

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC., APOTEX CORP., APOTEX PHARMACEUTICALS
HOLDINGS INC., AND APOTEX HOLDINGS, INC.,
Petitioner,

v.

OSI PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2016-01284
Patent 6,900,221 B1

Before LORA M. GREEN, RAMA G. ELLURU, and ZHENYU YANG,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

ORDER
Motion to Limit Petition
37 C.F.R. § 42.71

On February 8, 2017, the parties filed a Motion to Limit Petition Under 37 C.F.R. § 42.71. Paper 12. Specifically, the parties aver that they are “involved in a litigation concerning the ’221 patent in the United States District Court for the District of Delaware, *OSI Pharms., LLC and Genentech, Inc., v. Apotex, Inc. and Apotex Corp.*, C.A. No. 1:15-cv-00772-GMS-SRF.” *Id.* at 2. The parties state that they filed a stipulated order in that litigation agreeing to stay the litigation pending the outcome of this *inter partes* review proceeding, and also that they would seek to narrow the issues by removing claim 47 from the litigation, as well seeking to remove it from this proceeding. *Id.* at 2–3.

The Petition presents challenges as to claims 44–47 and 53 of the ’221 patent (Paper 3, 4–5), and the motion seeks to remove claim 47. As noted by the parties in the motion, the Board has yet to proceed to oral hearing or final written decision. *Id.* at 3. The parties have filed a true copy of the stipulated order in the co-pending district court litigation as Exhibit 2016. *Id.* In addition, limiting the proceeding facilitates the Board’s goal of resolving these *inter partes* reviews in a just, speedy and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, it is:

ORDERED, that the parties Motion to Limit is GRANTED; and

FURTHER ORDERED, that the grounds in this proceeding is limited to claims 44–46 and 53 rendered obvious by the combination of Schnur and OSI’s 10-K or Gibbs.

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