

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

COSMO TECHNOLOGIES LIMITED,
Patent Owner.

U.S. Patent No. 8,784,888 to Villa et al.
Issue Date: June 22, 2014

Title: Controlled Release and Taste Masking Oral Pharmaceutical Compositions

Inter Partes Review No.: IPR2017-01034

JOINT MOTION TO TERMINATE PROCEEDINGS

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. Statement of Relief Requested

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, and the Board's authorization email dated September 20, 2017, Petitioner Mylan Pharmaceuticals, Inc. and Patent Owner Cosmo Technologies, Inc. jointly move that the Board terminate the above captioned *inter partes* review (IPR) proceeding in its entirety as a result of settlement between Petitioner and Patent Owner.

The parties are filing concurrently herewith a separate request that the settlement agreement 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

Patent Owner brought a suit against Petitioner in the District Court for Delaware (No. 16-cv-00152), asserting that Petitioner infringed one or more claims of U.S. Patent No. 8,784,888.

Petitioner filed this IPR petition on March 9, 2017. The Board has not yet determined whether trial will be instituted for this IPR.

On September 20, 2017, Petitioner, Defendants, and Patent Owner entered into a settlement agreement. *See* Ex. 2001 (Confidential). Under the terms of the settlement agreement, Patent Owner agrees to dismiss its infringement claim of U.S. Patent No. 8,784,888 against Petitioner following termination of this IPR proceeding.

III. Related District Court Litigation

U.S. Patent No. 8,784,888 is currently the subject of the following ongoing litigations: *Cosmo Technologies Limited, Valeant Pharmaceuticals International, and Valeant Pharmaceuticals Luxembourg S.A. R.L. v. Mylan Pharmaceuticals Inc.*,

Case No. IPR2017-01024

16-cv-00152 (D. Del.) (“Mylan Action”); *Cosmo Technologies Limited, Valeant Pharmaceuticals International, and Valeant Pharmaceuticals Luxembourg S.A. R.L. v. Alvogen Pine Brook, Inc.*, 15-cv-00193 (D. Del.) (“Alvogen Action”); and *Cosmo Technologies Limited, Valeant Pharmaceuticals International, and Valeant Pharmaceuticals Luxembourg S.A. R.L. v Actavis Laboratories FL, Inc.*, 15-cv-00164 (D. Del.) (“Actavis Action”). The parties are identified in the case captions.

The Alvogen Action and Actavis Action had a bench trial on May 22-23, 2017 before Judge Leonard Stark in the District of Delaware concerning infringement of the ‘888 patent. A transcript of Judge Stark’s findings and rulings from the bench were submitted to the PTAB as Exhibit 2025 in related IPR No. IPR2017-01035. The Court has not yet made final, written findings of fact or conclusions of law in these two actions.

The Mylan Action is scheduled for a bench trial in late November in the same district court as the Alvogen and Actavis Actions. Patent Owner Cosmo and co-plaintiffs Valeant Pharmaceuticals International and Valeant Pharmaceutical Luxembourg S.A. R.L. originally asserted infringement of the ‘888 patent and other patents, but are proceeding only with claims under related U.S. Patent No. 9,320,716. Petitioner Mylan has counterclaims of non-infringement and invalidity. Because the claims regarding the ‘888 patent have not yet been dismissed, the settlement agreement, Exhibit 2001, would resolve the dispute for the ‘888 patent and certain other patents in that litigation.

IV. Related *Inter Partes* Review

Concurrently with the filing of this IPR No. IPR2017-01034 concerning the ‘888 patent, Mylan also filed IPR No. IPR2017-01035 concerning U.S. Pat. No. 9,320,716. The ‘716 patent is related to the ‘888 patent.

V. 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 further provides: “If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” *Id.*

Similarly, 37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a).”

A. The Board Should Terminate This IPR Proceeding In Its Entirety

As noted in the statement of facts, the Board has not yet determined whether trial will be instituted. As such, the Board has not decided the merits of the pending IPR proceeding, and the parties have since settled. Thus, the Board should terminate the review in its entirety under 35 U.S.C. § 317, and 37 C.F.R. §§ 42.72, 42.74.

In the past, the Board has terminated the entire proceedings based on joint motions to terminate that were filed before the Board instituted any proceedings. *See, e.g., Unified Patents Inc. v. Advanced Silicon Techs. LLC*, IPR2016-01026, Paper No. 11 (Oct. 11, 2016) (granting motion to terminate, where “trial has not yet been instituted, and the merits of the proceedings have not been decided”); *Sony Corp. v. Straight Path IP Group Inc.*, IPR2014-00230, Paper No. 13 (May 2, 2014) (“agree[ing] with the parties that terminating the instant proceedings with respect to both Petitioner and Patent Owner, at this early juncture, promotes efficiency and minimizes unnecessary costs”).

Termination of the entire proceedings, at this early stage, would save the Board significant administrative resources. Termination would also further the

AIA's purpose of providing an efficient and less costly alternative forum for patent dispute and its encouragement for settlement.

Termination of the entire proceedings would also save the parties costs related to this *inter partes* review and also the related district court litigation involving infringement and invalidity claims concerning U.S. Patent No. 8,784,888.

The parties understand that if the Board terminates this IPR with respect to Petitioner under 35 U.S.C. § 317(a), no estoppel under § 315(e) will attach to Petitioner, or Petitioner's privy, based on Petitioner seeking this IPR. The parties also understand that if the Board terminates this IPR with respect to Petitioner before a final written decision on patentability, no estoppel will attach to Petitioner, or Petitioner's privy, under 37 C.F.R. § 42.73(d)(1). The parties understand that if the Board terminates this IPR before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

B. Written Settlement Statement

Pursuant to 37 C.F.R. § 42.74(c), the parties are filing herewith as Exhibit 2001 a true copy of the settlement agreement entered between the parties on September 20, 2017. The settlement agreement was entered into in contemplation of termination of this proceeding.

VI. Conclusion

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate this proceeding in its entirety and grant the request to treat the settlement agreement between the parties as business confidential information.

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.