

Patent Owner's Opposition to Motion for Joinder

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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.

Case IPR2017-02139
Patent 6,407,213

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

Patent Owner Genentech Inc. ("Genentech") submits this Opposition to Petitioner Samsung Bioepis Co., Ltd.'s ("Bioepis's") Motion for Joinder with IPR2017-01488 ("Motion for Joinder") (Paper 3).

Bioepis seeks to join this *inter partes* review with IPR2017-01488, filed by Pfizer, Inc. ("Pfizer"), and for which the Board has not yet issued an institution decision (the "Pfizer IPR"). Bioepis asserts that joinder will not impact trial or otherwise prejudice Genentech because its petition is "essentially a copy" of the one filed by Pfizer and that Bioepis is willing to take a "limited capacity" role where it "will not submit any separate filings unless it strongly disagrees with a position adopted by Pfizer" (IPR2017-02139, Paper 3 at 6 (Sept. 29, 2017)), "will try to coordinate with Pfizer . . . to consolidate and minimize additional filings, manage questions at depositions, and avoid redundancies" (*id.* at 7), and "anticipates participating only in a secondary role." (*Id.*)

Bioepis has filed this same Motion for Joinder in four other proceedings, in which Bioepis likewise admits that its petition is "essentially a copy" of a petition filed by a third party. (*See Samsung Bioepis Co., Ltd., v. Genentech, Inc.*, IPR2017-01958, Paper 1 at 1 (Aug. 25, 2017); *Samsung Bioepis Co., Ltd. v. Genentech, Inc.*, IPR2017-01959, Paper 1 at 1 (Aug. 25, 2017); *Samsung Bioepis Co., Ltd. v. Genentech, Inc.*, IPR2017-01960, Paper 1 at 1 (Aug. 25, 2017); *Samsung Bioepis Co., Ltd. v. Genentech, Inc.*, IPR2017-02140, Paper 3 at 1 (Sept.

29, 2017).) When Bioepis filed this same Motion for Joinder in its first three proceedings (IPR2017-01958; IPR2017-01959; IPR2017-01960), Genentech opposed because Bioepis's assertions that it would *try* to coordinate and work with the original petitioner provided no real assurance that joinder would in fact create no additional burden for the Board, the original petitioner, or Genentech.

(IPR2017-01958, Paper 7; IPR2017-01959, Paper 7; IPR2017-01960, Paper 7.)

However, recognizing that joinder *could* promote economy and efficiency, Genentech proposed certain conditions to ensure that Bioepis maintained its "understudy" role unless and until the original petitioner entered into a settlement with Genentech. (*Id.*)

In IPR2017-01960, the Board granted joinder without any conditions, reasoning that those proposed by Genentech may discourage petitioners from seeking joinder and may otherwise "be at odds with [the Board's] discretion to managing this case." (IPR2017-01960, Paper 8 at 5-6.) Certainly, Genentech does not mean to suggest limitations on the Board's management of this or any proceeding. But Genentech does believe that some conditions are appropriate to ensure that Bioepis maintains its "understudy" role.

Indeed, even Bioepis invited the Board to enter conditions to Bioepis's joinder, noting that "[t]he Board may simplify discovery and briefing procedures via procedures it has used in the past." (IPR2017-02139, Paper 3 at 6.) Beyond

the proceedings cited by Bioepis (*see id.*), numerous examples exist where the Board has exercised its discretion to impose conditions on joinder. For example, in *Argentum Pharm. LLC v. West-ward Pharm. Int'l, Ltd.*, IPR 2017-01063, Paper 11 (PTAB Sept. 25, 2017) the Board found that adopting certain proposed requirements of the patent owner was “appropriate and in keeping with procedures followed by the Board in other cases of joinder where the joining parties filed identical Petitions with identical evidence.” (*Id.* at 7.) These conditions included that (1) “any paper, except for a motion that does not involve the other Petitioners, shall be filed by the [original petitioner] as a single, consolidated filing on behalf of [all petitioners] pursuant to the page limits set forth in 37 C.F.R. § 42.24;” (2) counsel for the original petitioner “will conduct cross-examination and other discovery on behalf of [the joining petitioner], and [the patent owner] is not required to provide separate discovery responses or additional deposition time as a result of the joinder;” and (3) the petitioners “will designate attorneys to present at the oral hearing (if requested and granted) as a consolidated presentation.” (*Id.* at 7-8; *see also, e.g., Torrent Pharm Ltd. v. UCB Pharma GMBH*, IPR2016-01636, Paper 10 at 7-8 (PTAB Dec. 7, 2016) (requiring that (1) all filings by the joining party be consolidated with the original petitioner “unless the filing involves an issue unique to [the joining party] or states a point of disagreement related to the consolidated filing,” and the party receives authorization from the Board; (2) “the

page limits set forth in 37 C.F.R. § 42.24 will apply to all consolidated filings”; and (3) the joining party “is bound by any discovery agreements, including deposition arrangements between the Patent Owner and [original party], and shall not seek any discovery beyond that sought by the [original petitioner]”); *SL Corp. v. Adaptive Headlamp Techs., Inc.*, IPR2016-01368, Paper 9 at 9 (PTAB Nov. 16, 2016) (adopting conditions proposed in motion by petitioner that it shall not “actively participate,” “file additional written submissions,” “pose questions at depositions,” or “argue at oral hearing” absent prior leave from the Board).

Genentech believes that similar conditions in this proceeding will ensure that it runs efficiently, that any prejudice to Genentech is minimized, and that misunderstandings regarding Bioepis's role are kept to a minimum. Accordingly, if the Board grants joinder, Genentech respectfully requests that the Board impose the following conditions:

1. For so long as the Pfizer IPR remains pending following joinder, Bioepis agrees to incorporate its filings with those of Hospira into a consolidated filing in the Pfizer IPR, including being subject to the ordinary rules for one-party page limits, unless Bioepis receives prior authorization from the Board. *See Argentum Pharm. LLC*, IPR 2017-01063, Paper 11 at 7-8 (imposing same condition on joining party); *Torrent Pharm.*, IPR2016-01636, Paper 10 at 7-8 (same); *see also* IPR2017-02139, Paper 3 at 6 (acknowledging that “the Board may

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