Filed on behalf of: Celltrion, Inc.
By: Lora M. Green (lgreen@geminilaw.com)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLTRION, INC.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

Case No. IPR2023-00462
Patent No. 10,464,992

UNOPPOSED MOTION TO STAY *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 10,464,992

As authorized in a telephonic call with the Board on August 4, 2023, Petitioner Celltrion, Inc. hereby moves to stay the Request for *Ex Parte* Reexamination of U.S. Patent No. 10,464,992 ("the '992 Patent"), Control No. 90/014,448, filed on February 11, 2020 (the "Reexamination"). Patent Owner has indicated that it will not oppose this motion.

I. Legal Standard

The Director has authorization to stay *ex parte* reexamination proceedings when co-pending with *inter partes* review proceedings. 35 U.S.C. 315(d). This authorization has been extended to the Board. 37 C.F.R. 42.122(a) ("Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter."); *see also* PTAB Consolidated Trial Practice Guide (November 2019), 3-4.

The Board will grant a stay of a co-pending reexamination proceeding for good cause. Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16656 (April 22, 2019). Such good cause may exist where an ongoing AIA proceeding, such as *inter partes* review, addresses the same claims of a patent at issue in another overlapping Office proceeding, such as a reexamination. *Id.*

In deciding whether to grant a stay of a co-pending reexamination proceeding, the Board may consider several factors, including:

(i) whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding;

(ii) whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;

(iii) whether the concurrent parallel Office proceeding will duplicate efforts within the Office;

(iv) whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (*e.g.*, whether substantially similar issues are presented in the concurrent parallel Office proceeding);

(v) whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;

(vi) the respective timeline and stage of each proceeding;

(vii) the statutory deadlines of the respective proceedings; and

(viii) whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Id., 16657.

II. Factual Background

The Reexamination was filed on February 11, 2020, by a third-party Requester. The Requester asked for reexamination of all claims (claims 1-18) of the '992 Patent. Control No. 90/014,448, February 20, 2011, Request for Reexamination ("Request"), 1. The Request submitted three Substantial New Questions of patentability pursuant to 37 C.F.R. 1.510(b)(1), alleging obviousness-type double patenting over three different earlier-expiring Regeneron patents (U.S. Patent Nos. 7,608,261; 9,340,594, and 9,580,489), optionally in view of additional prior art. *Id*., 13-17. Reexamination was ordered on April 1, 2020. Control No. 90/014,448, April 1, 2020, Office Action. On May 29, 2020, Patent Owner filed a petition to the Director requesting that the *ex parte* reexamination order be vacated, or in the alternative, stayed. Control No. 90/014,448, May 29, 2020, Petition to Vacate *Ex Parte* Reexamination Order on, in the Alternative, to Stay the Reexamination Proceeding Pursuant to 37 C.F.R. §§ 1.182 and 1.182. Patent Owner's petition was dismissed on September 30, 2021. Control No. 90/014,448, September 30, 2021, Decision on Petition Under 37 C.F.R. § 1.181. On November 24, 2021, Patent Owner asked for reconsideration of that decision. Control No. 90/014,448, November 24, 2021, Petition for Reconsideration. Apart from an IDS filed in March of 2023 by Patent Owner in conjunction with a Notice of

Concurrent Proceedings, there has been no other movement on the reexamination docket.

III. Argument

When weighing the factors that the Board may consider when contemplating a stay, good cause exists to stay the co-pending reexamination. Those factors are either neutral, or support staying the co-pending reexamination.

The claims challenged in the instant IPR and in the co-pending Reexamination are identical – both Office proceedings involve all of the claims of the ’992 patent. Accordingly, continuing with both proceedings would duplicate efforts by the Office and may lead to inconsistent results. *See CBS Interactive Inc. v. Helferich Patent Licensing, LLC.*, IPR2013–00033, Paper 15 (P.T.A.B. Nov. 6, 2012), 2; *Sienna Biopharms., Inc. v. William Marsh Rice University*, IPR2017-00045, Paper 22 (P.T.A.B. June 23, 2017), 3 (the Board exercising discretion to stay an *ex parte* reexamination that concerned the same claims as an IPR that had been instituted but had not yet reached a final written decision). Specifically, since all of the claims of the ’992 patent are at issue, a motion to amend claims by Patent Owner in the Reexamination could change the scope of the challenged claims during the pendency of the IPR, giving the Board and Petitioner a moving target. *See CBS Interactive*, 2; *Sienna Biopharms*, 3. While the same grounds of unpatentability are not raised between the two proceedings (as the Reexamination

deals with obviousness-type double patenting), the same prior art is at issue in both proceedings. For example, the *'319 Publication* (EX1029) is discussed in both the Petition and in the Reexamination. *See, e.g.*, Request, 5-6. Moreover, while the Reexamination has been pending since 2020, there has been little movement on that docket – prior to Patent Owner filing an IDS with references in March 2023, there had been no other movement on that docket since November of 2021. A decision in this IPR is expected relatively quickly – within twelve months of institution, and would likely simplify the results of the reexamination. *CBS Interactive*, 3.

IV. Conclusion

For the foregoing reasons, Petitioner requests that the co-pending Reexamination, Control No. 90/014,448, be stayed pending the resolution of this IPR.

Respectfully submitted,

Dated: August 11, 2023

/ Lora M. Green /
Lora M. Green, Lead Counsel
Reg. No. 43,541

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), this is to certify that I caused to be served a true and correct copy of the foregoing Motion to Stay Reexamination on this 11th day of August, 2023, on the Patent Owner via email (by agreement) to the following counsel of record:

Adam R. Brausa, Reg. No. 60,287
Rebecca Weires, Reg. No. 77,895
Daralyn J. Durie (to be admitted *pro hac vice)*
Kira A. Davis (to be admitted *pro hac vice)*

Respectfully submitted,

Dated: August 11, 2023

/ Lora M. Green /
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