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Paper 48
Entered: June 1, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMGEN INC.,
Petitioner,

v.

ALEXION PHARMACEUTICALS,
Patent Owner.

Case IPR2019-00739 (Patent 9,725,504 B2)
Case IPR2019-00740 (Patent 9,718,880 B2)
Case IPR2019-00741 (Patent 9,732,149 B2)[1]

Before TINA E. HULSE, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges.*

POLLOCK, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

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[1] This Order addresses the same issue for the above-identified proceedings. Therefore, we exercise our discretion to issue one decision to be filed in each proceeding. The parties are not authorized to use this style heading in any subsequent papers.

Amgen Inc. ("Petitioner") filed Petitions for *inter partes* review of claims 1–10 of U.S. Patent No. 9,725,504 B2 ("the '504 patent"), claims 1–3 of U.S. patent No. 9,718,880 B2 ("the '880 patent"), and claim 1 of U.S. Patent No. 9,732,149 B2 ("the '149 patent"). Paper 2.[2] In each case, Alexion Pharmaceuticals ("Patent Owner") timely filed a Preliminary Response. Paper 10. The parties further submitted authorized Replies and Sur-Replies to the corresponding Preliminary Responses. *See* Papers 13 and 14, respectively.

On August 30, 2019, we granted Amgen's Petitions to institute *inter partes* reviews as to all challenged claims. Paper 15. Also on August 30, 2019, we issued a Scheduling Order, which set June 1, 2020 as DUE DATE 8, the date for oral argument, if requested. Paper 16. Patent Owner subsequently filed Responses to the Petitions. Paper 22. Petitioner filed Replies (Paper 29) and Patent Owner filed Sur-replies. Paper 38.

On April 17, 2020, the parties requested oral argument (Papers 36, 37), which we granted (Paper 41). On May 27, 2020, this panel convened a conference call to discuss the parties' joint request to postpone the date of oral hearing in light of on-going settlement negotiations. *See* Paper 44. To facilitate settlement, we reset the date of oral hearing to June 16, 2020, and authorized the filing of a motion to terminate each of the above proceedings. *Id*.

On May 29, 2020, the parties filed Joint Motions to Terminate. Paper 45. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the parties also filed, as Exhibit 1097, a copy of their Settlement Agreement, made in connection with the

[2] For simplicity, we refer to the papers filed in IPR2019-00739. Corresponding papers are filed in IPR2019-00740 and IPR2019-00741.

termination of these proceedings. The parties further filed a joint request that the Settlement Agreement be treated as business confidential information, and be kept separate from the file of the involved patent, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 46.

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Consolidated Office Patent Trial Practice Guide* (November 2019),[3] 86 (citing 35 U.S.C. §§ 317(a), 327). In their Joint Motions to Terminate, Patent Owner and Petitioner aver that they "have executed a settlement agreement that resolves all of their disputes concerning the '504[, '740, and '149] patent[s]." *See* Paper 45, 1. Moreover, the Joint Motions to Terminate were filed before any final written decision and a decision on the merits.

Upon consideration of the facts before us, we determine that it is appropriate to terminate the above proceedings and enter judgment, without rendering a final written decision. *See* 37 C.F.R. §§ 42.5(a), 42.71(a), 42.73(a), 42.74. Accordingly, we grant the Joint Motions 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 and, thus, remain designated as Board only.

[3] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

ORDER

Accordingly, it is

ORDERED that the joint request of Patent Owner and Petitioner to treat the Settlement Agreement (Ex. 1097) as business confidential information, to be kept separate from the patent file, is GRANTED;

FURTHER ORDERED the Settlement Agreement shall remain designated as Board only; and

FURTHER ORDERED that the joint motion to terminate the proceedings is GRANTED.

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