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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner

v.

NOVARTIS AG,
Patent Owner

Inter Partes Review No. 2016-01059

U.S. Patent 5,665,772

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

TABLE OF CONTENTS

I.	STATEMENT OF PRECISE RELIEF REQUESTED	1
II.	RESPONSE TO PAR’S STATEMENT OF MATERIAL FACTS.....	3
III.	STATEMENT OF REASONS FOR DENYING PAR’S REQUESTED RELIEF AND FOR GRANTING NOVARTIS’S REQUESTED RELIEF	4
1.	Par’s -1059 Petition Is Time-Barred	4
2.	Par’s Conduct In Delaying Filing Its -1059 Petition Provided A Strategic Advantage And Such Conduct Should Not Be Encouraged.....	9
3.	Par’s Contention That Institution On Claim 7 Does Not Require Consideration Of The -1059 Record Lacks Support	11
4.	Par’s Initial Proposed Schedule Is Highly Prejudicial To Novartis And Its Alternate Schedule Effectively Allows For A Separate Trial On Claim 7 In Violation Of The One Year Statutory Bar.....	13
IV.	CONCLUSION	14

TABLE OF AUTHORITIES

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<i>Ariosa Diagnostics v. Isis Innovation Ltd.</i> , IPR2013-00250, Paper 24 (Sep. 3, 2013).....	6
<i>Ariosa Diagnostics v. Isis Innovation Ltd.</i> , IPR2013-00250, Paper 3 (Apr. 19, 2013)	7
<i>Aventis Pharma Deutschland GmbH v. Lupin Ltd.</i> , 499 F.3d 1293 (Fed. Cir. 2007)	12
<i>Dell Inc. v. Network-1 Sec. Sols., Inc.</i> , IPR2013-00385, Paper 17 (Jul. 29, 2013)	8
<i>Enzymotec Ltd. v. Neptune Techs. & Biores., Inc.</i> , IPR2014-00556, Paper 19 (Jul. 9, 2014)	8
<i>Geneva Pharm., Inc. v. Glaxosmithkline PLC</i> , 189 F. Supp. 2d 377 (E. D. Va. 2002).....	4, 12
<i>Geneva Pharm., Inc. v. Glaxosmithkline PLC</i> , 349 F.3d 1373 (Fed. Cir. 2003)	4
<i>Kyocera Corp. v. Softview LLC</i> , IPR2013-00004, Paper 15 (Apr. 24, 2013)	8
<i>Medtronic, Inc. v. Norred</i> , IPR2014-823, Paper 12 (Dec. 8, 2014)	6
<i>Micro Motion, Inc. v. Invensys Sys., Inc.</i> , IPR2014-1409, Paper 14 (Feb. 18, 2015).....	5
<i>Reloaded Games, Inc. v. Parallel Networks LLC</i> , IPR2014-950, Paper 12 (Oct. 22, 2014).....	5
<i>Samsung Elecs. Co. v. Va. Innovation Scis., Inc.</i> , IPR2014-00557, Paper 10 (Jun. 13, 2014)	7

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<i>Skyhawk Techs., LLC v. L&H Concepts, LLC</i> , IPR2014-1485, Paper 13 (Mar. 20, 2015)	6
<i>Target Corp. v. Destination Maternity Corp.</i> , IPR2014-00508, Paper 28 (Feb. 12, 2015).....	6
<i>Target Corp. v. Destination Maternity Corp.</i> , IPR2014-00508, Paper 31 (Feb. 12, 2015).....	7
<i>Zhongshan Broad Ocean Motor Co. v. Nidec Motor Corp.</i> , IPR2015-00762, Paper 16 (Oct. 5, 2015).....	8

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35 U.S.C. § 315(b)	1, 5, 9
35 U.S.C. § 315(c)	1, 5, 9
35 U.S.C. § 316(b)	11
37 C.F.R. § 42.1(b)	11

I. STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Novartis AG (“Novartis”) opposes the May 17, 2016 joinder motion by Petitioner Par Pharmaceutical, Inc. (“Par”). In that motion, Par seeks to join its newly filed petition for IPR2016-01059, which challenges claim 7 of U.S. patent No. 5,665,772 (“’772 patent”), with its recently instituted proceeding IPR2016-00084 (“-84 IPR”), which challenges claims 1-3 and 8-10 of the ’772 patent.

Par’s joinder motion should be denied for four reasons.

First, Par’s May 17, 2016 petition for IPR2016-01059 (“-1059 petition”) is time-barred. On October 27, 2014, Novartis served on Par a complaint alleging that Par infringed the ’772 patent. The one-year period under 35 U.S.C. § 315(b) for Par to file a petition challenging any claim of the ’772 patent thus expired on October 27, 2015. And 35 U.S.C. § 315(c) does not permit Par, under these circumstances, to circumvent that one-year § 315(b) deadline through joinder.

Second, Par’s joinder motion provides no explanation for its delay in filing the -1059 petition. Even accepting as true Par’s counsel’s representation that “I wasn’t on the team at the time, but it was an inadvertent omission” (Ex. 1031 at 19), that delay permitted Par to conceal the fact that its obviousness ground for claim 7 conflicts with its obviousness grounds for claims 1-3 and 8-10. By delaying the -1059 petition, Par unfairly denied Novartis and the Board an

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