

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS-KABI USA LLC,
Petitioner,

v.

ASTRAZENECA AB,
Patent Owner.

Case IPR2017-01910 (Patent 6,774,122)
Case IPR2017-01912 (Patent 8,466,139)
Case IPR2017-01913 (Patent 8,329,680)¹

Before GRACE KARAFFA OBERMANN, ZHENYU YANG, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
*Denying Petitioner's Request for
Authorization to File a Motion to Withdraw the Petitions
And
Denying Petitioner's Motions for Joinder
37 C.F.R. §§ 42.5(a), 42.71(a), 42.122(b)*

¹ This order addresses issues common to each case, therefore, we enter the word-for-word identical order in each proceeding identified in the heading. We refer to the cases, respectively, as IPR910, IPR912, and IPR913. Exhibit and paper numbers are the same in each proceeding. The parties may use this style heading when filing an identical paper in multiple proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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On November 1, 2017, a telephonic conference call was held among counsel for both parties and Judges Obermann, Yang, and Pollock. Neither party retained a court reporter. This order constitutes the record of the call.

Patent Owner requested the call “to determine how to proceed” under these circumstances: Petitioner filed a motion seeking joinder in IPR910, IPR912, and IPR913 with proceedings initiated by a different petitioner—namely, InnoPharma Licensing—in, respectively, IPR2017–00900 (IPR900), IPR2017–00904 (IPR904), and IPR2017–00905 (IPR905). Ex. 3001, 2 (email correspondence); Paper 3 (motion for joinder).² The earlier-filed petitions submitted by InnoPharma Licensing were denied by the Board a few days after Petitioner filed the instant petitions and motions for joinder. Ex. 3001, 2 (earlier-filed petitions were denied on August 30, 2017); Paper 1 (petition, filed August 24, 2017); Paper 3 (motion for joinder, filed August 24, 2017).

A second purpose of the call was to discuss Petitioner’s request for authorization to file a motion to withdraw the petitions and motions for joinder in the instant proceedings. Ex. 3001, 2. Patent Owner opposed that request. *Id.* at 1.

Two facts became apparent during the call. First, Petitioner has not been served with a complaint for infringement of any patent at issue in these proceedings; therefore, no impending time bar, arising under 35 U.S.C. § 315(b), would prevent Petitioner from filing a follow-on petition in any proceeding, in an attempt to improve the challenges with the benefit of our

² The earlier-filed cases were misidentified in the email correspondence as IPR2017-01900, IPR2017-01904, and IPR2017-01905. Ex. 3001, 2. As we explained during the call, that was harmless error.

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analysis set forth in the decisions that denied the petitions filed by InnoPharma Licensing in IPR900, IPR904, and IPR905. Second, under questioning, counsel for Petitioner would admit only that Petitioner has no plans to file any follow-on petitions “at this time.”

*Denying Petitioner’s Request for
Authorization to File a Motion to Withdraw the Petitions*

Both parties were provided an opportunity to argue their positions relative to Petitioner’s request for authorization to file a motion to withdraw the petitions. In a nutshell, Petitioner recognized that no applicable rule contemplates the withdrawal of a petition by a petitioner over the objections of a patent owner. Petitioner argued, however, that the Board is empowered to grant such a request under its broad authority to manage cases on its docket. Specifically, according to Petitioner, the Board is authorized to grant a petitioner’s request to withdraw a petition, over the objections of a patent owner, under the provisions of Rule 42.5(a) (relating to the Board’s authority to “determine a proper course of conduct in a proceeding for any situation not specifically covered by” the rules) or under the provisions of Rule 42.71(a) (relating to the Board’s authority to “dismiss any petition”). Petitioner further argued that authorization of a motion to withdraw would serve the interests of economy and efficiency by ending these cases immediately, thereby sparing the parties and the Board from incurring any further burden or expense.

Patent Owner opposed Petitioner’s request, arguing that authorizing a motion to withdraw the petitions, over Patent Owner’s objections, would unfairly prejudice Patent Owner. Specifically, Patent Owner pointed out (and Petitioner confirmed) that the instant petitions are virtually identical to

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the petitions that were filed by InnoPharma Licensing and denied by the Board in IPR900, IPR904, and IPR905. Petitioner copied verbatim the earlier-filed petitions, and supporting declarations, submitted by InnoPharma Licensing.

Patent Owner, for its part, indicated a desire to defend against the instant petitions by using the same, or essentially the same, arguments and evidence that led to the Board's denial of the petitions filed by InnoPharma Licensing. In Patent Owner's view, Patent Owner would be prejudiced by the withdrawal of the instant petitions as an alternative to the Board ruling on the merits of them. Of particular concern to Patent Owner, in that regard, was an erosion of its ability to successfully defend against any follow-on petitions filed by Petitioner.

On that point, Patent Owner observed that the Board, in a recently-designated precedential decision, enumerated a non-exclusive list of factors applicable to the discretionary denial of a follow-on petition under 35 U.S.C. § 314(a). *General Plastic Industrial Co., Ltd. v Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (precedential).

Patent Owner argued that a grant of a request to withdraw the instant petitions, under circumstances that leave open the possibility that Petitioner will file follow-on petitions, would prejudice Patent Owner by undercutting its ability to make out the third *General Plastic* factor, relating to "whether at the time of filing of the second petition the petitioner already . . . received the Board's decision on whether to institute review in the first petition." *Id.* at 9. Stated somewhat differently, Patent Owner suggested that Petitioner

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should be required to bear the consequences of its deliberate decision to file petitions identical to those submitted by InnoPharma Licensing.

At the conclusion of the call, we held that none of the Board's rules expressly contemplates the withdrawal of a petition by a petitioner over the objections of a patent owner. We also held that the particular circumstances of this case disfavor granting the requested relief under our general powers of case management. Specifically, only Patent Owner stands to benefit from any economy or efficiency that would result from a grant of Petitioner's request. Yet Patent Owner raised no concerns related to the burden or expense of defending against the petitions, but rather, indicated a firm desire to proceed by filing a preliminary response to the petitions. On that point, we observed that Petitioner will incur no further burden or expense during the pre-institution stage. Petitioner will face additional burden or expense only if the petition is granted in one or more proceeding. Should that occur, we advised Petitioner that it may seek authorization to file a motion for termination of trial as provided by our rules. 37 C.F.R. § 42.72. Further, given that Petitioner's counsel provided no assurances that Petitioner will not file follow-on petitions challenging the patents at issue in these proceedings, we found that a grant of Petitioner's request, over Patent Owner's objections, would prejudice Patent Owner by undercutting its ability to defend against such petitions. Accordingly, we *denied* Petitioner's request for authorization to file a motion to withdraw the petitions.

Denying Petitioner's Motions for Joinder

Given that the petitions in IPR900, IPR904, and IPR905, filed by InnoPharma Licensing, were denied several days after Petitioner filed the

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