

IPR2020-01060  
U.S. Patent No. 7,326,708  
Petitioner's Mot. for Joinder Under §§ 42.22 and 42.122(b)  
Attorney Docket No. REDDY 7.1R-024

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DR. REDDY'S LABORATORIES INC. and  
DR. REDDY'S LABORATORIES LTD.,  
Petitioners,

v.

MERCK SHARP & DOHME CORP.,  
Patent Owner.

U.S. Patent No. 7,326,708 to CYPES *et al.*

Issue Date: February 5, 2008

Title: Phosphoric acid salt of a dipeptidyl peptidase-IV inhibitor

*Inter Partes* Review No. IPR2020-01060

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**PETITIONER'S MOTION FOR JOINDER  
UNDER 37 C.F.R. §§ 42.22 AND 42.122(b)**

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**I. STATEMENT OF RELIEF REQUESTED**

Petitioners Dr. Reddy's Laboratories, Inc. and Dr. Reddy's Laboratories, Ltd. (collectively "DRL" or "Petitioner") respectfully request joinder of the concurrently filed petition for *inter partes* review of U.S. Patent No. 7,326,708 ("the '708 Patent") (IPR2020-01060) with *Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, filed October 30, 2019, and instituted May 12, 2020 ("the Mylan IPR"). (*See* IPR2020-00040, Paper 21.) The instant Petition is substantially the same as the Mylan IPR: it involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations) as the Mylan IPR. If joined, as discussed further below, DRL will assume a "silent understudy" role and will not take an active role in the *inter partes* review proceeding unless the Mylan Petitioner ceases to participate in the instituted IPR.

While the instant Petition includes the declaration of Dr. Fortunak ("DRL Declarant"), this declaration presents nearly identical expert testimony to that put forth by Dr. Chorghade ("Mylan Declarant") in the Mylan IPR. If Mylan allows DRL to use the Mylan Declarant, then DRL will withdraw the DRL Declarant, and rely only the Mylan Declarant. The PTAB has acknowledged that such concessions are sufficient to minimize the impact on the original proceeding. *SAP Am. Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13, at 4 (May 19, 2014). Thus, the

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proposed joinder will neither unduly complicate the Mylan IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining patentability in the Mylan IPR without prejudice to Patent Owner.

Although DRL is not otherwise time barred pursuant to 37 C.F.R. § 42.101(b), this Motion for Joinder, and accompanying Petition, are timely because they are filed less than one month after a decision instituting trial in the Mylan IPR. 37 C.F.R. § 42.122(b) (“no later than one month after the institution date of any *inter partes* review for which joinder is requested.”). Accordingly, DRL respectfully requests that the Board grant this Motion for Joinder.

## **II. STATEMENT OF REASONS FOR RELIEF REQUESTED**

### **A. Legal Standards**

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(c) 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.

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A motion for joinder should “(1) set forth the 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.” *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 (PTAB July 29, 2013); *Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11, at 3 (Oct. 24, 2014); *Macronix Int’l Co. v. Spansion*, IPR2014-00898, Paper 15, at 4 (Aug. 13, 2014) (quoting *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (April 24, 2013)).

**B. DRL’s Motion Is Timely**

A motion for joinder is timely if the moving party files within one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). Because DRL files this motion within one month after a decision on the institution of the Mylan IPR, this motion is timely.

**C. Joinder Is Appropriate**

Joinder is appropriate because DRL’s Petition does not raise any new grounds of unpatentability and does “not present issues that might complicate or delay” the Mylan IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). DRL’s Petition is substantially identical to the petition in the Mylan IPR, challenging the same claims of the

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