

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.

Petitioner

v.

3M COMPANY et al.

Patent Owner

Case IPR2015-02002

Patent 6,743,413

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

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Mylan Pharmaceuticals Inc. (“Petitioner”) and 3M Company (“Patent Owner”) jointly request termination of this *inter partes* review (IPR) of U.S. Patent 6,743,413 (“the ’413 patent”), Case No. IPR2015-02002. 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 November 15, 2016.

The parties believe that termination of the 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. *See, e.g., Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1370 (Fed. Cir. 2001); *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 oral hearing for the present proceeding has not yet occurred and is scheduled for December 5, 2016. 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. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (Also 35 U.S.C. § 317(a), which provides that “[a]n *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.”)

- There is no related litigation regarding the '413 patent.
- 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 '413 patent before the Board.

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: November 15, 2016

Respectfully Submitted,

/Jitendra Malik/

Jitendra Malik, Ph.D., Reg. No. 55,823
Robert J. Caison, Reg. No. 72,939

Attorneys for Mylan Pharmaceuticals Inc.
Customer Number 00826
Alston & Bird LLP
Telephone: (919) 862-2210
Facsimile: (919) 862-2260

/Dorothy P. Whelan/

Dorothy P. Whelan, Reg. No. 33,814

Gwilym Attwell, Reg. No. 45,449

John R. Lane, Reg. No. 47,733

Attorneys for 3M Company

Customer Number 26171

Fish & Richardson P.C.

Telephone: (612) 337-2508

Facsimile: (612) 288-9696