

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.

Case IPR2014-00752
Patent 8,133,903

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

SNEDDEN, *Administrative Patent Judge*.

ORDER

Authorizing the Filing of a Joint Motion to Terminate
35 U.S.C. § 317; 37 C.F.R. §§ 42.20(b), 42.72

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In an email correspondence sent to the Board on December 2, 2019, the parties requested a teleconference to seek permission to file a joint motion to terminate Petitioner Celltrion from this proceeding. The relevant portion of the email reads as follows:

Petitioner, Eli Lilly and Company (“Lilly”), and Patent Owner, Los Angeles Biomedical Research Institute at Harbor-UCLA Medical Center (“LAB”), have settled their disputes regarding U.S. Patent No. 8,133,903, which is the subject of IPR2014-00752.

Accordingly, Lilly and LAB jointly request permission to file: (i) a Joint Motion To Terminate IPR2014-00752; and (ii) a Joint Motion To Keep The Settlement Agreement As Confidential Pursuant to 35 U.S.C. § 317.

Upon consideration of the parties’ joint request, the parties are authorized to file a Joint Motion to Terminate (as a Paper). 35 U.S.C. § 317(a). The Joint Motion to Terminate should reference this authorization and must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.

The Joint Motion to Terminate also must include a true copy of any settlement agreement or understanding (as an Exhibit) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). A redacted version will not be accepted as a true copy of the settlement agreement.

Attention of the parties is directed to FAQ G2 on the Board’s website page

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at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions#> for instructions on how to file a settlement agreement as confidential.

The parties are authorized to file a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) in this proceeding. Any Joint Request to File the Settlement Agreement as Business Confidential Information must be filed as a separate paper contemporaneously with the Joint Motion to Terminate. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

In consideration of the foregoing, it is

ORDERED that the parties are authorized to file, by no later than December 15, 2109, (1) a Joint Motion to Terminate (as a Paper), including a true copy of any settlement agreement (as an Exhibit), and (2) a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (as a separate Paper) in this proceeding.

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PETITIONER:

Mark J. Feldstein
Charles E. Lipsey
Joshua L. Goldberg
Maureen Queler
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
mark.feldstein@finnegan.com
charles.lipsey@finnegan.com
joshua.goldberg@finnegan.com
maureen.quele@finnegan.com

Mark J. Stewart
Dan L. Wood
ELI LILLY AND COMPANY
stewart_mark@lilly.com
wood_dan_l@lilly.com

PATENT OWNER:

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