

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SAWAI USA, INC. and SAWAI PHARMACEUTICAL CO., LTD.

Petitioners,

v.

BIOGEN MA INC.,

Patent Owner.

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Case IPR2019-00789

Patent 8,399,514

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**PATENT OWNER'S OPPOSITION TO  
PETITIONER'S MOTION FOR JOINDER**

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## I. Introduction

Time-barred Petitioner Sawai<sup>1</sup> filed its motion for joinder with IPR2018-01493 (“Mylan IPR”) on the next to last possible day. Instead of relying on the Mylan IPR declarants, however, Sawai introduces new declarants and further creates a new real party in interest (“RPI”) problem. The need to address the new declarants and new RPI issues will interfere with and delay the Mylan IPR. Sawai also fails to justify joinder where Sawai’s district court trial has been scheduled for December 9, 2019, several weeks before the February 6, 2020, date for a final decision in the Mylan IPR.

Sawai’s motion should be denied.

## II. Legal Standard: Joinder Should Be Denied Where It Would Cause Inconvenience or Delay

In deciding whether to permit joinder of one *inter partes* review with another under 35 U.S.C. § 315, the Board “take[s] into account the particular facts of each case, substantive and procedural issues, and other considerations.”

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<sup>1</sup> See Paper 1 at 2, identifying as a related litigation involving U.S. Patent No. 8,399,514, *Biogen Int’l GmbH v. Sawai USA, Inc.*, C.A. No. 17-cv-00875 (D. Del.), in which Biogen served the complaint on Sawai more than a year before Sawai’s petition in this IPR.

*Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (PTAB Aug. 13, 2014 (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl))). The burden to prove that joinder is appropriate rests solely on the movant and the Board's decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. §§ 42.20(c), 42.122; *Medtronic, Inc. v. Norred, Troy*, IPR2014-00823, Paper 12 at (Dec. 8, 2014) (denying joinder where "Petitioner's stated reasons for allowing joinder do not outweigh meaningful reasons not to allow joinder").

Considerations relevant to the Board's discretion include (1) impact on the trial schedule for the existing review, (2) complication of briefing and discovery, and (3) adverse effects on potential settlements. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11 at 3 (PTAB Oct. 24, 2014); *Macronix*, IPR2014-00898, Paper 15 at 4 (quoting *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)); *Global Foundries U.S. Inc. v. Godo Kaisha IP Bridge 1*, IPR2017-00926, Paper 12 at 10 (PTAB Jun. 9, 2017). For example, the Board recognizes that additional discovery, at least cross-examination of the new declarants, will be required where the joining petitioner relies on new declarants and denies "Motion[s] for Joinder [that do] not offer a practical way to accommodate the additional discovery without inconveniencing all involved or delaying the due dates in the [earlier] IPR." *Mylan Pharma., v Janssen Oncology, Inc.*, IPR2016-01332, Paper 21 at 11 (PTAB Jan. 10, 2017); *see*

also 37 C.F.R. § 42.51(b)(1)(ii). Similarly, the “potential for additional discovery [to address Petitioner’s failure to identify all RPIs] presents a new substantive issue. . . and, as a result, weighs in favor of denying Petitioner’s Motion for Joinder.” *Unified Patents Inc. v. Personalized Media Commc’ns, LLC*, IPR2015-00521, Paper 14 at 5 (PTAB Jun. 8, 2015).

### **III. Joinder with Sawai Would Inconvenience and Delay the Mylan IPR**

The Board should deny Sawai’s motion because joinder would obstruct the “just, speedy, and inexpensive resolution” of the Mylan IPR. *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (PTAB Jul. 29, 2013) (“When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).”). First, Sawai’s petition adds new declarants, each of whom will need to be cross-examined. Yet, Sawai offers no proposal to accommodate this additional discovery without prejudicing Biogen and delaying the Mylan IPR. Second, Sawai’s petition adds new substantive issues concerning its identification of all RPIs as required under 35 U.S.C. § 312(a)(2). This new issue, coupled with Sawai’s failure to coordinate with Mylan regarding declarants, indicates that Sawai will have an active role in, and interfere with, the Mylan IPR. Sawai points to no case granting joinder under such circumstances. Finally, Sawai provides no valid

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