

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

BIOGEN, INC.,
Patent Owner.

Case IPR2018-00186
Patent No. 9,296,821 B2

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317, Petitioner Pfizer Inc. (“Petitioner” or “Pfizer”) and Patent Owner Biogen, Inc. (“Patent Owner” or “Biogen”) jointly request termination of IPR2018-00186 concerning U.S. Patent No. 9,296,821 B2 (“the ’821 patent”).

I. Background

On December 1, 2017, Petitioner filed a petition for *inter partes* review of the ’821 patent before the United States Patent Trial and Appeal Board (the “Board”). Patent Owner filed its preliminary response on March 19, 2018 (Paper No. 9). The Board issued its decision to institute on June 14, 2018 (Paper No. 15). Patent Owner filed its patent owner response on October 8, 2018 (Paper No. 32). Petitioner has not yet filed its reply and the Board has not yet decided the merits of this proceeding.

The ’821 patent is also the subject of IPR2017-01095, filed by Petitioner Celltrion, Inc. The Board issued a Final Written Decision in IPR2017-01095 on October 4, 2018, finding claims 1-6 of the ’821 patent unpatentable. No other petitions for *inter partes* review have been filed regarding the ’821 patent. There are currently no other proceedings involving the ’821 patent before the Office.

On October 16, 2018, the parties, through their respective counsel, agreed to seek termination of this proceeding pursuant to 35 U.S.C. § 317. The parties notified the Board of their agreement and requested authorization to file a joint

motion to terminate this proceeding as to both Petitioner and Patent Owner. The Board authorized the filing of the requested joint motion to terminate this proceeding on October 25, 2018. Email from Andrew Kellogg at Trials dated October 25, 2018. The parties hereby jointly represent that the agreement to terminate the proceeding was made through the parties' respective counsel and no written agreement exists to be filed with the Board. In addition, the parties jointly represent that there are no other written or oral agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this proceeding.

II. Argument

A. Petitioner Should Be Terminated From This Review

Under 35 U.S.C. § 317(a), "an inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." The parties here are jointly requesting termination of this proceeding and the Office has not yet "decided the merits of the proceeding before the request for termination is filed." The Board should therefore terminate Petitioner from the proceeding under § 317(a).

B. Termination of the Proceeding Is Appropriate

The Board has discretion to terminate an *inter partes* review in its entirety when no petitioner remains in the proceeding. *See* 35 U.S.C. § 317(a) (“If no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)”). Moreover, because Pfizer is the only petitioner in the *Inter Partes* Review proceeding, once the proceeding is terminated with respect to Pfizer, no petitioner will remain in the *inter partes* review, and the Office may terminate the review in its entirety under Section 317. Petitioner and Patent Owner jointly submit that the Board should do so.

Termination of this proceeding is appropriate as the Board has not yet “decided the merits of the proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012); *Atrium Medical Corp. v. Davol Inc.*, IPR2013-00186, Judgment (Paper 75) (appropriate to terminate IPR as to all parties where briefing complete but no final decision on merits has been rendered).

The Board has routinely terminated proceedings at the request of parties in cases that have progressed much further than the present proceeding, *see, e.g.*, *Apex Medical Corp. v. Resmed Ltd.*, IPR2013-00512, Paper 39 at 24 (PTAB Sept. 12, 2014) (granting motion to terminate in its entirety notwithstanding that instituted proceeding was fully briefed); *Volusion, Inc. v. Versata Software, Inc.*,

CBM2013-00018, Paper 52 at 2 (PTAB June 17, 2014) (granting motion to terminate instituted proceeding in its entirety after final oral hearing); *see also ARM, Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-00527, Paper 10 at 2-3 (PTAB May 12, 2017) (granting motion to terminate in its entirety after preliminary response but prior to institution), and the parties respectfully request that the Board terminate this *Inter Partes* Review proceeding in its entirety. Termination is particularly appropriate in this proceeding, as this joint motion is presented in advance of the deadline for Petitioner's reply and well before the Board must issue a final written decision in this case.

Termination of this proceeding will also conserve the time and resources of the parties and the Board. No interest will be served by continuing this proceeding, as the parties have agreed to seek termination in the manner described herein.

Assuming this motion is granted, neither Petitioner nor Patent Owner will participate further in this proceeding. Petitioner further states that it will not file any subsequent petitions for *inter partes* review concerning the '821 patent.

C. No Collateral Agreements

The parties further state that there are no other written or oral agreements, including any collateral agreements or understandings between the parties, made in

connection with, or in contemplation of, the termination of this proceeding pursuant to 35 U.S.C. § 317.

III. Conclusion

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board terminate IPR2018-00186. Petitioner and Patent Owner are available at the Board's convenience to discuss this matter in more detail or answer any additional questions raised by this joint motion.

Respectfully submitted by:

Dated: October 31, 2018

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on October 31, 2018, a true and correct copy of the foregoing “JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 37 C.F.R. § 317,” was served by filing this document through Patent Trial and Appeal Board End to End system as well as delivering a copy via email to the following attorneys of record:

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