Trials@uspto.gov
Tel: 571-272-7822

Paper 11
Entered: February 22, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02139
Patent 6,407,213 B1

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Bioepis Co., LTD ("Bioepis") filed a Petition, seeking an *inter partes* review of claims 1, 2, 4, 12, 25, 29–31, 33, 42, 60, 62–67, 69, 71–81 of U.S. Patent No. 6,407,213 B1 (Ex. 1001, "the '213 patent"). Paper 1 ("Pet."). Genentech, Inc. ("Patent Owner") did not file a Preliminary response to the Petition. Along with the Petition, Bioepis filed a Motion for Joinder to join this proceeding with IPR2017-01488. Paper 3 ("Mot."). Patent Owner opposes the Motion. Paper 7 ("Opp.").

As explained further below, we institute an *inter partes* review on the same grounds as instituted in IPR2017-01488 and grant Petitioner's Motion for Joinder.

II. DISCUSSION

In IPR2017-01488, Pfizer, Inc. challenged claims 1, 2, 4, 12, 25, 29–31, 33, 42, 60, 62–67, 69, and 71–81 of the '213 patent on the following grounds:

Ground	Claim(s)	Basis	Reference(s)
1	1, 2, 25, 29, 63, 66, 67, 71, 72, 75, 76, 80, and 81	§ 102	Kurrle[1]
2	1, 2, 4, 29, 62–64, 80, and 81	§ 102	Queen 1990[2]
3	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 72, 75, 76, 78, 80, and 81	§ 103	Kurrle and Queen 1990

[1] Kurrle, et al., European Patent Application Publication No. 0 403 156, published December 19, 1990. Ex. 1071.8

[2] Queen, et al., International Publication No. WO 1990/07861, published July 26, 1990. Ex. 1050.

Ground	Claim(s)	Basis	Reference(s)
4	12	§ 103	Kurrle, Queen 1990, and Furey [3]
5	73 and 77	§ 103	Kurrle, Queen 1990, and Chothia & Lesk[4]
6	74	§ 103	Kurrle, Queen 1990, and Chothia 1985[5]
7	79 and 65	§ 103	Kurrle, Queen 1990, Chothia & Lesk, and Chothia 1985
8	30, 31, 33, and 42	§ 103	Queen 1990 and Hudziak[6]
9	42	§ 103	Queen 1990, Hudziak and Furey
10	60	§ 103	Queen 1990, Hudziak, and Chothia & Lesk

On December 1, 2017, we instituted an *inter partes* review to review the patentability of those claims. *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-01488, Paper 27.

The Petition in this case is substantively identical to the one in IPR2017-01488. *Compare* IPR2017-01488, Paper 1 *with* IPR2017-02139, Paper 1; *see* Mot. 3–4 (admitting that "the Petition and evidence offered by Bioepis is nearly identical to that in IPR2017—01488"). For the reasons stated in our Decision on Institution in

[3] Furey et al., *Structure of a Novel Bence-Jones Protein (Rhe) Fragment at 1.6 Å Resolution*, 167 J. MOL. BIOL. 661–92 (1983). Ex. 1125.

[4] Chothia and Lesk, *Canonical Structures for the Hypervariable Regions of Immunoglobulins*, 196 J. MOL. BIOL. 901–17 (1987). Ex. 1062.

[5] Chothia et al., *Domain Association in Immunoglobulin Molecules: The Packing of Variable Domains*, 186 J. MOL. BIOL. 651–63 (1985). Ex. 1063.

[6] Hudziak et al., *p185^{HER2} Monoclonal Antibody Has Antiproliferative Effects In Vitro and Sensitizes Human Breast Tumor Cells to Tumor Necrosis Factor*, 9 MOL. CELL BIOL. 1165–72 (1989). Ex. 1021.

IPR2017-01488, we institute an *inter partes* review in this proceeding on the same grounds. *See* IPR2017-01488, Paper 27.

Having determined that institution is appropriate, we now turn to Bioepis's Motion for Joinder. Under the statute, "[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." 35 U.S.C. § 315(c). 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).

Under the circumstances of this case, we determine that joinder is appropriate. Bioepis filed the Petition and Motion for Joinder in the present proceeding before we instituted an *inter partes* review in IPR2017-01488, and thus, satisfies the requirement of 37 C.F.R. § 42.122(b). Bioepis represents that the Petition in this case is "essentially a copy of the Pfizer Petition." Mot. 1. According to Bioepis, the Petition "relies solely on the same prior art analysis and expert testimony submitted by Pfizer." *Id.* at 3. Bioepis asserts that it "anticipates participating in the proceeding in a limited 'understudy' capacity," unless Pfizer is terminated as a party. *Id.* at 2, 5; *see also id.* at 6 (agreeing that, "as long as Pfizer remains a party . . . the Board may order petitioners to consolidate filings, and limit Bioepis to . . . [an] understudy role"). As a result, Bioepis avers that joinder will "create no additional burden for the Board, Genentech, or Pfizer,"

"have no impact on the trial schedule of IPR2017-01488," and result in no prejudice to either Genentech or Pfizer. *Id.* at 1–3.

In its Opposition, Genentech does not challenge Bioepis's arguments. Instead, Genentech urges that we impose certain conditions on Bioepis. Opp. 4–5. According to Genentech, previously, when Bioepis filed petitions to challenge three patents other than the '213 patent and sought to join three other IPRs, we instituted *inter partes* reviews and "granted joinder without any conditions." *Id.* at 2. This representation is inaccurate.

In IPR2017-01958, -01959, and -01960, Bioepis sought to join IPR2017-00804, -00805, and -00737 (all filed by Hospira, Inc.), respectively. IPR2017-01958, Paper 1; IPR2017-01959, Paper 1; IPR2017-01960, Paper 1. We instituted an *inter partes* review and granted joinder in each case. IPR2017-01958, Paper 9; IPR2017-01959, Paper 9; IPR2017-01960, Paper 11. When doing so, we specifically ordered that "absent leave of the Board, Bioepis shall maintain an understudy role with respect to Hospira, coordinate filings with Hospira, not submit separate substantive filings, not participate substantively in oral argument, and not actively participate in deposition questioning except with the assent of all parties." *See, e.g.*, IPR2017-01960, Paper 11, 7. Those requirements, although not verbatim, appear to be substantially the same as Genentech requests here. *See* Opp. 4–5.

Where, as in the present case, a party seeks to take a secondary role in an on-going IPR, joinder promotes economy and efficiency, thereby reducing the burden on the Patent Owner and on the limited

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.