

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ACTAVIS LLC  
*Petitioner,*

v.

ABRAXIS BIOSCIENCE, LLC  
*Patent Owner*

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Case IPR2017-01101  
Case IPR2017-01103  
Case IPR2017-01104

U.S. Patent 7,820,788  
U.S. Patent 7,923,536  
U.S. Patent 8,138,229

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

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board’s authorization of January 26, 2018, Petitioner Actavis LLC (“Petitioner” or “Actavis”) and Patent Owner Abraxis Bioscience, LLC (“Patent Owner”) jointly move to terminate the present *inter partes* review proceeding in light of Patent Owner and Petitioner’s settlement of their disputes.

Petitioner and Patent Owner are concurrently filing a true and complete copy of their confidential written settlement materials (with exhibits, Confidential Exhibit 2066) in connection with this matter as required by statute. Petitioner and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. A joint request to treat the settlement materials (with exhibits, Confidential Exhibit 2066) 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.

### **LEGAL STANDARD**

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.” 35 U.S.C. § 317(a). 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 (P.T.A.B. July 28, 2014).

### ARGUMENT

Termination of the present *inter partes* review proceeding is appropriate because (1) Petitioner and Patent Owner have settled their disputes and have agreed to terminate the proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination.

*First*, the parties’ settlement completely resolves the controversy between Patent Owner and Petitioner relating to the ’788, ’536, and ’229 patents. Actavis, which is the real party in interest in the present proceeding, was named defendant in *Abraxis BioScience, LLC, et al. v. Actavis LLC*, No. 16-1925 (D.N.J.). On January 26, 2018, the parties filed a Consent Judgment requesting that all claims against Actavis and all counterclaims by Actavis be dismissed with prejudice.

*Second*, the Office has not decided the merits of the proceeding. Although the Board has instituted trial (Paper 7), the proceeding is still in the briefing stage and there is no determination of whether an oral hearing will occur. A joint stipulation to extend Due Dates 1-2 was filed on January 8, 2018. (Paper 20).

*Third*, public policy favors the termination. 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 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements, Exhibit A identifies each district court litigation, and all petitions for *Inter Partes* Review that have been filed against the '788, '536, and '229 patents or other related patents, and discusses the status of each case.

### **CONCLUSION**

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Date: January 29, 2018

Respectfully submitted,

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