

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APOTEX CORP.  
Petitioner

v.

ALCON RESEARCH, LTD.  
Patent Owner

Case IPR2013-00428  
Patent No. 8,268,299

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

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and pursuant to the authorization to file this motion provided by the Board during a conference call with the parties on July 10, 2014, Petitioner Apotex Corp. (“Apotex”) and Patent Owner Alcon Research, Ltd. (“Alcon”) jointly request the termination of this *inter partes* review of U.S. Patent No. 8,268,299.

The parties have settled their dispute and executed a settlement agreement to terminate this *inter partes* review and the parties’ co-pending *inter partes* review proceedings 2013-00429 and 2013-00430.

The parties’ settlement agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1020. 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).

Termination of this *inter partes* review is proper under 35 U.S.C. § 317(a) because the Board has not yet decided the merits of the proceeding. Indeed, the briefing and discovery process in this proceeding has not yet been completed. Alcon has filed a Patent Owner’s Response to the Petition, but Alcon’s declarants have not been deposed, and Apotex has not filed a Reply or any evidence in Reply. Alcon did not file a Motion to Amend and thus no such motion is pending.

No other party's rights will be prejudiced by the termination of this *inter partes* review. While there is no litigation pending between Alcon and Apotex relating to the patent that is the subject of this *inter partes* review, there is pending litigation relating to this patent between Alcon and other parties in the following actions: (1) *Alcon Research, Ltd. v. Mylan Pharmaceuticals Inc. & Mylan Inc.*, No. 1:13-cv-01332 (SLR) (D. Del.), (2) *Alcon Research, Ltd. v. Wockhardt Ltd., Wockhardt Bio AG, & Wockhardt USA, LLC*, No. 1:13-cv-02040 (SLR) (D. Del.), (3) *Alcon Research, Ltd. v. Micro Labs Ltd. & Micro Labs USA Inc.*, No. 1:14-cv-00014 (SLR) (D. Del.), and (4) *Alcon Research, Ltd. v. Watson Labs., Inc., Actavis, Inc. and Actavis Pharma, Inc.*, No. 1:14-cv-00647 (SLR) (D. Del.). Each of these litigations is at an early stage. The *Mylan* action is the fact discovery period. The *Wockhardt* action is also in the fact discovery period, albeit at an earlier stage than the *Mylan* action. The *Micro* action has been stayed pending the outcome of the *Mylan* or *Wockhardt* actions. The *Watson* action has just begun, as *Watson* has not yet filed an Answer. None of these other parties' rights will be impacted by the termination of this *inter partes* review.

There are no other proceedings pending before the Patent and Trademark Office relating to the patent at issue in this *inter partes* review.

Case IPR2013-00428  
U.S. Patent No. 8,268,299

Accordingly, Apotex and Alcon respectfully request that this *inter partes* review proceeding be terminated.

Dated: July 14, 2014

Respectfully submitted,

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

The undersigned hereby certifies that a copy of the foregoing “Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317,” along with Exhibit 1020, were served in their entirety on July 14, 2014, via email upon the following counsel of record for the Patent Owner:

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Date: July 14, 2014

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