

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,

Petitioner

v.

HORIZON THERAPEUTICS, LLC,

Patent Owner

Case IPR2018-01550

Patent 9,561,197

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

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I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Par Pharmaceutical, Inc. (“Par” or “Petitioner”) and Horizon Therapeutics, LLC (“Horizon” or “Patent Owner”) jointly move that the Board terminate this *inter partes* review (IPR) proceeding, which is directed at U.S. Patent No. 9,561,197 (“the ’197 patent”), in its entirety as a result of settlement between Petitioner and Patent Owner. *See* Ex. 2001 (Confidential).

The parties are concurrently filing a separate request that the settlement agreement (Ex. 2001) 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

Petitioner filed this IPR petition on August 16, 2018. Patent Owner has yet to file its Preliminary Response, which is not due until November 30, 2018 (*see* Paper No. 5), and the Board has yet to issue a decision instituting *inter partes* review. Accordingly, no oral argument has been held and the Board has yet to issue a final decision in this matter.

On September 17, 2018, Petitioner and Patent Owner entered into a settlement agreement. *See* Ex. 2001 (Confidential). Under the terms of the settlement agreement, the parties agreed to jointly seek termination of IPR2018-

01550, and the parties agreed to dismiss related district court litigation, *Horizon Therapeutics, LLC v. Par Pharmaceutical, Inc.*, Civil Action No. 1:17-cv-05901-MAH-KM (D.N.J. filed Aug. 08, 2017). Thus, this settlement agreement resolves all currently pending Patent Office and District Court proceedings between the parties involving the '197 patent.

III. RELATED LITIGATION

The following currently pending district court litigation proceeding involves the '197 patent:

- (a) *Horizon Therapeutics, LLC v. Par Pharmaceutical, Inc.*, Civil Action No. 1:17-cv-05901-MAH-KM (D.N.J. filed Aug. 08, 2017). The Complaint asserts infringement of the '197 patent.

IV. 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.*

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