

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.
APOTEX, INC.
Petitioner

v.

ALLERGAN, INC.
Patent Owner.

Case IPR2015-01278
Patent 8,633,162

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

***Joint Motion to Terminate
IPR2015-01278***

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Apotex Corp. and Apotex, Inc. (“Petitioner”) and Patent Owner Allergan, Inc. (“Patent Owner”) jointly request termination of this *inter partes* review (IPR) of U.S. Patent 8,633,162 (“the ’162 patent”), Case No. IPR2015-01278. **The parties note that the Decision on Institution is currently set for Wednesday, December 16, 2015.**

The parties have settled their disputes, and have reached agreement to terminate this IPR. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on December 15, 2015.

Termination of this proceeding is proper for at least the following reasons:

- The parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are **strong public policy reasons to favor settlement** between the parties to a proceeding”) (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. For example, it endorses the ability of parties to agree to never challenge validity as

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part of a settlement. *See Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1370 (Fed. Cir. 2001); *see also Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not yet “decided the merits of the proceeding **before the request for termination is filed.**” 35 U.S.C. § 317(a) (emphasis added); 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.”) Indeed, the Board has not yet made a decision on institution of this *inter partes* review. Apotex filed its petition for *inter partes* review on June 4, 2015. No Motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (And 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

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decided the merits of the proceeding before the request for termination is filed.”)

- The only related pending district court litigation regarding the ’162 patent is *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc. et al., & Innopharma, Inc.*, C.A. No. 2:15-cv-1455-JRG (E.D. Tex. 2015) (consolidated) and *Allergan, Inc. v. Innopharma, Inc., & Pfizer, Inc.*, C.A. No. 1:15-cv-00815 (D. Del. 2015). The validity of the ’162 patent was already previously challenged (unsuccessfully) by a generic drug manufacturer in the U.S. District Court for the Eastern District of Texas, *Allergan, Inc. v. Actavis, Inc. et al.*, Case No. 2:14-cv-00638-JRG (E.D. Tex. 2014).
- Further, the parties are unaware of any other matter before the USPTO that would be affected by the outcome of this proceeding. And there are no pending related proceedings regarding the ’162 patent before the Board.

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The settlement agreement between the parties has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)-(c).

Dated: December 15, 2015

Respectfully Submitted,

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