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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRECKENRIDGE PHARMACEUTICAL, INC.
Petitioner

v.

NOVARTIS AG
Patent Owner

Case No. To Be Assigned
Patent No. 5,665,772

MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Breckenridge Pharmaceutical, Inc. (“Breckenridge” or the “Petitioner”) respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the above-captioned *inter partes* review (hereinafter “Breckenridge IPR”) with the pending *inter partes* review concerning the same patent and the same two grounds of invalidity in *Par Pharmaceutical, Inc. v. Novartis AG*, Case No. IPR2016-00084 (“Par IPR”), which was instituted on April 29, 2016. Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent and will not prejudice any of the parties to the Par IPR.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of April 29, 2016, the date of institution of the Par IPR.

II. STATEMENT OF MATERIAL FACTS

1. Petitioner is not aware of any reexamination certificates or pending prosecution concerning U.S. Patent No. 5,665,772 (“the ‘772 patent”), which is the subject of both the Par IPR and the Breckenridge IPR.

2. On August 13, 2014, Novartis Pharmaceuticals Corporation and Novartis AG (“Novartis”) filed a complaint accusing Breckenridge of infringing the ‘772 patent. On August 27, 2014, the waiver of service of summons was

filed. *Novartis Pharmaceuticals Corporation and Novartis AG. v.*

Breckenridge Pharmaceutical, Inc., C.A. No. 1:14-CV-01043-RJA (D. Del.).

3. *Par Pharmaceutical, Inc.* (“Par”) filed its petition for *inter partes* review of the ’772 patent on October 26, 2015. (Par IPR, IPR2016-00084).

4. The Par IPR included the following four grounds for challenging the validity of the ’772 patent:

Ground 1: Claims 1-3 and 10 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious in View of Morris, Van Duyne, Rossmann, Lemke, and Yalkowsky;

Ground 2: Claims 8 and 9 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious in View of Morris, Van Duyne, Rossmann, Lemke, Yalkowsky, and in further view of Hughes;

Ground 3: Claims 1-3 and 10 of the ’772 Patent Would Have Been Obvious Over Routine Use of Computer-Aided Drug Design Software In View of Morris, Van Duyne, Lemke, and Yalkowsky; and,

Ground 4: Claims 8 and 9 are Invalid under 35 U.S.C. § 103 on the Ground That They Are Rendered Obvious Over Routine Use of Computer-Aided Drug Design Software In View of Morris, Van Duyne, Lemke, and Yalkowsky, and in further view of Hughes.

(Par IPR, IPR2016-00084, Petition at p. 38-54).

5. The Board instituted the Par IPR on April 29, 2016 on Grounds 1 and 2. (Par IPR, IPR2016-00084, Paper 8 at 5-6, 17).

6. The Petition filed in the Breckenridge IPR presents only the identical grounds on which the Par IPR was instituted. Those being Grounds 1 and 2 of the Par IPR.

7. To date, Par and Breckenridge represent two of the three defendants involved in pending litigation regarding the ‘772 patent in the District of Delaware. Roxane Laboratories, Inc. is the third defendant involved in pending litigation regarding the ‘772 patent also in the District of Delaware.¹

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review proceedings. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

(c) JOINDER.--If the Director institutes an inter partes review, the 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 that the Director, after receiving a preliminary response under

¹ For a list of related litigations involving the ‘772 patent, see Breckenridge’s Petition for Inter Partes review, page 7, submitted concurrently herewith.

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