

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIKMA PHARMACEUTICALS USA INC., HIKMA
PHARMACEUTICALS PLC,
Petitioner,

v.

AMARIN PHARMACEUTICALS IRELAND LIMITED,
Patent Owner.

IPR2022-00215
Patent 8,642,077 B2

Before TINA E. HULSE, CHRISTOPHER G. PAULRAJ, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On March 10, 2022, with authorization of the Board, the parties filed a joint motion to terminate the proceeding (paper 7) in light of an agreement between the parties and a joint request to treat that agreement as business confidential information under 35 U.S.C. § 317(b) (paper 6).

The parties explain that good cause exists to terminate this proceeding because they have resolved their disputes relating to U.S. Patent No. 8,642,077 (“the challenged patent”) and the proceeding is still at an early stage. Paper 7, 2. Moreover, pursuant to 37 C.F.R. § 42.74(b), the parties represent that the agreement made in contemplation of termination is in writing and that a true and correct copy of that agreement has been filed as Petitioner’s Exhibit 1050. *Id.* at 1. The parties jointly request that the agreement, filed as Exhibit 1050, be kept as a separate paper and made available only under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) because they consider it “to contain highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed.” Paper 6, 1.

The parties are correct that this proceeding is in an early stage. The deadline for Patent Owner’s preliminary response has not yet passed and a decision on institution has not been entered. Accordingly, because the parties represent that they have resolved their disputes relating to the challenged patent and have filed a written copy of their agreement as contemplated by the statute and our rules, we agree that it is appropriate to grant the parties’ joint motion to terminate.

We also grant the parties’ joint request to treat the agreement in Exhibit 1050 as business confidential information. That exhibit will be kept separate from the files of the challenged patent and shall be made available

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only to a Government agency on written request, or to other persons on a written request and showing of good cause. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate (paper 7) is granted and this proceeding is terminated; and

FURTHER ORDERED that the joint request that Exhibit 1050 be treated as business confidential information and kept separate from the file of U.S. Patent 8,642,077 B2 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (paper 6) is granted.

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