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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**

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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

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