

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MSN PHARMACEUTICALS, INC. and
MSN LABORATORIES PRIVATE LIMITED,
Petitioner,

v.

BRECKENRIDGE PHARMACEUTICAL, INC.,
Patent Owner.

IPR2025-01107
Patent 11,013,729 B2

Before COKE MORGAN STEWART, *Deputy Under Secretary of
Commerce for Intellectual Property and Deputy Director of the United
States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Breckenridge Pharmaceutical, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned case, and MSN Pharmaceuticals, Inc. and MSN Laboratories Private Limited (collectively, “Petitioner”) filed an opposition (Paper 8, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the challenged patent is the subject of litigation in a parallel proceeding in the District of Delaware. DD Req. 10. The projected final written decision due date in the Board proceeding is December 25, 2026. *Id.* The district court’s scheduled trial date is October 6, 2026. *Id.* As such, it is unlikely that a final written decision in this proceeding will issue before district court trial occurs.

Although Petitioner is not a party to the parallel district court proceeding, the same general invalidity arguments that are presented in the Petition are also presented in the district court proceeding. DD Req. 14–17; Paper 1, 6, 34–37, 51–54; Ex. 2005, 27–31. As a result, the validity of the challenged patent is already being adjudicated in another forum that will issue an earlier decision, and the issues presented in the Petition are similar to those about to be litigated, raising concerns of inconsistent outcomes and duplication of efforts. Petitioner does not provide persuasive reasoning why an *inter partes* review is an appropriate use of Board resources under these circumstances. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025).

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of

all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

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FOR PETITIONER:

Noorossadat Torabi
WINSTON & STRAWN LLP
ntorabi@winston.com

FOR PATENT OWNER:

Andrew Larsen
Melissa Hayworth
MERCHANT & GOULD, P.C.
alarsen@merchantgould.com
mhayworth@merchantgould.com