

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02019 (Patent 6,339,142 B1)
Case IPR2017-02020 (Patent 9,249,218 B2)

Before ERICA A. FRANKLIN, ZHENYU YANG, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
35 U.S.C § 317

In each of the captioned cases, with authorization of the Board, the parties filed a joint motion to terminate the proceeding pursuant to 35 U.S.C § 317. Paper 67.¹ The parties also filed a true copy of their written settlement agreement. Ex. 2062. Additionally, citing to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74, the parties filed a joint request that the settlement agreement be treated as business confidential information and kept separate from the files of US Patent Nos. 6,339,142 B1 and 9,249,218 B2. Paper 68.

In each joint motion, the parties explain that termination of the proceeding is appropriate because they have reached an agreement settling their dispute with respect to the involved patent. Paper 67, 2. The parties explain also that the settlement requires Petitioner and Patent Owner to file a stipulated dismissal of the related district court litigation, *Genentech, Inc. v. Pfizer, Inc.*, Civ. No. 17-cv-1672-CFC (D. Del.). *Id.*

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.” *See also* 37 C.F.R. § 42.74(a) (“parties may agree to settle any issue in a proceeding”). The Decisions on Institution for these proceedings were entered on March 12, 2018. Paper 16. The date designated for the oral argument is January 10, 2019. Paper 43 (Modified Scheduling Order). The parties assert that terminating the proceeding is appropriate based upon the timing of their request, as they have filed their joint motion before the Board

¹ The papers and exhibit cited in this decision are numbered the same in each proceeding.

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has decided the merits of proceeding. Paper 67, 4. We agree and, thus, find that the parties have satisfied section § 317(a).

Under 35 U.S.C. § 317(b),

[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.

See also 37 C.F.R. § 42.74(b). The parties have filed a settlement agreement relating to these proceedings. Ex. 2062. They “certify that there are no other written or oral agreements or understandings . . . that are made in connection with or in contemplation of, the termination of the instant proceeding.” Paper 67, 5. Thus, we find that the parties have satisfied section 317(b).

Based on the foregoing, pursuant to 35 U.S.C. § 317, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision.

ORDER

In accordance with the foregoing, it is hereby:

ORDERED that the joint motions to terminate the proceedings are *granted*; and

FURTHER ORDERED that the joint requests that the settlement agreement, Ex. 2062, be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the proceedings are *terminated*.

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