

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC., SAWAI USA, INC.,  
and SAWAI PHARMACEUTICAL CO., LTD.,  
Petitioner

v.

BIOGEN MA INC.,  
Patent Owner

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Case IPR2018-01403<sup>1</sup>  
Patent 8,399,514

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**JOINT MOTION TO TERMINATE PROCEEDING AS TO PETITIONER  
SAWAI PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a), Petitioners Sawai USA Inc. and Sawai Pharmaceutical Co. Ltd. (collectively “Sawai”) and Patent Owner Biogen MA Inc. jointly request termination of the *inter partes* review of U.S. Patent No. 8,399,514 ('514 patent), Case No. IPR2019-01403 as to Petitioner Sawai in light of Biogen and Sawai’s resolution of their dispute relating to this IPR.

Biogen and Sawai have settled their disputes regarding the '514 patent. Biogen and Sawai’s settlement is memorialized in an agreement (“Settlement Agreement”), a true and correct copy of which is being filed confidentially as Exhibit 1135 (in a separate paper), as required by 35 U.S.C. § 317(b).

In accordance with 37 C.F.R. § 42.20(b), on November 13, 2019, Sawai and Biogen sought authorization from the Board (via email) to file this motion to terminate and to file the Settlement Agreement as business confidential information. In an Order dated November 18, 2019 (Paper No. 90)(“Order”), the Board authorized the parties to file this joint motion to terminate and further authorized the parties to file a joint request to file the Settlement Agreement as business confidential information in a separate paper filed contemporaneously with the joint motion to terminate. Order at 3.

## II. TERMINATION IS APPROPRIATE

Pursuant to the Order, the joint motion to terminate as to Petitioner Sawai must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. Order at 2.

1) Explanation Why Termination is Appropriate: Biogen and Sawai have reached agreement regarding their disputes relating to the '514 patent. Pursuant to Section 1(b) of the Settlement Agreement, Patent Owner and Sawai jointly agreed to terminate Sawai from this proceeding. (Ex. 1135 at Section 1(b).) Accordingly, the parties jointly request that Sawai be terminated from this proceeding under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. The litigation between Biogen and Sawai related to this proceeding has also been settled and Biogen and Sawai filed a stipulation to dismiss the related litigation. (Ex. 1135 at Section 1(a).) *Biogen International GmbH and Biogen MA Inc. v. Sawai USA, Inc. and Sawai Pharmaceutical Co. Ltd.*, 1:17-cv-875-MN (D. Del.) (dismissed Nov. 14, 2019).

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 the patent owner, unless the Office has decided the merits of the

proceeding before the request for termination is filed.” This proceeding has been instituted but the Board has not decided on the merits of the proceeding.

Strong public policy considerations favor settlement between the parties to an inter partes review proceeding. *See* Office Trial Practice Guide, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). No public interest or other factors weigh against termination of Sawai from this proceeding.

Because the underlying dispute has been resolved between Biogen and Sawai and because termination of Sawai would encourage settlement of Patent Office proceedings, consistent with federal judicial preference and the management of limited judicial and Patent Office resources, Biogen and Sawai submit that termination of this proceeding is appropriate.

2) Related Litigation: The following pending litigation concerns the ’514 patent:

*Biogen International GmbH and Biogen MA Inc. v. Amneal Pharmaceuticals, LLC et al.*, No. 1:17-cv-823-MN (D. Del.) (consolidated)

*Biogen International GmbH and Biogen MA Inc. v. Accord Healthcare, Inc.*, No. 1:17-cv-872-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Alkem Labs. Limited. and S&B Pharma Inc.*, No. 1:17-cv-850-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Aurobindo Pharma U.S.A., Inc. and Aurobindo Pharma USA LLC*, No. 1:17-cv-824-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Cipla Limited and Cipla USA Inc.*, No. 1:17-cv-851-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Glenmark Pharmaceuticals Limited and Glenmark Pharmaceuticals Inc., USA*, No. 1:17-cv-852-MN (D. Del.)

*Biogen MA Inc. v. Graviti Pharmaceuticals. Pvt. Limited and Graviti Pharmaceuticals Inc.*, No. 1:17-cv-846-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Hetero USA Inc., Hetero Labs Limited Unit-III and Hetero Labs Limited*, No. 1:17-cv-825-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Lupin Atlantis Holdings SA and Lupin Inc.*, No. 1:17-cv-853-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Macleods Pharmaceuticals, Limited and Macleods Pharma USA Inc.*, No. 1:17-cv-857-MN (D. Del.)

*Biogen MA Inc. v. MSN Laboratories Private Limited and MSN Pharmaceuticals Inc.*, No. 1:17-cv-845-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Mylan Pharmaceuticals, Inc.*, No. 1:17-cv-116-IMK (N.D. W. Va.)

*Biogen International GmbH and Biogen MA Inc. v. Pharmathen S.A.*, No. 1:17-cv-855-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Sandoz, Inc. and Princeton Pharmaceutical Inc.*, 1:17-cv-874-MN (D. Del.)

*Biogen MA Inc. v. Shilpa Medicare Limited.*, No. 1:17-cv-847-MN (D. Del.)

*Biogen MA Inc. v. Slayback Pharma LLC and Slayback Pharma India LLP*, No. 1:17-cv-828-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. Torrent Pharmaceuticals Limited and Torrent Pharma Inc.*, No. 1:17-cv-854-MN (D. Del.)

*Biogen International GmbH and Biogen MA Inc. v. TWi Pharmaceuticals Inc. and TWi Pharmaceuticals USA Inc.*, No. 1:17-cv-856-MN (D. Del.)

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