

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC,
Petitioner,

v.

KAKEN PHARMACEUTICAL CO., LTD. and VALEANT
PHARMACEUTICALS INTERNATIONAL, INC.,
Patent Owner.

Case IPR2017-01429
Patent 7,214,506 B2

Before ERICA A. FRANKLIN, SUSAN L. C. MITCHELL, and
ROBERT A. POLLOCK *Administrative Patent Judges.*

MITCHELL, *Administrative Patent Judge.*

DECISION
Granting Motion for Joinder
37 C.F.R. § 42.122

INTRODUCTION

Petitioner Argentum Pharmaceuticals LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 2 of U.S. Patent 7,214,506 B2 (Ex. 1001, “the ’506 patent”). Paper 2 (“Pet.”). Pursuant to 37 C.F.R. § 42.122(b), Petitioner also filed a Motion for Joinder, seeking to join the instant proceeding with *Acrux DDS Pty Ltd. v. Kaken Pharmaceutical Co., Ltd.*, IPR2017-00190 (PTAB). Paper 3 (“Mot.”).

Kaken Pharmaceutical Co., Ltd. and Valeant Pharmaceuticals International, Inc. (collectively, “Patent Owner”) filed an Opposition to Petitioner’s Motion for Joinder (Paper 7, “Opp.”), which it later withdrew in light of Petitioner’s Reply to Patent Owner’s Opposition and further agreement reached between the parties detailed below. In a separate decision, entered concurrently, we institute an *inter partes* review as to the same claims on the same grounds of unpatentability for which we instituted trial in IPR2017-00190. For the reasons set forth below, Petitioner’s Motion for Joinder is *granted*.

ANALYSIS

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) permits joinder of like review proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315.

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C § 315(c), which provides:

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.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). The Board considers the impact of both substantive issues and procedural matters on the proceedings.

As the moving party, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). In its Motion for Joinder, Petitioner contends that joinder, in this particular situation, is appropriate because: (1) the Petition is limited to the same grounds instituted in the IPR2017-00190 Petition (Mot. 4); (2) the Petition relies on the same prior art analysis and expert testimony submitted in IPR2017-00190, i.e. is “nearly identical” to the Petition in IPR2017-00190 (*id.*); (3) joinder will promote the just, speedy, and inexpensive resolution of patentability issues such as the patentability of the challenged claims of the ’506 Patent (*id.* at 4–5); (4) joinder will not negatively impact the schedule in IPR2017-00190 because Petitioner “anticipates participating in the proceeding in a limited capacity as an understudy, absent termination of Acrux [Petitioner in ’190 IPR] as a party” (*id.* at 5); and (5) Petitioner agrees to consolidated filings and discovery (*id.* at 6–7).

We agree that the substantive issues in IPR2017-00190 would not be affected by joinder, because the Petition is substantively identical to the Petition filed in IPR2017-00190. Notably, the Petition asserts identical grounds of unpatentability, challenging the same claims of the '506 patent. *Compare* Pet. 23–65, *with* IPR2017-00190, Paper 1 (“’190 Pet.”), 21–63. Petitioner also submits the same Declaration of Dr. Kenneth Walters. *Compare* Ex. 1005, *with* ’190, Ex. 1005. Moreover, we institute the instant trial based on the same grounds for which we instituted trial in IPR2017-00190. *See* ’190 Dec. 25. Therefore, the Petition raises no new issues beyond those already before us in IPR2017-00190.

Patent Owner originally opposed Petitioner’s Motion for Joinder. *See* Paper 7. Patent Owner withdrew its opposition, however in light of statements made in Petitioner’s Reply to the Motion for Joinder and the following agreements reached by the parties.

1. Petitioner agrees not to offer a rebuttal expert of its own;
2. Petitioner clarifies its statement on page 4 of its Reply to the Motion for Joinder that “to address specific issues unique to Argentum” means Petitioner may raise issues for which only it, and not Acrux, would have a basis to raise, or may respond to issues raised by Patent Owner that are relevant only to Petitioner and not Acrux;
3. Petitioner clarifies its statement on page 4 of its Reply to the Motion for Joinder that its reference to “apportion hearing time” is limited to addressing specific issues unique to Petitioner in any oral communication with the Board, including conference calls and oral hearing.

We agree with the parties that conducting a single joined proceeding for reviewing claims 1 and 2 of the '506 patent is more efficient than conducting multiple proceedings, eliminating duplicate filings and discovery. Petitioner agrees to consolidated filings and discovery. *Id.* at 6–7. Moreover, joinder will not require any change to the trial schedule in IPR2017-00190 as Petitioner will assume an “understudy role,” allowing the trial to be completed within one year. *Id.* at 5–6. Given that the Petition raises no new issues, and Petitioners agree to consolidated filings and discovery, the impact of joinder on IPR2017-00190 will be minimal, and joinder will streamline the proceedings, reducing the costs and burdens on the parties and the Board.

For the foregoing reasons, Petitioner has met its burden of demonstrating that joinder of the instant proceeding with IPR2017-00190 is warranted under the circumstances.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion for Joinder with IPR2017-00190 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2017-00190;

FURTHER ORDERED that the grounds of unpatentability on which a trial was instituted in IPR2017-00190 are unchanged;

FURTHER ORDERED that the Scheduling Order for IPR2017-00190 shall govern the joined proceeding;

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