

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADELLO BIOLOGICS, LLC,
Petitioner,

v.

AMGEN INC. and AMGEN MANUFACTURING, LIMITED,
Patent Owners.

Case PGR2019-00001
Patent 9,856,287

**PETITIONER ADELLO BIOLOGICS, LLC'S AND PATENT OWNERS'
JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 327**

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. §327(a) and 37 C.F.R. §42.72, Petitioner Adello Biologics, LLC (“Petitioner Adello”) and Patent Owners Amgen Inc. and Amgen Manufacturing Limited (together, “Patent Owners”) jointly request termination of Petitioner Adello from PGR2019-00001 concerning U.S. Patent No. 9,856,287 (the ’287 patent”). In addition, the parties request that this proceeding be terminated in its entirety.

Petitioner Adello and Patent Owners notified the Board of their settlement on November 22, 2019 and received authorization to file this joint motion to terminate on November 25, 2019.

II. STATEMENT OF FACTS

In support of the Motion to Terminate Proceeding, Petitioner Adello and Patent Owners state as follows:

Petitioner Adello together with co-petitioner Apotex filed a petition for post-grant review on October 1, 2018. Patent Owners filed a preliminary response on January 23, 2019. On April 19, 2019, the Board instituted this post-grant review. Pap. 13. Patent Owners filed a Patent Owner Response on July 26, 2019. Co-petitioner Apotex filed an unopposed motion for adverse judgment August 8, 2019 against itself. Pap. 21. As noted in that motion, Petitioner Adello was to remain as

the sole Petitioner in the proceeding. *Id.* That motion was granted on October 4, 2019. Pap. 23.

Petitioner Adello and Patent Owners have settled their dispute and all litigation relating to the '287 patent. Petitioner Adello and Patent Owners also agreed to move to terminate this post-grant 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. §327(b) as Exhibit 1052. 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, Petitioner Adello and Patent Owners 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. §327(b) and 37 C.F.R. §42.74(c), and have filed herewith a separate paper setting forth this request.

III. RELATED LITIGATION

The following currently pending district court litigations involve the '287 patent: Amgen Inc. and Amgen Manufacturing, Limited v. Tanvex BioPharma USA, Inc., Tanvex BioPharma, Inc., and Tanvex Biologics Corp., Case No. 3:19-

cv-01374-H-AHG (Southern District of California), which was filed July 23, 2019 and remains pending as to all parties.

The following concluded district court litigations involved the '287 patent: Amgen Inc. and Amgen Manufacturing, Limited v. Accord BioPharma, Case No. 0:18-cv-61828-WPD (Southern District of Florida), which was filed August 7, 2018 and dismissed on November 14, 2019; and Amgen Inc. and Amgen Manufacturing, Limited. v. Kashiv BioSciences, LLC, Amneal Pharmaceuticals LLC, and Amneal Pharmaceuticals, Inc., Case No. 2:18-cv-03347 (District of New Jersey), which was filed March 8, 2018, and dismissed on November 26, 2019.

There is one other PTAB proceeding involving this patent, IPR2019-00971, which was denied institution on October 16, 2019. IPR2019-00971, Paper 13.

IV. ARGUMENT

This proceeding should be terminated with respect to Petitioner Adello.

The statutory provision on a settlement relating to post-grant reviews provides that a post-grant 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. § 327(a). Because the Board has not decided the merits of this post grant review proceeding, and because Petitioner Adello and Patent Owners are jointly

requesting termination, the Board should terminate Petitioner Adello under §327(a).

Petitioner Adello and Patent Owners request this proceeding be terminated in its entirety. Section 327(a) provides that, “[i]f no petitioner remains in the post-grant review, the Office may terminate the review or proceed to a final written decision under section 328(a).” *Id.* This proceeding was recently instituted, and termination would save additional expenditure of resources by the Board, as well as by Patent Owner, and would further the purpose of post-grant 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).

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*

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.