

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN TECHNOLOGIES, INC.,
Petitioner,

v.

NOVEN PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2018-01119
Patent 9,833,419 B2

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and KRISTI L. R.
SAWERT, *Administrative Patent Judges*.

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DECISION
Granting Joint Motion to Terminate
Due to Settlement Prior to Institution
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On September 5, 2018, Mylan Technologies, Inc. (“Petitioner”) and Noven Pharmaceuticals, Inc. (“Patent Owner”) filed a joint motion to terminate this proceeding pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Paper 7 (“Motion” or “Mot.”). The motion was accompanied by a true, unredacted copy of a binding settlement term sheet (Ex. 2025), and a joint request to treat the binding settlement term sheet 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 8).

The parties represent in their joint motion that they “have settled their dispute and executed a binding term sheet to terminate th[is] *inter partes* review[.]” Mot. 1. The parties state that the binding settlement term sheet “reflects all essential terms of a settlement agreement between the [p]arties.” *Id.* at 2. Additionally, the parties state that they have filed identical motions to terminate the related *inter partes* review proceedings IPR2018-00173 and IPR2018-00174, and that the related district court case between the parties, *Noven Pharmaceuticals, Inc. v. Mylan Technologies Inc.*, 1:17-cv-01777 (D. Del.), and related Federal Circuit Appeal No. 18-2287, have been dismissed. *Id.* at n.1, 3–4.

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. This proceeding is in a preliminary stage. No decision on whether to institute trial has been issued. Under the circumstances presented here, we determine that it is appropriate to

terminate this preliminary 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 binding settlement term sheet 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 binding settlement term sheet 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' binding settlement term sheet as business confidential information, to be kept separate from the patent file, is GRANTED; and

FURTHER ORDERED that the instant proceeding is TERMINATED.

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