

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Regeneron Pharmaceuticals, Inc.,  
Petitioner,

v.

Novartis Pharma AG,  
Novartis Technology LLC,  
Novartis Pharmaceuticals Corporation,  
Patent Owner

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Case IPR2020-01317  
U.S. Patent No. 9,220,631

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**PETITIONER'S UNOPPOSED MOTION TO WITHDRAW ITS  
REQUEST FOR REHEARING OF THE BOARD'S DECISION  
DENYING *INTER PARTES* REVIEW**

**STATEMENT OF PRECISE RELIEF REQUESTED**

Pursuant to the authorization by the Board granted on April 26, 2021, Petitioner Regeneron Pharmaceuticals, Inc. (“Regeneron”) respectfully moves for withdrawal of its pending Request for Rehearing of the Board’s decision denying institution of *inter partes* review in this proceeding (IPR2020-01317). Counsel for Regeneron conferred with counsel for Patent Owner<sup>1</sup> prior to filing this motion, and Patent Owner does not oppose this motion to withdraw.

**REASONS FOR RELIEF REQUESTED**

On January 15, 2021, the Board issued its Decision Denying Institution of *Inter Partes* Review 35 U.S.C. § 314, 37 C.F.R. § 42.4 (Paper 15) (“Institution Decision”). The Board denied institution under § 314(a) because of the pendency of a parallel International Trade Commission investigation (“the ITC Investigation”) involving U.S. Patent No. 9,220,631 (“the 631 patent”). The Board held that the “outcome of the ITC Investigation will be known months before we could reach a final determination.” Paper 15 at 23. On February 12, 2021, Regeneron filed its Request for Rehearing Pursuant to 37 C.F.R. § 42.71(d) (Paper 16). On that same day, Petitioner requested that the Precedential Opinion Panel

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<sup>1</sup> Novartis Pharma AG, Novartis Technology LLC, and Novartis Pharmaceuticals Corporation (collectively, “Novartis”).

(“POP”) consider Regeneron’s rehearing request. Exhibit 3003. On April 16, 2021, Regeneron requested withdrawal of its request for POP consideration. *See* Ex. 3004. On April 22, 2021, the Board acknowledged that the POP request was withdrawn. *See* Paper 18, *Notification of Withdrawal of Receipt of POP Request*.

On April 7, 2021, Patent Owner filed a motion to terminate the ITC Investigation and withdraw its complaint. The administrative law judge presiding over the ITC Investigation granted Patent Owner’s motion on April 8, 2021. Thus, the basis for the Board’s Institution Decision, and the primary ground on which Regeneron based its Request for Rehearing – the pendency of the parallel ITC Investigation – no longer applies. As such, Regeneron no longer seeks rehearing of the Board’s Institution Decision in this proceeding and submits that withdrawal is appropriate under the circumstances.<sup>2</sup> *See, e.g., Power Integrations, Inc. v. Semiconductor Components Indus., LLC*, IPR2018-00399, Paper 12 (PTAB March 20, 2019) (granting motion to withdraw request for rehearing and ordering that the “Decision Denying Institution remains in effect”); *Hospitality Core Services LLC v. Nomadix, Inc.*, IPR2016-0052, IPR2016-00073, Paper 11 (PTAB June 21, 2016)

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<sup>2</sup> With the withdrawal of the ITC complaint, Regeneron has filed a new petition for *inter partes* review of the 631 patent (IPR2021-00816).

(granting motion to withdraw request for rehearing and holding that the Board “will not issue any decision in response” to the request).

**CONCLUSION**

Based on the foregoing, Regeneron respectfully requests withdrawal of its Request for Rehearing of the Board’s Institution Decision.

Dated: April 27, 2021

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on April 27, 2021, the foregoing

**PETITIONER'S UNOPPOSED MOTION TO WITHDRAW ITS REQUEST**

**FOR REHEARING OF THE BOARD'S DECISION DENYING *INTER***

***PARTES REVIEW*** was served via electronic mail upon the following:

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