

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owners

Case IPR2016-00710
Patent 6,331,415

**JOINT MOTION TO TERMINATE WITH RESPECT TO MYLAN
PURSUANT TO 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), Petitioner Mylan Pharmaceuticals Inc. (“Mylan” or “Petitioner”) and Patent Owners Genentech, Inc. (“Genentech”) and City of Hope (collectively, “Patent Owners”) jointly request termination with respect to Mylan in IPR2016-00710, which is directed to U.S. Patent No. 6,331,415 (the “415 Patent”).

A. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Mylan and Patent Owners jointly request termination with respect to Mylan in this *inter partes* review pursuant to a settlement.

II. STATEMENT OF FACTS

Mylan and Genentech have reached a settlement that resolves the dispute between Mylan and Patent Owners with respect to this *inter partes* review proceeding. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate with Respect to Mylan in reference to sealing of the settlement agreement. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office). The Board previously provided authorization to file this motion on March 13, 2017. (3/13/17 A. Kellogg email re IPR2016-00710 – Request to File Motion to Terminate.)

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 (PTAB Jul. 28, 2014).

(1) Brief Explanation. Termination with respect to Mylan is appropriate because Mylan and Genentech have reached a settlement that resolves all disputes between Mylan and Patent Owners with respect to this proceeding. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate with Respect to Mylan in reference to sealing of the settlement agreement.

(2) Related Litigation. There is currently no litigation involving the challenged patent.

(3)(4) Related Proceeding before the Patent Office and Its Status. On January 3, 2017, Merck Sharp & Dohme Corp. (“Merck”) was joined as a party to this *inter partes* review. (Paper 32 at 5.) The settlement between Mylan and Genentech does not involve Merck, and this *inter partes* review would continue

between Merck and Patent Owners if this Motion to Terminate with Respect to Mylan is granted.

III. ARGUMENT

The Board should terminate this *inter partes* review with respect to Mylan as Mylan and Patent Owners jointly request, for the following reasons.

First, Mylan and Patent Owners have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated with respect to a party upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, Mylan and Genentech have reached a settlement that resolves all disputes between Mylan and Patent Owners in this proceeding and as to the '415 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Ex. 1089. Mylan and Genentech request that the settlement agreement be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, Mylan and Patent Owners in the present proceeding jointly certify that there are no other written or oral agreements or understandings,

including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

IV. CONCLUSION

For the foregoing reasons, Mylan and Patent Owners respectfully request termination with respect to Mylan in this *inter partes* review of the '415 Patent.

Respectfully submitted,

Dated: March 13, 2017

/Deanne M. Mazzochi/
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