

Filed On Behalf Of:

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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**

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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

¹ Also:

- 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.

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.

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