

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. IPR2017-00599

Patent No. 8,633,162

REPLY TO OPPOSITION TO MOTION FOR JOINDER

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I. SUMMARY

Petitioner Akorn's motion for joinder should be granted because it is timely, typical, and presents nothing out of the ordinary for the Board to consider.

The Board has routinely granted motions for joinder where, party seeking joinder presents the same arguments and the same grounds as in the IPR to which joinder is sought. *See, e.g., Samsung Electronics, Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 (PTAB August 24, 2016); *Perfect World Entm't, Inc. v. Uniloc USA, Inc., et al.*, IPR2015-01026, Paper 10, (PTAB Aug. 3, 2015); *Fujitsu Semiconductor Limited v. Zond, LLC*, IPR2014-00845, Paper 14 (PTAB Oct. 2, 2014); *Enzymotec Ltd. v. Neptune Technologies & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB Jul. 9, 2014). This is the same situation here, and Petitioner Akorn's Motion for Joinder should be granted, consistent with the Board's "policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." *Enzymotec*, IPR2014-00556, Paper 19, at 5; *see also* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right – if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding . . .")) (emphasis added).

The Board has also routinely granted joinder where, as here, the joining party agrees to an understudy role in the joined proceeding. See, e.g., *Amerigen Pharm. Ltd. v. UCB Pharma GMBH*, IPR2016-01665, slip op. at 4-7 (PTAB December 7, 2016) (Paper No. 26).

Furthermore, the Board has also routinely granted joinder where, as here, the petitioner files its Petition and Motion for Joinder within 30 days of the institution of the trial in the IPR to which joinder is sought. See, e.g., *Samsung Electronics, Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 (PTAB August 24, 2016); *Nintendo of Am., Inc., et al. v. Babbage Holdings, LLC*, IPR2015-00568, Paper 12 (PTAB Mar. 18, 2015)).

Accordingly, Petitioner Akorn's Motion for Joinder should be granted, since it is consistent with motions for joinder that have been routinely granted.

II. RESPONSE TO PATENT OWNER'S ARGUMENT

Patent Owner's sole argument against joinder is an interpretation of 35 U.S.C. § 315(b) and (c) that Patent Owner itself acknowledges has already been addressed and rebuffed by the Board. In particular, Patent Owner argues that Petitioner Akorn's IPR Petition was time-barred under 35 U.S.C. § 315(b)-(c). See Patent Owner Allergan, Inc.'s Opposition to Motion for Joinder, IPR2017-00599, Paper 7 (February 6, 2017), at 5. Patent Owner acknowledges, however, that its

argument is not one that is consistent with the Board's current position on this issue. *Id.* at FN 1 (“Allergan 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. *See Microsoft Corp. v. Proxyconn Inc.*, IPR2013-00109, Paper 15 (PTAB Feb. 25, 2013); *see also Achates Reference Publ'g, Inc. v. Apple, Inc.*, 803 F.3d 652 (Fed. Cir. 2015); 37 C.F.R. § 42.122(b).”). Indeed, in *Microsoft* and *Samsung*, the Board granted joinder specifically because the exception to the one-year time bar applied. *Microsoft Corp. v. Proxyconn Inc.*, IPR2013-00109, Paper 15 (PTAB Feb. 25, 2013) at 4; *Samsung Electronics, Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 (PTAB August 24, 2016) at 4.

Accordingly, there is no disagreement between the parties that the Board, by granting joinder in, for example, *Microsoft* (IPR2013-00109) and *Samsung* (IPR2016-00962), has confirmed that 35 U.S.C. § 315 does not bar joinder in the present instance.

III. CONCLUSION

In view of the above, Petitioner Akorn respectfully requests that the Board grant its Motion for Joinder.

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