

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 MYLAN PHARMACEUTICALS INC.'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 Mylan Pharmaceuticals Inc. (“Mylan”) and Patent Owner Novo Nordisk A/S (“Novo”) jointly request termination of Mylan from IPR2023-00724 concerning U.S. Patent No. 10,335,462 (“the ’462 patent”) and the withdrawal of Novo’s motion for sanctions (Paper No. 70) and Novo’s motion for additional discovery (Paper No. 71).

Mylan and Novo notified the Board of their settlement on October 2, 2024, and received authorization to file this joint motion to terminate on October 3, 2024.

II. STATEMENT OF FACTS

In support of the Joint Motion to Terminate, Mylan 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, each of which remains pending. Paper Nos. 70-71. An oral hearing has not yet been held and the merits of this *inter partes* review have not been decided.

Mylan and Novo have settled their dispute relating to the '462 patent and related patents, and have agreed to move to terminate this *inter partes* review and to withdraw Novo's motion for sanctions (Paper No. 70) and motion for additional discovery (Paper No. 71).

The parties' Settlement Agreements have been made in writing, and a true and correct copy of each Agreement will be concurrently filed with this Office as business confidential information pursuant to 35 U.S.C. §317(b) as Exhibits 2657, 2658, and 2659. There are no collateral agreements. Because the settlement agreements are confidential, Mylan and Novo respectfully request 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 have filed herewith a separate paper 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.)

- *In re: Ozempic (Semaglutide) Patent Litigation*, MDL No. 22-MD-3038 (CFC) (D. Del.)
- *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.)
- *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.)
- *Novo Nordisk Inc. et al. v. Mylan Pharmaceuticals Inc.*, C.A. 24-775 (CFC) (D. Del.)

IV. ARGUMENT

This proceeding, including all pending motions, should be terminated with respect to Mylan. The statutory provision on a settlement relating to *inter partes* reviews provides that an *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”). Because the Board has not decided the merits of this *inter partes* review proceeding, and because Mylan and Novo have jointly requested termination, the Board should terminate Mylan under §317(a).

V. CONCLUSION

For the foregoing reasons, Mylan and Novo respectfully request that the Board terminate Mylan from IPR2023-00724, and withdraw Novo’s motion for sanctions (Paper No. 70) and Novo’s motion for additional discovery (Paper No. 71).

Dated: October 4, 2024

/Brandon M. White/
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

Emily J. Greb
Reg. No. 68,244

Respectfully submitted by:

/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)

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

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
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

SBloodworth@perkinscoie.com
Perkins Coie LLP
700 13th Street, NW
Washington, DC 20005
Telephone: (202) 654-6200

*Attorneys For Patent Owner Novo
Nordisk A/S*

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

*Attorneys For Petitioner Mylan
Pharmaceuticals Inc.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PETITIONER MYLAN PHARMACEUTICALS INC.'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

	<p>Telephone: (608) 663-7460</p> <p>Bryan D. Beel BBeel@perkinscoie.com Perkins Coie LLP 1120 NW Couch St. Portland, OR 97209 Telephone: (503) 727-2000</p> <p>Nathan Kelley Kelley_nathan-ptab@perkinscoie.com Perkins Coie LLP 700 13th Street, NW Washington, DC 20005 Telephone: (202) 654-6200</p> <p>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</p> <p>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</p> <p>Semaglutide-Ozempic@perkinscoie.com By Electronic Mail</p>
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:	<p>Lawrence Kass Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) lkass@steptoe.com</p> <p>Tyler Doh Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) tdoh@steptoe.com</p> <p>Michael I. Green Steptoe LLP 1114 Avenue of the Americas New York, NY P: (212-506-3900) migreen@steptoe.com</p> <p>Semaglutide@Steptoe.com</p> <p>By Electronic Mail</p>
--------------------	--

Dated: October 4, 2024

Respectfully Submitted,

By: /Sayem Osman/
Sayem Osman