

Filed on behalf of: Par Pharmaceutical, Inc.

Entered: May 17, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.
Petitioner

v.

NOVARTIS AG
Patent Owner

Case IPR2016-01059
U.S. Patent No. 5,665,772

**PETITIONER'S MOTION FOR JOINDER
PURSUANT TO 37 C.F.R. § 42.122(B)**

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Petitioner Par Pharmaceutical, Inc. (“Par”) respectfully requests joinder of the petition for *inter partes* review of claim 7 of U.S. Patent No. 5,665,772 (“the ’772 Patent”), filed concurrently with this motion, with the instituted *inter partes* review in *Par Pharmaceutical, Inc. v. Novartis AG*, No. IPR2016-00084.

I. INTRODUCTION

In instituting the -00084 proceeding, the Board already found that Par has demonstrated a reasonable likelihood of proving claims 1, 8, and 9 obvious. Independent claim 1 recites a genus of rapamycin derivatives. Claims 8 and 9 recite methods of using those rapamycin derivatives for therapeutic effect.

Par now seeks to join dependent claim 7, which recites a composition comprising a compound of claim 1 and a pharmaceutically acceptable carrier. When the prior art describes using a class of compounds with pharmaceutical excipients—as it does here—the validity of pharmaceutical composition claims, as claimed in claim 7, “rise[s] or fall[s] with the validity of” the compound claim. *Aventis Pharma Deutschland GmbH v. Lupin, Ltd.*, 499 F.3d 1293, 1303 (Fed. Cir. 2007) (finding a dependent pharmaceutical composition claim obvious because the independent compound claim was obvious and the prior art taught using ACE inhibitors with pharmaceutical excipients). The prior art explicitly taught using therapeutic amounts of rapamycin and its derivatives with pharmaceutically acceptable carriers. Thus, dependent claim 7 is unpatentable over the exact same

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