

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALNYLAM PHARMACEUTICALS, INC.,
Petitioner,

v.

SILENCE THERAPEUTICS GMBH,
Patent Owner.

Case PGR2018-00059
Patent 9,695,423

Before JEFFREY B. ROBERTSON, RAMA G. ELLURU, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *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. § 327; 37 C.F.R. §§ 42.72, 42.74*

I. INTRODUCTION

On December 18, 2018, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate this post-grant review proceeding challenging claims 1–25 of U.S. Patent No. 9,695,423 (“the ’423 patent”). Paper 16 (“Mot.”).¹ Along with the Joint Motion, the Parties filed a Confidential Settlement and License Agreement (Exhibit 1064, “Settlement Agreement”), as well as a Joint Request to Treat the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) (Paper 17 (“Req.”)). The Parties represent that the filed copy of the Settlement Agreement is a true and correct copy. Mot. 1–2.

II. DISCUSSION

Under 35 U.S.C. § 327(a), post-grant 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 ’423 patent, at issue in this proceeding. *Id.* at 1–2. The Parties further represent that they have reached an agreement to jointly seek termination of this post-grant review proceeding. *Id.* at 1.

¹ Filing of the Joint Motion was authorized via e-mail correspondence from Board personnel on December 17, 2018.

Although we have issued a Decision Denying Institution of Post-Grant Review (Paper No. 9) in this proceeding, Petitioner has filed a Request for Rehearing (Paper No. 11) of that decision, which is currently pending and we have not yet ruled upon. In view of the stage of this proceeding and 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 post-grant review 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. § 327(b) and 37 C.F.R. § 42.74(c).

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 328(a).

Accordingly, for the reasons discussed above, it is:

III. ORDER

ORDERED that the Joint Motion to Terminate (Paper 16) the proceeding is *granted*;

FURTHER ORDERED that the Joint Request (Paper 17) to Treat the Settlement Agreement (Exhibit 1064) as Business Confidential Information is *granted*;

FURTHER ORDERED that the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 9,695,423, and made available only

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to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that post-grant review proceeding PGR2018-00059 is hereby *terminated*.

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Patent 9,695,423

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