

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN INSTITUTIONAL INC.
Petitioner,

v.

FRESENIUS KABI USA, LLC
Patent Owner.

Case IPR2017-00643
Patent No. 9,168,238

PETITIONER'S REQUEST FOR REFUND OF IPR FEES

Petitioner Mylan Institutional Inc. (“Mylan”) requests a refund in the amount of \$ 20,000 to be paid to Deposit Acct. No. 160605 (Customer ID No. 00826) pursuant to the U.S. Patent and Trademark Office’s Final Rule Setting and Adjusting Patent Fees, 78 F.R. 4211, 4234-35 (Jan. 18, 2013).

On January 19, 2017, Mylan filed a Petition for *inter partes* review against U.S. Patent No. 9,168,238, proceeding IPR2017-00643. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Mylan deposited an electronic payment in the amount of \$ 31,000 with the PTO at the time of filing its Petition. Mylan’s payment consisted of \$ 11,000 in fees associated with Mylan’s *inter partes* review request, and a further \$ 20,000 in Post-Institution fees.

Mylan and Patent Owner Fresenius Kabi USA, LLC (“Fresenius”) entered into a settlement agreement that resolved all underlying disputes between the parties, including the *inter partes* review proceeding IPR2017-00643, against U.S. Patent No. 9,168,238. Accordingly, on April 13, 2017, the parties jointly moved to terminate this proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

On April 19, 2017, the Board entered a decision to terminate proceeding IPR2017-00643. Accordingly, Mylan requests a refund in the amount of \$20,000 for the Post-Institution fees.

RESPECTFULLY SUBMITTED,

Date: April 20, 2017

/Jitendra Malik/

Jitendra Malik
Reg. No. 55823
Alston & Bird LLP
4721 Emperor Boulevard, Suite 400
Durham, North Carolina 27703

*Lead Counsel for Petitioner
Mylan Institutional Inc.*

CERTIFICATION OF SERVICE

The undersigned certifies a copy of the foregoing **PETITIONER'S REQUEST FOR REFUND OF IPR FEES** was served on April 20, 2017 via electronic mail directed to the counsel of record for the Patent Owner at the following:

Imron T. Aly
ialy@schiffhardin.com

Jason G. Harp
jharp@schiffhardin.com

John K Hsu
jhsu@schiffhardin.com

Respectfully submitted,

Alston & Bird LLP

By: /Jitendra Malik/

Jitendra Malik, Ph.D.
Reg. No. 55823
Alston & Bird LLP
4721 Emperor Blvd., Suite 400
Durham, NC 27703-8580
jitty.malik@alston.com

*Attorneys for Petitioner
Mylan Institutional Inc.*