

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,<sup>1</sup>

v.

NOVARTIS AG,  
Patent Owner.

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Cases IPR2016-01059, IPR2016-01102, and IPR2016-01103  
Patent 5,665,772

Before LORA M. GREEN, CHRISTOPHER L. CRUMBLEY, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION  
Dismissing Requests for Rehearing  
*37 C.F.R. § 42.71(d)*

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<sup>1</sup> Par Pharmaceutical is Petitioner in IPR2016-01059, Breckenridge Pharmaceutical is Petitioner in IPR2016-01103, and Roxane Laboratories is Petitioner in IPR2016-01102. This consolidated caption is for the purposes of this joint Decision and is not to be used by the parties.

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Par Pharmaceutical, Breckenridge Pharmaceutical, and Roxane Laboratories (collectively, “Petitioners”) request reconsideration of our Decision denying or denying-in-part their Motions for Joinder with IPR2016-00084. IPR2016-01059, Paper 20; IPR2016-01102, Paper 19; IPR2016-01103, Paper 19. Patent Owner Novartis filed a consolidated Response to these requests. *See, e.g.*, IPR2016-01059, Paper 21.<sup>1</sup>

A party dissatisfied with a decision of the Board may file a request for rehearing. 37 C.F.R. § 42.71(d). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

The rehearing requests each pertain to our denial of joinder as to claim 7 of the ’772 patent, which depends from claim 1 that is at issue in the instituted *inter partes* review IPR2016-00084. In our Decision denying joinder of claim 7, we determined that the joinder Petitions had established a reasonable likelihood of prevailing as to claim 7, based on Petitioners’ unpatentability arguments as to claim 1 made in IPR2016-00084. IPR2016-01059, Paper 19, 10–12. Nevertheless, we declined to exercise our discretion to grant joinder. *Id.* at 15–18. It is of this latter determination that Petitioners request rehearing.

In light of our determination in today’s Final Written Decision in IPR2016-00084 that Petitioners have not proven the unpatentability of claim

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<sup>1</sup> Unless otherwise indicated, when essentially identical documents have been filed in each of the cases, for simplicity we will cite only to the docket of IPR2016-01059.

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1 of the '772 patent; however, Petitioners' rehearing requests are moot. Petitioners advanced no ground of unpatentability as to claim 7 that did not rely on the unpatentability of claim 1. As claim 1 has not been proven unpatentable, there is no basis to conclude that claim 7 is separately unpatentable. Therefore, even if we were to reconsider exercising our discretion not to join claim 7 to IPR2016-00084, as Petitioners ask, the claim would remain patentable.

### ORDER

Accordingly, it is:

ORDERED that the Requests for Rehearing are *dismissed as moot*.

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