UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTAVIS ELIZABETH LLC and TEVA PHARMACEUTICALS USA, INC.

Petitioners,

v.

NOVARTIS A.G.,

Patent Owner.

Case No. IPR2017-01946

U.S. Patent No. 9,187,405

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

Actavis Elizabeth LLC and Teva Pharmaceuticals USA, Inc. (collectively, "Petitioners") respectfully request that their Petition for *Inter Partes* Review of U.S. Patent No. 9,187,405 (the "'405 patent") ("Petition") be granted and joined pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) with the petition for *inter partes* review filed by Apotex, Inc. and Apotex Corp. (collectively, "Apotex") concerning the '405 Patent: *Apotex, Inc. and Apotex Corp. v. Novartis AG*, No. IPR2017-00854 ("Apotex IPR").

On February 3, 2017, Apotex filed a petition for *inter parties* review of the '405 Patent. *See Apotex Inc. v. Novartis A.G.,* IPR2017-00854, Paper No. 2, February 3, 2017. Having only been instituted on July 18, 2017, the Apotex IPR is at an early stage. On June 9, 2017, Argentum Pharmaceuticals LLC ("Argentum") filed a petition for *inter parties* review of the '405 Patent and a concurrent motion for joinder. *See Argentum Pharms. LLC v. Novartis A.G.,* IPR2017-01550, Paper No. 2, June 2, 2017. The Argentum IPR was instituted and the accompanying motion for joinder was granted August 9, 2017. *See Argentum Pharms. LLC v. Novartis A.G.,* IPR2017-01550, Paper No. 10, August 9, 2017. Petitioners concurrently file this motion with a petition for *inter partes* review of the '405 patent. Apotex has represented to Petitioners that it will not oppose this Motion for Joinder.

In accordance with the Board's Representative Order identifying matters to be addressed in a motion for joinder (*Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, April 24, 2013), Petitioners submit that:

(1) joinder is appropriate because it will promote efficient determination of the validity of the '405 Patent without prejudice to Apotex, Argentum or patent owner Novartis A.G. ("Novartis");

(2) Petitioners challenge the same claims of the '405 patent using the same grounds as Apotex and Argentum;

(3) joinder need not affect the schedule in the Apotex IPR—as the instant petition is substantially identical to the Apotex petition and the Argentum petition and can be addressed concurrently—nor increase the complexity of that proceeding, minimizing costs; and

(4) Petitioners are willing to agree to consolidated filings with Apotex to eliminate burden and schedule impact.

Accordingly, joinder should be granted. *See, e.g.*, *id.* at 4 (Apr. 24, 2013) (noting factors considered in granting joinder requests).

I. PETITIONERS' MOTION FOR JOINDER IS TIMELY

As discussed below, Petitioners' motion for joinder is timely pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) because it is being filed no later than one month from the institution of the petition in the Apotex's IPR.

The Board may join any party who has properly filed a petition to a proceeding following institution of an *inter partes* review. 35 U.S.C. § 315(c). If a petitioner seeks to be joined as a party to another *inter partes* review of the same patent, it is required to file a request "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).

Here, Petitioners have moved for joinder "no later than one month after the institution date" of *inter partes* review in the Apotex IPR, which was instituted on July 18, 2017. Therefore, Petitioners' request to be joined as a party to the Apotex IPR is timely.

II. PETITIONERS SHOULD BE JOINED AS PARTIES TO THE APOTEX IPR

The Board has provided that a motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule of the existing proceeding; and (4) address specifically how briefing

and discovery may be simplified. *See, e.g.*, *Kyocera*, IPR2013-00004, Paper 15 at 4. Analysis of these factors here warrants the grant of the requested joinder.

A. Joinder of Petitioners Will Promote an Efficient Determination of the Validity of the '405 Patent Without Prejudice to Any Party

If Petitioners were joined as parties, the validity of the grounds raised in Apotex's and Argentum's IPRs and Petitioners' concurrently filed Petition could be determined in a single proceeding. Petitioners' petition challenges the validity of the same claims of the '405 Patent on the same grounds as in Apotex's and Argentum's Petitions. Petitioners also rely on substantially the same supporting evidence[1] in their Petition as in Apotex's Petition and Argentum's Petition, including the same expert and expert declaration. *See Apotex,* Paper No. 2. A consolidated proceeding, including Petitioners, Apotex and Argentum, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g.*, *Oracle Am., Inc. v. Realtime Data LLC*, IPR2016-01672, Paper No. 13 at 7, March 7, 2017.

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[1] Petitioners have added one additional exhibit (EX1041), which is a copy of the Federal Circuit Decision of April 12, 2017 affirming the Final Written Decision in *Torrent Pharms. Ltd. v. Novartis A.G.,* IPR2014-00784, an IPR related to the present proceeding.

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