

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner

Case IPR2019-00977
Patent No. 8,603,044 B2

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c)
AND 37 C.F.R. §§ 42.22, 42.122(b)**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via the PTAB E2E System

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Pfizer Inc. (“Petitioner”) respectfully moves for joinder and/or consolidation of its today-filed petition for *Inter Partes* Review (“IPR”) of claims 11, 14, 15, 18, and 19 of U.S. Patent No. 8,603,044 B2 (“the ’044 patent”) with a previously instituted and currently pending IPR, captioned *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH.*, No. IPR2018-01675 (the “Mylan IPR”).

The Mylan IPR was instituted on April 2, 2019, on the same patent and the same claims as Petitioner’s Petition (the “Petition”) filed today. Further, Petitioner here asserts that the same claims are obvious over the same prior art based on substantially the same arguments presented in the Mylan IPR.

Petitioner has asked Mylan if it consents to joinder. As of the date of this motion, Petitioner and Mylan are in the process of discussing that request, and Mylan has not yet indicated whether it consents to this motion.

Joinder will not cause any delay in the resolution of the Mylan IPR. Joinder, therefore, is appropriate because it will promote the efficient and consistent resolution of the same patentability issues with respect to the ’044 patent, it will not delay the Mylan IPR trial schedule, and the parties in the Mylan IPR will not be prejudiced.

Petitioner also agrees to abide by and adopt all of the actions and proceedings in the Mylan IPR that may occur prior to the Board reaching its decision on the instant Petition and motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. Sanofi-Aventis Deutschland GmbH (“Patent Owner”) purportedly owns the ’044 patent.

2. Petitioner identifies the following previous litigation related to the ’044 patent:

- The ’044 patent was asserted in *Sanofi-Aventis U.S. LLC v. Merck Sharp & Dohme Corp.*, No. 1:16-cv-00812 (D. Del.), *Sanofi-Aventis U.S. LLC v. Eli Lilly and Co.*, No. 1:14-cv-00113 (D. Del.), *Sanofi-Aventis U.S. LLC v. Eli Lilly and Co.*, No. 1:14-cv-00884 (D. Del.), and *Sanofi-Aventis U.S. LLC, et al. v. Mylan GmbH, et al.*, No. 1:17-cv-00181 (N.D.W. Va.).

3. Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ’044 patent. The following litigation or *inter partes* reviews related to the ’044 patent are pending:

- On April 2, 2019, the Board granted institution of *inter partes* review in the Mylan IPR. Mylan IPR, Paper 28.

- On April 2, 2019, the Board also granted institution of *inter partes* review in *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, Case IPR2018-01676.
- The '044 patent has been asserted in *Sanofi-Aventis U.S. LLC, et al. v. Mylan GmbH, et al.*, No. 2:17-cv-09105 (D.N.J.).

4. The Board instituted the Mylan IPR on one ground: Claims 11, 14, 15, 18, and 19 as obvious under 35 U.S.C. § 103(a) over Burroughs.

5. Along with its Motion for Joinder, Petitioner here has simultaneously filed a Petition for *Inter Partes* Review, No. IPR2019-00977, which argues, *inter alia*, that the same claims of the '044 patent are obvious over the same grounds and for substantially the same reasons set forth in the Mylan IPR. The Petition is also supported by the expert declaration of Charles Clemens. The opinions set forth in Mr. Clemens's declaration are nearly identical to the opinions set forth in the declaration of Mr. Karl R. Leinsing filed in the Mylan IPR (Mylan IPR Ex. 1011).

The grounds proposed in the present Petition are therefore the same grounds of unpatentability on which the Board instituted the Mylan IPR, and the Petition does not contain any additional arguments or evidence (except for reliance on a different expert, as noted above) in support of the unpatentability of claims 11, 14, 15, 18, and 19 of the '044 patent.

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