Paper No. _____

Filed on behalf of Akorn Inc.
By: Michael R. Dzwonczyk
Azy S. Kokabi
Travis B. Ribar
Sughrue Mion, PLLC
2100 Pennsylvania Ave., NW
Washington, DC 20037
Telephone: 202-293-7060
Facsimile: 202-293-7860
email: mdzwonczyk@sughrue.com
akokabi@sughrue.com
tribar@sughrue.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKORN INC.
Petitioner

v.

ALLERGAN, INC.
Patent Owner

Case No. IPR2017-00594
Patent No. 8,685,930

PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,685,930

TABLE OF CONTENTS

Page

I. INTRODUCTION

On December 8, 2016, the Board instituted IPR2016-01127, stating that there was a reasonable likelihood that claims 1-36 of U.S. Patent No. 8,685,930 to Acheampong *et al.* ("the '930 patent," EX1001) are unpatentable. *Mylan Pharm., Inc. v. Allergan, Inc.*, IPR2016-01127, slip op. at 24 (PTAB December 8, 2016) (Paper 8). The present Petition presents the same grounds of unpatentability and the same arguments and evidence as the Petition in IPR2016-01127. The present Petitioner has received permission from the petitioner in IPR2016-01127 to rely upon the same expert. The present Petition is substantially identical to the Petition filed in IPR2016-01127. Accordingly, it is believed that the present Petition should be granted for the same reasons that the Board instituted IPR2016-01127.

In particular, Akorn Inc. ("Petitioner") requests review of the '930 patent, EX1001) that issued on April 1, 2014. PTO records indicate the '930 patent is assigned to Allergan, Inc. ("Patent Owner"). This Petition demonstrates that there is a reasonable likelihood that claims 1-36 of the '930 patent are unpatentable for failure to distinguish over asserted prior art. Additional petitions are being filed to address related patents that are assigned to Patent Owner. All challenged patents are continuations from the same family and are terminally disclaimed over one another. The patents claim an ophthalmic emulsion for the treatment of

overlapping ocular disorders, or conventional methods of administering the emulsion.

In particular, the '930 patent claims a topical ophthalmic emulsion for treating dry eye disease, such as keratoconjunctivitis sicca ("KCS"), which contains 0.05 percent by weight ("%") cyclosporin A ("CsA"), 1.25% castor oil, and other standard emulsion ingredients in a combination well known in the art. EX1001, 14:41-16:49. In fact, each element of the emulsion, including the claimed CsA and castor oil percentages and preferred ratios for combining them, was disclosed in a single prior art reference (Ding '979) for use in topical ophthalmic emulsions to treat dry eye disease/KCS. Indeed, during prosecution of a parent application, applicants admitted that the claimed emulsion containing 0.05% CsA and 1.25% castor oil "is squarely within the teaching of the Ding ['979] reference" and "would have been obvious" to a person of skill in the art at the time of the invention. EX1005, 0435; EX1002, ¶18.

Four years later, in prosecuting the '930 patent as a continuation application, applicants changed course and attempted to withdraw these admissions. EX1004, 0007. They argued that data collected ***after*** their earlier admissions established patentability because of an alleged unexpected result that the emulsion was "equally or more therapeutically effective for the treatment of dry eye/keratoconjunctivitis sicca than the formulation containing 0.10% by weight

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.