

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,

Petitioner

v.

HORIZON THERAPEUTICS, LLC,

Patent Owner

Case IPR2018-00459

Patent 9,561,197

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

TABLE OF CONTENTS

I. STATEMENT OF RELIEF REQUESTED1

II. STATEMENT OF FACTS1

III. RELATED LITIGATION AND INTER PARTES REVIEWS.....2

IV. ARGUMENT2

 A. The Board Should Terminate this IPR in its Entirety3

 B. Written Settlement Agreement.....5

V. CONCLUSION.....5

TABLE OF AUTHORITIES

Cases

Apex Med. Corp. v. Resmed Ltd.,
IPR2013-00512, Paper 39 (P.T.A.B. Sept. 12, 2014)4

Plaid Techs., Inc. v. Yodlee, Inc.,
IPR2016-00273, Paper 29 (P.T.A.B. Feb. 8, 2017)4

Samsonite, LLC v. Otter Products, LLC,
IPR2015-00507, Paper 13 (P.T.A.B. July 31, 2015).....4

Toyota Motor Corp. v. Blitzsafe Tex. LLC,
IPR2016-00421, Paper 28 (P.T.A.B. Feb. 21, 2017)4

Volution v. Versata Software,
CBM2013-00018, Paper 52 (P.T.A.B. June 17, 2014)4

Statutes

35 U.S.C. § 3174

35 U.S.C. § 317(a) 1, 2, 3

35 U.S.C. § 317(b)5

Other Authorities

Office Patent Trial Practice Guide,
77 Fed. Reg. 48,756 (Aug. 14, 2012)3, 5

Regulations

37 C.F.R. § 42.1071

37 C.F.R. § 42.723, 4

37 C.F.R. § 42.744

37 C.F.R. § 42.74(c).....1, 5

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Lupin Ltd. and Lupin Pharmaceuticals Inc. (collectively “Lupin” 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. 9,561,197 (“the ’197 patent”), in its entirety as a result of settlement between Petitioner and Patent Owner. *See* Ex. 2021 (Confidential).

The parties are concurrently filing a separate request that the settlement agreement (Ex. 2021) 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 January 12, 2018. On May 23, 2018, Patent Owner filed its Preliminary Response under 37 C.F.R. § 42.107. The Board has yet to issue a decision instituting *inter partes* review. Accordingly, no oral argument has been held and the Board has yet to issue a final decision in this matter.

On June 27, 2018, Petitioner and Patent Owner entered into a settlement agreement. *See* Ex. 2021 (Confidential). Under the terms of the settlement agreement, the parties agreed to jointly seek termination of IPR2018-00459, and

the parties agreed to dismiss related district court litigation, *Horizon Therapeutics, LLC v. Lupin Ltd. and Lupin Pharmaceuticals, Inc.*, Civil Action No. 2:17-cv-05900-KM-MAH (D.N.J., filed Aug. 8, 2017). Thus, this settlement agreement resolves all currently pending Patent Office and District Court proceedings between the parties involving the '197 patent.

III. RELATED LITIGATION

The following currently pending district court litigation proceedings involve the '197 patent:

- (a) *Horizon Therapeutics, LLC v. Lupin Ltd. and Lupin Pharmaceuticals, Inc.*, Civil Action No. 2:17-cv-05900-KM-MAH (D.N.J., filed Aug. 08, 2017). The Complaint asserts infringement of U.S. Patent No. 9,561,197.
- (b) *Horizon Therapeutics, LLC v. Par Pharmaceutical, Inc.*, Civil Action No. 2:17-cv-05901-KM-MAH (D.N.J. filed Aug. 08, 2017). The Complaint asserts infringement of U.S. Patent No. 9,561,197.

IV. ARGUMENT

Section 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). It

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