

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC.,
Petitioner,

v.

VIIV HEALTHCARE CO. and
VIIV HEALTHCARE UK LTD.,
Patent Owner.

Case IPR2015-00550
Patent 6,417,191 B1

Before LORA M. GREEN, ZHENYU YANG, and TINA E. HULSE,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECISION

Denying Motion for Joinder and
Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Teva Pharmaceuticals USA, Inc. (“Petitioner Teva”) filed a Petition requesting an *inter partes* review of claims 1–51 of U.S. Patent No. 6,417,191 B1 (Ex. 1001, “the ’191 patent”). Paper 2 (“Pet.”). ViiV

Healthcare Co. and ViiV Healthcare UK Ltd. (collectively, “Patent Owner”) filed a Preliminary Response to the Petition. Paper 10 (“Prelim. Resp.”)

Concurrently with the filing of the Petition, Petitioner filed a motion for joinder pursuant to 35 U.S.C. § 315(c). Paper 3 (“Mot. for Joinder”). Specifically, Petitioner “moves to join this proceeding with *Apotex Corp. v. ViiV Healthcare Co. and ViiV Healthcare UK Ltd.*, IPR2014-000876 (the ‘Apotex IPR’), instituted on December 8, 2014.” Pet. 1. Petitioner Teva timely filed its Joinder Motion within one month after institution of a trial in IPR2014-00876, as required by 37 C.F.R. § 42.122(b). Paper 3, 2. Patent Owner filed an Opposition to Motion for Joinder (Paper 9, “Opp. to Joinder”); as did Petitioner, Apotex Corp. (“Petitioner Apotex”), in IPR2014-00876. IPR2014-00876, Paper 24. We have jurisdiction under 35 U.S.C. § 314.

For the reasons provided below, we exercise our discretion under 35 U.S.C. § 315(c) and deny Petitioner Teva’s Motion to join the Petition to IPR2014-00876. We also deny the Petition and do not institute an *inter partes* review of the ’191 patent in this proceeding.

A. *Related Proceedings*

Patent Owner states that it has asserted the ’191 patent in *ViiV Healthcare UK Ltd. v. Lupin Ltd.*, No. 1:14-cv-00369-LPS (D. Del.). Paper 7, 2. Patent Owner states that it also asserted the ’191 patent in *ViiV Healthcare UK Ltd. v. Lupin Ltd.*, No. 1:11-cv-00576-RGA (D. Del.), and *ViiV Healthcare UK Ltd. v. Teva Pharmaceuticals USA, Inc.*, No. 1:11-cv-00688-RMB (D. Del.), which were consolidated, and are currently on appeal in the U.S. Court of Appeals for the Federal Circuit (Docket Nos. 14-1303, 14-1304, and 14-1315). *Id.*

B. The Asserted Ground of Unpatentability

Petitioner challenges the patentability of claims 1–51 of the '191 patent on the following ground (Pet. 14):

References	Basis	Claims Challenged
Cameron ¹ and Daluge ²	§ 103	1–51

II. ANALYSIS

A. Decision on Motion for Joinder

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

(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.

The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. When exercising that 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. 37 C.F.R. § 42.1(b). Here, we determine that Petitioner Teva's stated reasons for allowing joinder do not outweigh meaningful reasons not to allow joinder.

¹ Cameron et al., EP 0513917 A1, published November 19, 1992 (Ex. 1002).

² Daluge et al., *1592U89 Succinate – A Novel Carbocyclic Nucleoside Analogue with Potent, Selective Anti-HIV Activity*, ABSTRACTS OF THE 34TH ICAAC, 7 Abstract I6 (October 5, 1994) (Ex. 1003).

The Petition was filed on January 8, 2015. Petitioner Teva acknowledges that, more than one year before filing the Petition, it was served with a complaint alleging infringement of the '191 patent in *ViiV Healthcare UK Ltd. v. Teva Pharmaceuticals USA, Inc.*, No. 1:11-cv-00688-RMB (D. Del.). Pet. 5 n.2. Section 315(b) bars institution of *inter partes* review when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). The one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). Thus, absent joinder of this proceeding to IPR2014-00876, the Petition is barred under § 315(b).

