

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLTRION, INC.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

IPR2023-00462
Patent 10,464,992 B2

Before JOHN G. NEW, SUSAN L. C. MITCHELL, and JAMIE T. WISZ,
Administrative Patent Judges.

WISZ, *Administrative Patent Judge.*

ORDER
Granting Motion to Stay *Ex Parte* Reexamination of
U.S. Patent No. 10,464,992
35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

I. INTRODUCTION

On January 17, 2023, Celltrion, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–18 of U.S. Patent No. 10,464,992 (Ex. 1001, “the ’992 patent”). Regeneron Pharmaceuticals, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With Board authorization, Petitioner filed a Pre-Institution Reply (Paper 9, “Reply”), and Patent Owner filed a Sur-Reply (Paper 10, “Sur-Reply”). On July 20, 2023, we instituted *inter partes* review as to all challenged claims of the ’992 patent. *See* Paper 11.

On February 11, 2020, a third-party Requester filed a Request for *Ex Parte* Reexamination of claims 1–18 of the ’992 patent. Ex. 3001. On April 1, 2020, this request was granted in Reexamination Control No. 90/014,448 (“the ’448 Reexamination Proceeding”). Ex. 3002. Petitioner filed an Unopposed Motion to Stay *Ex Parte* Reexamination of U.S. Patent No. 10,464,992 on August 11, 2023 (Paper 14, “Motion”).

The Board has authority to stay a reexamination involving a patent challenged in an *inter partes* review. 37 C.F.R. § 42.122(a) (2019); *see also* 35 U.S.C. § 315(d) (2012). For the reasons discussed below, we determine that there is good cause to stay the ’448 Reexamination Proceeding.

II. ANALYSIS

Office guidance outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. *See* Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (“Notice Regarding Amendment Options”). We discuss each of those factors below.

A. 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

All claims challenged in this proceeding are subject to reexamination in the '448 Reexamination Proceeding. Ex. 3002. This factor favors a stay.

B. Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings

Although the same grounds of unpatentability are not raised in both proceedings (because the Reexamination deals with obviousness-type double patenting), there is an overlap of prior art in both proceedings. Motion 4–5. For example, the '319 publication (Ex. 1029)¹ is one of the references relied on in Ground 2 of the Petition and is also discussed by the Examiner in the '448 Reexamination Proceeding as art which forms the basis of a substantial new question of patentability. See Pet. 41; Ex. 3002, 4–9. This factor favors a stay.

C. Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Because all of the same claims and some of the prior art we are considering in this proceeding are also at issue in the '448 Reexamination Proceeding, allowing both to proceed concurrently would duplicate efforts. This factor favors a stay.

¹ Papadopoulos et al., WO 00/75319 A1, published Dec. 14, 2000 (Ex. 1029, “the '319 publication”).

D. 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)

The '448 Reexamination Proceeding is considering the same claims and some of the same prior art as we are considering in this trial, which raises the possibility of inconsistent results. This factor favors a stay.

E. Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

The '448 Reexamination Proceeding is considering the same claims as we are considering in this trial, and Patent Owner may respond with an amendment that would affect their scope. This factor favors a stay.

F. The respective timeline and stage of each proceeding

In the '448 Reexamination Proceeding, the Examiner granted the request for reexamination on April 1, 2020, but has not yet issued an 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. Patent Owner's petition was dismissed on September 30, 2021. On November 24, 2021, Patent Owner asked for reconsideration of that decision, which was dismissed on August 24, 2023.

In this proceeding, we entered a decision granting institution on July 20, 2023. Paper 11. Thus, in both proceedings, the Office has invested some resources, but a significant amount of work remains in each. This factor is neutral.

G. The statutory deadlines of the respective proceedings

This proceeding is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11) (2012). The '448 Reexamination Proceeding is

required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305 (2012). This factor favors a stay.

H. Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot

A determination in this proceeding regarding the patentability of the challenged claims in view of the cited references would likely simplify the issues in the ’448 Reexamination Proceeding, which is also considering those claims and some of the same prior art. This factor favors a stay.

III. CONCLUSION

For the foregoing reasons, we find that Petitioner has shown good cause for staying the ’448 Reexamination Proceeding pending resolution of this IPR. *See* Notice Regarding Amendment Options, 84 Fed. Reg. at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Unopposed Motion to Stay *Ex Parte* Reexamination of U.S. Patent No. 10,464,992 is *granted*;

FURTHER ORDERED that Reexamination Control No. 90/014,448 is stayed, pending the termination or completion of IPR2023-00462;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/014,448 are tolled for the duration of the stay, and no further papers shall be filed in the reexamination while this stay remains in place; and

FURTHER ORDERED that the time periods for filing further papers in Reexamination Control No. 90/014,448 will be restarted when the stay is lifted.

IPR2023-00462
Patent 10,464,992 B2

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