

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROXANE LABORATORIES, INC.
Petitioner

v.

NOVARTIS AG
Patent Owner

Case No. To Be Assigned
Patent No. 5,665,772

MOTION FOR JOINDER
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Roxane Laboratories Inc. (“Roxane” or “Petitioner”) respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the *inter partes* review petition submitted concurrently herewith (hereinafter “Roxane IPR”) with the pending *inter partes* review concerning, for claims 1-3 and 8-10, the same two grounds of invalidity in *Par Pharmaceutical, Inc. v. Novartis AG*, Case No. IPR2016-00084 (“Par IPR”), which was instituted on April 29, 2016, and for claim 7, the same prior art, evidence and arguments in the grounds of invalidity in the Par IPR. Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent and will not prejudice any of the parties to the Par IPR.

This Motion for Joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of April 29, 2016, the date on which the Par IPR was instituted.

II. STATEMENT OF MATERIAL FACTS

1. Petitioner is not aware of any reexamination certificates or pending prosecution concerning U.S. Patent No. 5,665,772 (“the ’772 Patent”), which is the subject of both the Par IPR and the Roxane IPR.

2. On September 16, 2014, *Novartis AG* (“Novartis”) filed a complaint in the District of Delaware accusing Roxane of infringing the ’772 Patent. D.I.1,

1:14-cv-01196-RGA (D. Del.). Novartis asserts claims 1-3, 7 and 10 against Roxane. Claim 1 of the '772 Patent is directed to a compound of Formula I.¹ Claims 2, 3 and 10 depend from claim 1. Claim 7 of the '772 Patent recites a pharmaceutical composition comprising a compound of claim 1. Claims 8 and 9 recite methods of using a compound of claim 1.

3. *Par Pharmaceuticals, Inc.* (“Par”) filed a petition for *inter partes* review of claims 1-3 and 8-10 the '772 Patent on October 26, 2015. (Par IPR, IPR2016-00084).

4. The Par IPR included, *inter alia*, the following two grounds for challenging the validity of the '772 Patent:

Ground 1: Claims 1-3 and 10 are invalid under 35 U.S.C. § 103 on the ground that they are rendered obvious in view of Morris, Van Duyne, Rossmann, Lemke, and Yalkowsky; and

Ground 2: Claims 8 and 9 are invalid under 35 U.S.C. § 103 on the ground that they are rendered obvious in view of Morris, Van Duyne, Rossmann, Lemke, Yalkowsky, and in further view of Hughes.

(Par IPR, IPR 2016-0084, Petition at 38-54).

5. The Board instituted the Par IPR on April 29, 2016 on Grounds 1 and

¹ On February 9, 2016, the Patent Office entered a certificate of correction that corrects Claim 1. (Ex. 1030, '772 Patent Certificate of Correction.)

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