

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC,
Petitioner,

v.

ALKERMES PHARMA IRELAND LIMITED,
Patent Owner.

Case IPR2018-00943
Patent 7,919,499 B2

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

SAWERT, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate
35 U.S.C. § 317(a) and 37 C.F.R. § 42.74

On July 30, 2019, pursuant to the Board’s authorization, Amneal Pharmaceuticals LLC (“Petitioner”) and Alkermes Pharma Ireland Limited (“Patent Owner”) filed a joint motion to terminate this *inter partes* review pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Paper 27 (“Motion” or “Mot.”). The motion was accompanied by a true, unredacted copy of a Settlement and License Agreement (Ex. 2058), and a joint request to treat the Settlement and License Agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 28).

The parties represent in their joint motion that they “have settled their disputes” and have “executed a Settlement and License Agreement that authorizes the Parties to seek termination of this *inter partes* review.” Mot. 2. Additionally, the parties state that the patent-at-issue in this proceeding, U.S. Patent No. 7,919,499 B2 (“the ’499 patent”), is not involved in any related district court litigations, or in any related *inter partes* review proceedings. *Id.*

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 also* 37 C.F.R. § 42.72. Here, although the Board has instituted an *inter partes* review of claims 1–13 of the ’499 patent, the Board has not heard oral argument and has not decided the merits of the proceeding.

Under the circumstances presented here, therefore, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties’ 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 and License 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 and License Agreement as business confidential.

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding is GRANTED;

FURTHER ORDERED that the joint request to treat the parties' Settlement and License Agreement as business confidential information, to be kept separate from the patent file, is GRANTED; and

FURTHER ORDERED that the instant proceeding is TERMINATED.

IPR2018-00943
Patent 7,919,499 B2

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