

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,

Petitioner

v.

HORIZON THERAPEUTICS, LLC,

Patent Owner

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Case IPR2017-01160

Patent 9,326,966

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**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW**

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## **I. STATEMENT OF RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317(a), Lupin Ltd. and Lupin Pharmaceuticals Inc. (collectively “Lupin” or “Petitioner”) and Horizon Therapeutics, LLC (“Horizon” or “Patent Owner”) jointly move that the Board terminate this *inter partes* review (IPR) proceeding, which is directed at U.S. Patent No. 9,326,966 (“the ’966 patent”), in its entirety as a result of settlement between Petitioner and Patent Owner. *See* Ex. 2054 (Confidential).

The parties are concurrently filing a separate request that the settlement agreement (Ex. 2054) being filed herewith be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

## **II. STATEMENT OF FACTS**

Petitioner filed this IPR petition on March 27, 2017. On July 6, 2017, Patent Owner filed its Preliminary Response under 37 C.F.R. § 42.107. The Board issued a decision instituting *inter partes* review on September 28, 2017. On February 9, 2018, Patent Owner filed its Patent Owner Response. On June 14, 2018, per the parties’ respective requests, the Board ordered a consolidated Oral Argument with IPR2017-01159, directed at related U.S. Patent 9,254,278 (“the ’278 patent”), for July 9, 2018. *See* Paper No. 33.

On June 27, 2018, Petitioner and Patent Owner entered into a settlement agreement. *See* Ex. 2054 (Confidential). Under the terms of the settlement agreement, the parties agreed to jointly seek termination of IPR2017-01160 as well as related *inter partes* review IPR2017-01159, and the parties agreed to dismiss related district court litigation, *Horizon Therapeutics, Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:15-cv-07624-RBK-JS (D.N.J. filed Oct. 19, 2015), and *Horizon Therapeutics, Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:16-cv-4438-RBK-JS (D.N.J. filed Jul. 21, 2016). Thus, this settlement agreement resolves all currently pending Patent Office and District Court proceedings between the parties involving the '966 patent and related '278 patent.

On July 5, 2018, per the request of the parties, the Board cancelled the oral argument scheduled for July 9, 2018, and authorized the parties to file the instant joint motion to terminate the proceedings by no later than July 13, 2018. *See* Paper No. 35. Accordingly, no oral argument has been held and the Board has yet to issue a final decision in this matter.

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