

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILA SPECIALTIES INC. AND
MYLAN PHARMACEUTICALS INC.,
Petitioners,

v.

CUBIST PHARMACEUTICALS, INC.,
Patent Owner

Patent No. 8,058,238

Case IPR2015 UNASSIGNED

**DECLARATION OF LORELEI P. WESTIN IN SUPPORT OF AGILA'S
MOTION TO CORRECT ACCORDED FILING DATE
UNDER 37 C.F.R. §§ 1.10, 42.20 and 42.22**

I, Lorelei P. Westin, declare as follows:

1. I am an attorney associated with the law firm of Wilson Sonsini Goodrich & Rosati (“WSGR”) and co-counsel for Petitioner Agila Specialties Inc. and Mylan Pharmaceuticals Inc. (“Agila”) in this case. I submit this declaration in support of Agila’s Motion to Correct Accorded Filing Date Under 37 C.F.R. §§ 1.10, 42.20 and 42.22, and I have personal knowledge of the facts set forth in this declaration and can testify competently to those facts.

2. I have been an associate attorney with Wilson Sonsini Goodrich & Rosati, starting in 2004-2005 and since 2007, and a registered Patent Attorney since 2008. I was a registered patent agent with the U.S. Patent and Trademark Office from 2002-2008. I have been working on post-grant proceedings since December 2012, and have been back-up counsel on twelve *inter partes* review petitions. I am familiar with the rules of the Patent and Trial Appeal Board.

3. On October 23, 2014, I was one of the associate attorneys working on the Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238 (the ‘238 patent). The ‘238 patent issued with 192 claims, and four petitions were drafted to challenge all claims of the ‘238 patent within the page limits per the Office’s *inter partes* review rules. The four petitions challenging all claims of the ‘238 patent were drafted and ready for filing, along with a fifth *inter partes* review petition challenging all claims of U.S. Patent No. 8,139,342 (the ‘342 patent), between 3:30-

4:00 pm Pacific Time (PT) on October 23rd. In addition, a declaration submitted in support of Petitioners' *Inter Partes* Review of the '238 patent, which was executed by October 22, 2014 by Dr. Catherine N. Mulligan, an expert in the subject matter of the '238 patent, was also ready to file electronically as well. All 37 exhibits prepared for filing with the four *inter partes* review petitions were marked and ready to file by October 22, 2014.

4. I started filing the first of five petitions for the '342 and '238 patents shortly after 5:30 pm PT on the U.S. Patent Trial and Appeal Board's Patent Review Processing System (PRPS), after the service copy to patent owner Cubist Pharmaceuticals Inc. (Cubist) was prepared. The Petition for *Inter Partes* Review of U.S. Patent No. 8,129,342 was filed first, followed by: 1) Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, challenging claims 1-7, 49, 52-65, 93, 108-111, 125-138 and 147-150; 2) Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, challenging claims 8-9, 49-51, 85-92, 105-107, 113-124, 144-146, 151-162 and 164-175; and 3) Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, challenging claims 37-42, 48, 49, 66-84, 94-99, 100-104, 112, 139-143 and 163. Because of issues with our courier for personal service of the petitions and exhibits to Cubist, I stopped several times during the uploading of the documents to attend to the service copies. With these interruptions, I estimated that it took an average of 35 minutes to file each petition. I also encountered minor technical issues

with the PRPS during the uploading of the first four petitions, with one incident that required a restart of the PRPS system.

5. At approximately 8:15 pm PT, I directed our paralegal Adriana Serrano to begin efilings the last Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, challenging claims 10-36, 43-47 and 176-192. Because I was on Ms. Serrano's computer, I directed her to use my computer. All of the petitions for the '238 and '342 patents were filed under lead counsel Peter Munson's log-in information. Later that evening, I received notification from Ms. Serrano that the last petition was given a provisional filing date of October 24, 2014, which was reflected in an email received from the PTAB, dated October 23, 2014 at 9:00 pm PT, for IPR2015-00144. *See* Exh. 1041.

6. We spoke to lead counsel Peter Munson, at which time Ms. Serrano told us about the technical difficulties that she encountered with PRPS. We made the decision to file the petition and exhibits under 37 C.F.R. § 42.6(b)(2), which provides for filing by paper copy where accompanied by: (i) a motion requesting acceptance of the paper copy submission; and (ii) identifying the date of transmission where a party seeks a filing date other than the date of receipt at the Board. By approximately 9:30 pm PT, we had started to make arrangements to paper file the petition under 37 C.F.R. § 42.6(b)(2)(i).

7. To make this paper filing by midnight October 23, 2014, *i.e.*, in less than 2-1/2 hours, we worked with our colleagues in our Palo Alto office to print: 1) Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, challenging claims 10-36, 43-47 and 176-192, and revised to include an authorization for payment of the *inter partes* review petition fee by our deposit account; 2) Exhibits 1001-1037; and 3) Powers of Attorney from Petitioners Agila and Mylan. We also drafted a Motion to Request Acceptance of Mailed Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238, as required under 37 C.F.R. § 42.6(b)(2)(i)(A). The petition package containing the petition, motion, exhibits and power of attorneys was assembled and mailed by Priority Express Mail[®] at the U.S. Post Office, San Francisco International Terminal, before midnight on October 23, 2014. *See* Exhibit 1039.

8. We subsequently reviewed e-mail notifications from the U.S. Patent and Trademark Office regarding both electronic payment of the \$42,400 fee, as well from the U.S. Patent and Trademark Office regarding the assigned filing date. While the e-mail containing information regarding payment of the \$42,400 fee for the Petition for *Inter Partes* Review of U.S. Patent No. 8,058,238 (IPR2015-00144) was dated October 23, 2014, *see* Exh. 1040, the e-mail assigning the provisional filing date listed October 24, 2014 for the same petition. Exh. 1041.

9. On October 27, 2014, I spoke to Maria Vignone, senior paralegal for the Patent Trial and Appeal Board. We discussed the difficulties of electronic uploading

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