

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*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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)

Petitioner filed a Petition for an *inter partes* review of claims 1, 2, 4, 12, 25, 29–31, 33, 42, 60, 62–67, 69, and 71–81 of U.S. Patent No. 6,407,213 B1. Paper 2. Patent Owner filed a Preliminary Response on December 16, 2016. Paper 11. We must decide whether to institute a review by March 16, 2017. *See* 35 U.S.C. 314(b).

In an e-mail dated February 24, 2017, the parties informed the Board that they “are engaged in productive settlement negotiations in connection with the above-captioned matters,” and jointly requested that the Board “withhold any decision regarding institution in IPR2016-01693 and IPR2016-01694 until the statutory deadline (March 16, 2017).” *See* Ex. 3001.

The parties’ joint request is granted-in-part. The parties are hereby given advanced authorization to file a joint motion to terminate the proceeding, should a settlement is reached in a timely manner. The parties are also authorized to file a joint request to treat the settlement agreement as business confidential, if needed. No conference call is necessary.

To allow the Board sufficient time to process its decision, the parties must file the joint motion and any related papers and exhibits by COB on **March 7, 2017**. If the parties fail to meet this deadline, the Board will issue its decision on institution by the statutory deadline, March 16, 2017. A joint motion to terminate the proceeding, if filed after March 7, 2017, will **not** be considered until after the issuance of the institution decision.

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The parties should be mindful of the requirements set forth in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 that any agreement between the parties made in connection with the termination of the proceeding must be in writing and a true copy must be filed with the Board. To the extent that the parties wish to maintain some level of confidentiality for such an agreement, please refer to the procedures set forth in 37 C.F.R. § 42.74(c).

To have the settlement agreement treated as business confidential under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement electronically in the Patent Review Processing System (PRPS) as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

Accordingly, it is

ORDERED that the parties' joint request for the Board to withhold decision on institution in IPR2016-01693 and IPR2016-01694 is GRANTED-IN-PART as specified in this Order.

PETITIONER:

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

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

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