

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRECKENRIDGE PHARMACEUTICAL, INC., AND
WEST-WARD PHARMACEUTICALS INTERNATIONAL LTD.
Petitioner,

v.

NOVARTIS PHARMACEUTICALS CORP.,
Patent Owner.

Case IPR2017-01592¹
Patent 8,410,131 B2

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLOCK, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

JUDGMENT

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

¹ IPR2018-00507 has been joined to this proceeding.

On August 7, 2018, Petitioner Breckenridge Pharmaceutical, Inc. (“Petitioner Breckenridge”) and Patent Owner filed a Joint Motion to Terminate IPR as to Breckenridge Pursuant To 35 U.S.C. § 317. Paper 52. The parties filed a copy of their Settlement Agreement, made in connection with the termination of these proceedings, in accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Ex. 2114. The parties also filed a Joint Request that the settlement treatment be treated as business confidential information, and be kept separate from the file of the involved patent, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 53. In particular, Petitioner Breckenridge and Patent Owner request that the Settlement Agreement be maintained as viewable by the Board alone, and, thus, not accessible by Petitioner West-Ward Pharmaceuticals International Limited (“Petitioner West-Ward”). *Id.* at 2.²

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, Patent Owner and Petitioner

² Patent Owner and Petitioner Breckenridge also seek entry of the default protective order with certain modifications to paragraphs 2(A)–(E) and 2(G) of that order such that “only parties Novartis and Breckenridge and their respective party representatives and in-house counsel shall have access to Exhibit 2114.” Paper 53, 2. We decline to make those modifications to the default protective order ourselves. As noted in this Order, we grant the parties request to designate the Settlement Agreement as Board only. If the parties wish to renew their request, they should file a joint motion to seal, as well as the default protective order with their proposed modifications. The parties should also file a copy of their proposed protective order showing all the changes from the default protective order in redline. *See* 37 C.F.R. § 42.54.

Breckenridge aver that they “have settled their dispute.” Paper 52, 2; *see also id.* at 3 (stating that and that the pending litigation between Patent Owner and Petitioner Breckenridge regarding the patent at issue here “has been settled”). The Joint Motion to Terminate was filed before oral argument and a final written decision on the merits. The proceeding will continue as to Petitioner West-Ward.

Upon consideration of the facts before us, we determine that it is appropriate to terminate this proceeding as to Petitioner Breckenridge and enter judgment, 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, Petitioners Breckenridge and West-Ward were joined to this proceeding, and, therefore, the proceeding will continue only as to Petitioner West-Ward. *See* Paper 50, 2–3. Patent Owner and Petitioner West-Ward should continue to file papers and exhibits in the instant proceeding, that is, IPR2016-01479, but adjust the case caption accordingly.

I. ORDER

Accordingly, it is

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

FURTHER ORDERED that we GRANT the joint request of Patent Owner and Petitioner Breckenridge to maintain the Settlement Agreement as Board only;

FURTHER ORDERED that the joint motion to terminate the proceedings is GRANTED as to Petitioner Breckenridge; and

FURTHER ORDERED that the instant proceeding continues as between Petitioner West-Ward Pharmaceuticals International Limited and Patent Owner; subsequent to this Order, the case caption will list West-Ward Pharmaceuticals International Limited as the sole Petitioner.

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