Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INARI AGRICULTURE, INC.,
Petitioner,

v.

CORTEVA AGRISCIENCE LLC,
Patent Owner.

_____

Case No. IPR2024-00179
Patent No. 10,947,555

_____

CONTINGENT UNOPPOSED MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO *INTER PARTES* REVIEW IPR2023-01036

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I. PRELIMINARY STATEMENT

Inari Agriculture, Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 10,947,555 ("the Inari Petition") filed concurrently herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Bayer CropScience LP et al v. Corteva Agriscience LLC*, IPR2023-01036 ("the Bayer IPR").

Petitioner's Motion for Joinder is timely under 37 C.F.R. § 42.22 and 42.122(b) as the Board has not yet issued an institution decision in the Bayer IPR, therefore, the Petition and Motion satisfy the requirement of the request being filed no later than one month from institution of a trial. *Blue Coat Systems, Inc. v. Finjan, Inc.*, IPR2016-00480, Paper 9 at 7 (PTAB June 24, 2016) (granting motion for joinder and rejecting patent owner's contention that joinder motion filed before institution was premature). The Inari Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Bayer IPR.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Bayer IPR while efficiently resolving the question of the validity of U.S. Patent No. 10,947,555 (the "'555 patent") in a single proceeding.

In the alternative, to the extent that IPR2023-01036 terminates prior to the Board's decision on this Motion for Joinder, rendering this Motion moot, Inari respectfully requests that the Board evaluate Inari's Petition on the merits.

II. STATEMENT OF MATERIAL FACTS

1. On August 9, 2022, Patent Owner filed an infringement action against Monsanto Company and Bayer CropScience LP (collectively "Bayer"), *Corteva Agriscience LLC v. Monsanto Company et al*, No. 1:22-cv-01046-GBW (D. Del.). Patent Owner asserted the '555 Patent in the infringement action against Bayer.

2. On June 15, 2023, Bayer filed a petition for *inter partes* review (IPR2023-01036) ("the Bayer Petition") requesting cancellation of claims 1-34 of the '555 patent.

3. On September 21, 2023, Patent Owner filed a Patent Owner Preliminary Response in IPR2023-01036. Bayer was subsequently authorized to file a Reply to Patent Owner's Preliminary Response, which was filed on October 6, 2023, and Patent Owner filed a Sur-Reply on October 16, 2023.

4. The Bayer Petition and the Inari Petition are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims and rely on the same evidence, including a substantively identical expert declaration.

5. Inari has conferred with counsel for Bayer and confirmed that it does not oppose this motion.

III. STATEMENT OF RELIEF REQUESTED

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *Dell, Inc. v. Network-1 Security Solutions, Inc.,* IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013).

B. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

All four factors weigh in favor of granting the motion for Inari. The Inari Petition is substantively identical to the Bayer Petition. Inari does not present any new grounds of unpatentability, consistent with PTAB joinder practice. Additionally, as all substantive issues are identical and Inari will act as an "understudy," joinder should have no impact on the pending schedule of the Bayer IPR. *See Sony Corporation v. Memory Integrity, LLC*, IPR2015-01353, Paper No.

11 at 6 (Oct. 5, 2015) (granting motion for joinder where petitioners requested an "understudy" role); *see also Samsung Electronics America, Inc. v. Uniloc 2017 LLC*, IPR2018-01383, Paper No. 9 at 4-5 (Nov. 19, 2018) (granting motion for joinder). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Bayer IPR is Appropriate

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (emphasis in original) (internal quotations and citations omitted). Here, joinder with the Bayer IPR is appropriate because the Inari Petition submits identical arguments and the same grounds introduced in the existing Bayer IPR, consistent with PTAB joinder practice.

More specifically, the Inari Petition copies verbatim the challenges set forth in the Bayer Petition and relies on a substantially identical expert declaration. The only differences between the Inari Petition and the Bayer Petition relate to formalities of a different party filing the petition; there are no other changes to the facts, citations, evidence, or arguments introduced in the Bayer Petition. While the Inari Petition relies on a declaration from a different expert witness, Inari's expert reviewed and agreed with the expert declaration supporting Bayer's IPR, and

Inari's expert declaration is substantively identical to Bayer's expert declaration and does not include any new or additional opinions. *See Everlight Elecs. Co. Ltd., v. Document Security Sys., Inc.*, IPR2018-01260, Paper No. 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration). Moreover, assuming that Bayer does not terminate its IPR before its expert is deposed, Inari will waive its expert declaration and agree to be bound by the declaration(s) and deposition(s) of Bayer's expert. Because these proceedings are virtually identical, good cause exists for joining this proceeding with the Bayer IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of the Inari Petition and the Bayer Petition in a single proceeding.

