

Case No. IPR2018-01358
U.S. Patent No. 9,549,938

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

ANACOR PHAMACEUTICALS, INC.,
Patent Owner

Case No. IPR2018-01358
U.S. Patent No. 9,549,938

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

Petitioner Mylan Pharmaceuticals Inc. (“Mylan”) has filed a motion seeking joinder with IPR2018-00168 filed by FlatWing Pharmaceuticals, Inc. (“Flatwing”). The Board instituted IPR2018-00168 on June 8, 2018, and issued a scheduling order setting oral argument for March 1, 2019.

Patent Owner Anacor Pharmaceuticals, Inc. (“Anacor”) opposes Mylan’s motion to the extent that Mylan is not confined to a true “silent understudy” role. *Famy Care Ltd. v. Allergan, Inc.*, IPR2017-00567, Paper No. 12 at 9 (P.T.A.B. July 10, 2017). Although Mylan’s motion expresses a purported willingness to limit the extent of its participation in the joined proceedings, Mylan has proposed no specific limits on its ability to engage in discovery, briefing, and trial.

Three particular issues with Mylan’s motion are illustrative. *First*, Mylan raises the possibility that it will make separate filings after seeking authorization from the Board to address any disagreements with FlatWing. Mot. at 6. This, of course, would require the Board to resolve a potential dispute among the parties each time Mylan seeks to press its own case. While Mylan asserts that any separate filing will be “short,” it has not committed to any specific type or volume limitation. And although Mylan states that its current petition is a “practical” or “substantive” copy of Flatwing’s, Mot. at 1–2, Mylan has not restricted itself from raising new arguments and issues. *Second*, Mylan states that it will “coordinate with FlatWing” to “manage questioning at depositions.” Mot. 7. This vague

pronouncement suggests that Mylan will seek an active role in discovery. *Third*, by not discussing its desired role at oral argument, Mylan presumably will seek some level of participation at that time. *See Famy Care*, Paper No. 12 at 9 (denying joinder where subsequent petitioner insisted on participating in oral argument). Thus, it is not at all clear that Mylan has actually committed to an understudy role, much less a “silent” one.

Mylan suggests that in granting joinder, the Board may adopt “similar” limits to those it has imposed in the past. Mot. at 6 (citing cases). But as discussed above, Mylan has agreed to few, if any, specific limits, and the additional complexity Mylan seeks to add to FlatWing’s IPR will prejudice Anacor. Nevertheless, consistent with limitations that the Board has previously imposed on “understudies,” Anacor will not oppose joinder if: (a) the joined proceedings are based exclusively on the petition and evidence submitted by FlatWing; (b) all filings by Mylan in the joined proceeding are consolidated with FlatWing’s and the page limits and word counts set forth in 37 C.F.R. § 42.24 apply to all such consolidated briefing; (c) Mylan is bound by any agreements between Anacor and FlatWing concerning discovery and/or depositions; (d) Mylan at deposition shall not receive any direct, cross-examination, or redirect time beyond that permitted for FlatWing alone under either 37 C.F.R. § 42.53 or any agreement between Anacor and FlatWing; and (e) Mylan will not participate in oral argument. *See*

Mylan Pharm. Inc. v. Novartis AG, IPR2015-00268, Paper No. 17 at 5 (P.T.A.B. Apr. 10, 2015); *see also Navico, Inc. v. Garmin Switz. GmbH*, IPR2017-02051, Paper No. 8 at 7–8 (P.T.A.B. Jan. 23, 2018); *Famy Care*, Paper No. 12 at 9.

Date: August 6, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that a true and correct copy of the foregoing document was served on August 6, 2018, by delivering a copy via electronic mail on the following attorneys of record for the Petitioner:

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