

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC.,

Petitioner,

v.

ALLERGAN, INC.,

Patent Owner

U.S. Patent No. 8,642,556

Issued Date: February 4, 2014

Title: Methods of Providing Therapeutic Effects
Using Cyclosporin Components

IPR Case No.: IPR2017-00579

Patent No. 8,642,556

Motion for Joinder

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b)

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TABLE OF CONTENTS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED2

II. STATEMENT OF MATERIAL FACTS3

III. STATEMENT OF REASONS FOR RELIEF REQUESTED5

 A. Legal Standard6

 B. Joinder Will Not Impact the Mylan IPR’s Case Schedule7

 C. Joinder Will Enhance Efficiency by Avoiding Duplicate
 Efforts and Inconsistencies10

 D. A Joined Proceeding Avoids Prejudice to Teva and Will
 Not Prejudice Mylan or Allergan.....10

 E. Joinder will not prejudice Patent Owner or Mylan.....11

IV. CONCLUSION.....12

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b), Teva Pharmaceuticals USA, Inc., (“Teva”) respectfully submits this Motion for Joinder, together with a petition for *inter partes* review of U.S. Patent No. 8,642,556 (“the ’556 patent”), seeking cancellation of claims 1-20 of the ’556 patent (“the Teva IPR”) and joinder of this proceeding with *Mylan Pharmaceuticals Inc., v. Allergan, Inc.*, Case IPR2016-01129 (the “Mylan IPR” or “IPR 1129”).

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of December 8, 2016, the date on which the Mylan IPR was instituted. *See* Mylan IPR, Paper 8.

Teva submits that joinder is appropriate because it will: (1) promote efficient determination of the validity of the ’556 patent in a single proceeding without prejudice to first petitioner Mylan Pharmaceuticals Inc. (“Mylan”) or patent owners Allergan, Inc. (“Allergan” or “Patent Owner”) because Teva’s petition raises the ***identical*** grounds of unpatentability instituted by the Board in the Mylan IPR (*see, e.g., Motorola Mobility, Inc. v. Softview, Inc.* IPR2013-00256, Paper No. 10 (granting motion for joinder under similar circumstances)); (2) not affect the schedule in the Mylan IPR nor increase the complexity of that proceeding, minimizing costs; and (3) minimize burden because Teva will agree to

consolidated filings¹ and discovery and will accept a back-seat, “understudy” role in the joint proceedings.² Absent joinder, Teva could be prejudiced if the Mylan IPR is terminated before a final written decision is issued, as Teva’s interests will not be adequately represented before the Board. Accordingly, joinder should be granted.

This Motion for Joinder and accompanying Petition are timely under 37 C.F.R. §§ 42.22 and 42.122(b), as they are submitted within one month of December 8, 2016, the Mylan IPR’s institution date. *See Mylan IPR, Paper 8 (Decision).*

II. STATEMENT OF MATERIAL FACTS

1. Petitioner and other entities are involved in litigation over the ’556 patent and related patents in the action styled *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc., et al.*, No. 2:15-cv-01455, filed by Allergan, Inc. in the

¹ Teva agrees to consolidated filings for all substantive papers in the respective proceedings, except for motions that do not involve Mylan. Teva agrees to incorporate its filings with those of Mylan in a consolidated filing, subject to the ordinary rules for one party on page limits.

² To the extent the Board considers granting Teva’s motion for joinder, Teva is willing to take a passive role. For example, Teva agrees not file additional papers, not file additional pages to Mylan’s papers, not present any new, additional, or supplemental arguments, not cross-examine Allergan’s expert or attempt to offer a rebuttal expert of its own, and not present any arguments at oral hearings. *See e.g., Samsung Elec. Co., Ltd. v. Arendi S.A.R.L.*, IPR2014-01518, Paper 10 at 6 (PTAB Mar. 18, 2015) (allowing joinder where movants takes a “limited understudy role” without a separate opportunity to actively participate). Only if Mylan drops out of the proceedings for any reason, will Teva cease its passive role.

Eastern District of Texas (EX1023). Petitioner also identifies the following pending actions involving the '556 patent: *Allergan, Inc., v. Innopharma, Inc. and Pfizer, Inc.*, No. 2:15cv1504, in the Eastern District of Texas.

2. On June 3, 2016, Mylan filed its petition for *inter partes* review seeking cancellation of claims 1-20 of the '556 patent. (Mylan IPR, Paper 3.)

3. The Mylan IPR petition included the following five grounds for challenging the validity of the '556 patent:

Ground 1: Claims 1-20 are anticipated under 35 U.S.C. § 102(b) by Ding '979;

Ground 2: Claims 1-20 are obvious under 35 U.S.C. § 103 over Ding '979 and Sall;

Ground 3: Claims 14 and 19 are obvious under 35 U.S.C. § 103 over Ding '979, Sall, and Glonek;

Ground 4: Claims 11, 18, and 20 are obvious under 35 U.S.C. § 103 over Ding '979, Sall, and Acheampong; and

Ground 5: Claim 19 is obvious under 35 U.S.C. § 103 over Ding '979, Sall, Glonek, and Acheampong.

4. On September 9, 2016, Patent Owner filed a Preliminary Response. (Mylan IPR, Paper No. 7)

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