

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

SANOFI-AVENTIS U.S. LLC and
SANOFI-AVENTIS DEUTSCHLAND GMBH,
Petitioners,

v.

ASTRAZENECA PHARMACEUTICALS LP and
AMYLIN PHARMACEUTICALS, LLC,
Patent Owners.

Cases IPR2016-00353 (Patent 7,691,963 B2),
IPR2016-00354 (Patent 8,445,647 B2), and
IPR2016-00355 (Patent 8,951,962 B2)¹

Filed: October 6, 2016

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

¹ The word-for-word identical paper is filed in each proceeding identified in the heading.

I. PRECISE RELIEF REQUESTED

Petitioners sanofi-aventis U.S. LLC and Sanofi-Aventis Deutschland GmbH (“Sanofi”) and Patent Owners AstraZeneca Pharmaceuticals LP and Amylin Pharmaceuticals, LLC (“AstraZeneca”) (Sanofi and AstraZeneca collectively identified as “the Parties”), by and through their respective counsel, jointly request termination of the above-captioned *inter partes* review proceedings of U.S. Patent Nos. 7,691,963, 8,445,647, and 8,951,962 pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74. The parties have fully and finally resolved the dispute between them and entered into a Settlement Agreement effective September 28, 2016 (“Agreement”) formally settling the dispute.

On October 5, 2016, the Parties emailed the Board to request the Board’s authorization to file a joint motion to terminate the above-captioned *inter partes* review proceedings. The Parties also sought the Board’s authorization to file with the motion to terminate a request to treat the written Agreement as business confidential information. Later on October 5, 2016, the Board authorized the Parties to file both a motion to terminate and a request to treat the agreement as business confidential information.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed.

Case IPR2016-00353 (U.S. Patent No. 7,691,963)
Case IPR2016-00354 (U.S. Patent No. 8,445,647)
Case IPR2016-00355 (U.S. Patent No. 8,951,962)

Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on October 5, 2016. Guidance as to the content of a motion to terminate is provided in IPR2015-00293, Paper No. 7. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements and is accompanied by the Agreement made in connection with termination of these proceedings, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (b).

A. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because these proceedings are in their very early stages: Patent Owners have not filed their Patent Owners' Responses to the Petitions, Petitioners have not filed their Replies to the Patent Owners' Responses, the Parties have not filed motions to exclude, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. By virtue of the Agreement, the dispute between the Parties has been resolved, including the Parties' related litigation. Per the Agreement, the Parties filed a Stipulation of Dismissal with Prejudice of the related litigation on

Case IPR2016-00353 (U.S. Patent No. 7,691,963)
Case IPR2016-00354 (U.S. Patent No. 8,445,647)
Case IPR2016-00355 (U.S. Patent No. 8,951,962)

October 3, 2016 and the Court approved entry of the stipulated dismissal with prejudice on October 5, 2016. There are no other pending cases involving U.S. Patent No. 7,691,963, 8,445,647, or 8,951,962.

B. All Parties in Any Pending Related Litigation Involving the Patent at Issue

In addition, Petitioners were the named Plaintiffs in the above-referenced litigation and Patent Owners were the named Defendants. That litigation has been dismissed in its entirety. No future litigation amongst the Parties or their affiliates involving the U.S. Patent No. 7,691,963, 8,445,647, or 8,951,962 is contemplated.

C. Related Proceedings Currently Before the Office

There are a total of three related IPRs before the PTAB - Cases IPR2016-00353 (Patent 7,691,963 B2), IPR2016-00354 (Patent 8,445,647 B2), and IPR2016-00355 (Patent 8,951,962 B2). The Parties are seeking to dismiss all three of these IPRs.

III. Agreement

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Agreement is in writing, and a true and correct copy is being filed concurrently herewith as

Case IPR2016-00353 (U.S. Patent No. 7,691,963)
Case IPR2016-00354 (U.S. Patent No. 8,445,647)
Case IPR2016-00355 (U.S. Patent No. 8,951,962)

Exhibit A.² The parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the Agreement as business confidential information to be kept separate from the file of the involved patents.

IV. CONCLUSION

For all these reasons, the Parties respectfully request termination of the *Inter Partes* Review of Cases IPR2016-00353 (Patent 7,691,963 B2), IPR2016-00354 (Patent 8,445,647 B2), and IPR2016-00355 (Patent 8,951,962 B2).

Respectfully submitted this 6 day of October, 2016.

By: /s/ Paul H. Berghoff
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Lead Counsel for Petitioner

By: /s/ David I. Berl
David I. Berl
Reg. No. 72,751
Lead Counsel for Patent Owner

² The Agreement is being filed via the PTAB E2E (End to End) system with access to the “Parties and Board only.”

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