

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAWAI USA, INC. and SAWAI PHARMACEUTICAL CO., LTD.,  
Petitioners,

v.

ASTELLAS PHARMA INC.,  
Patent Owner

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Case No. IPR2018-00079  
Patent No. 6,346,532

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**JOINT MOTION TO TERMINATE PROCEEDING  
PURSUANT TO 35 U.S.C. 317(a) AND 37 C.F.R. 42.72**

Filed on behalf of:

Sawai USA, Inc. and Sawai Pharmaceutical Co., Ltd., *Petitioners*  
AND  
Astellas Pharma Inc., *Patent Owner*

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. 42.72, Patent Owner Astellas Pharma Inc. and Petitioners Sawai USA, Inc. and Sawai Pharmaceutical Co., Ltd. (collectively “the Parties”) jointly request termination of IPR2018-00079 regarding U.S. Patent No. 6,346,532 (“the ’532 patent”). The Board authorized the parties to file this Joint Motion, including the request to keep the settlement and license agreement confidential, during the May 21, 2018 conference call between the Board and the Parties.

The Parties have settled their disputes involving the ’532 patent. They have agreed to settle the claims and counterclaims related to the ’532 patent in the related district court litigation (*Astellas Pharma Inc. v. Sawai Pharmaceutical Co., Ltd.*, Civil Action No. 16-cv-954 (D. Del.)), and the dismissal has been entered by the Court. The Parties are not aware of additional proceedings regarding the ’532 patent, with the exception that the ’532 patent is involved in a district court litigation which is currently stayed (*Astellas Pharma Inc. v. Actavis Elizabeth LLC*, Civil Action No. 16-cv-905 (D. Del.)).

Pursuant to 37 C.F.R. 42.74(b), the Parties’ settlement and license agreement and any collateral agreements made in contemplation of termination of the proceeding are in writing, and true and correct copies of such documents are being filed herewith as Exhibit 1026. No other such agreements, written or oral, exist between or among the Parties. The Parties jointly request that the settlement and

license agreement be treated as business confidential information and be kept separate from the files of the above captioned IPR, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

## **I. Background.**

On October 16, 2017, Petitioners filed a request for *inter partes* review of claims 1, 3-6, 9, 11, 12, 15, 16 of the '532 patent. Paper 1. On May 4, 2018, the Board denied institution of *inter partes* review. Paper 7.

The Parties have agreed to settle their disputes involving the '532 patent. On May 14, 2018, the Parties informed the Board of the settlement and requested authorization to file a joint motion to terminate the proceeding. On May 21, 2018, the Board authorized the filing of the requested joint motion to terminate this proceeding. The Board additionally authorized the parties to include with the joint motion to terminate a request to treat the settlement and license agreement as business confidential information

## **II. Termination Is Appropriate.**

Termination of this IPR is appropriate as no dispute remains between the Patent Owner and Petitioners involving the '532 patent. Termination would finally resolve these IPR proceedings between the Parties.<sup>1</sup>

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<sup>1</sup> The Parties note that the deadline to file a request for rehearing is 30 days from May 4, 2018, which has not passed as of the filing of this Joint Motion. See 37 C.F.R. 42.71(d).

Motions to terminate are routinely granted in view of settlements. *See, e.g., Nike, Inc. v. Point 3 Basketball, LLC*, Case No. IPR2016-00396 (Paper 20 at 3). Furthermore, the Board has found that a motion to terminate a petition in view of settlement, and post-denial of institution, is also appropriate. *See, e.g., Nokia Solutions and Networks US LLC v. Hua Wei Technologies*, Case No. IPR2017-00591 (Paper 17 at 2-3) (granting joint motion to terminate in view of settlement, after denying institution of *inter partes* review).

### **III. Status of Related Litigation.**

As noted above, the related district court action between Patent Owner and Petitioners has been settled with respect to the '532 patent, and the Court has ordered dismissal on the claims and counterclaims related thereto.

### **IV. Treat Settlement Agreement as Business Confidential Information.**

Patent Owner and Petitioners concurrently request that the settlement and license agreement (including any related attachments) filed herewith as Exhibit 1026 be treated as business confidential information, be kept separate from the file of the above captioned IPR, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). In view of that request the settlement and license agreement has been filed for access by the “Parties and Board Only.”

## V. Conclusion.

For the foregoing reasons, Patent Owner and Petitioners jointly request that the Board terminate IPR2018-00079, and treat the settlement and license agreement filed herewith as business confidential information and keep the agreement separate from the file of the above captioned IPR.

Respectfully submitted,

Dated: May 29, 2018

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