

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRONTIER THERAPEUTICS, LLC

Petitioner

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE
SPEZIALPRÄPARATE MBH

Patent Owner

Inter Partes Review Case No. 2016-00649

Patent No. 8,664,231

Title: Concentrated Methotrexate Solutions

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

I. STATEMENT OF PRECISE RELIEF REQUESTED AND STATEMENT OF FACTS

Pursuant to 35 U.S.C. § 317(a), Petitioner Frontier Therapeutics, LLC (“Petitioner”) and Patent Owner medac Gesellschaft für klinische Spezialpräparate mbH (“Patent Owner”) jointly request withdrawal of Petitioner’s Petition for *Inter Partes* Review (“IPR”) and termination of IPR2016-00649, directed to U.S. Patent 8,664,231 (the “‘231 Patent”). The United States Patent Trial and Appeal Board (“Board”) authorized this motion on November 21, 2016.

On February 22, 2016, Petitioner filed a Petition for an IPR of the ‘231 Patent. Patent Owner’s Preliminary Response was filed on June 2, 2016. The Board instituted *inter partes* review on September 1, 2016. Due Date 1 is currently set for December 2, 2016. The parties agree to extend that date, as necessary. The Board has not had trial or issued a final written decision.

Under 35 U.S.C. § 317(a), “[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.” The parties have settled their disputes with respect to the ‘231 Patent, and have reached agreement to file the present motion, seeking withdrawal of the Petition and termination of this IPR. Moreover, termination is appropriate here because this trial is in its very early

stages. No discovery has been conducted or exchanged. No motions are pending. And, Patent Owner has not filed its § 42.120 Response to Petition.

The parties, thus, jointly request that the Board withdraw the Petition and terminate IPR2016-00649 in view of the settlement reached between the parties.

II. RELATED PROCEEDINGS

There are no related proceedings in the District Court or Federal Circuit. Before the Board, there is a pending *inter partes* review in the context of the '231 patent, Koios Pharmaceuticals LLC v. medac Gesellschaft für klinische Spezialpräparate mbH, IPR2016-01370. That petition was accorded a filing date of July 20, 2016 and Patent Owner filed its Preliminary Response, as provided in Paper No. 6, on November 10, 2016. Petitioner has not filed any motion for joinder. And, the Board has not issued any Institution Decision.

III. CONCLUSION

For the foregoing reasons, the parties respectfully request withdrawal of Petitioner's Petition for *Inter Partes* Review and termination of Case No. IPR2016-00649 involving U.S. Patent 8,664,231.

Dated: November 22, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

It is hereby certified that on this 22nd day of November, 2016, a copy of the Joint Motion To Terminate Proceeding Pursuant to 35 U.S.C. § 317 was served via electronic mail upon the following:

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November 22, 2016

Respectfully submitted,

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