

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN INSTITUTIONAL LLC and PFIZER INC.,  
Petitioner,

v.

NOVO NORDISK A/S,  
Patent Owner.

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IPR2020-00324<sup>1</sup>  
Patent 8,114,833 B2

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Before ERICA A. FRANKLIN, JOHN G. NEW, and  
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER

Granting Patent Owner and Petitioner Mylan Institutional LLC's Joint  
Motion to Terminate the Proceeding as to Petitioner Mylan  
Institutional LLC and Joint Request to Treat Settlement Documents as  
Business Confidential Information  
*35 U.S.C § 317*

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<sup>1</sup> IPR2020-01252 has been joined with this proceeding.

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On April 7, 2021, with authorization of the Board, Patent Owner and Petitioner Mylan Institutional LLC (“Petitioner Mylan”) filed a joint motion to terminate the proceeding as to Petitioner Mylan only. Paper 66. Patent Owner filed a true copy of their written settlement agreement under seal. Ex. 2098. Additionally, citing to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(c), Patent Owner and Petitioner Mylan filed a joint request that the settlement agreement be treated as business confidential information and kept separate from the file of US Patent No. 8,114,833 B2 (Ex. 1001, “the ’833 patent”). Paper 65.

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 for this proceedings was entered on June 23, 2020. Paper 12. The Decision Granting Petitioner Pfizer Inc.’s Motion for Joinder with this proceeding was entered on December 4, 2020. Paper 33. On March 26, 2021, the parties presented arguments at an oral hearing. Paper 51. In the joint motion, Patent Owner and Petitioner Mylan explain that termination of the proceeding as to Petitioner Mylan is appropriate because Patent Owner and Petitioner Mylan reached a settlement agreement that settles their dispute and all litigation between them that involves the ’833 patent. Paper 66, 1–6. Patent Owner and Petitioner Mylan assert also that the requested termination is appropriate because the Board has not decided the merits of proceeding. *Id.* at 3. In the joint motion,

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Patent Owner and Petitioner Mylan note that “Petitioner Pfizer Inc. takes no position with respect to this Motion to Terminate.” *Id.* at 1.

Although we do not agree with the assertion in the joint motion that the Board has not decided the merits of the proceeding as of the date that the parties filed their motion for termination, such that the proceeding “shall be terminated” as to Petitioner Mylan, *see id.* at 3, we nevertheless agree to such termination based upon the settlement reached by Patent Owner and Petitioner Mylan. Additionally, due to the prior joinder of this proceeding with IPR2020-01252, Pfizer Inc. remains a petitioner in this proceeding after termination as to Petitioner Mylan. Consequently, granting the requested termination as to Petitioner Mylan does not terminate this proceeding. As such, we will proceed to a final written decision. 35 U.S.C. §§ 317(a) and 318(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) (“Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”). As noted above, Patent Owner and Petitioner Mylan have filed a settlement agreement relating to these proceedings. Ex. 2098. In their joint motion, they state that the settlement agreement filed as Exhibit 2098 is a “true and correct copy” and that “[t]here

are no collateral agreements.” Paper 66, 1–2. We understand those statements to mean that Patent Owner and Petitioner Mylan certify that Exhibit 2098 is a true and complete copy of their settlement agreement and that there are no other written or oral agreements or understandings between them that are made in connection with, or in contemplation of, the termination of Petitioner Mylan in the instant proceeding.<sup>2</sup> *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). Based on that understanding, we determine that the parties have satisfied section 317(b).

#### ORDER

In accordance with the foregoing, it is hereby:

ORDERED that the joint motion to terminate the proceeding as to Petitioner Mylan is *granted*;

FURTHER ORDERED that this *inter partes* review is *terminated* as to Petitioner Mylan only, but is not terminated as to Patent Owner or Petitioner Pfizer Inc.; and

FURTHER ORDERED that the joint request that the settlement agreement, Ex. 2098, be treated as business confidential information and kept separate from the file of the involved is *granted*.

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<sup>2</sup> If this understanding is inaccurate, Patent Owner and Petitioner Mylan shall immediately notify the Board in writing.

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