

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

PFIZER INC.,  
Petitioner,

v.

BIOGEN, INC.,  
Patent Owner.

---

Case IPR2018-00285  
Patent 8,329,172 B2

---

**PATENT OWNER AND PETITIONER PFIZER INC.'S  
JOINT MOTION TO TERMINATE  
PURSUANT TO 35 U.S.C. § 317**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, Petitioner Pfizer Inc. (“Pfizer”) and Patent Owner Biogen, Inc. (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate this proceeding in its entirety.

The parties notified the Patent and Trial Appeal Board of the parties’ settlement on March 15, 2019, and received authorization to file this Motion to Terminate on March 19, 2019.

## II. STATEMENT OF FACTS

In support of the Motion to Terminate Proceeding, Pfizer and Patent Owner state as follows:

Pfizer filed its petition for *inter partes* review on December 14, 2017, and Patent Owner filed a preliminary response on April 11, 2018. On July 9, 2018, the Board instituted this *inter partes* review.

Pfizer and Patent Owner have settled their dispute and all litigation relating to U.S. Patent No. 8,329,172. The parties also agreed to move to terminate this *inter partes* review.

The parties’ Settlement Agreement has been made in writing, and a true and correct copy will be concurrently filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) as Exhibit 2066. There are no collateral agreements. Because the settlement agreement is confidential, Pfizer and Patent Owner

respectfully request that it be treated as business confidential information, be kept separate from the underlying patent file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c), and have filed herewith a separate paper setting forth this request.

### III. RELATED LITIGATION

There are no currently-pending district court litigations or appeals involving U.S. Patent No. 8,329,172.

This is the only currently-pending *inter partes* review involving U.S. Patent No. 8,329,172.

### IV. ARGUMENT

The statutory provision on a settlement relating to *inter partes* reviews provides that an *inter partes* review “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.” 35 U.S.C. § 317(a). It also provides that, “[i]f 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).” *Id.*

Here, the Board has not decided the merits of the proceeding. Oral argument has not occurred, and no final decision on any of the merits of the Petition has issued. In other proceedings, the Board has granted motions to terminate within a similar period of time before the statutory deadline. For example, in *Petroleum Geo-Services Inc. v. WesternGeco LLC*, the Board terminated the proceeding in its entirety after oral

argument had already been conducted, and after the parties requested permission to move to terminate five days before the statutory one-year deadline and filed their motion to terminate (as authorized by the Board) two days before the statutory deadline. *See Petroleum Geo-Services Inc. v. WesternGeco LLC*, IPR2016-00407, Paper 29 at 2, 3-4 (July 5, 2017) (granting termination of the entire proceeding, notwithstanding that “the record . . . is closed, and the Board was ready to issue a final written decision”); “Generally . . . the Board expects that a proceeding will terminate after the filing of a settlement agreement” (citing *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). *See also, e.g., Taiwan Semiconductor Mfg. Co. Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-01862, Paper 39 (Jan. 24, 2019) (granting termination of proceeding in view of settlement two months after oral argument); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00018, Paper 52 at 2 (June 17, 2014) (granting full termination of proceeding after oral argument; “While this case is in the late stages of the trial, no final written decision has been made”); *Lam Research Corp. v. Flamm*, IPR2015-01764, Paper 27 at 4, 6 (Dec. 15, 2016) (granting full termination of proceeding after oral argument despite “extremely advanced nature” of proceeding, when “substantial resources—both on the part of the Board, as well as the parties—have been invested in this matter”).

Indeed, the Board has stated an expectation that proceedings such as this will be terminated after the filing of a settlement agreement: “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding . . . . The Board *expects*

*that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. 317(a), as amended . . .” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (emphasis added); see Petroleum Geo-Services Inc. v. WesternGeco LLC, IPR2016-00407, Paper 29 at 3. For at least the reasons discussed herein, the Board’s expectation that such proceedings should be terminated is proper and well justified here.*

First, applying here the Board’s expectation that these proceedings should be terminated promotes the Congressional goal of “establish[ing] a more efficient and streamlined patent system” that, *inter alia*, “limit[s] unnecessary and counterproductive litigation costs.” *See Changes to Implement Inter partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, Final Rule, 77 Fed. Reg. 48680, 48680 (Aug. 14, 2012). By permitting termination of review proceedings upon settlement of the disputes of all parties prior to a decision on the merits, the Patent Office provides a measure of certainty as to the outcome of such proceedings – helping to promote settlements and creating a timely, cost-effective alternative to litigation. In contrast, should the Board decide to continue the present proceedings, the Congressional goal of speedy and less costly dispute resolutions and the Board’s stated goal of promoting settlement would be chilled (by, *inter alia*, giving patent owners less incentive to resolve disputes, and by adding to the burdens to both patent owners and the Office in addressing any subsequent appeals).

