

Paper No. _____
Filed: April 27, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILA SPECIALTIES INC. and MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

CUBIST PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00142
Patent 8,058,238

**PETITIONERS' AND PATENT OWNER'S JOINT MOTION TO
TERMINATE PROCEEDING UNDER 35 U.S.C. § 317**

I. RELIEF REQUESTED AND STATEMENT OF FACTS

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and the Board's authorization of this motion by e-mail on April 23, 2015, Petitioners Agila Specialties Inc. and Mylan Pharmaceuticals Inc., and Patent Owner Cubist Pharmaceuticals, Inc., jointly request termination of *Inter Partes* Review ("IPR") IPR2015-00142 of U.S. Patent No. 8,058,238.

1. Brief Explanation of Why Termination is Appropriate

Agila Specialties Inc. and Mylan Pharmaceuticals Inc. filed a Petition for IPR in this proceeding on October 23, 2014 (Paper 1), and Cubist Pharmaceuticals, Inc.'s Preliminary Response was filed on February 6, 2015 (Paper 14). A decision whether to institute this *inter partes* review has not yet been issued by the Board. The parties have reached a settlement agreement to withdraw the IPR petition and to terminate this *inter partes* review.

This agreement has been made in writing, and a true and correct copy is filed with this Office, pursuant to 35 U.S.C. § 317(b), as Exhibit 1040. Because the document is also being filed on the public docket in related district court litigation, there is no need for it to be treated as confidential or kept separate from the present case files.

Termination is thus proper because the parties jointly request termination and the Office has not yet issued an institution decision or otherwise decided the merits of the proceeding.

2. Related Litigation Involving the Patent at Issue

There is a single *pending* related district court litigation involving the parties to this proceeding: *Cubist Pharmaceuticals, Inc. v. Strides, Inc. and Agila Specialties Private Limited*, Case No. 13-cv-1679-GMS, in the United States District Court for the District of Delaware (the “Related Litigation”). The parties in the Related Litigation are Plaintiff Cubist Pharmaceuticals, Inc. (“Cubist”) and Defendants Strides, Inc. (n/k/a Agila Specialties Inc.) and Agila Specialties Private Limited (collectively, “Agila”). Cubist and Strides, Inc. are also parties to this *inter partes* review proceeding.

The parties have identified other related litigation matters in their respective notices filed with the Board, i.e., Paper 1, p. 4; Paper 7, pp. 2-3; and Paper 12, pp. 2-3. These matters are either no longer pending or involve other defendants.

3. Related Proceedings Currently Before The Office

As between the instant parties there are three additional proceedings involving the patent, IPR2015-00141, IPR2015-00143, and IPR2015-00144, and there are other IPRs involving the parties on different patents that are also at issue

Case IPR2015-00142
Patent 8,058,238

in the Related Litigation. The various IPRs and their corresponding patents are as follows:-

IPR2015-00131 (Patent No. 6,468,967);
IPR2015-00132 (Patent No. 6,852,689);
IPR2015-00140 (Patent No. 8,129,342);
IPR2015-00141 (Patent No. 8,058,238);
IPR2015-00142 (Patent No. 8,058,238);
IPR2015-00143 (Patent No. 8,058,238); and
IPR2015-00144 (Patent No. 8,058,238).

Similar Joint Motions to Terminate Proceedings are also being filed in the above-listed IPR proceedings. The Office has not yet issued an institution decision in any of these proceedings.

A petition for IPR has been filed by Fresenius-Kabi USA LLC against Patent No. 6,852,689, i.e., IPR2015-00223, and against Patent No. 6,468,967 i.e., IPR2015-00227. The Fresenius-Kabi IPR petitions are not part of this agreement.

4. Current Status of the Related Litigation

Cubist previously filed a complaint against Agila in the Related Litigation alleging infringement of U.S. Patent Nos. 6,468,967, 6,852,689, 8,058,238, and 8,129,342. On April 23, 2015, Cubist and Agila filed with the Delaware Court a “Stipulation to Narrow Issues in the Litigation, Covenant Not to

Case IPR2015-00142
Patent 8,058,238

Sue, and Settlement of IPR Proceedings” (the “Stipulation”). As more fully set forth in the Stipulation filed herewith, Plaintiff agreed to limit the asserted claims against Agila in the Related Litigation and covenanted not to sue Agila for infringement of the remaining unasserted claims in exchange for Defendants stipulating to infringement for the purposes of the Related Litigation to the extent the asserted claims are not found invalid or unenforceable pursuant to a final non-appealable decision and, *inter alia*, requesting termination of this *inter partes* review proceeding.

II. CONCLUSION

For the foregoing reasons, Petitioners Agila Specialties Inc. and Mylan Pharmaceuticals Inc., and Patent Owner Cubist Pharmaceuticals, Inc. respectfully request termination of Case No. IPR2015-00142 involving U.S. Patent No. 8,058,238.

Respectfully submitted,

Date: April 27, 2015

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Date: April 27, 2015

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