

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner

Case IPR2017-01768
Patent 9,095,559

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

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I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Par Pharmaceutical, Inc. (“Par” 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. 9,095,559 (“the ’559 patent”), in its entirety as a result of settlement between Petitioner and Patent Owner. *See* Ex. 2058 (Confidential).

The parties are concurrently filing a separate request that the settlement agreement (Ex. 2058) 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 July 13, 2017. On November 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 January 30, 2018. On May 9, 2018, Patent Owner filed its Patent Owner Response, and on August 16, 2018, Petitioner filed its Reply. On September 5, 2018, the Board granted Patent Owner’s request for a sur-reply, which deadline is currently suspended pending the Board’s decision on further briefing from the parties regarding evidence in said

sur-reply. *See* Paper Nos. 36, 37. Oral argument, if requested, is currently set for December 14, 2018. *See* Paper No. 28.

On September 17, 2018, Petitioner and Patent Owner entered into a settlement agreement. *See* Ex. 2058 (Confidential). Under the terms of the settlement agreement, the parties agreed to jointly seek termination of IPR2017-01768 as well as related *inter partes* reviews IPR2017-01767 and IPR2017-01769, and the parties agreed to dismiss related district court litigation, *Horizon Therapeutics Inc. v. Par Pharmaceutical Inc.*, Civil Action No. 1:16-cv-03910-RBK-JS (D.N.J. filed June 30, 2016). Thus, this settlement agreement resolves all currently pending Patent Office and District Court proceedings between the parties involving the '559 patent and related U.S. Patent Nos. 9,254,278 (“the '278 patent”) and 9,326,966 (“the '966 patent”).

On September 21, 2018, per the request of the parties, the Board authorized the parties to file the instant joint motion to terminate the proceedings by no later than October 4, 2018. *See* Paper No. 40. Accordingly, no oral argument has been held and the Board has yet to issue a final decision in this matter.

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