

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC, Petitioner,

v.

NOVO NORDISK A/S, Patent Owner.

Case No. IPR2022-00657

Patent No. 8,114,833

**NOVO NORDISK A/S AND FRESENIUS KABI USA,
LLC'S JOINT MOTION TO TERMINATE**

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, Petitioner Fresenius Kabi USA, LLC (“Petitioner”) and Patent Owner Novo Nordisk A/S (“Patent Owner”) jointly request termination of IPR2022-00657, which is directed to U.S. Patent No. 8,114,833.

Petitioner and Patent Owner notified the Board of their settlement on September 1, 2022 and received authorization to file this Motion to Terminate on September 2, 2022. The parties are filing this Motion in advance of the deadline of September 8, 2022 set by the Board.

II. STATEMENT OF FACTS

In support of the Motion to Terminate, Petitioner and Patent Owner state as follows:

Petitioner filed its petition for *inter partes* review on March 3, 2022. The Board has not yet issued a decision on institution. Petitioner and Patent Owner have settled their dispute relating to U.S. Patent No. 8,114,833. As part of their settlement, the parties agreed to move to terminate this proceeding.

The Settlement Agreements between Petitioner and Patent Owner have been made in writing, and true and correct copies will be concurrently filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37

C.F.R. § 42.74 as Exhibits 2007 and 2008. There are no collateral agreements. Because the Settlement Agreements are confidential, Petitioner and Patent Owner respectfully request that they be treated as business confidential information, be kept separate from the underlying patent file, and be made available only in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c). The parties have filed herewith a separate paper setting forth this request for treatment of the Settlement Agreements as business confidential information.

III. RELATED LITIGATION

U.S. Patent No. 8,114,833 is currently being asserted in the following litigations: *Novo Nordisk Inc. v. Mylan Pharmaceuticals, Inc.*, 1:22-cv-00023 (N.D.W. Va.)¹; *Novo Nordisk Inc. v. Teva Pharmaceuticals, Inc.*, 1:21-cv-01782 (D. Del.); *Novo Nordisk Inc. v. Hikma Pharmaceuticals USA, Inc.*, 1:21-cv-01783 (D. Del.); *Novo Nordisk Inc. v. Orbicular Pharmaceutical Technologies Pvt. Ltd.*, 1:22-cv-00856 (D. Del.); *Novo Nordisk Inc. v. Sun Pharmaceutical Industries Ltd.*, 1:22-cv-00896 (D. Del.); *Novo Nordisk Inc. v. Sun Pharmaceutical Industries Ltd.*, 1:22-cv-00897 (D. Del.); *Novo Nordisk Inc. v. Biocon Pharma Ltd*, 1:22-cv-00936 (D. Del.); and *Novo Nordisk Inc. v. Biocon Pharma Ltd*, 1:22-cv-00937. (D. Del.).

¹ Consolidated for all pretrial purposes in *In Re: Ozempic (Semaglutide) Patent Litigation*, MDL No. 22-MD-3038 (CFC).

IV. ARGUMENT

The statutory provision on a settlement relating to *inter partes* reviews provides that an *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). Here, termination is appropriate because the parties have settled their dispute, the Board has not decided whether to institute an *inter partes* review, and the Board has not decided the merits of the proceeding.

The Board has stated its expectation that proceedings such as this will be terminated after the filing of a settlement agreement: “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board *expects that a proceeding will terminate after the filing of a settlement agreement*, unless the Board has already decided the merits of the proceeding.” PTAB Consolidated Trial Practice Guide November 2019, at 86 (emphasis added) (citing 35 U.S.C. 317(a)); *see also* 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (same); *Petroleum Geo- Services Inc. v. WesternGeco LLC*, IPR2016-00407, Paper 29 at 3 (P.T.A.B. July 5, 2017) (“Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement.”). A termination of the proceeding will conserve the Board’s resources and obviate the need for any more Board involvement in this matter.

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V. CONCLUSION

In light of the foregoing, Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate IPR2022-00657 and grant the request to treat the Settlement Agreements between the parties as business confidential information. Petitioner and Patent Owner are available at the Board's convenience to discuss these related matters in more detail or answer any additional questions raised by this joint motion.

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