Paper No. ____
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2016-01101
Patent No. RE38,551

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

I. Statement of the Precise Relief Requested

Mylan Pharmaceuticals Inc. ("Mylan" or "Petitioner") submits, concurrently with this motion, a petition for *inter partes* review ("Petition") of claims 1-13 of U.S. Reissue Patent No. RE38,551 ("the '551 patent"), which is purportedly assigned to Research Corporation Technologies, Inc. ("Patent Owner"). Mylan respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petition with a pending *inter partes* review initiated by Argentum Pharmaceuticals LLC ("Argentum"), *Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.*, IPR2016-00204.

Mylan's request for joinder is timely because it has been less than one month since the Board issued an institution decision on May 23, 2016, in IPR2016-00204. *See* 37 C.F.R. § 42.122(b). Grounds 1-4 of the accompanying Petition are practical copies of the grounds presented in the petition in IPR2016-00204, including Grounds 3A-3B that were instituted by the Board, and challenge the same claims over the same prior art and using the same arguments and expert testimony. Petitioner requests joinder only as to Grounds 3A-3B, and not as to Grounds 1A-1B, 2A-2B, or 4A-4B.

Institution and joinder for Grounds 3A-3B should create no additional burden for the Board, Patent Owner, or the existing petitioners in IPR2016-00204

because these grounds are practical copies of already instituted grounds. In addition, joinder is appropriate because it will efficiently resolve the validity of claims 1-13 of the '551 patent over the same prior art in a single IPR proceeding, without prejudicing the parties to IPR2016-00204.

Absent termination of Argentum as a party to the proceeding, Mylan anticipates participating in the proceeding in a limited capacity as an understudy. Moreover, joinder will have no impact on the trial schedule of IPR2016-00204 because that IPR is still in its early stages, and Mylan, in its limited role, is agreeable to the same schedule.

II. Background

On July 10, 2013, UCB, Inc. *et al.* asserted claims for infringement of the '551 patent in *UCB, Inc. et al. v. Mylan Pharmaceuticals Inc. and Mylan, Inc.*, Case No. 1:13-cv-01214, in the District of Delaware, which case was consolidated with *UCB, Inc. v. Accord Healthcare Inc.*, 1:13-cv-01206 (D. Del. Jul. 10, 2013). In IPR2014-01126, the Board denied institution of *inter partes* review of the '551 patent based on a petition filed by Actavis, Inc., Actavis Laboratories FL, Inc., Actavis Pharma, Inc., Amneal Pharmaceuticals of New York, LLC, Aurobindo Pharma Ltd., Aurobindo Pharma USA, Inc., Breckendridge Pharmaceutical, Inc., Vennoot Pharmaceuticals, LLC, Sandoz Inc., Sun Pharma Global FZE, and Sun Pharmaceutical Industries, Ltd. On November 23, 2015, Argentum filed a petition for *inter partes* review challenging claims 1-13 of the

'551 patent, which was assigned Case No. IPR2016-00204. On May 23, 2016, the Board instituted review on claims 1-13. This Petition is a practical copy of the IPR2016-00204 petition, including the same prior art analysis and expert testimony. *See* Pet. The Petition has been revised in portions to address certain formalities, such as, e.g., mandatory notice information, counsel, related matters, etc.

III. Argument

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. §315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g.*, *Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Mylan's Motion for Joinder Is Timely

Joinder may be requested no later than one month after the institution date of an *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122. Here, because the Board issued its institution decision in IPR2016-00204 on May 23, 2016, this Motion for Joinder and the accompanying Petition are timely.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, granting joinder will not enlarge the scope of the IPR2016-00204 and will not negatively impact the IPR2016-00204 schedule, but a decision denying joinder could severely prejudice Mylan. Thus, joinder is appropriate and warranted.

1. Joinder is Appropriate

Joinder with IPR2016-00204 is appropriate because the Petition is limited to the same grounds instituted in the IPR2016-00204 petition, and expressly does not advance for joinder purposes in this proceeding the grounds that were not instituted in IPR2016-00204. It also relies on the same prior art analysis and expert testimony submitted by Argentum. Indeed, the Petition is nearly identical with respect to the grounds raised in the IPR2016-00204 petition, and does not include any grounds not raised in that petition. Other than certain formalities, the present petition and evidence is virtually identical in content to the IPR2016-00204

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