

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2016-01693 (Patent 6,407,213 B1)
Case IPR2016-01694 (Patent 6,407,213 B1)¹

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding Due to Settlement before Institution
37 C.F.R. §§ 42.72, 42.74

¹ This order addresses issues that are common to each referenced case. We, therefore, issue a single order that has been entered in each case. For convenience, paper numbers refer to those filed in IPR2016-01693.

IPR2016-01693 (Patent 6,407,213 B1)

IPR2016-01694 (Patent 6,407,213 B1)

On March 7, 2017, pursuant to 35 U.S.C. § 317(a), and with the Board’s authorization, the parties filed a Joint Motion to Terminate in each of the above-captioned proceedings. Paper 21. In addition, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties filed a true and correct copy of a Settlement Agreement (Ex. 1132), along with a Joint Request That Settlement Agreement Be Treated as Business Confidential Information, to be kept separate from the publicly available patent files (Paper 22).

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.” These cases are in their preliminary stage. No decision on whether to institute a trial has been made in either case.

Under 37 C.F.R. § 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a).” After reviewing the Joint Motions to Terminate and the Settlement Agreement, we determine that it is appropriate to terminate the proceedings without rendering a final written decision. Therefore, the Joint Motions to Terminate are GRANTED.

Accordingly, it is

ORDERED that the Joint Motions to Terminate Proceeding are GRANTED and the proceedings are hereby TERMINATED; and

FURTHER ORDERED that the Joint Requests That Settlement Agreement Be Treated as Business Confidential Information are

IPR2016-01693 (Patent 6,407,213 B1)

IPR2016-01694 (Patent 6,407,213 B1)

GRANTED, and the Settlement Agreement will be kept separate from the patent files.

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