

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RANBAXY INC.

Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.

Patent Owner

Case IPR2016-00024
Patent 8,772,306

JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317(a)

As authorized in the Patent Trial and Appeal Board's (the "Board") May 11, 2016 e-mail (Ex. 2020), 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. 8,772,306 (the "'306 patent") be terminated.

1. Brief Explanation As To Why Termination Is Appropriate

Petitioner filed its petition for IPR on October 7, 2015. (Paper 1.) On October 16, 2015, the Board accorded the petition a filing date, and gave Patent Owner until January 16, 2016 to file a Preliminary Response. (Paper 3.) On January 15, 2016, Patent Owner timely filed a Preliminary Response. (Paper 8.) On April 12, 2016, the Board issued its Decision on Institution, partially instituting and partially denying institution of the challenged claims. (Paper 10.)

Shortly thereafter, the parties settled their dispute and executed a confidential settlement agreement to terminate this proceeding and the parties' related district court litigation: *Jazz Pharmaceuticals, Inc. et al. v. Amneal Pharmaceuticals, LLC. et al.*, 13-391-ES-JAD (D.N.J.). A Stipulation and Order of Dismissal agreed to by the parties in the related district court litigation is being filed concurrently in the district court.

Pursuant to 37 C.F.R. § 42.74(b), the parties' confidential settlement agreement is in writing, and a true and correct copy is being filed concurrently

herewith as Exhibit 2021.¹ The parties are also filing concurrently herewith a joint request to treat the confidential settlement agreement as business confidential information and keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Termination of this proceeding is proper under 35 U.S.C. § 317(a) because the proceeding is in its early stages and the Board has not yet decided the merits of this proceeding. Further, no other Petitioners remain in this proceeding, and the parties are unaware of any other matter before the USPTO that would be affected by the outcome of this proceeding as explained below. The related litigations also involve several patents other than the patent at issue in this IPR. Accordingly, the parties respectfully request that the Board terminate the *inter partes* review of U.S. Patent No. 8,772,306.

2. Related Litigations Involving The Patent At Issue

The related litigations involving the patent at issue in this proceeding, as well as the defendants in each case, are set forth below.

¹ The settlement agreement is being filed electronically via the Patent Review Processing System with access to the “Parties and Board Only.”

Case	Defendants
<i>Jazz Pharmaceuticals, Inc. et al. v. Roxane Laboratories, Inc.</i> , 15-1360-ES-JAD (D.N.J.)	Roxane Laboratories, Inc.
<i>Jazz Pharmaceuticals, Inc. et al. v. Amneal Pharmaceuticals, LLC. et al.</i> , 13-391-ES-JAD (D.N.J.)	Amneal Pharmaceuticals, LLC Par Pharmaceutical, Inc. Watson Laboratories, Inc. Lupin Ltd., Lupin Pharmaceuticals Inc., and Lupin Inc.

3. Related Proceedings Currently Before The Office

The Board has denied institution of IPR of the '306 patent in IPR2016-00002. Another petition for IPR of the '306 patent has been filed by a different party, Amneal Pharmaceuticals LLC, but no decision on institution has been rendered in that proceeding. *See* IPR2016-00546.

4. Current Status Of The Related Litigations

The litigations against all other defendants remain pending. Each litigation involves multiple patents and no trial date has been set in any proceeding.

For the foregoing reasons, the parties jointly and respectfully request termination of the present proceeding.

Date: May 12, 2016

Respectfully submitted,

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