

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.: IPR2014-00549

U.S. Patent No. 6,316,023

PETITIONER'S MOTION TO CORRECT PETITION AND EXHIBITS

Petitioner Noven Pharmaceuticals, Inc. respectfully moves the Board to correct certain clerical and typographic errors in its petition for *inter partes* review (Paper 1), Exhibits 1010, 1011, 1018, 1020, and 1021 as set forth below.

On October 28, 2014, Patent Owners Novartis AG and LTS Lohmann Therapie-Systeme AG (“Patent Owners”) served objections pursuant to 37 C.F.R. § 42.64(b)(1) to all of Petitioner’s exhibits except the challenged patent and its file wrapper. Patent Owners’ objections included (i) general evidentiary objections and (ii) specific objections due to the clerical and typographical errors addressed herein. During the initial conference call with the Board, held on October 30, 2014, Petitioner sought guidance from the Board regarding responding to the objections. The Board counseled that Petitioner may respond to Patent Owners’ objections by serving supplemental evidence and if the parties agree that the supplemental evidence cures the alleged defect in the evidence, the parties were directed to seek authorization to file a motion to correct the relevant exhibit(s) or paper(s). Paper 14 at 4. On November 12, 2014, Pursuant to 37 C.F.R. § 42.64(b)(2), Petitioner provided a list of corrections to address Patent Owners’ specific objections and reserved the right to respond to Patent Owners’ general objections should they file a motion to exclude under C.F.R. § 42.64(c). Patent owners agreed that the proposed amendments corrected the clerical and typographical errors in a communication dated November 19, 2014, and stated that

they will not oppose a motion to correct the clerical and typographical errors in an email dated December 9, 2014. Petitioner sought permission to file this unopposed motion, which was granted in an email from the Board on December 10. Petitioner has provided this motion and the corrected petition and exhibits to Patent Owners, and Patent Owners have stated that they do not oppose this motion. Patent Owners, however, maintain all objections that are not specifically addressed below in this motion.

By this motion, Petitioner seeks to correct the following clerical and typographical errors:

Petition for *Inter Partes* Review of U.S. Patent 6,316,023 (Paper 1)

To address, in part, Patent Owners’ objections, Petitioner requests permission to correct its Petition for Inter Partes Review of U.S. Patent 6, 316,023 with the following corrections to the List of Exhibits (Paper 1 at v-vi):

(1) The list of exhibits on page v incorrectly refers to Ex. 1017 as “Ho-Leung Fung, Chapter 7 – Chemical Kinetics and Drug Stability in MODERN PHARMACEUTICS (G.S. Banker and C.T. Rhodes, eds.), Marcel Dekker, NY (1978), pp. 227-62.” The correct citation is “Ho-Leung Fung, Chapter 7 – Chemical Kinetics and Drug Stability in MODERN PHARMACEUTICS (G.S. Banker and C.T. Rhodes, eds.), Marcel Dekker, NY (1979), pp. 227-62.”

(2) The list of exhibits on page v incorrectly refers to Ex. 1018 as “Carey & Sundberg, ADVANCED ORGANIC CHEMISTRY, 2nd ed. Part A: Structure and Mechanism, Plenum Press, New York, 1984, pp. 652.” The correct citation is “Carey & Sundberg, ADVANCED ORGANIC CHEMISTRY, Part A: Structure and Mechanism, 3rd Edition (Plenum Press, NY), pp. 651-727 (1990).”

(3) The list of exhibits on page vi incorrectly refers to Ex. 1022 as “Linnell, R.H., The Oxidation of Nicotine. I. Kinetics of the Liquid Phase Reaction Near Room Temperature. Tobacco Science, Vol. 4, pp. 89–90 (1960).” The correct citation is “Linnell, R.H., The Oxidation of Nicotine. I. Kinetics of the Liquid Phase Reaction Near Room Temperature. Tobacco Science, Vol. 4, pp. 89–91 (1960).”

Exhibit 1010

To correct the following clerical error in paragraph 26 of Exhibit 1010 (Declaration of Agis Kydonieus, Ph.D), Petitioner provides Corrected Exhibit 1010, which now includes a Supplemental Declaration of Agis Kydonieus, Ph.D. dated November 11, 2014, appended to the original Exhibit 1010, identifying the following correction:

Page 15, paragraph 26: change “(Ex. 1012 at 1; Ex. 1014 at 3.)” to “(Ex. 1012 at 1; Ex. 1013 at 3.)”

See Corrected Ex. 1010 at 43-44.

Exhibit 1011

To correct the following typographical and clerical errors in paragraphs 9, 14, 31, and 48 of Exhibit 1011 (Declaration of Christian Schöneich, Ph.D.), Petitioner provides Corrected Exhibit 1011, which now includes a Supplemental Declaration of Christian Schöneich, Ph.D. dated November 11, 2014, appended to the original Exhibit 1011, identifying the following corrections:

(1) On pages 4 (paragraph 9) and 13-14 (paragraph 31), Ex. 1018 is incorrectly referred to as “Carey & Sundberg, ADVANCED ORGANIC CHEMISTRY, 2nd ed. Part A: Structure and Mechanism, Plenum Press, New York, 1984, pp. 652.” The correct language is “Carey & Sundberg, Advanced Organic Chemistry, Part A: Structure and Mechanism, 3rd Edition (Plenum Press, NY), pp. 651-727 (1990).”

(2) On pages 4-5 (paragraph 9) and 19 (paragraph 48), Ex. 1022 is incorrectly referred to as “Linnell, R.H., The Oxidation of Nicotine. I. Kinetics of the Liquid Phase Reaction Near Room Temperature. Tobacco Science, Vol. 4, pp. 89–90 (1960).” The correct language is “Linnell, R.H., The Oxidation of Nicotine. I. Kinetics of the Liquid Phase Reaction Near Room Temperature. Tobacco Science, Vol. 4, pp. 89–91 (1960).”

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