

Filed on behalf of: Par Pharmaceutical, Inc.

Entered: June 30, 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

Before PATRICK E. BAKER, *Trial Paralegal*

**PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR
JOINDER PURSUANT TO 37 C.F.R. § 42.122(B)**

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The facts of this case justify joinder. As is evident from the calls with the Board, Petitioner Par has agreed (and will agree) to any reasonable request to accommodate joinder and regrets its inadvertent omission of claim 7. For its part, Patent Owner Novartis steadfastly opposes joining claim 7, going so far as to accuse Par of making a strategic decision to omit claim 7—which is asserted in the district court litigation—in order to somehow abuse the IPR procedure to its advantage. In fact, it is Novartis that seeks to leverage the situation to its strategic advantage and avoid consideration of its patentably-indistinct composition claim in the same proceedings as its compound and method of treatment claims.

I. PAR DOES NOT SEEK A SECOND BITE OF THE APPLE

Novartis first argues that joinder should be denied because Par is seeking a “second bite of the apple.” (Opp. 4-9.) Not so. This is not a situation where Par has added *substantive* arguments to try and remedy *substantive* shortcomings in the -00084 petition. Rather, Par seeks to join the inadvertently omitted claim 7.

Contrary to Novartis’s allegations, Par is not attempting to cure a “deficiency on the merits” because Par is not a “seek[ing] to introduce *additional* grounds based on *additional* prior art through a second petition.” *Zhongshan Broad Ocean Motor Co. v. Nidec Motor Corp.*, No. IPR2015-00762, Paper 16 at 8 (P.T.A.B. Oct. 5, 2015) (emphases added). Par relies on the *same* grounds and the *same* prior art that are already instituted for claims 8 and 9. Par does not seek to

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cure a “deficiency” but rather to include “similar sets of claimed subject matter and prior art” so that the Board can arrive at a consistent result for the ’772 patent and resolve the entire dispute between the parties. *Samsung Elecs. Co. v. Va. Innovation Scis.*, No. IPR2014-00557, Paper 10 at 18 (P.T.A.B. June 13, 2014).

None of Novartis’s cited cases presents facts as found here. (Opp. 7-8, 11-12.) In *Micro Motion* and *Reloaded Games*, the petitioners sought to add new grounds and/or references to challenge claims the Board previously declined to institute, using the institution decision as a guide to remedy deficiencies in the earlier filed petition. *Micro Motion, Inc. v. Invensys Sys., Inc.*, No. IPR2014-01409, Paper 14 at 14 (P.T.A.B. Feb. 18, 2015); *Reloaded Games, Inc. v. Parallel Networks LLC*, No. IPR2014-00950, Paper 12 at 4-5 (P.T.A.B. Oct. 22, 2014). In *Samsung Elecs. Co. v. Affinity Labs of Tx., Ltd.*, challenges to the claims in the new petition were already under review in multiple proceedings, and the Board found that the additional burden, costs, and use of judicial resources was not justified. No. IPR2015-00820, Paper 12 at 2, 5 (P.T.A.B. May 15, 2015). And in *Medtronic, Inc. v. Norred*, the Board denied joinder because the petitioner sought review of the decision denying institution through joinder rather than rehearing. No. IPR2014-00823, Paper 12 at 5 (P.T.A.B. Dec. 8, 2014). Here, Par does not present any arguments for claim 7 that were previously rejected by the Board.

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