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Paper 48
Entered: October 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

HOFFMAN-LA ROCHE, INC.,
Patent Owner.

Case IPR2018-01219
Patent 8,314,225 B2

Before SUSAN L. C. MITCHELL, TINA E. HULSE, and WESLEY B. DERRICK, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner, Pfizer Inc., and Patent Owner, Hoffman-La Roche, Inc., (collectively "the Parties") have jointly requested that the above-identified *inter partes* review proceeding be terminated, pursuant to a settlement. Following a conference call on September 17, 2019, with counsel for the Parties and Judges Derrick, Mitchell, and Hulse, we issued an Order cancelling the oral argument for this proceeding and authorizing the Parties to file a joint motion to terminate the proceeding and a joint request to treat the settlement agreement as business confidential information. Paper 45. On September 20, 2019, the Parties filed a joint motion to terminate (Paper 46, "Joint Motion to Terminate"). Along with the Joint Motion to Terminate, the Parties filed a copy of a settlement agreement (Ex. 2049, "the Settlement Agreement") and a joint request to treat the Settlement Agreement as business confidential information (Paper 47, "Joint Request").

II. DISCUSSION

In the Joint Motion to Terminate, the Parties represent that they "have settled their dispute and all litigation relating to U.S. Patent Number 8,314,225" ("the '225 patent") and have "agreed to move to terminate this *inter partes* review." Paper 46, 1. The Parties also represent that "Genentech, the real party-in-interest in this IPR, asserted [the '225 patent] against Pfizer in *Genentech, Inc. and City of Hope v. Pfizer Inc.*, Civ. Act. 1-19-cv-00638 (D. Del. April 5, 2019)," that "Pfizer subsequently added Patent Owner as a counterclaim defendant," and that "[t]he [P]arties have settled this litigation as part of the Settlement Agreement." Paper 46, 2–3. The Parties further represent that "[t]here are no other currently-pending district court litigations or appeals involving [the '225 patent]." *Id.* at 3.

Also, as the Parties represent, "[t]his is the only currently-pending *inter partes* review involving [the '225 patent]." *Id.* at 2.

The Parties also represent that their "Settlement Agreement has been made in writing, and a true and correct copy . . . [has been] filed . . . as business confidential information pursuant to 35 U.S.C. § 317(b) as Exhibit 2049," and that "[t]here are no collateral agreements." *Id.*

We instituted a trial on the above-identified proceeding on December 18, 2018. Paper 12. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. 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." Section 317(a) also provides that, "[i]f no petitioner remains in the inter partes review, the Office may terminate the review[.]" Further, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Notwithstanding that this proceeding has moved beyond the preliminary stage, under these circumstances, we determine that good cause exists to terminate this proceeding with respect to both the Petitioner and the Patent Owner.

In the Joint Request, the Parties ask that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '225 patent. Paper 47, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we determine that it is appropriate to treat the Settlement Agreement as business confidential

information, and to keep the document separate from the files of the ’225 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Joint Motion to Terminate and the Joint Request to treat the Settlement Agreement as business confidential information are *granted*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is

ORDERED that, as was timely requested by the Parties, the Settlement Agreement, Exhibit 2049, shall be treated as business confidential information and kept separate from the file of U.S. Patent No. 8,314,225 B2 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted;* and

FURTHER ORDERED that the proceeding is *terminated*.

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