

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN INSTITUTIONAL INC.,  
Petitioner,

v.

FRESENIUS KABI USA, LLC,  
Patent Owner.

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Case IPR2017-00643 (Patent 9,168,238 B2)  
Case IPR2017-00644 (Patent 9,168,239 B2)  
Case IPR2017-00645 (Patent 9,006,289 B2)<sup>1</sup>

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Before LORA M. GREEN, ERICA A. FRANKLIN, and  
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate the Proceeding Before Institution  
*37 C.F.R. §§ 42.71; 42.74*

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<sup>1</sup> This order addresses issues common to each of the captioned cases. Thus, we issue a single order for entry in each case.

IPR2017-00643 (Patent 9,168,238 B2)

IPR2017-00644 (Patent 9,168,239 B2)

IPR2017-00645 (Patent 9,006,289 B2)

On April 14, 2017, in each of the above-captioned cases, with authorization of the Board, the parties filed a joint motion to terminate the proceeding under 35 U.S.C § 317 (a). Paper 6.<sup>2</sup> The parties also filed a true copy of their written settlement agreement. Ex. 1058. Additionally, citing to 35 U.S.C § 317 (b) and 37 C.F.R. § 42.74 (c), the parties filed a joint request that the settlement agreement be treated as business confidential information and “kept separate from the files of these proceedings and the involved patents.” Paper 7, 2.

In each joint motion, the parties explain that termination of the proceeding is appropriate because they have reached an agreement settling their dispute with respect to the involved patent. Paper 6, 2.

These cases are in the preliminary proceeding stage; a decision whether to institute trial in each case has not been entered. Under these circumstances, we determine that it is appropriate to enter judgment terminating the proceedings. Additionally, the parties’ request for the settlement agreement to be treated as business confidential information and kept separate from the file of the involved patent is *granted*.

Insofar as the parties request that the settlement agreement be “kept separate from the files of these proceedings,” Paper 7, 2, such request is not expressly authorized by 35 U.S.C § 317 (b) or 37 C.F.R. § 42.74 (c), cited by the parties, and is *denied*. The settlement agreement will remain a part of the files of each respective proceeding as a sealed and restricted exhibit.

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<sup>2</sup> Citations to paper and exhibit numbers in this order refer to filings in IPR2017-00643. Similar documents were filed in each of the captioned cases.

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Accordingly, it is hereby

ORDERED that the joint motions to terminate the proceedings are *granted*;

FURTHER ORDERED that the joint requests that the settlement agreement, Ex. 1058, be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are *granted*;

FURTHER ORDERED that the joint requests that the settlement agreement, Ex. 1058, be kept separate from the files of these proceedings are *denied*, the exhibit shall remain sealed in each proceeding; and

FURTHER ORDERED that the proceeding in each of the above-captioned cases is *terminated*.

IPR2017-00643 (Patent 9,168,238 B2)

IPR2017-00644 (Patent 9,168,239 B2)

IPR2017-00645 (Patent 9,006,289 B2)

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