

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUN PHARMACEUTICAL INDUSTRIES LTD.
Petitioner,

v.

MERCK SHARP & DOHME CORP.
Patent Owner.

Case IPR2020-01072
Patent No. 7,326,708

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

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Sun Pharmaceutical Industries Ltd. (“Petitioner”) respectfully moves for joinder and/or consolidation of its today-filed petition for *Inter Partes* Review (“IPR”) of claims 1–4, 17, 19, and 21–23 of U.S. Patent No. 7,326,708 (“the ’708 patent”) with a previously instituted and currently pending IPR, captioned *Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.*, No. IPR2020-00040 (the “Mylan IPR”).

The Mylan IPR was instituted on May 12, 2020, 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 invalid based on substantially the same arguments presented in the Mylan IPR. Moreover, Petitioner’s declaration is substantively identical to the declaration 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 ’708 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. Merck Sharpe & Dohme Corp. (“Patent Owner”) purportedly owns the ’708 patent.

2. Petitioner identifies the following previous litigation related to the ’708 patent: *Merck Sharp & Dohme Corp. v. Macleods Pharmaceuticals, Ltd. et al.*, 1:19-cv-00316 (D. Del.); *Merck Sharp & Dohme Corp. v. Torrent Pharmaceuticals Limited et al.*, 1:19-cv-00320 (D. Del.); *Merck Sharp & Dohme Corp. v. Wockhardt Bio AG et al.*, 1:19-cv-00321 (D. Del.); *Merck Sharp & Dohme Corp. v. Accord Healthcare, Inc.*, 1:19-cv-02192 (D. Del.).

3. Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ’708 patent.

4. The following litigation or *inter partes* reviews related to the ’708 patent are pending:

- On May 12, 2020, the Board granted institution of *inter partes* review in the Mylan IPR. Mylan IPR, Paper 21.
- The following petitions for *inter partes* have been filed: Mylan IPR; *Teva Pharmaceuticals USA, Inc. et al v. Merck Sharp & Dohme Corp.*,

No. IPR2020-01045; *Dr. Reddy's Laboratories, Inc. et al v. Merck Sharp & Dohme Corp.*, No. IPR2020-01060.

- The '708 patent has been asserted in *Merck Sharp & Dohme Corp. v. Sun Pharmaceutical Industries Ltd.*, 1:19-cv-00319 (D. Del.); *Merck Sharp & Dohme Corp. v. Mylan Pharmaceuticals Inc. et al.*, 1:19-cv-00101 (N.D. W. Va.); *Merck Sharp & Dohme Corp. v. Alvogen Pine Brook f/k/a Alvogen Pine Brook, Inc. et al.*, 1:19-cv-00310 (D. Del.); *Merck Sharp & Dohme Corp. v. Anchen Pharmaceuticals, Inc. et al.*, 1:19-cv-00311 (D. Del.); *Merck Sharp & Dohme Corp. v. Sandoz, Inc.*, 1:19-cv-00312 (D. Del.); *Merck Sharp & Dohme Corp. v. Apotex Inc. et al.*, 1:19-cv-00313 (D. Del.); *Merck Sharp & Dohme Corp. v. Zydus Pharmaceuticals (USA) Inc. et al.*, 1:19-cv-00314 (D. Del.); *Merck Sharp & Dohme Corp. v. Watson Pharmaceuticals, Inc. et al.*, 1:19-cv-00317 (D. Del.); *Merck Sharp & Dohme Corp. v. Teva Pharmaceuticals USA, Inc.*, 1:19-cv-00318 (D. Del.); *Merck Sharp & Dohme Corp. v. Lupin Ltd. et al.*, 1:19-cv-00347 (D. Del.); *Merck Sharp & Dohme Corp. v. Mylan Pharmaceuticals Inc. et al.*, 1:19-cv-01489 (D. Del.); and *In re Sitagliptin Phosphate ('708 & '921) Patent Litigation*, C.A. No. 19-md-2902 (D. Del.).

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