

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
FOXHILL CAPITAL PARTNERS, and MYCONOVO, INC.,<sup>1</sup>  
Petitioners,

v.

DR. FALK PHARMA GMBH,  
Patent Owner.

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Case IPR2016-01386, Case IPR2016-01409  
Patent 8,865,688 B2

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Before LORA M. GREEN, GRACE KARAFFA OBERMANN, and  
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Reviews and Motions for Joinder  
*35 U.S.C. § 314, 37 C.F.R. §§ 42.108 and 42.122*

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<sup>1</sup> Mylan Pharmaceuticals Inc. (“Mylan”) is Petitioner in Case IPR2016-01386, Foxhill Capital Partners and MycoNovo, Inc. (collectively, “Foxhill”) is Petitioner in Case IPR2016-01409.

## I. INTRODUCTION

Petitioners, Mylan and Foxhill, each filed a Petition requesting an *inter partes* review of claims 1 and 16 of U.S. Patent No. 8,865,688 (Ex. 1001, “the ’688 patent”). Paper 1 (“Pet.”).<sup>2</sup> Concurrently with the Petitions, Mylan and Foxhill each filed a Motion for Joinder requesting that Petitioner be joined as a party to *GeneriCo LLC v. Dr. Falk Pharma*, IPR2016-00297 (“297 IPR”). Paper 3 (“Joinder Mot.”).

Patent Owner, Dr. Falk Pharma GmbH, filed an opposition to the Motion for Joinder in each case. IPR2016-01386, Paper 6 (“1386 PO Opp.”); IPR2016-01409, Paper 9 (“1409 PO Opp.”). In each case, Patent Owner waived its right to present a preliminary response to the Petition for *inter partes* review. Paper 8.

Petitioner in IPR2016-00297, GeneriCo, LLC and Flat Line Capital, LLC (collectively, “GeneriCo”), filed an opposition to Foxhill’s Motion for Joinder, IPR2016-00297, Paper 22 (“GeneriCo Opp.”), but did not oppose Mylan’s Motion for Joinder.

In Case IPR2016-01409, Foxhill filed a Reply to Patent Owner’s Opposition to Motion for Joinder, IPR2016-01409, Paper 10 (“Reply to PO”) and a Reply to GeneriCo’s Opposition to Motion for Joinder, IPR2016-01409, Paper 11 (“Reply to GeneriCo”).

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<sup>2</sup> Citations are to IPR2016-01386 as representative of corresponding papers in both cases unless otherwise indicated.

## II. DISCUSSION

### A. *The Petitions*

Mylan and Foxhill each represent that “Grounds 1–4 are practical copies of the grounds presented in the petition in IPR2016-00297, including Grounds 3 and 4 that were instituted by the Board, challenging the same claims over the same prior art and using the same arguments and expert testimony.” Pet. 4. Mylan and Foxhill each further represent that the “Petition has been revised in portions only to address certain formalities, such as, e.g., mandatory notice information, counsel, related matters, etc.” Joinder Mot. 2. In addition, Mylan and Foxhill each represent that “[t]he Digenis Declaration is an exact copy of Dr. Digenis’ declaration from IPR2016-00297.” Pet. 4.

Mylan and Foxhill each request institution “only on the Grounds instituted in IPR2016-00297, i.e., Grounds 3 and 4 (which the Board determined subsumed Ground 1), as to claims 1 and 16, and not on Grounds 1 and 2.” Pet. 1.

We incorporate our analysis from our institution decision in the 297 IPR. IPR2016-00297, Paper 13 (“Dec.”), 4–30. For the same reasons, we conclude that Mylan and Foxhill have each demonstrated a reasonable likelihood of prevailing on Grounds 3 or 4 in the alternative. Dec. 4–27; Pet. 4–51. Because Mylan and Foxhill do not seek institution based on Grounds 1 and 2, Pet. 1, and for the same reasons as stated in the 297 IPR, Dec. 27–30, we do not institute review based on either of Grounds 1 or 2.

*B. Motions for Joinder*

Based on authority delegated to us by the Director, we have discretion to join a party to another *inter partes* review, subject to certain exceptions not present here. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. As the moving party, Petitioner 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 ground(s) 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 how briefing and/or discovery may be simplified to minimize schedule impact. *See* Joinder Mot. 3; *Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative); Frequently Asked Question H5 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Here, Mylan and Foxhill each represent, and Patent Owner does not dispute, that the Petitions are “practical copies of the grounds presented in the petition in IPR2016-00297 . . . and challenge the same claims over the same prior art and using the same arguments and expert testimony.” Joinder Mot. 1; 1386 PO Opp. 4; 1409 PO Opp. 3. Mylan and Foxhill further represent that they each intend to pursue only Grounds 3 and 4, as instituted in the 297 IPR. Joinder Mot. 1. In addition, Mylan and Foxhill each seek to participate in the 297 IPR proceeding “in a limited capacity as an understudy” to GeneriCo. *Id.* at 2.

Based on the above, Mylan and Foxhill argue that joinder is “appropriate because it will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of validity of

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the challenged claims of the '688 patent,” and potentially minimize issues and resolve any litigation regarding the challenged claims. *Id.* at 4–5. In addition, Mylan and Foxhill contend no new grounds are presented, and granting joinder will not prejudice Patent Owner or GeneriCo or significantly affect the trial schedule in the case. *Id.* at 5–6.

Lastly, Mylan and Foxhill indicate that discovery and briefing can be simplified here because, in their understudy role, as long as GeneriCo remains a party (i.e., does not reach a settlement with Patent Owner), each of Mylan and Foxhill “will not submit any separate filings unless it disagrees with” GeneriCo’s position “(which it is not anticipated), and in the event of any disagreement it will request authorization from the Board to submit a short separate filing directed only to points of disagreement” with GeneriCo. *Id.* at 7. As long as GeneriCo remains a party, Mylan and Foxhill will not seek to submit any new declarations or request any additional depositions or time during depositions. *Id.* at 8.

Patent Owner states that it “would not oppose” Foxhill’s joinder, if the Board orders “meaningful protections” to ensure that Foxhill’s participation does not complicate, disrupt, or delay the 297 IPR. 1409 PO Opp. 1. Patent Owner opposes Mylan’s joinder, however, asserting that it will “complicate, disrupt, and delay” the 297 IPR. 1386 PO Opp. 1. Patent Owner further asserts that, absent joinder, Mylan’s petition is time-barred. *Id.* at 2.

GeneriCo states that it “does not agree to work with Foxhill” and “does not consent to sharing its draft briefs with Foxhill.” GeneriCo Opp. 2, 7. GeneriCo states that its expert, Dr. Digenis, “is not contractually obligated to testify on Foxhill’s behalf” and “would be contractually

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