

Case IPR2016-01578  
Patent 8,338,470

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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AMNEAL PHARMACEUTICALS LLC,  
Petitioner

v.

HOSPIRA, INC.,  
Patent Owner

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Case No. IPR2016-01578  
Patent No. 8,338,470

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**JOINT MOTION TO TERMINATE THE *INTER PARTES* REVIEW**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Patent Owner Hospira, Inc. (“Patent Owner”) and Petitioner Amneal Pharmaceuticals LLC (“Amneal”) jointly request termination of IPR2016-01578, which is directed to U.S. Patent No. 8,338,470 (the “‘470 Patent”).

On August 10, 2016, Amneal filed a Petition for *Inter Partes* Review (“Amneal IPR” – which is the above-captioned *Inter Partes* Review, *i.e.*, IPR2016-01578) before the United States Patent Trial and Appeal Board (the “Board”). Patent Owner’s preliminary response was filed on November 10, 2016 in the Amneal IPR. On February 9, 2017, the Board issued a Decision to Institute *Inter Partes* Review of the ‘470 Patent in the Amneal IPR. Paper No. 11.

Patent Owner has not filed a response in the *Inter Partes* Review and one is not due (by stipulation of Amneal and Patent Owner, filed May 1, 2017, Paper 16) until May 29, 2017.

Patent Owner and Amneal respectfully submit that termination with respect to Amneal is appropriate because they have reached an agreement resolving the dispute involving the patent at issue in the above-captioned *Inter Partes* Review, it is prior to full briefing on the issues raised in the above-captioned *Inter Partes* Review, and the Board has not issued a final written decision. Further, Amneal represents that it will no longer participate even if the Board does not terminate its participation in the above-captioned *Inter Partes* Review. This means that Amneal

will file no further papers. It also will not conduct any examination of Patent Owner's witnesses and will not be participating in any oral argument.

The Patent Owner and Amneal jointly requested authorization to file the instant Motion and a Joint Motion to treat the Settlement Agreement as business confidential information (filed concurrently herewith) on April 17, 2017. The Board authorized filing of the Motions in an email dated April 26, 2017.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), filed herewith is a true copy of the written Confidential Settlement Agreement resolving the dispute in the above-captioned *Inter Partes* Review. See Exhibit 1067.

Patent Owner and Amneal are concurrently filing a Joint Request that the Settlement Agreement, Confidential Exhibit 1067, shall be treated as business confidential information, shall be kept separate from the file of the involved patent, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c).

Respectfully Submitted,

Dated: May 3, 2017

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Dated: May 3, 2017

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## CERTIFICATE OF SERVICE

I hereby certify that on May 3, 2017, true copies of the accompanying JOINT MOTION TO TERMINATE THE *INTER PARTES* REVIEW and Exhibit 1067 were served on the Patent Owner via electronic mail to the following correspondence addresses:

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Respectfully submitted,  
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