

Filed on behalf of: Roxane Laboratories, Inc.

Entered: November 10, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROXANE LABORATORIES, INC.

Petitioner

v.

NOVARTIS AG

Patent Owner

Case IPR2016-01102

U.S. Patent No. 5,665,772

Before LORA M. GREEN, CHRISTOPHER L. CRUMBLY, and ROBERT A. POLLOCK, *Administrative Patent Judges*.

**PETITIONER'S REQUEST FOR REHEARING OF
THE BOARD'S DECISION DENYING JOINDER**

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Petitioner Roxane Laboratories, Inc. (“Roxane”) respectfully requests rehearing of the Board’s Decision denying joinder, Paper 17 (Oct. 27, 2016) (“Dec.”).

Roxane timely filed an IPR petition requesting review of claims 1-3 and 7-10 of the ‘772 patent (the “Roxane Petition”) and a Motion for Joinder with Par Pharmaceutical, Inc.’s (“Par’s”) IPR2015-00084 (the “Par I IPR”), instituted on claims 1-3 and 8-10 of the ‘772 patent. The Board granted Roxane’s Motion for Joinder with respect to claims 1-3 and 8-10, but denied it with respect to claim 7. The Board also denied a second IPR petition submitted by Par, directed to claim 7 of the ‘772 patent (IPR2016-01059; the “Par II IPR”).

Roxane is aware that Par is concurrently filing a Request for Rehearing of the Board’s Decision denying joinder in the Par II IPR. The subject of Par’s Request for Rehearing is the same as that of the present Request for Rehearing. If Par’s Request for Rehearing is granted, Roxane’s Request for Rehearing likewise should be granted.

The Board agreed that the Roxane Petition established that claim 7 of the ‘772 patent is likely obvious. Dec. at 12. The only difference between claim 7 and claim 1 is that claim 7 recites a composition comprising a therapeutically effective amount of the compound of claim 1 and an acceptable carrier, without any further specificity. Nevertheless, the Board did not institute review. Accordingly, if the

Board finds that claims 1-3 and 8-10 are unpatentable, claim 7 will block the public from using an obvious compound, for its obvious methods of use.

The Board identified two reasons for denying Roxane's joinder motion as to claim 7. Dec. at 15. First, according to the Board, Par's inadvertent omission of claim 7 in the Par I IPR petition is not a "sufficient justification for the grant of joinder." *Id.* at 15. Second, according to the Board, the joinder of claim 7 would "unduly complicate" and cause "undue delays" in the Par I IPR proceeding, to which Roxane has been joined. *Id.* at 17.

In denying joinder, the Board misapprehended or overlooked at least the following matters. First, the Board did not explain why Roxane should be prejudiced by Par's failure to include claim 7 in the Par I IPR. Second, the Board abused its discretion when it found that joining claim 7 would cause undue delays and unduly complicate the Par I IPR. Third, the Board failed to adequately account for the public interest.

I. Legal Standard

A party seeking rehearing must identify the matters that the Board misapprehended or overlooked. 37 C.F.R. §42.71(d). The Board reviews its decision for an abuse of discretion, 37 C.F.R. §42.71(c), which occurs when the "decision represents an unreasonable judgment in weighing relevant factors" or "the agency offers insufficient reasons for treating similar situations differently."

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