

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF NEW YORK**

NOVARTIS PHARMA AG, NOVARTIS
PHARMACEUTICALS CORPORATION, and
NOVARTIS TECHNOLOGY LLC,

Plaintiffs,

v.

REGENERON PHARMACEUTICALS, INC.,

Defendant.

Civil Action No.: 1:20-cv-00690 (TJM-CFH)

JURY TRIAL DEMANDED

UNOPPOSED MOTION TO STAY PURSUANT TO 28 U.S.C. § 1659

Defendant Regeneron Pharmaceuticals, Inc. (“Regeneron”) hereby respectfully moves to stay the above-captioned case pursuant to 28 U.S.C. § 1659.¹ Plaintiffs Novartis Pharma AG, Novartis Pharmaceuticals Corporation, and Novartis Technology LLC (collectively, “Novartis”) do not oppose this motion. Support for this motion is found in the accompanying Memorandum of Law and Affidavit of Anish Desai.

¹ By virtue of this motion, Regeneron does not waive, and in fact, expressly reserves, all defenses and procedural rights otherwise available to it.

Dated: July 28, 2020

/s/ Anish Desai

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*Counsel for Defendant Regeneron
Pharmaceuticals, Inc.*

Dated: _____, 2020

SO ORDERED:

Honorable Thomas J. McAvoy, U.S.D.J.

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CERTIFICATE OF SERVICE

I hereby certify that on July 28, 2020, I electronically filed the foregoing UNOPPOSED MOTION TO STAY PURSUANT TO 28 U.S.C. § 1659 with the Clerk of the District Court using the CM/ECF system, which sent notification of such filing upon the counsel of record.

Dated: July 28, 2020

/s/ Anish R. Desai

Anish R. Desai

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**MEMORANDUM OF LAW IN SUPPORT OF UNOPPOSED MOTION TO STAY
PURSUANT TO 28 U.S.C. § 1659**

For the reasons stated below, the Court should grant the motion to stay the above-captioned matter pursuant to 28 U.S.C. § 1659. Plaintiffs Novartis Pharma AG, Novartis Pharmaceuticals Corporation, and Novartis Technology LLC (collectively, “Novartis”) filed this action against Defendant Regeneron Pharmaceuticals, Inc. (“Regeneron”) on June 19, 2020, alleging infringement solely of U.S. Patent No. 9,220,631 (“the ’631 patent”). Also on June 19, 2020, Novartis filed a Complaint in the U.S. International Trade Commission (“ITC”), requesting that the ITC institute an investigation against Regeneron under Section 337 of the Tariff Act of 1930, as amended. In the ITC complaint, Novartis asserted infringement against Regeneron of the same ’631 patent that is at issue in this case.

On July 21, 2020, the ITC issued a notice of institution of the investigation, entitled *Certain Pre-filled Syringes for Intravitreal Injection and Components Thereof*, Investigation No. 337-TA-1207 (“ITC Proceeding”). Pursuant to 19 C.F.R. § 210.10(b), the investigation was

instituted by publication of the Notice of Institution in the Federal Register on July 27, 2020. Exhibit A, Federal Register, Vol. 85, No. 144 at 45,227-45,228. Under Section 1659 of Title 28, upon the request of any party to a civil action that is also a respondent in an ITC proceeding involving the parties in the civil action, the Court “shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission.” 28 U.S.C. § 1659(a). The stay is mandatory and must be granted if it is made within thirty days from the later of: (1) the party being named a respondent in a proceeding before the ITC, or (2) the filing of the district court action. 28 U.S.C. § 1659(a)(1)-(2); *see also In re Princo*, 478 F.3d 1345, 1355 (Fed. Cir. 2007) (granting writ of mandamus and directing district court to stay proceedings pursuant to 28 U.S.C. § 1659(a) until the ITC proceeding became final and was no longer subject to judicial review).

Here, the ITC Proceeding involves the same Defendant as this civil action. *See* Exhibit A, Federal Register, Vol. 85, No. 144 at 45,228. Novartis alleges infringement of only the ’631 patent in both the ITC Proceeding and this civil action. *Id.* As this action involves the same issues as the ITC Proceeding, a stay of this action is required pursuant to 28 U.S.C. § 1659(a). The ITC issued a Notice of Institution of Investigation on July 21, 2020, which was published in the Federal Register on July 27, 2020. Therefore, this motion is timely filed within thirty days of Regeneron being named as a respondent in the ITC Proceeding. Finally, Novartis does not oppose this motion.

For the foregoing reasons, Regeneron respectfully requests that the Court stay this action under 28 U.S.C. § 1659(a) until determination of the ITC Proceeding, including any appeals therefrom, becomes final.

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