

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC. and MYLAN LABORATORIES  
LIMITED,  
Petitioners

v.

BAXTER INTERNATIONAL INC. and BAXTER HEALTHCARE S. A.,  
Patent Owners

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Case IPR2016-00217  
Patent No. 6,310,094

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

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a), Petitioners Mylan Pharmaceuticals Inc. and Mylan Laboratories Limited (“Petitioners”) and Baxter International, Inc. and Baxter Healthcare S. A. (“Patent Owners”) (together, “the Parties”) jointly request termination of the *inter partes* Review of U.S. Patent No. 6,310,094, Case No. IPR2016-00217. In accordance with 37 C.F.R. § 42.20(b), the Parties sought, and received, authorization from the Board to file this motion on April 25, 2016.

The Parties have settled their disputes. The Parties’ settlement is memorialized in a Settlement Agreement, a true and correct copy of this agreement is filed as Exhibit 1026. The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. § 42.74(c) and a joint request to that effect is being filed concurrently herewith.

## II. TERMINATION IS APPROPRIATE

Termination of this proceeding is proper because the IPR is in its early stages. The Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 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.”). *See Oracle Corp. v. Community United IP, LLC*, Case No. CBM2013-00015, Paper No. 13 (PTAB Jul. 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

At this early point in the proceeding, no decision on institution has been issued by the Board. Thus, the Board has not yet decided the merits of the proceeding at the time this motion for termination is filed.

The litigation between the Parties related to this proceeding has also been settled.<sup>1</sup> And the Parties are unaware of any other matter before the USPTO that would be affected by the settlement and termination of this proceeding, and there are no other proceedings before the Board involving the '094 Patent.

For all these reasons, the Parties respectfully request the Board terminate this proceeding, Case No. IPR2016-00217.

Dated: April 25, 2016

Respectfully submitted,

/ Steven W. Parmelee /

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<sup>1</sup> Other litigations involving the '094 Patent are still pending, but do not involve the Petitioners.

Case No. IPR2016-00217  
U.S. Patent No. 6,310,094

/ James W. Hill /

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LIST OF EXHIBITS

| Exhibit No. | Description  |
|-------------|--|
| 1001        | U.S. Patent No. 6,310,094 to Liu <i>et al.</i>   |
| 1002        | Declaration of Robert J. Linhardt, Ph.D.   |
| 1003        | <i>Curriculum Vitae</i> of Robert J. Linhardt, Ph.D.   |
| 1004        | File history of 6,310,094 to Liu <i>et al.</i>   |
| 1005        | Brevibloc <sup>®</sup> Injection. (1999). In <i>Physicians' Desk Reference</i> (53rd ed., 624-626). Montvale, NJ: PDR Network.   |
| 1006        | Y.C. Lee <i>et al.</i> , <i>High-Performance Liquid Chromatographic Method for the Determination of Esmolol Hydrochloride</i> . 73 J. PHARM. SCI. 1660 (1984)                                      |
| 1007        | S. Turco and R. E. King, <i>Chapters 4 and 8, STERILE DOSAGE FORMS: THEIR PREPARATION AND CLINICAL APPLICATION</i> (3rd ed., 1987)   |
| 1008        | U.S. Patent No. 5,129,894 to Sommermeyer <i>et al.</i>   |
| 1009        | Brevibloc Injection Label, Center for Drug Evaluation and Research, 1988.  |
| 1010        | L. Blanski <i>et al.</i> , <i>Esmolol, the first ultra-short-acting intravenous beta blocker for use in critically ill patients</i> , 17 HEART LUNG 80 (1988)                                      |
| 1011        | D.J. Pearce, <i>Brevibloc drug errors</i> , 43 CAN. J. ANESTH. 419 (1996)  |
| 1012        | U.S. Patent No. 4,857,552 to Rosenberg <i>et al.</i>   |
| 1013        | <i>Chapters 36 and 84, REMINGTON'S 19<sup>TH</sup> EDITION: THE SCIENCE AND PRACTICE OF PHARMACY</i> . (A. Gennaro ed. 1995)   |
| 1014        | D. M. Baaske <i>et al.</i> , <i>Stability of esmolol hydrochloride in intravenous solutions</i> , 51 AM. J. HOSP. PHARM. 2693 (1994)   |
| 1015        | P. Pittenger, <i>The Biologic Standardization of Local Anesthetics With Special Reference to Effect of Sterilization on Solutions of Cocaine and Procaine</i> , 12 J. AM. PHARM. ASSOC. 229 (1923) |
| 1016        | J. B. Murray <i>et al.</i> <i>Stability of Cocaine in Aqueous Solution</i> 3 J. CLIN. PHARM. 1 (1978)  |
| 1017        | J. T. Murphy <i>et al.</i> , <i>Preparation, Sterilization, and Preservation of Ophthalmic Solutions: Experimental Studies and a Practical</i>   |

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