

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KASHIV PHARMA, LLC,
Petitioner,

v.

PURDUE PHARMA L.P.,
THE P.F. LABORATORIES, INC., and
PURDUE PHARMACEUTICALS L.P.
Patent Owners.

Case IPR2018-00625 (Patent 9,492,392 B2)
Case IPR2018-00717 (Patent 9,492,393 B2)¹

Before CHRISTOPHER G. PAULRAJ, JACQUELINE T. HARLOW, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION

*Granting Joint Motions to Terminate and
Granting Joint Requests to File Settlement Materials as
Business Confidential Information
37 C.F.R. §§ 42.5(a), 42.71(a), 42.74*

¹ We exercise our discretion to issue one Decision to be filed in both cases. The parties are not authorized to use this style heading for any subsequent papers.

IPR2018-00625 (Patent 9,492,392 B2)

IPR2018-00717 (Patent 9,492,393 B2)

I. INTRODUCTION

On August 9, 2018, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate in each of the above-identified *inter partes* review proceedings, pursuant to a settlement agreement. Paper 22 (“Joint Motion”).² Along with the Joint Motion, the Parties filed confidential versions of a Settlement Agreement (Ex. 2030), Releases (Ex. 2031 and 2032), a Patent License Agreement (Ex. 2033), and a Distribution and Supply Agreement (Ex. 2034) (collectively referred to as “the Settlement Materials”), as well as a Joint Request to File the Settlement Materials as Business Confidential Information and Maintain the Settlement Materials Separate from the Public File pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 23 (“Joint Request”)).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of these *inter partes* review proceedings, and that the filed copies of the Settlement Materials are true and complete copies. Joint Motion 2. The Parties further represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the challenged patents. *Id* at 3.

These cases are at the preliminary proceeding stage;³ no institution of a trial has been made. Based on the facts of this case, we determine that

² For purposes of expediency, we cite to Papers and Exhibits filed in IPR2018-00625. Similar Papers and Exhibits were filed in IPR2018-00717.

³ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted. 37 C.F.R. § 42.2.

IPR2018-00625 (Patent 9,492,392 B2)

IPR2018-00717 (Patent 9,492,393 B2)

good cause exists to dismiss these proceedings, without rendering a decision as to whether a trial will be instituted.

The Parties also filed a Joint Request that the Settlement Materials be treated as business confidential information and be kept separate from the publicly available file of the respective patents involved in these *inter partes* proceedings. Joint Request 2. We have reviewed the Settlement Materials and find that they contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Materials between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (IPR2018-00625, Paper 22) is granted, and IPR2018-00625 is dismissed;

FURTHER ORDERED that the Joint Motion to Terminate (IPR2018-00717, Paper 22) is granted, and IPR2018-00717 is dismissed;

FURTHER ORDERED that the Joint Request (IPR2018-00625, Paper 23) for the Settlement Materials (Exhibits 2030–2034) to be treated as business confidential information and be kept separate from the file of U.S. Patent No. 9,492,392, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is granted; and

FURTHER ORDERED that the Joint Request (IPR2018-00717, Paper 23) for the Settlement Materials (Exhibits 2030–2034) to be treated as business confidential information and be kept separate from the file of U.S.

IPR2018-00625 (Patent 9,492,392 B2)

IPR2018-00717 (Patent 9,492,393 B2)

Patent No. 9,492,393, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.

§ 42.74(c), is granted.

IPR2018-00625 (Patent 9,492,392 B2)

IPR2018-00717 (Patent 9,492,393 B2)

For PETITIONER:

Tedd W. Van Buskirk

Michael H. Teschner

Maegan A. Fuller

Nichole M. Valeyko

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

tvanbuskirk@lernerdavid.com

MTeschner.ipr@ldlkm.com

MFuller.ipr@ldlkm.com

nvaleyko@lernerdavid.com

For PATENT OWNER:

Gasper J. LaRosa

Kelsey I. Nix

Pablo Hendler

Kenneth S. Canfield

Sarah A. Geers

Christopher Harnett

Lisamarie LoGiudice

JONES DAY

gjarosa@jonesday.com

knix@jonesday.com

phendler@jonesday.com

kcanfield@jonesday.com

sgeers@jonesday.com

charnett@jonesday.com

llogiudice@jonesday.com