

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEUMODX MOLECULAR, INC.,
Petitioner,

v.

HANDYLAB, INC.,
Patent Owner.

IPR2019-01494
Patent 8,323,900 B2

Before JO-ANNE M. KOKOSKI, CHRISTOPHER G. PAULRAJ, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c), 37 C.F.R. § 42.122

I. INTRODUCTION

NeuMoDx Molecular, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–22 of U.S. Patent No. 8,323,900 B2 (“the ’900 patent,” Ex. 1003). Paper 1 (“Pet.”). HandyLab, Inc. (“Patent Owner”) did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2019-00490. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on August 15, 2019, within one month after we instituted trial in IPR2019-00490, and Patent Owner does not oppose the Motion for Joinder.

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2019-00490 and grant Petitioner’s Motion for Joinder.

A. *Related Proceedings*

Petitioner identifies the following related matter in which the ’900 patent is asserted: *Becton, Dickinson and Co. v. NeuMoDx Molecular, Inc.*, No. 1:19-cv-01226-LPS (D. Del). Pet. 2.

B. *IPR2019-00490*

In IPR2019-00490, Qiagen North American Holdings, Inc. (“Qiagen”) challenged claims 1–22 of the ’900 patent. After considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the challenged claims. *Qiagen North American Holdings, Inc. v. HandyLab, Inc.*, IPR2019-00490 (PTAB July 16, 2019) (Paper 8, “Qiagen Inst.”). The instituted review in IPR2019-00490 involves the following grounds of patentability:

Reference(s)	Basis	Challenged Claim(s)
Zou I ¹ and McNeely ² or Pourahmadi ³	§ 103	1–8, 12, 14, 15, 17, 19–22
Zou I, McNeely or Pourahmadi, and Zou II ⁴	§ 103	9–11, 13
Zou I, McNeely or Pourahmadi, and Chow ⁵	§ 103	18
Zou I, McNeely or Pourahmadi, and Duong ⁶	§ 103	16

Qiagen Inst. 7.

II. DISCUSSION

According to Petitioner’s Motion for Joinder, “the NeuMoDx petition and the Qiagen IPR are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims.” Mot. 1. Petitioner further states that “upon joining the Qiagen IPR, NeuMoDx will act as an ‘understudy’ unless the current petitioner ceases to actively participate in the instituted IPR.” *Id.* Thus, for the same reasons stated in our Decision on Institution in IPR2019-00490, we determine institution is warranted here.

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously

¹ U.S. Patent No. 6,509,186 B1, issued Jan. 21, 2003 (Ex. 1008).

² U.S. Patent App. Pub. No. US 2004/0037739 A1, published Feb. 26, 2004 (Ex. 1009).

³ U.S. Patent App. Pub. No. US 2002/0055167 A1, published May 9, 2002 (Ex. 1015).

⁴ U.S. Patent No. 6,762,049 B2, issued July 13, 2004 (Ex. 1011).

⁵ U.S. Patent No. 5,955,028, issued Sept. 21, 1999 (Ex. 1014).

⁶ WO 01/54813 A2, published Aug. 2, 2001 (Ex. 1013).

instituted *inter partes* review. 35 U.S.C. § 315(c). 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*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

Under the circumstances of this case, we determine that joinder is appropriate. As Petitioner notes, the petition in IPR2019-0490 is substantially the same as the Petition here, presenting the same arguments and relying on the same expert testimony and evidence. Mot. 4. Because the present Petition relies on the same expert declaration as the petition in IPR2019-0490, no additional deposition is needed. *Id.* at 6. Further, Petitioner’s agreement to take an “understudy” role will result in joinder simplifying the proceedings without prejudice to the parties. *Id.* at 6–7. Thus, Petitioner has satisfied the requirements for joinder here, and as noted above, Patent Owner has not opposed joinder.

III. CONCLUSION

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2019-00490. We limit Petitioner NeuMoDx Molecular, Inc.’s participation in the joined proceeding, such that (1) Qiagen alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Petitioner is bound by all filings by Qiagen in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as Qiagen

IPR2019-01494
Patent 8,323,900 B2

remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in IPR2019-00490 and protects the interests of Qiagen as original petitioner in IPR2019-00490, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–22 of the '900 patent with respect to the grounds set forth in the Petition;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2019-00490 is *granted*;

FURTHER ORDERED that the Scheduling Order in place for IPR2019-00490 (Paper 9 in that case), including any changes thereto as agreed to by the parties to that case, shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2019-00490;

FURTHER ORDERED that the case caption in IPR2019-00490 for all further submissions shall be changed to add NeuMoDx Molecular, Inc. as a named Petitioner, and to indicate by footnote the joinder of IPR2019-01494 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2019-00490.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.