

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METRICS, INC., MAYNE PHARMA, and JOHNSON MATTHEY, INC.,
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD., BAUSCH & LOMB, INC., and
BAUSCH & LOMB PHARMA HOLDINGS CORP.,
Patent Owner.

Case IPR2014-01041 (Patent 8,129,431 B2)
Case IPR2014-01043 (Patent 8,669,290 B2)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

JUDGMENT

*Granting Joint Motion to Terminate and
Granting Joint Request to Treat Settlement Agreement as Confidential
37 C.F.R. §§ 42.73, 42.74*

¹ This order addresses issues common to both cases; therefore, we issue a single order to be entered in each case. The parties are authorized to use this style heading when filing an identical paper in both proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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On July 1, 2015, pursuant to Board authorization, the parties filed a joint motion to terminate each proceeding identified in the caption. Paper 37.² With each joint motion, the parties filed a copy of their written settlement agreement, covering various matters involving the patents under review. Ex. 2027. The parties concurrently filed a joint request in each proceeding to treat their written settlement agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 38.

The parties advance Exhibit 2027 as a true copy of the parties' written settlement agreement, Paper 37, 1, and "certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review." *Id.* at 2. The parties attest that their agreement "ends all patent disputes between the parties, including" these *inter partes* reviews. Paper 37, 7. The parties also submit a copy of a stipulated consent judgment and injunction entered on June 30, 2015, which terminated their related district court litigation. Ex. 2028; *see* Paper 37, 3. The Board generally expects that a trial will terminate after the filing of a settlement agreement. *See Office Patent Trial Practice Guide*, 77 *Fed. Reg.* 48756, 48768 (Aug. 14, 2012).

² Paper and Exhibit numbers are identical in IPR2014-01041 and IPR2014-01043. Substantially similar joint motions to terminate were filed in each proceeding.

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The relatively early stage of these *inter partes* reviews counsels against proceeding to a final written decision. The reviews were instituted on February 19, 2015. Paper 19. Patent Owner has not yet filed a Response, which is due on July 27, 2015. Paper 36. As such, the record is incomplete and, lacking Patent Owner's Response, is tilted towards Petitioner. We are not inclined to move forward to a final decision on this record.

The parties identify a number of ongoing district court actions, and *inter partes* reviews, involving Patent Owner and entities other than Petitioner. *Id.* at 2–6. Most significantly, on March 19, 2015, an unrelated entity filed petitions challenging the patents under review and, concurrently therewith, filed motions to join with these proceedings; motions that Petitioner here has opposed. *See* Paper 34 (Petitioner's opposition to joinder). One factor, informing our decision to grant the parties' joint motion to terminate the instant proceedings, is that the unrelated petitioner in those other cases is not facing a time bar in the absence of joinder. *See* IPR2015-00902, Paper 3, 2; IPR2015-00903, Exhibit 0, 2 (motions for joinder, stating that underlying litigation was filed November 3, 2014); *see also* Exhibit 2001, 8 (hearing transcript in related cases, in which counsel for both parties confirm that the petitions in the related proceedings will not be time-barred in the absence of joinder); 35 U.S.C. § 315(b), (c) (explaining statutory bar, and the exception that applies to joinder).

Taking account of all of the circumstances, including the incompleteness of the record and the fact that Petitioner and Patent Owner have resolved all of their outstanding patent disputes, the Board determinates

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that it is appropriate to terminate the proceedings without rendering a final written decision. 37 C.F.R. § 42.72.

It is

ORDERED that the joint motion to terminate the proceedings is *granted* in each proceeding;

FURTHER ORDERED that the joint request that the settlement agreement be treated as business confidential information, to be kept separate from the patent file, is *granted* in each proceeding; and

FURTHER ORDERED that each proceeding is *terminated*.

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