

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PFIZER, INC.,  
Petitioner,

v.

BIOGEN, INC.,  
Patent Owner.

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Case IPR2018-00231  
Patent 9,504,744 B2

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**PETITIONER'S AUTHORIZED UNOPPOSED MOTION TO TERMINATE  
PROCEEDING WITH PREJUDICE**

## **I. INTRODUCTION**

Pursuant to the Board's authorization via email on May 31, 2018, Petitioner Pfizer, Inc. files this motion to dismiss its IPR petition and terminate IPR2018-00231 (U.S. Patent 9,504,744 B2) with prejudice. IPR2018-00231 is in its preliminary phase and is thus well-suited for termination. Patent Owner, Biogen, Inc. has filed a Preliminary Response (Paper 9), but the Board has yet to reach the merits and issue a decision on institution. Even though Petitioner remains confident in its arguments and evidence that the claims of the '744 patent are obvious over the cited prior art, Petitioner respectfully requests the Board to dismiss the petition and terminate IPR2018-00231 with prejudice to preserve the Board's and parties' resources and to achieve a just, speedy, and inexpensive resolution to this dispute. Further, Patent Owner has indicated that it does not oppose this motion.

## **II. BACKGROUND AND PROCEDURAL HISTORY**

IPR2018-00231 is one several IPR proceedings involving a rituximab-related patent in Patent Owner's "rituximab portfolio." Pet. 7; Prelim. Resp. 2. This Petition (IPR2018-00231) was filed on December 1, 2017. Patent Owner timely filed its Preliminary Response on March 19, 2018, and now the Petition is currently pending before the Board.

Prior to filing the Petition in IPR2018-00231, Petitioner previously challenged U.S. Patent No. 8,557,244 in Case IPR2017-01167. *Pfizer, Inc. v. Biogen, Inc.*,

Paper 2 (PTAB Apr. 27, 2017). The '244 patent shares the same expiration date and specification as the '744 patent and is also one of the patents in Patent Owner's "rituximab portfolio." Pet. 7. The Board previously denied institution of IPR2017-01167 on November 6, 2017 and also denied Petitioner's Rehearing Request on March 22, 2018. *Pfizer, Inc. v. Biogen, Inc.*, Case IPR2017-01167, Paper 12 (PTAB Mar. 22, 2018).

### **III. ARGUMENT**

Good cause exists to dismiss Petitioner's IPR petition and terminate IPR2018-00231. Termination would preserve the Board's and the parties' resources, and would expeditiously resolve Petitioner's request, furthering the purpose of IPR challenges. 37 C.F.R. § 42.1(b). IPR2018-00231 is in its preliminary stage as the Board has not yet reached the merits or issue a decision on institution. Patent Owner would not be prejudiced by termination—especially where Petitioner is requesting to terminate the proceeding with prejudice.

The Board "may terminate a trial without rendering a final written decision, where appropriate." 37 C.F.R. § 42.72. Further, the rules governing IPR proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." *Id.* § 42.1(b). In determining whether a termination request is "appropriate," the Board primarily examines the stage and nature of the

proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, Case IPR2015-01270, Paper 12 at 3 (PTAB Dec. 9, 2015).

Proceedings that are in their preliminary proceeding stages—i.e., before the Board issues an institution decision—are well-suited for termination. *See id.* (granting opposed motion to terminate proceeding during the preliminary proceeding stage of underlying IPR proceeding); *HTC Corp. v. Patentmarks Commc'ns, LLC*, Case IPR2014-00905, Paper 7 at 3 (PTAB Aug. 26, 2014) (granting unopposed motion to terminate noting that a “decision on the Petition . . . has not yet been rendered. Under these circumstances, we determine that it is appropriate . . . to terminate this proceed without rendering a final written decision.”). Because IPR2018-00231 is in the preliminary proceeding phase, termination would be proper.

As a preliminary proceeding, IPR2018-00231 is ripe for termination and would conserve both the Board’s and the parties’ resources. Terminating IPR2018-00231 would further the purpose of *inter partes* review proceedings by justly and expeditiously resolving this dispute without subjecting the Board and the parties to unnecessary expense involving in taking IPR2018-00231 through trial. The parties will incur substantial expense in preparing and presenting expert declarants for depositions, submitting substantive briefs and motions, and presenting at an oral hearing. The Board will also likely have to expand a significant amount of resources

if it declined to terminate IPR2018-00231. As an example, the Board would likely be requested to address various procedural disputes, preside over an oral hearing, and draft a substantive decision on institution and a final written decision on the merits. These resources and obligations can be spared by terminating IPR2018-00231. Termination will therefore reduce the overall burden on the Board given that there are two instituted trials involving rituximab patents underway (IPR2017-01168 and IPR2017-01923) and three more petitions are pending (IPR2017-01166, IPR2018-00186, and IPR2018-00285).

Moreover, termination of this proceeding is appropriate because resolution of IPR2018-00231 is not necessary. Because the '744 and the '244 patent share the same expiration date and because the Board previously denied institution of the '244 patent, there is no reason to tax the Board's finite resources with the present proceeding. Therefore, terminating this proceeding would also conserve the Board's and the parties' resources in view of the larger context of the dispute between the parties.

Termination is also a just resolution as Patent Owner will not be prejudiced by this Board terminating IPR2018-00231. Indeed, because Petitioner seeks to dismiss the petition and terminate the proceeding with prejudice, Patent Owner will not be prejudiced by the termination. The '744 patent is not the subject of any district

court litigation between Petitioner and Patent Owner and thus terminating this proceeding will not affect any other proceedings between the parties.

#### IV. CONCLUSION

For all the reasons stated above, Petitioner respectfully requests that the Board dismiss the underlying Petition and Terminate IPR2018-00231 with prejudice.

Dated: June 4, 2018

Respectfully submitted,

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## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), I certify that, on June 4, 2018, a true and correct copy of the foregoing PETITIONER'S AUTHORIZED UNOPPOSED MOTION TO TERMINATE PROCEEDING WITH PREJUDICE was served by via email to the following attorneys:

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