

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC,
Petitioner,

v.

NOVO NORDISK A/S,
Patent Owner.

IPR2022-00657
Patent 8,114,833 B2

Before ERICA A. FRANKLIN, JOHN G. NEW, and
SUSAN L.C. MITCHELL, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate the Proceeding Prior to Institution; and
Granting-in-Part Joint Request that the Settlement Agreement be Treated as
Business Confidential and Kept Separate
37 C.F.R. §§ 42.5(a), 42.71(a), 42.74

With authorization from the Board, the parties filed a joint motion to terminate this proceeding, Paper 11 (“Joint Motion”), along with a copy of their written settlement agreements, Exhibits 2007 and 2008 (collectively referred to as “Settlement Agreements”). Additionally, pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(c), the parties filed a joint request that the Settlement Agreement be treated as business confidential information and be kept separate. Paper 12.

In the Joint Motion, the parties assert that termination is appropriate because the proceeding is in its preliminary stage and a decision on institution has not been entered. Paper 11, 3. The parties explain also that they have entered into confidential settlement agreements, Ex. 2007 and Ex. 2008, that resolve the parties’ dispute regarding U.S. Patent No. 8,114,833 B2 (Ex. 1001) Paper 11, 3. The parties state that the Settlement Agreements “have been made in writing, and true and correct copies will be concurrently filed with this Office as business confidential pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(b) as Exhibits 2007 and 2008.” *Id.* at 1–2. The parties confirm that there are no collateral agreements. *Id.* at 2.

As the parties correctly assert, this case is in the preliminary phase of the proceeding, and the Board has not issued a decision whether to institute trial. As noted, the parties have filed the Settlement Agreements. Under the circumstances, we determine that it is appropriate to grant the Joint Motion to Terminate.

Additionally, the parties' joint request for the Settlement Agreements to be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted* with respect to those provisions.

We note that the parties additionally request "that the Board order that, in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the Settlement Agreements, any such written request be served upon Petitioner and Patent Owner on the day the written request is provided to the Board." Paper 12, 1. That request is *denied*. Under 35 U.S.C. § 317(b), settlement agreements "shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause." The provision under 37 C.F.R. § 42.74(c) reads similarly. Here, the parties are essentially asking us to include additional requirements to those provisions. Further, the parties' request would require us to issue an order for the conduct of Government agencies or individuals seeking access to the settlement agreements who are not parties to this proceeding or subject to our orders. As we find those aspects of the parties' request to be inappropriate, it is *denied*.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Joint Motion to Terminate the Proceeding is *granted*;

FURTHER ORDERED that the joint request for the settlement agreement to be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted-in-part*; and

FURTHER ORDERED that the proceeding is terminated.

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Patent 8,114,833 B2

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