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. 9,248,191
Issued Date: February 2, 2016
Title: Methods of Providing Therapeutic Effects
Using Cyclosporin Components

IPR Case No.: IPR2017-00586
Patent No. 9,248,191

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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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. 9,248,191 ("the '191 patent"), seeking cancellation of claims 1-27 of the '191 patent ("the Teva IPR") and joinder of this proceeding with *Mylan Pharmaceuticals Inc., v. Allergan, Inc.*, Case IPR2016-01132 (the "Mylan IPR" or "IPR 1132").

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 '191 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 filings[1] 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 '191 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. Petitioner also identifies the following pending action: *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 1-27 of the '191 patent. (Mylan IPR, Paper 3.)

3. The Mylan IPR petition included the following four grounds for challenging the validity of the '191 patent:

Ground 1: Claims 1-16 and 21-27 are obvious under 35 U.S.C. § 103 over Ding '979 and Sall;

Ground 2: Claims 1-16 and 21-27 are obvious under 35 U.S.C. § 103 over Ding '979, Sall and Acheampong; and

Ground 3: Claims 17-20 are obvious under 35 U.S.C. § 103 over Ding '979, Sall, and Glonek; and

Ground 4: Claim 20 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).

5. December 8, 2016, the Board instituted review of claims 1-27 of the '191 patent in the Mylan IPR with respect to Grounds 1-4. (Mylan IPR, Paper 8.)

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