Second, applying the Board’s expectation that these proceedings should be

terminated is also consistent with the adjudicatory nature of *inter partes* review proceedings recognized by the Board and the Federal Circuit, as contrasted with the examinational nature of the *inter partes* reexamination proceedings they replaced. *See, e.g., Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at 6 (June 11, 2013) (“An *inter partes* review is more adjudicatory than examinational, in nature.”); *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013) (“In 2011, Congress replaced *inter partes* reexamination with a new proceeding called *inter partes* review . . . . The purpose of this reform was to ‘convert[] *inter partes* reexamination from an examinational to an adjudicative proceeding,’ . . . .”) (citations omitted); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“rather than create (another) agency-led, inquisitorial process for reconsidering patents, Congress opted for a party-directed, adversarial process.”). Under 35 U.S.C. § 317, termination as to the Petitioner is mandatory upon joint request of the parties (which has now been filed), and once that termination is effected, there will be no counterparty in these proceedings. In the circumstances presented here, continuing without an adversary would needlessly alter the role of the Board and undermine the fundamentally adjudicatory nature of this IPR. *See, e.g.,* 35 U.S.C. § 316(e) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”) (emphasis added); 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (noting that the new procedures were intended to be strictly adjudicative in nature, where “the petitioner, rather than the Office, bears the

burden of showing unpatentability”).

## V. CONCLUSION

Wherefore, Pfizer and Patent Owner respectfully request that the Board grant the parties' Joint Motion to terminate IPR2018-00285, and grant the request to treat the settlement agreement between the parties as business confidential information.

Pfizer and Patent Owner are available at the Board's convenience to discuss these related matters in more detail or answer any additional questions raised by this joint motion.

Dated: March 19, 2019

/s/ John Scheibeler

John Scheibeler (Reg. No. 35,346)  
Dimitrios T. Drivas (Reg. No. 32,218)  
Leon Miniovich (*pro hac vice*)  
White & Case LLP  
1221 Avenue of the Americas  
New York, NY 10020  
P: 212-819-8200/F: 212-354-8113  
jscheibeler@whitecase.com  
ddrivas@whitecase.com  
lminiovich@whitecase.com

Eric Krause (Reg. No. 62,329)  
Allen Wang (Reg. No. 68,456)  
White & Case LLP  
2 Palo Alto Square, Suite 900  
3000 El Camino Real  
Palo Alto, CA 94306  
P: 650-213-0300/F: 650-213-8158  
eric.krause@whitecase.com  
allen.wang@whitecase.com

Jovial Wong (Reg. No. 60,115)  
Eimeric Reig-Plessis  
Charles B. Klein  
Winston & Strawn, LLP  
1700 K St. NW  
Washington, DC 20006  
P: 202-282-5867/F: 202-282-5100  
jwong@winston.com  
ereigplessis@winston.com  
cklein@winston.com

*Attorneys For Petitioner*

Respectfully submitted by:

/s/ Michael R. Fleming

Michael R. Fleming, Reg. No. 67,933  
Gary N. Frischling, Reg. No. 35,515  
Keith A. Orso, Reg. No. 52,084  
Yite John Lu, Reg. No. 63,158  
Irell & Manella LLP  
1800 Avenue of the Stars, Suite 900  
Los Angeles, CA 90067  
Telephone: (310) 277-1010  
mfleming@irell.com  
gfrischling@irell.com  
korso@irell.com  
yjlu@irell.com

*Attorneys For Patent Owner*



## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER AND PETITIONER PFIZER INC.'S JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 has been served in its entirety by causing the aforementioned document to be electronically mailed to the following attorneys of record for the Patent Owner and Petitioner Pfizer listed below:

### **Patent Owner's Counsel of Record:**

Michael R. Fleming, Reg. No. 67,933  
Gary N. Frischling, Reg. No. 35,515  
Keith A. Orso, Reg. No. 52,084  
Yite John Lu, Reg. No. 63,158

mfleming@irell.com  
gfrischling@irell.com  
korso@irell.com  
yjlu@irell.com

### **Petitioner Pfizer's Counsel of Record:**

John Scheibeler (Reg. No. 35,346)  
jscheibeler@whitecase.com

Dimitrios T. Drivas (Reg. No. 32,218)  
ddrivas@whitecase.com

Eric Krause (Reg. No. 62,329)  
eric.krause@whitecase.com

Allen Wang (Reg. No. 68,456)  
allen.wang@whitecase.com

Leon Miniovich (*pro hac vice*)  
lminiovich@whitecase.com

Jovial Wong (Reg. No. 60,115)  
jwong@winston.com

Eimeric Reig-Plessis  
ereigplessis@winston.com

Charles B. Klein  
cklein@winston.com

Dated: March 19, 2019

Respectfully Submitted,

By: /s/ Pia S. Kamath