

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALERITAS, INC. and VALERITAS HOLDINGS, INC.,
Petitioners,

v.

ROCHE DIABETES CARE, INC.,
Patent Owner.

Case IPR2019-00552 (Patent 6,736,795 B2)
Case IPR2019-00553 (Patent 6,736,795 B2)¹

Before JON B. TORNQUIST, WESLEY B. DERRICK, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

ORDER

Dismissing the Proceedings
37 C.F.R. § 42.5(a), 37 C.F.R. § 42.71(a)

¹ This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

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IPR2019-00553 (Patent 6,736,795 B2)

On July 16, 2019, with Board authorization, the parties filed a Joint Motion to Terminate in each of these proceedings (Paper 10 in both proceedings). With each motion to terminate, the parties filed a copy of a written settlement agreement (Paper 11 in both proceedings²) along with a joint motion requesting that the settlement agreement be treated as business confidential information and kept separate from the files of the identified patents (Paper 12 in both proceedings).

The parties indicate in the Joint Motion to Terminate that they have “settled their dispute and executed a settlement agreement³ . . . to terminate all pending *inter partes* reviews and Parties’ related litigation involving the ’795 Patent.”⁴ IPR2019-00552, Paper 10, 1. “The Parties further certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review[s].” *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). This case is in the preliminary proceeding stage, which begins with the filing of a petition for instituting a trial—which has occurred in these cases—and ends with a

² While identified as Exhibit 1012 in IPR2019-00552 and Exhibit 1014 in IPR2019-00553, both were filed as Paper 11. We accept the written settlement agreement filed as a paper in this instance, excusing the corresponding mis-citation to Exhibits 1012 and 1014 in the Joint Motion to Terminate.

³ The settlement agreement filed as Paper 11 is identified as “a true copy of the [settlement agreement]” by reference to Exhibit 1012 in IPR2019-00552 (Paper 10, 2) and Exhibit 1014 in IPR2019-00553 (Paper 10, 2).

⁴ We cite to the papers filed in IPR2019-00552.

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written decision as to whether a trial will be instituted—which has not yet occurred. *See* 37 C.F.R. § 42.2.

Based on the facts of these cases, and in view of the Parties' Joint Motion to Terminate in these proceedings, we determine that it is appropriate to dismiss the Petition in both of these proceedings without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). We also determine that it is appropriate to treat the settlement agreement as business confidential information to be kept separate from the files of U.S. Patent No. 6,736,795 B2. *See* 35 U.S.C. § 317(b).

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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motions are *granted*;

FURTHER ORDERED that the Petitions for *Inter Partes* Review of the above-referenced patent are *dismissed*; and

FURTHER ORDERED that the settlement agreement between the parties (Paper 11) shall be treated as business confidential information and kept separate from the files of U.S. Patent No. 6,736,795 B2.

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IPR2019-00553 (Patent 6,736,795 B2)

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