Trials@uspto.gov
Tel: 571-272-7822

Paper 16
Entered: October 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REGENERON PHARMACEUTICALS, INC.,
Petitioner,

v.

NOVARTIS VACCINES AND DIAGNOSTICS, INC.,
GRIFOLS WORLDWIDE OPERATIONS LIMITED,
Patent Owner.

Case No. IPR2019-01086
Patent 5,688,688

Before SHERIDAN K. SNEDDEN, CHRISTOPHER L. CRUMBLY, and ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

On September 26, 2019, and pursuant to our authorization, Petitioner Regeneron Pharmaceuticals, Inc. filed a "Joint Motion to Terminate under 35 U.S.C § 317(a) and 37 C.F.R. § 42.72" signed by counsel for both parties. Paper 15. The Motion requests that we "terminate this IPR proceeding in view of the District Court's September 5, 2019 Judgment of Noninfringement and Order of Dismissal." *Id.* at 2 (citing Ex. 1048, 3). The parties explain that in the copending litigation, *Novartis Vaccines and Diagnostics, Inc., et al. v. Regeneron Pharmaceuticals, Inc.*, No. 18-cv-02434-DLC, the U.S. District Court for the Southern District of New York entered judgment of non-infringement for all claims of the '688 Patent and dismissed the parties' claims and counterclaims. *Id.* at 1–2 (citing Ex. 1048, 1–2). In the Judgment of Noninfringement and Order of Dismissal, the District Court further stated that "Regeneron shall request to terminate" the instant Petition, and "[t]he parties shall cooperate as necessary to make any necessary filings with the Board in connection therewith." Ex. 1048, 3.

According to the parties, termination of this IPR proceeding is appropriate as it "will conserve Board resources." Paper 15, 2–3. In addition, "[t]here is no settlement agreement to submit, and other than the District Court litigation mentioned above, there are no other pending cases or proceedings involving the '688 Patent that would be affected by the termination of this proceeding." *Id.* at 3.

This proceeding is in its initial stages and the Board has not yet decided the merits of the Petition. Because no *inter partes* review has been instituted, the termination Order sought in the Motion is not the most appropriate remedy. We instead construe Paper 15 as a joint request to dismiss the petition, which we find appropriate under the circumstances

before us. *See* 35 U.S.C. § 314; 37 C.F.R. §§ 42.5(a), 42.71(a).

Accordingly, based on the foregoing, it is

ORDERED that the Petition is dismissed;

FURTHER ORDERED that no trial is instituted, and

FURTHER ORDERED that this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

For PETITIONER:

Irena Royzman
Hannah Lee
Kramer Levin Naftalis & Frankel LLP
iroyzman@kramerlevin.com
hlee@kramerlevin.com

For PATENT OWNER:

Deanne Mazzochi
Paul Molino
Matthew Anderson
dmazzochi@rmmslegal.com
paul@rmmslegal.com
manderson@rmmslegal.com