

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,

Petitioner

v.

GENENTECH, INC.,

Patent Owner

Case IPR2016-01693

Patent 6,407,213

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), Petitioner Mylan Pharmaceuticals Inc. (“Mylan” or “Petitioner”) and Patent Owner Genentech, Inc. (“Genentech” or “Patent Owner”) jointly request termination of IPR2016-01693, which is directed to U.S. Patent No 6,407,213 (the “213 Patent”).

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owner jointly request termination of this *inter partes* review pursuant to a settlement.

II. STATEMENT OF FACTS

No decision on institution has been issued yet in this case. Further, Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office). The Board previously provided authorization to file this motion on February 28, 2017. (Paper 20.) A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each

such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

(1) Brief Explanation. Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement.

(2) Related Litigation. There is currently no litigation involving the challenged patent.

(3)(4) Related Proceeding before the Patent Office and Its Status. Petitioner filed a separate petition challenging certain claims of the ’213 Patent in IPR2016-01694. Petitioner and Patent Owner are concurrently filing a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a) in IPR2016-01694. Petitioner and Patent Owner are unaware of any pending judicial or administrative matter that would affect, or be affected by, a decision in this *inter partes* review.

III. ARGUMENT

The Board should terminate this case as the parties jointly request, for the following reasons.

First, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the '213 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See Ex. 1132*. The parties request that the settlement agreement be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, the parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

Third, a termination of this proceeding will conserve the Board’s resources and obviate the need for any more Board involvement in this matter.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review of the '213 Patent.

Respectfully submitted,

Dated: March 7, 2017

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on March 7, 2017, the foregoing document is being served by E-mail by agreement of the parties to the following counsel of record for the Patent Owner:

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