

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KASHIV BIOSCIENCES, LLC,
Petitioner,

v.

AMGEN INC.,
Patent Owner.

IPR2019-00791 (Patent 8,940,878 B2)
IPR2019-00797 (Patent 9,643,997 B2)¹

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

TERMINATION

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

¹ We exercise our discretion to issue a single Decision to be entered in each case using a joint caption. The parties are not permitted to use this caption. Except where stated, we use the Paper and Exhibit numbers from IPR2019-00791 for convenience.

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On December 3, 2019, pursuant to the Board’s authorization, Kashiv BioSciences, LLC (“Petitioner”) and Amgen Inc. (“Patent Owner”) filed a joint motion in each of the above-referenced cases to terminate these *inter partes* reviews pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74.

IPR2019-00791, Paper 20 (“Mot.”). The motion was accompanied by a true, unredacted copy of a Settlement Agreement (Exhibit 1076 in IPR2019-00791 and Exhibit 1080 in IPR2019-00797), and a joint request to treat the Settlement Agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 21).

The parties represent in their joint motion that they have agreed to terminate these *inter partes* review proceedings. Mot. 1. In particular, the parties state that they “have settled their dispute and all litigation relating to” the patents challenged in these proceedings. *Id.* The parties state that the related district-court case between the parties, *Amgen Inc. and Amgen Manufacturing, Limited. v. Kashiv BioSciences, LLC, Amneal Pharmaceuticals LLC, and Amneal Pharmaceuticals, Inc.*, No. 2:18-cv-03347-CCC-MF (D.N.J.), has been dismissed. *Id.* at 2. The parties also state that there are no other Board proceedings between the parties involving the challenged patents. *Id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see also* 37 C.F.R. § 42.72. Here, although the Board has instituted *inter partes* reviews of certain claims of the challenged patents, neither a Patent Owner Response nor a Reply have been filed. The Board has not

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heard oral argument and has not decided the merits of the proceedings. We further note that the proceedings are in their early stages of trial, as none of the stipulated due dates have passed. See Paper 20 (Joint Stipulation to Modify Due Dates 1 Through 3).

Under the circumstances presented here, therefore, we determine that it is appropriate to terminate these proceedings with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' joint motion to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Settlement Agreement treated as business confidential information and kept separate from the files of the patent-at-issue in this proceeding. Thus, we grant the joint request to treat the Settlement Agreement as business confidential.

Accordingly, it is

ORDERED that the joint motion to terminate is GRANTED;

FURTHER ORDERED that the joint request to treat the parties' Settlement Agreement (Exhibit 1076 in IPR2019-00791 and Exhibit 1080 in IPR2019-00797) as business confidential information, to be kept separate from the patent file, is GRANTED; and

FURTHER ORDERED that the instant proceedings are TERMINATED.

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