

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Celltrion, Inc.
Petitioner,

v.

Genentech, Inc.
Patent Owner.

Patent No. 7,976,838 B2
Issued: July 12, 2011
Filed: March 20, 2008
Inventor: Mark C. Benyunes

Title: THERAPY OF AUTOIMMUNE DISEASE IN A PATIENT WITH AN
INADEQUATE RESPONSE TO A TNF- α INHIBITOR

Inter Partes Review No. 2015-01733

**PETITIONER CELLTRION, INC.’S
UNOPPOSED MOTION TO DISMISS WITHOUT PREJUDICE
ITS PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 7,976,838 B2**

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Alexandria, VA 22313-1450

Pursuant to the Board's October 1, 2015 Order (Paper 10), Petitioner Celltrion, Inc. hereby requests dismissal of its petition without prejudice and termination of this proceeding. This request is being made contingent upon the dismissal being without prejudice. Patent Owner does not oppose dismissal without prejudice. Celltrion also requests that its motion for joinder with IPR2015-00417 (Paper 3) be dismissed as moot.

Background

The Board instituted Boehringer Ingelheim's ("Boehringer") IPR2015-00417, a petition for *inter partes* review of U.S. Patent No. 7,976,838 ("the '838 patent"), on July 14, 2015. On August 14, 2015, Celltrion filed this petition for *inter partes* review of the '838 patent, together with a motion for joinder with IPR2015-00417. The Board has not yet decided whether to institute Celltrion's petition, and Patent Owner's preliminary response is not due until November 27, 2015.

As noted in Celltrion's motion for joinder, Celltrion's petition is substantively identical to Boehringer's petition in IPR2015-00417, and Celltrion relies on the same exhibits and expert declaration of Dr. Kalden that Boehringer submitted in IPR2015-00417. (Paper 3.) In its motion for joinder, Celltrion also represented that it would coordinate its activities with Boehringer and not offer separate argument, expert testimony, or briefing. Celltrion structured its petition in

this manner to conform to the Board's precedents regarding joinder practice, which demonstrate that offering additional expert witnesses, testimony, or arguments can lead to denial of joinder. *See, e.g., ZTE Corporation et al. v. Adaptix, Inc.*, Case IPR2015-01184 (July 24, 2015) (Paper 10 at 4-5).

To secure consent to the joinder, Celltrion, Patent Owner, and Boehringer had been negotiating a stipulation in which Celltrion agreed that it would not take an active role in the joined IPRs unless and until Boehringer was dismissed from them. Prior to execution of the stipulation, however, Boehringer unilaterally filed a request for adverse judgment for abandonment of the contest in IPR2015-00417. (IPR2015-00417, Paper 17.) Boehringer took this action without consulting Celltrion, and less than two weeks before the scheduled deposition of Boehringer's expert Dr. Kalden, on whose declaration Celltrion also relies. In subsequent communications, Boehringer indicated that Dr. Kalden is not free to work with Celltrion and that it will not permit Celltrion to retain him. The Board has now terminated IPR2015-00417.

In subsequent meet-and-confers, Patent Owner indicated that it would not oppose dismissal of Celltrion's petition without prejudice. Such dismissal would allow Celltrion to re-file its petition with a new expert to replace the now-unavailable Dr. Kalden, permit Patent Owner a full and fair opportunity to respond

to the re-filed petition, and remove the pending petition from the Board's docket while Celltrion prepares its papers.

In an October 1, 2015 conference call with the Board, Celltrion requested the Board's permission to file a motion to dismiss its petition, contingent on the dismissal being without prejudice so that Celltrion may re-file with a new expert.

On October 1, the Board granted Celltrion permission to file this contingent motion to dismiss and directed Celltrion to file it by October 2. (Paper 10.)

Argument

For the reasons stated above, Celltrion respectfully requests that the Board dismiss Celltrion's IPR2015-01733 and terminate the proceeding without prejudice. This request is being made contingent upon the dismissal being without prejudice.¹ Such dismissal is necessary to avoid the manifest prejudice that would otherwise befall Celltrion if it were forced to proceed without Dr. Kalden. Because this proceeding is in an early stage, Patent Owner's preliminary opposition is not due for approximately eight weeks, and the Board has not yet considered the merits of the petition. Accordingly dismissal will not prejudice Patent Owner or waste the Board's resources. Patent Owner does not oppose dismissal without prejudice.

¹ As discussed in the October 1, 2015 conference call with the Board, should the Board view dismissal other than without prejudice as more appropriate, Celltrion understands that the Board will not enter any dismissal, and will thereafter discuss with the parties an alternative proposed by Celltrion, which is to modify the schedule to permit Celltrion to correct its petition without prejudicing Patent Owner's time to develop and file its preliminary response.

Thus, such dismissal is appropriate. *See, e.g., ZTE (USA) v. Vringo Infrastructure Inc.*, IPR2015-00701 (Paper 12) (dismissing petitions without “a final written decision pursuant to 35 U.S.C. § 318(a)” where patent owner did not oppose termination). Celltrion also requests that the Board dismiss its motion for joinder with IPR2015-00417 as moot.

Dated: October 2, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 2nd day of October, 2015, I caused to be served a true and correct copy of the foregoing “PETITIONER CELLTRION, INC.’S UNOPPOSED MOTION TO DISMISS WITHOUT PREJUDICE ITS PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,976,838 B2” by e-mail on the Patent Owner and its representatives at the below addresses:

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