

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC

Petitioner,

v.

ALLERGAN, INC.

Patent Owner.

U.S. Patent No. 8,629,111

Inter Partes Review No. IPR2016-01232

**PETITIONER ARGENTUM PHARMACEUTICALS LLC'S MOTION FOR
JOINDER UNDER 35 C.F.R. § 315(c) AND 37 C.F.R. §§ 42.22 and 42.122(b)**

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Argentum Pharmaceuticals LLC (“Argentum”) submits this Motion for Joinder under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,629,111. Argentum requests joinder of the instant IPR proceeding with an IPR filed by Mylan Pharmaceuticals Inc. (“Mylan”) involving the same patent claims and the same grounds of unpatentability. *Mylan Pharms. Inc. v. Allergan, Inc.*, Case IPR2016-01128 (filed June 3, 2016) (the “Mylan IPR”).

Argentum’s request for joinder is timely because it was filed before the institution date of the Mylan IPR and, therefore, “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). *See Mercedes-Benz USA, LLC v. Innovative Display Techs. LLC*, Case IPR2015-00360, slip. op. at 4 (PTAB May 22, 2015) (Paper 22) (holding joinder motion timely, as it was filed more than one month before institution decision); *Taiwan Semiconductor Mfg. Co. v. Zond, LLC*, Case IPR2014-00781, slip. op. at 4 (PTAB May 29, 2014) (Paper 5) (explaining that pre-institution joinder movant “should indicate whether it would withdraw non-instituted grounds of unpatentability should the Board institute an *inter partes* review with less than all of the asserted grounds of unpatentability in [the earlier-filed, not-yet-instituted IPR] proceedings”).

II. STATEMENT OF MATERIAL FACTS

1. On June 3, 2016, Mylan filed an IPR petition against claims 1-27 of U.S. Patent No. 8,629,111, which was accorded Case No. IPR2016-01128 (the “Mylan IPR”).

2. The Mylan IPR Petition asserts the following grounds of unpatentability:

- a. Ground 1: Claims 1-27 are anticipated under § 102 by Ding ’979;
- b. Ground 2: Claims 1-27 are obvious under Ding ’979 and Sall;
and
- c. Ground 3: Claims are obvious under §103 over Ding ’979, Sall,
and Acheampong.

3. Today, concurrent with the instant motion for joinder, Argentum filed an IPR petition that was accorded Case No. IPR2016-01232, asserting the same grounds of unpatentability against the same patent claims as in the Mylan IPR. As stated in Argentum’s IPR Petition and in this motion, Argentum is willing to withdraw any grounds of unpatentability that the Board denies in the Mylan IPR Petition.

4. Argentum’s IPR Petition is substantively identical to Mylan’s IPR Petition and includes all the same exhibits as those filed in the Mylan IPR, except

for additional Exhibits 1025-1026 and the “Additional Arguments And/Or Reasoning” section of Argentum’s IPR Petition. As stated in Argentum’s IPR Petition and in this motion, Argentum is willing to withdraw Exhibits 1025-1026 and the “Additional Arguments And/Or Reasoning” section to facilitate joinder If the Board deems such a withdrawal necessary in order to join the two proceedings.

III. APPLICABLE LEGAL STANDARD

The Leahy-Smith America Invents Act (AIA) gives the Board discretion to join any person as a party to another petitioner’s IPR. 35 U.S.C. § 315(c). In deciding whether to exercise its discretion, the Board considers factors including: (1) the movant’s reasons why joinder is appropriate; (2) whether the new petition presents 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. *Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, slip. op. at 4 (PTAB July 29, 2013) (Paper 17).

IV. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is Appropriate Because It Would Promote Efficient Resolution of Identical Challenges in a Single Proceeding

Joinder is appropriate here because it is the most expedient way to secure the just, speedy, and inexpensive resolution of two related proceedings involving the same patent in a single *inter partes* review. *See* 35 U.S.C. § 316(b); 37 C.F.R.

§ 42.1(b). Otherwise, determining the same validity questions in separate concurrent proceedings would duplicate efforts and create a risk of inconsistent results and piecemeal review. Accordingly, a joined *inter partes* review will avoid inefficiency and potential inconsistency and result in a final written decision without delay.

