

Filed On Behalf Of:

Novartis AG

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED,
Petitioner

v.

NOVARTIS AG,
Patent Owner

Inter Partes Review No. 2017-01078

U.S. Patent 9,006,224

**PATENT OWNER NOVARTIS'S RESPONSE TO
PETITIONER WEST-WARD'S MOTION FOR JOINDER**

Patent Owner Novartis AG (“Novartis”) does not oppose the March 13, 2017 joinder motion of West-Ward Pharmaceuticals International Limited (“West-Ward”). Nevertheless, to advance the “just, speedy, and inexpensive resolution” of joint proceedings, Novartis respectfully requests that the Board order West-Ward in joint proceedings (i) to rely solely on the petition and the evidence filed by Par in IPR2016-01479; (ii) to consolidate all briefing under the page limits of 37 C.F.R. § 42.24 and to share the pages that are allotted for written work product to Par in IPR2016-01479; and (iii) to share with Par the time that is or will be allotted for cross and redirect examination to Par in the IPR2016-01479.

Precedent exists for those limitations. *See, e.g., Bungie, Inc. v. Acceleration Bay, LLC*, IPR2016-00934, Paper 11 (July 8, 2016) at 13-14 (granting Bungie’s motion for joinder, ordering that petitioners consolidate all briefing under the page limits of 37 C.F.R. § 42.24, and ordering that Bungie not file any additional pages to address points of disagreement with the Activision petitioners without first moving for and obtaining the Board’s permission); *ZTE USA, Inc. v. Evolved Wireless LLC*, IPR2016-01280, Paper 8 (Dec. 21, 2016) at 4 (consolidating identical IPR petitions *sua sponte*, and ordering that petitioners “will share all time permitted for depositions and will file all papers, except for papers that do not involve the other petitioner, as a consolidated paper, and that consolidated papers will not be given additional pages or words unless otherwise authorized by the

Board.”). *Cf. Teva Pharms. USA, Inc. v. Viiv Healthcare Co.*, IPR2015-00550, Paper 11 (June 25, 2015) at 6 (denying joinder where joinder raised the prospect that the parties and the Board would have to manage burdensome additional pages of briefing).

In addition, Novartis respectfully advises the Board that West-Ward is a party to litigation against Novartis on U.S. Patent No. 9,006,224 (“the ’224 Patent”) that is currently pending in the District Court for the District of Delaware and scheduled for trial May 22-24, 2017. *See* Patent Owner’s Mandatory Notices Under 37 C.F.R. § 42.8(a)(2), Paper 4 at page 1; *Novartis Pharm. Corp. v. West-Ward Pharm. Int’l Ltd.*, C.A. No. 15-474-RGA (D. Del.). On the current schedule in IPR2016-01479, Novartis’s Patent Owner Response is due on May 11, 2017, before the May 22-24, 2017 District Court trial commences. But the Reply of Petitioners (including West-Ward, should IPR2017-01078 be joined to the proceeding in IPR2016-01479) will be due on August 3, 2017, after the District Court trial is completed. Thus, Petitioners, but not Novartis, would have an opportunity to cite District Court trial testimony regarding the ’224 Patent to the Board. The current schedule in IPR2016-01479 may thereby create unfairness to Novartis if citation of the District Court trial testimony occurs. Novartis wishes to inform the Board that, should Petitioners seek to rely on incomplete or misleading excerpts from the May 2017 District Court trial record, it may be necessary for

Novartis to request permission from the Board to file a Sur-Reply or seek alternative means of addressing such incomplete or misleading citations.

Respectfully submitted,

Dated: April 13, 2017

/Nicholas N. Kallas/

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Lead Counsel for Patent Owner

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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing Patent Owner Novartis's Response To Petitioner West-Ward's Motion For Joinder Of Its Petition was served on April 13, 2017 by causing it to be sent by email to counsel for Petitioner West-Ward Pharmaceuticals International Limited in IPR2017-01078 and Petitioner Par Pharmaceutical, Inc. in IPR2016-01479 at the following email addresses:

West-Ward Pharmaceuticals International Limited

Keith A. Zullo (kzullo@goodwinprocter.com)

Marta E. Delsignore (mdelsignore@goodwinprocter.com)

Par Pharmaceutical, Inc.

Daniel Brown (daniel.brown@lw.com)

Jonathan M. Strang (jonathan.strang@lw.com)

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