

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,

Petitioner,

v.

**BRISTOL-MYERS SQUIBB COMPANY and
PFIZER INC.,**

Patent Owners.

Case IPR2018-00892

Patent No. 9,326,945

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), Petitioner Mylan Pharmaceuticals Inc. (“Mylan” or “Petitioner”) and Patent Owners Bristol-Myers Squibb Company (“BMS”) and Pfizer Inc. (“Pfizer” and, collectively with BMS “Patent Owners”) jointly request termination of IPR2018-00892, which is directed to U.S. Patent No 9,326,945 (the “945 Patent”).

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owners jointly request termination of this *inter partes* review pursuant to a settlement.

II. STATEMENT OF FACTS

Petitioner and Patent Owners have reached an agreement to settle this *inter partes* review proceeding. A “Joint Request That Settlement Agreements Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreements. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office). The Board previously provided authorization to file this motion on January 9, 2019. (Paper 39.) 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 26 at 2 (PTAB July 28, 2014).

- (1) Brief Explanation. Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That Settlement Agreements Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreements.
- (2) Related Litigation. The following litigations concerning the ’945 patent are pending: *Bristol-Myers Squibb Co. et al. v. Aurobindo Pharma USA Inc.*, 1:17-cv-00374-LPS (D. Del.); *Bristol-Myers Squibb Co. et al. v. Sunshine Lake Pharma Co., Ltd. et al.*, 1:17-cv-00380-LPS (D. Del.); *Bristol-Myers Squibb Co. et al. v. Unichem Laboratories, Ltd.*, 1:17-cv-00382-LPS (D. Del.); *Bristol-Myers Squibb Co. et al. v. Dr. Reddy’s Laboratories, Ltd. et al.*, 1:17-cv-00401-LPS (D. Del.); *Bristol-Myers Squibb Co. et al. v. Sandoz Inc.*, 1:17-cv-00407-LPS (D. Del.); *Bristol-Myers Squibb Co. et al. v. Sigmapharm Laboratories, LLC*, 1:17-cv-00408-LPS (D. Del.); and *Bristol-Myers Squibb Co. et al. v. Zydus Pharmaceuticals (USA) Inc.*,

1:17-cv-00412-LPS (D. Del.), each consolidated (1:17-cv-00374-LPS (D. Del.).

- (3) (4) Related Proceeding before the Patent Office and Its Status. There is currently no other proceeding before the Patent Office involving the '945 patent.

III. ARGUMENT

The Board should terminate this case as the parties jointly request, for the following reasons.

First, Petitioner and Patent Owners have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the '945 Patent. True copies of the settlement agreements are filed concurrently herewith. *See* Exs. 1047, 1048. The parties request that the settlement agreements be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, the parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

Third, a termination of this proceeding will conserve the Board's resources and obviate the need for any more Board involvement in this matter.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owners respectfully request termination of this *inter partes* review of the '945 Patent.

January 9, 2019

Respectfully submitted,

By: /Robert L. Florence/
Robert L. Florence
Reg. No. 54,933
PARKER POE ADAMS & BERNSTEIN
LLP
1180 Peachtree Street, N.E.
Suite 3300
Atlanta, GA 30309
robertflorence@parkerpoe.com
Tel: (678) 690-5701

*Counsel for Petitioner Mylan
Pharmaceuticals Inc.*

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.