

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS GENE THERAPIES, INC. and
NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

GENZYME CORPORATION,
Patent Owner.

IPR2023-01044 (Patent 10,429,288 B2)
IPR2023-01045 (Patent 10,429,288 B2)¹

Before JEFFREY N. FREDMAN, SHERIDAN K. SNEDDEN, and
JAMES A. TARTAL, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER

Authorizing the Filing of a Joint Motion to Terminate
35 U.S.C. § 317; 37 C.F.R. §§ 42.20(b), 42.72

¹ This Order addresses issues common to each of these proceedings and we use this caption for efficiency. The parties may not use this style heading in any subsequent papers without authorization.

In email correspondence sent to the Board on February 14, 2024, the parties requested authorization to file a joint motion to terminate these proceedings. The relevant portion of the email reads as follows:

Petitioners Novartis Gene Therapies, Inc. and Novartis Pharmaceuticals Corporation and Patent Owner Genzyme Corporation have reached an agreement to settle their disputes in IPR2023-01044 and IPR2023-01045. The Parties therefore seek authorization to file a Joint Motion to Terminate these IPR proceedings pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74, and a Joint Request that the Settlement Agreement be Treated as Business Confidential Information and Kept Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Upon consideration of the parties' joint request, the parties are authorized to file a Joint Motion to Terminate (as a Paper) in each proceeding. 35 U.S.C. § 317(a). The Joint Motion to Terminate must include a true copy of any settlement agreement or understanding (as an Exhibit) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). A redacted document will not be accepted as a true copy of the settlement agreement. Attention of the parties is directed to FAQ G2 on the Board's website page at https://www.uspto.gov/help/patent-help#type-browse-faqs_2802 for instructions on how to file a settlement agreement as confidential.

The parties are also authorized to file a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) in each proceeding. Any Joint Request to File the Settlement Agreement as Business Confidential Information must be filed as

a separate paper contemporaneously with the Joint Motion to Terminate.

See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

In consideration of the foregoing, it is

ORDERED that the parties are authorized to file, by no later than March 6, 2024, (1) a Joint Motion to Terminate (as a Paper), including a true copy of any settlement agreement (as an Exhibit), and (2) a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (as a separate Paper) in each proceeding.

IPR2023-01044; IPR2023-01045
Patent 10,429,288 B2

PETITIONER:

John Livingstone
John.livingstone@finnegan.com

Jeffrey Smyth
Jeffrey.smyth@finnegan.com

Amanda Murphy
Amanda.murphy@finnegan.com

PATENT OWNER:

Amanda Antons
Amanda.antons@dechert.com

Blaine Hackman
Blaine.hackman@dechert.com