

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERIGEN PHARMACEUTICALS LIMITED,

Petitioner,

v.

SHIRE LLC,

Patent Owner.

Case IPR2017-00665
U.S. Patent No. 8,846,100

**JOINT NOTICE OF SETTLEMENT, REQUEST TO
TERMINATE AND REQUEST TO KEEP
SEPARATE UNDER 37 C.F.R. § 42.74 (c)**

**JOINT NOTICE OF SETTLEMENT, JOINT
MOTION TO TERMINATE, AND JOINT REQUEST
TO KEEP SEPARATE**

The parties to IPR2017-00665, Petitioner Amerigen Pharmaceuticals Limited ("Amerigen") and Patent Owner Shire LLC ("Shire"), have reached a settlement of all issues in this proceeding.

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Amerigen and Shire jointly move to terminate the present *inter partes* review proceeding. This Joint Notice, Joint Motion, and Joint Request to Keep Separate were authorized by the Board on April 21, 2017.

Termination is appropriate in the instant proceeding because the dispute between the parties has been resolved, and further, the parties have agreed to terminate this *inter partes* review. 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 is still in its early stages. Patent Owner has not yet filed a preliminary response (and thus, no institution decision has issued). Moreover, 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.

There are no district court actions between Petitioner and Patent Owner involving U.S. Patent No. 8,846,100.

Consistent with the terms of the Settlement Agreement, Amerigen agrees that all challenged claims are valid and enforceable. Accordingly, Amerigen and Shire jointly request, 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Board to terminate these proceedings immediately and without issuing a final written opinion. Although § 317(a) refers specifically to a post-institution proceeding, the Board's regulatory authority to terminate trial is not limited and may therefore be exercised even pre-institution. *See* 37 C.F.R. 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate....").

The parties are filing, concurrently herewith a true copy of their Settlement Agreement (executed on April 19, 2017) as Exhibit 2001.¹

The parties further request, pursuant to 37 C.F.R. § 42.74(c), that this agreement (Ex. 2001) be treated as confidential business information and be kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a motion to seal pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

¹ The Settlement Agreement has been filed electronically via E2E for "Board Only" to preserve confidentiality. Filing under the designation "Board Only" was authorized by the Board on April 21, 2017.

Respectfully submitted,

Dated: April 26, 2017

/Joseph R. Robinson/

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Dustin B. Weeks, PTO Reg. No. 67,466

Attorneys for Patent Owner

Dated: April 26, 2017

/Marc R. Wezowski/

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Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing JOINT NOTICE OF SETTLEMENT, REQUEST TO TERMINATE AND REQUEST TO KEEP SEPARATE UNDER 37 C.F.R. § 42.74 (c) has been served on attorneys for Petitioner, via electronic mail on April 26, 2017, to the following addresses provided by Petitioner:

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Respectfully submitted,

Dated: April 26, 2017

/Dustin B. Weeks/

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