

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GENZYME CORPORATION,
Patent Owner.

Case No. IPR2023-01044
Patent No. 10,429,288

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.5, 42.71(a), 42.72,
AND 42.74**

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I. Introduction

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74, Petitioners Novartis Gene Therapies, Inc. and Novartis Pharmaceuticals Corporation (collectively “Petitioner”) and Patent Owner Genzyme Corporation (“Patent Owner”) jointly request termination of *Inter Partes* Review Proceedings IPR2023-01044 and IPR2023-01045 in their entirety. The Parties have settled their dispute relating to U.S. Patent No. 10,429,288 (the “’288 patent”). The parties reached a settlement by agreement with an effective date of February 6, 2024, notified the Patent Trial and Appeal Board of the parties’ settlement on February 14, 2024, and received authorization to file this Motion to Terminate on February 21, 2024.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner have filed herewith a true copy of the confidential settlement agreement between Petitioner and Patent Owner in both IPR2023-01044 and IPR2023-01045 as Confidential Exhibit 1029. This agreement resolves the dispute between Petitioner and Patent Owner concerning the ’288 patent. Petitioner and Patent Owner certify that there are no collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceedings. Because the settlement agreement is confidential, the parties respectfully request (and concurrently file herewith a request) that it be treated as business confidential information, be kept separate from the underlying petition and

patent files, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The copy of the agreement (Confidential Exhibit 1029) is being filed as Board and Parties Only.

II. Statement and Reasons for Requested Relief

Termination of the present *inter partes* review proceedings is appropriate because (1) the Parties have reached a settlement agreement and have agreed to jointly request termination of these proceedings; (2) the Board has not yet “decided the merits of the proceeding[s]”; and (3) public policy favors the termination. *See, e.g.*, Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) at 86; Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

First, the parties’ settlement, as set forth in the settlement materials (Confidential Exhibit 1029), completely resolves the controversy between Patent Owner and Petitioner relating to U.S. Patent No. 10,429,288. Second, 35 U.S.C. § 317(a) provides “[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 IPR2023-01044, a Decision to Institute Trial was entered on January 9, 2024, and in IPR2023-01045, a Decision to Institute Trial was entered on January 17, 2024. Patent Owner has not yet filed its Responses to the

Petition in either proceeding, Petitioner has not yet filed its Replies, and the Board has not decided the merits of the proceedings. Third, public policy favors the termination. As recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding. Therefore, termination of the proceedings is appropriate upon this Joint Request.

III. Status of Related Proceedings

Petitioner and Patent Owner settled their dispute concerning the '288 patent before the United States District Court for the District of Delaware, *Genzyme Corporation and Aventis Inc. v. Novartis Gene Therapies, Inc., and Novartis*

Pharmaceuticals Corporation, Case No. 1:23-cv-00554-RGA (D. Del.) by agreement with an effective date of February 6, 2024.

IV. The Parties' Settlement Agreement Should Be Treated as Business Confidential Information

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate Case Numbers IPR2023-01044 and IPR2023-01045 in their entirety and grant the parties' joint request to treat the settlement agreement between the parties as business confidential information. The settlement agreement between Petitioner and Patent Owner has been made in writing, and a true and correct copy has been filed in the concurrently filed as Confidential Exhibit 1029 in both proceedings with a joint Request to Treat Agreement as Business Confidential pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Petitioner and Patent Owner respectfully request that the agreement is kept separate from the files of both *Inter Partes* Review proceedings.

V. Conclusion

For the foregoing reasons, Petitioner and Patent Owner jointly respectfully request that the Board terminate IPR2023-01044 and IPR2023-01045 and treat the settlement agreement as business confidential information. Should the Board have any questions raised by this joint motion, Petitioner and Patent Owner are available at the Board's convenience.

Respectfully submitted,

Date: February 26, 2024

/John D. Livingstone/
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Counsel for Petitioner

Date: February 26, 2024

/Amanda K. Antons/
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Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Joint Motion to Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74** was served electronically via email on February 26, 2024, in its entirety on the following:

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Patent Owner has consented to electronic service by email.

Dated: February 26, 2024

/William Esper/
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