

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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APOTEX INC.,  
Petitioner  
v.

CELGENE CORPORATION,  
Patent Owner

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Case IPR2023-00512  
U.S. Patent No. 8,846,628

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

Pursuant to 35 U.S.C. § 317(a), Petitioner Apotex Inc. (“Apotex” or “Petitioner”) and Patent Owner Celgene Corporation (“Celgene” or “Patent Owner”) jointly request termination of IPR2023-00512, which is directed to U.S. Patent No 8,846,628 (the “’628 Patent”).

### **I. STATEMENT OF PRECISE RELIEF REQUESTED**

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

### **II. STATEMENT OF FACTS**

No final written decision has been issued yet in this case. Further, Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. A “Joint Request That the Settlement Agreement 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 agreement. *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 3, 2024. (Jan. 3, 2024, email from E. Goldschlager on behalf of the Board).

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 Jul. 28, 2014).

(1) Brief Explanation. Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That the Settlement Agreement 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 agreement.

(2) Related Litigation. The challenged patent is or was the subject of the following district court cases: *Celgene Corp. and Celgene Int’l Sàrl v. Accord Healthcare, Inc.*, Case No. 21-cv-1795-RGA (D. Del.), filed December 22, 2022 (“Accord”); *Celgene Corp., Celgene Int’l Sàrl, and Bristol-Myers Squibb Co. v. MSN Labs. Private Ltd. and MSN Pharms., Inc.*, Case No. 23-cv-00699-RGA (D. Del.), filed June 27, 2023 (“MSN”); *Celgene Corp., Celgene Int’l Sàrl, and Bristol-Myers Squibb Co. v. Teva Pharms., Inc.*, Case No. 23-cv-1008-RGA (D. Del.), filed September 13, 2023 (“Teva”); and *Celgene Corp., Celgene Int’l Sàrl, and Bristol-Myers Squibb Co. v. Natco Pharma Ltd.*, Case No. 23-cv-1019-RGA (D. Del.), filed September 18, 2023 (“Natco”). On August 31, 2023, the district court consolidated the Accord and MSN proceedings as Case No. 21-cv-1795-

RGA (D. Del.). On November 27, 2023, the district court entered a consent judgment and order of dismissal in the Accord case pursuant to the parties' stipulation. Fact discovery is currently set to close on January 31, 2024 in the MSN case, and the court has scheduled a bench trial for September 23, 2024. The district court has not yet set a schedule for the Teva and Natco cases.

(3) Related Proceeding before the Patent Office and Its Status. There is currently no related proceeding before the Patent Office.

### III. ARGUMENT

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

First, Petitioner and Patent Owner 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 '628 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Exhibit 1060. The parties request that the settlement agreement 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 Owner respectfully request termination of this *inter partes* review of the '628 Patent.

Dated: January 4, 2024

Respectfully submitted,  
/s/ Vishal C. Gupta/  
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