

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIKMA PHARMACEUTICALS USA INC.,
Petitioner,

v.

SK BIOPHARMACEUTICALS CO., LTD., and AXSOME MALTA LTD,
Patent Owners.

IPR2024-01418
U.S. Patent No. 11,560,354

JOINT MOTION TO TERMINATE PROCEEDING

INTRODUCTION

Pursuant to the Board’s authorization of March 5, 2025, Petitioner Hikma Pharmaceuticals USA Inc. (“Petitioner” or “Hikma”) moves and respectfully requests that the Board dismiss the present petition and terminate IPR2024-01418 consistent with the Board’s precedent allowing petitioners to withdraw IPR petitions pre-institution.

BACKGROUND

The present petition was filed on September 25, 2024. Patent Owners SK Biopharmaceuticals Co., Ltd. and Axsome Malta Ltd. submitted their Preliminary Response on January 23, 2025. The parties have entered into a confidential settlement agreement (“Settlement Agreement”) that will resolve the parties’ instant dispute regarding the challenged ’354 Patent, as well as other disputes in the District of New Jersey in lawsuits captioned Axsome Malta Ltd. et al. v. Alkem Laboratories Ltd., et al., Civil Action No. 23-20354 (D.N.J.) (consolidated) and Axsome Malta Ltd. et al. v. Hikma Pharmaceuticals USA Inc., Civil Action No. 24-10620 (D.N.J.). This Settlement Agreement has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) (Ex. 1021). There are no other agreements, oral or written, between the parties

made in connection with, or in contemplation of, the termination of this proceeding. Pursuant to the terms of the Settlement Agreement, the parties have filed a Stipulation and Order of Dismissal in the aforementioned district court cases.

Further, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Patent Owners and Petitioner are concurrently filing a Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Be Kept Separate, which asks the Board to treat the Settlement Agreement as business confidential information, and to keep it separate from the files of this proceeding and the files of the '354 Patent.

ARGUMENT

Good cause exists to dismiss the present petition and terminate IPR2024-01418. The proceeding is in its preliminary stage and Board has not yet made any institution decision. “The Board may...dismiss any petition.” 37 C.F.R. 42.71(a); see also 37 C.F.R. § 42.72 (the Board “may terminate a trial without rendering a final written decision, where appropriate”). Further, the rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” Id. § 42.1(b). In determining whether a termination request is “appropriate,” the Board primarily examines the stage and nature of the proceedings. See, e.g., *Samsung Elecs. Co. v. NVIDIA Corp.*,

IPR2015-01270, Paper 12 at 3 (PTAB Dec. 9, 2015). Here, dismissal will preserve both Board and party resources, particularly in view of the early stage of the proceeding.

The Board has precedent for allowing petitioners to withdraw IPR petitions pre- institution when proceedings are in a similar posture. See, e.g., *Ericsson Inc. v. Electronics and Telecommunications Research Institute*, IPR2020-00241, Paper 13 (PTAB March 9, 2020); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01221, Paper 21 (PTAB Jan. 13, 2020); *Huawei Technologies Co. Ltd v. Harris Global Communications, Inc.*, IPR2019-01512, Paper 8 (PTAB Jan. 10, 2020); *Pfizer, Inc., v. Biogen, Inc.*, IPR2018-00231, Paper No. 11 (PTAB June 6, 2018); *Darfon Electronics Corp. v. Lite-On Technology Corp.*, IPR2018-01797, Paper No. 8 (PTAB Jan. 9, 2019); *Turner Sports Interactive, Inc. v. Tagi Ventures, LLC*, IPR2017-01010, Paper No. 7 (PTAB July 31, 2017). Moreover, withdrawal of the present petition does not prejudice the Patent Owners, who do not oppose the filing of this motion.

CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board grant the Unopposed Motion to Dismiss Petition for Inter Partes Review in Case Number IPR2024-01418 and dismiss the proceeding in its entirety.

Dated: March 6, 2025

Respectfully Submitted,

IPR2024-01418
U.S. Patent No. 11,560,354

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CERTIFICATE OF SERVICE

I hereby certify that on March 6, 2025, I caused a true and correct copy of the foregoing to be served on the following counsel for Patent Owners by electronic mail to the following email addresses:

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