

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC,
Petitioner

v.

HOSPIRA, INC.,
Patent Owner

Inter Partes Review No. IPR2017-01055
Patent 8,338,470

PATENT OWNER PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107

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The Board should not institute this *inter partes* review (IPR) because Fresenius Kabi USA, LLC (“Petitioner”) is time-barred under 35 U.S.C. § 315(b). Petitioner filed its Petition for *inter partes* review (“the Petition”) more than 1 year after it was served with a complaint in district court litigation. Although the Petition was accompanied by a motion for joinder with *Amneal Pharmaceuticals LLC v. Hospira, Inc.*, Case No. IPR2016-01578 (“the Amneal IPR”), the Amneal IPR has since been terminated by the Board. As such, Petitioner’s motion for joinder is moot as there is no proceeding for it to join, and its Petition must therefore be denied as time-barred.

I. ARGUMENT

A. The Petition Is Untimely

“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Patent Owner sued Petitioner in the U.S. District Court for the Northern District of Illinois for infringement of several patents, including U.S. Patent No. 8,338,470 (“the ’470 Patent), based on Petitioner’s filing of ANDA No. 208129 with a certification under 21 U.S.C. § 355(j)(2)(a)(vii)(IV) and pursuant to 35 U.S.C. § 271(e)(2). Petitioner admits that it was served with the complaint alleging infringement more than one year before it

filed its Petition. *See* Paper 4 (Motion for Joinder), n.1 (“Fresenius Kabi ... was served with a complaint asserting infringement of the ’470 patent more than one year before filing the Petition...”). Accordingly, by Petitioner’s own admission, its Petition is barred under § 315(b).

B. There Is No Pending IPR To Which Petitioner Could Be Joined

Petitioner attempted to avoid the time bar of § 315(b) by accompanying its Petition with a request for joinder under 35 U.S.C. § 315(c) of a then-pending IPR brought by Amneal. *See* Paper 4 (Motion for Joinder). However, that IPR was terminated by the Board on May 26, 2017. *See* IPR2016-01578, Paper 19. Accordingly, there is no pending IPR to which this petition could be joined.

There can be no joinder when there is no underlying proceeding to join. *Aerohive Networks, Inc. v. Chrimar Sys., Inc.*, IPR2016-01757, Paper 11, at *3 (P.T.A.B. Feb. 23, 2017) (“There is no longer any pending proceeding in the ’569 IPR to join that would allow Petitioner to avoid the time bar of section 315(b). As a result, the Petition is barred under section 315(b).”). *See also Apple, Inc. v. Benjamin Filmalter Grobler*, IPR2014-00060, Paper 12, at *3 (P.T.A.B. Oct. 29, 2013) (“[B]ecause the Board entered a judgment terminating [the underlying IPR], there is no proceeding for Apple to join.”); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2015-00261, Paper 10, at *5 (P.T.A.B. Jan. 29, 2015) (“Because IPR2014-00646 is no longer pending, it cannot serve as a proceeding to which

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