

Paper No. 9
Date Filed: April 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DANA-FARBER CANCER INSTITUTE, INC.
Petitioner

v.

BRISTOL-MYERS SQUIBB COMPANY,
Patent Owner

Case IPR2023-00249
U.S. Patent 10,323,092

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Dana-Farber Cancer Institute, Inc. (“Petitioner”) and Bristol-Myers Squibb Company (“Patent Owner”) jointly request termination of this *inter partes* review of U.S. Patent No. 10,323,092 (“’092 patent”), and termination of the proceeding with respect to Petitioner.

The parties have reached a settlement agreement regarding the ’092 patent and have agreed to terminate this IPR2023-00249. No other IPRs are known to be pending against the ’092 patent. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on April 6, 2023.

Termination of this proceeding is proper for at least the following reasons:

- The parties have agreed to settle and dismiss their related district court litigation, *Dana-Farber Cancer Institute, Inc. v. Bristol-Myers Squibb, Co., et al.*, No. 1:19-cv-11380-PBS, and there are no other cases between the parties that involve the ’092 patent.
- The parties jointly request termination. 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“There are *strong public policy reasons to favor settlement* between the parties to a proceeding.”) (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346. 351 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of*

Transp., 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not “decided the merits of the proceeding *before the request for termination is filed*.” 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48,768 (“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.”). No Motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding. 77 Fed. Reg. 48,680, 48,686 (Aug. 14, 2012); 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”).

The settlement agreement between the parties is being made in writing, and a true and correct copy will be filed with this request as Exhibit 1073, along with a request to treat the settlement agreement as business confidential information and to keep Exhibit 1073 separate from the public files. In view of that request, Exhibit 1073 has been filed for access “Available Only to Board.” There are no other agreements or understandings, oral or written, including collateral agreements, made in connection with, or in contemplation of, the termination of the proceedings between the parties.

Dated: April 6, 2023

Respectfully submitted,

By: /Steven D. Maslowski/
Steven D. Maslowski
Registration No. 46,905
Akin Gump Strauss Hauer & Feld LLP
1735 Market Street, 12th Floor
Philadelphia, PA 19103
Tel: 215-965-1259
Fax: 215-965-1210
smaslowski@akingump.com
Counsel for Patent Owner
Bristol-Myers Squibb Company

By: /Amanda K. Antons/
Amanda K. Antons, Ph.D.
Registration No. 65,236
Dechert LLP
35 West Wacker Drive, Suite 3400
Chicago, IL 60601-1608
Tel: 312-646-5822
Fax: 312-646-5858
Amanda.antons@dechert.com
Counsel for Petitioner

Dana-Farber Cancer Institute, Inc.

CERTIFICATE OF SERVICE

I certify that today in

Dana-Farber Cancer Institute, Inc. v. Bristol-Myers Squibb Co., IPR2023-00249

I caused to be served a copy of:

Joint Motion to Terminate Pursuant to 35 U.S.C. § 317
Exhibit 1073
Certificate of Service

upon:

Bristol-Myers Squibb Company c/o:
AKIN GUMP STRAUSS HAUER & FELD LLP
Steven D. Maslowski (smaslowski@akingump.com)
Matt Person (mpearson@akingump.com)
Rachel J. Elsby (relsby@akingump.com)
Jason Weil (jweil@akingump.com)
BMS-DF-IPR@akingump.com

via:

electronic service to the email addresses above.

Dated: April 6, 2023

Respectfully submitted,

/Amanda K. Antons/

Amanda K. Antons (Reg. No. 65,236)

amanda.antons@dechert.com

DECHERT LLP

35 W Wacker Drive

Suite 3400

Chicago, IL 60601-1608

Telephone: 312-646-5822

Facsimile: 312-646-5858

*Counsel for Petitioner Dana-Farber
Cancer Institute, Inc.*