

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC and
FRESENIUS KABI SWISSBIOSIM GmbH,
Petitioner,

v.

CHUGAI SEIYAKU KABUSHIKI KAISHA and
HOFFMAN-LA ROCHE INC.,
Patent Owner.

IPR2022-01065
Patent No. 10,231,981 B2

Before JOHN G. NEW, ZHENYU YANG, and TINA E. HULSE,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

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

I. INTRODUCTION

With the Board’s authorization, Petitioner Fresenius Kabi USA, LLC and Fresenius Kabi SwissBioSim GmbH, and Patent Owner Chugai Seiyaku Kabushiki Kaisha and Hoffmann-La Roche Inc., (collectively “the Parties”) filed a joint motion to terminate the proceeding due to settlement. Paper 11 (“Joint Motion”). The Parties also filed a copy of a Settlement Agreement (Ex. 1101 (“Settlement Agreement”)) governing their settlement together with a joint request (Paper 12 (“Joint Request”)) that the Settlement Agreement be treated as business confidential information and kept separate from the publicly available file of this proceeding.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this proceeding, and that the filed copy of the Settlement Agreement represents “a true and correct copy” of the settlement agreement. Joint Motion 1. The Parties further represent that there are no related District Court proceedings. *Id.* at 2.

This proceeding is at the preliminary stage, and we have not yet decided whether to institute a trial. Under these circumstances, we determine that it is appropriate to terminate this proceeding. *See* 35 U.S.C. § 317. We also determine that it is appropriate to treat the Settlement Agreement as business confidential information to be kept separate from the patent files and separate from the file of this proceeding pursuant to 37 C.F.R. § 42.74(c), and therefore grant the portion of the Joint Request to keep the Settlement Agreement separate from the file of the subject patent.

We note that in the Joint Request, the Parties additionally seek an order from the Board that, “in the event a person or entity makes a written

request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon Petitioners and Patent Owner on the day the written request is provided to the Board.” Joint Request 1. That request is *denied*. Under 35 U.S.C. § 317(b), settlement agreements “shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” The provision under 37 C.F.R. § 42.74(c) reads similarly. Here, the Parties are essentially asking us to include additional requirements to those provisions. Further, the Parties’ request would require us to issue an order for the conduct of Government agencies or individuals seeking access to the settlement agreements who are not parties to this proceeding or subject to our orders. As we find those aspects of the Parties’ request to be inappropriate, it is *denied*.

III. ORDER

Accordingly, it is:

ORDERED that the Parties' Joint Motion to Terminate is *granted*, and this proceeding is terminated;

FURTHER ORDERED that the Joint Request is *granted-in-part* and *denied-in-part* in the manner noted above; and

FURTHER ORDERED that the Settlement Agreement shall be kept separate from the file of Patent No. 10,231,981 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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