To facilitate joinder, Argentum has asserted the same grounds of unpatentability as in Mylan's IPR Petition and hereby agrees to: (1) withdraw any grounds the Board denies in Mylan's IPR Petition, and (2) withdraw Exhibits 1025-1026 and the "Additional Arguments And/Or Reasoning" section of Argentum's IPR Petition if joinder is granted. *See Taiwan Semiconductor*, IPR2014-00781, Paper 5, at 4 (explaining that pre-institution joinder movant "should indicate whether it would withdraw non-instituted grounds of unpatentability should the Board institute an *inter partes* review with less than all of the asserted grounds of unpatentability in [the earlier-filed, not-yet-instituted IPR] proceedings"); *SAP Am. Inc. v. Clouding IP, LLC*, Case IPR2014-00306, slip. op. at 4 (PTAB May 19, 2014) (Paper 13) (granting joinder where second petitioner promised to withdraw its expert declaration and rely only on the first petitioner's expert declaration).

Absent joinder, Argentum is not otherwise time-barred from filing a separate IPR petition that would potentially burden the Board with two separate IPR trials based on different grounds and evidence. This fact weighs in favor of joinder. *See*

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Lupin Ltd. v. Horizon Therapeutics, Inc., Case IPR2016-00283, Motion at 7 (PTAB Dec., 2015) (Paper 4) (joinder motion granted which argued “Lupin would not be time-barred from filing the present Petition without a corresponding motion for joinder”); *Teva Pharms. USA, Inc. v. AstraZeneca AB*, Case IPR2016-01122, Motion at 11 (PTAB June 1, 2016) (Paper 6) (joinder motion arguing “Teva has an independent right to file an IPR, having not been previously sued for allegedly infringing AstraZeneca’s . . . patent” and thus the “Board may otherwise be burdened with two proceedings.”)

B. No New Grounds of Unpatentability

Argentum’s IPR Petition presents the same three grounds of unpatentability as those in Mylan’s IPR Petition. Moreover, Argentum hereby agrees to: (1) withdraw any grounds the Board denies in Mylan’s IPR Petition, and (2) withdraw Exhibits 1025-1026 and the “Additional Arguments And/Or Reasoning” section of Argentum’s IPR Petition in the event that joinder is granted and such withdrawal is deemed necessary by the Board for joinder. *See Taiwan Semiconductor*, IPR2014-00781, Paper 5 at 4; *SAP Am.*, IPR2014-00306, Paper 13 at 4. Because joinder will not introduce any new prior art, expert declarations, or grounds of unpatentability into the Mylan IPR, joining Argentum’s proceeding will not complicate the substantive issues already pending in the Mylan IPR.

C. No Impact on the Trial Schedule

Joinder will not impact the Board's ability to complete the Mylan IPR in a timely manner, as Argentum raises the same grounds against the same claims in the Mylan IPR. Moreover, because Argentum agrees to withdraw all additional arguments and exhibits from its petition which differ from those in Mylan's IPR if joinder is granted, there will be no need to alter the trial schedule to accommodate depositions.

D. How Briefing and Discovery May be Simplified

In an effort to simplify briefing and discovery, Argentum agrees to abide by procedures the Board has adopted when granting joinder in other cases, such as *Dell*, IPR2013-00385, and *SAP Am.*, IPR2014-00306. In those proceedings, the Board required the petitioners to make consolidated filings, for which the first petitioner was responsible, and allowed the new petitioner to file an additional seven-page paper addressing only points of disagreement with points asserted in the consolidated filing. *See Dell*, IPR2013-00385, Paper 17 at 11; *SAP Am.*, IPR2014-00306, Paper 13 at 5. The Board also permitted the patent owner to respond to any separate filing, limiting the page limit to that used in the separate filing. *See Dell*, IPR2013-00385, Paper 17 at 11; *SAP Am.*, IPR2014-00306, Paper 13 at 5. Adopting similar procedures in this case will minimize any delay that could arise from briefing submitted by each party, while at the same time providing

all parties an opportunity to be heard. *See Dell*, IPR2013-00385, Paper 17 at 8.

Moreover, as in the above cases, Argentum shall coordinate with Mylan regarding questioning at depositions and at the oral hearing, which shall not to exceed the time allotted by the rules for one party, or as otherwise agreed between Mylan and Patent Owner or as ordered by the Board. *See Dell*, IPR2013-00385, Paper 17 at 12; *SAP Am.*, IPR2014-00306, Paper 13 at 6.

V. CONCLUSION

For the foregoing reasons, Argentum respectfully requests the Board to institute its Petition for *Inter Partes* Review and join this proceeding with *Mylan Pharmaceuticals Inc. v. Allergan, Inc.*, Case IPR2016-01128.

Respectfully submitted,

Date: June 22, 2016

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6 (e), the undersigned certifies that on this 22nd day of June, 2016, I caused to be served a true and correct copy of the foregoing “PETITIONER ARGENTUM PHARMACEUTICALS LLC’S MOTION FOR JOINDER” by Federal Express Next Business Day Delivery on representatives of the Patent Owner at the correspondence address of the Patent Owner as follows:

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