

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.

IPR2018-01403¹
Patent 8,399,514 B2

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
JAMIE T. WISZ, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER

Settlement as to Sawai USA, Inc. and Sawai Pharmaceutical Co., Ltd.
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Case IPR2019-00789 has been joined with this proceeding. *See* IPR2018-01403, Paper 60.

I. INTRODUCTION

Petitioners Sawai USA, Inc. and Sawai Pharmaceutical Co., Ltd. (collectively, “Sawai”) and Patent Owner Biogen MA Inc. (“Biogen”) have requested that the above-identified *inter partes* review proceeding be terminated with respect to Sawai due to a settlement. With our authorization provided in the Order dated November 18, 2019 (Paper 90), Sawai and Biogen filed a “Joint Motion to Terminate Proceeding as to Petitioner Sawai Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” (Paper 94 (“Joint Motion”)). Along with the Joint Motion, the parties filed a “Settlement and License Agreement” (Ex. 1135 (“Settlement Agreement”)), as well as a “Joint Motion to Keep Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317” (Paper 95).

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

In the Joint Motion, Sawai and Biogen represent that they have reached agreement to settle their disputes regarding U.S. Patent No. 8,399,514 B2 (“the ’514 patent”), they jointly seek termination of this *inter partes* review proceeding with respect to Sawai, and the filed copy of the Settlement Agreement is a true and correct copy. Joint Motion 2–3.² The parties also represent that the Settlement Agreement resolves the related

² The Joint Motion does not include page numbers. Thus, for convenience, we refer herein to pages of the Joint Motion numbered in consecutive order, beginning with the title page as page 1.

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District Court litigation and Patent Office proceedings between Sawai and Biogen involving the '514 patent. *Id.* at 4–6.

We instituted a trial on the above-identified proceeding on February 6, 2019. Paper 12. We instituted and joined Sawai's petition in IPR2019-00789 to this proceeding on September 12, 2019. *See* Paper 60. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, Sawai and Biogen have shown adequately that the termination of the proceeding with respect to Sawai is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding as to Sawai. Mylan Pharmaceuticals Inc. will remain as Petitioner in this proceeding.

Sawai and Biogen also filed a joint motion requesting that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '514 patent. Paper 95. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate Proceeding is *granted*, and IPR2018-01403 is terminated with respect to Petitioner Sawai;

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FURTHER ORDERED that Mylan Pharmaceuticals Inc. will remain as Petitioner in this proceeding; and

FURTHER ORDERED that the Joint Motion to Keep Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 8,399,514 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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