

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., DR. REDDY'S LABORATORIES,
INC. DR. REDDY'S LABORATORIES, LTD., SUN PHARMACEUTICAL
INDUSTRIES LTD., SUN PHARMACEUTICAL INDUSTRIES, INC., AND
APOTEX, INC.
Petitioner

v.

NOVO NORDISK A/S,
Patent Owner

Case IPR2023-00724¹
Patent 10,335,462

**PETITIONER DR. REDDY'S LABORATORIES, LTD.'S AND PATENT
OWNER'S JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. §317**

¹ IPR2024-00009 (Dr. Reddy's Laboratories), IPR2024-00107 (Sun
Pharmaceutical Industries), and IPR2024-00631 (Apotex Inc.) have been joined
with this proceeding.

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. §317(a) and 37 C.F.R. §42.72, Petitioner Dr. Reddy's Laboratories, Ltd. ("DRL") and Patent Owner Novo Nordisk A/S ("Novo") jointly request termination of DRL from IPR2023-00724 concerning U.S. Patent No. 10,335,462 ("the '462 patent"), and further jointly request termination of this proceeding in its entirety.

DRL and Novo notified the Board of their settlement on October 8, 2024, and received authorization to file this joint motion to terminate on October 8, 2024.

Novo and Petitioner Mylan Pharmaceuticals Inc. ("Mylan") notified the Board of their settlement on October 2, 2024, and filed a joint motion to terminate Mylan from this proceeding on October 4, 2024. Pap.103.

Novo and Petitioners Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc. (together, "Sun") notified the Board of their settlement on October 7, 2024, and filed a joint motion to terminate Sun from this proceeding on October 7, 2024. Pap.107.

Novo and Petitioner Apotex, Inc. ("Apotex") notified the Board of their settlement on October 7, 2024, and filed a joint motion to terminate Apotex from this proceeding on October 7, 2024. Pap.110.

II. STATEMENT OF FACTS

In support of the Motion to Terminate Proceeding, DRL and Novo state as follows:

Mylan filed a petition for *inter partes* review on March 16, 2023. Novo filed a preliminary response on July 6, 2023, and Mylan filed a reply on August 10, 2023. On October 4, 2023, the Board instituted *inter partes* review. Pap.10. On January 17, 2024, Novo filed a response, on May 22, 2024, Mylan filed a reply, and on August 5, 2024, Novo filed a sur-reply. On August 16, 2024, Novo filed a motion for sanctions and a motion for additional discovery. Pap.70, 71. On October 4, 2024 Novo and Mylan filed a joint motion to terminate Mylan from this proceeding and to terminate Novo's motion for sanctions and motion for additional discovery. Pap.103. An oral hearing was held on October 8, 2024, and the merits of this *inter partes* review have not been decided.

Sun filed a petition for *inter partes* review on November 2, 2023 (IPR2024-00107), and Novo filed a preliminary response on February 29, 2024. On May 28, 2024, the Board instituted Sun's *inter partes* review and joined it to this IPR, IPR2023-00724, where Mylan is the original petitioner. IPR2024-00107, Pap. 16. On October 7, 2024, Novo and Sun filed a joint motion to terminate Sun from this proceeding. Pap.107. An oral hearing was held on October 8, 2024, and the merits of IPR2023-00724 have not been decided.

Apotex filed a petition for *inter partes* review and a motion for joinder on March 1, 2024, Novo filed an opposition to Apotex's motion for joinder on April 1, 2024, Apotex filed a reply in support of its motion for joinder on April 15, 2024, Novo filed a preliminary response on June 12, 2024, Apotex filed a reply to Novo's preliminary response on July 1, 2024, and Novo filed a sur-reply on July 15, 2024. On September 11, 2024, the Board instituted *inter partes* review and joined the proceeding to IPR2023-00724. IPR2024-00631, Pap.22; IPR2024-00631, Pap.23. On October 7, 2024, Novo and Apotex filed a joint motion to terminate Apotex from this proceeding. Pap.110. An oral hearing was held on October 8, 2024, and the merits of IPR2023-00724 have not been decided.

DRL filed a petition for *inter partes* review on October 20, 2023 (IPR2024-00009), and Novo filed a preliminary response on January 26, 2024. On April 25, 2024, the Board instituted DRL's *inter partes* review and joined it to this IPR, IPR2023-00724, where Mylan is the original petitioner. IPR2024-00009, Pap. 16. An oral hearing was held on October 8, 2024, and the merits of IPR2023-00724 have not been decided.

Novo and all petitioners have settled their dispute relating to the '462 patent and related patents, all petitioners have requested termination (Pap.103, 107, 110).

The parties' Settlement Agreements have been made in writing, and a true and correct copy of each Agreement has previously been filed with this Office as

business confidential information pursuant to 35 U.S.C. §317(b) as Exhibits 2666-2668. There are no collateral agreements. Because the Settlement Agreements are confidential, Novo respectfully requests that they 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. §317(b) and 37 C.F.R. §42.74(c), and has previously filed separate papers setting forth this request.

