

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA LLC,
Petitioner,

v.

CUBIST PHARMACEUTICALS LLC,
Patent Owner.

Cases: IPR2015-01566 (Patent 8,129,342 B2)
IPR2015-01570 (Patent 8,058,238 B2)
IPR2015-01571 (Patent 8,058,238 B2)

Before BRIAN P. MURPHY, JON B. TORNQUIST, and
TINA E. HULSE, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

ORDER

Termination of the Proceedings
35 U.S.C. § 317(a), 37 C.F.R. § 42.72

IPR2015-01566 (Patent 8,129,342 B2)
IPR2015-01570 (Patent 8,058,238 B2)
IPR2015-01571 (Patent 8,058,238 B2)

On June 8, 2016, we authorized Fresenius Kabi USA LLC (“Petitioner”) and Cubist Pharmaceuticals LLC (“Patent Owner”) to file a joint motion to terminate the above-identified proceedings. On June 10, 2016, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, the parties filed a Joint Motion to terminate these proceedings. Paper 28 (“Joint Motion” or “Joint Mot.”).¹ The parties also filed exhibits in support of their Joint Motion. Ex. 1043 (“Consent Judgment”);² Ex. 1044 (“Cert. Denial”).

“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). The Board has not yet decided the merits of these proceedings, and final written decisions have not been entered. Petitioner and Patent Owner represent that there are no other related proceedings currently pending before the Board involving the patents at issue. Joint Mot. ¶ 4.

Petitioner and Patent Owner identify related, co-pending U.S. district court proceedings, *Cubist Pharmaceuticals, Inc. v. Hospira, Inc.*, 1:12-cv-00367-GMS (D. Del.) (“the *Hospira* Case”). *Id.* ¶ 5. In the *Hospira* Case, the district court found the presently challenged claims of U.S. Patent No. 8,129,342 and U.S. Patent No. 8,058,238 invalid, a decision that was

¹ For ease of reference, all citations are to the papers and exhibits filed in IPR2015-01566. Similar papers and exhibits were filed in the other proceedings.

² We note Exhibit 1043 is marked “CONFIDENTIAL–FILED UNDER SEAL,” but the exhibit has not been filed as Parties and Board Only in PRPS, and the parties have not requested that the document be treated as business confidential information. 35 U.S.C. § 317(b).

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affirmed on appeal. *Id.* Patent Owner's petition for *certiorari* to the Supreme Court was denied on May 31, 2016. *Id.* ¶ 9; Ex. 1044, 6. The parties represent that their disputes concerning the validity of the challenged claims in these *inter partes* review proceedings have been resolved. Joint Mot. 3.

Accordingly, we determine that good cause exists to terminate these proceedings.

IV. ORDER

For the foregoing reasons, it is

ORDERED that the Joint Motions in IPR2015-01566 (Paper 28), IPR2015-01570 (Paper 25), and IPR2015-01571 (Paper 28) are *granted*; and

FURTHER ORDERED that the above-identified *inter partes* review proceedings are hereby terminated.

IPR2015-01566 (Patent 8,129,342 B2)
IPR2015-01570 (Patent 8,058,238 B2)
IPR2015-01571 (Patent 8,058,238 B2)

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