

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner

v.

WARNER CHILCOTT COMPANY, LLC.,
Patent Owner

Case IPR2015-00682
Patent 7,704,984

**JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of August 17, 2015, Petitioner Mylan Pharmaceuticals Inc. and Patent Owner Warner Chilcott Company, LLC jointly move to terminate the present *inter partes* review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 7,704,984 ("the '984 patent"). The parties are filing, concurrently herewith, a true and complete copy of their written Settlement Agreement in connection with this matter as required by the statute. The Settlement Agreement completely settles the parties' controversy and their dispute relating to the '984 patent as between Patent Owner and Petitioner and the entities named as real parties-in-interest in the present proceeding, including the entities named as defendants in the U.S. district court litigation captioned *Warner Chilcott Company, LLC v. Mylan Inc. et al.*, Civil Action No. 3:13-6560 (JAP) (D.N.J.). The parties will file a Stipulation and Order of Dismissal in the district court litigation within ten (10) business days of the Settlement Date (*see* Exhibit B to Settlement Agreement).

The parties further jointly certify that there is no other agreement or understanding between Patent Owner and Petitioner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '984 patent. A joint request to treat the Settlement Agreement as business confidential information is filed concurrently herewith.

Termination With Respect to Inter Partes Review Proceeding

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). Each is addressed in turn below:

1. Termination is appropriate in this proceeding because the parties have settled their dispute with respect to the '984 patent, and have agreed to terminate this *inter partes* review. The applicable statute, 35 U.S.C. § 317(a), provides that an *inter partes* review proceeding “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.” In this case, the *inter partes* review has not yet been instituted. The Patent Owner’s Preliminary Response to the petition was filed on May 21, 2015,

and the Office has made no decision on the merits. Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding, *see* Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012), and no public interest or other factors militate against termination of this proceeding.

2. The following litigations involved the '984 Patent:

Case Caption	Disposition
<i>Warner Chilcott Company, LLC v. Lupin Ltd., et al.</i> , C.A. No. 11-5048 (JAP) (D.N.J.)	closed
<i>Warner Chilcott Company, LLC v. Amneal Pharmaceuticals, LLC, et al.</i> , C.A. No. 12-2928 (D.N.J.)	closed
<i>Warner Chilcott Company, LLC v. Lupin Ltd. et al.</i> , C.A. No. 2014-1262, -1273 (Fed. Cir.)	closed
<i>Warner Chilcott Company, LLC v. Mylan Inc. et al.</i> , C.A. No. 3:13-6560 (JAP) (D.N.J.)	settled
<i>Bayer Intellectual Property GMBH et al., v. Warner Chilcott Company LLC, et al.</i> , C.A. No. 1:12-1032 (GMS) (D. Del.) ¹	pending

3. There are no related proceedings currently before the U.S. Patent & Trademark Office involving the patent at issue.

4. As discussed above, the parties have settled and will file a stipulation and order of dismissal in the pending district court case, *Warner Chilcott Company,*

¹ This case is on appeal to the Federal Circuit, and concerns whether the '984 patent and a patent owned by Bayer are "interfering patents."


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LLC v. Mylan Inc. et al., Civil Action No. 3:13-6560 (JAP), United States District Court, District of New Jersey.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

Date: August 19, 2015

Respectfully submitted,

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