

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED

Petitioner

v.

NOVARTIS PHARMACEUTICALS CORPORATION

Patent Owner

Case IPR2018-_____

U.S. Patent No. 8,410,131

**PETITIONER'S MOTION FOR JOINDER PURSUANT TO 35 U.S.C.
§ 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

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I. STATEMENT OF RELIEF REQUESTED

West-Ward Pharmaceuticals International Limited (“West-Ward” or “Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review (“the West-Ward Petition”) of claims 1-3 and 5-9 of U.S. Patent No. 8,410,131 (“the ’131 patent”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests *inter partes* review and joinder with *Breckenridge Pharmaceutical, Inc. v. Novartis Pharmaceuticals Corporation*, IPR2017-01592 (the “Breckenridge IPR”), which was instituted on January 3, 2018. Joinder is appropriate because it will promote efficient and consistent resolution of the unpatentability grounds at issue and will not prejudice any of the parties to the Breckenridge IPR. Petitioner has requested consent from Breckenridge Pharmaceutical, Inc. (“Breckenridge”) to file this motion for joinder. To date, Breckenridge has not indicated its position regarding Petitioner’s request. Absent joinder, West-Ward will be prejudiced because its interests may not be adequately represented in the Breckenridge IPR.

This Motion for Joinder and accompanying Petition are being filed within one month of the decision instituting trial in the Breckenridge IPR, and are therefore timely. 37 C.F.R. §§ 42.22, 42.122(b).

II. STATEMENT OF MATERIAL FACTS

1. Novartis Pharmaceuticals Corporation (“Novartis” or “Patent Owner”) owns the ’131 patent. Novartis sued West-Ward (previously Roxane Laboratories, Inc.), in the United States District Court for the District of Delaware, for infringement of the ’131 patent in 2015 and final judgment was entered in favor of Novartis in December 2017.

2. On June 12, 2017, Breckenridge filed a petition for *inter partes* review of claims 1-3 and 5-9 of the ’131 patent. *See* IPR2017-01592, Paper No. 1.

3. On January 3, 2018, the Board instituted an *inter partes* review of claims 1-3 and 5-9 of the ’131 patent. *See* IPR2017-01592, Paper No. 12.

4. West-Ward’s Petition that accompanies the present Motion for Joinder is filed within one month of the January 3, 2018 decision to institute the Breckenridge IPR, and includes only the same grounds of unpatentability that were instituted in the Breckenridge IPR. West-Ward’s Petition is timely under 37 C.F.R. § 42.122, which provides that the time period set forth in 37 C.F.R. § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

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