As a moving party, Petitioner Teva has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). 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) specifically address how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); FAQ H5 on the Board's website at <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>.

Petitioner Teva contends that joinder will not affect the scheduling order set in IPR2014-00876. Paper 3, 5. Specifically, Petitioner Teva argues that it seeks review on the same ground, based on the same Declaration, on which the Board instituted *inter partes* review in IPR2014-

00876. *Id.* Petitioner contends further that joinder will enhance efficiency and avoid duplicate efforts, as well as inconsistencies. *Id.* at 6. Moreover, according to Petitioner, it could be prejudiced if it were not allowed to join the existing *inter partes* review if Petitioner Apotex and Patent Owner were to settle IPR2014-00876. *Id.* at 7. Most notably, Petitioner Teva argues further that it and Apotex will address the same art and same challenge, it “envisions few differences in the parties’ positions.” *Id.* at 8. Thus, Petitioner asserts that it and Apotex will file consolidated papers, and it will limit “itself to separate filings of only seven pages directed only to points of disagreement with Apotex.” *Id.* at 9.

Patent Owner responds that “joinder will unnecessarily complicate and disrupt the Apotex IPR.” Paper 26, 1. In particular, Patent Owner notes that Apotex, Petitioner in IPR 2014-00876, opposes joinder. *Id.* Petitioner Apotex agrees, noting that Petitioner Teva has not secured Apotex’s agreement to consolidate filings. IPR2014-00876, Paper 24, 3. Specifically, Petitioner Apotex states:

Teva’s Motion implies that Apotex and Teva have agreed to work together to prepare filings and coordinate discovery. Despite Teva’s implication, Teva has not secured Apotex’s agreement to coordinate efforts. Nor can it. Teva is a direct competitor of Apotex’s and Apotex does not consent to sharing its draft briefs with Teva. Apotex’s draft briefs are attorney-client-privileged documents and attorney work product, and Teva fails to identify any authority suggesting that the Board could or should require a party to divulge its privileged attorney work product. Moreover, Apotex and Teva do not have a joint defense agreement with respect to the ’191 patent and do not have aligned interests with respect to IPR proceedings involving the ’191 patent. The interests of justice do not support requiring competitors to cooperate in a contested case.

Id. at 5.

We agree with Patent Owner and Petitioner Apotex in IPR2014-00876 that Petitioner Teva has not established that joinder would be appropriate given the circumstances of this case. In particular, we note that Petitioner in this proceeding, Teva, has not obtained the agreement of Petitioner in IPR2014-00876, Apotex, to consolidate filings. Thus every paper filed by Petitioner in any joined proceeding could be subject to at least seven additional pages of briefing by Petitioner in this proceeding, Teva, plus additional responsive briefing by Patent Owner in the joined proceeding. Moreover, there is reduced prejudice to Petitioner Teva that Petitioner Apotex and Patent Owner ViiV Healthcare may settle, as Petitioner Apotex has already filed its Reply to Patent Owner's Response in IPR2014-00876, and we would be less likely to allow settlement given the late stage of the proceeding. *See Blackberry Corp. v. Mobilemedia Ideas*, Case IPR2013-00036, slip op. at 2 (PTAB Jan. 21, 2014) (Paper 64) (noting that as set forth in 37 C.F.R. § 42.74(a), the Board is not party to the settlement, and may determine independently any question of patentability).

B. Denial of Inter Partes Review

Petitioner Teva admits that it was served with a complaint alleging infringement of the '191 patent more than one year prior to the date of filing of the instant Petition. Pet. 5 n.5. Accordingly, in view of the denial of the requested relief of joinder with IPR2014-00876, institution of an *inter partes* review as requested by Petitioner is barred by statute. 35 U.S.C. § 315(b); *see also* 37 C.F.R. § 42.101(b).

III. CONCLUSION

We deny the Motion for Joinder, and, therefore, deny the Petition because it was not filed within the time limits imposed under 35 U.S.C. § 315(b).

IV. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that Petitioner's request for joinder is *denied*; and
FURTHER ORDERED that the Petition for *inter partes* review of claims 1–51 of the '191 patent is denied.

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