

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS, INC., and
MERCK SHARP & DOHME CORP.,
Petitioner,

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owner.

Case IPR2016-00710¹
Patent 6,331,415 B1

Before TONI R. SCHEINER, LORA M. GREEN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

JUDGMENT

Granting Joint Motion to Terminate as to Mylan
Due to Settlement After Institution
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

¹ Case IPR2017-00047 has been joined with this proceeding.

On March 13, 2017, Petitioner Mylan Pharmaceuticals, Inc. (“Petitioner Mylan”) and Patent Owner filed a Joint Motion To Terminate With Respect to Mylan Pursuant To 35 U.S.C. § 317(a). Paper 47. The parties filed a copy of their Settlement Agreement, made in connection with the termination of these proceedings, in accordance with 37 C.F.R. § 42.74(b). Paper 48.² The parties also filed a Joint Request that the settlement be treated as business confidential information, and be kept separate from the file of the involved patent, under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 49. In particular, Petitioner Mylan and Patent Owner request that the Settlement Agreement be maintained as viewable by the Board alone, and thus, not accessible by Petitioner Merck Sharp & Dohme Corp. (“Petitioner Merck”). *Id.* at 2.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 37 C.F.R. § 42.72. In their Joint Motion to Terminate, Mylan and Patent Owner indicate that the Settlement Agreement resolves all disputes between them with respect to this proceeding. *See* Paper 47, 3. The Joint Motion to Terminate was filed before oral argument, and thus, before final written decision and a decision on the merits.

² The parties filed a copy of their settlement agreement as a paper, but we note that the better practice would have been to file it as an exhibit.

Upon consideration of the facts before us, we determine that it is appropriate to terminate this proceeding and enter judgment as to Mylan, without rendering a final written decision. *See* 37 C.F.R. §§ 42.5(a), 42.71(a), 42.73(a), 42.74. Accordingly, we grant the Joint Motion to Terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Settlement Agreement treated as business confidential information and kept separate from the files of the patent at issue in this proceeding. Thus, we grant the Joint Request to treat the Settlement Agreement as business confidential, as well as keeping it designated as Board only.

We note, however, that as shown in the caption, Petitioner Merck was joined to this proceeding, and, therefore, the proceeding will continue as to that Petitioner. *See* Paper 47, 3–4. As IPR2017-00047 was terminated in the order granting institution and joinder (Paper 32, 5–6), Patent Owner and Petitioner should continue to file papers and exhibits in IPR2016-00710. In addition, the Scheduling Order in IPR2016-00710 continues to govern the proceeding.

ORDER

Accordingly, it is

ORDERED that the joint request of Petitioner Mylan and Patent Owner to treat the Settlement Agreement as business confidential information, to be kept separate from the patent file, is GRANTED;

IPR2016-00710
Patent 6,331,415 B1

FURTHER ORDERED that the joint motion to terminate the proceedings is GRANTED as to Petitioner Mylan; and
FURTHER ORDERED that the instant proceeding continues as between Petitioner Merck and Patent Owner.

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