

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
SAWAI USA, INC., AND
SAWAI PHARMACEUTICAL CO., LTD.,
Petitioner,

v.

BIOGEN MA INC.,
Patent Owner.

Case IPR2018-01403¹
Patent 8,399,514 B2

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER

Authorizing the Filing of a Joint Motion to Terminate Petitioner Sawai
35 U.S.C. § 317; 37 C.F.R. §§ 42.20(b), 42.72

¹ Case IPR2019-00789 has been joined with this proceeding.

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In two email correspondence sent to the Board on November 13, 2019, Petitioners, Sawai USA, Inc. and Sawai Pharmaceuticals Co., Ltd. (together, “Sawai”) and Patent Owner, Biogen MA Inc. (“Biogen”), indicated that Sawai and Biogen have settled their disputes regarding U.S. Patent No. 8,399,514. Sawai and Biogen additionally requested a teleconference to seek permission to file a joint motion to terminate this proceeding. Specifically, as indicated in the email, Sawai and Biogen jointly requests permission to file: (i) a Joint Motion To Terminate Sawai from IPR2018-01403; and (ii) a Joint Motion To Keep The Settlement Agreement As Confidential Pursuant to 35 U.S.C. § 317.

Upon consideration thereof, the parties are authorized to file a joint motion to terminate (as a Paper). 35 U.S.C. § 317(a). The joint motion must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.

The joint motion to terminate also must include a true copy of any settlement agreement or understanding (as an Exhibit) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). A redacted version will not be accepted as a true copy of the settlement agreement. Attention of the parties is directed to FAQ G2 on the Board’s website page at <https://www.uspto.gov/patents-application-process/patent-trial-and->

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[appeal-board/ptab-e2e-frequently-asked-questions#](#) for instructions on how to file a settlement agreement as confidential.

The parties are authorized to file a joint request to file settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b) in this proceeding. Any joint request to file the settlement agreement as business confidential information must be filed as a separate paper contemporaneously with the joint motion to terminate. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

In consideration of the foregoing, it is

ORDERED that the parties are authorized to file, by no later than December 2, 2019, (1) a joint motion to terminate Petitioner Sawai (as a Paper), including a true copy of any settlement agreement (as an Exhibit), and (2) a joint request to file settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b) (as a separate Paper) in this proceeding.

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