

Filed On Behalf Of:

Alnylam Pharmaceuticals, Inc.

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALNYLAM PHARMACEUTICALS, INC.,
Petitioner,
v.
SILENCE THERAPEUTICS GMBH,
Patent Owner.

Case PGR2018-00059
U.S. Patent No. 9,695,423

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 327(a)

Pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74, Petitioner Alnylam Pharmaceuticals, Inc. and its wholly owned subsidiary Alnylam U.S., Inc. (collectively, “Alnylam” or “Petitioner”) and Patent Owner Silence Therapeutics GmbH (“Patent Owner”) jointly and respectfully request termination of PGR2018-00059, which is directed to U.S. Patent No. 9,695,423 (the “’423 patent”), due to settlement between Petitioner and Patent Owner. The Board authorized the parties to file this motion by e-mail on December 17, 2018.

I. Brief Explanation as to Why Termination Is Appropriate

On April 2, 2018, Petitioner filed its petition for post-grant review of the ’423 patent (Paper No. 2). On April 16, 2018, the Board issued a Notice of Filing Date Accorded to Petition (Paper No. 4). Patent Owner filed its Preliminary Response on July 16, 2018 (Paper No. 7). On October 10, 2018, the Board issued a Decision Denying Institution of Post-Grant Review (Paper No. 9). On November 2, 2018, Petitioner filed its Request for Rehearing (Paper No. 11) (pending). On December 9, 2018, Petitioner and Patent Owner reached a settlement that resolves all disputes between them with respect to this proceeding and the parties’ related district court litigation. A Stipulation and Order of Dismissal agreed to by the parties in the related district court litigation has been filed in the district court.

Pursuant to 37 C.F.R. § 42.74(b), the parties’ confidential settlement

agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1064. The parties are also filing concurrently herewith a joint request to treat the confidential settlement agreement as business confidential information and keep it separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c) and 35 U.S.C. § 327(b). The parties hereby certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

Termination of this proceeding is proper under 35 U.S.C. § 327(a) because the Board has not issued a final written decision and thus, has not yet decided the ultimate merits of this proceeding. Accordingly, Petitioner and Patent Owner respectfully request that the Board terminate PGR2018-00059, due to settlement between Petitioner and Patent Owner.

II. Related Litigations Involving The Patent At Issue

The only related litigation involving the patent at issue in this proceeding is *Alnylam Pharmaceuticals, Inc. v. Silence Therapeutics PLC*, No. 1:18-cv-10613-MLW (D. Mass. filed Mar. 29, 2018). The complaint in that case was filed in the United States District Court for the District of Massachusetts on March 29, 2018. The parties to that litigation are: Petitioner Alnylam Pharmaceuticals, Inc. as the plaintiff; and Patent Owner Silence Therapeutics GmbH and its exclusive licensee,

Silence Therapeutics plc, as the defendants. The parties to that litigation have filed a Stipulation and Order of Dismissal in the district court to discontinue that action.

III. Related Proceedings Currently Before the Patent Office

There are no other related proceedings before the Patent Office involving the patent at issue. Petitioner and Patent Owner are likewise concurrently filing similar motions to terminate with respect to Case Nos. PGR2018-00067 (U.S. Patent No. 9,758,784), PGR2018-00075 (U.S. Patent No. 9,783,802), PGR2018-00088 (U.S. Patent No. 9,790,505) and PGR2018-00089 (U.S. Patent No. 9,790,501).

IV. Conclusion

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this post-grant review of the '423 patent.

Dated: December 18, 2018

Respectfully submitted,

/s/ Scott K. Reed

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Dated: December 18, 2018

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