

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

AMGEN, INC. and AMGEN MANUFACTURING LIMITED,  
Patent Owner.

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IPR2020-00314  
Patent 9,856,287 B2

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Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

TERMINATION

Due to Settlement before Institution of Trial  
35 U.S.C. § 317, 37 C.F.R. §§ 42.72, 42.74

With our permission, Petitioners Fresenius Kabi USA, LLC and Fresenius Kabi SwissBioSim GmbH and Patent Owners Amgen, Inc. and Amgen Manufacturing, Limited filed a Joint Motion to Terminate this proceeding pursuant to 35 U.S.C. § 317. Paper 14. Pursuant to 35 U.S.C. § 317(b), they filed a true and correct copy of a settlement agreement, a related license agreement, and a confidentiality agreement between the parties. Ex. 1048. In addition, they also jointly requested that Exhibit 1048 be filed as business confidential information, and be kept separate from the publically available patent files. Paper 15.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter 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.” The statute also requires:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review as between the parties.

35 U.S.C. § 317(b).

Under 37 C.F.R. § 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a).” Additionally, 37 C.F.R. § 42.74(b) provides that “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.” After reviewing the Joint Motion to

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Terminate and the agreements included in Exhibit 1048, 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).

In this case, the Board has not decided whether to institute *inter partes* review. Thus, it is appropriate to terminate the proceeding, and we grant the Joint Motion to Terminate.

Accordingly, it is

ORDERED that the Joint Motion to Terminate is GRANTED and this proceeding is hereby TERMINATED; and

FURTHER ORDERED that Exhibit 1048 will be treated as business confidential information, and will be kept separate from the patent files.

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