

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. and LUPIN PHARMACEUTICALS INC.,
Petitioner,

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner.

Case IPR2018-00459
Patent 9,561,197 B2

Before DEBORAH KATZ, TONI R. SCHEINER, and RAMA G. ELLURU,
Administrative Patent Judges.

ELLURU, *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*

I. INTRODUCTION

On July 9, 2018, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate this *inter partes* review proceeding challenging claims of U.S. Patent No. 9,561,197 (“the ’197 patent”). Paper 9 (“Mot.”).¹ Along with the Joint Motion, the Parties filed a Confidential Settlement and License Agreement (Exhibit 2021, “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 10 (“Req.”)). The Parties represent that the filed copy of the Settlement Agreement is a true copy. Mot. 5.

II. DISCUSSION

Under 35 U.S.C. § 317(a), *inter partes* review proceedings “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.”

In the Joint Motion, the Parties represent that they have entered into a settlement agreement. Mot. 1. The Parties represent that their settlement agreement resolves all currently pending Office and District Court proceedings between them involving the ’197 patent, at issue in this proceeding. *Id.* at 2. The Parties further represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding. *Id.* at 1–2.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial. In view of the early stage of this proceeding and

¹ Filing of the Joint Motion was authorized via e-mail correspondence from Board personnel on July 6, 2018.

the settlement between the Parties, we determine that good cause exists to terminate this 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 patent involved in this *inter partes* proceeding. Req. 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).

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 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.” Req. 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 Settlement Agreement access requests.

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

Accordingly, for the reasons discussed above, it is:

III. ORDER

ORDERED that the Joint Motion to Terminate (Paper 9), as to Petitioner and Patent Owner, is *granted*;

FURTHER ORDERED that the Joint Request (Paper 10) to Treat the Settlement Agreement (Exhibit 2021) as Business Confidential Information is *granted*;

FURTHER ORDERED that the Settlement Agreement shall be kept separate from the file of Patent 9,561,197, 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); and

FURTHER ORDERED that *inter partes* review proceeding IPR2018-00459 is hereby terminated with respect to Petitioner and Patent Owner pursuant to 37 C.F.R. § 42.72.

Case IPR2018-00459

Patent 9,561,197 B2

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