Trials@uspto.gov
571-272-7822

Paper 9
Entered: September 11, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTAVIS ELIZABETH LLC and
TEVA PHARMACEUTICALS USA, INC.,
Petitioner,
v.
NOVARTIS AG,
Patent Owner.

Case IPR2017-01946
Patent US 9,187,405 B2

Before LORA M. GREEN, CHRISTOPHER M. KAISER, and ROBERT A. POLLOCK, *Administrative Patent Judges.*

POLLOCK, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review and Granting Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Actavis Elizabeth LLC and Teva Pharmaceuticals USA, Inc. (collectively, "Teva") filed a Petition requesting an *inter partes* review of claims 1–6 of U.S. Patent No. 9,187,405 B2 ("the '405 patent"). Paper 2 ("Pet."). Along with the Petition, Teva filed a Motion for Joinder to join this proceeding with IPR2017-00854. Paper 3 ("Mot."). Teva filed the Petition and Motion for Joinder in the present proceeding on August 15, 2017, within one month after we instituted trial in IPR2017-00854. Novartis AG, ("Novartis") has not filed a Preliminary Response to the Petition, and any such response is due November 15, 2017. Novartis does not oppose Teva's motion for joinder. Ex. 3001; Mot., 1.

As explained further below, we institute trial on the same grounds as instituted in IPR2017-00854 and grant Teva's Motion for Joinder.

II. DISCUSSION

In IPR2017-00854, Apotex, Inc. and Apotex Corp. ("Apotex") challenged claims 1–6 of the '405 Patent on the following grounds:

Ground	Claims	References	Basis
1	1–6	Kovarik[1] and Thomson	§ 103
2	1–6	Chiba,[2] Kappos 2005,[3] and Budde[4]	§ 103

[1] Kovarik and Appel-Dingemanse, WO 2006/058316, published June 1, 2006.
[2] Chiba et al., US 6,004,565, issued Dec. 21, 1999. Ex. 1006.
[3] Kappos et al., "*FTY720 in Relapsing MS: Results of a Double-Blind Placebo-Controlled Trial with a Novel Oral Immunomodulator*," 252 (Suppl 2) J. NEUROLOGY Abstract O141 (2005). .
[4] Budde, et al., "*First Human Trial of FTY720, a Novel Immunomodulator, in Stable Renal Transplant Patients*," 13 J. AM. SOC. NEPHROLOGY 1073-1083 (2002). .

Ground	Claims	References	Basis
3	1–6	Kappos 2010[5]	§ 102

After considering the Petition and Patent Owner's Preliminary Response, we instituted trial in IPR2017-00854 on each of the three asserted grounds. IPR2017-00854, Paper 11, 27. On August 9, 2017, we instituted *inter partes* review on those same grounds in IPR2017-01550 and granted Petitioner Argentum Pharmaceuticals LLC's motion for joinder with IPR2017-00854. IPR2017-00854, Paper 10, 5.

As with Argentum's Petition, Teva's Petition is substantively identical to Apotex's Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2017-01946, Paper 2, *with* IPR2017-00854, Paper 2. For the same reasons stated in our Decision on Institution in IPR2017-00854, we institute trial in this proceeding on the same three grounds.

Having determined that institution is appropriate, we now turn to Teva's Motion for Joinder. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that "[i]f 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." *Id*. When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

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[5] Kappos et al., "*A Placebo-Controlled Trial of Oral Fingolimod in Relapsing Multiple Sclerosis*," 362(5) N. ENGL. J. MED. 387–401.

Under the circumstances of this case, we determine that joinder is appropriate. Teva raises no new grounds of unpatentability from IPR2017-00854 and contends that there will be no impact on the trial schedule previously set in that case. Mot. 5–6; *see* IPR2017-00854, Paper 12. As Teva notes, the Petition in IPR2017-00854 is substantively identical to the grounds, analysis, exhibits,[6] and expert declarations relied on in the instant proceeding. Mot. 2, 4, 5. Teva agrees "to submit consolidated filings for all substantive papers in the respective proceedings with Apotex and to incorporate its filings with those of Apotex in a consolidated filing, subject to the ordinary rules for one party on page limits. *Id*. at 6. Teva further agrees "to let Apotex take the lead at the hearing and depositions and will agree that cross examinations will occur within the timeframe normally allotted to one party." *Id*.

Teva represents that Apotex does not oppose Argentum's Motion for Joinder. *Id*. at 3. By email to the Board dated September 5, 2017, counsel for Novartis represents that, 1) Novartis does not object to the Motion; 2) Teva has agreed not to pursue any arguments or make any filings separate from those made by Apotex in IPR2017-00854 (subject to Petitioner's right to take a lead role in the proceeding if Apotex drops out of IPR2017-00854); and 3) that it will not submit a Preliminary Response in IPR2017-01946. Ex. 3001.

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[6] Teva notes that it has "added one additional exhibit (EX1041) which is a copy of the Federal Circuit Decision of April 12, 2017 affirming the Final Written Decision in IPR2014-00784, an IPR related to the present proceeding." Mot., 4, fn.1.

In view of the foregoing, we find that joinder based upon the conditions stated in Teva's Motion for Joinder and Novartis' September 5 email will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined. Thus, without opposition to the Motion for Joinder from any of the parties, the Motion is granted.

III. ORDER

Accordingly, it is

ORDERED that *inter partes* review is instituted in IPR2017-01946 on the following grounds:

> Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Kovarik and Thomson;
>
> Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Chiba, Kappos 2005, and Budde;
>
> Claims 1–6 under 35 U.S.C. § 102 as anticipated by Kappos 2010.

FURTHER ORDERED that Teva's Motion for Joinder with IPR2017-00854 is granted;

FURTHER ORDERED that IPR2017-01946 is terminated and joined to IPR2017-00854, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2017-00854 (Paper 12) shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2017-00854;

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