

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC.,
Petitioner,

v.

PFIZER INC.,
Patent Owner.

Inter Partes Review No.: IPR2021-01132

U.S. Patent No. 6,890,927 to Bogle *et al.*
Issued: May 10, 2005

Title: TARTRATE SALTS OF 5,8, 14-TRIAZATERACYCLO[10.3.1.02,11
04.9]-HEXADECA-2(11),3,5,7,9-PENTAENE AND
PHARMACEUTICAL COMPOSITIONS THEREOF

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72 AND
JOINT REQUEST TO KEEP PAPERS SEPARATE
AS BUSINESS CONFIDENTIAL INFORMATION**

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner Apotex Inc. (“Apotex”) and Patent Owner Pfizer Inc. (“Pfizer”; and together with Apotex, “the Parties”) jointly request termination of *Inter Partes* Review No. IPR2021-01132.

The Parties have settled all of their disputes involving U.S. Patent No. 6,890,927 (“the ‘927 patent”). As part of that resolution, the Parties have agreed to seek to terminate this proceeding.

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ settlement agreement made in contemplation of termination of this proceeding is in writing, and a true and correct copy of such document is being filed herewith as Petitioner’s Exhibit 1025.

The Parties hereby jointly request that the settlement agreement at Petitioner’s Exhibit 1025 be treated as business confidential information, and be kept separate from the files of the above captioned IPR pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. BACKGROUND

On June 17, 2021, Apotex filed a request for *Inter Partes* Review of claims 1-2 of the ‘927 patent. *See* IPR2021-01132, Paper 1. On October 12, 2021, Pfizer filed a Patent Owner Preliminary Response. *See* IRP2021-01132, Paper 6. The Board has not issued an Institution Decision.

On October 19, 2021, the Parties agreed to settle all of their disputes concerning the ‘927 patent.

On the same day (October 19, 2021), the Parties informed the Board of settlement and requested authorization to file a joint motion to terminate the proceeding with respect to both Apotex and Pfizer. On October 20, 2021, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both Parties. The Board additionally authorized the Parties to include with the joint motion to terminate a request to treat the settlement as business confidential information.

III. TERMINATION IS APPROPRIATE

Termination of this IPR is appropriate as the Board has not yet “decided the merits of the proceeding” in this proceeding. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). More specifically, the Board has not issued any decision regarding Apotex’s request for Institution as noted above.

Notably, no dispute remains between Apotex and Pfizer involving the ‘927 patent:

- i. the Parties have agreed to jointly request termination of the *Inter Partes* Review, IPR2021-01132; and
- ii. the litigation between the Parties involving the ‘927 patent has been dismissed as part of the settlement. *Pfizer Inc. et. al. v. Apotex Inc. and*

Apotex Corp., Civil Action No. 1:21-cv-01402-CFC (D. Del.), D.I. 8,
Order (Oct. 19, 2021).

IV. RELATED LITIGATION STATUS

As noted above, the related district court action between Pfizer and Apotex has been settled and dismissed.

V. TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

Apotex and Pfizer hereby request that the settlement agreement (including any related attachments) filed herewith as Petitioner's Exhibit 1025 be treated as business confidential information, be kept separate from the file of the above captioned IPR, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). In view of that request, the settlement agreement has been filed for access by the "Parties and Board Only."

VI. CONCLUSION

For the foregoing reasons, Apotex and Pfizer jointly request that the Board terminate this *Inter Partes* Review proceeding, and treat the settlement agreement filed herewith as business confidential information and maintain said agreement separate from the file of the above captioned IPR.

Respectfully submitted,

RAKOCZY MOLINO MAZZOCHI SIWIK LLP

Dated: October 21, 2021

/s/ Deanne M. Mazzochi

Deanne M. Mazzochi (Reg. No. 50,158)

Paul J. Molino (Reg. No. 45,350)

Jeffrey A. Marx (Reg. No. 56,977)

6 West Hubbard Street, Suite 500

Chicago, IL 60654

Telephone: (312) 222-6305

Facsimile: (312) 222-6325

dmazzochi@rmmslegal.com

paul@rmmslegal.com

jmarx@rmmslegal.com

Counsel for Petitioner Apotex Inc.

/s/ Michael Liu

Andrew V. Trask (Reg. No. 59,239)

Michael Xun Liu (Reg. No. 68,815)

Williams & Connolly LLP

725 Twelfth Street NW

Washington, D.C. 20005

T: (202) 434-5000

F: (202) 434-5029

atrask@wc.com

mliu@wc.com

Richard V. Zanzalari

Pfizer Inc.

Eastern Point Road, MS-9114

Groton, CT 06340

richard.zanzalari@pfizer.com

USPTO Registration No. 49,032

Bryan C. Zielinski

Pfizer Inc.

10555 Science Center Drive

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