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Paper No. 9
Filed: March 31, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC.,
Petitioner,

v.

ALLERGAN, INC.,
Patent Owner.

Case IPR2017-00579
Patent 8,642,556 B2

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108; 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Teva Pharmaceuticals USA, Inc. ("Teva") filed a Petition, seeking an *inter partes* review of claims 1–20 of U.S. Patent No. 8,642,556 B2 ("the '556 patent," Ex. 1001). Paper 4 ("Pet"). Along with the Petition, Teva filed a Motion for Joinder to join this proceeding with *Mylan Pharmaceuticals Inc. v. Allergan, Inc.*, IPR2016-01129. Paper 3 ("Mot"). Teva filed the Petition and Motion for Joinder in the present proceeding on January 6, 2017, within one month after we instituted trial in IPR2016-01131. 37 C.F.R. § 42.122(b). Patent Owner Allergan, Inc. ("Allergan") filed an opposition to Teva's Motion for Joinder. Paper 8. Via e-mail correspondence to the Board on March 30, 2017, Allergan indicated that it did not intend to file a Preliminary Response to Teva's Petition. Ex. 3001.

As explained further below, we institute trial on the same grounds as instituted in IPR2016-01129 and grant Teva's Motion for Joinder.

II. DISCUSSION

In IPR2016-01129, Mylan Pharmaceuticals Inc. ("Mylan") challenged claims 1–20 of the '556 patent on the following grounds:

References	**Basis**	**Claims challenged**
Ding '979[1]	§ 102	1–20
Ding '979 and Sall[2]	§ 103(a)	1–20

[1] Ding et al., US 5,474,979, issued Dec. 12, 1995 (Ex. 1006).
[2] Sall et al., *Two Multicenter, Randomized Studies of the Efficacy and Safety of Cyclosporine Ophthalmic Emulsion in Moderate to Severe Dry Eye Disease*, 107 OPHTHALMOLOGY 631–39 (2000) (Ex. 1007).

References	Basis	Claims challenged
Ding '979, Sall, and Glonek[3]	§ 103(a)	14 and 19
Ding '979, Sall, and Acheampong[4]	§ 103(a)	11, 18, and 20
Ding '979, Sall, Glonek, and Acheampong		19

After considering the Petition and the Patent Owner Preliminary Response, we instituted trial in IPR2016-01129 on all five grounds. IPR2016-01129, Paper 8, 25–26.

Teva's Petition is substantively identical to Mylan's Petition, challenging the same claims based on the same art and the same grounds. *Compare* IPR2016-01129, Paper 3 *with* IPR2017-00579, Paper 4. For the same reasons stated in our Decision on Institution in IPR2016-01129, we institute trial in this proceeding on the same three grounds. *See* IPR2016-01129, Paper 8.

Having determined that institution is appropriate, we now turn to Teva's Motion for Joinder. Based on authority delegated to us by the Director, we have discretion to join an *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that "[i]f the Director institutes an inter partes review, the

[3] Glonek et al., US 5,578,586, issued Nov. 26, 1996 (Ex. 1009).
[4] Acheampong et al., *Cyclosporine Distribution into the Conjunctiva, Cornea, Lacrimal Gland, and Systemic Blood Following Topical Dosing of Cyclosporine to Rabbit, Dog, and Human Eyes*, LACRIMAL GLAND, TEAR FILM, AND DRY EYE SYNDROMES 2: BASIC SCIENCE AND CLINICAL RELEVANCE 1001–04 (David A. Sullivan et al. eds., 1998) (Ex. 1008).

Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311." *Id.* When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. As Teva notes, the Petition in IPR2017-00579 is substantially identical to the Mylan Petition with no substantive differences. Mot. 8. Teva proposes the same claim construction positions and relies upon the same exhibits. *Id.* Although Teva also submitted the declaration of Dr. Chambliss, Teva has agreed to rely on Mylan's expert, Dr. Amiji, and withdraw the expert declaration of Dr. Chambliss. *Id.* at 9.

Teva has also agreed to assume a "back-seat, 'understudy' role" in the joined proceedings, "without any right to separate or additional briefing or discovery, unless authorized by the Board upon a request to address an issue that is unique to Teva." *Id.* at 8. Teva further contends that there will be no impact on the trial schedule of IPR2016-01129, and that joinder will promote the just, speedy, and inexpensive resolution of the proceedings without prejudice to the parties. *Id.* at 10–11.

Allergan opposes Teva's Motion for Joinder, arguing that the statute prohibits the joinder of time barred petitions to existing *inter partes* review proceedings. Paper 8, 3–5. But Allergan also "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." *Id.* at 5 n.1 (citing *Microsoft Corp. v. Proxyconn Inc.*, IPR2013-00109, slip op. at 4 (PTAB Feb. 25, 2013) (Paper 15); *Achates Reference Publ'g, Inc. v. Apple, Inc.*, 803 F.3d 652 (Fed. Cir. 2015); 37 C.F.R. § 42.122(b)). We are not persuaded by Allergan's arguments for the reasons stated in the Board's prior decisions. *See, e.g., Microsoft*, Paper 15 at 4 ("[T]he one-year time bar [under 35 U.S.C. § 315(b)] does not apply to a request for joinder.").

In view of the foregoing, we find that joinder based upon the conditions stated in Teva's Motion for Joinder will have little or no impact on the timing, cost, or presentation of the trial on the instituted grounds. Moreover, discovery and briefing will be simplified if the proceedings are joined. Thus, Teva's Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is

ORDERED that trial is instituted in IPR2017-00579 on the following grounds:

A. Claims 1–20 as anticipated by Ding '979;

B. Claims 1–20 as obvious over Ding '979 and Sall;

C. Claims 14 and 19 as obvious over Ding '979, Sall, and Glonek;

D. Claims 11, 18, and 20 as obvious over Ding '979, Sall, and Acheampong; and

E. Claim 19 as obvious over Ding '979, Sall, Glonek, and Acheampong.

FURTHER ORDERED that Teva's Motion for Joinder with IPR2016-01129 is *granted*;

FURTHER ORDERED that IPR2017-00579 is terminated and joined to IPR2016-01129, pursuant to 37 C.F.R. §§ 42.72, 42.122, based on the conditions stated in Teva's Motion for Joinder (Paper 3), as discussed above;

FURTHER ORDERED that the Scheduling Order in place for IPR2016-01129 shall govern the joined proceedings;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2016-01129;

FURTHER ORDERED that the case caption in IPR2016-01129 for all further submissions shall be changed to add Teva as a named Petitioner with Mylan, and to indicate by footnote the joinder of IPR2017-00579 to that proceeding, as indicated in the attached sample case caption;[5]

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2016-01129.

[5] We note that Petitioner Akorn Inc. has also filed a Motion for Joinder of IPR2017-00598 with IPR2016-01129. Concurrent with this decision, the Board has entered a decision granting Akorn's motion, as well. Accordingly, the sample case caption also reflects joinder of IPR2017-00598.

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Sample Case Caption

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MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS USA, INC., and AKORN INC.,
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v.

ALLERGAN, INC.,
Patent Owner.

Case IPR2016-01129[6]
Patent 8,642,556 B2

[6] Cases IPR2017-00579 and IPR2017-00598 have been joined with this proceeding.