

Filed On Behalf Of: Novartis AG

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**PAR PHARMACEUTICAL, INC.,  
BRECKENRIDGE PHARMACEUTICAL, INC. AND  
ROXANE LABORATORIES, INC.,**  
Petitioners,

v.

**NOVARTIS AG,**  
Patent Owner

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Case IPR2016-00084<sup>1</sup>  
U.S. Patent 5,665,772

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**PATENT OWNER'S  
MOTION TO EXCLUDE EVIDENCE**

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<sup>1</sup> The Board on October 27, 2016 joined Breckenridge's IPR2016-01023 and Roxane's IPR2016-01103 with Par's IPR2016-00084 challenging claims 1-3 and 8-10 of the '772 patent. Because the three Petitioners' arguments and evidence are substantively identical, this motion cites only papers from IPR2016-00084.

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## I. INTRODUCTION

Patent Owner Novartis moves to exclude the following evidence:

1. Petitioners' arguments and the opinions of Petitioners' expert Dr.

William Jorgensen that rely upon the specification of '772 patent itself as evidence of the prior art, *i.e.*, Exhibit 1003 (the October 26, 2015 Jorgensen declaration), ¶¶ 21, 54 and 75; and Exhibit 1118 (the December 5, 2016 Jorgensen reply declaration), ¶¶ 8, 9, 25 and 26. Any argument or expert opinion in that regard should be excluded as irrelevant under F.R.E. 402. IPR2016-00084, Paper 11 at 2; Paper 50 at 16.

2. Exhibit 1008 (Lemke Chapter 16). That exhibit is one chapter of a 142-page book and thus is incomplete. IPR2016-00084, Paper 11 at 6. If the Board considers Exhibit 1008, F.R.E. 106 requires that the Board in fairness also consider other relevant chapters from that book, *i.e.*, Exhibit 2045 and Exhibit 2104.

3. Exhibits 1034 (Fiebig) and 1117 (Schwartz). Those exhibits address elements of Petitioners' *prima facie* case and should have been served with the October 25, 2015 petition. Because they were not served until December 5, 2016 with Petitioners' reply, they are untimely. IPR2016-00084, Paper 50 at 3.

4. Exhibit 1118, ¶¶ 8-11, 13-17, 20, 23, 25-26, 32-33, 53, 82, 86-87, 89-99, 101-102, 104-105, 107-108 and 110, and Exhibit 1119 (the December 5, 2016 reply declaration of Petitioners' expert Dr. Mark J. Ratain), ¶¶ 32-36, 43, 57 and

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