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Filed On Behalf Of: Novartis AG

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'S RESPONSE TO PETITIONERS' REQUESTS FOR RECONSIDERATION OF THE BOARD'S DECISION DENYING JOINDER OF CLAIM 7

TABLE OF AUTHORITIES

Cases

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This brief responds to the November 10, 2016 papers of Petitioners Par, Breckenridge and Roxane (IPR2016-01059, Paper 20; IPR2016-01103, Paper 19; IPR2016-01102, paper served but not filed ("Rox. Br.")) requesting rehearing of the Board's October 27, 2016 decisions denying joinder of Petitioners' challenges to claim 7 of U.S. Patent No. 5,665,772 (IPR2016-01059, Paper 18; IPR2016-01103, Paper 17; IPR2016-01102, Paper 16).[1] For the following reasons, rehearing should be denied.

First, Petitioners' rehearing papers violate 37 C.F.R. § 42.71(d). Under that rule, a rehearing 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." Petitioners' papers do not identify where the allegedly misapprehended or overlooked matters were previously addressed in any motion, opposition or reply.

Second, Petitioners' rehearing papers raise impermissible new arguments. Par newly argues that a petitioner seeking joinder need not explain why the

[1] The Board authorized this brief in a December 2, 2016 email. For the Board's convenience, Novartis herein responds collectively to all three of Petitioners' November 10, 2016 papers. Also, because the Board's October 27, 2016 decisions are identical, Novartis herein cites only one of them: IPR2016-01059, Paper 18.

materials sought to be joined were omitted from the original petition (IPR2016-01059, Paper 20 at 3-6); that certain joinder decisions allegedly contradict other decisions disfavoring "second bites at the apple" (*id.* at 7-8, 13-14); and that scheduling obstacles are not a reason for denying joinder (*id.* at 8-12). Breckenridge and Roxane newly argue that they should not be prejudiced by Par's delay in challenging claim 7. IPR2016-01103, Paper 19 at 5-6; Rox. Br. at 2-3. Roxane newly argues that its challenge to claim 7 is not a "second bite at the apple." Rox. Br. at 3-4. And all three Petitioners newly argue that that they could not have challenged claim 7 earlier than they did.[2] IPR2016-01059, Paper 20 at 9; IPR2016-01103, Paper 19 at 5; Rox. Br. at 5.

Those arguments could well have been raised in Petitioners' joinder motions or replies. Because they were not, the Board could not have misapprehended or overlooked them. *E.g.*, *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2015-01873, Paper 14 at 5 (P.T.A.B. Jun. 27, 2016) ("Petitioner does not identify where

[2] No authority barred Petitioners from challenging claim 7 before institution of Par's IPR. *Linear Tech. v. In-Depth Test*, IPR2015-01994, Paper 7 (P.T.A.B. Oct. 20, 2015) is not such authority. There, the Board denied as premature a motion to join another party's IPR, but authorized the movant to renew its motion upon institution of the other party's IPR. *Id.* at 4-5.

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