

Filed: November 14, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MSN LABORATORIES PRIVATE LTD. AND MSN PHARMACEUTICALS
INC.

Petitioner,

v.

BAUSCH HEALTH IRELAND LIMITED,

Patent Owner.

Case IPR2023-00016
U.S. Patent No. 7,041,786

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

I. INTRODUCTION

Patent Owner Bausch opposes Petitioner MSN's joinder motion because MSN in fact seeks an unbounded and active role in the joined proceedings rather than the "understudy role" it references no fewer than nine times in its motion. If MSN truly wanted such an unbounded and active role, it should have filed its own petition. Having chosen to instead seek joinder with Mylan's earlier IPR action (IPR2022-00722), MSN's role should be limited to that of a complete understudy to avoid unnecessarily complicating the Mylan action and unnecessarily burdening Bausch and the Board. Bausch told MSN it would not oppose MSN's joinder motion if MSN accepted a complete understudy role, but MSN refused. Bausch therefore opposes joinder unless and until MSN accepts a complete understudy role.

II. ARGUMENT

The America Invents Act permits the Board in its discretion to join multiple IPR proceedings only in certain circumstances. 35 U.S.C. § 315(c); 37 C.F.R. 42.122. As the moving party, MSN has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). When determining whether to grant a motion for joinder, the Board considers factors including: (1) the impacts joinder would have on the trial schedule; and (2) how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, Paper 15 at 4 (P.T.A.B. Apr. 24, 2013).

A. A complete understudy role is appropriate for MSN.

To prevent any delays of and complications in the joined proceeding, the Board limits the joined party's participation when granting joinder motions. Here, MSN repeatedly states that it wants an understudy role, and, like other panels, this Board should limit MSN's participation in that way. For example, in *Everlight Elecs. Co., Ltd. v. Document Sec. Sys.*, the Board clarified that the joined petitioner "will be a 'complete understudy' and do *nothing* unless and until [the original petitioner] abandons its IPR." IPR2018-01225, Paper 14 at 7 (P.T.A.B. Sept. 27, 2018) (emphasis in original). The Board specifically stated that "[the joined petitioner] will not demand or even request that it has any input to any motion, brief, exhibit, deposition, teleconference, hearing, or any other aspect of the joined IPR, unless [the original petitioner] abandons its IPR. [The original petitioner] and PO will proceed in the exact same manner as if [the joined petitioner] had never joined." *Id.*

The Board imposed similar limitations in *Ion Geophysical Corp. and Ion International S.A.R.L. v. Westerngeco LLC*, specifically ordering that the joined party "is not permitted to file papers, engage in discovery, or participate in any deposition or oral hearing in IPR2014-00689." *See* IPR2015-00565, 2015 WL 1906173, at *4 (P.T.A.B. Apr. 23, 2015); *see also* *Microsoft Corp. v. Ipr Licensing, Inc.*, IPR2014-00525." *See* No. IPR2015-00074, 2015 WL 1004475, at *4 (P.T.A.B.

Mar. 4, 2015) (Board ordering that “unless given prior authorization by the Board, [the joined party] is not permitted to file papers, engage in discovery, or participate in any deposition or oral hearing in”). The Board should impose those same limitations here. A complete understudy role for MSN is appropriate.

B. The Board should reject the unbounded and active role MSN articulated in its motion.

Despite stating that it would take an “understudy” role in the joined proceeding nine times in its motion, Paper 4 at 5, 9, 10, 11, 12, MSN instead seeks an unbounded and active role. For example, MSN ambiguously indicates that it will submit separate filings “in the unlikely event of a disagreement with Mylan’s position or an issue unique to MSN arises during the proceeding.” Paper 4 at 9-10. As another example, rather than simply coordinating with Mylan, MSN ambiguously indicates that it will only “*endeavor to* coordinate with Mylan” on such things as “manag[ing] questioning at depositions” and “ensur[ing] that briefing and discovery occur within the time normally allotted.” *Id.* at 10 (emphasis added). When pressed on these ambiguous statements during a meeting and confer, MSN could not articulate what “the unlikely event” would be. Instead, MSN’s counsel stated that “you know when you see it,” like “pornography.” EX2001 at Andres O. Larsen’s email of October 29, 2022 (admitting that MSN referenced “pornography” when stating “you know it when you see it”). And with respect to depositions, MSN refused to say whether it would request additional time during cross examinations.

Id. The Board should reject this unbounded and active role and instead give MSN the “understudy” role it repeatedly referenced.

The Board’s holding in *Ericsson Inc. v. Unioloc 2017 LLC* is instructive in this regard. IPR2020-00376, Paper 8 at 2 (P.T.A.B. January 21, 2020). In that case, like here, the party seeking joinder, Ericsson, sought an unbounded and active role, stating that “[a]ll filings by Ericsson in the joined proceeding shall be consolidated with the filings of Microsoft *unless a filing solely concerns issues that do not involve Microsoft.*” *Id.* (emphasis added). Finding the statement confusing, the Board asked Ericsson to file a Supplemental Motion for Joinder and clarified the meaning of an “understudy role.”

In our view, an “understudy role,” if taken by Ericsson, means Ericsson will not be making any substantive filings **and will be bound by whatever substantive filings Microsoft [the original petitioner] makes**, so long as Microsoft remains a party in the proceeding. **The same is true for oral hearing presentations.** Also, **Ericsson will not seek to take cross examination testimony of any witness or have a role in defending the cross-examination of a witness, so long as Microsoft remains a party in the proceeding. Likewise with other discovery matters.** If and when Microsoft’s participation in the proceeding terminates, Ericsson can make its own filings as Petitioner. **In short, in its “understudy role,” Ericsson will remain completely inactive, but for issues that are solely directed and pertinent to Ericsson.**

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