

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REGENERON PHARMACEUTICALS, INC.,
Petitioner,

v.

NOVARTIS PHARMA AG, NOVARTIS TECHNOLOGY LLC,
NOVARTIS PHARMACEUTICALS CORPORATION,
Patent Owner.

IPR2020-01318
Patent 9,220,631 B1

Before ERICA A. FRANKLIN, ROBERT L. KINDER, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION

Dismissing the Petition and Terminating the Proceeding
Prior to Institution of Trial
35 U.S.C. § 314

With our authorization, Regeneron Pharmaceuticals, Inc. (“Petitioner”) filed an Unopposed Motion to Terminate this proceeding. Paper 16 (“Mot.” or “Motion”). Petitioner requests that the Petition be dismissed and the proceeding terminated because “granting the motion will preserve the resources of the Board and the parties, and will promote efficiency as contemplated by 37 C.F.R. § 42.1(b).” Mot. 1. In making its Motion, Petitioner asserts that dismissal of the Petition in this proceeding is appropriate because the proceeding is at an early stage, with no decision having yet been made whether to institute trial. Mot. 3–4. Petitioner also contends that dismissal will “save the Board and the parties from devoting any further resources and time to this proceeding,” and “will help achieve 37 C.F.R. § 42.1(b)’s goal of securing the ‘just, speedy, and inexpensive resolution of every proceeding.’” Mot. 4.

Petitioner notes that it filed two petitions for *inter partes* review of U.S. Patent No. 9,220,631 (“the ’631 patent”). Mot. 1. The petitions were docketed as IPR2020-01317 (“the ’1317 IPR”) and IPR2020-01318 (this IPR). *Id.* Petitioner contends that granting this Motion will alleviate the Board from work in this IPR and allow the Board to instead focus its resources on analyzing the issues raised in the ’1317 IPR in determining whether to institute a trial in that proceeding. Mot. 4. Dismissal of this proceeding will not impact the pendency of the ’1317 IPR, according to Petitioner. *Id.*

Novartis Pharma AG, Novartis Technology LLC, and Novartis Pharmaceuticals Corporation (collectively, “Patent Owner”) has indicated that it will not oppose Petitioner’s Motion. Mot. 1 (citing Ex. 1066, correspondence between counsel).

Dismissal of the Petition and termination of the proceeding is appropriate under the present circumstances. *See* 37 C.F.R. § 42.72 (providing authorization to “terminate a trial without rendering a final written decision, where appropriate”). Our “regulations expressly provide the Board with broad authority to dismiss a petition where appropriate.” *Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 at 4 (PTAB Oct. 9, 2018); *see* 37 C.F.R. § 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition or motion.”). We have yet to reach the merits of the Petition and we have not yet issued an institution decision. Thus, the proceeding is at an early stage and it is appropriate to dismiss the Petition and terminate the proceeding to promote efficiency and unnecessary costs. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 (PTAB Dec. 9, 2015) (granting opposed motion to dismiss before institution). Accordingly, we grant Petitioner’s Motion because of the “early juncture” of this proceeding, it is unopposed, and doing so will “promote efficiency and minimize unnecessary costs.” *Id.* at 3–4; Ex. 1066.

It is
ORDERED that Petitioner’s Unopposed Motion to Terminate the Proceeding is *granted*;
FURTHER ORDERED that the Petition (Paper 3) is *dismissed*; and
FURTHER ORDERED that this proceeding is *terminated*.

IPR2020-01318
Patent 9,220,631 B1

PETITIONER:

Elizabeth Weiswasser
Brian Ferguson
Anish Desai
Christopher Pepe
WEIL GOTSHAL & MANGES, LLP
Elizabeth.weiswasser@weil.com
Anish.desai@weil.com
Brian.ferguson@gweil.com
Christopher.pepe@weil.com

PATENT OWNER:

Elizabeth J. Holland
William G. James
Linnea Cipriano
Joshua Weinger
GOODWIN PROCTER LLP
EHolland@goodwinlaw.com
WJames@goodwinlaw.com
LCipriano@goodwinlaw.com
JWeinger@goodwinlaw.com