

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUN PHARMACEUTICAL INDUSTRIES, LTD., SUN PHARMACEUTICAL
INDUSTRIES, INC. and SUN PHARMA GLOBAL FZE
Petitioners,

v.

NOVARTIS A.G.,
Patent Owner

Case No.: IPR2017-01929
Patent No.: 9,187,405

**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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Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE, (collectively “Petitioners”) move for joinder of the accompanying *Inter Partes* Review (“IPR”) Petition filed today, *Sun Pharmaceutical Industries, Ltd., Sun Pharmaceutical Industries, Inc., and Sun Pharma Global FZE v. Novartis A.G.*, Case No. IPR2017-01929, with *Apotex, Inc. and Apotex Corp. v. Novartis AG*, IPR2017-00854, 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 patent, and same prior art; (4) Petitioner relies in whole on the same evidence and the same declaration testimony in both proceedings; (5) joinder would neither complicate the issues nor unduly delay the existing schedule of IPR2017-00854; (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

Petitioners request 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 1-6 of U.S.

Patent No. 9,187,405 (“the ’405 patent”) with the related and instituted IPR, *Apotex, Inc. and Apotex Corp. v. Novartis AG*, Case No. IPR2017-00854 (“the Apotex IPR”).

Petitioners have notified counsel for Apotex, Inc. and Apotex Corp. (“Apotex”), petitioner in the Apotex IPR, of this Motion. Apotex has indicated that it does not oppose Petitioners’ request for joinder.¹ Further, Apotex and Petitioner have agreed to coordinate in discovery should joinder be granted, with Apotex leading in all discovery matters and hearings before the Board.

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

¹ Petitioners have notified and requested consent from counsel for Patent Owner, Novartis A.G. Counsel for Patent Owner have informed Petitioners that they are discussing Petitioners’ request with their client. Petitioners have also notified counsel for Argentum Pharmaceuticals LLC, petitioner in related IPR *Argentum Pharmaceuticals LLC v. Novartis, A.G.*, Case No. IPR2017-01550, which was joined with the Apotex IPR on August 9, 2017. Argentum has indicated that it does not oppose Petitioners’ request for joinder with the Apotex IPR.

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., Argentum Pharmaceuticals LLC v. Novartis, A.G.*, Case No. IPR2017-01550, Paper 10 (PTAB August 9, 2017); *Wockhardt Bio AG v. Jazz Pharms., Inc.*, IPR2015-01813, Paper 10 (PTAB Oct. 30, 2015); *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,

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