

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN INSTITUTIONAL LLC and PFIZER INC,
Petitioners,

v.

NOVO NORDISK A/S,
Patent Owner.

IPR2020-00324¹

Patent 8,114,833 B2

**PATENT OWNER AND PETITIONER MYLAN INSTITUTIONAL LLC'S
JOINT MOTION TO TERMINATE AS TO PETITIONER MYLAN
INSTITUTIONAL LLC PURSUANT TO 35 U.S.C. § 317**

¹ IPR2020-01252 has been joined with this proceeding.

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner Mylan Institutional LLC (“Mylan”) and Patent Owner Novo Nordisk A/S (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate this proceeding as to Petitioner Mylan.

Petitioner Pfizer Inc. takes no position with respect to this Motion to Terminate.

Mylan and Patent Owner first notified the Board of their settlement on March 26, 2021, and received authorization to file this Motion to Terminate on April 6, 2021.

II. STATEMENT OF FACTS

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

Mylan filed its petition for *inter partes* review on December 19, 2019, and Patent Owner filed a preliminary response on March 30, 2020. On June 23, 2020, the Board instituted this *inter partes* review. Mylan and Patent Owner have settled their dispute and all litigation relating to U.S. Patent No. 8,114,833, and have agreed to move to terminate this *inter partes* review with respect to Mylan.

The agreement settling this matter and all litigation relating to U.S. Patent No. 8,114,833 between Mylan and Patent Owner has been made in writing (the

“Settlement Agreement”), and a true and correct copy will be concurrently filed with the Board as business confidential information pursuant to 35 U.S.C. § 317(b) as Exhibit 2098. There are no collateral agreements. Because the Settlement Agreement is confidential, Mylan 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

The district court litigation involving U.S. Patent No. 8,114,833 between Patent Owner and Mylan, *Novo Nordisk Inc. et al. v. Mylan Institutional LLC*, C.A. No. 19-cv-01551 (D. Del.), was also resolved by the Settlement Agreement. The court ordered the parties’ jointly filed stipulation of dismissal of the district court litigation on April 6, 2021. The other currently-pending district court litigation involving U.S. Patent No. 8,114,833 is *Novo Nordisk Inc. et al. v. Sandoz, Inc.*, Case No. 1:20-cv-00747 (D. Del.).

The other currently-pending *inter partes* review involving U.S. Patent No. 8,114,833 is *Pfizer Inc. v. Novo Nordisk, A/S*, IPR2020-01252, which has been joined with this *inter partes* review. This proceeding will continue with Pfizer Inc. as a petitioner.

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). Here, the Board has not decided the merits of the proceeding. Oral argument occurred only on March 26, 2021, and no final decision on any of the merits of the Petition has issued. Therefore, under 35 U.S.C. § 317, the Board shall terminate Mylan’s involvement in this proceeding upon this joint request of the parties.

For the avoidance of doubt, in other proceedings, the Board has granted motions to terminate, after oral argument and 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 2-4 (P.T.A.B. 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 *Prollenium U.S., Inc. v. Allergan Industrie, SAS*, IPR2019-01505, Paper 70 (P.T.A.B. Feb. 19, 2021) (granting termination after oral argument); *Taiwan Semiconductor Mfg. Co. Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-01862, Paper 39 (P.T.A.B. Jan. 24, 2019) (granting termination of proceeding in view of settlement two months after oral argument); *Volusion, Inc. v. Versata Software, Inc. et al.*, CBM2013-00018, Paper 52 at 2 (P.T.A.B. June 17, 2014) (granting full termination of proceeding after oral argument; “[w]hile 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 (P.T.A.B. 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 as to Mylan 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

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