

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner

v.

SUMITOMO DAINIPPON PHARMA CO., LTD.,
Patent Owner

Case IPR2017-01292
U.S. Patent No. 9,555,027

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

IPR2017-01292

U.S. Patent No. 9,555,027

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.74, and the Board's e-mail of July 27, 2017, Petitioner Par Pharmaceutical, Inc. ("Par") and Patent Owner Sumitomo Dainippon Pharma Co., Ltd. ("Sumitomo") jointly move to terminate the present *inter partes* review proceeding in light of the parties' resolution of their dispute relating to U.S. Patent No. 9,555,027 ("the '027 Patent").

As required by 35 U.S.C. § 317(b), the parties are concurrently filing a true copy of the parties' agreement (executed on May 31, 2017) as Exhibit 2002.¹ The parties are also concurrently filing a motion to seal pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), requesting that the agreement (Ex. 2002) be treated as confidential business information and kept separate from the files of the involved patent.

Because the agreement resolves the current dispute between the parties, the parties jointly request that this proceeding be terminated under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. *See Fandango, LLC et al. v. Ameranth, Inc.*, CBM2014-00013, Paper 22 at 5-6 (March 24, 2014). There are no additional collateral agreements or understandings made in connection with, or in contemplation of, termination of the *inter partes* review.

¹ This agreement was filed via E2E for "Parties and Board Only" to preserve confidentiality.

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“An 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.” 35 U.S.C. § 317(a); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48, 756, 46,768 (Aug. 14, 2012) (“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.”).

Because trial has not been instituted and the Board has not decided the merits of the proceeding, terminating this proceeding is appropriate, conserving the resources of the Board and the parties. In fact, Patent Owner has not yet filed a preliminary response, and the Board has not decided whether to institute. Further, strong public policy considerations favor agreement between the parties to an *inter partes* review proceeding. *See Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”); *see also* Office Trial Practice Guide, 77 Fed. Reg. at 48,768. No public interest or other factors weigh against termination of this proceeding.

In its e-mail of July 27, 2017, the Board also indicated that this motion must “identify all parties in any related district court litigation involving the patent(s) in dispute and discuss the current status of each such related litigation with respect to each party to the litigation” and “identify the case numbers of any pending, related

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inter partes review proceedings.” There are no such related district court litigations or *inter partes* review proceedings.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

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Date: August 1, 2017

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