

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS, INC.,
Petitioner,

v.

ANACOR PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2018-01358
Patent 9,549,938 B2

Before GRACE KARAFFA OBERMANN, TINA E. HULSE, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Mylan Pharmaceuticals, Inc. (“Mylan”) filed a Petition requesting an *inter partes* review of claims 1–6 of U.S. Patent No. 9,549,938 B2 (Ex. 1001, “the ’938 patent”). Paper 2 (“Pet.”). Along with the Petition, Mylan filed a Motion for Joinder to join this proceeding with *FlatWing Pharmaceuticals, LLC v. Anacor Pharmaceuticals, Inc.*, IPR2018-00168. Paper 3 (“Motion” or “Mot.”). Mylan filed the Petition and Motion on July 6, 2018, within one month after we instituted trial in IPR2018-00168 on June 8, 2018. 37 C.F.R. § 42.122(b); *see FlatWing*, IPR2018-00168, Paper 9 (PTAB June 8, 2018). Anacor Pharmaceuticals, Inc. (“Patent Owner”) filed an Opposition to Mylan’s Motion for Joinder¹ (Paper 8) and Mylan filed a Reply (Paper 10). In a subsequent e-mail correspondence to the Board on September 27, 2018, the parties informed the Board that Patent Owner “no longer opposes Mylan’s motions for joinder.” Ex. 3001.

As explained further below, we institute trial on the same grounds as instituted in IPR2018-00168 and grant Mylan’s Motion for Joinder.

II. DISCUSSION

In IPR2018-00168, FlatWing Pharmaceuticals, LLC (“FlatWing”) challenged claims 1–6 of the ’938 patent on the following grounds:

¹ Patent Owner also filed a motion to request acceptance of its PTAB E2E submission due to technical difficulties with filing its Opposition. Paper 9. Absent opposition from Mylan, we find good cause exists to grant that request for the reasons stated in Patent Owner’s motion. *Id.* Patent Owner’s motion is, therefore, *granted*.

References	Basis	Claims challenged
Austin ² and Brehove ³	§ 103	1 and 2
Austin, Brehove, and Samour ⁴	§ 103	3–6
Austin and Freeman ⁵	§ 103	1 and 2
Austin, Freeman, and Samour	§ 103	3–6

After considering the Petition (Patent Owner did not file a Preliminary Response), we instituted trial in IPR2018-00168 on all four grounds. IPR2018-00168, Paper 9, 15.

Mylan’s Petition is substantively identical to FlatWing’s Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2018-00168, Paper 1 *with* IPR2018-01358, Paper 2. For the same reasons stated in our Decision on Institution in IPR2018-00168, we institute trial in this proceeding on the same four grounds. *See* IPR2018-00168, Paper 9.

Having determined that institution is appropriate, we now turn to Mylan’s Motion for Joinder. Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f the Director institutes an inter partes review, the

² Austin et al., WO 95/33754, published Dec. 14, 1995 (“Austin,” Ex. 1007).

³ Brehove, US 2002/0165121 A1, published Nov. 7, 2002 (“Brehove,” Ex. 1008).

⁴ Samour et al., US 6,224,887 B1, issued May 1, 2001 (“Samour,” Ex. 1010).

⁵ Freeman et al., WO 03/009689 A1, published Feb. 6, 2003 (“Freeman,” Ex. 1009).

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).

Under the circumstances of this case, we determine that joinder is appropriate. As Mylan notes, the Petition in this proceeding is substantially identical to the Mylan Petition with no substantive differences. Mot. 1–2. Mylan relies on the same expert declarations submitted in IPR2018-00168. *Id.* Moreover, Mylan has agreed to assume a “silent understudy” role in the joined proceedings, as long as FlatWing remains a party to the proceeding Reply 1–3. Mylan further contends that there will be no impact on the trial schedule of IPR2018-00168, and that joinder will promote the just, speedy, and inexpensive resolution of the proceedings without prejudice to the parties. Mot. 4–8.

In view of the foregoing, we find that joinder based upon the conditions stated in Mylan’s Motion for Joinder (and its Reply) 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, Mylan’s Motion for Joinder is granted.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–6 of the ’938 patent is instituted with respect to all grounds set forth in the Petition;

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FURTHER ORDERED that Mylan's Motion for Joinder with IPR2018-00168 is granted;

FURTHER ORDERED that IPR2018-01358 is terminated and joined to IPR2018-00168, pursuant to 37 C.F.R. §§ 42.72 and 42.122, based on the conditions stated in Mylan's Motion for Joinder (Papers 3, 10), as discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2018-00168 (Paper 10) shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2018-00168;

FURTHER ORDERED that the case caption in IPR2018-00168 for all further submissions shall be changed to add Mylan as a named Petitioner with FlatWing, and to indicate by footnote the joinder of IPR2018-01358 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-00168.

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