

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD,
Petitioners,

v.

JANSSEN BIOTECH, INC.,
Patent Owner.

Case No. IPR2023-01103
U.S. Patent 10,961,307

JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 35 U.S.C. § 317(a), Petitioner Samsung Bioepis Co., Ltd. (“Petitioner”) and Patent Owner, Janssen Biotech, Inc. (“Patent Owner”) (collectively, “the Parties”) have resolved their dispute and jointly request termination of IPR2023-001103 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on August 1, 2023.

I. STATEMENT OF FACTS

The Parties have executed a confidential settlement agreement (“Settlement Agreement”) to resolve all present disputes and to avoid any additional disputes regarding the ’307 patent, including this *inter partes* review (IPR) proceeding. The Parties are filing currently with this joint motion: (i) the Settlement Agreement resolving, inter alia, the present *inter partes* review proceeding (Exhibit 1073); and

(ii) a “Joint Request To File Settlement Agreement As Business Confidential Information” under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

A. Brief Explanation

Termination is appropriate in this case because the Parties have resolved all of their disputes relating to U.S. Patent No. 10,961,307 (“the ’307 Patent”), as set forth in the confidential Resolution Document. *See* Exhibits 1001, 1073.

Both Petitioner and Patent Owner support termination of the proceeding. This proceeding is still in its preliminary stages. Patent Owner has not filed a Preliminary Response to the Petition, and the Board has not rendered an Institution Decision.

B. Related Litigation

The '307 Patent was previously asserted by Patent Owner in *Janssen Biotech, Inc. v. Amgen Inc.*, Case No. 1:22-cv-01549-MN (D. Del. Nov. 29, 2022), but the case is no longer pending. There is no other litigation involving the '307 patent.

C. Related Proceedings Before the Office

The '307 Patent is not subject to any other related proceedings before the Office.

II. STATEMENT OF RELIEF REQUESTED

Due to the resolution of all of the parties' disputes relating to the patent that is the subject of this IPR proceeding, the Parties jointly request termination of IPR2023-01103 under 35 U.S.C. § 317(a). The requested relief is appropriate because the Parties have resolved all of their disputes in this proceeding relating to the '307 Patent. A true copy of the document resolving the disputes related to the '307 Patent is filed concurrently herewith. *See* Exhibit 1073; 37 CFR § 42.74(b). Further, a termination of this proceeding will promote efficiency and conserve the Board's and the parties' resources.

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR of the '307 Patent.

Date: August 3, 2023

/s/ Michael A. Morin

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Respectfully submitted,

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CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a) was served on the 3rd day of August, 2023, via Federal Express® overnight delivery directed to Patent Owner at the correspondence address of record:

DAVID A. LANE, JR.
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This Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a) is also being served on the below litigation counsel for Patent Owner via electronic mail:

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