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Paper 10
Entered: August 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC.,
Petitioner,
v.
NOVARTIS AG,
Patent Owner.

Case IPR2017-01550
Patent 9,187,405 B2

Before LORA M. GREEN, CHRISTOPHER M. KAISER, and ROBERT A. POLLOCK, *Administrative Patent Judges.*

POLLOCK, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review and Granting Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Argentum Pharmaceuticals LLC ("Argentum") filed a Petition requesting an *inter partes* review of claims 1–6 of U.S. Patent No. 9,187,405 B2 ("the '405 patent"). Paper 1 ("Pet."). Along with the Petition, Argentum filed a Motion for Joinder to join this proceeding with IPR2017-00854. Paper 3 ("Mot."). Argentum filed the Petition and Motion for Joinder in the present proceeding on June 9, 2017, within one month after we instituted trial in IPR2017-00854. Novartis AG, ("Novartis") has not filed a Preliminary Response to the Petition, and any such response would have been due September 16, 2017.

As explained further below, we institute trial on the same grounds as instituted in IPR2017-00854 and grant Argentum's Motion for Joinder.

II. DISCUSSION

In IPR2017-00854, Apotex, Inc. and Apotex Corp. ("Apotex") challenged claims 1–6 of the '405 Patent on the following grounds:

Ground	Claims	References	Basis
1	1–6	Kovarik[1] and Thomson	§ 103
2	1–6	Chiba,[2] Kappos 2005,[3] and Budde[4]	§ 103

[1] Kovarik and Appel-Dingemanse, WO 2006/058316, published June 1, 2006.
[2] Chiba et al., US 6,004,565, issued Dec. 21, 1999. Ex. 1006.
[3] Kappos et al., "*FTY720 in Relapsing MS: Results of a Double-Blind Placebo-Controlled Trial with a Novel Oral Immunomodulator*," 252 (Suppl 2) J. NEUROLOGY Abstract O141 (2005). .
[4] Budde, et al., "*First Human Trial of FTY720, a Novel Immunomodulator, in Stable Renal Transplant Patients*," 13 J. AM. SOC. NEPHROLOGY 1073-1083 (2002). .

Ground	Claims	References	Basis
3	1–6	Kappos 2010[5]	§ 102

After considering the Petition and Patent Owner's Preliminary Response, we instituted trial in IPR2017-00854 on each of the three asserted grounds. IPR2017-00854, Paper 11, 27.

Argentum's Petition in the instant matter is substantively identical to Apotex's Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2017-01550, Paper 1, *with* IPR2017-00854, Paper 2. For the reasons stated in our Decision on Institution in IPR2017-00854, we institute trial in this proceeding on the same three grounds.

Having determined that institution is appropriate, we now turn to Argentum's Motion for Joinder. 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).

Under the circumstances of this case, we determine that joinder is appropriate. Argentum raises no new grounds of unpatentability from IPR2017-00854 and contends that there will be no impact on the trial

[5] Kappos et al., "*A Placebo-Controlled Trial of Oral Fingolimod in Relapsing Multiple Sclerosis*," 362(5) N. Engl. J. Med. 387–401.

schedule previously set in that case. Mot. 5–6; *see* IPR2017-00854, Paper 12. As Argentum notes, the Petition in IPR2017-00854 is substantively identical to the grounds, analysis, exhibits,[6] and expert declarations relied on in the instant proceeding. Mot. 2, 4, 5. Argentum agrees "to coordinate with Apotex regarding questioning at depositions and at the oral hearing, which will not exceed the time allotted by the rules for one party, or as otherwise agreed between Apotex and Patent Owner or as ordered by the Board," and invites the Board to adopt procedures similar to those used in other joinder cases, such as requiring Petitioners to make consolidated filings, for which Apotex is responsible. *Id*. at 6–7.

Argentum represents that Apotex does not opposed Argentum's Motion for Joinder. *Id*. at 3. By email to the Board dated August 4, 2017, counsel for Novartis represents that, 1) Novartis does not object to the Motion for Joinder; 2) Argentum has agreed not to pursue any arguments or make any filings separate from those made by Apotex; and 3) that Novartis will not submit a Preliminary Response in IPR2017-01550, and "instead will proceed with a Patent Owner Response to the Petitions in both IPRs simultaneously." Ex. 3001.

In view of the foregoing, we find that joinder based upon the conditions stated in Argentum's Motion for Joinder and Novartis' August 4 email will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be

[6] Argentum notes that it has "added one additional exhibit (EX1041) which is a copy of the Federal Circuit Decision of April 12, 2017 affirming the Final Written Decision in IPR2014-00784, an IPR related to the present proceeding." Mot., 2–3.

simplified if the proceedings are joined. Thus, without opposition to the Motion for Joinder from any of the parties, the Motion is granted.

III. ORDER

Accordingly, it is

ORDERED that *inter partes* review is instituted in IPR2017-01550 on the following grounds:

> Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Kovarik and Thomson;
>
> Claims 1–6 under 35 U.S.C. § 103 as unpatentable over the combination of Chiba, Kappos 2005, and Budde;
>
> Claims 1–6 under 35 U.S.C. § 102 as anticipated by Kappos 2010.

FURTHER ORDERED that Argentum's Motion for Joinder with IPR2017-00854 is granted;

FURTHER ORDERED that IPR2017-01550 is terminated and joined to IPR2015-00854, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2017-00854 (Paper 12) shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2017-00854;

FURTHER ORDERED that the case caption in IPR2017-00854 for all further submissions shall be changed to add Argentum as a named Petitioner after Apotex, and to indicate by footnote the joinder of IPR2017-01550 to that proceeding, as indicated in the attached sample case caption;

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