Paper No. ____ Date Filed: June 27, 2016

Filed On Behalf Of:

Novartis AG

By:

Nicholas N. Kallas NKallas@fchs.com ZortressAfinitorIPR@fchs.com (212) 218-2100

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROXANE LABORATORIES, INC.,

Petitioner

v.

NOVARTIS AG,

Patent Owner

Inter Partes Review No. 2016-01102

U.S. Patent 5,665,772

PATENT OWNER NOVARTIS'S OPPOSITION TO PETITIONER ROXANE'S MOTION FOR JOINDER



TABLE OF CONTENTS

I.	STA	ATEMENT OF PRECISE RELIEF REQUESTED	1
II.		SPONSE TO ROXANE'S STATEMENT OF TERIAL FACTS	2
III.	RO	ATEMENT OF REASONS FOR DENYING XANE'S REQUESTED RELIEF AND FOR ANTING NOVARTIS'S REQUESTED RELIEF	4
	1.	Roxane's Petition Is Time-Barred	4
	2.	Roxane's Delay In Challenging Claim 7 Unfairly Provides Roxane With A Strategic Advantage	6
	3.	Roxane's Contention That Institution On Claim 7 Does Not Require Consideration Of The -1102 Record Is Wrong	8
	4.	Petitioners' Proposed Schedule For Joint Proceedings Is Unworkable And Prejudicial To Novartis And The Board	9
	5.	Roxane's Role In Any Joint Proceedings Should Be Limited	10
IV	CONCLUSION		11



TABLE OF AUTHORITIES

Cases

Aventis Pharma Deutschland GmbH v. Lupin Ltd., 499 F.3d 1293 (Fed. Cir. 2007)	9
Dell Inc., Hewlett Packard Co. and NetApp, Inc. v. Elecs. and Telecomms. Research Inst.,	
IPR2015-00549, Paper 10 (Mar. 26, 2015)	6
Geneva Pharm., Inc. v. Glaxosmithkline PLC, 189 F. Supp. 2d 377 (E. D. Va. 2002)	3
Geneva Pharm., Inc. v. Glaxosmithkline PLC, 349 F.3d 1373 (Fed. Cir. 2003)	3
Lupin Ltd. v. Senju Pharm. Co., Ltd., IPR2015-01871, Paper 13 (Jan. 25, 2016)	10
Teva Pharms. USA, Inc. v. Viiv Healthcare Co., IPR2015-00550, Paper 11 (Jun. 25, 2015)	11
Statutes	
35 U.S.C. § 316(b)	8
37 C.F.R. § 42.1(b)	8



I. STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Novartis AG ("Novartis") opposes the May 26, 2016 joinder motion of Petitioner Roxane Laboratories, Inc. ("Roxane"). In that motion, Roxane seeks to join its petition for IPR2016-01102 ("-1102 petition") challenging claims 1-3 and 7-10 of U.S. Patent No. 5,665,772 ("'772 patent") with Par Pharmaceutical, Inc.'s ("Par") instituted IPR2016-00084 ("-84 IPR") challenging claims 1-3 and 8-10 of the '772 patent.¹

Roxane's joinder motion should be denied for four reasons.

First, Roxane's May 26, 2016 -1102 petition is time-barred.

Second, joinder of Roxane's -1102 petition with Par's -84 IPR would allow Roxane to exploit the strategic advantage which Par gained by delaying its

Breckenridge moves to join with the -84 IPR its May 10, 2016 petition in IPR2016-01023 ("-1023 petition") challenging claims 1-3 and 8-10 and its May 26, 2016 petition in IPR2016-01103 ("-1103 petition") challenging claim 7; and

 Par moves to join with the -84 IPR its May 17, 2016 petition in IPR2016-01059 ("-1059 petition) challenging claim 7.

Novartis opposes all such joinder motions.



¹ Also:

challenge to claim 7 until after the Board instituted the -84 IPR, as explained below. The exploitation of such gamesmanship should not be encouraged.

Third, Roxane wrongly assumes that the record at the institution stage in its -1102 IPR will be the same as that in Par's -84 IPR. To the contrary: in opposing Roxane's -1102 petition, Novartis is entitled in its Preliminary Response to make new arguments and to rely on new evidence not before the Board in Par's -84 IPR.

Fourth, contrary to the statements in Roxane's motion, joinder of the -1102 IPR will have a significant and prejudicial effect on the schedule. Indeed, Breckenridge, Par and Roxane (collectively, "Petitioners") no longer appear to be pursuing the original -84 IPR schedule with respect to their follow-on claim 7 petitions, including the -1102 petition. And the alternate schedule for hypothetical joint proceedings that Petitioners proposed in their June 15, 2016 email to the Board and discussed on a June 17, 2016 teleconference between the parties, effectively requires a separate trial on claim 7, thereby creating extra work for Novartis and the Board.

For these reasons, Roxane's motion should be denied.

II. RESPONSE TO ROXANE'S STATEMENT OF MATERIAL FACTS

Novartis does not dispute Statements 1-5 and 10 in Roxane's Statement Of Material Facts. IPR2016-01102, Paper 3 at § II.



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

