

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC and FRESENIUS KABI
SWISSBIOSIM GmbH,
Petitioner,

v.

AMGEN INC.,
Patent Owner.

IPR2019-01183
Patent 9,643,997 B2

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

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

On June 18, 2020, pursuant to the Board’s authorization, Fresenius Kabi USA, LLC and Fresenius Kabi SwissBioSim GmbH (“Petitioner”) and Amgen Inc. (“Patent Owner”) filed a joint motion to terminate this *inter partes* review pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Paper 30 (“Joint Motion” or “Mot.”). The Joint Motion was accompanied by a true, unredacted copy of a Settlement Agreement, a related License Agreement, and a Confidentiality Agreement between the parties (Exhibit 1070), along with a joint request to treat Exhibit 1070 as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 31).

The parties represent in their Joint Motion that they have agreed to terminate this *inter partes* review proceeding. Mot. 1. In particular, the parties state that they “have settled their dispute relating to” U.S. Patent No. 9,643,997 B2 (“the ’997 patent”), the patent challenged in this proceeding. *Id.* The parties state that, out of the previously-identified district-court cases involving the ’997 patent, i.e., *Amgen Inc. v. Kashiv Biosciences, LLC*, No. 2:18-cv-03347 (D.N.J.), *Amgen Inc. v. Mylan Inc.*, No. 2:17-cv-01235 (W.D. Pa.), *Amgen Inc. v. Hospira Inc.*, No. 1:18-cv-01064 (D. Del.), and *Sandoz Inc. v. Amgen Inc.*, No. 3:19-cv-00977 (N.D. Cal.), “*Amgen v. Hospira* is the only case currently pending involving the ’997 patent.” *Id.* at 3. The parties also state that “[t]he only other *inter partes* review involving the ’997 patent, IPR2019-00797, was previously terminated.” *Id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14,

2012); *see also* 37 C.F.R. § 42.72. Here, although the Board has instituted *inter partes* review of the '997 patent, neither Petitioner's Reply nor Patent Owner's Sur-reply have been filed. The Board has not heard oral argument and has not decided the merits of the proceeding.

Under the circumstances presented here, therefore, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner. And, after reviewing the Joint Motion to terminate and the agreements included in Exhibit 1070, we determine that the parties have satisfied the requirements for settlement under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. *See DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (requiring all collateral agreements to be filed as part of a settlement). Accordingly, we grant the parties' Joint Motion to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Settlement Agreement treated as business confidential information and kept separate from the files of the '997 patent in this proceeding. Thus, we grant the parties' request to treat the Settlement Agreement as business confidential.

Accordingly, it is

ORDERED that the Joint Motion to terminate is GRANTED;

FURTHER ORDERED that the joint request to treat the parties' Settlement Agreement (Exhibit 1070) as business confidential information, to be kept separate from the patent file, is GRANTED; and

FURTHER ORDERED that the instant proceedings are TERMINATED.

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