

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCK SHARP & DOHME CORP.,  
Petitioner,

v.

GENENTECH, INC. AND CITY OF HOPE,  
Patent Owner.

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Case IPR2016-00710<sup>1</sup>  
Patent 6,331,415 B1

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Before TONI R. SCHEINER, LORA M. GREEN, and  
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

JUDGMENT

Granting Joint Motion to Terminate as to Merck  
Due to Settlement After Institution  
*35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74*

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<sup>1</sup> Case IPR2017-00047 has been joined with this proceeding.

On May 4, 2017, Petitioner Merck Sharp & Dohme Corp. (“Petitioner Merck”) and Patent Owner filed a Joint Motion To Terminate Pursuant To 35 U.S.C. § 317(a). Paper 63. The parties filed a copy of their Settlement Agreement, made in connection with the termination of these proceedings, in accordance with 37 C.F.R. § 42.74(b). Ex. 1151. 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 involved patent, under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 64.

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* 37 C.F.R. § 42.72. In their Joint Motion to Terminate, the parties indicate that the Settlement Agreement resolves all disputes between them with respect to this proceeding. *See* Paper 63, 3. The parties aver also that there are “no other written or oral agreements or understandings, including any collateral agreements, between them.” *Id.* The Joint Motion to Terminate was filed before oral argument, and, thus, before final written decision and a decision on the merits.

We note that we terminated the proceeding as to Petitioner Mylan Pharmaceuticals, Inc., on April 4, 2017. Paper 54. Terminating as to Petitioner Merck will terminate the proceeding as to all parties. Thus, upon consideration of the facts before us, we determine that it is appropriate to terminate this proceeding, without rendering a final written decision. *See* 37

C.F.R. §§ 42.5(a), 42.71(a), 42.73(a), 42.74. Accordingly, we grant the 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 patent at issue in this proceeding. Thus, we grant the Joint Request to treat the Settlement Agreement as business confidential, as well as keeping it designated as Board only.

#### ORDER

Accordingly, it is

ORDERED that the Joint Request of Petitioner Merck and Patent Owner to treat the Settlement Agreement as business confidential information, to be kept separate from the patent file, is GRANTED;

FURTHER ORDERED that the joint motion to terminate the proceeding as to Petitioner Merck is GRANTED; and

FURTHER ORDERED that the instant proceeding is TERMINATED

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