

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN TECHNOLOGIES, INC.

Petitioner

v.

NOVEN PHARMACEUTICALS, INC.

Patent Owner.

Case No. IPR2018-00173

U.S. Patent No. 9,724,310

**JOINT MOTION TO TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317¹**

¹ Identical documents are being filed in IPR2018-00174 and IPR2018-01119.

As authorized in the Patent Trial and Appeal Board's email dated August 24, 2018, and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Patent Owner and Petitioner jointly and respectfully request that the *inter partes* reviews of U.S. Patent No. 9,724,310 ("the '310 Patent") (IPR2018-00173), U.S. Patent No. 9,730,900 ("the '900 Patent") (IPR2018-00174), and U.S. Patent No. 9,833,419 ("the '419 Patent") (IPR2018-0119) be terminated. In accordance with the Board's email, this motion includes (1) a brief explanation why termination is appropriate and (2) identifies all parties in pending district court litigation involving the patents and the current status of each such litigation. There are no other pending *inter partes* review proceedings involving the patents.

I. Statement of Relief Requested

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, and pursuant to the authorization to file this motion provided by the Board's email to the parties on August 24, 2018, Petitioner Mylan Technologies, Inc. and Patent Owner Noven Pharmaceuticals, Inc. (collectively, the "Parties") jointly request the termination of the *inter partes* reviews of the '310 Patent (IPR2018-00173), the '900 Patent (IPR2018-00174), and the '419 Patent (IPR2018-0119) in their entirety as a result of settlement between the Parties.

The Parties have settled their dispute and executed a binding term sheet to terminate these *inter partes* reviews. The Parties' binding term sheet has been

made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 2024 (“Binding Term Sheet”). The Parties are also filing concurrently herewith a joint request to treat the Binding Term Sheet as business confidential information and keep it separate from the files of the *inter partes* reviews and the involved patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) and (c). The Binding Term Sheet reflects all essential terms of a settlement agreement between the Parties. At the Board’s request, the Parties will provide the Board with a copy of the settlement agreement once it has been duly executed.

II. Statement of Facts

A. IPR2018-00173 and IPR2018-00174

Petitioner filed petitions requesting *inter partes* reviews of the ’310 Patent and the ’900 Patent on December 4, 2017. Patent Owner filed preliminary responses on March 13, 2018, and on June 12, 2018, the Board denied institution in both IPR2018-00173 and IPR2018-00174. Thereafter, Petitioner filed requests for rehearing on July 12, 2018, and Patent Owner filed oppositions to the requests for rehearing on July 20, 2018. The Board has not yet issued decisions on the requests for rehearing in IPR2018-00173 and IPR2018-00174.

B. IPR2018-01119

Petitioner filed a petition requesting *inter partes* review of the ’419 Patent (a related continuation of the ’310 and ’900 Patents) on May 18, 2018. Patent Owner

filed a preliminary response on August 22, 2018. The Board has not yet issued an institution decision in IPR2018-01119.

III. Argument

35 U.S.C. § 317(a) provides: “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).

Similarly, 37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide additionally counsels that “[t]here are strong public policy reasons to favor settlement between the parties to proceeding” and that 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. 35 U.S.C. 317(a), as amended, and 35 U.S.C. 327.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

A. Explanation Why Termination Is Appropriate

In accordance with the Binding Term Sheet, the Parties are seeking to terminate these *inter partes* reviews. The other proceedings related to the challenged patents involving the Parties, *i.e.*, *Noven Pharmaceuticals, Inc. v.*

Mylan Technologies Inc., et al., C.A. No. 1:17-cv-01777-LPS (D. Del.), and related Federal Circuit Appeal No. 18-2287, have been dismissed. Thus, no dispute remains between the Parties involving the '310 Patent, the '900 Patent, or the '419 Patent.

As noted in the Statement of Facts, the Board has not yet issued decisions on the requests for rehearing in IPR2018-00173 and IPR2018-00174 and has not yet decided whether to institute in IPR2018-01119. Thus, the Board has not yet “decided the merits of the proceeding[s] before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. at 48,768.

The Parties are unaware of any other matters before the Board that would be affected by the outcome of these proceedings. There are no other pending *inter partes* review proceedings involving the patents.

Further, because the Board has yet to issue a final decision on the merits, termination of the proceedings would save the Board significant administrative resources and limit unnecessary and counterproductive costs. Termination also would further the AIA’s purpose of providing an efficient and less costly alternative forum for patent disputes and its encouragement for settlement.

B. Pending District Court Litigation Involving The Patents

In addition to the litigation dismissed by the Parties, the following district court proceedings involving the patents are pending:

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.

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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.

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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.