UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Celltrion, Inc.,
Petitioner

v.

Genentech, Inc.,
Patent Owner

Inter Partes Review No. 2018-01019
Patent: 7,976,838 B2

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND 42.122(b)

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Celltrion, Inc. respectfully requests its Petition for *Inter Partes* Review of U.S. Patent No. 7,976,838 ("the '838 patent") be granted and joined pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) with the petition for *inter partes* review filed by Pfizer, Inc. concerning the '838 patent: *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-01923 ("the Pfizer Petition").

Celltrion's Petition relies on the references cited and follows the arguments raised in the Pfizer Petition, and is essentially a copy of the Pfizer Petition. It includes the identical grounds presented in the Pfizer Petition and therefore would create no additional burden for the Board, Pfizer or Genentech if joined. Joinder would therefore lead to an efficient resolution of the validity of the '838 patent.

Counsel for Celltrion and counsel for Pfizer met and conferred as to the level of cooperation between Pfizer and Celltrion that will be maintained if Celltrion's motion for joinder is granted. Celltrion stipulates that if joinder is granted, it will cooperate with Pfizer in the joined proceeding, whether at hearings, at depositions, in filings, or otherwise, as outlined below. Unless Pfizer is terminated from the proceedings, Celltrion will proceed in a limited "understudy" role. Joinder will not impact the trial schedule because the proceeding based on the Pfizer Petition is in its early stages.

The Board has granted joinder in other proceedings when presented with this fact pattern and procedural history. For example, in a case that is the mirror image of this one, the Board recently joined Pfizer to an instituted IPR where Celltrion

was the Petitioner. *Pfizer, Inc. v. Genentech, Inc*., IPR2017-02063, Paper 25, (PTAB Feb. 21, 2018). In that case, Pfizer had previously filed a petition for *inter partes* review of the patent at issue, and its petition had been denied. Subsequently, Pfizer filed a second petition with a Motion for Joinder to Celltrion's IPR2017-01121. Pfizer and Celltrion had entered into an agreement wherein Pfizer took an understudy role to Celltrion and no deadlines in the original IPR were changed. The Board there granted joinder, finding that doing so did not increase the burden on either the patent owner or the Board.

Here, Celltrion and Pfizer have entered into the identical agreement, but with Pfizer taking the lead role and Celltrion taking the understudy role. Under these circumstances, identical to those in IPR2017-01063, there is no undue prejudice to Patent Owner, and therefore the Board should institute IPR and grant Celltrion's Motion for Joinder. *See id*. at *3.

Accordingly, and for the reasons discussed below, joinder should be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

Patent Office records indicate that the '838 patent is assigned to Genentech. On August 29, 2017, Pfizer filed a petition for *inter partes* review of this patent. *See Pfizer, Inc., v. Genentech, Inc.,* IPR2017-01923, Paper 2 (Aug. 29, 2017). Celltrion files this motion concurrently with a petition for *inter partes* review of the '838 patent.

Celltrion previously filed a petition for *inter partes* review of the '838 patent, on August 24, 2016 *Celltrion, Inc., v. Genentech, Inc.,* IPR2016-01667, Paper 2 (August 24, 2016). On March 2, 2017, the Board entered a Decision

Denying Institution based on that petition. *Celltrion,* IPR2016-01667, Paper 15 (PTAB March 2, 2017). Celltrion filed a Request for Rehearing of that decision on April 3, 2017. *Celltrion,* IPR2016-01667, Paper 18 (Apr. 3, 2017). On August 18, 2017, the Board entered a Decision Denying Petitioner's Request for Rehearing. *Celltrion,* IPR2016-01667, Paper 19 (PTAB Aug. 18, 2017).

Celltrion also previously filed a petition for *inter partes* review of the '838 patent on August 14, 2015 *Celltrion, Inc., v. Genentech, Inc.,* IPR2015-01733, Paper 2 (August 14, 2015). On October 2, 2015, Celltrion filed a motion to dismiss its petition without prejudice. *Celltrion,* IPR2015-01733, Paper 11 (Oct. 2, 2015). The Board entered a Decision Dismissing Petitions and Terminating Proceedings on October 6, 2015. *Celltrion,* IPR2015-01733, Paper 12 (Oct. 6, 2015).

III. ARGUMENT

The Board may join any person who properly files a petition for *inter partes* review to a separate, ongoing *inter partes* review. 35 U.S.C. § 315(c). A petition that seeks joinder must be timely 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).

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." *Macronix Int'l Co., Ltd. v. Spansion LLC,* IPR2014-00898,

Paper 15 at 4 (PTAB Aug. 13, 2014) (citing *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

Celltrion's motion is timely, and the Board should grant joinder because consideration of the foregoing factors weighs in favor of joinder.

