

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner,

v.

NOVARTIS AG,
Patent Owner.

Cases IPR2016-00084 and IPR2016-01059
Patent 5,665,772

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

CRUMBLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Counsel for Petitioner, Par Pharmaceutical, Inc., and Patent Owner,
Novartis AG, contacted the Board to advise us that, as instructed in our

IPR2016-00084 and IPR2016-01059
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Order of June 2, 2016 (Paper 13¹), the parties had met and conferred regarding various scheduling issues in these related *inter partes* review proceedings. Despite their efforts, however, the parties had been unable to reach agreement on a schedule acceptable to both parties. The panel convened a call on June 17, 2016, attended by Judges Green, Crumbley, and Pollock, as well as counsel for Par and Novartis. Counsel for Breckenridge Pharmaceutical, Inc. (the Petitioner in IPR2016-01023 and IPR2016-01103) and Roxane Laboratories, Inc. (the Petitioner in IPR2016-01102) also attended the call, as both parties have filed Motions seeking joinder of their respective proceedings with IPR2016-00084.

A court reporter was present on the call, and Par has filed a copy of the transcript with the Board. Ex. 1032, “Tr.” The details of the parties’ positions are reflected in the transcript and need not be repeated in full detail herein.

As was discussed during the call, Par agreed to extend Due Date 1 in IPR2016-00084 at Novartis’ request, both to accommodate the trial schedule in the copending District Court action and to permit the Board to rule on the joinder motions in the related cases before Novartis files its Patent Owner Response. The parties agreed to re-set Due Date 1 to September 16, 2016, subject to the Board’s final approval of the schedules of the related cases. Tr. 11–12.

The parties were unable, however, to reach agreement on significantly shortening the deadline for Novartis’ preliminary response in IPR2016-

¹ For brevity, citations herein are to the record in IPR2016-00084. Similar papers may be found in the record of IPR2016-01059.

01059, currently set for August 15, 2016. Par requested that the preliminary response date for its case, as well as those for the Breckenridge and Roxanne cases, be set to July 1, 2016, though counsel later suggested that July 29, 2016 would be acceptable. Tr. 11. Novartis proposed August 12, 2016, for all four cases. Tr. 16. While Par did not express strong disagreement with Novartis' date, counsel did note that it risked delaying the Board's final written decision in IPR2016-00084. Tr. 23.

Upon review of the current schedules of the five related cases and the parties' proposed modifications, and taking into account our mandate to provide a just, speedy, and inexpensive resolution of these proceedings, we will re-set the due date for Novartis' preliminary responses to July 29, 2016. Delaying the preliminary responses further would make synchronizing the schedules of any joined proceedings, without significantly delaying the final written decision in IPR2016-00084, difficult. Furthermore, the subject matter of the later cases substantially overlaps with—and, in many respects, is identical to—that of the instituted IPR2016-00084 case, which should speed the preparation of Novartis' preliminary responses.²

The remaining schedule modifications proposed by the parties are contingent on a number of factors, including which (if any) of the later-filed proceedings are instituted and joined, and the date on which institution takes

² We note that Novartis has expressed interest in filing testimonial evidence with its preliminary responses, an option that was not available under the version of our Rules in effect when the IPR2016-00084 preliminary response was due. We do not expect that shortening the response period by two weeks will significantly hinder Novartis' ability to present testimonial evidence, given the overlapping subject matter of the cases.

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place. The Board will take these proposals under advisement, and may further modify the schedules of these proceedings at a later date.

In light of the foregoing, it is

ORDERED that the Scheduling Order in IPR2016-00084 (Paper 9) is hereby modified as follows:

DUE DATE 1September 16, 2016

DUE DATE 2December 5, 2016

DUE DATE 3 N/A

and

FURTHER ORDERED that in IPR2016-01059, Novartis shall file its preliminary response, if any, on or before July 29, 2016.

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