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Paper 41
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner.

Case IPR2019-00980
Patent 8,992,486 B2

Before HYUN J. JUNG, BART A. GERSTENBLITH, and JAMES A. TARTAL, *Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

DECISION
Instituting *Inter Partes* Review
and
Granting Motion for Joinder
35 U.S.C. §§ 314, 315(c)

I. INTRODUCTION

Pfizer Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting institution of an *inter partes* review of claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 of U.S. Patent No. 8,992,486 B2 (Ex. 1003, "the '486 patent"). Concurrently with its Petition, Petitioner filed a Motion for Joinder seeking to join the instituted *inter partes* review in *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, Case IPR2018-01678 (the "Mylan IPR"). Paper 3, 1.

Sanofi-Aventis Deutschland GmbH ("Patent Owner") waived its Preliminary Response. Paper 9, 1; *see also* Paper 8, 1 (stating "Sanofi has also concurrently filed a waiver of its Preliminary Response in the above Pfizer IPRs"). Patent Owner also filed a Response to Petitioner's Motions for Joinder. Paper 8. Thereafter, Petitioner filed a Reply in Support of Petitioner's Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22, 42.122(b). Paper 10.

For the reasons below, we institute *inter partes* review of challenged claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 of the '486 patent. We also *grant* Petitioner's Motion for Joinder and join Petitioner to IPR2018-01678. In view of the joinder, we terminate this proceeding.

II. BACKGROUND

A. Related Proceedings

The parties indicate that the '486 patent has been asserted in *Sanofi-Aventis U.S. LLC v. Mylan GmbH*, No. 2:17-cv-09105-SRC-CLW (D.N.J.); *Sanofi-Aventis U.S. LLC v. Merck Sharp & Dohme Corp.*, No. 1:16-cv-00812-RGA-MPT (D. Del.); and *Sanofi-Aventis U.S. LLC v. Eli Lilly*

and Co., No. 1:14-cv-00113-RGA-MPT (D. Del.). Pet. 1–2; Paper 3, 2–3; Paper 5, 2; Exs. 1029, 1030.

The parties also indicate that the '486 patent is challenged in Cases IPR2018-01677, IPR2018-01679, IPR2019-00122, IPR2019-00981, and IPR2019-00982. Pet. 1, 2; Paper 5, 3–4. Petitioner notes that IPR2018-01677 was terminated after granting an unopposed motion to dismiss. Pet. 1; Paper 3, 2.

The parties additionally indicate that related patents are challenged in Cases IPR2018-01670, IPR2018-01675, IPR2018-01676, IPR2018-01680, IPR2018-01682, IPR2018-01684, IPR2018-01696, IPR2019-00977, IPR2019-00978, IPR2019-00979, IPR2019-00987, IPR2019-01022, and IPR2019-01023. Pet. 2; Paper 5, 2–4. The parties further identify related patent applications and patents. Pet. 2–4; Paper 5, 4–6.

B. Evidence Relied Upon

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

(1) U.S. Patent No. 6,235,004 B1, issued May 22, 2001 (Ex. 1014, "Steenfeldt-Jensen"); and

(2) U.S. Patent Application Publication No. US 2002/0052578 A1, published May 2, 2002 (Ex. 1015, "Moller").

In support of its challenges, Petitioner provides a Declaration of Charles Clemens (Ex. 1011). *See* Paper 3, 3 (stating that the "Petition is also supported by the expert declaration of Charles Clemens" and that the "opinions set forth in Mr. Clemens's declaration are nearly identical to the opinions set forth in the declaration of Mr. Karl R. Leinsing filed in the Mylan IPR (Mylan IPR Ex. 1011)").

C. Asserted Grounds

Petitioner challenges, under 35 U.S.C. § 103, claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 as unpatentable over (1) Steenfeldt-Jensen and (2) the combination of Moller and Steenfeldt-Jensen. Pet. 5, 23–98.

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition is substantively identical to the petition in the Mylan IPR. *Compare* Pet. *with Mylan*, Case IPR2018-01678 (PTAB Sept. 10, 2018) (Paper 2); *see also* Paper 3, 3 (stating that "the same claims of the '486 patent are obvious over the same grounds and for substantially the same reasons set forth in the Mylan IPR"), 3–4 (stating that "the Petition does not contain any additional arguments or evidence (except for reliance on a different expert, as noted above) in support of the unpatentability of claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 of the '486 patent"). For substantially the same reasons discussed in the Decision instituting *inter partes* review in the Mylan IPR, Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the '486 patent. *Mylan*, Case IPR2018-01678 (PTAB Apr. 3, 2019) (Paper 20).

Accordingly, we institute *inter partes* review of claims 1–6, 12–18, 20, 23, 26–30, 32, 33, 36, and 38–40 of the '486 patent based on the asserted grounds of unpatentability set forth in the present Petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). At this stage of the proceeding, we have not made a final determination as to the unpatentability of any challenged claim or any underlying factual or legal issue.

IV. MOTION FOR JOINDER

Petitioner contends that its Motion for Joinder is timely "because it is submitted within one month of the date the Mylan IPR was instituted." Paper 3, 4.

"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." 37 C.F.R. § 42.122(b). On May 2, 2019, Petitioner filed the Motion for Joinder requesting to join the Mylan IPR. The Board instituted an *inter partes* review in the Mylan IPR on April 3, 2019. Petitioner requested joinder no later than one month after the institution date of the Mylan IPR. Petitioner's Motion for Joinder, therefore, is timely.

Acting under the designation of the Director, we have discretion to determine whether to join a party to an instituted *inter partes* review. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(a). We may

> join as a party to [an instituted] inter partes review any person who properly files a petition under section 311 that . . . after receiving a preliminary response under section 313 or the expiration of the time for filing such a response . . . warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c). We have explained that a motion for joinder should: (1) set forth reasons why 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. *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

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