

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC

Petitioner

v.

CIPLA LIMITED

Patent Owner

Case No. IPR2017-00807

U.S. Patent No. 8,168,620

**JOINT MOTION TO TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317**

Mail Stop “PATENT BOARD”

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

As authorized in the Patent Trial and Appeal Board's e-mail dated May 16, 2018, and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Patent Owner and Petitioner jointly and respectfully request that the *inter partes* review ("IPR") of U.S. Patent No. 8,168,620 be terminated.

I. Statement of Relief Requested

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, and pursuant to the authorization to file this motion provided by the Board with the parties on May 16, 2018, Petitioner Argentum Pharmaceuticals LLC ("Argentum") and Patent Owner Cipla Limited ("Cipla") jointly request the termination of this *inter partes* review of U.S. Patent No. 8,168,620 in its entirety as a result of settlement between Petitioner and Patent Owner.

The parties have settled their dispute and executed a settlement agreement to terminate this *inter partes* review.

The parties' settlement agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 2183. The parties are also filing concurrently herewith a joint request to treat the settlement agreement as business confidential information and keep it separate from the files of the IPR and the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) and (c).

II. Statement of Facts

Petitioner filed this IPR petition on February 2, 2017. On August 21, 2017, the Board instituted *inter partes* review of claims 1, 4-6, 24-26, 29, and 42-44 of the '620 patent. On May 15, 2018, Petitioner and Patent Owner entered into a settlement agreement. *See* CIP2183 (Confidential). Argentum agrees to terminate this IPR proceeding.

The Board has not yet decided the merits of the pending IPR proceeding.

III. Argument

35 U.S.C. § 317(a) provides: “An 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.” 35 U.S.C. § 317(a).

Similarly, 37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a).”

The Trial Practice Guide additionally counsels that “[t]here are strong public policy reasons to favor settlement between the parties to proceeding” and that 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. 35

U.S.C. 317(a), as amended, and 35 U.S.C. 327.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

A. Termination of this proceeding is proper.

As noted in the Statement of Facts, oral argument has not yet occurred. Thus, the Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“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.”). The Board has already cancelled the oral hearing that was scheduled to take place in this proceeding. Further, the parties are unaware of any other matter before the Board that would be affected by the outcome of this proceeding. Accordingly, the parties respectfully request that the Board terminate the *inter partes* review of U.S. Patent No. 8,168,620.

In the past, the Board has terminated the entire proceedings based on joint motions to terminate even after the merits had been fully briefed and the matter was ready for oral argument, or even after oral argument. *See Toyota Motor Corp. v. Blitzsafe Tex. LLC*, IPR2016-00421, Paper 28 (Feb. 21, 2017) (granting motion to terminate even after all substantive papers were filed, “particularly in light of the fact that a final written decision is not due until more than four months from now”); *Plaid Techs., Inc. v. Yodlee, Inc.*, IPR2016-00273, Paper 29 (Feb. 8, 2017)

(granting motion to terminate because “the parties’ joint motions to terminate were filed prior to the oral hearings in these cases”); *Apex v. Resmed*, IPR2013-00512, Paper 39 (Sept. 12, 2014) (granting joint motion to terminate after the parties had fully briefed the matter); *Rackspace Hosting, Inc. v. Clouding IP, LLC*, CBM2014-00034, Paper 28 (Dec. 9, 2014) (granting motion to terminate after close of evidentiary record and less than ten days before trial); *Volusion v. Versata Software*, CBM2013-00018, Paper 52 (June 17, 2014) (granting motion to terminate after oral argument).

Further, because the Board has yet to conduct an oral hearing and issue a decision on the merits, termination of the entire proceeding would save the Board significant administrative resources. Termination would also further AIA’s purpose of providing an efficient and less costly alternative forum for patent disputes and its encouragement for settlement.

IV. Related Litigations Involving The Patent At Issue

Litigations involving the patent at issue in this proceeding are set forth below. As shown below, none of these litigations is currently pending as each has been resolved.

Case	Defendant(s)
<i>Meda Pharmaceuticals Inc. et al v. Apotex Inc. et al.</i> , 14-1453-LPS (D. Del.) (filed Dec. 2, 2014; settled May 17, 2017)	Apotex Inc. Apotex Corp.

<i>Meda Pharmaceuticals Inc. et al v. Teva Pharmaceuticals USA, Inc.</i> , 15-785-LPS (D. Del.) (filed Sept. 8, 2015; settled July 28, 2017)	Teva Pharmaceuticals USA, Inc.
<i>Meda Pharmaceuticals Inc. et al v. Perrigo UK FINCO Limited Partnership et al.</i> , 16-794 (D. Del.) (filed Sept. 9, 2016; settled July 7, 2017)	Perrigo UK FINCO Limited Partnership; Perrigo Company; Perrigo Pharmaceuticals Co.

V. Related *Inter Partes* Review Proceedings Currently Before The Office

There are no other *inter partes* review proceedings currently before the Office involving the patent at issue.

VI. Written Settlement Statement

Pursuant to 37 C.F.R. § 42.74(c), the parties are filing herewith as CIP2183 a true copy of the settlement agreement entered between the parties on May 16, 2018. The settlement agreement was entered into in contemplation of termination of this proceeding.

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate this proceeding in its entirety and grant the request to treat the settlement agreement between the parties as business confidential information.

Respectfully submitted,

/Michael Houston/

Date: May 17, 2018

Michael R. Houston
Reg. No. 58,486
Lead Attorney for Petitioner

Respectfully submitted,

/Dennies Varughese/

Date: May 17, 2018

Dennies Varughese
Registration No. 61,868
Lead Attorney for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above-captioned “JOINT MOTION TO TERMINATE PROCEEDINGS PURSUANT TO 35 U.S.C. § 317” was served in its entirety on May 17, 2018, upon the following parties via electronic mail upon the following counsel of record for the Petitioner:

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