UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner

Case IPR2019-00978
Patent U.S. 8,603,044

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTIONS FOR JOINDER

Patent Owner ("Sanofi") respectfully submits this response to Petitioner's ("Pfizer") Motions for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22, 42.122(b) of IPR Nos. 2019-00977, 2019-00978, 2019-00980, 2019-00981, 2019-00982, 2019-00987, 2019-01022, and 2019-01023 ("Pfizer IPRs"), respectively, to IPR Nos. 2018-01675, 2018-01676, 2018-01678, 2018-01679, 2019-00122, 2018-01684, 2018-01680, and 2018-01682 filed by Mylan Pharmaceuticals Inc. (collectively the "Mylan 044, 486, 008 and 844 IPRs").[1] Sanofi has also concurrently filed a waiver of its Preliminary Response in the above Pfizer IPRs. As set forth herein, Sanofi does not oppose joinder based on the representations made by Pfizer in its Motion for Joinder, but submits that a 1-month extension of the schedule is warranted in order to accommodate joinder of Pfizer to the Mylan 044, 486, 008 and 844 IPRs.

In its Motion for Joinder, Pfizer represented to the Board that (1) its petitions present the exact same grounds instituted in the Mylan 044, 486, 008, and 844 IPRs and there are no new grounds of unpatentability; (2) its arguments and accompanying expert declarations by Charles Clemens are substantively identical to the arguments and expert declarations by Karl Leinsing in the Mylan 044, 486, 008,

[1] A separate response has been filed in IPR2019-00979 (U.S. 8,679,069) which Pfizer is seeking to join with IPR2018-01670.

and 844 IPRs; (3) it agrees to take an understudy role in these proceedings if joinder is granted, and only assume a primary role if Mylan ceases to participate in the IPRs; and (4) it will coordinate with Mylan to facilitate the elimination of repetitive briefs and testimony. Sanofi has further confirmed with Pfizer that the above representations mean that Pfizer, as an understudy to Mylan, will not seek time to take the deposition of any Sanofi declarants.

While Sanofi does not oppose Pfizer's Motion for Joinder under the conditions listed above, pursuant to 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c), a modest 1-month extension[2] of the entire schedule is needed if joinder is granted. Specifically, an extension is necessary to allow sufficient time to cross-examine Mr. Clemens, and incorporate both his and Mr. Leinsing's testimony into Sanofi's Patent Owner Responses, which are all currently due on June 25, 2019. Even accepting Pfizer's representations that the Pfizer IPRs present identical grounds and substantively identical arguments as the Mylan 044, 486, 008, and 844 IPRs, and that Pfizer will take on an understudy role if the proceedings are joined,

[2] Patent Owner proposes a 1-month extension, as opposed to a 2- or 3-week extension, because of the intervening July 4th holiday and the fact that Patent Owner will also be preparing opening expert reports in the co-pending litigation between Sanofi and Mylan in the District of New Jersey currently due on July 15, 2019.

the parties must still coordinate scheduling for both Mr. Clemens and Mr. Leinsing to be cross-examined on their respective opinions in nine IPR proceedings on five patents. Assuming Pfizer agrees to make Mr. Clemens available for deposition in accordance with the time limits that Patent Owner and Mylan have negotiated for Mr. Leinsing's depositions (35 hours of cross examination, 20 hours of redirect examination, and 10 hours of re-cross examination), the parties will need to schedule 65 hours of deposition time sufficiently in advance of Due Date 1 so that Patent Owner has a full and fair opportunity to incorporate the deposition testimony into its Patent Owner Responses.

Furthermore, extending only Due Date 1, while leaving the remaining dates in the schedule in place would unnecessarily tighten the schedule. The Board's rules specifically contemplate and allow for extensions of the schedule because of joinder. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). Moreover, Patent Owner anticipates similar scheduling issues in connection with at least Due Dates 2 and 3 due to the need to schedule numerous days of cross-examination on Patent Owner's responsive declarations and Pfizer's and Mylan's reply declarations. For example, extending Due Date 1 to July 30, 2019 while leaving Due Date 2 on September 17, 2019 as currently scheduled would require the parties to schedule depositions of Patent Owner's declarant on five patents in nine IPR proceedings during a period of less than two months. Likewise, extending Due Date 2 by one month to October 22,

2019 while leaving Due Date 3 on October 29, 2019 as currently scheduled would require Patent Owner to depose Mylan's and Pfizer's reply declarants and prepare sur-replies in each of the nine IPR proceedings within *one week* of receiving Mylan's and Pfizer's replies. Thus, Patent Owner's proposed one month extension of the entire schedule is necessary in order to avoid compressing the time between substantive due dates to the prejudice of the parties. The proposed extension is set forth in the table below:

	Current Schedule	**Revised Schedule**
Due Date 1 - Patent Owner Response - Motion to Amend ("MTA")	June 25, 2019	July 30, 2019
Due Date 2: - Petitioner Reply to POR - Petitioner Opposition to MTA	September 17, 2019	October 22, 2019
Due Date 3: - Patent Owner Sur-reply - Patent Owner Reply on MTA	October 29, 2019	December 3, 2019
Due Date 4 - Request for Oral Argument	November 19, 2019	December 20, 2019
Due Date 5 - Petitioner Sur-Reply on MTA - Motions to Exclude Evidence	December 6, 2019	January 10, 2020
Due Date 6 - Oppositions to Mot. to Exclude - Request for Prehearing Conference	December 13, 2019	January 17, 2020

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