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Subject: IPR2019-00789 (IPR2018-01403): Request for Precedential Opinion Panel Review
Attachments: 2019.09.26 Patent Owner's Rehearing Request on Institution and Joinder o....pdf

To the Honorable Board,

Based on my professional judgment, I believe this case requires an answer to three precedent-setting questions of exceptional importance:

1. Whether joinder of a second petitioner under 35 U.S.C. § 315(c) is improper where patent owner is precluded from responding to the joined petitioner's petition, introduce responsive evidence of its own, and challenge the joined petitioner's new evidence.

2. Whether joinder under 35 U.S.C. § 315(c) of an otherwise § 315(b) time-barred petitioner is improper where the joined petitioner provides no justification for the late filing of its petition, identifies no special circumstances warranting exercise of discretion, and/or relies upon new witnesses, new declarations, or otherwise raises new issues.

3. Whether institution is improper when the petitioner fails to identify in the petition all RPIs at the time of filing pursuant to 35 U.S.C. § 312(a)(2) and/or when patent owner has brought into question the accuracy of petitioner's initial RPI identification, but the petitioner fails to adduce any competent evidence in support of petitioner's burden to prove compliance with 35 U.S.C. § 312(a)(2), or the Board fails to rely on any such evidence.

The "Director has an interest in creating binding norms for fair and efficient Board proceedings, and for establishing consistency across decision makers." Patent Trial and Appeal Board ("PTAB") Standard Operating Procedure 2 (Rev. 10) ("SOP2"), 2. To that end, Precedential Opinion Panel ("POP") review "may be used to . . . to promote certainty and consistency" or "to rehear any case it determines warrants the Panel's attention." SOP2, 4.

I. POP Review is Needed

The Board's Institution Decision (Paper 17, "Dec.") misapprehended, overlooked, and improperly decided the issue of joinder for otherwise time-barred Sawai. Contrary to the Decision's findings (Dec., 10-11, 19-21), Sawai's Petition was not a true "copycat" petition because it relied upon new declarants. *See* Dec., 5. The Decision is inconsistent with other panels and a POP decision establishing that joinder is inappropriate where, as here, different experts are relied on and no justification exists for the late filing of the petition. *See, e.g., Proppant Express Investments, LLC v Oren Technologies, LLC*, IPR2018-00914, Paper 38 at 19 (PTAB Mar. 13, 2019) (precedential); *ZTE Corp. v. Adaptix, Inc.*, IPR2015-01184, Paper 10 at 5 (PTAB July 24, 2015). Further, as a result of the joinder decision and termination of Sawai's IPR, Patent Owner has been denied the

opportunity to be heard on and cross-examine the Sawai declarants, including technical experts, relied upon by Sawai in its petition—*e.g.*, Dr. Baumhefner (Ex. 1056), Dr. Bainbridge (Ex. 1057), Dr. Marks (Ex. 1058), Ms. Rock (Ex. 1059), and Mr. Hiramatsu on RPI (Ex. 1060)—all now insulated from review. IPR2019-00789, Paper 14 at 2-3, 23-24; 5 U.S.C. §§ 554-556. The joinder of Sawai to the Mylan IPR at this stage—with the accompanying *sua sponte* termination and lack of Biogen discovery from Sawai and its declarants—violates Patent Owner's due process rights. *E.g., Goldberg v. Kelly*, 397 U.S. 254, 269 (1970); *Facebook, Inc. v. Windy City Innovations, LLC*, IPR2016-01156, Paper 39 at 5 (PTAB Aug. 14, 2017); 28 U.S.C. §§ 554-556; 37 C.F.R. § 42.51(b)(1)(ii). In short, Sawai's reliance upon new evidence raised issues that cannot properly be addressed merely by terminating Sawai's petition and abandoning the evidence.

The Decision also improperly granted institution by misapprehending, overlooking, and erroneously deciding that the Real Party in Interest ("RPI") was properly named in the petition. 35 U.S.C. § 312(a)(2). The Decision's RPI analysis overlooked the evidence and argument that Sumitomo Corporation and SCOA (collectively "Sumitomo") are unnamed RPIs via an "attorney-in-fact" or "implied litigating agent" relationship with Sawai. IPR2019-00789, Paper 15, 7-9, 12-13; *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351, 1354 (Fed. Cir. 2018) ("*AIT*"). Rather than assessing this argument and applying the RPI analysis of *AIT*, the Decision only addressed whether "Sumitomo or SCOA exercise[d] control of this proceeding or otherwise 'desires review' of the patent.'" Dec., 17. The Decision further erred, after finding that Biogen "reasonably br[ought] into question the accuracy of a petitioner's identification of RPIs," Dec., 13, by holding that *Patent Owner* had "not persuaded" the Board that there were unnamed RPIs. *Id*., 15, 17. This was contrary to the established framework that *petitioner* always bears the burden of persuasion to establish compliance with the statutory requirement to identify all RPIs. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242-46 (Fed. Cir. 2018).

The Board's improper grant of institution, joinder, and termination in this proceeding merits POP review.

II. Patent Owner's Request for POP Review is Timely

SOP2 requires that this "email be accompanied by a request for rehearing filed with the Board." SOP2, 5 (emphasis added). According to SOP2, § II(C), Patent Owner attaches herewith Patent Owner's Request for Rehearing Under 37 C.F.R. § 42.71(d), which was simultaneously filed along with this request and is now pending before the Board. *See* No. IPR2018-01403, Paper 62 and No. IPR2019-00789, Paper 18. Petitioner's request for rehearing satisfies the requirements of 37 C.F.R. § 42.71(d), including compliance with the due dates set forth therein. *See id*.

For the above-stated reasons, Petitioner respectfully requests POP review of the PTAB panel decision.

Respectfully submitted,

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cc: All counsel of record

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