

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

QUALICAPS CO., LTD,
Patent Owner

IPR2017-00203
Patent 6,649,180 B1

JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317(a)

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of December 18, 2017, Patent Owner and Petitioner jointly request that the inter partes review ("IPR") of U.S. Patent No. 6,649,180 be terminated.

The parties have settled their dispute and executed a settlement agreement to terminate this proceeding and the parties' related district court

litigation: *Allergan Sales, LLC, and Qualicaps Co., Ltd. v. Mylan Pharmaceutical, Inc., Mylan Laboratories Limited, and Mylan, Inc.*, which action is on appeal to the United States Court of Appeals for the Federal Circuit under the caption *Warner Chilcott (US), LLC v. Teva Pharmaceuticals USA, Inc.*, Appeal No. 2018-1241 (Fed. Cir.). The Stipulations and Orders of Dismissal agreed to by the parties in these related litigations attached as Exhibit 1030 are to be filed within two days of the Board's Order to Terminate.

Pursuant to 37 C.F.R. §§ 42.74(b), the parties' settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1031. The parties are also filing concurrently herewith a joint request to treat the settlement as business confidential information and keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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).

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 '180 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 is still in progress and the oral hearing is set for January 25, 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 '180 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 barred from filing IPR petitions challenging the '180 patent.

Case Caption	Status
<i>Allergan Sales v. Teva</i> , No. 15-1471, 17-343 (consolidated) (E.D. Texas)	On appeal
<i>Warner Chilcott v. Zydus</i> , No. 16-323 (E.D. Texas)	Dismissed pursuant to stipulation

Finally, as discussed above, the Settlement Agreement, contingent upon the entry of the Board's Order to Terminate, fully resolves all litigation and proceedings between the parties to this IPR proceeding relating to the '180 patent.

Accordingly, the parties respectfully request termination of this proceeding.

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