

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

**FRESENIUS KABI USA LLC,
Petitioner**

v.

**CUBIST PHARMACEUTICALS.,
Patent Owner**

IPR2015-01570

**REQUEST FOR REFUND OF PORTION OF POST-INSTITUTION FEE
FOR *INTER PARTES* REVIEW OF U.S. PATENT 8,058,238**

**Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Fresenius Kabi USA LLC (“Petitioner”) respectfully requests a refund of \$43,200, a portion of the post-institution fee initially paid for its Petition for *Inter Partes* Review of U.S. Patent 8,058,238 (“the ’238 patent”), assigned case number IPR 2015-01570. Petitioner notes that this portion of the post-institution fee paid by Petitioner is in excess of the \$14,000 fee that is appropriate in light of the Board’s granting of Petitioner’s and patent owner’s joint motion to limit the Petition.

II. STATEMENT OF FACTS

On July 10, 2015, Petitioner filed a Petition for *Inter Partes* 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, 189, and 190 of the ’238 patent under 35 U.S.C. §§ 311-319 and 37 C.F.R. §§ 42.1-.80, 24.100-.123 (“Petition,” Paper No. 2). This review has not yet been instituted.

On September 1, 2015, Petitioner and patent owner jointly submitted a motion to limit the *Inter Partes* Review of the ’238 patent to claim 98 and 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, 189, and 190 of the ’238 patent from consideration in the proceeding.

On September 15, 2015, the Patent Trial and Appeal Board granted the joint motion to limit the instant proceeding to claim 98 of the '238 patent and 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, 189, and 190 of the '238 patent from consideration in the proceeding (Paper No. 12). The Board noted that "a decision whether to institute trial has not yet been made." (*Id.* at 3).

Because no trial has been instituted and no trial will be instituted on 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, 189, and 190 of the '238 patent, Petitioner hereby requests refund of \$43,200, the portion of the post-institution fee it paid pursuant to 37 C.F.R. § 42.15(a)(2) for each claim of the '238 patent in excess of 15 claims¹. Payment of the post-institution fee was processed through PRPS on July 10, 2015, and charged to the undersigned's Deposit Account No. 06-0923.

III. CONCLUSION

Upon review and approval of this request, Petitioner respectfully requests that the Board credit \$43,200 of the post-institution fee to Deposit Account No. 06-0923.

¹ Pursuant to 37 C.F.R. § 42.15, Petitioner paid a total post-institution fee of \$57,200 concurrently with filing the Petition as follows: \$14,000 post institution fee plus \$400 for each claim in excess of 15 claims = \$14,000 + (\$400)(108 claims) = \$57,200.

Case No. IPR2015-01570
Request for Refund of Portion of Post Institution Fee

Dated: October 12, 2015

Respectfully submitted,

/Cynthia Lambert Hardman/
Elizabeth J. Holland (Reg. No. 47,657)
Robert V. Cerwinski
Cynthia Lambert Hardman
(Reg. No. 53,179)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Tel: 212-813-8800
Fax: 212-355-3333

*Counsel for Petitioner Fresenius Kabi USA
LLC*

CERTIFICATION OF SERVICE

The undersigned hereby certifies that “**REQUEST FOR REFUND OF PORTION OF POST-INSTITUTION FEE FOR *INTER PARTES* REVIEW OF U.S. PATENT 8,058,238**” was served by electronic mail on this 12th day of October, 2015 on the following:

Emily R. Whelan
Andrej Barbic, Ph.D.
Gerard M. Devlin, Jr.
Lisa A. Jakob
Emily.Whelan@wilmerhale.com
Andrej.Barbic@wilmerhale.com
Gerard.Devlin@merck.com
Lisa.Jakob@merck.com
Wilmer Cutler Pickering
Hale and Dorr LLP
60 State Street
Boston, MA 02109

Dated: October 12, 2015

/s/ Cynthia Lambert Hardman
Elizabeth J. Holland (Reg. No. 47,657)
Robert V. Cerwinski
Cynthia Lambert Hardman
(Reg. No. 53,179)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Tel: 212-813-8800
Fax: 212-355-3333

*Counsel for Petitioner Fresenius Kabi USA
LLC*