

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CIPLA LTD.,  
Petitioner,

v.

ALCON RESEARCH, LTD.,  
Patent Owner.

---

Case IPR2018-01020 (Patent 8,791,154 B2)  
Case IPR2018-01021 (Patent 9,533,053 B2)<sup>1</sup>

---

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,  
and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER  
Termination of the Proceedings  
*35 U.S.C. § 317(a) and 37 C.F.R. § 42.72*

---

<sup>1</sup> This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

Case IPR2018-01020 (Patent 8,791,154 B2)

Case IPR2018-01021 (Patent 9,533,053 B2)

On September 14, 2018, the parties filed Joint Motions to Terminate these two proceedings pursuant to 35 U.S.C. § 317(a). Paper 10.<sup>2</sup> In addition, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties filed true and correct copies of a Settlement and License Agreement in each proceeding. Ex. 1043. The Agreements were accompanied by joint requests to treat the Agreement as business confidential information, to be kept separate from the publicly available patent files. Paper 9.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In these cases, Petitioner has filed its petitions, and Patent Owner has filed its mandatory notices, but there have been no preliminary responses, and we have not yet decided whether to institute trial. Paper 1; Paper 7.

Under 37 C.F.R. § 42.72, “[t]he Board may terminate a [proceeding] without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. [§] 317(a).” After reviewing the Joint Motions to Terminate and the Agreements, we determine that it is appropriate to terminate each of these proceedings without instituting trial or rendering a final written decision. Therefore, the Joint Motions to Terminate are GRANTED.

---

<sup>2</sup> We cite to the papers and exhibits filed in IPR2018-01020. Similar filings exist in IPR2018-01021.

Case IPR2018-01020 (Patent 8,791,154 B2)

Case IPR2018-01021 (Patent 9,533,053 B2)

Accordingly, it is

ORDERED that the Joint Motions to Terminate are GRANTED, and IPR2018-01020 and IPR2018-01021 are hereby TERMINATED; and

FURTHER ORDERED that the Joint Requests to File Settlement Agreements as Business Confidential Information are GRANTED, and the Settlement and License Agreements will be kept separate from the patent files.

PETITIONER:

Jitendra Malik, Ph.D.

Brian Sodikoff

Alissa M. Pacchioli

KATTEN MUCHIN ROSENMAN LLP

[jitty.malik@kattenlaw.com](mailto:jitty.malik@kattenlaw.com)

[brian.sodikoff@kattenlaw.com](mailto:brian.sodikoff@kattenlaw.com)

[alissa.pacchioli@kattenlaw.com](mailto:alissa.pacchioli@kattenlaw.com)

PATENT OWNER:

Christopher A. Suarez

David M. Krinsky

WILLIAMS & CONNOLLY LLP

[csuarez@wc.com](mailto:csuarez@wc.com)

[dkrinsky@wc.com](mailto:dkrinsky@wc.com)

Peter J. Waibel

NOVARTIS PHARMACUTICAL CORP.

[Peter.waibel@novartis.com](mailto:Peter.waibel@novartis.com)