

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

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

FRANKLIN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate the Proceeding and Joint Request to
Treat Settlement Documents as Business Confidential Information
35 U.S.C § 317

¹ This 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.

IPR2020-00324
Patent 8,114,833 B2

With authorization of the Board, Novo Nordisk A/S (“Patent Owner”) and Pfizer Inc. (“Petitioner Pfizer”) filed a joint motion to terminate the proceeding. Paper 77. Patent Owner filed a true copy of their written settlement agreement under seal. Ex. 2102. Additionally, with authorization from the Board, the parties 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 78.

The Decision on Institution for this proceeding was entered on June 23, 2020. Paper 12. The Decision on Institution of IPR2020-01252 and 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. Thereafter, with authorization from the Board, Patent Owner and Petitioner Mylan filed a joint motion to terminate the proceeding as to Petitioner Mylan because they reached an agreement that settled their dispute and all litigation between them involving the ’833 patent. Paper 66, 1–6. As noted in footnote 1, above, we granted the Termination as to Petitioner Mylan on April 16, 2021. Paper 67. On that same date, Petitioner Pfizer and Patent Owner requested authorization to file a motion to terminate the proceeding. We now consider that motion, as well as their joint request to treat their settlement agreement as business confidential information and to keep it separate from the file of the ’833 patent.

The parties assert that their requested termination is appropriate because they have settled their dispute concerning the '833 patent and have agreed to move to terminate this proceeding in full. Mot. 2 (citing Ex. 2102). The parties explain that there is no pending district court litigation between them that involves the '833 patent. *Id.* at 3. Additionally, the parties confirm that the district court litigation between Patent Owner and Mylan involving the '833 patent, i.e., *Novo Nordisk Inc. et al. v. Mylan Institutional LLC*, C.A. No. 19-cv-01551 (D. Del.), was resolved by a settlement between those parties and dismissed by the court on April 6, 2021. *Id.* Further, the parties correctly note that the Board has not issued a final written decision in this proceeding. *Id.*

Having considered the circumstances involved in this proceeding, including the foregoing assertions of the parties, we determine that a termination of the proceeding is appropriate.

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, the parties filed a settlement agreement relating to these proceedings. In their joint motion, they certify that “Exhibit 2102 is a true and complete copy of the Settlement

IPR2020-00324
Patent 8,114,833 B2

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.” Mot. 2. 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 is *granted*;

FURTHER ORDERED that this *inter partes* review is *terminated*;
and

FURTHER ORDERED that the joint request that the settlement agreement, Ex. 2102, be treated as business confidential information and kept separate from the file of the '833 patent is *granted*.

IPR2020-00324
Patent 8,114,833 B2

For PETITIONER PFIZER INC:

Thomas J. Meloro
tmeloro@willkie.com

Michael W. Johnson
mjohnson1@willkie.com

For PATENT OWNER NOVO NORDISK A/S:

Jeffrey Oelke
joelke@fenwick.com

Ryan Johnson
Ryan.johnson@fenwick.com

Laura Moran
Laura.moran@fenwick.com