

Paper No. _____
Filed: September 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

ANACOR PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2018-01358
Patent 9,549,938

**REPLY TO OPPOSITION TO MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

I. Statement of the Precise Relief Requested

Mylan Pharmaceuticals Inc. (“Mylan” or “Petitioner”) hereby replies to the opposition of Patent Owner Anacor Pharmaceuticals, Inc. (“Patent Owner” or “PO”) to Mylan’s motion for joinder.

Mylan’s motion for joinder (paper 3) stated that Mylan’s petition for *inter partes* review was substantively identical to Petition IPR2018-00168 filed by FlatWing Pharmaceuticals, LLC (“FlatWing”). Mylan’s motion for joinder was timely filed, within one month of the institution decision in IPR2018-00168, and the grounds are substantively identical to the grounds in the original petition filed in IPR2018-00168, which Grounds were all instituted. Mylan also stated it would participate in an understudy role to FlatWing, absent termination of FlatWing as a party.

PO states that it will not oppose joinder if Mylan agrees to certain limitations that it states are “consistent with limitations the Board has previously imposed on ‘understudies.’” (Opp. at 2).

Mylan has already stated in its motion that it will serve in an understudy role to FlatWing, and Mylan further agrees that so long as FlatWing continues to remain a party and prosecute the IPR: (a) the joined proceedings will be 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 and

word counts set forth in 37 C.F.R. § 42.24 apply to such consolidated briefing; (c) Mylan is bound by any agreements between Anacor and FlatWing concerning discovery and/or depositions; (d) Mylan at deposition will 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. Mylan expressly reserves the right to fully participate in the proceeding should FlatWing discontinue prosecuting the IPR.

Joinder will have no impact on the trial schedule of IPR2018-00168 because Mylan, in its understudy role, is agreeable to the same schedule. Mylan is not subject to a time-bar under 35 U.S.C. § 315. As such, Mylan again requests institution of the petition even if the Board should decide against joinder with IPR2018-00168.

PO cites to a joinder decision in *Famy Care Ltd. V. Allergan, Inc.*, IPR2017-00567, to voice concern whether Mylan has agreed to the limited role of an understudy in the present proceeding. In *Famy Care*, the Board noted that Famy Care sought “the opportunity to present additional arguments, briefing, and evidence, including two additional expert declarations, beyond what is being considered based on Mylan’s Petition in IPR2016-01128.” Under those

circumstances, the Board determined that joinder “would not ‘secure the just, speedy, and inexpensive resolution’ of the proceeding.”

The present case for joinder is nothing like what was requested by Famy Care. Here, Mylan has agreed to the understudy role and has made clear that its role will be that of a silent understudy to the extent that the original petitioner, FlatWing, continues to prosecute the IPR. Under these circumstances, joinder is appropriate and will not be disruptive to the conduct of the original proceeding, and will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of patentability of the challenged claims of the ’938 patent. As noted previously, Mylan is not time-barred under 35 U.S.C. § 315, so joinder will obviate the need to burden the Board with two separate IPR trials that are based on identical grounds and evidence, and will not prejudice Patent Owner or FlatWing.

II. Conclusion

For the foregoing reasons, Mylan respectfully requests that this motion be granted and an *inter partes* review of the challenged claims 1-6 be instituted based on grounds 1-4, and that this proceeding be joined with IPR2018-00168.

Respectfully submitted,

Dated: September 6, 2018

/ Steven W. Parmelee /
Steven W. Parmelee, Lead Counsel
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Reply to Opposition to Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) was served on September 6, 2018, on the Patent Owner at the electronic correspondence addresses of the Patent Owner as follows:

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