

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANOFI-AVENTIS U.S. LLC,
REGENERON PHARMACEUTICALS, INC., AND,
GENZYME CORPORATION,
Petitioner,

v.

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

Case IPR2015-01624¹
Patent 6,331,415 B1

Before LORA M. GREEN, ERICA A. FRANKLIN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.73

¹ Case IPR2016-00460 has been joined with this proceeding.

On August 24, 2016, and pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the parties filed copies of the settlement agreements between Genentech, Inc., City of Hope, Sanofi-Aventis U.S. LLC, and Regeneron Pharmaceuticals, Inc. (Exhibit 2142), and between Genentech, Inc., City of Hope, and Genzyme Corp. (Exhibit 2143), along with a joint motion to terminate the proceeding and joint request to treat the settlement agreement as business confidential, to be separate from the patent file (Paper 42).² We note that although the parties may agree to settle their issues related to the involved patent, the Board is not a party to the settlement and may determine independently any question of patentability. 37 C.F.R. § 42.74(a).

For the reasons provided below, the joint motion to terminate is granted. The joint request that the settlement agreement be treated as business confidential information is also granted.

Petitioner has yet to file a reply to the Patent Owner Response in the joined proceeding, and we have not yet decided the merits of this proceeding. The parties represent that the “settlement agreements and any collateral agreements made in contemplation of termination of the proceeding are in writing, and true and correct copies of such documents are being filed herewith as Exhibits 2142 and 2143. No other such agreements, written or oral, exist between or among the parties.” Paper 42, 2. The parties represent further that they have agreed to settle their disputes as

² We note that the preferred practice is to file the joint motion to terminate and the joint request to treat the settlement agreement as business confidential as separate papers.

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involving the patent at issue in the instant proceeding, U.S. Patent No. 6,331,415, as well as related U.S. Patent No. 7,923,221, “including all litigation and Patent Office proceedings related thereto.” *Id.* at 4.

In view of the parties’ settlement agreement made in connection with the termination in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), we determine that it is appropriate to terminate the involvement of Petitioners. Moreover, we determine that it also is appropriate to terminate the proceeding with respect to Patent Owner, because we have not yet decided the merits of this proceeding. As a result, it is appropriate to enter judgment in the form of termination. *See* 37 C.F.R. § 42.2.

Accordingly, it is

ORDERED that the parties’ request that the settlement agreement be treated as business confidential information, to be kept separate from the patent file, is GRANTED;

FURTHER ORDERED that the joint motion to terminate the proceeding is GRANTED;

FURTHER ORDERED that the proceeding is TERMINATED.

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