

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED
Petitioner

v.

NOVARTIS AG
Patent Owner

Case No. To Be Assigned
Patent No. 9,006,224

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 West-Ward Pharmaceuticals International Limited (“West-Ward” or “Petitioner”) respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the petition for *inter partes* review submitted concurrently herewith (hereinafter “West-Ward IPR Petition”) with the pending *inter partes* review of claims 1-3 of U.S. Patent No. 9,006,224 (“the ’224 Patent”) in *Par Pharmaceutical, Inc. v. Novartis AG*, Case No. IPR2016-01479 (“Par IPR”), which was instituted on February 15, 2017. The West-Ward IPR Petition presents the same grounds of invalidity as set forth in the Par Pharmaceutical, Inc. (“Par”) IPR Petition. (IPR2016-01479, Paper 1).

On July 19, 2016, Roxane Laboratories, Inc. (“Roxane”)¹ filed a petition for *inter partes* review of claims 1-2 of the ’224 patent. (IPR2016-01461, Paper No. 2). The Board denied institution of Roxane’s Petition on February 13, 2017. (IPR2016-01461, Paper No. 9).

Roxane and West-Ward respectfully submit that the Roxane IPR Petition established that each element of claim 1 and claim 2 of the ’224 patent is found in the prior art, and that there is a reasonable likelihood that at least claim 1 and claim

¹ On January 11, 2017, the Mandatory Notices in IPR2016-01461 were updated to identify West-Ward as an additional real-party-in-interest. (IPR2016-01461, Paper No. 8).

2 of the '224 patent are invalid as obvious over the prior art cited therein.

Nevertheless, the Board denied institution of Roxane's IPR Petition. In view of the Board's denial of institution of the Roxane IPR and institution of the Par IPR (IPR2016-01479), West-Ward respectfully requests joinder with the Par IPR. Joinder in similar circumstances was granted by the Board in *Oracle America, Inc. v. Realtime Data LLC*, IPR2016-01672, Paper No. 13, March 7, 2017.

Joinder is appropriate because it will promote efficient and consistent resolution of the validity of a single patent, will not prejudice any of the parties to the Par IPR, and is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted within one month of February 15, 2017, the date on which the Board instituted the Par IPR.

II. STATEMENT OF MATERIAL FACTS

1. Petitioner is not aware of any reexamination certificates or pending prosecution concerning the '224 Patent, which is the subject of the Par IPR and the West-Ward IPR Petition.

2. On June 10, 2015, Novartis Pharmaceuticals Corporation and Novartis AG ("Novartis") filed a complaint in the District of Delaware accusing Roxane, now West-Ward, of infringing the '224 Patent. *Novartis Pharm. Corp. et al. v.*

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