

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANTARES PHARM, INC., LEO PHARMA A/S AND
LEO PHARMA INC.,
Petitioner,

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE
SPEZIALPRÄPARATE MBH.,
Patent Owners.

Case IPR2014-01091
Patent 8,664,231 B2

Before TONI SCHEINER, ERICA A. FRANKLIN, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges.*

FRANKLIN, *Administrative Patent Judge.*

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

On April 17, 2015, the parties filed a joint motion to terminate the proceeding pursuant to 35 U.S.C § 317. Paper 17. In addition, and pursuant to 35 U.S.C § 317 (b) and 37 C.F.R. § 42.74, the parties filed a true copy of their written settlement agreement, Ex. 1034, and requested in the joint motion that the settlement agreement be treated as business confidential information and kept separate from the file of US Patent No. 8,664,231 B2 (“the ’231 patent”), Paper 17, 2. The joint motion and the settlement agreement were filed so as to limit viewing to the parties and the Board only.

The parties indicated in their joint motion that termination of this proceeding is appropriate because they have reached an agreement settling their dispute with respect to the ’231 patent. *Id.* at 1. The parties indicated also that they have filed a joint stipulation of dismissal in the related district court litigation, *Medac Pharma, Inc. v. Antares Pharma, Inc.*, No. 1:14-cv-01498-JBS-KMW (D.N.J.). *Id.* at 2.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” As the parties indicated in their joint motion, this proceeding has not yet been decided on the merits.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” As the parties have filed their written settlement agreement, and have requested a dismissal of the co-pending district court case, we determine that it is

appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of claims 1–22 of the '231 patent. *See* 37 C.F.R. §§ 42.72, 42.73, 42.74.

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the file of the '231 patent. 37 C.F.R. § 42.74(c). Although the parties filed the joint motion so as to limit viewing to the parties and the Board only, a motion to seal, containing a protective order, was not filed concurrently with the joint motion, nor would sealing the joint motion be appropriate. Accordingly, the joint motion (Paper 17), as well as this Judgment, will be made publicly available. *See* 37 C.F.R. § 42.14.

Accordingly, it is

ORDERED that the parties' joint request that the settlement agreement be treated as business confidential information is GRANTED; and

FURTHER ORDERED that the joint motion to terminate the proceeding is GRANTED; and

FURTHER ORDERED that the proceeding is TERMINATED.

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