

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)
Case IPR2017-00644 (Patent No. 9,168,239)
Case IPR2017-00645 (Patent No. 9,006,289)**

**JOINT MOTION TO TERMINATE
PROCEEDINGS PURSUANT TO § 317**

Pursuant to 35 U.S.C. § 317(a), Petitioner Mylan Institutional Inc. and Patent Owner Fresenius Kabi USA, LLC (“Patent Owner”) (together, “the Parties”) jointly request termination of these inter partes reviews (IPRs) with respect to U.S. Patent No. 9,006,289, IPR2017-00645; U.S. Patent No. 9,168,238, IPR2017-00643; and U.S. Patent No. 9,168,239, IPR2017-00644. In accordance with 37 C.F.R. § 42.20(b), the parties sought, and received, authorization from the Board to file this motion on April 13, 2017.

The parties have settled their disputes. The Parties’ settlement is memorialized in a Settlement Agreement filed concurrently herewith. (Ex. 1058). Termination of these proceedings is proper because the IPRs are in their early stages. The IPRs have not been instituted, Patent Owner has not yet filed its Patent Owner Responses, and the Board has not yet “decided the merits of the proceeding[s].” 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already yielded the merits of the proceeding.”). The parties are unaware of any other matter before the USPTO that would be affected by the settlement of this proceeding and there are no other proceedings before the Board involving U.S. Patent No. 9,006,289, U.S. Patent No. 9,168,238, and U.S. Patent No. 9,168,239.

For all these reasons, the Parties respectfully request that the Board terminate these IPRs.

Respectfully submitted,

Mylan Institutional Inc.

By its attorneys

/Jitendra Malik/

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Respectfully submitted,

Fresenius Kabi USA, LLC

By its attorneys

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 was served electronically via e-mail on this 13th day of April, 2017, and directed to Patent Owner's Counsel of Record at the following addresses:

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jhsu@schiffhardin.com

Dated: April 13, 2017

Respectfully submitted,

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