media Solutions, LLC*, Case IPR2016-01814, (PTAB May 11, 2017) (Paper 15) (terminating only the petitioner of the first IPR).

Although a motion was filed to terminate the Mylan IPR on July 7th, joinder of the DRL IPR is still appropriate, perhaps more so. As an initial matter, the Board's decision to grant joinder in the *Convergent* IPRs should control here, as the Board has yet to grant Mylan's and Patent Owner's Joint Motion to Terminate. Moreover, joinder makes sense as a matter of efficiency. Should the Board deny DRL's instant Motion for Joinder and opt to institute DRL's application as a novel IPR (substantially identical to that submitted by Mylan), the Board must then restart the review process, thus duplicating its past efforts. Grant of DRL's joinder to Mylan's pending IPR would be a more efficient use of Board time and resources than setting the clock back to redo this review. Finally, public policy weighs in favor of joinder – restarting the process by instituting DRL's IPR as new would only serve to delay the ultimate determination as to the patentability of the challenged claims.

II. BACKGROUND

1. Several months ago, on April 13, 2017, Patent Owner and Eli Lilly and Co. (“Lilly”) filed a complaint accusing DRL and Dr. Reddy's Laboratories, Ltd., of infringing the '166 patent. *Eli Lilly and Co., et al. v. Dr. Reddy's Laboratories, Inc., et al.*, Civil Action No. 17-cv-02541-KM-MAH (D.N.J.). Lilly is a real party in interest to the Mylan IPR and Dr. Reddy's Laboratories, Ltd. is a real party in interest to the DRL IPR.

2. Seven months earlier, on September 2, 2016, Mylan Pharmaceuticals Inc. (“Mylan”) had been sued in the United States District Court for the Eastern District of Virginia by Patent Owner and Lilly on the ‘166 patent. *Eli Lilly & Co. et al. v. Mylan et al.*, No. 1:16-cv-01122 (E.D.V.A).

3. Mylan filed its petition for *inter partes* review of the ‘166 patent on November 22, 2016. Mylan IPR, IPR2017-00323 (Paper 2).

4. The Mylan IPR included the following ground for challenging the validity of the ‘166 patent:

Ground 1: Claims 1-12 are Obvious under 35 U.S.C. § 103 over the ‘675 PCT in view of the Sildenafil NDA and FDA Guideline. Mylan IPR, IPR2017-00323 (Petition, Paper 2 at 30-46).

5. The Board instituted the Mylan IPR on June 12, 2017. Mylan IPR, IPR2017-00323 (Paper 12 at 4, 17).

6. The Petition filed in the DRL IPR presents the identical ground on which the Mylan IPR was instituted.

7. DRL is one of several defendants involved in pending litigations regarding the ‘166 patent in the District of New Jersey or the Eastern District of

Virginia.¹

8. The District Court action in the Eastern District of Virginia between Mylan, Patent Owner and Lilly was dismissed in a Consent Judgment entered July 6, 2016.

III. LEGAL STANDARD

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review proceedings. The statutory provision governing joinder of *inter partes* review proceedings, 35 U.S.C. § 315(c), gives the Board the discretion to grant joinder of a properly filed petition for *inter partes* review.

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, (PTAB July 29, 2013) (Paper No. 17 at 3). In deciding whether to grant joinder, the Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an

¹ A list of pending litigations involving the ‘166 patent is at DRL’s Petition for *Inter Partes* review, page 26, submitted earlier today.

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