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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. IPR2016-01023
Patent No. 5,665,772

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

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I. Introduction

In its opposition, Novartis raises two primary arguments. First, Novartis alleges that Breckenridge's petition and motion for joinder were "late-filed." Second, Novartis alleges that granting Breckenridge's motion for joinder will prejudice Novartis based on its inclusion of Dr. Baldwin's declaration and identifying prior art under 35 U.S.C. § 102(b); as well as a contrived theory that Breckenridge will raise further new exhibits or arguments in reply to Patent Owner's response. These arguments do not withstand scrutiny.

Novartis implicitly acknowledges the weakness in its arguments by conceding that it will not oppose joinder if Breckenridge agrees to procedures similar to those already proposed in Breckenridge's motion for joinder. Paper 5 at 5-6. For example, Breckenridge proposed that the Board may adopt procedures analogous to those in *Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385 (Paper 17 at 8-9) and *Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256 (Paper 10 at 8-10). Breckenridge also stated that it seeks to join the Par IPR in an understudy role without any active participation separate from Par unless authorized by the Board and pertaining to an issue unique to Breckenridge.

II. Breckenridge's Motion for Joinder Is Not Time-Barred

Novartis refers to Breckenridge's petition as "late-filed." Paper 12 at 1, 4, 6. This is disingenuous. Breckenridge's petition and accompanying motion for

joinder to IPR2016-00084 were timely filed and are ripe for joinder.

37 C.F.R. § 42.122(b) provides that joinder may be requested no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See also* 35 U.S.C. § 315(b) and (c). *Inter partes* review in IPR2016-00084 was instituted on April 29, 2016. IPR2016-00084, Paper 8. Breckenridge filed its petition and motion to join on May 10, 2016 within one month of the institution date in accordance with 37 C.F.R. § 42.122(b). IPR2016-01023, Papers 4-6. On this basis, Breckenridge's petition and motion are timely.

III. Joinder Does Not Prejudice Novartis, Par, or the Board

Novartis alleges prejudice because of Breckenridge's reliance on the declaration of Dr. Baldwin. Paper 12 at 4-5. Novartis's argument, however, disregards Breckenridge's motion for joinder and its representations to the Board regarding Dr. Baldwin's declaration.¹

Breckenridge repeatedly stated it will adopt Dr. Jorgensen's declaration should Par agree. In its motion for joinder, Breckenridge stated "Breckenridge will rely on the same expert as Par, should Par permit it." Paper 5 at 6. Breckenridge's

¹ Novartis alleges that Breckenridge's petition does not cite to Dr. Jorgensen's declaration (Ex. 1003). However, Breckenridge's petition cites Dr. Baldwin's declaration (Ex. 1030), which repeatedly refers to Dr. Jorgensen's declaration. *See* Ex. 1030, ¶¶ 17, 40, 44, 49, 50, 69, 118, 133, 177.

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