

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. and LUPIN PHARMACEUTICALS, INC.,
Petitioners,

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner.

Case IPR2017-01159 (Patent 9,254,278 B2)
Case IPR2017-01160 (Patent 9,326,966 B2)¹

Before DEBORAH KATZ, GRACE KARAFFA OBERMANN,
RAMA G. ELLURU, *Administrative Patent Judges.*

KATZ, *Administrative Patent Judge.*

ORDER

*Granting Joint Motion to Terminate Proceeding and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74*

¹ We exercise our discretion to issue one Order to be filed in both cases. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2017-01159 (Patent 9,254,278 B2)

Case IPR2017-01160 (Patent 9,326,966 B2)

On July 9, 2018, Petitioner Lupin Ltd. and Lupin Pharmaceuticals Inc. and Patent Owner Horizon Therapeutics, LLC (“the parties”) filed a Joint Motion to Terminate in each of the above-identified proceedings. *See* IPR2017-01159, Paper 36, and IPR2017-01160, Paper 36 (“Joint Motions”). According to the parties, the settlement agreement resolves all currently pending Patent Office and District Court proceedings between the parties to this proceeding involving the ’278 patent and ’966 patent. Joint Motions 2. The parties represent that they have reached an agreement jointly seeking termination of these *inter partes* review proceedings. *Id.* The parties also represent that they have agreed to dismiss related district court litigation, *Horizon Therapeutics, Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:15-cv-07624-RBK-JS (D.N.J. filed Oct. 19, 2015), and *Horizon Therapeutics, Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:16-cv-4438-RBK-JS (D.N.J. filed Jul. 21, 2016). *Id.*

Although we instituted a trial (*see* IPR2017-01159, Paper 10; IPR2017-01160, Paper 10), a decision has not yet been finalized in this proceeding. Accordingly, we grant the parties’ requests and terminate the proceedings. *See* 35 U.S.C. § 317(a).

Along with the Joint Motions, the parties filed copies of a Confidential Settlement and License Agreement (Exhibit 2054, “Settlement Agreement”) in each proceeding and request that they be kept separate and confidential because of the inclusion of highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed. *See* IPR2017-01159, Paper 39, and IPR2017-01160, Paper 37 (“Joint Requests”). We grant the requests, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties further request “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

Case IPR2017-01159 (Patent 9,254,278 B2)

Case IPR2017-01160 (Patent 9,326,966 B2)

to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.” Paper 39, 1. We have no such procedure to serve upon the parties a request for access to the Settlement Agreement, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding such requests.

Accordingly, for the reasons discussed above:

It is ORDERED that the Joint Motion to Terminate (IPR2017-01159, Paper 36) is *granted*, and IPR2017-01159 is *terminated* with respect to Petitioner and Patent Owner pursuant to 37 C.F.R. § 42.72;

It is FURTHER ORDERED that the Joint Motion to Terminate (IPR2017-01160, Paper 36) is *granted*, and IPR2017-01160 is *terminated* with respect to Petitioner and Patent Owner pursuant to 37 C.F.R. § 42.72;

It is FURTHER ORDERED that the parties’ joint requests to treat the settlement agreement as business confidential information (IPR2017-01159, Paper 39, and IPR2017-01160, Paper 37) are *granted*, and the Settlement Agreement (Exhibit 2054) shall be kept separate from the files of the involved patents, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Case IPR2017-01159 (Patent 9,254,278 B2)

Case IPR2017-01160 (Patent 9,326,966 B2)

For PETITIONER:

Elizabeth Holland

eholland@goodwinprocter.com

Cynthia Hardman

chardman@goodwinprocter.com

For PATENT OWNER:

Robert Green

rgreen@greengriffith.com

Matthew Phillips

mphillips@lpiplaw.com

Emer Simic

esimic@greengriffith.com

Dennis Bennett

admin@globalpatentgroup.com

Ann Kotze

akotze@greengriffith.com