

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

ADAMIS PHARMACEUTICALS CORPORATION
Petitioner

v.

BELCHER PHARMACEUTICALS, LLC
Patent Owner

CASE: IPR2019-01021
U.S. PATENT NO. 9,283,197

**JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317(b)
AND 37 C.F.R. § 42.74(c)**

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Adamis Pharmaceuticals Corporation, LLC (“Petitioner”) and Patent Owner Belcher Pharmaceuticals, LLC (“Patent Owner”) jointly request termination of the *inter partes* review of U.S. Patent No. 9,283,197 (“the ’197 patent”), Case IPR2019-01021, based on a settlement and license agreement between Petitioner and Patent Owner.

II. REASONS FOR GRANTING THE MOTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, 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.”

The Board authorized the filing of the instant joint motion and request in its e-mail to the parties on July 26, 2019. Consistent with the Board’s standing practice, the Board’s notice of authorization instructs the parties that their joint motion should: (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related district court litigation involving the patents in dispute and discuss the current status of each such related litigation with respect to each party to the litigation, and (3) identify the case numbers of any pending, related *inter partes* review proceedings. This motion satisfies each of the above requirements and is

also accompanied by a true copy of the Parties' fully-executed settlement and license agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

1. Termination is Appropriate

Termination is appropriate because the Parties have settled their dispute and this *inter partes* review has not been instituted. Petitioner filed its petition for *inter partes* review on April 26, 2019. Patent Owner has not filed a preliminary response. The Parties have settled their dispute, and have reached agreement to terminate this *inter partes* review proceeding.

2. All Parties in any Pending Related Litigation Involving the Patent at Issue and the Current Status of each Related Litigation with Respect to each Party to the Litigation

Petitioner filed an action for a declaratory judgment of non-infringement against the '197 Patent in the Middle District of Florida Case No. 8:18-cv-02379-WFJ-AAS. On July 25, 2019, Petitioner filed an Unopposed Stipulation to Dismiss with Prejudice Case No. 8:18-cv-02379. On July 29, 2019, the District Court dismissed the case with prejudice.

Patent Owner is presently asserting the '197 Patent against International Medication System Limited and Hospira, Inc. in the District of Delaware, Case Nos. 1-18-cv-00960 and 1-17-cv-00775, respectively. A bench trial was held in Case No. 1-17-cv-00775 against Hospira, Inc. on June 19 and 20, 2019. The court has not yet

issued its ruling following the bench trial. Case No. 1-18-cv-00960 against International Medication System Limited is currently stayed pending the outcome of Case No. 1-17-cv-00775.

3. Related *Inter Partes* Review Proceedings

Aside from this *inter partes* review proceeding, the ‘197 Patent is not involved in any pending, related post grant review proceedings, or any other proceeding currently before the Patent Office.

III. SETTLEMENT AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ Settlement Agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1026.¹

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and the Board’s authorization of the filing of this joint request in its email to the Parties on July 26, 2019, the Parties jointly request that the true copy of the Settlement Agreement filed concurrently herewith as Exhibit 1026 be treated as business confidential information, which shall be kept separate from the file of U.S. Patent No. 9,283,197.

¹ The Settlement Agreement is being filed via the Patent Review Processing System (PRPS) with access to “Parties and Board Only.”

The Parties further request the Board to not make Exhibit 1026 available to any third party, except as provided for in 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

IV. CONCLUSION

For all of these reasons, Petitioner and Patent Owner respectfully request termination of the *inter partes* review of U.S. Patent No. 9,283,197, Case IPR2019-01021.

Dated: July 29, 2019

Respectfully submitted,

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