

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC. and APOTEX CORP.

Petitioners

v.

ABRAXIS BIOSCIENCE, LLC

Patent Owner

U.S. Patent No. 7,820,788
Filed: October 26, 2006
Issued: October 26, 2010
Inventor: Neil P. Desai, et al.

TITLE: COMPOSITIONS AND METHODS OF
DELIVERY OF PHARMACOLOGICAL AGENTS

Inter Partes Review No.: IPR2018-00152

**PETITIONERS' MOTION FOR JOINDER PURSUANT
TO 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 & 42.122(b)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 & 42.122(b), Petitioners Apotex Inc. and Apotex Corp. (“Apotex”) request institution of an *inter partes* review concerning U.S. Patent No. 7,820,788 (“the ’788 patent”) and move for joinder with the *inter partes* review concerning the same patent, *Actavis LLC v. Abraxis BioScience, LLC*, IPR2017-01101 (the “Actavis IPR”) that was instituted on October 10, 2017.

In view of the Board’s Representative Order outlining issues to be addressed in a motion for joinder (*Kyocera Corp. et al. v. Softview LLC*, Paper No. 15, IPR2013-00004, Apr. 24, 2013), Petitioners submit that: (1) joinder is appropriate because it will promote efficient resolution of the proceedings without prejudice to the prior petitioner and patent owner, Actavis LLC (“Actavis”) and Abraxis BioScience, LLC (“Abraxis”), respectively; (2) Petitioners’ IPR petition (“Apotex Petition”) does not raise new grounds of unpatentability over those instituted by the Board in the Actavis IPR; (3) joinder would not affect the pending schedule in the Actavis IPR; and (4) Petitioners and Actavis agree to submit consolidated filings to minimize the burden and the impact on the schedule. *See, e.g., Advanced Micro Devices Inc. v. Zond LLC*, Paper No. 12, IPR2014-01042 (Nov. 7, 2014) and *Amneal Pharm., LLC v. Yeda Res. & Dev. Co., Ltd.*, Paper No. 9, IPR2015-01976 (Dec. 28, 2015) (granting motions for joinder under similar circumstances). Petitioners have

also agreed to work with Actavis and take an “understudy” role in the joint IPR so long as Actavis does not settle and/or dismiss the Actavis IPR.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 & § 42.122(b) because it is submitted within one month from the October 10, 2017 date the Board instituted the Actavis IPR. Actavis IPR, Paper No. 7.

II. STATEMENT OF MATERIAL FACTS

1. On April 6, 2016, Abraxis filed a complaint against Actavis asserting infringement of the '788 patent and related U.S. Patent Nos. 8,138,229 and 7,923,536. *Abraxis BioScience, LLC et al., v. Actavis LLC*, No. 2:16-cv-01925 (D.N.J).

2. On April 4, 2017, Actavis filed a petition for *inter partes* review of the '788 patent, alleging unpatentability of all claims on anticipation and obviousness grounds. Actavis IPR, Paper No. 2.

3. On July 12, 2017, Abraxis filed a Preliminary Patent Owner's response. *Id.*, Paper No. 6.

4. On October 10, 2017, the Board instituted trial on the grounds of unpatentability raised by Actavis for Claims 1-12 of the '788 patent. *Id.*, Paper No. 7.

5. On November 9, 2017, Petitioners filed the Apotex Petition and Motion for Joinder within one month of the Actavis IPR October 10, 2017 institution date.

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