

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

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

Case IPR2016-00710
Patent 6,331,415

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

Pursuant to 35 U.S.C. § 317(a), Petitioner Merck Sharp & Dohme Corp. (“Petitioner”) and Patent Owners Genentech, Inc. and City of Hope (collectively, “Patent Owners”) jointly request termination of IPR2016-00710, which is directed to U.S. Patent No. 6,331,415 (the “’415 Patent”).

A. STATEMENT OF PRECISE RELIEF REQUESTED

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

II. STATEMENT OF FACTS

Petitioner and Patent Owners have reached a settlement that resolves their dispute with respect to 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 May 4, 2017. (5/4/17 A. Kellogg e-mail re IPR2016-2017- Request to File Motion to Terminate.)

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 because the parties have reached a settlement that resolves all disputes between them with respect to this 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.

(2) Related Litigation. There is currently no litigation involving the challenged patent. The parties’ settlement also resolves the currently pending litigation between the parties relating to U.S. Patent No. 7,923,221, which is a continuation of the ’415 patent at issue in this proceeding.

(3)(4) Related Proceeding before the Patent Office and Its Status. There are no other currently pending proceedings before the Patent Office involving the challenged patent.

III. ARGUMENT

The Board should terminate this *inter partes* review as the parties jointly request for the following reasons.

First, Petitioner and Patent Owners 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 with respect to a party 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, Petitioner and Patent Owners have reached a settlement that resolves all disputes between them in this proceeding and as to the '415 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See Ex. 1151.* 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, Petitioner and Patent Owners 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.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owners respectfully request termination of this *inter partes* review of the '415 Patent.

Respectfully submitted,

Dated: May 4, 2017

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*Counsel for Genentech, Inc. & City of
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on May 4, 2017, the foregoing document is being served by E-mail by agreement of the parties to the following counsel of record for the Patent Owners:

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