

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC,¹
Petitioner,

v.

NOVO NORDISK A/S,
Patent Owner.

IPR2020-00324²

Patent 8,114,833 B2

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

¹ The proceeding has been terminated as to the original petitioner, Mylan Institutional LLC. Paper 67.

² IPR2020-01252 has been joined with this proceeding. Paper 33.

I. STATEMENT OF RELIEF REQUESTED

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

Petitioner Mylan Institutional LLC (“Mylan”)’s participation in this proceeding was terminated on April 16, 2021. Paper No. 67.

Pfizer and Novo Nordisk first notified the Board of their settlement on April 16, 2021, and received authorization to file this Joint Motion to Terminate on June 17, 2021.

II. STATEMENT OF FACTS

In support of the Joint Motion to Terminate, Pfizer and Novo Nordisk state as follows:

Petitioner Mylan filed IPR2020-00324 on December 19, 2019. The Board instituted Mylan’s petition on June 23, 2020. Pfizer filed its petition for *inter partes* review and a motion for joinder with IPR2020-00324 on July 22, 2020. On December 4, 2020, the Board instituted Pfizer’s *inter partes* review and joined it with IPR2020-00324.

The parties engaged in oral argument on March 26, 2021. See Paper No. 68. At oral argument, Mylan’s counsel informed the Board that Mylan and Novo Nordisk had reached a settlement and would be seeking the Board’s permission to

file a motion to terminate as to Mylan. Paper No. 68 at 53-54. On April 6, 2021, the Board authorized Mylan and Novo Nordisk to file a motion to terminate as to Mylan. On April 7, 2021, Mylan and Novo Nordisk filed a Joint Motion to Terminate as to Mylan. Paper No. 66. The Board terminated Mylan's involvement in this *inter partes* review on April 16, 2021. Paper No. 67. The Board has not yet issued a final written decision in this proceeding; pursuant to 37 C.F.R. § 42.100(c), such a decision is expected by June 23, 2021.

Pfizer and Novo Nordisk have now also settled their dispute concerning U.S. Patent No. 8,114,833, and have agreed to jointly move to terminate this *inter partes* review in full. The agreement settling this matter between Pfizer and Novo Nordisk, dated April 15, 2021 (the "Settlement Agreement") was made in writing, and is being concurrently filed with the Board, pursuant to 35 U.S.C. § 317(b), as Exhibit 2102. Exhibit 2102 is a true and complete copy of the Settlement Agreement, and there are no other written or oral agreements or understandings between Pfizer and Novo Nordisk that are made in connection with, or in contemplation of, the termination of the instant proceeding. Because the Settlement Agreement is confidential, Pfizer and Novo Nordisk 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 is no pending district court litigation involving U.S. Patent No. 8,114,833 between Pfizer and Novo Nordisk.

A district court litigation involving U.S. Patent No. 8,114,833 between Novo Nordisk and Mylan, *Novo Nordisk Inc. et al. v. Mylan Institutional LLC*, C.A. No. 19-cv-01551 (D. Del.), was resolved by the settlement between Novo Nordisk and Mylan discussed above. The district court dismissed that case on April 6, 2021.

Another district court litigation involving U.S. Patent No. 8,114,833 between Novo Nordisk and Teva, *Novo Nordisk Inc. et al. v. Teva Pharms. USA, Inc.*, C.A. No. 17-cv-00227 (D. Del.), was resolved by settlement, and was dismissed on March 18, 2019.

The only pending district court litigation involving U.S. Patent No. 8,114,833 is *Novo Nordisk Inc. et al. v. Sandoz, Inc.*, C.A. No. 1:20-cv-00747 (D. Del.).

There are no other pending *inter partes* reviews involving U.S. Patent No. 8,114,833.

IV. ARGUMENT

Novo Nordisk and Pfizer jointly request that the Board terminate this proceeding in its entirety, under 35 U.S.C. § 317(a), for at least the reasons set forth below.

First, Pfizer is the only remaining petitioner in this proceeding, in which the Board has not yet issued a final written decision. Thus, should the Board terminate Pfizer from the proceeding, no petitioner will remain, and the Board may terminate the review in its entirety. 35 U.S.C. § 317(a). *See, e.g., Nissan North America, Inc. et al. v. BlitzSafe Texas, LLC*, IPR2016-00418, Paper No. 50 at 2 (P.T.A.B. Mar. 10, 2017) (“[A]lthough this proceeding is in a late stage and we have heard oral argument, the Board has not yet issued a Final Written Decision. . . . With the exception of Petitioner. . . and Patent Owner, the Board has terminated all other remaining entities. . . we exercise our discretion to terminate this proceeding in its entirety.”).

Terminating proceedings after settlement, as requested here, 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 terminating a

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