

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIPLA LIMITED,
Petitioner,

v.

ALCON RESEARCH LTD.,
Patent Owner.

Case IPR2018-01021
U.S. Patent No. 9,533,053

JOINT MOTION TO TERMINATE PROCEEDINGS
UNDER 35 U.S.C. § 317(a)

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorizing order, Petitioner Cipla Limited and Patent Owner Alcon Research Ltd. jointly request termination of this uninstituted proceeding seeking *inter partes* review of U.S. Patent No. 9,533,053.

The parties have resolved their dispute with respect to U.S. Patent No. 9,533,053—as described in the Agreement by the parties filed herewith as Exhibit 1042. Other than as indicated in the Agreement, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding. *See, e.g., General Growth Properties, Inc. et al. v. Peschke*, IPR2013-00400, Paper 35 at 2-3 (Apr. 9, 2014). The parties are also filing concurrently herewith a joint request to treat the Agreement as business confidential information and to keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Termination of this proceeding is proper under 35 U.S.C. § 317(a), because the Board has not instituted trial, let alone decided the merits of the proceeding. Further, the parties are unaware of any matter before the USPTO that would be affected by the outcome of this proceeding. The only related matter in the USPTO

is IPR2018-01020, which involves U.S. Patent No. 8,791,154. The parties are concurrently requesting termination of that proceeding. Likewise, the parties are concurrently seeking dismissal of all claims relating to U.S. Patent Nos. 8,791,154 and 9,533,053 in connection with *Alcon Research, Ltd. v. Cipla Limited et al.*, 1:17-cv-01244 (D. Del.). Accordingly, the parties respectfully request termination of this proceeding.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with the filing to Deposit Account 501710 (Customer ID No. 27160).

Dated: September 14, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned *Joint Motion to Terminate Proceedings Under 35 U.S.C. § 317(a)*, along with Exhibit 1042, were served on September 14, 2018 by filing this document through the Patent Review Processing System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner and Patent Owner:

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