III. RELATED LITIGATION

There are pending district court litigations involving the '462 patent, which are listed below.

- *Novo Nordisk Inc., et al. v. Mylan Pharmaceuticals Inc.*, C.A. 22-23 (IMK) (N.D. W. Va.) transferred to D. Del. as 22-1040 (CFC)
- *Novo Nordisk Inc. et al. v. Mylan Pharmaceuticals Inc.*, C.A. 22-1040 (CFC) (D. Del.) (dismissed)
- *In re: Ozempic (Semaglutide) Patent Litigation*, MDL No. 22-MD-3038 (CFC) (D. Del.) (dismissed)
- *Novo Nordisk Inc. et al. v. Rio Biopharmaceuticals, Inc. et al.*, C.A. 22-294 (CFC) (D. Del.)
- *Novo Nordisk Inc. et al. v. Aurobindo Pharma USA, Inc. et al.*, C.A. 22-295 (CFC) (D. Del.) (dismissed)

- *Novo Nordisk Inc. et al. v. Sun Pharmaceuticals Industries Ltd. et al.*, C.A. 22-296 (CFC) (D. Del.)
- *Novo Nordisk Inc. et al. v. Zydus Worldwide DMCC et al.*, C.A. 22-297 (CFC) (D. Del.)
- *Novo Nordisk Inc. et al. v. Dr. Reddy's Laboratories Ltd. et al.*, C.A. 22-298 (CFC) (D. Del.)
- *Novo Nordisk Inc. et al. v. Alvogen, Inc.*, C.A. 22-299 (CFC) (D. Del.) (dismissed)
- *Novo Nordisk Inc. et al. v. Mylan Pharmaceuticals Inc.*, C.A. 24-775 (CFC) (D. Del.) (dismissed)

IV. ARGUMENT

This proceeding should be terminated both with respect to DRL and in its entirety, as Novo and each other petitioner have already requested termination of all other petitioners from this proceeding. Pap.103, 107, 110. The statutory provision on a settlement relating to *inter partes* reviews provides that a *inter partes* 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. § 317(a) (“An inter partes review instituted under this chapter 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”).

Section 317(a) further provides that “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 18(a).” 35 U.S.C. §317(a). Termination would save additional expenditure of resources by the Board, as well as by the Parties, 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 after oral hearing has been held. *E.g., Ascend Performance Materials Operations LLC v. Samsung SDI Co., LTD*, IPR2020-00349, Pap.64, 2-5 (Mar. 3, 2022) (granting motion to terminate filed after issuance of final written decision and prior to the issuance of a new final written decision on remand from the Director); *Taiwan Semiconductor Mfg. Co. Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-01862, Pap.39 (Jan. 24, 2019) (granting termination of proceeding in view of settlement two months after oral argument); *Petroleum Geo-Services Inc. v. WesternGeco LLC*, IPR2016-00407, Pap.29, 2-4 (July 5, 2017) (terminating proceeding where parties notified the Board of settlement less than a week before the statutory deadline for a final written decision); *Lam Research Corp. v. Flamm*, IPR2015-01764, Pap.27, 4, 6 (Dec. 15, 2016) (granting full termination of proceeding after

oral argument despite “extremely advanced nature” of proceeding, when “substantial resources—both on the part of the Board, as well as the parties—have been invested in this matter”); *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: “There 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 agreement*, unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal Board, Consolidated Trial Practice Guide, at 86 (Nov. 2019) (emphasis added).

For at least the reasons noted above, the Board’s expectation that such proceedings should be terminated is proper and well justified here.

V. CONCLUSION

For the foregoing reasons, DRL and Novo respectfully request that the Board terminate DRL from IPR2023-00724 and further terminate this proceeding in its entirety.

Dated: October 8, 2024

Respectfully submitted by:

/s/ Jovial Wong

Jovial Wong
Reg. No. 60,115
Winston & Strawn LLP
1901 L Street NW
Washington, DC 20036
Telephone: (202) 282-5867
jwong@winston.com

Scott Border
Reg. No. 77,744
Winston & Strawn LLP
1901 L Street NW
Washington, DC 20036
Telephone: (202) 285-5054
sborder@winston.com

Sharon Lin McIntosh
(*pro hac vice* to be submitted)
Winston & Strawn LLP
1901 L Street NW
Washington, DC 20036
Telephone: (202) 285-5756
slin@winston.com

*Attorneys For Petitioner Dr. Reddy's
Laboratories, Ltd.*

/Megan Raymond/

Megan Raymond (Reg. No. 72,997)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
801 17th Street NW, Suite 1050
Washington, DC 20006
P: (202) 505-5878
megan.raymond@groombridgewu.com

J. Steven Baughman (Reg. No. 47,414)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
801 17th Street NW, Suite 1050
Washington, DC 20006
P: (202) 505-5832
steve.baughman@groombridgewu.com