A. Celltrion's Motion for Joinder Is Timely

Joinder may be requested "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). Pfizer's petition was instituted on April 4, 2018. *Pfizer*, IPR2017-01923, Paper 14 (Apr. 24, 2018). Celltrion's current motion is timely as it is being filed within one month of the institution date, the time set by 37 C.F.R. § 42.122(b).

B. The Kyocera Factors Weigh in Favor of Joinder

Each of the four factors that the Board considers in motions for joinder favor granting of Celltrion's motion. As shown below, joinder will not add further complication to the proceedings or cause prejudice to the parties. Moreover, joinder will significantly simplify briefing, discovery and trial associated with review of the '838 patent.

1. Joinder of Celltrion is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '838 Patent Without Prejudice to Any Party

If Celltrion is joined as a party, the validity of the grounds raised in the Pfizer Petition and Celltrion's Petition can be determined in a single proceeding. Celltrion's Petition challenges the validity of the same claims of the '838 patent on identical grounds to those in the Pfizer Petition. There are no substantive differences between Pfizer's and Celltrion's Petitions. *See Pfizer*, IPR2017-01923,

Paper 2 (Aug. 29, 2017). Celltrion also relies on substantially the same supporting evidence in its Petition as is relied on in the Pfizer Petition.[1] A consolidated proceeding, including both Pfizer and Celltrion, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g.*, *Oracle America*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board").

Joining Celltrion as a party to the Pfizer IPR also would not cause any prejudice to either Genentech or Pfizer. Genentech, as the patent owner, must respond to the common invalidity grounds identified in Pfizer's and Celltrion's Petitions regardless of joinder. Thus, Genentech bears no additional burden. For

---

[1] Celltrion submits copycat declarations from Dr. Boers, Dr. Mehta, and Ms. Greenfield, on whom Celltrion will rely only in the event that Pfizer is terminated from the proceedings. The supporting declarations submitted by Celltrion differ from those filed by Pfizer (from Dr. Massarotti, Dr. Grossbard, and Dr. Bennett), in that they have been updated to list the qualifications and personal experience of Dr. Boers, Dr. Mehta, and Ms. Greenfield. Dr. Boers's and Dr. Mehta's discussion of the prior art and their analysis is substantially the same as the analysis of Pfizer's experts. Likewise, the declaration by Ms. Greenfield to authenticate and corroborate the prior art status of some of the references relied on in the petition is substantially identical to Dr. Bennett's declaration submitted by Pfizer.

both Genentech and Pfizer, Celltrion's Petition has been filed sufficiently early so that joinder would affect neither the potential schedule of the *inter partes* review, nor the costs associated with a full trial. *See id.* at 7.

This factor favors joinder.

2. Celltrion's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in Pfizer's Petition

Celltrion's Petition challenges the validity of the '838 patent on identical grounds to those in the Pfizer Petition. *See Pfizer*, IPR2017-01923, Paper 2 (Aug. 29, 2017). Celltrion's supporting materials, including its supporting expert declaration, are also substantially the same as those presented by Pfizer. *See, supra*, n. 1. Therefore, consolidation of this proceeding with Pfizer's via joinder of Celltrion's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add additional complexity to the case. The Board has granted joinder in similar situations. *See, e.g., Hyundai Motor Co. v. Am Vehicular Scis. LLC,* IPR2014-01543, Paper 11 at 2-4 (PTAB Oct. 24, 2014); *Sony Corp. of Am. v. Network-1 Sec Solutions, Inc.*, IPR2013-00495, Paper 13 at 5-9 (PTAB Sept. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper 17 at 6-10 (PTAB July 29, 2013); *Motorola Mobility*, IPR2013-00256, Paper 10 at 4-10 (PTAB June 20, 2013).

This factor favors joinder.

3. Joinder Would Not Affect the Schedule in the Pfizer IPR

Given that the Board instituted review of the Pfizer petition only a month ago, joinder of Celltrion would not affect the schedule in any forthcoming trial. Celltrion's participation would result in no changes to the schedule.

This factor favors joinder.

4. Joinder Will Simplify Briefing and Discovery Because Celltrion Has Agreed to Consolidated Filings and an Understudy Role

To further prevent joinder from imposing any burden on Pfizer or Genentech and to further ensure that there are no changes in the potential trial schedule, Celltrion has agreed, as long as Pfizer remains a party to the review, to (1) coordinate any communications with Pfizer's experts through Pfizer's counsel; (2) not produce its own testifying witnesses; and (3) not file substantive papers (except for those associated with Board-approved motions that do not affect Pfizer or Pfizer's position).

