

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

Case IPR2020-01318
U.S. Patent No. 9,220,631

**PETITIONER'S UNOPPOSED MOTION TO TERMINATE THE
PROCEEDING**

On November 24, 2020, the Board authorized Petitioner Regeneron Pharmaceuticals, Inc. (“Regeneron”) to file a motion to terminate this proceeding (IPR2018-01318) in accordance with 37 C.F.R. §§ 42.71(a) and 42.72. Counsel for Patent Owner Novartis Pharma AG, Novartis Technology LLC, and Novartis Pharmaceuticals Corporation (collectively, “Novartis”) has indicated that Novartis will not oppose this motion. *See* Ex. 1066 (E. Holland 2020-11-20 email).

As explained herein, 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). Regeneron therefore respectfully requests that the Board grant this motion and terminate the proceeding. Regeneron’s co-pending IPR2020-01317, which addresses the same patent as in this proceeding, remains pending and Regeneron respectfully requests that the Board analyze that petition on the merits and institute trial therein.

FACTUAL BACKGROUND

On July 16, 2020, Regeneron filed two petitions for *inter partes* review of U.S. Patent No. 9,220,631 (“the 631 patent”). The petitions were docketed as IPR2020-01317 (“the 1317 IPR”) and IPR2020-01318 (this IPR). As required by the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), Regeneron also submitted a Notice providing, *inter alia*, its ranking of the petitions

in the order in which it wished the Board to consider the merits. *See* Paper 2.

Regeneron ranked the 1317 IPR first, and this IPR second. *Id.*

On October 22, 2020, Novartis filed its Patent Owner Preliminary Response (“POPR”). Paper 10. In addition to making arguments directed to the merits, Novartis asserted that pursuant to 35 U.S.C. §§ 314(a) and 325(d) the Board should exercise its discretion and deny institution.

On November 17, 2020, the Board granted Regeneron’s request to file a reply to the POPR, limited to addressing the 35 U.S.C. §§ 314(a) and 325(d) issues. Paper 14. The Board further authorized Novartis to file a sur-reply brief. *Id.*

On November 20, 2020, Regeneron requested permission from the Board to file the instant motion, and on November 24, 2020 the Board provided authorization for Regeneron to do so. On November 25, 2020, Regeneron filed its Reply Regarding 35 U.S.C. §§ 314(a), 325(d) in the 1317 IPR, but did not file a substantive Reply in this proceeding in light of its anticipated motion to terminate.

LEGAL STANDARDS

37 C.F.R. § 42.5(a) addresses the conduct of IPR proceedings, stating that the Board “may determine a proper course of conduct in a proceeding....” 37 C.F.R. § 42.71(a) provides that the Board “may take up petitions or motion for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.” 37 C.F.R. § 42.72 authorizes the Board to

“terminate a trial without rendering a final written decision, where appropriate....”

The Board has previously relied on these regulations to grant motions to terminate IPRs prior to an institution decision. *See, e.g., Samsung Elec. Co., Ltd. v. Nvidia Corp.*, IPR2015-01270, Paper 11 (PTAB Dec. 9, 2015) (dismissing petition prior to institution pursuant to 37 C.F.R. §§ 42.5(a), 42.71(a)); *see also Facebook, Inc. v. EveryMD.com LLC*, IPR2018-00050, Paper 19 (PTAB Oct. 9, 2018).

ARGUMENT

The regulations identified above “provide the Board with broad authority to dismiss a petition where appropriate....” *Facebook*, Paper 19 at 4. Regeneron respectfully submits that dismissal of this petition and termination of the proceedings is appropriate because the Board has yet to reach the merits of the petition and has not yet issued an institution decision. There are a number of arguments raised in the petition and in the POPR that will require the Board to devote significant resources towards analyzing those issues and determining whether instituting a trial is appropriate. Moreover, if this IPR is not terminated, the Board’s analysis will be further complicated by the need to consider Regeneron’s ranking of petitions (this one and co-pending 1317 IPR), Novartis’s response thereto, and determine whether the facts warrant instituting two proceedings.

Granting Regeneron's instant motion will alleviate the Board from that work. The Board may instead focus its resources on analyzing the issues raised in the 1317 IPR in determining whether to institute a trial in that proceeding.

Granting the motion will thus save the Board and the parties from devoting any further resources and time to this proceeding. This will help achieve 37 C.F.R. § 42.1(b)'s goal of securing the "just, speedy, and inexpensive resolution of every proceeding." *See Samsung*, Paper 11 at 4 (granting pre-institution motion to terminate: "we exercise our discretion and dismiss these petitions under 37 C.F.R. §§ 42.5, 42.71(a), at this early juncture, to promote efficiency and minimize unnecessary costs").

For these reasons, Regeneron respectfully requests that the Board grant its unopposed motion to terminate this proceeding and dismiss the petition. For the sake of clarity, this termination does not impact the pendency of the 1317 IPR, which remains pending.

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