

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TEVA PHARMACEUTICALS USA, INC. and  
WATSON LABORATORIES, INC.,  
Petitioner,

v.

MERCK SHARP & DOHME CORP.,  
Patent Owner.

U.S. Patent No. 7,326,708 to Cypes et al.

Issue Date: February 5, 2008

Title: Phosphoric Acid Salt of a Dipeptidyl Peptidase-IV Inhibitor

*Inter Partes* Review No.: IPR2020-01045

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**PETITIONER'S MOTION FOR JOINDER  
UNDER 37 C.F.R. §§ 42.22 AND 42.122(b)**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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## I. STATEMENT OF RELIEF REQUESTED

Petitioners Teva Pharmaceuticals USA, Inc. and Watson Laboratories, Inc. (hereinafter “Teva” or “Petitioner”) respectfully request joinder of the concurrently filed petition for *inter partes* review of U.S. Patent No. 7,326,708 (“the ’708 patent”) (IPR2020-01045) with *Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, filed October 30, 2019 and instituted May 12, 2020 (hereinafter, “the Mylan IPR”). *See* IPR2020-00040, Paper 21. The instant Petition is the same as the Mylan IPR: it involves the same patent, claims, grounds of unpatentability, and evidence (including the same prior art combinations) as the Mylan IPR. If joined, as discussed further below, Teva will assume a “silent understudy” role and will not take an active role in the *inter partes* review proceeding unless the Mylan IPR Petitioner ceases to participate in the instituted IPR.

While the instant Petition includes the declaration of Dr. Chyall, this declaration presents identical expert testimony to that put forth by Dr. Chorghade in the Mylan IPR. *Compare* Chyall Decl. EX 1002, with *Mylan Pharms. Inc. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, EX 1002, Decl. of Dr. Mukund Chorghade, Ph.D. (“Chorghade Decl.”). If Mylan allows Teva to use Dr. Chorghade, then Teva will withdraw Dr. Chyall’s Declaration and will rely only on Dr. Chorghade. The PTAB has acknowledged that such concessions are sufficient

to minimize the impact on the original proceeding. *Mylan Pharms. Inc. v. Almirall, LLC*, IPR2019-01095, Paper 12 at 7-8 (Nov. 27, 2019); *SAP Am. Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13 at 4 (May 19, 2014). Thus, the proposed joinder will neither unduly complicate the Mylan IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the Mylan IPR without prejudice to Patent Owner.

The Motion for Joinder and accompanying Petition are timely because they are filed less than one month after the May 12, 2020 decision instituting trial in the Mylan IPR. 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested.”); *see, e.g., Kingston Tech. Co. v. Securewave Storage Solutions, Inc.*, IPR2020-00139, Paper 12 at 6-7 (PTAB Mar. 23, 2020) (holding that “me-too” petition was timely where it was filed more than one year after petitioner was sued for infringement but within one month of the institution of the IPR which petitioner sought to join); *Central Sec. Grp.-Nationwide, Inc. v. Ubiquitous Connectivity, L.P.*, IPR2019-01609, Paper 11 at 8-9 (“The *only* timing requirement for a motion for joinder is that it be filed ‘*no later than one month after the institution date* of any *inter partes* review for which joinder is requested.’” (first emphasis added)). Moreover, granting a motion for joinder and instituting a “me too” petition that would otherwise be time-barred under 35 U.S.C. § 315(b)

does not prejudice the Patent Owner. *See Nokia of Am. Corp. v. Oyster Optics, LLC*, IPR2018-00984, Paper 9 at 6 (Jul. 27, 2018) (instituting such a petition and determining that joinder would not unduly prejudice the patent owner).

Accordingly, Teva respectfully requests that the Board grant this Motion for Joinder.

## II. STATEMENT OF REASONS FOR RELIEF REQUESTED

### A. Legal Standards

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(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.

“A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address[] specifically how briefing and discovery may be simplified.” *Kingston Tech.*, IPR2020-00139, Paper 12 at 6-7; *see, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11

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