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Paper 33
Date: December 4, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

NOVO NORDISK A/S,
Patent Owner.

IPR2020-01252
Patent 8,114,833 B2

Before ERICA A. FRANKLIN, JOHN G. NEW, and
SUSAN L.C. MITCHELL, *Administrative Patent Judges.*

FRANKLIN, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review and Granting Motion for Joinder
35 U.S.C. § 314; 37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

Pfizer Inc. Institutional LLC ("Petitioner" or "Pfizer") timely filed a Petition requesting an *inter partes* review of claims 1–31 of U.S. Patent No. 8,114,833 B2 (Ex. 1001, "the '833 patent"). Paper 2 ("Petition" or "Pet."). Petitioner also filed a Motion for Joinder to join this proceeding with *Mylan Institutional LLC. v. Novo Nordisk A/S*, IPR2020-00324 (the "Mylan IPR"), which was instituted on June 23, 2020. Paper 3 ("Mot.").

Novo Nordisk A/S ("Patent Owner") did not file a Preliminary Response to the Petition or an opposition to the joinder motion.

For the reasons set forth below, we (1) institute an *inter partes* review in this proceeding based on the same grounds instituted in the Mylan IPR, and (2) grant Pfizer's Motion for Joinder, subject to the conditions detailed herein.

II. INSTITUTION OF *INTER PARTES* REVIEW

In the Mylan IPR, we instituted trial on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–15	102(b)	Flink[1]
1–15	103(a)[2]	Flink
1–31	103(a)	Flink, Betz[3]

Mylan IPR, Paper 13.

[1] Flink et al., PCT Publication No. WO 03/002136 A2, published Jan. 9, 2003 ("Flink," Ex. 1004).
[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the '833 patent issued was filed before this date, the pre-AIA version of § 103 applies.
[3] Betz et al., PCT Publication No. WO 04/004781 A1, published Jan. 15, 2004 ("Betz," Ex. 1005).

Pfizer's Petition is substantially identical to the petition in the Mylan IPR and seeks only to challenge the same claims based upon the same grounds and prior art involved in the Mylan IPR, and for the same reasons set forth in the Mylan IPR. *See* Pet. 4. Petitioner relies on the Declaration of Laird Forrest, Ph.D. (Ex. 1002), who is the same expert relied upon by the petitioner in the Mylan IPR. Dr. Forrest's declaration testimony submitted in this proceeding is identical to what was submitted in the Mylan IPR. *Compare* Ex. 1002, *with* Mylan IPR, Ex. 1002.

Patent Owner has not filed a Preliminary Response in this proceeding. Thus, at this stage of the proceeding, Patent Owner has not raised any arguments in response to the substantive grounds of the Petition.

Having considered the Petition, we determine that, under the current circumstances, it is appropriate to exercise our discretion to institute an *inter partes* review of the challenged claims based upon the same grounds authorized and for the same reasons discussed in our Institution Decision in the Mylan IPR. *See* Mylan IPR, Paper 13.

III. JOINDER OF *INTER PARTES* REVIEWS

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

> (c) JOINDER. — If the Director institutes an inter partes review, the 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); *see also*, "Frequently Asked Questions H5," https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions.

Petitioner timely filed its Joinder Motion within one month of the institution of the Mylan IPR, as required by 37 C.F.R. § 42.122(b). *See* Paper 6 (Notice of Filing Date Accorded to Petition). In the motion, Petitioner explains that it will "maintain a secondary role in the proceeding, if joined [with the Mylan IPR proceeding]. Petitioner will assume a primary role only if the Mylan IPR petitioner ceases to participate in the IPR." Mot. 3, 6. As discussed in the Institution Decision, Section III above, the instituted grounds in this proceeding (the "Pfizer IPR") are the same as the instituted grounds in the Mylan IPR.

Having considered the unopposed motion for joinder, and our decisions to institute the same ground in the Mylan IPR and the Pfizer IPR, we determine that Petitioner Pfizer has established persuasively that joinder is appropriate and will have little to no impact on the timing, cost, or presentation of the trial on the instituted ground. Thus, in consideration of the foregoing, and in the manner set forth in the following Order, the Motion for Joinder is *granted*.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that trial is instituted in IPR2020-01252 for claims 1–31 of the '833 patent on all grounds set forth in the Petition;

FURTHER ORDERED that Pfizer's Motion for Joinder with IPR2020-00324 is *granted*;

FURTHER ORDERED that IPR2020-01252 is terminated and joined with IPR2020-00324, pursuant to 37 C.F.R. §§ 42.72, 42.122, wherein Pfizer will maintain a secondary role in the proceeding, unless and until Mylan ceases to participate as a petitioner in the *inter partes* review;

FURTHER ORDERED that the Scheduling Order in place for IPR2020-00324 shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2020-00324;

FURTHER ORDERED that the case caption in IPR2020-00324 for all further submissions shall be changed to add Pfizer Inc. as a named Petitioner after the Mylan Petitioner, and to indicate by footnote the joinder of IPR2020-01252 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall also be entered into the record of IPR2020-00324.

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