

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA LLC,
Petitioner,

v.

CUBIST PHARMACEUTICALS, INC.,
Patent Owner.

IPR2015-01566 (Patent No. 8,129,342)
IPR2015-01570 (Patent No. 8,058,238)
IPR2015-01571 (Patent No. 8,058,238)
IPR2015-01572 (Patent No. 8,058,238)

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

TORNQUIST, *Administrative Patent Judge*.

ORDER
Motions to Limit Petitions
37 C.F.R. § 42.71

IPR2015-01566 (Patent No. 8,129,342)
IPR2015-01570 (Patent No. 8,058,238)
IPR2015-01571 (Patent No. 8,058,238)
IPR2015-01572 (Patent No. 8,058,238)

On September 1, 2015, the parties filed joint motions to limit the Petition in each of IPR2015-01566 (Paper 12), IPR2015-01570 (Paper 9), IPR2015-01571 (Paper 12), and IPR2015-01572 (Paper 12), pursuant to a Joint Stipulation and Agreement between the parties (Ex. 1041 (unredacted version), Ex. 1042 (redacted version)). The parties also filed joint requests to treat the Stipulation and Agreement as business confidential information, to be kept separate from the files of the involved patents. *See, e.g.*, IPR2015-01566, Paper 13.

In IPR2015-01566 the parties' seek to remove from consideration claims 1–22, 24–52, and 54 of U.S. Patent No. 8,129,342 and, thereby, to limit the Petition to claims 23 and 53. IPR2015-01566, Paper 12, 3.

In IPR2015-01570 the parties seek to remove from consideration 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 U.S. Patent No. 8,058,238 and, thereby, to limit the Petition to claim 98. IPR2015-01570, Paper 9, 3–4.

In IPR2015-01571 the parties seek to remove from consideration claims 1–19, 21–44, 48–51, 53, 92–97, 99–107, 112–146, 151–167, 176, 177, 179, 183–186, 188, and 189 of U.S. Patent No. 8,058,238 and, thereby, to limit the Petition to claims 98 and 187. IPR2015-01571, Paper 12, 3–4.

In IPR2015-01572 the parties seek to remove from consideration claims 20, 45–47, 49–52, 54–90, 108–111, 147–150, 168–175, 178, 180–183, and 190–192 of U.S. Patent No. 8,058,238 and, thereby, to limit the Petition to claim 91. IPR2015-01572, Paper 12, 3–4.

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IPR2015-01572 (Patent No. 8,058,238)

The above-identified proceedings are still in their preliminary stages, and a decision whether to institute trial has not yet been made. The narrowing of issues at this preliminary stage of the proceedings would serve to both conserve judicial resources and facilitate the Board's goal of resolving *inter partes* reviews in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b). Accordingly, we grant the parties' joint motion to limit the Petition in each of the above-identified proceedings.

Based on the foregoing, it is:

ORDERED, that the parties' joint motions to limit the Petitions filed in IPR2015-01566, IPR2015-01570, IPR2015-01571, and IPR2015-01572 are GRANTED; and

FURTHER ORDERED that the Petition in IPR2015-01566 is limited to claims 23 and 53 of U.S. Patent No. 8,129,342;

FURTHER ORDERED that the Petition in IPR2015-01570 is limited to claim 98 of U.S. Patent No. 8,058,238;

FURTHER ORDERED that the Petition in IPR2015-01571 is limited to claims 98 and 187 of U.S. Patent No. 8,058,238;

FURTHER ORDERED that the Petition in IPR2015-01572 is limited to claim 91 of U.S. Patent No. 8,058,238; and

FURTHER ORDERED that the parties' request that the joint Stipulation and Agreement (Ex. 1041) be treated as business confidential information and kept separate from the patent files, is GRANTED.

IPR2015-01566 (Patent No. 8,129,342)
IPR2015-01570 (Patent No. 8,058,238)
IPR2015-01571 (Patent No. 8,058,238)
IPR2015-01572 (Patent No. 8,058,238)

PETITIONER:

Elizabeth Holland
Cynthia Hardman
GOODWIN PROCTER LLP
eholland@goodwinprocter.com
chardmani@goodwinprocter.com

PATENT OWNER:

Emily R. Whelan
Andrej Barbic
WILMER CUTLER PICKERING HALE AND DORR LLP
Emily.Whelan@wilmerhale.com
Andrej.Barbic@wilmerhale.com

Gerard M. Devlin, Jr.
Lisa A. Jakob
MERCK & CO., INC.
Gerard.Devlin@merck.com
Lisa.Jakob@merck.com