

Filed On Behalf Of:

Novartis AG and LTS Lohmann Therapie-Systeme AG

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVEN PHARMACEUTICALS INC.,
Petitioner

v.

NOVARTIS AG AND LTS LOHMANN THERAPIE-SYSTEME AG,
Patent Owners

Inter Partes Review No. 2014-00549

U.S. Patent 6,316,023

PATENT OWNERS' LIST OF PROPOSED MOTIONS

Pursuant to the Decision Instituting Trial (Paper 10) and the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012), Patent Owners Novartis AG and LTS Lohmann Therapie-Systeme AG (collectively, “Novartis”) submit the following list of proposed motions they may file during the trial. This list is provided without prejudice to Novartis’s right to seek authorization to file additional motions or to decide not to file the motions listed.

1. Motion for Charlotte C. Jacobsen to appear *pro hac vice*.
2. Motion to modify Due Date 1 as set forth in the October 14, 2014 Scheduling Order (Paper 11), if necessary in view of the parties’ mutual agreement to modify Due Dates 1-3, discussed below, and any motion deemed necessary to timely obtain cross-examination testimony of Petitioner’s experts or exclude the testimony of Petitioner’s experts if they are not reasonably made available for deposition in the United States.
3. Motion for discovery regarding attempts by Noven Pharmaceuticals Inc. and Hisamitsu Pharmaceutical Co., Inc. to design around the invention of U.S. Patent 6,316,023 (the “’023 Patent”). This discovery would be in the nature of requests for admissions, request for production of documents and any other appropriate means of discovery.

4. Novartis may seek authorization at a later date to file one or more motions requesting discovery related to factual issues that may be raised by Petitioner during this *inter partes* review proceeding.
5. Novartis may seek authorization at a later date to file a Motion to Seal, containing a proposed protective order, in the event that Novartis determines that it intends to rely upon confidential information during this *inter partes* review proceeding. Any such motion may be accompanied by, as described at 77 Fed. Reg. 48631, (a) a request to return the confidential material should the motion to seal be denied as well as (b) a redacted version of the material accompanied with a contingent motion to rely on the material as redacted should the motion to seal be denied.

Additionally, Novartis reserves its right to file motions that are automatically authorized by the Board, including a motion to exclude evidence and a motion for observation on cross-examination.

At the initial scheduling conference, Novartis also wishes to discuss the following issue.

1. The parties have mutually agreed on a no earlier than January 2, 2015 start date for the depositions of Petitioner's declarants, and to the following modifications of Due Dates 1-3, as set forth in the October 14, 2014

Scheduling Order:

- a. DUE DATE 1: Change from December 23, 2014 to January 20, 2015.
- b. DUE DATE 2: Change from March 3, 2015 to March 31, 2015.
- c. DUE DATE 3: Eliminate Due Date 3. Novartis does not intend to request to file a motion to amend the challenged claims of the '023 Patent in this proceeding.

Respectfully submitted,

Dated: October 28, 2014

/Raymond R. Mandra/
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CERTIFICATE OF SERVICE

I certify that a copy of the Patent Owner's List of Proposed Motions was served on October 28, 2014 by causing it to be sent by email to counsel for Petitioner at the following email addresses:

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Dated: October 28, 2014

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