

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 9,296,821 B2

Before ERICA A. FRANKLIN, SHERIDAN K. SNEDDEN, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
35 U.S.C § 317

On October 24, 2018, the parties contacted the Board to request authorization to file a joint motion to terminate this proceeding. Ex. 3001. On October 25, 2018, we authorized the joint motion and instructed the parties that any agreement between the parties made in connection with the termination request must be in writing and a true copy must be filed with Board. *Id.* (citing 37 C.F.R. § 42.74(b)). On October 31, 2018, the parties filed a joint motion to terminate the proceeding pursuant to 35 U.S.C § 317. Paper 33. In the joint motion, the parties explain that, through their respective counsel, they “agreed to seek termination of this proceeding pursuant to 35 U.S.C. § 317.” *Id.* at 1.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” *See also* 37 C.F.R. § 42.74(a) (“parties may agree to settle any issue in a proceeding”). The Decision on Institution was entered on June 14, 2018. Paper 15. Patent Owner filed its Patent Owner’s Response to the Petition on October 8, 2018. Paper 32. Petitioner has not filed its Petitioner’s Reply to Patent Owner’s Response. The stipulated due date for that filing is January 15, 2019. Paper 27. The parties assert that terminating the proceeding is appropriate based upon the timing of their request, as they have filed their joint motion before the Board has decided the merits of proceeding. Paper 33, 3. We agree and, thus, find that the parties have satisfied section § 317(a).

Under 35 U.S.C. § 317(b),

[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.

See also 37 C.F.R. § 42.74(b). The parties have set forth their agreement to seek a termination of this proceeding in writing, wherein such writing is their email to the Board seeking authorization to file an agreed upon joint motion to terminate the proceeding, along with their subsequently filed joint motion to terminate. *See* Ex. 3001 (counsel certification that the agreement to terminate the proceeding was made in writing and such writing is limited to counsel's joint email to the Board and joint motion to terminate). Further, the parties confirm in their joint motion that "no written agreement exists to be filed with the Board" and 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." Paper 33, 2; *see also* Ex. 3001 (counsel certification that there are (i) *no other written* agreements or understandings between Patent Owner and Petitioner, made in connection with, or in contemplation of, the termination, and (ii) *no unwritten* agreements or understandings between Patent Owner and Petitioner, made in connection with, or in contemplation of, the termination). Thus, we find that the parties have satisfied section 317(b).

Also, as noted by the parties in their joint motion, Paper 33, 1, the same claims of the '821 patent challenged in this proceeding were challenged in IPR2017-01095. *See* IPR2017-01095, Paper 12 (Decision on Institution). The Final Written Decision entered in IPR2017-01095, on October 4, 2018, concluded that each of those claims is unpatentable over the combined prior art cited in that proceeding. *Id.* at Paper 60.

Based on the foregoing, pursuant to 35 U.S.C. § 317, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision.

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding is GRANTED; and

FURTHER ORDERED that the proceeding is TERMINATED.

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