

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FAMY CARE LIMITED
Petitioner

v.

ALLERGAN, INC.
Patent Owner.

Case IPR 2017-00566 (US 8,648,048 B2)
Case IPR 2017-00567 (US 8,629,111 B2)
Case IPR 2017-00568 (US 8,633,162 B2)
Case IPR 2017-00569 (US 9,248,191 B2)
Case IPR 2017-00570 (US 8,642,556 B2)
Case IPR 2017-00571 (US 8,685,930 B2)

**JOINT MOTION TO TERMINATE PROCEEDINGS PURSUANT TO 35
U.S.C. § 317(a)¹**

¹ The word-for-word identical paper is filed in each proceeding identified above in the caption pursuant to the Board's Scheduling Order (Paper 13).

Pursuant to 35 U.S.C. § 317(a), Petitioner Famy Care Limited (“Famy Care” or “Petitioner”) and Patent Owner Allergan, Inc. (“Allergan” or “Patent Owner”) jointly request termination of Case Nos. IPR2017-00566, IPR2017-00567, IPR2017-00568, IPR2017-00569, IPR2017-00570, and IPR2017-00571, which are respectively directed towards U.S. Patent Nos. 8,648,048 B2 (the “‘048 patent”); 8,629,111 B2 (the “‘111 patent”); 8,633,162 B2 (the “‘162 patent”); 9,248,191 B2 (the “‘191 patent”); 8,642,556 B2 (the “‘556 patent”); and 8,685,930 B2 (the “‘930 patent”).

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owner jointly request termination of *inter partes* review Case Nos. IPR2017-00566, IPR2017-00567, IPR2017-00568, IPR2017-00569, IPR2017-00570, and IPR2017-00571 pursuant to a settlement.

II. STATEMENT OF FACTS

On January 6, 2017, Famy Care filed petitions seeking *inter partes* review of the ‘048, ‘111, ‘162, ‘191, ‘556, and ‘930 patents in Case Nos. IPR2017-00566, IPR2017-00567, IPR2017-00568, IPR2017-00569, IPR2017-00570, and IPR2017-00571. The Board entered decisions instituting *inter partes* review on July 10, 2017 (Case No. IPR2017-00567), and on July 12, 2017 (Case Nos. IPR2017-00566, IPR2017-00568, IPR2017-00569, IPR2017-00570, and IPR2017-00571).

The Patent Owner's responses to Famy Care's petitions are due on September 6, 2017 under the Scheduling Order (Paper 13).

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 26 at 2 (PTAB Jul. 28, 2014).

(1) **Brief Explanation**. Termination is appropriate in these cases because the parties have settled their dispute. The parties are filing a "Joint Request That Settlement Documents Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74" concurrently with this Joint Motion to Terminate.

(2)(4) **Related Litigation and Status**. The related litigation involving the patents at issue includes *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc.*, No. 2:15-cv-1455 ("*Allergan v. Teva*"); and *Allergan, Inc. v. DEVA Holding AS*, No. 2:16-cv-1447 ("*Allergan v. Deva*"), both pending in the Eastern District of Texas. Allergan Inc. is the plaintiff in both cases, and the defendants are Akorn, Inc., InnoPharma, Inc., Mylan Pharmaceuticals Inc., Mylan Inc., and Teva

Pharmaceuticals USA, Inc.² in *Allergan v. Teva*, and Deva Holding A.S. in *Allergan v. Deva*. The trial in *Allergan v. Teva* is scheduled from August 28, 2017 to September 1, 2017. *Allergan v. Deva* is currently in the discovery phase.

(3)(4) **Related Proceedings before the Patent Office and Status.** The related proceedings before the Patent Office are Case Nos. IPR2016-01127, IPR2016-01128, IPR2016-01129, IPR2016-01130, IPR2016-01131, and IPR2016-01132. These proceedings were initiated by Mylan Pharmaceuticals Inc., and later cases initiated by Teva Pharmaceuticals USA, Inc. and Akorn, Inc. were joined with them (*i.e.*, Case Nos. IPR2017-00576, IPR2017-00594, IPR2017-00578, IPR2017-00596, IPR2017-00579, IPR2017-00598, IPR2017-00583, IPR2017-00599, IPR2017-00585, IPR2017-00600, IPR2017-00586, and IPR2017-00601). In these consolidated cases, the Patent Owner has responded to the petitions, the Petitioners have replied, and the Patent Owner has filed sur-replies. The oral argument is scheduled for September 15, 2017.

Pharmaceuticals LLC (“Argentum”) filed an IPR petition for the ‘111 patent (*i.e.*, IPR2016-1232). Apotex Corp. and Apotex Inc. filed IPR petitions for the ‘162, ‘111, ‘930, ‘048, and ‘556 patents (*i.e.*, Case Nos. IPR2015-01278, IPR2015-01282, IPR2015-01283, IPR2015-01284, IPR2015-01286). These petitions were all terminated before institution decisions.

² Famy Care had been a defendant in this consolidated litigation, but the court dismissed and terminated the case between Allergan and Famy Care on August 28, 2017 due to the settlement.

III. ARGUMENT

The Board should terminate the *inter partes* review of the ‘048, ‘111, ‘162, ‘191, ‘556, and ‘930 patents in Case Nos. IPR2017-00566, IPR2017-00567, IPR2017-00568, IPR2017-00569, IPR2017-00570, and IPR2017-00571 as the parties jointly request, for the following reasons.

First, the parties are jointly requesting termination because they have reached a settlement as to all the disputes in these proceedings and as to the ‘048, ‘111, ‘162, ‘191, ‘556, and ‘930 patents. *See* 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are **strong public policy reasons to favor settlement between** the parties to a proceeding”) (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. For example, it endorses the ability of parties to agree to never challenge validity as part of a settlement. *See Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1370 (Fed. Cir. 2001); *see also Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law

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