Celltrion also will confer and cooperate with Pfizer on the consolidated filings but, as long as Pfizer is a party to the review, Pfizer will make all final decisions and will retain responsibility for oral argument (including telephone hearings and appeals). Celltrion will not seek or receive separate time and will not separately argue during oral argument, including telephone hearings and appeals, except when addressing Board-approved motions that do not affect Pfizer or Pfizer's position.

Celltrion also will coordinate the discovery and testimony relating to witnesses with Pfizer but, as long as Pfizer is a party to the review, Pfizer will

make all final decisions. In particular, as long as Pfizer is a party to the review, Celltrion will not separately file or serve objections or discovery requests, will not receive separate cross examination or redirect time, will not separately cross examine or redirect any witness, and agrees that cross examinations will occur within the timeframe normally allotted to one party without a need for extension in light of the joinder.

Thus, for briefing and document submissions, as long as Pfizer remains a party to the *inter partes* review, the Board may order petitioners to consolidate filings such that Pfizer would submit papers on behalf of petitioners and Celltrion would not be allowed additional filings. Moreover, for depositions, no adjustments to the schedule would be required and, indeed, no additional depositions would be necessary. Celltrion will not rely on expert testimony beyond that submitted by Pfizer unless Pfizer is terminated from the case prior to any necessary depositions. Thus, Celltrion's experts, Dr. Boers, Dr. Mehta, and Ms. Greenfield, would not be relied on if Pfizer's experts remain available. Absent termination of Pfizer from the proceedings, Celltrion will participate only in a secondary "understudy" role. However, if Pfizer is no longer a party, Celltrion will be free to rely on the opinions and testimony of Dr. Massarotti, Dr. Grossbard, Dr. Bennett, and other declarants for Pfizer that are already of record.

As a result of the foregoing, by consolidating filings with Pfizer, Genentech will only need to respond to one principal set of papers. No further time to address additional arguments will be required by any party, and the consolidated trial can thus proceed at the same pace as if Celltrion were not joined. *Torrent Pharm Ltd,*

v. UCB Pharma GMBH, IPR2016-01636, Paper 10 at 5 (PTAB Dec. 7, 2016); *Amerigen Pharm Ltd, v. UCB Pharma GMBH*, IPR2016-01665, Paper 8 at 6 (PTAB Dec. 7, 2016).

This factor favors joinder.

C. The Board Has Granted Joinder under these Circumstances, Finding No Undue Burden or Prejudice

As discussed above, the Board has granted joinder in IPR2017-02063, with facts that mirror those here. Although Pfizer had previously filed an IPR that was not instituted, the Board allowed Pfizer to join Celltrion's IPR2017-02063. In that case, Pfizer and Celltrion entered into an agreement wherein Pfizer took an understudy role to Celltrion and no deadlines in the original IPR were changed. The Board granted joinder, finding that joinder neither placed undue burden on nor caused undue prejudice to the patent owner. *See id*. at *3. The circumstances are identical here, and therefore the Board should institute IPR and grant Celltrion's Motion for Joinder.

IV. CONCLUSION

For the foregoing reasons, Celltrion respectfully requests that the Board grant its concurrently filed Petition for *inter partes* review of the '838 patent and join the grounds of invalidity therein raised with Pfizer IPR2017-01923.

* * *

Dated: May 4, 2018

Respectfully submitted,

/Elizabeth J. Holland/

Elizabeth J. Holland (Reg. No. 47,657)
Huiya Wu (Reg. No. 44,411)
Sarah Fink (Reg. No. 64,886)

GOODWIN PROCTER LLP
The New York Times Building 620
Eighth Avenue New York, NY 10018
(212) 813-8800 (telephone)
(212) 355-3333 (facsimile)

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Motion for Joinder was served on May 4, 2018, via FedEx Overnight delivery on the assignee for the patent, counsel of record for the assignee as listed in the records of the U.S.P.T.O., counsel of record for Patent Owner in IPR2017-01923, and counsel of record for Petitioner Pfizer in IPR2017-01923 at the following addresses:

Genentech Inc.
Wendy M. Lee
1 DNA Way
South San Francisco CA 94080-4990

Jeffrey P. Kushan
SIDLEY AUSTIN LLP
1501 K Street, NW
Washington, DC 20005

Counsel for assignee

J. Steven Baughman
Megan Raymond
PAUL, WEISS, RIFKIND, WHARTON & GARRISON LLP
2001 K St. NW
Washington, DC 20006

Michael R. Fleming
Gary N. Frischling
Keith A. Orso
Yite John Lu
David Gindler
IRELL & MANELLA LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067

Counsel for Genentech in

Jovial Wong
Charles B. Klein
Eimeric Reig-Plessis
WINSTON & STRAWN LLP
1700 K Street, NW
Washington, DC 20006

Counsel for Petitioner Pfizer in IPR2017-10923

/Elizabeth J. Holland/
Elizabeth J. Holland