

Paper No. ____
Filed: July 6, 2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

ANACOR PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2018-01359

Patent 9,566,289

**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”) submits, concurrently with this motion, a petition for *inter partes* review (“Petition”) of claims 1-15 of U.S. Patent No. 9,566,289 (“the ’289 patent”), which is assigned to Anacor Pharmaceuticals, Inc. (“Patent Owner”). Mylan respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petition with a pending *inter partes* review initiated by FlatWing Pharmaceuticals LLC (“FlatWing”), IPR2018-00169. Petitioner requests joinder as to the instituted grounds, Grounds 1-6.

Joinder will promote efficiency and consistent resolution of substantively identical challenges to the same patent. This motion for joinder is timely because it is filed within one month of the institution decision in IPR2018-00169. Joinder should create no unfair burden for the Board, Patent Owner, or FlatWing because these grounds are substantive copies of grounds from the original petition filed in IPR2018-00169, which Grounds have all been instituted. The present Petition contains only minor modifications from the petition in IPR2018-00169, such as changes to address the identity of the petitioner, the request for joinder with IPR2018-00169, and formatting the Identification of the Challenge as a chart. The Petition relies upon the expert declaration of Dr. Stephen Kahl, Ph.D (Ex. 1003) and the expert declaration of Dr. S. Narasimha Murthy, Ph.D (Ex. 1005), each of

which was submitted in IPR2018-00169. Petitioner has updated the exhibit labeling to match the case information for this case.

Absent termination of FlatWing as a party to the proceeding, Mylan anticipates participating in a joined proceeding in an understudy role. Moreover, joinder will have no impact on the trial schedule of IPR2018-00169 because that IPR is still in its early trial stages, and Mylan, in its limited role, is agreeable to the same schedule. Mylan is not subject to any time-bar under 35 U.S.C. § 315. As such, Mylan requests institution of the petition even if the Board decides against joinder with IPR2018-00169.

II. Background

On November 21, 2017, FlatWing filed a petition for *inter partes* review challenging claims 1-15 of the '289 patent, Case No. IPR2018-00169. On June 8, 2018, the Board instituted review on claims 1-15. This Petition is a practical copy of the IPR2018-00169 petition, including the same prior art analysis and identical expert testimony. *See* Pet.

III. Argument

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. §315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In

deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

B. Mylan's Motion for Joinder Is Timely

Joinder may be requested no later than one month after the institution date of an *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122. Here, because the Board issued its institution decision in IPR2018-00169 on June 8, 2018, this Motion for Joinder and the accompanying Petition are timely.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. As discussed below, granting joinder will not enlarge the scope of the IPR2018-00169 beyond that proposed in the original petition and will not negatively impact the IPR2018-00169 schedule.

1. Joinder is Appropriate

Joinder with IPR2018-00169 is appropriate because the Petition is limited to the same grounds proposed in the IPR2018-00169 petition, all of which were instituted. It also relies on the same prior art analysis and identical expert testimony to that submitted by FlatWing. Indeed, the Petition is nearly identical with respect to the grounds raised in the IPR2018-00169 petition, and does not include any grounds not raised in that petition.

Joinder is also appropriate because it will promote the just, speedy, and inexpensive resolution of patentability issues, including the determination of patentability of the challenged claims of the '289 patent. 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 based on identical grounds and evidence.

Moreover, granting joinder will not prejudice Patent Owner or FlatWing. As mentioned above, the accompanying Petition does not raise any new ground that is not raised in the IPR2018-00169 petition. Therefore, joinder should not significantly affect the timing in IPR2018-00169. Also, there should be little to no additional cost to Patent Owner or FlatWing given the absence of new grounds. On the other hand, Mylan and the public may be potentially prejudiced if joinder is denied. For example, absent joinder, Patent Owner and FlatWing might settle and

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