UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC
Petitioner

v.

CUBIST PHARMACEUTICALS, INC.

Patent Owner

Case IPR2015-01570
(Patent No. 8,058,238)

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

I. Statement of Relief Requested

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and the Board's June 8, 2016 email authorization, Petitioner Fresenius Kabi USA, LLC ("Fresenius") and Patent Owner Cubist Pharmaceuticals, Inc. ("Cubist") jointly request termination of this *inter partes* review ("IPR"), which concerns U.S. Patent No. 8,058,238 (the "'238 patent").

II. Statement of Facts

1. On July 10, 2015, Fresenius filed the petition in this IPR.

2. On January 28, 2016, IPR2015-01570 was instituted on claim 98 of the '238 patent.

3. Cubist has not yet filed its Patent Owner Response in this IPR.

4. There is only one other proceedings currently pending before the Board relating to the '238 patent, IPR2015-01571. The parties are simultaneously moving for termination of this proceeding.

5. In 2012, Cubist filed suits against Hospira, asserting that Hospira infringed the '238 patent, among other patents. The cases were consolidated as *Cubist Pharmaceuticals, Inc. v. Hospira, Inc.*, 1:12-cv-00367-GMS (D. Del.) ("the Hospira Case"). In the *Hospira* Case, the district court found claim 98 of the '238 patent (among other claims) invalid, a decision that was affirmed on

appeal. *Cubist Pharmaceuticals, Inc. v. Hospira, Inc.*, Nos. 2015-1197, -1204, -1259 (Fed. Cir.) ("the Hospira Appeal").

6. In 2014, Cubist filed suit against Fresenius, asserting infringement of the '238 patent, among other patents. *Cubist Pharmaceuticals, Inc. v. Fresenius-Kabi USA LLC*, 1:14-cv-00914-GMS (D. Del.) ("the Fresenius Case"). On February 2, 2016, as a result of the Federal Circuit's affirmance of invalidity in the Hospira Appeal, Cubist and Fresenius consented to the entry of judgment that claims 91, 98, and 187 of the '238 patent, the only claims of the '238 patent that Cubist was asserting in the Fresenius Case, were invalid. Exhibit 1043.

7. Cubist filed a petition for *certiorari* of the Hospira Appeal to the United States Supreme Court. It also appealed the consent judgment from the Fresenius Case to the Federal Circuit while its petition for *certiorari* in the Hospira Appeal was pending ("the Fresenius Appeal").

8. On May 24, 2016, the Federal Circuit summarily affirmed the judgment in the Fresenius Appeal.

9. On May 31, 2016, the Supreme Court denied *certiorari* in the Hospira Appeal. A true and correct copy of the Supreme Court's May 31, 2016 Order List is being filed contemporaneously as Exhibit 1044 (see page 6).

10. There is no district court litigation currently pending relating to the '238 patent.

III. Termination of this IPR is Appropriate

The Board should terminate this IPR for at least the following reasons.

First, there is no longer any dispute between the parties regarding the validity of claim 98 of the '238 patent. The district court's decision of invalidity of this claim in the Hospira case was affirmed by the Federal Circuit. The Supreme Court subsequently denied *certiorari* to review the judgment in the Hospira Appeal. As a result, the parties' dispute concerning validity of claim 98 of the '238 patent has been resolved.

In light of the final holding that the only claim at issue in this IPR is invalid, further consideration of the instant Petition by the Board is unnecessary. The parties accordingly seek termination of this IPR.

Second, the statutory condition for termination under 35 U.S.C. § 317(a) is satisfied, as this joint request for termination is being filed before the Board has decided the merits of the proceeding. The Board has adopted a general policy that, in such circumstances, a proceeding should be terminated prior to the issuance of a final written decision. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) ("The Board expects that a

proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.").

Third, concluding this review at this early juncture promotes efficiency and conserves the resources of the Board and the parties. The merits of the petition have not yet been determined. Although the IPR has been instituted, Cubist has not yet filed its Patent Owner's Response. Termination of this proceeding at this time conserves resources because it will obviate the need for the Board to take further action including preparation of a final written decision.

Upon termination of this proceeding, there will be no pending proceedings before the Board involving the '238 patent.

For the foregoing reasons, the parties respectfully request termination of this IPR without rendering a final written decision.

To the extent the joint motion to terminate is not granted, Petitioner intends to continue fully participating in this proceeding. Patent Owner will not take any further action in the proceeding.

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