

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC,
APOTEX INC., AND APOTEX CORP.
Petitioners

v.

ALCON RESEARCH, LTD.
Patent Owner

Case IPR2016-00544¹
Patent No. 8,791,154 B2

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

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and pursuant to the authorization to file this motion provided by the Board via email on November 29, 2016, Petitioners Argentum Pharmaceuticals LLC (“Argentum”), Apotex Inc. and Apotex Corp. (“Apotex”), and Patent Owner Alcon Research, Ltd. (“Alcon”) jointly request the termination of this *inter partes* review of U.S. Patent No. 8,791,154.

¹ Petitioners Apotex Inc. and Apotex Corp. from IPR2016-01640 have been joined as a Petitioner to this proceeding.

Argentum, Apotex and Alcon have settled their disputes, and have reached agreements to terminate this *inter partes* review. The parties' settlement agreements have been made in writing, and a true and correct copies of the two agreements are being filed concurrently herewith as Exhibits 2004 and 2005. The parties are also filing concurrently herewith joint requests to treat the settlement agreements as business confidential information and keep them separate from the files of the IPR and the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Termination of this *inter partes* review is proper under 35 U.S.C. § 317(a) because the Board has not yet decided the merits of the proceeding. Indeed, the briefing and discovery process in this proceeding has not yet been completed. Alcon has not yet filed a Patent Owner's Response to the Petition nor has Alcon filed a Motion to Amend.

No other party's rights will be prejudiced by the termination of this *inter partes* review. There is pending litigation relating to this patent between Alcon and other parties in the following consolidated actions *Alcon Research, Ltd. v. Watson Laboratories, Inc.*, No. 1:15-cv-1159 (SLR) (SRF) (D. Del.) and *Alcon Research, Ltd. v. Lupin Ltd. and Lupin Pharmaceuticals, Inc.*, No. 1:16-cv-195 (SLR) (SRF) (D. Del.). This litigation is at an early stage, as the action is in the

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fact discovery period. None of these other parties' rights will be impacted by the termination of this *inter partes* review.

There is also a pending litigation involving Apotex and Alcon, *Alcon Research, Ltd. v. Apotex Inc. and Apotex Corp.*, No. 1:16-cv-906 (SLR) (D. Del.), which will be dismissed by stipulation contemporaneously with the termination of this *inter partes* review.

Other than the present IPR, there are no other proceedings pending before the Patent and Trademark Office relating to the patent at issue in this *inter partes* review.

Accordingly, Apotex and Alcon respectfully request that this *inter partes* review proceeding be terminated as to Apotex.

Dated: November 30, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the foregoing “JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317” was served on November 30, 2016, by filing this document through the PTAB E2E system as well as delivering a copy via electronic mail to the following attorneys of record for the Petitioners:

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