

Filed On Behalf Of:

Novartis AG

By:

Nicholas N. Kallas
NKallas@fchs.com
ZortressAfinitorIPR@fchs.com
(212) 218-2100

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRECKENRIDGE PHARMACEUTICAL, INC.,
Petitioner

v.

NOVARTIS AG,
Patent Owner

Inter Partes Review No. 2016-01023

U.S. Patent 5,665,772

**PATENT OWNER NOVARTIS'S OPPOSITION TO
PETITIONER BRECKENRIDGE'S MOTION FOR JOINDER**

TABLE OF CONTENTS

I.	STATEMENT OF PRECISE RELIEF REQUESTED	1
II.	RESPONSE TO BRECKENRIDGE’S STATEMENT OF MATERIAL FACTS	2
III.	STATEMENT OF REASONS FOR DENYING BRECKENRIDGE’S REQUESTED RELIEF AND GRANTING NOVARTIS’S REQUESTED RELIEF	3
1.	Joinder Prejudices Novartis, Par And The Board	3
2.	Denying Joinder Will Not Prejudice Breckenridge	5
3.	The Board Should Deny Joinder In View Of The Prejudice To Novartis, Par And The Board	6
4.	Breckenridge’s Participation In A Joint Proceeding Should Be Limited To Mitigate Any Prejudice To Novartis, Par And The Board.....	8
IV.	CONCLUSION	9

TABLE OF AUTHORITIES

Cases

<i>Dell Inc v. Elecs. and Telecomms. Research Inst.</i> , IPR2015-00549, Paper 10 (Mar. 26, 2015).....	7
<i>Dell Inc. v. Network-1 Security Solutions, Inc.</i> , IPR2013-00385, Paper No. 17 (Jul. 29, 2013).....	8
<i>Lupin Ltd. v. Senju Pharm. Co., Ltd.</i> , IPR2015-01871, Paper 13 (Jan. 25, 2016).....	8
<i>Microsoft Corp. v. Proxyconn, Inc.</i> , IPR2012-00026 and IPR2013-00109, Paper 80 (Dec. 9, 2015).....	6
<i>Samsung Elecs. Co., Ltd. v. Arendi S.A.R.L.</i> , IPR2014-01142, Paper 11 (Oct. 2, 2014).....	7
<i>Teva Pharms. USA, Inc. v. Viiv Healthcare Co.</i> , IPR2015-00550, Paper 11 (Jun. 25, 2015).....	9
<i>ZTE Corp. v. Adaptix Inc.</i> , IPR2015-01184, Paper 10 (Jul. 24, 2015).....	7

Statutes

35 U.S.C. § 315(b).....	1, 4, 6
35 U.S.C. § 316(a)(11).....	6

I. STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Novartis AG (“Novartis”) conditionally opposes the May 10, 2016 joinder motion by Petitioner Breckenridge Pharmaceutical, Inc. (“Breckenridge”). (IPR2016-01023, Paper 5.) In that motion, Breckenridge seeks to join its newly filed petition for IPR2016-01023 with Par Pharmaceutical, Inc.’s (“Par”) pending IPR proceeding IPR2016-00084.

Breckenridge’s late-filed petition and joinder motion prejudices Novartis because the petition relies on a new expert declaration and a new argument, and risks prejudicing Novartis, Par and the Board by opening the door to the possibility that Breckenridge will raise further new exhibits or arguments in reply to Novartis’s patent owner response if Breckenridge’s petition is instituted and its joinder motion is granted. For these reasons, Breckenridge’s joinder motion should be denied.

Novartis nevertheless will not oppose joinder, provided that the Breckenridge agrees, or the Board orders, that (i) the joint proceeding be based exclusively on the petition and evidence filed by Par in IPR2016-00084, (ii) Breckenridge share with Par the pages currently allotted to Par in IPR2016-00084 for any written work product; and (iii) Breckenridge share

with Par the time currently allotted to Par in IPR2016-00084 for the cross and re-direct examination of any witness.

II. RESPONSE TO BRECKENRIDGE'S STATEMENT OF MATERIAL FACTS

Novartis does not dispute Statements 1-5 and 7 set forth in Breckenridge's Statement Of Material Facts. (IPR2016-01023, Paper 5 at § II.)

Novartis disputes Statement 6 insofar as the exhibits and arguments of Breckenridge are not identical to those of Par. First, whereas Par's petition in IPR2016-00084 relies on the expert declaration of Dr. William L. Jorgensen, Breckenridge's petition relies on the expert declaration of a new expert, Dr. Steven W. Baldwin, who is not an expert in Par's IPR2016-00084. Even if Breckenridge withdraws Dr. Baldwin's expert declaration—which Breckenridge said it would do, but to date has not done—Novartis still must respond to Breckenridge's petition, which relies solely on Dr. Baldwin's declaration, and does not cite any part of Dr. Jorgensen's declaration. Second, Breckenridge alleges that the Morris 1992 reference (Ex. 1005), which Par characterizes only as pre-AIA § 102(a) art, also qualifies as pre-AIA § 102(b) art. (*Compare* IPR2016-01023, Paper 4 at 24 *and* IPR2016-00084, Paper 2 at 26.)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.