

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOCKHARDT BIO AG,
Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Cases: IPR2016-00370
Patent 6,472,431

Before JACQUELINE WRIGHT BONILLA, SHERIDAN K. SNEDDEN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

ORDER
Termination of the Proceedings
37 C.F.R. §§ 42.72, 42.74

On April 19, 2016, we authorized Petitioner Wockhardt Bio AG (“Petitioner Wockhardt”) and Jazz Pharmaceuticals, Inc. (“Patent Owner”) to file a joint motion to terminate this proceeding due to settlement. Ex. 2002. We also authorized the Petitioner Wockhardt and Patent Owner to file a joint request to treat the underlying settlement agreement as business confidential information. *Id.* On April 20, 2016, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74,

the parties filed a Joint Motion to terminate these proceedings (Paper 12, “Joint Motion” or “Joint Mot.”) and a Joint Request to treat the submitted settlement agreement (Ex. 2003) as business confidential information (Paper 13). In the Joint Motion, the parties represent that a true and correct copy of the confidential settlement agreement has been submitted electronically via the Patent Review Processing System (PRPS) as “Parties and Board Only.” Joint Mot. 2–3, 3 n.1.

“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). The Office has not yet decided the merits of this proceeding, and a final written decision has not yet been entered. Petitioner and Patent Owner represent that there are no related proceedings currently before the Office involving the patent at issue. Joint Mot. 4. Petitioner and Patent Owner identify related, co-pending U.S. district court proceedings, and they represent that the related district court proceedings remain pending against other defendants. *Id.* Petitioner and Patent Owner further represent that they have concurrently filed a Stipulation and Order of Dismissal in the related district court. *Id.* at 2. Accordingly, we determine that good cause exists to terminate this proceeding.

“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” 35 U.S.C. § 317(b). After reviewing the parties’ settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. We determine that good cause

exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

ORDER

For the reasons given, it is

ORDERED that the Joint Motion (Paper 12) is *granted*;

FURTHER ORDERED that the Joint Request that the Confidential Settlement Agreement be Treated as Business Confidential Information (Paper 13) is *granted*;

FURTHER ORDERED that this proceeding is hereby terminated; and

FURTHER ORDERED that the filed settlement agreement (Ex. 2003) be treated as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as “Parties and Board Only” in PRPS.

IPR2016-00370
Patent 6,472,431

FOR PETITIONERS:

Dennies Varughese
Deborah Sterling
STERNE, KESSLER, GOLDSTEIN & FOX
dvarughe-PTAB@skgf.com
dsterlin-PTAB@skgf.com

FOR PATENT OWNER:

F. Dominic Cerrito
Eric C. Stops
Evangeline Shih
Frank C. Calvosa
QUINN EMANUEL URQUHART & SULLIVAN, LLP
nickcerrito@quinnemanuel.com
ericstops@quinnemanuel.com
evangelineshih@quinnemanuel.com
frankcalvosa@quinnemanuel.com

John V. Biernacki
JONES DAY
jvbiernacki@jonesday.com