

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. IPR2017-00601

Patent No. 9,248,191

MOTION FOR JOINDER

Table of Contents

I. Statement of precise relief requested..... 1

II. Statement of material facts2

III. Applicable legal standard3

IV. Argument4

 A. Joinder is timely4

 B. Joinder is appropriate because both IPRs present the same grounds of unpatentability concerning the same claims of the same patent.....5

 C. Joinder is appropriate because the Akorn IPR proposes no additional grounds of unpatentability.....6

 D. Joinder will not impact the existing trial schedule.....6

 E. Joinder will simplify briefing and discovery6

V. Conclusion7

CERTIFICATE OF SERVICE9

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. 9,248,191 (“the ‘191 Patent”) (“the Akorn IPR”) with IPR2016-01132, 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 24 (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. 9,248,191. The Mylan IPR was accorded Case No. IPR2016-01132.

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

a. Ground 1: Claims 1-16 and 21-27 are obvious under §103 over Ding ’979 and Sall;

b. Ground 2: Claims 1-16 and 21-27 are obvious under §103 over Ding ’979, Sall, and Acheampong;

c. Ground 3: Claims 17-20 are obvious under §103 over Ding ’979, Sall, and Glonek; and

d. Ground 4: Claim 20 is obvious under §103 over Ding ’979, Sall, Acheampong, and Glonek.

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.*, IPR2016-01128, slip op. at 24 (PTAB December 8, 2016) (Paper 8).

4. Akorn filed a Petition for *Inter Partes* Review on January 6, 2017, Case No. IPR2017-00601, 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

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