Moreover, granting joinder will not prejudice Patent Owner or the current petitioner, Bayer. As discussed above, the Inari Petition does not raise any new ground that is not raised in the Bayer Petition. Therefore, there should be little or no additional cost to Patent Owner or Bayer due to Inari's joinder. Inari has conferred with counsel for Bayer and confirmed that it does not oppose this motion.

2. Petitioner Does Not Propose New Grounds of Unpatentability

As discussed above, the Inari Petition does not assert any new grounds of patentability. It challenges the same claims of the '555 patent based on the same

arguments, evidence, and grounds of unpatentability as the Bayer IPR. *See Sony,* IPR2015-01353, Paper No. 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration"); *Everlight*, IPR2018-01260, Paper No. 12 at 6-7 (granting motion for joinder where petitioner "asserts the same unpatentability grounds" and "relies on the same prior art analysis [even] though it relies on a different expert"); *see also Par Pharm., Inc. v. Novartis AG,* IPR2016-01023, Paper No. 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners "do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule").

3. No Impact on the Bayer IPR Trial Schedule

Joinder should have no impact on the Bayer IPR trial schedule because the Inari Petition presents no new issues or grounds of unpatentability. *See Sony*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). There are no new issues for the Board to address, and Patent Owner will not be required to present

any additional responses or arguments. Moreover, Inari will adhere to all deadlines set by the Board's Scheduling Order for the Bayer IPR.

The Patent Owner's Response will not be impacted because the issues presented in the Inari Petition are identical to the issues presented in the Bayer Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Bayer Petition.

Additionally, no additional expert discovery will be needed. While the Inari Petition relies on a declaration from a different expert witness, Inari's expert has reviewed and agreed with the expert declaration supporting the Bayer IPR, and Inari's expert declaration is substantively identical to Bayer's expert declaration. Assuming Bayer does not terminate its IPR before its expert is deposed, Inari agrees to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the Bayer IPR, and Inari will waive its own expert declaration. Accordingly, if Bayer does not terminate its IPR prematurely, there will be no need for any deposition of Inari's expert.

Accordingly, joinder of Inari to the Bayer IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

4. Briefing and Discovery Will Be Simplified

Inari agrees to a complete and silent "understudy" role and will not raise any issues. Specifically, Inari agrees that, if joined, the following conditions shall apply so long as Bayer remains an active party. These conditions are less burdensome on the Patent Owner and lead petitioner than conditions that have been previously approved by the Board in similar circumstances:

a) All substantive filings will be consolidated, for which Bayer will maintain responsibility (i.e., Inari will rely on the filings of Bayer), unless a filing solely concerns issues that do not involve Bayer (e.g., Mandatory Notices);

b) Inari shall rely on the grounds instituted by the Board in the Bayer IPR, and the arguments and discovery introduced by Bayer; Inari shall not be permitted to raise any new grounds not already instituted by the Board in the Bayer IPR, or introduce any argument or discovery not already introduced by Bayer;

c) Inari shall be bound by any agreement between Patent Owner and Bayer concerning discovery and/or depositions; and

d) Inari at deposition shall not request any direct, cross examination or redirect time beyond that permitted for Bayer alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Bayer.

See Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5-6 (Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing, or discovery.").

e) Inari agrees to be bound by the expert deposition and declarations of Bayer's expert and Inari will waive its own expert declaration, unless Bayer ceases to be an active participant in its IPR prior to Bayer's expert's deposition.

In short, Inari agrees to participate in the joined proceedings as an "understudy" and would assume an active role only if Bayer is dismissed from the joined proceedings or elects to transfer control to Inari.

Thus, by Inari accepting an "understudy" role, Patent Owner and Bayer can comply with the existing trial schedule without needing any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See Sony*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where

petitioners agreed to an "understudy" role). Inari is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

For the foregoing reasons, Inari respectfully requests that the Board grant its Petition for *Inter Partes* Review of the '555 patent be granted and that the proceedings be joined with IPR2023-01036.

Respectfully submitted,
Inari Agriculture, Inc.

Date: November 15, 2023

/Scott A. McKeown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C.
601 Massachusetts Avenue NW
Washington, DC 20001

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on November 15, 2023, I will cause a copy of the foregoing document, including any exhibits or appendices filed therewith, to be served via Overnight FedEx at the following correspondence address of record for the patent:

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001-4413

A courtesy copy was also sent via electronic mail to all counsel of record in IPR2023-01036 at the following addresses:

Dov P. Grossman	dgrossman@wc.com
Ben Picozzi	bpicozzi@wc.com
Pier D. DeRoo	pier.deroo@finnegan.com
Michael J. Flibbert	michael.flibbert@finnegan.com
Rachael P. Dippold	rachael.dippold@finnegan.com
Jessica L. Roberts	jessica.roberts@finnegan.com
Yieyie Yang	yieyie.yang@finnegan.com

Date: November 15, 2023

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.