

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC AND FRESENIUS KABI SWISSBIOSIM
GmbH.,
Petitioners

v.

AMGEN INC. and AMGEN MANUFACTURING, LIMITED,
Patent Owners

Case IPR2020-00314
Patent 9,856,287

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, the parties jointly request termination of IPR2020-00314 concerning U.S. Patent No. 9,856,287 ("the '287 patent").

The parties notified the Board of the parties' settlement on June 12, 2020 and received authorization to file this Motion to Terminate on June 15, 2020.

II. STATEMENT OF FACTS

In support of the Motion to Terminate Proceeding, the parties state as follows:

Petitioners filed their petition for *inter partes* review on December 20, 2019. No institution decision has issued.

Petitioners and Patent Owner have settled their dispute relating to the '287 patent. The parties also agreed to move to terminate this *inter partes* review.

The parties' Settlement Agreement has been made in writing, and a true and correct copy will be concurrently filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) as Exhibit 1048. Except to the extent specifically referenced and filed with, or reduced to writing in, the Settlement Agreement, there are no collateral agreements. Because the settlement agreement is confidential, Petitioners and Patent Owner respectfully request that it be treated as business confidential information, be kept separate from the underlying patent

file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and have filed herewith a separate paper setting forth this request.

III. RELATED LITIGATION

There are no currently pending litigations involving the '287 patent. The past litigation involving the '287 patent is as follows: *Amgen Inc. et al. v. Accord Biopharma*, Case No. 0:18-cv-61828-WPD (S.D. Fla.) (stipulated dismissal approved Nov. 15, 2019); *Amgen Inc. et al. v. Kashiv BioSciences, LLC et al.*, Case No. 2:18-cv-03347-CCC-MF (D.N.J.) (stipulated dismissal so-ordered Nov. 25, 2019); and *Amgen Inc. et al. v. Tanvex BioPharma USA, Inc. et al.*, Case No. 3:19-cv-01374-H-AHG (S.D. Cal.) (joint motion to dismiss granted Dec. 19, 2019).

An IPR and a PGR were previously filed against the '287 patent, but neither is currently pending. The first (PGR2019-00001) was terminated on December 6, 2019 and the second (IPR2019-00971) was not instituted.

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. Because the Board has not decided the merits of this

inter partes review proceeding, and because the parties here are jointly requesting termination, the Board should terminate the Petitioners under § 317(a).

Section 317(a) also provides that, "[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)." *Id.* This proceeding has not been instituted, and termination would save additional expenditure of resources by the Board, as well as by Patent Owner, and would further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes (including by encouraging settlement). The Board has routinely terminated proceedings at the request of settling parties in cases that have progressed much further than the present proceeding. *See, e.g., Apex Med. Corp. v. Resmed Ltd.*, IPR2013-00512, Pap. 39, 2 (Sept. 12, 2014) (granting motion to terminate in its entirety notwithstanding that instituted proceeding was fully briefed); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00018, Pap. 52, 2-3 (June 17, 2014) (granting motion to terminate instituted proceeding in its entirety after final oral hearing); *see also ARM, Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-00527, Pap. 10, 2-3 (May 12, 2017) (granting motion to terminate in its entirety after preliminary response but prior to institution). Indeed, the Board has stated an *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. 35 U.S.C. § 317(a), as amended. . . ." Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (emphasis added). For at least the reasons noted above, the Board's expectation that such proceedings should be terminated is proper and well justified here.

V. CONCLUSION

For the foregoing reasons, Petitioners and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate IPR2020-00314.

Dated: June 18, 2020

Respectfully submitted by:

/Huiya Wu/

/Megan Raymond/

Huiya Wu (Reg. No. 44,411)
Robert V. Cerwinski
Linnea Cipriano
James Breen
GOODWIN PROCTER LLP
620 Eighth Avenue
New York, NY 10018
hwu@goodwinlaw.com
DG-FK287@goodwinlaw.com
rcerwinski@goodwinlaw.com
lcipriano@goodwinlaw.com
jamesbreen@goodwinlaw.com

Megan Raymond (Reg. No. 72,997)
J. Steven Baughman (Reg. No. 47,414)
PAUL, WEISS, RIFKIND, WHARTON
& GARRISON LLP
2001 K Street, NW
Washington, DC 20006-1047
mraymond@paulweiss.com
sbaughman@paulweiss.com

Attorneys For Patent Owner

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.