

**IN THE 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 LIMIT PETITION UNDER 37 C.F.R. § 42.71

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.25 and an email authorizing this motion in *Inter Partes* Review IPR2015-01570, which concerns U.S. Patent No. 8,058,238 (“the ’238 Patent”),¹ Petitioner Fresenius Kabi USA LLC (“Fresenius”) and Patent Owner Cubist Pharmaceuticals LLC (“Cubist”) jointly request that the Board (1) limit the petition to claim 98, and (2) remove claims 3-7, 21-25, 27-33, 35-44, 48-52, 55-57, 61-63, 66, 85, 87-89, 92-97, 99-109, 113, 115-121, 123-151, 153-159, 161-162, 164-167, 175-184, and 189-190 of the ’238 Patent from consideration in this proceeding.

II. STATEMENT OF FACTS

Fresenius filed a petition for *inter partes* review on July 10, 2015, requesting review of claims 3-7, 21-25, 27-33, 35-44, 48-52, 55-57, 61-63, 66, 85, 87-89, 92-109, 113, 115-121, 123-151, 153-159, 161-162, 164-167, 175-184, and 189-190 of the ’238 Patent. This proceeding is still in its preliminary stages, and the Board has not yet decided whether to institute trial.

Fresenius and Cubist are parties to a litigation concerning the ’238 patent in the United States District Court for the District of Delaware, *Cubist Pharmaceuticals, Inc., v. Fresenius Kabi USA, LLC*, C.A. No. 14-914-GMS

¹ August 25, 2015 email from Maria Vignone, Paralegal Operations manager, Patent Trial and Appeal Board, to Cynthia Lambert Hardman and others.

(D.Del.).² In the Delaware litigation, on August 10, 2015, Fresenius and Cubist filed, under seal, a Stipulation and Agreement to Narrow Issues in the Litigation and IPR Proceedings and Covenant Not to Sue (“Stipulation and Agreement”) wherein the parties agreed to narrow the issues in dispute in both the litigation and in this *inter partes* review by, *inter alia*, seeking to remove claims 3-7, 21-25, 27-33, 35-44, 48-52, 55-57, 61-63, 66, 85, 87-89, 92-97, 99-109, 113, 115-121, 123-151, 153-159, 161-162, 164-167, 175-184, and 189-190 of the ’238 patent from consideration in this proceeding.³

III. ARGUMENT

A. Limiting the Petition in IPR2015-01570 is Appropriate

The parties respectfully submit that the Board should limit the petition in IPR2015-01570 for at least the following reasons.

² The district court litigation also involves U.S. Patent Nos. 6,468,967, 6,852,689, and 8,129,342, and Fresenius has also filed petitions for *inter partes* review concerning each of these patents, and additional petitions on the ’238 patent. *See* IPR2015-00223, IPR2015-00227, IPR2015-01566, IPR2015-01571, and IPR2015-01572.

³ A redacted public version of the Stipulation and Agreement was filed on August 17, 2015.

First, the parties are filing this joint motion before the Board has decided the merits of the proceeding. Indeed, the Patent Owner's Preliminary Response is not yet due, and the Board has not yet decided whether to institute trial.

Second, the parties have agreed to limit this proceeding in connection with a broader agreement to narrow the disputed issues in several co-pending proceedings, including multiple *inter partes* reviews and a district court litigation.

Third, because the merits of the petition have not been determined, reducing the number of claims at this early juncture promotes efficient use of the resources of the Board, and saves expenses for the parties.

B. A Copy of the Stipulation is Provided

The Stipulation and Agreement has been made in writing, and a true copy is filed herewith as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, as Exhibit 1041. A Joint Request to File an Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 is also being filed herewith. The redacted public version of the Stipulation and Agreement filed in the district court litigation is also submitted herewith as Exhibit 1042.

C. Summary

For the foregoing reasons, Fresenius and Cubist respectfully request that the Board limit the petition to claim 98, and remove claims 3-7, 21-25, 27-33, 35-44,

48-52, 55-57, 61-63, 66, 85, 87-89, 92-97, 99-109, 113, 115-121, 123-151, 153-159, 161-162, 164-167, 175-184, and 189-190 from consideration in this proceeding.

Dated: September 1, 2015

Respectfully submitted,

/Elizabeth J. Holland/

Elizabeth J. Holland

Reg. No. 47,657

Lead Attorney for Petitioner Fresenius Kabi
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Dated: September 1, 2015

Respectfully submitted,

/Emily R. Whelan/

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