

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN TECHNOLOGIES INC.,  
Petitioner,

v.

MONOSOL RX, LLC,  
Patent Owner.

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Case IPR2017-00200  
Patent No. 8,603,514

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**JOINT MOTION TO TERMINATE PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

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Patent 8,603,514

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of September 28, 2017, Petitioner Mylan Technologies, Inc. ("Mylan") and Patent Owner MonoSol Rx, LLC jointly move to terminate the present *inter partes* review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 8,603,514 ("the '514 patent"). The parties are filing, concurrently herewith, a true and complete copy of their written Settlement and License Agreement ("Settlement Agreement") (Confidential Exhibit 1030) in connection with this matter as required by the statute. The Settlement Agreement completely settles the parties' controversy and their dispute relating to the '514 patent as between Patent Owner and Mylan, the Petitioner and real party-in-interest in the present proceeding, who was named as a defendant in the U.S. district court litigation captioned *Indivior Inc., et al. v. Mylan Technologies Inc., et al.*, C.A. No. 1:15-01016-RGA (D. Del.). In the district court litigation, the parties will file a Consent Judgment in the district court litigation within one (1) business day after exchange of consideration (*see* Settlement Agreement (Confidential Exhibit 1030), para. 2.1 and Exhibit A).

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including

any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Settlement Agreement (Confidential Exhibit 1030) be treated as business confidential information and kept separate from the file of the '514 patent. A joint request to treat the Settlement Agreement as business confidential information, kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b), is being filed concurrently herewith.

#### Termination of *Inter Partes* Review Proceeding

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at \*2 (PTAB July 28, 2014). Each element is addressed below.

As for requirement (1), termination is appropriate in this proceeding because the parties have settled their dispute with respect to the '514 patent, and have agreed to terminate this *inter partes* review. The applicable statute, 35 U.S.C. § 317(a), provides that an *inter partes* review proceeding “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.” In this case, the *inter partes* review has been instituted, but the parties’ filings are still in process and the oral hearing is set for January 10, 2018. The Office has made no final decision on the merits. Moreover, as recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48,768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As for requirements (2) and (4), the table below identifies parties in district court litigations that involve or involved the ’514 patent, and discusses the current status of these related litigations with respect to each party to the litigation. *See Heartland Tanning, Inc.*, Paper No. 26, at \*2. Petitioner and Patent Owner believe that all of the named defendants in the below-identified litigations are time-barred from filing IPR petitions challenging the ’514 patent. In particular, the defendant

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in the most recently filed litigation, Actavis Laboratories UT, Inc., was previously named in the June 2015 Second Amended Complaint in *Reckitt Benckiser Pharmaceuticals Inc., RB Pharmaceuticals Limited, and MonoSol Rx, LLC v. Watson Laboratories Inc. and Actavis, Inc.*, C.A. No. 1:13-cv-01674 (D. Del.) (original complaint filed on October 8, 2013).

<b>Case Caption</b>	<b>Current Status of Each Related Litigation With Respect to Each Party to the Litigation or Proceeding</b>
<i>Indivior Inc., et al. v. Actavis Laboratories UT, Inc.</i> , No. 1:16-cv-01009 (D. Del.) (filed on October 31, 2016)	Pending
<i>Indivior Inc., Indivior UK Limited, and MonoSol Rx, LLC v. Teva Pharmaceuticals USA, Inc.</i> , C.A. No. 1:16-cv-00178 (D. Del.) (filed on March 21, 2016)	Stayed on May 3, 2016
<i>Indivior Inc., Indivior UK Limited, and MonoSol Rx, LLC v. Sandoz Inc.</i> , C.A. No. 1:15-cv-01051 (D. Del.) (filed on November 13, 2015)	Closed on August 22, 2016
<i>Indivior Inc., Indivior UK Limited, and MonoSol Rx, LLC v. Mylan Technologies Inc., Mylan Pharmaceuticals Inc., and Mylan N.V.</i> , C.A. No. 1:15-cv-00209 (N.D.W.Va.) (filed on November 5, 2015)	Stayed on January 8, 2016
<i>Indivior Inc., Indivior UK Limited, and MonoSol Rx, LLC v. Mylan Technologies Inc., Mylan Pharmaceuticals Inc., and Mylan N.V.</i> , C.A. No. 1:15-cv-01016 (D. Del.) (filed on November 4, 2015)	Pending
<i>Reckitt Benckiser Pharmaceuticals Inc., RB Pharmaceuticals Limited, and MonoSol Rx, LLC v. Alvogen Pine Brook, Inc.</i> , C.A. No. 1:15-cv-00477 (D. Del.) (filed on June 10, 2015)	Pending

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