

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC,
Petitioner

v.

ICOS CORPORATION,
Patent Owner

Case IPR2017-00323
Patent No. 6,943,166

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

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a), Petitioner Mylan Pharmaceuticals Inc. (“Petitioner”) and Patent Owner ICOS Corporation (“Patent Owner”) (together, “the Parties”) jointly request termination of the *inter partes* review of U.S. Patent No. 6,943,166 (’166 patent), Case No. IPR2017-00323 in light of the Parties’ resolution of their dispute relating to this IPR. In accordance with 37 C.F.R. § 42.20(b), the Parties sought, and received, authorization via email from the Board to file this motion on July 6, 2017.

The Parties have settled their disputes regarding the ’166 patent. The Parties’ settlement is memorialized in agreements (collectively referred to herein as “Settlement Agreements”), true and correct copies of which are filed as Exhibit 1038, as required by 35 U.S.C. § 317(b).

II. TERMINATION IS APPROPRIATE

The Parties have reached agreement regarding their disputes relating to the ’166 patent. Pursuant to Section III.A of the Binding Term Sheet, Patent Owner and Petitioner jointly agreed to terminate this proceeding. (Ex. 1038 at 1.) Accordingly, the parties jointly request that this proceeding be terminated under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74.

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The litigation between the Parties related to this proceeding has also been settled and the parties have agreed to stipulate to dismiss the related litigation. (Ex. 1038 at 5.)

The Parties are unaware of any other matter before the USPTO that would be affected by the settlement and termination of this proceeding. Institution of IPR2017-00412 (Monosol Rx, LLC v. ICOS Corporation), which also involved the '166 Patent, was denied on July 3, 2017 (Paper No. 11).

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.” This proceeding has been instituted but the Patent Owner has not yet filed a Patent Owner Response and the Board has not decided on the merits of the proceeding.

Strong public policy considerations favor settlement between the parties to an inter partes review proceeding. *See* Office Trial Practice Guide, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012). No public interest or other factors weigh against termination of this proceeding.

Because the underlying disputes have been resolved between the parties and because full termination would encourage settlement of Patent Office proceedings, consistent with federal judicial preference and the management of limited judicial

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and Patent Office resources, the Parties submit that termination of this proceeding is appropriate.

III. SUBMISSION OF THE SETTLEMENT AGREEMENTS

Submitted concurrently with this Motion are the Settlement Agreements between the Parties (EX1038), as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). The Parties jointly request that these Settlement Agreements be treated as business confidential and be kept separate from the file of the involved patent and be made available only to Federal Government agencies on written request or to any person only on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties are filing, concurrently herewith, a Joint Request to File the Settlement Agreements as Business Confidential Information.

IV. CONCLUSION

For the reasons stated above, the Parties respectfully request the Board terminate this proceeding, Case No. IPR2017-00323.

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Dated: July 7, 2017

Respectfully submitted,

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