

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*.

JUDGMENT

Granting Joint Motions to Terminate Proceeding Due to
Settlement after Institution,
Granting Joint Motions to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317 and 37 C.F.R. § 42.72, 42.74

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.

On February 26, 2024, Novartis Gene Therapies, Inc. and Novartis Pharmaceuticals Corporation (“Petitioner”) and Genzyme Corporation (“Patent Owner”) jointly filed the following documents in each proceeding: (1) a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 (Paper 17, “Joint Motion to Terminate”), (2) a true copy of the parties’ settlement agreement (Ex. 1029), and (3) a joint request that the settlement agreement be treated as business confidential and be kept separate from the file under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18, “Joint Request to Keep Confidential and Separate”). In each proceeding, the Parties jointly seek to terminate *inter partes* review based on a settlement. Paper 17, 1.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 37 C.F.R. § 42.72. The Parties request termination prior to a decision by the Board on the merits in these proceedings. The Parties represent that they settled their dispute concerning the ’288 patent before the United States District Court for the District of Delaware in *Genzyme Corporation and Aventis Inc. v. Novartis Gene Therapies, Inc., and Novartis Pharmaceuticals Corporation*, Case No. 1:23-cv-00554-RGA (D. Del.). Paper 17, 3–4. The Parties also state they filed a true copy of the confidential settlement agreement as required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *Id.* at 1; Ex. 1029. The Parties further certify that “[t]here 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.” *Id.* Under these circumstances, we

determine that it is appropriate to terminate both proceedings and to enter in each proceeding a judgment without rendering a final written decision.

Accordingly, we grant the Joint Motion to Terminate in each proceeding.

We also determine that the Parties complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information and to be kept separate from the files of the patent at issue in these proceedings. Thus, we grant the Joint Request to Keep Confidential and Separate in each proceeding and treat the settlement agreement as business confidential and to be kept separate from the '288 patent file.

It is

ORDERED that, in each of the above-identified proceedings, the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that, in each of the proceedings, the Joint Request to Keep Confidential and Separate is *granted* and the settlement agreement included in Exhibit 1029 shall be treated as business confidential information and be kept separate from the '288 patent file; and

FURTHER ORDERED that each of the proceedings is *terminated* with respect to Petitioner and Patent Owner.

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

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