

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC,
Petitioner,

v.

CEPHALON, INC.,
Patent Owner.

Case IPR2016-00098 (Patent 8,791,270 B2)
Case IPR2016-00111 (Patent 8,895,756 B2)¹

Before JACQUELINE WRIGHT BONILLA, ZHENYU YANG, and
TINA E. HULSE, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

ORDER

Termination of the Proceedings
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

¹ This order addresses issues that are common to each referenced case. We, therefore, issue a single order that has been entered in each case. For convenience, paper numbers refer to those filed in IPR2016-00098.

IPR2016-00098 (Patent 8,791,270 B2)
IPR2016-00111 (Patent 8,895,756 B2)

On July 26, 2016, the parties filed a Joint Motion to Terminate each of the above-captioned proceedings pursuant to 35 U.S.C. § 317. Paper 17. In addition, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties filed a true and correct copy of a Settlement Agreement (Ex. 2032) in each case, along with a Joint Request to File Settlement Agreement as Business Confidential, to be kept separate from the publicly available patent files (Paper 18).

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In these cases, the Board instituted trial on May 4, 2016. Paper 10. So far, Patent Owner has not filed its Patent Owner Response, and the Board has not decided the merits of the proceedings.

Under 37 C.F.R. § 42.72, “[T]he 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).” After reviewing the Joint Motions to Terminate and the Settlement Agreement, we determine that it is appropriate to terminate the proceedings without rendering a final written decision. Therefore, the Joint Motions to Terminate are GRANTED.

IPR2016-00098 (Patent 8,791,270 B2)
IPR2016-00111 (Patent 8,895,756 B2)

Accordingly, it is

ORDERED that the Joint Motions to Terminate are GRANTED and the proceedings are hereby TERMINATED; and

FURTHER ORDERED that the Joint Motions to File Settlement Agreement as Business Confidential are GRANTED, and the Settlement Agreement will be kept separate from the patent files.

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