

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC

Petitioner,

v.

ALLERGAN, INC.

Patent Owner.

U.S. Patent No. 8,629,111

Inter Partes Review No. IPR2016-01232

**PETITIONER ARGENTUM PHARMACEUTICALS LLC'S MOTION FOR
JOINDER UNDER 35 C.F.R. § 315(c) AND 37 C.F.R. §§ 42.22 and 42.122(b)**

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U.S. Patent No. 8,629,111

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Argentum Pharmaceuticals LLC (“Argentum”) submits this Motion for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,629,111. Argentum requests joinder of the instant IPR proceeding with an IPR filed by Mylan Pharmaceuticals Inc. (“Mylan”) involving the same patent claims and the same grounds of unpatentability. *Mylan Pharms. Inc. v. Allergan, Inc.*, Case IPR2016-01128 (filed June 3, 2016) (the “Mylan IPR”).

Argentum’s request for joinder is timely because it was filed before the institution date of the Mylan IPR and, therefore, “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). See *Mercedes-Benz USA, LLC v. Innovative Display Techs. LLC*, Case IPR2015-00360, slip. op. at 4 (PTAB May 22, 2015) (Paper 22) (holding joinder motion timely, as it was filed more than one month before institution decision); *Taiwan Semiconductor Mfg. Co. v. Zond, LLC*, Case IPR2014-00781, slip. op. at 4 (PTAB May 29, 2014) (Paper 5) (explaining that pre-institution joinder movant “should indicate whether it would withdraw non-instituted grounds of unpatentability should the Board institute an *inter partes* review with less than all of the asserted grounds of unpatentability in [the earlier-filed, not-yet-instituted IPR] proceedings”).

II. STATEMENT OF MATERIAL FACTS

1. On June 3, 2016, Mylan filed an IPR petition against claims 1-27 of U.S. Patent No. 8,629,111, which was accorded Case No. IPR2016-01128 (the “Mylan IPR”).

2. The Mylan IPR Petition asserts the following grounds of unpatentability:

- a. Ground 1: Claims 1-27 are anticipated under § 102 by Ding ’979;
- b. Ground 2: Claims 1-27 are obvious under Ding ’979 and Sall;
and
- c. Ground 3: Claims are obvious under §103 over Ding ’979, Sall,
and Acheampong.

3. Today, concurrent with the instant motion for joinder, Argentum filed an IPR petition that was accorded Case No. IPR2016-01232, asserting the same grounds of unpatentability against the same patent claims as in the Mylan IPR. As stated in Argentum’s IPR Petition and in this motion, Argentum is willing to withdraw any grounds of unpatentability that the Board denies in the Mylan IPR Petition.

4. Argentum’s IPR Petition is substantively identical to Mylan’s IPR Petition and includes all the same exhibits as those filed in the Mylan IPR, except

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for additional Exhibits 1025-1026 and the “Additional Arguments And/Or Reasoning” section of Argentum’s IPR Petition. As stated in Argentum’s IPR Petition and in this motion, Argentum is willing to withdraw Exhibits 1025-1026 and the “Additional Arguments And/Or Reasoning” section to facilitate joinder If the Board deems such a withdrawal necessary in order to join the two proceedings.

III. APPLICABLE LEGAL STANDARD

The Leahy-Smith America Invents Act (AIA) gives the Board discretion to join any person as a party to another petitioner’s IPR. 35 U.S.C. § 315(c). In deciding whether to exercise its discretion, the Board considers factors including: (1) the movant’s reasons why joinder is appropriate; (2) whether the new petition presents 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. *Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, slip. op. at 4 (PTAB July 29, 2013) (Paper 17).

IV. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is Appropriate Because It Would Promote Efficient Resolution of Identical Challenges in a Single Proceeding

Joinder is appropriate here because it is the most expedient way to secure the just, speedy, and inexpensive resolution of two related proceedings involving the same patent in a single *inter partes* review. See 35 U.S.C. § 316(b); 37 C.F.R.

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