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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MSN LABORATORIES PRIVATE LTD. AND MSN PHARMACEUTICALS INC.
Petitioners

v.

BAUSCH HEALTH IRELAND LIMITED,
Patent Owner

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

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

Pursuant to the Board's November 29, 2022 Order (IPR2023-00016, Paper 12; "Order"), Petitioner MSN Private Laboratories Private Ltd. and MSN Pharmaceuticals Inc. ("Petitioner") submits this Reply to the Opposition to Motion for Joinder by Patent Owner Bausch Health Ireland Limited ("Patent Owner").

In the Order, the Board stated that "[t]he scope of the 'understudy role' MSN is proposing is not clear from the Joinder Motion[,]" and asked for clarification on the role Petitioner would take if joinder were granted. Order, 3. The Board also provided its view on a proper "understudy role" as follows:

To be clear, in our view an “understudy role” means that MSN would not make any substantive filings and would be bound by whatever substantive filings Mylan makes, so long as Mylan remains a party in the proceeding. The same is true for oral hearing presentations. Moreover, as an understudy MSN would not seek to take cross-examination testimony of any witness or have a role in defending the cross-examination of a witness beyond mere observation. The same would be true for other discovery. If Mylan’s participation terminates before the proceeding is complete, MSN would move into an active role and could make its own filings. But absent MSN would remain completely inactive as the understudy with the exception being

ministerial issues specifically directed to MSN (e.g., an update to MSN's Mandatory Notices or Powers of Attorney).

Id. at 3-4.

Petitioner hereby adopts the Board's understanding of an understudy, and agrees to the following role should Petitioner's IPR be instituted and joined with the Mylan IPR, so long as Mylan remains a party to the proceeding:

(1) That MSN will not make any substantive filings in a joined proceeding, and that MSN will be bound by whatever substantive filing Mylan makes (including any expert reports in support of a substantive filing by Mylan);

(2) That MSN will not participate in the oral hearing in a joined proceeding, and so will be bound by Mylan's presentation at oral hearing;

(3) That MSN will not seek to take cross-examination testimony of any witness or have a role in defending the cross-examination of a witness in a joined proceeding;

(4) That MSN will not seek any other discovery during a joined proceeding;

(5) That MSN may still address ministerial issues specifically directed to MSN, for example, an update to MSN's Mandatory Notices or Powers of Attorney, in a joined proceeding.

Furthermore, Petitioner and Patent Owner have discussed the need for Petitioner to clarify its ‘understudy role’ (*see* Order at 4), and have reached an agreement on the limitations defined above.

In view of the above clarifications, Petitioner respectfully requests that its Motion for Joinder be granted, and that its Petition be instituted and joined into IPR2022-00722 pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

Respectfully submitted,

Date: December 6, 2022

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