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Paper 30
Date: January 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC.,
Petitioner,

v.

CELLGENE CORPORATION,
Patent Owner.

IPR2023-00512
Patent 8,846,628 B2

Before TINA E. HULSE, RYAN H. FLAX, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

DECISION
Due to Settlement After Institution of Trial
Granting Joint Motion to Treat Settlement Agreement as Confidential
35 U.S.C. § 317; 37 C.F.R. §§ 42.71(a), 42.72, 42.74

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Celgene Corporation ("Patent Owner") is the owner of U.S. Patent 8,846,628 B2 ("the '628 patent"). Paper 5, 1. On February 10, 2023, Apotex Inc. ("Petitioner") filed a Petition for *inter partes* review challenging the patentability of claims 1, 2, 6–9, 11–28, 32–36, and 38–43 of the '628 patent (claims 3–5, 10, 29–31, and 37 are not challenged). Paper 1, 1, 6 ("Pet."). On July 20, 2023, we instituted trial in this proceeding. Paper 7. No final decision on patentability has been entered by the Board.

On January 4, 2024, the parties jointly, with our authorization, filed a Joint Motion to Terminate this proceeding on the basis of a settlement reached by the parties. Paper 28 ("Mot."); *see* 35 U.S.C. § 317(a); 42 C.F.R. § 42.74.

35 U.S.C. § 317(b) states:

> Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.

Id. Pursuant to that statute, and in connection with the Joint Motion to Terminate, the parties filed a copy of their written settlement agreement resolving, *inter alia*, this *inter partes* review. Exhibit 1060 ("Settlement Agreement").

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See* 35 U.S.C. § 317(a) ("An 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,

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unless the Office has decided the merits of the proceeding before the request for termination is filed."); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)"). As noted above, the Board has not yet rendered a final decision. Thus, we *grant* the Joint Motion to Terminate the proceedings.

The parties also move that the Settlement Agreement (Ex. 1060) be treated as confidential information and kept separate from the '316 patent's record. Paper 29. This request is *granted*. *See* 37 C.F.R. § 42.74(c).

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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate this proceeding is *granted*, the Petition is *dismissed*, and this proceeding is hereby *terminated* under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motion to Treat the Settlement Agreement (Ex. 1060) as confidential information is *granted*, and this agreement shall be kept separate from the public files of the '628 patent, and made available only to Government agencies on written request, or to any person on written request and a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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