

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC,
Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-01817
Patent 8,457,988 B1

Before JACQUELINE WRIGHT BONILLA, SUSAN L. C. MITCHELL, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner Amneal Pharmaceuticals LLC (“Amneal”) filed a Petition requesting *inter partes* review of claims 1–15 of U.S. Patent No. 8,457,988 B1 (“the ’988 patent”). Paper 1 (“Petition” or “Pet.”). Amneal also filed a Motion for Joinder under 35 U.S.C. § 315(c) requesting joinder of the present proceeding with *Par Pharm., Inc. v. Jazz Pharms., Inc.*, Case IPR2015-00551. Paper 3 (“Mot.”).

IPR2015-00551 also challenges claims 1–15 of the ’988 patent owned by Jazz Pharmaceuticals, Inc. (“Patent Owner”). We instituted trial in IPR2015-00551 on July 28, 2015, on the grounds that: (1) claims 1, 3–9, and 11–15 would have been obvious over the “Advisory Committee Art” (Exs. 1003–1006); and (2) claims 2 and 10 would have been obvious over the Advisory Committee Art in view of Korfhage (Ex. 1037)—two grounds and references relied upon by Amneal in the instant Petition. IPR2015-00551, Paper 19. Those same two grounds are the only basis on which Amneal seeks institution of *inter partes* review of claims 1–15 in this case. Pet. 11–12. Amneal filed the Petition and Motion for Joinder in the present proceeding on August 26, 2015, within one month after we instituted trial in IPR2015-00551. 37 C.F.R. § 42.122(b).

II. DISCUSSION

Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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.” *Id.* When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery,

and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

We convened a conference call on November 19, 2015, among counsel for Amneal, Wockhardt Bio AG (“Wockhardt”),¹ Par Pharmaceutical, Inc. (“Par”), and Patent Owner. The purpose of the conference call was to discuss Amneal’s Motion for Joinder, requesting that we join the present case with IPR2015-00551, a case previously joined with IPR2015-01814 in relation to a Petition filed by a different Petitioner, Wockhardt. *Wockhardt Bio AG v. Jazz Pharms., Inc.*, Case IPR2015-01814 (PTAB Oct. 30, 2015) (Paper 10). During the conference call, counsel for Amneal indicated that it would file a copy of the transcript of the call when it became available.

Of particular relevance here, we note that Amneal’s Petition is based only on the identical grounds on which we instituted *inter partes* review in IPR2015-00551 (and joined IPR2015-01814). Mot. 5. The Petition is based on “same prior art, same exhibits, same expert declaration, and same claim construction positions” raised in IPR2015-00551 (and IPR2015-01814). *Id.* at 6, 8. Amneal also is a Petitioner in four related *inter partes* reviews, Cases IPR2015-00545, IPR2015-00546, IPR2015-00547, and IPR2015-00554, and has separately filed a Petition and a Motion for Joinder with Case IPR2015-00548. *Id.* at 9–10. In relation to those cases, Amneal is, or has asked to be, subject to the same schedule governing IPR2015-00551.

We further note that, in its Motion for Joinder, Amneal agrees to, *inter alia*, (i) “not request any alterations to the scheduling order” already in place in

¹ Wockhardt is a Petitioner in a related *inter partes* review proceeding, Case IPR2015-01814, also challenging the ’988 patent, and involving Petitioner Par and Patent Owner Jazz Pharmaceuticals, Inc.

IPR2015-00551, including all briefing and discovery dates; (ii) have no impact on the trial schedule in any of the related six IPR cases involving Par, Wockhardt, and Patent Owner; and (iii) “consolidated filings and discovery with Par, subject to the rules for one party on page limits and deposition time.” Mot. 10–11. Amneal also notes that Par does not oppose the Motion for Joinder and that Par agrees to the consolidation of filings and discovery. *Id.* at 11. During the conference call, Patent Owner also agreed that, if joinder were to be ordered on the conditions set forth in the Motion for Joinder, then Patent Owner would not oppose joinder and would waive filing a preliminary response to Amneal’s Petition.

In view of the foregoing, we find that joinder based upon the conditions stated by Amneal in its Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted ground. Discovery and briefing will be simplified if the proceedings are joined. Thus, there being no opposition to Amneal’s Motion for Joinder from any of the parties, the Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is

ORDERED that trial is instituted in IPR2015-001817 as to the following two grounds: (1) claims 1, 3–9, and 11–15 of the ’988 patent as obvious over the Advisory Committee Art; and (2) claims 2 and 10 of the ’988 patent as obvious over the Advisory Committee Art in view of Korfhage—the same two grounds on which we instituted trial in IPR2015-00551;

FURTHER ORDERED that Amneal’s Motion for Joinder with IPR2015-00551 is *granted*;

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FURTHER ORDERED that IPR2015-01817 is terminated and joined to IPR2015-00551, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions stated in Amneal's Motion for Joinder (Paper 3), as discussed above, and as agreed during the conference call of November 19, 2015;

FURTHER ORDERED that the Scheduling Order in place for IPR2015-00551 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2015-00551;

FURTHER ORDERED that the case caption in IPR2015-00551 for all further submissions shall be changed to add Amneal as a named Petitioner after Par and Wockhardt, and to indicate by footnote the joinder of IPR2015-01817 to that proceeding, as indicated in the attached form of caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2015-00551.

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