UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC. AND APOTEX CORP.
Petitioners,

v.

ABRAXIS BIOSCIENCE, LLC
Patent Owner

Case IPR2018-00151
Case IPR2018-00152
Case IPR2018-00153

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

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 June 15, 2018, Petitioners Apotex Inc. and Apotex. Corp. ("Petitioners" or "Apotex") and Patent Owner Abraxis Bioscience, LLC ("Patent Owner") jointly move to terminate the present *inter partes* review proceeding in light of Patent Owner and Petitioners' settlement of their disputes.

Petitioners and Patent Owner are concurrently filing a true and complete copy of their confidential written settlement materials (with exhibits, Confidential Exhibit 2093) in connection with this matter as required by statute. Petitioners 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 2093) 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) Petitioners 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 Petitioners relating to the '229, '788, and '536 patents.

Second, the Board denied institution of the IPRs and Apotex did not file a request for rehearing.

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 '229, '788, and '536 patents or other related patents, and discusses the status of each case.

CONCLUSION

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

Date: June 21, 2018

Respectfully submitted,

/ *John Josef Molenda* /
John Josef Molenda
(Reg. No. 47,804)
Vishal Gupta
(Reg. No. 67,284)
Siew Yen Chong
(Reg. No. 62,108)

/ Christopher J. Harnett /
Christopher J. Harnett (Reg. No. 35,538)
Anthony M. Insogna (Reg. No. 35,203)
Cary Miller, Ph.D. (Reg. No. 54,708)
Lisamarie LoGiudice, Ph.D. (Reg. No. 71,047)
JONES DAY
250 Vesey Street

Fang Bu
(to seek *pro hac vice* admission)
STEPTOE & JOHNSON LLP
1114 Avenue of the Americas, 35th Floor
New York, NY 10036
212-506-3900
Abraxane@Steptoe.com
Counsel for Petitioners Apotex Inc. and Apotex Corp.

New York, NY 10281-10147
Tel: (212) 326-3939
Fax: (212)-755-7306
charnett@jonesday.com
aminsogna@jonesday.com
cmiller@jonesday.com
llogiudice@jonesday.com

F. Dominic Cerrito (Reg. No. 38,100)
Andrew S. Chalson (pro hac vice)
Frank C. Calvosa (Reg. No. 69,064)
Daniel Wiesner (pro hac vice)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
General Tel: (212) 849-7000
Direct Tel: (212) 849-7450
Fax: (212) 849-7100
nickcerrito@quinnemanuel.com
andrewchalson@quinnemanuel.com
frankcalvosa@quinnemanuel.com
danielwiesner@quinnemanuel.com

Counsel for Patent Holder Abraxis Bioscience, LLC

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.