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Filed on behalf of Samsung Bioepis Co., Ltd.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD., Petitioner,

v.

GENENTECH, INC., Patent Owner.

United States Patent No. 6,407,213
Title: Method for making humanized antibodies

Case No.: IPR2017-02139

MOTION FOR JOINDER WITH IPR2017-01488

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I. Statement of the Precise Relief Requested

Samsung Bioepis Co., Ltd. ("Bioepis" or "Petitioner") submits, concurrently with this motion, a petition for *inter partes* review ("Petition") of claims 1, 2, 4, 12, 25, 29-31, 33, 42, 60, 62-67, 69, and 71-81 of U.S. Patent No. 6,407,213 (the "'213 patent"), which is assigned to Genentech, Inc. ("Genentech" or "Patent Owner"). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Bioepis respectfully requests joinder of the Petition with pending IPR2017-01488.

Bioepis's request for joinder is timely. On May 24, 2017, Pfizer Inc. ("Pfizer") filed an *inter partes* review petition (the "Pfizer Petition") concerning the '213 patent. The Patent Trial and Appeal Board (the "Board") is still considering whether to institute review of the Pfizer Petition. As the Board has not yet made an institution decision, Bioepis's request for joinder is therefore timely. *See* 37 C.F.R. § 42.122(b).

The Petition closely follows the references cited and the grounds raised in the Pfizer Petition. The Petition is, in fact, essentially a copy of the Pfizer Petition, which is currently being considered by the Board. As such, institution and joinder create no additional burden for the Board, Genentech, or Pfizer. Institution and joinder will therefore lead to the efficient resolution of the validity of claims 1, 2, 4, 12, 25, 29-31, 33, 42, 60, 62-67, 69, and 71-81 of the '213 patent.

Absent termination of Pfizer as a party to the proceeding, Bioepis anticipates participating in the proceeding in a limited "understudy" capacity. Joinder will therefore have no impact on the trial schedule of IPR2017-01488 because that IPR is still in its early stages and Bioepis, in its limited role, is agreeable to whatever schedule is implemented in that proceeding.

II. Argument

The Board may join any person that properly files a petition for *inter partes* review to a separate, ongoing *inter partes* review. 35 U.S.C. § 315(c). A petition which seeks joinder must be filed "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).

A motion for joinder should also "(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 for the existing review; and (4) address specifically how briefing and discovery may be simplified." *Macronix Int'l Co., Ltd. v. Spansion LLC*, Paper 15 at 4 (PTAB Aug. 13, 2014) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

A. Bioepis's Motion for Joinder is Timely

Joinder may be requested no later than one month after the Board's institution of an *inter partes* review for which joinder is requested. 37 C.F.R. §

42.122. Here, the Board has not yet issued an institution decision in IPR2017-01488. This motion for joinder is therefore timely.

Bioepis's motion is also not premature. *See, e.g.*, *Apple*, IPR2013-00348, Paper 6 at 3 (PTAB Aug. 14, 2013); *see also Oracle Am.*, IPR2016-01672, Paper 13, at 4 (PTAB Mar. 7, 2017).

B. The Four Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board for joinder motions favors joinder of Bioepis to the IPR2017-01488 proceeding. As shown in Sections II.B.1-4 below, joinder will not negatively affect the timing of discovery or trial in IPR2017-01488, and so neither Genentech nor Pfizer will face any prejudice due to the joinder. Joinder will, however, significantly simplify the briefing, discovery, and trial associated with the Petition.

1. Joinder of Bioepis is appropriate

Joinder with IPR2017-01488 is appropriate because the Petition is limited to the same grounds and claims on which the Board is considering institution in IPR2017-01488. The Petition further relies solely on the same prior art analysis and expert testimony submitted by Pfizer.[1] Other than the mandatory notice and

[1] Beyond the expert testimony offered by Pfizer in IPR2017-01488, Bioepis submitted expert declarations from Drs. Diljeet Athwal and Mark Gerstein. Dr. Athwal's declaration is substantively identical to the declaration of Dr. Jefferson Foote submitted by Pfizer. Dr. Gerstein's declaration is substantively identical to the declaration of Mr. Timothy Buss submitted by Pfizer. Bioepis,

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