

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKORN INC.,
Petitioner

v.

ALLERGAN, INC.
Patent Owner

Case IPR2017-00599
Patent 8,633,162

**PATENT OWNER ALLERGAN, INC.'S
OPPOSITION TO MOTION FOR JOINDER**

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(b)-(c) and 37 C.F.R. § 42.22, Allergan, Inc. ("Allergan") respectfully requests that the Board deny Akorn, Inc.'s ("Akorn") Motion for Joinder, together with Akorn's petition for *inter partes* review of U.S. Patent No. 8,633,162 ("the '162 patent"), seeking cancellation of claims 1-24 of the '162 patent ("the Akorn IPR") and joinder of this proceeding with *Mylan Pharmaceuticals Inc. v. Allergan, Inc.*, Case IPR2016-01130 ("IPR 1130").

II. STATEMENT OF MATERIAL FACTS

1. Allergan, Akorn, and other entities are involved in litigation over the '162 and related patents in *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc., et al.*, No. 2:15-cv-01455, filed by Allergan, in the Eastern District of Texas.

2. The complaint in *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc., et al.*, No. 2:15-cv-01455 was filed by Allergan against defendants, including Akorn, on August 24, 2015.

3. On June 3, 2016, Mylan Pharmaceuticals, Inc. ("Mylan") filed its petition for *inter partes* review seeking cancellation of claims 1-24 of the '162 patent. (IPR 1130, Paper 3.)

4. On September 9, 2016, Allergan filed a Preliminary Response. (IPR 1130, Paper 7).

5. On December 8, 2016, the Board instituted review of claims 1-24 of the '162 patent in IPR 1130. (IPR 1130, Paper 8.)

6. Akorn submitted its petition for *inter partes* review of claims 1-24 of the '162 patent and its Motion for Joinder on January 6, 2017, more than one year after Allergan filed its complaint alleging infringement of the '162 patent against Akorn.

III. ARGUMENT

The Board should deny Akorn's Motion for Joinder because the applicable statutory scheme, 35 U.S.C. § 315(b)-(c), prohibits the joinder of time barred petitions to existing *inter partes* review proceedings.

Congress created the current *inter partes* review scheme in 2011 when it enacted the American Invents Act ("AIA"). 35 U.S.C. § 315(b) was part and parcel of this scheme. § 315(b) imposes a mandatory time bar on the institution of *inter partes* review proceedings:

An *inter partes* review ***may not be instituted*** if the petition requesting the proceeding is filed more than 1 year after the date on which the petition, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

35 U.S.C. § 315(b) (emphasis added).

Section 315(b) provides an exception from this time bar, but only for “a request for joinder”: “The time limitation set forth in the preceding sentence shall not apply for a request for joinder under subsection (c).” *Id.* The joinder provision—*i.e.* 35 U.S.C. § 315(c)—permits the Board discretion to join a party to an existing *inter partes* review provided certain criteria are met.

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join a party to that *inter partes* review any person who ***properly files a petition under section 311*** that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

35 U.S.C. § 315(c) (emphasis added).

Thus, sections 315(b)-(c) provide that if a party properly files a petition ***within the one-year deadline*** described in section 315(b), and then files a request for joinder under subsection (c) after that deadline expires, section 315(b) would permit the Board to grant the joinder request. Properly construed, the statutory scheme codified at sections 315(b)-(c) requires that the petition be “properly filed” for the consideration of both the petition and the joinder request, contemplating

that the petition would have been filed *within* the one-year period authorized by section 315(b).¹

Applying section 315(b)-(c)'s proper construction, Akorn's Motion for Joinder should be denied because its petition for *inter partes* review is time-barred, thus not properly filed. Allergan sued Akorn for infringement of the '162 patent in the Eastern District of Texas on August 24, 2015. Akorn filed its petition for *inter partes* review and Motion for Joinder on January 6, 2017, more than one year after Allergan brought the relevant infringement action. Under section 315(b)'s one-year time bar, Akorn's petition for *inter partes* review is untimely—*i.e.* barred. As noted above, section 315(c)'s proper construction permits the Board to join *inter partes* review proceedings only when the underlying petition was properly filed. Because Akorn's petition for *inter partes* review is barred by section 315(b), the board has no discretion to grant Akorn's Motion for Joinder of its improperly filed petition. Consequently, in view of the relevant statutory scheme, the Board should deny Akorn's Motion for Joinder.

¹ Allergan acknowledges the Board's current position that (1) section 315(b)'s one-year time bar exception applies to both petitions and requests for joinder and (2) that institution decisions are not reviewable on appeal. *See Microsoft Corp. v. Proxyconn Inc.*, IPR2013-00109, Paper 15 (PTAB Feb. 25, 2013); *see also Achates Reference Publ'g, Inc. v. Apple, Inc.*, 803 F.3d 652 (Fed. Cir. 2015); 37 C.F.R. § 42.122(b).

IV. CONCLUSION

Because the applicable statutory scheme unequivocally proscribes joinder in this case, Allergan respectfully requests that the Board deny Akorn's Motion for Joinder.

Respectfully submitted,

Date /February 6, 2017/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on February 6, 2017, a complete and entire copy of this Patent Owner Allergan, Inc.'s Opposition to Motion for Joinder was provided via electronic service, to the Petitioner by serving the correspondence address of record as follows:

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