

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIKMA PHARMACEUTICALS USA INC.,
Petitioner,

v.

SK BIOPHARMACEUTICALS CO., LTD.,
and AXSOME MALTA LTD.,
Patent Owner.

IPR2024-01418
Patent 11,560,354 B2

Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

BACKGROUND

On September 25, 2024, Hikma Pharmaceuticals USA Inc. (“Petitioner”) filed a petition in this proceeding. Paper 1. SK Biopharmaceuticals Co., Ltd. and Axsome Malta Ltd. (collectively, “Patent Owner”) filed a preliminary response. Paper 8. With our prior authorization (Ex. 2022), Petitioner filed a Preliminary Reply (Paper 9), and Patent Owner filed a Preliminary Sur-reply (Paper 10). The Board has not issued a decision on institution.

With our prior authorization, the parties : (1) a Joint Motion to Terminate Proceeding (Paper 11 (“the Motion” or “Mot.”)); (2) a Joint Request that Settlement Agreement be Treated as Business Confidential Information (Paper 12 (“the request” or “Req.”)); and (3) a true copy of the settlement agreement made in connection with the termination of this proceeding (Ex. 1021 (the “Agreement”)). Upon consideration of the arguments presented and for the reasons below, we *grant* the motion, *grant* the request, and *terminate* this proceeding.

DISCUSSION

A. Joint Motions to Terminate

Under the applicable regulations, the parties may agree to settle any issue in a proceeding. 37 C.F.R. § 42.74(a) (2024). The regulations further provide that “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.” 37 C.F.R. § 42.74(b).

In the Motion, the parties state that they have settled their disputes and have reached a written agreement that resolves “the parties’ instant dispute

regarding the challenged '354 Patent, as well as other disputes in the District of New Jersey in lawsuits . . .” Mot. 2. The parties further represent that the Agreement (Ex. 1021) is “a true and correct copy” and that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” Mot. 2–3.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the parties. Accordingly, we grant the motion and terminate this proceeding.

*B. Joint Requests to Treat Settlement Agreement
as Business Confidential Information*

The parties request that the Agreement (1) be treated “as business confidential information” and (2) “be kept separate from the file of the patent at issue, and only made available to Federal Government agencies upon written request.” Req. 4; *see* Mot. 3 (similar). After reviewing the Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We thus treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to be kept separate from the files of the involved patent.

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

ORDER

Accordingly, it is hereby:

ORDERED that the joint motion is granted, the petition in IPR2024-01418 is dismissed, and this proceeding is terminated with respect to all parties;

FURTHER ORDERED that the joint request to treat the settlement agreement as business confidential information is granted; and

FURTHER ORDERED that the Agreement (Ex. 1021) (1) shall be treated as business confidential information; (2) shall be kept separate from the file of U.S. Patent No. 11,560,354 B2; and (3) shall be made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause pursuant to 37 C.F.R. § 42.74(c).

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