

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKORN INC.,
Petitioner,

v.

ALLERGAN, INC.,
Patent Owner.

Case IPR2017-00596
Patent 8,629,111 B2

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Akorn Inc. (“Akorn”) filed a Petition, seeking an *inter partes* review of claims 1–27 of U.S. Patent No. 8,629,111 B2 (“the ’111 patent,” Ex. 1001). Paper 4 (“Pet”). Along with the Petition, Akorn filed a Motion for Joinder to join this proceeding with *Mylan Pharmaceuticals Inc. v. Allergan, Inc.*, IPR2016-01128. Paper 3 (“Mot”). Akorn filed the Petition and Motion for Joinder in the present proceeding on January 6, 2017, within one month after we instituted trial in IPR2016-01131. 37 C.F.R. § 42.122(b). Patent Owner Allergan, Inc. (“Allergan”) filed an opposition to Akorn’s Motion for Joinder (Paper 8) and Akorn filed a reply (Paper 9). Via e-mail correspondence to the Board on March 30, 2017, Allergan indicated that it did not intend to file a Preliminary Response to Akorn’s Petition. Ex. 3001.

As explained further below, we institute trial on the same grounds as instituted in IPR2016-01128 and grant Akorn’s Motion for Joinder.

II. DISCUSSION

In IPR2016-01128, Mylan Pharmaceuticals Inc. (“Mylan”) challenged claims 1–27 of the ’111 patent on the following grounds:

| References | Basis | Claims challenged |
|---------------------------------|----------|-------------------|
| Ding ’979 ¹ | § 102 | 1–27 |
| Ding ’979 and Sall ² | § 103(a) | 1–27 |

¹ Ding et al., US 5,474,979, issued Dec. 12, 1995 (Ex. 1006).

² Sall et al., *Two Multicenter, Randomized Studies of the Efficacy and Safety of Cyclosporine Ophthalmic Emulsion in Moderate to Severe Dry Eye Disease*, 107 OPTHALMOLOGY 631–39 (2000) (Ex. 1007).

| References | Basis | Claims challenged |
|--|----------|-------------------|
| Ding '979, Sall, and Acheampong ³ | § 103(a) | 11 and 16 |

After considering the Petition and the Patent Owner Preliminary Response, we instituted trial in IPR2016-01128 on all three grounds. IPR2016-01128, Paper 8, 22–23.

Akorn's Petition is substantively identical to Mylan's Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2016-01128, Paper 3 *with* IPR2017-00596, Paper 4. For the same reasons stated in our Decision on Institution in IPR2016-01128, we institute trial in this proceeding on the same three grounds. *See* IPR2016-01128, Paper 8.

Having determined that institution is appropriate, we now turn to Akorn's Motion for Joinder. Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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.” *Id.* When determining whether to grant a motion for joinder we consider factors

³ Acheampong et al., *Cyclosporine Distribution into the Conjunctiva, Cornea, Lacrimal Gland, and Systemic Blood Following Topical Dosing of Cyclosporine to Rabbit, Dog, and Human Eyes*, LACRIMAL GLAND, TEAR FILM, AND DRY EYE SYNDROMES 2: BASIC SCIENCE AND CLINICAL RELEVANCE 1001–04 (David A. Sullivan et al. eds., 1998) (Ex. 1008).

such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. As Akorn notes, the Petition in IPR2017-00596 is substantially the same as the Mylan Petition, presenting the same arguments and relying on the same expert testimony and exhibits. Mot. 4–5.

Akorn has also agreed to assume an “understudy role” in the joined proceedings. *Id.* at 6. As long as Mylan remains a party, Akorn agrees to “consolidated filings for all substantive papers in the respective proceedings, except for motions that do not involve Mylan.” *Id.* at 6. Akorn also agrees that cross-examination will not be extended in light of the joinder, and that the oral argument will be conducted by Mylan. *Id.* Akorn further contends that there will be no impact on the trial schedule of IPR2016-01128, and that joinder will simplify the proceedings without prejudice to the parties. *Id.* at 6–7.

Allergan opposes Akorn’s Motion for Joinder, arguing that the statute prohibits the joinder of time barred petitions to existing *inter partes* review proceedings. Paper 8, 3–5. But Allergan also “acknowledges the Board’s current position that (1) section 315(b)’s one-year time bar exception applies to both petitions and requests for joinder and (2) that institution decisions are not reviewable on appeal.” *Id.* at 5 n.1 (citing *Microsoft Corp. v. Proxyconn Inc.*, IPR2013-00109, slip op. at 4 (PTAB Feb. 25, 2013) (Paper 15); *Achates Reference Publ’g, Inc. v. Apple, Inc.*, 803 F.3d 652 (Fed. Cir. 2015); 37 C.F.R. § 42.122(b)). We are not persuaded by Allergan’s arguments for

the reasons stated in the Board's prior decisions. *See, e.g., Microsoft*, Paper 15 at 4 (“[T]he one-year time bar [under 35 U.S.C. § 315(b)] does not apply to a request for joinder.”).

In view of the foregoing, we find that joinder based upon the conditions stated in Akorn's Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined. Thus, Akorn's Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is

ORDERED that trial is instituted in IPR2017-00596 on the following grounds:

- A. Claims 1–27 as anticipated by Ding '979;
- B. Claims 1–27 as obvious over Ding '979 and Sall;
- C. Claims 11 and 16 as obvious over Ding '979, Sall, and

Acheampong.

FURTHER ORDERED that Akorn's Motion for Joinder with IPR2016-01128 is *granted*;

FURTHER ORDERED that IPR2017-00596 is terminated and joined to IPR2016-01128, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions stated in Akorn's Motion for Joinder (Paper 3), as discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2016-01128 shall govern the joined proceedings;

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