

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ELI LILLY AND COMPANY,  
Petitioner,

v.

LOS ANGELES BIOMEDICAL RESEARCH INSTITUTE AT  
HARBOR-UCLA MEDICAL CENTER,  
Patent Owner.

---

IPR2014-00752  
Patent 8,133,903 B2

---

Before FRANCISCO C. PRATS, SHERIDAN K. SNEDDEN, and  
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

TERMINATION  
Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

## I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On December 5, 2019, we authorized the Parties to file a joint motion to terminate the above-identified proceeding. Paper 102, 2. On December 9, 2019, the Parties filed a Joint Motion to Terminate the above-identified proceeding. Paper 103 (“Joint Motion”). Along with the Joint Motion, the Parties filed a Binding Term Sheet (Ex. 1184 (“Settlement Agreement”)), as well as a Joint Request 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) (Paper 104 (“Joint Request”)).

## 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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Joint Motion 1. The Parties further represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the ’903 patent. *Id* at 1–2.

Following remand to the Board by the Court of Appeals for the Federal Circuit in light of the Supreme Court’s holding in *SAS Institute, Inc.*

IPR2014-00752  
Patent 8,133,903 B2

*v. Iancu*, 138 S. Ct. 1348 (2018), we entered a revised Institution Order to include all grounds set forth in the Petition. Paper 60 (citing *L.A. BioMedical Research Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, slip op. at 5 (Fed. Cir. 2018)). 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, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patent involved in this *inter partes* proceeding. Paper 104, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, 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 between Petitioner and Patent Owner 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 (Paper 103) is *granted*, and IPR2014-00752 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 104) to Treat the Settlement Agreement (Exhibit 1184) as Business Confidential Information

IPR2014-00752  
Patent 8,133,903 B2

is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 8,133,903 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).

IPR2014-00752  
Patent 8,133,903 B2

FOR PETITIONER:

Mark Feldstein  
Charles Lipsey  
Joshua Goldberg  
Maureen Queler  
FINNEGAN, HENDERSON, FARABOW, GARRETT,  
& DUNNER, LLP  
Mark.feldstein@finnegan.com  
Charles.lipsey@finnegan.com  
Joshua.goldberg@finnegan.com  
Maureen.queler@finnegan.com

Mark Stewart  
Dan Wood  
ELI LILLY AND COMPANY  
Stewart\_mark@lilly.com  
Wood\_dan\_1@lilly.com

FOR PATENT OWNER:

David Tellekson  
Ewa Davison  
Virginia DeMarchi  
Michael Shuster  
Jonathan T. McMichael  
FENWICK & WEST LLP  
dtellekson@fenwick.com  
edavison@fenwick.com  
vdemarchi@fenwick.com  
mshuster@fenwick.com  
jcmichael@fenwick.com