Jenny C. Wu (*pro hac vice*)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
565 5th Avenue, Suite 2900
New York, NY 10017
P: (332) 269-0038
jenny.wu@groombridgewu.com

Michael Milea (Reg. No. 71,863)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
565 5th Avenue, Suite 2900
New York, NY 10017
P: (332) 269-0029
mike.milea@groombridgewu.com

Philip S. May (*pro hac vice*)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
801 17th Street NW, Suite 1050
Washington, DC 20006

IPR2023-00724
U.S. Patent 10,335,462

P: (202) 539-6620
philip.may@groombridgewu.com

Joshua Reich (Reg. No. 75,338)
GROOMBRIDGE, WU, BAUGHMAN &
STONE LLP
565 5th Avenue, Suite 2900
New York, NY 10017
P: (332) 269-0024
joshua.reich@groombridgewu.com

*Attorneys For Patent Owner Novo Nordisk
A/S*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PETITIONER DR. REDDY'S LABORATORIES, LTD.'S AND PATENT OWNER'S JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. §317 has been served in its entirety by causing the aforementioned document to be electronically mailed to the following attorneys of record for Mylan, Dr. Reddy's, Sun, and Apotex listed below:

Petitioners' Counsel of Record:

Lead Counsel:	Brandon M. White Reg. No. 52,354 White-ptab@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200 By Electronic Mail
Backup Counsel:	Emily J. Greb Reg. No. 68,244 Greb-ptab@perkinscoie.com Perkins Coie LLP 33 East Main Street Madison, WI 53703 Telephone: (608) 663-7460 Courtney Prochnow, PhD Reg. No. 67,639 Prochnow-ptab@perkinscoie.com Perkins Coie LLP 633 W. 5th St., Ste 5850

	Los Angeles, CA 90071 Telephone: (310) 788-9900 Christopher D. Jones Reg. No. 76,472 Jones-ptab@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200 Jonathan I. Tietz, PhD Reg. No. 76,753 Tietz-ptab@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200 Matthew A. Lembo Reg. No. 75,633 Lembo-ptab@perkinscoie.com Perkins Coie LLP 1155 Avenue of the Americas Floor 22 New York, NY 10036 Telephone: (212) 262-6900 Shannon M. Bloodworth SBloodworth@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200 David L. Anstaett DAnstaett@perkinscoie.com Perkins Coie LLP 33 East Main Street Madison, WI 53703
--	---

	Telephone: (608) 663-7460 Bryan D. Beel BBeel@perkinscoie.com Perkins Coie LLP 1120 NW Couch St. Portland, OR 97209 Telephone: (503) 727-2000 Nathan Kelley Kelley_nathan-ptab@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200 Rodney Swartz Reg. No. 73,343 RSwartz@perkinscoie.com Perkins Coie LLP 1120 NW Couch St. 10th Floor Portland, OR 97209 Telephone: (503) 727-2000 Jessica Kaiser Reg No. 58,937 kaiser-ptab@perkinscoie.com Perkins Coie LLP 1900 Sixteenth St., Suite 1400 Denver, CO 80202-5255 Tel: (303) 291-2300 Semaglutide-Ozempic@perkinscoie.com By Electronic Mail
--	--

Lead Counsel for Dr. Reddy's Laboratories,	Jovial Wong Reg. No. 60,115 Winston & Strawn LLP
--	--

Inc. and Dr. Reddy's Laboratories. Ltd.:	1901 L Street NW Washington, DC 20036 Telephone: (202) 282-5867 jwong@winston.com By Electronic Mail
Backup Counsel:	Scott Border Reg. No. 77,744 Winston & Strawn LLP 1901 L Street NW Washington, DC 20036 Telephone: (202) 285-5054 sborder@winston.com Sharon Lin McIntosh (<i>pro hac vice</i> to be submitted) Winston & Strawn LLP 1901 L Street NW Washington, DC 20036 Telephone: (202) 285-5756 slin@winston.com By Electronic Mail
Lead Counsel for Sun Pharmaceutical Industries Ltd. and Sun Pharmaceutical Industries, Inc.:	Brian Sodikoff Katten Munchin Rosenman LLP 525 West Monroe Street Chicago, IL 60661 P: (312) 902-5200 brian.sodikoff@katten.com By Electronic Mail

Backup Counsel:	Christopher B. Ferenc Katten Munchin Rosenman LLP 1919 Pennsylvania Ave., N.W. Suite 800 Washington, DC 20006 P: (202) 625-3500 christopher.ferenc@katten.com By Electronic Mail
--------------------	---

Lead Counsel for Apotex Inc.:	John J. Molenda Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) jmolenda@steptoe.com By Electronic Mail
----------------------------------	--

Backup Counsel:	Lawerence Kass Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) lkass@steptoe.com Tyler Doh Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) tdoh@steptoe.com Michael I. Green Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) migreen@steptoe.com Semaglutide@Steptoe.com By Electronic Mail
--------------------	---

Dated: October 8, 2024

Respectfully submitted,

By: /Sayem Osman/
Sayem Osman