

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HORIZON DISCOVER GROUP PLC,
HORIZON SAGE HOLDING CORP., AND SAGE LABS, INC.,
Petitioner,

v.

TRASPOSAGEN BIOPHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-01884 (Patent 8,558,055 B2)
Case IPR2015-01887 (Patent 8,722,964 B2)¹

Before TONI SCHEINER, ERICA A. FRANKLIN, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

¹ This judgment addresses issues that are identical in the two cases. We, therefore, exercise our discretion to issue one order to be filed in each case.

IPR2015-01884 (Patent 8,558,055 B2)

IPR2015-01888 (Patent 8,722,964 B2)

On November 19, 2015, the parties filed in each proceeding a joint motion to terminate the proceeding pursuant to 35 U.S.C § 317. Paper 7.² In addition, and pursuant to 35 U.S.C § 317 (b) and 37 C.F.R. § 42.74, the parties filed in each proceeding a true copy of their written settlement agreement, Ex. 1032, and requested in each joint motion that each settlement agreement be treated as business confidential information and kept separate from the file of US Patent No. 8,558,055 B2 and US Patent No. 8,722,964 B2. Paper 8. The settlement agreements were filed so as to limit viewing to the parties and the Board only.

The parties indicated in their joint motions that termination of these proceedings is appropriate because they have reached an agreement settling their dispute with respect to each patent. *Id.* at 2. The parties indicated also that they have filed a Stipulated Dismissal in the related district court litigation, *Sage Labs, Inc. v. Transposagen Biopharmaceuticals, Inc.*, No. 1:15-cv-00791-SLR (D. Del.). *Id.* at 3.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” As the parties indicated in their joint motions, these proceedings have not yet been decided on the merits. Each proceeding is in the preliminary stage.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a

² Paper numbers and Exhibit numbers refer to filings in IPR2015-01884. Similar papers and exhibits were filed in IPR2015-01887.

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true copy shall be filed with the Board before termination of the trial.” As the parties have filed copies of their written settlement agreements, and have requested a dismissal of the co-pending district court case, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of the challenged claims. *See* 37 C.F.R. §§ 42.72, 42.73, 42.74.

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the files of the file of US Patent No. 8,558,055 B2 and US Patent No. 8,722,964 B2.

37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties’ joint request that the settlement agreement in each proceeding be treated as business confidential information is *granted*; and

FURTHER ORDERED that the joint motion to terminate each proceeding is *granted*; and

FURTHER ORDERED that each proceeding is *terminated*.

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