

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

FRONTIER THERAPEUTICS, LLC,  
Petitioner,

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE  
SPEZIALPRÄPARATE MBH,  
Patent Owner.

---

Case IPR2016-00649  
Patent 8,664,231 B2

---

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and  
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER  
Termination of the Proceeding  
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

On November 22, 2016, the parties filed an authorized Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 (“Joint Motion to Terminate”), which seeks to terminate the above-captioned proceeding in view of a settlement reached between the parties. Paper 15. Also, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties filed a true copy of a Settlement Agreement (Ex. 2090). Paper 19, at 1. Additionally, on December 6, 2016, the parties filed a Corrected Joint Request to Treat Settlement Agreement (Exhibit 2090) As Business Confidential Information, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), requesting to keep the Settlement Agreement separate from the publicly-available patent files. Paper 19.<sup>1</sup>

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this case, the Board instituted trial on September 1, 2016. Paper 10. So far, Patent Owner has not filed its Patent Owner Response, and the Board has not decided the merits of the proceedings.

Under 37 C.F.R. § 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant

---

<sup>1</sup> On November 22, 2016, the parties originally filed a Joint Request to Keep Paper Separate as Business Confidential Information together with a copy of the Settlement Agreement as a single document under seal. Paper 16. That Joint Request has been corrected to exclude the attached copy of the Settlement Agreement, and has been properly filed as a public document. Paper 19. This order directs the original filing (Paper 16) to be expunged from the record.

to a joint request under 35 U.S.C. 317(a).” After reviewing the Joint Motion to Terminate and the Settlement Agreement, we determine that it is appropriate to terminate the proceeding without rendering a final written decision.

“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). Accordingly, we treat the Settlement Agreement as business confidential information in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

#### ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate is *granted* and the proceeding is hereby terminated;

FURTHER ORDERED that the Corrected Joint Request to Treat Settlement Agreement (Exhibit 2090) As Business Confidential Information is *granted*, and the Settlement Agreement will be kept separate from the patent files; and

FURTHER ORDERED that Paper 16 shall be expunged from the record.

IPR2016-00649  
Patent 8,664,231 B2

PETITIONER:

Gregory J. Gonsalves  
gonsalves@gonsalveslawfirm.com

PATENT OWNER:

James F. Haley, Jr.  
J. Steven Baughman  
ROPES & GRAY LLP  
james.haley@ropesgray.com  
Steven.baughman@ropesgray.com