

Paper No. _____

Filed on behalf of Akorn Inc.

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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. IPR2017-00596

Patent No. 8,629,111

MOTION FOR JOINDER

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Akorn, Inc. (“Akorn”) requests joinder and/or consolidation of its today-filed Petition (“the Akorn Petition”) for *inter partes* review of U.S. Patent No. 8,629,111 (“the ‘111 Patent”) (“the Akorn IPR”) with IPR2016-01128, filed June 3, 2016 by Mylan Pharms. Inc. (“the Mylan IPR”). The Mylan IPR was instituted on December 8, 2016. *Mylan Pharm., Inc. v. Allergan, Inc.*, IPR2016-01128, slip op. at 22 (PTAB December 8, 2016) (Paper 8).

The Akorn Petition is substantially the same as the Petition in the Mylan IPR. The Akorn Petition involves the same patent, the same claims, and presents the same grounds of unpatentability, using the same evidence, as the Petition in the Mylan IPR, except where Akorn-specific substitutions were required. The Akorn IPR challenges the claims as anticipated and/or obvious over the same prior art, based on the same arguments, and relies on the same expert, Dr. Mansoor Amiji as the Mylan IPR. Indeed, Mylan has consented to Akorn’s retention of Dr. Amiji for purposes of the Akorn IPRs.

Joinder is appropriate because the Akorn IPR Petitioner will take on a purely understudy role in the Mylan IPR, and thus joinder will not cause any delay in the Mylan IPR trial schedule. Mylan Pharms., Inc., the Petitioner in the Mylan IPR, is

not opposing this joinder, and joinder will not prejudice any of the parties to the Mylan IPR.

II. STATEMENT OF MATERIAL FACTS

1. On June 3, 2016, Mylan filed a Petition for *Inter Partes* Review (“the Mylan Petition”) of claims 1-27 of U.S. Patent No. 8,629,111. The Mylan IPR was accorded Case No. IPR2016-01128.

2. The Mylan Petition asserted the following grounds of unpatentability:

a. Ground 1: Claims 1-27 are anticipated under § 102 by Ding ’979;

b. Ground 2: Claims 1-27 are obvious under §103 over Ding ’979 and

Sall; and

c. Ground 3: Claims 11 and 16 are obvious under §103 over Ding ’979, Sall, and Acheampong.

3. On December 8, 2016, the PTAB granted the Mylan Petition on all of the asserted grounds of unpatentability. *Mylan Pharm., Inc. v. Allergan, Inc.*, IPR2016-001128, slip op. at 22 (PTAB December 8, 2016) (Paper 8).

4. Akorn filed a Petition for *Inter Partes* Review on January 6, 2017, Case No. IPR2017-00596, and filed the present Motion for Joinder the same day.

5. The Petition in the Akorn IPR is substantially identical to the Petition in the Mylan IPR and includes substantially the same exhibits and relies on the same expert as the Petition in the Mylan IPR.

III. APPLICABLE LEGAL STANDARD

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

(c) JOINDER. — If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). The PTAB has indicated that a motion for joinder should set forth the reasons joinder is appropriate, identify any new grounds of unpatentability asserted in the petition, and explain what impact (if

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