

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC. and APOTEX CORP.
Petitioner

v.

ALCON RESEARCH, LTD
Patent Owner

Patent No. 8,791,154
Issue Date: July 29, 2014
Title: HIGH CONCENTRATION OLOPATADINE
OPHTHALMIC COMPOSITION

Inter Partes Review No. 2016-01640

**MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioners Apotex Inc. and Apotex Corp. (collectively, “Apotex” or the “Petitioners”) respectfully request joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the above-captioned *inter partes* review (hereinafter “Apotex IPR”) with the pending *inter partes* review concerning the same patent and the same two grounds of invalidity in *Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, Case No. IPR2016-00544 (“Argentum IPR”), which was instituted on July 18, 2016. Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent and will not prejudice any of the parties to the Argentum IPR.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of July 18, 2016, the date on which the Argentum IPR was instituted.

II. BACKGROUND

On February 2, 2016, Argentum filed a Petition for *inter partes* review challenging claims 1-4, 8, 12, 13, 21, and 22 of the ’154 patent, which was assigned Case No. IPR2016-00544. On July 18, 2016, the Board instituted review on claims 1-4, 8, 12, 13, 21, and 22 on the following two grounds:

- (1) Claims 1-4, 8, 12, 13, 21, and 22 as obvious under 35 U.S.C. § 103 over Bhowmick, Yanni, and Castillo; and

(2) Claims 1-4, 8, 12, 13, 21, and 22 as obvious under 35 U.S.C. § 103 over Schneider, Hayakawa, Bhowmick, and Castillo.

The accompanying Petition presents only the identical grounds on which the Argentum IPR was instituted.

Argentum has represented to Apotex that it will not oppose this Motion for Joinder.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(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.

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should

consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of the present Apotex IPR with the Argentum IPR is appropriate.

“A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Id.* at 4. Each of these is addressed fully below.

A. Joinder is Appropriate

Joinder with the Argentum IPR is appropriate here because the Apotex IPR is limited to the same grounds instituted in the Argentum IPR and it relies on the same prior art analysis and expert testimony submitted by Argentum. The Apotex IPR is identical with respect to the grounds raised in the Argentum IPR, and does not include any grounds not raised in that proceeding.

Joinder is also appropriate because it will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of validity of the challenged claims of the '154 patent. For example, a final written decision on the validity of the '154 patent has the potential to minimize issues and potentially resolve any litigation with respect to the '154 patent.

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