

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC

Petitioner

v.

CIPLA LIMITED

Patent Owner

Case No. IPR2017-00807

U.S. Patent No. 8,168,620

JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. § 42.71

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Patent Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71 and an email communication authorizing this motion,¹ Petitioner Argentum Pharmaceuticals LLC and Patent Owner Cipla Ltd. jointly request limiting the Petition (Paper 1) in this proceeding to Grounds 2 and 3 only. The parties respectfully request that the Board remove Ground 1 from this proceeding.

II. STATEMENT OF FACTS

Petitioner filed this Petition on February 2, 2017 presenting three grounds challenging the patentability of U.S. Patent No. 8,168,620 (“the ’620 patent”): (1) Ground 1 alleging unpatentability of claims 1 and 25 under 35 U.S.C. § 102(b) over Segal; (2) Ground 2 alleging unpatentability of claims 1, 4-6, 24-26, and 29 under 35 U.S.C. § 103 over Hettche, Phillipps, and Segal; and (3) Ground 3 alleging unpatentability of claims 42-44 under 35 U.S.C. § 103 over Hettche, Phillipps, Segal, and Flonase Label. *See* Paper 1, at 2. The Board, however, instituted review on Grounds 2 and 3 only. *See* Paper 11, at 26-27. Subsequently, the Board entered an order on April 26, 2018 modifying the Decision on Institution to “include review of all challenged claims and all grounds presented in the

¹ See Email from Andrew Kellogg, Supervisory Paralegal, Patent Trial and Appeal Board, to counsel (dated May 4, 2018, 4:46 PM EST) (authorizing counsel to file a joint Motion to Limit Petition under 37 C.F.R. § 42.71).

Petition,” including the Ground 1 which was not initially instituted. *See* Paper 51, at 2.

III. ARGUMENT

Limiting the Petition is appropriate here for at least the following reasons.

First, both Petitioner and Patent Owner file this joint request to limit the Petition in connection with their stipulation to limit the disputes between the parties to Grounds 2 and 3 (as presented in the Petition) only. This stipulation has been made in writing, and a true and accurate copy is filed herewith as Exhibit CIP2182.

Second, the parties have agreed to remove Ground 1 from this proceeding, which is directed to claims 1 and 25 only. The Board has already instituted review of claims 1 and 25 in connection with Ground 2. Thus, even without Ground 1 this proceeding complies with the Supreme Court’s admonition in *SAS Instit., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018) to decide the patentability of all claims challenged in the petition.

Third, because the patentability of all challenged claims in the Petition will already be decided in the final written decision, reducing the number of grounds by removing Ground 1 from this proceeding promotes efficient use of the resources of the Board and saves expenses for the parties.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request that the Board remove Ground 1 from this trial and limit the Petition to Grounds 2 and 3 only.

Respectfully submitted,

Date: May 11, 2018

/Michael Houston/
Michael R. Houston
Reg. No. 58,486
Lead Attorney for Petitioner

Respectfully submitted,

Date: May 11, 2018

/Dennies Varughese/
Dennies Varughese
Registration No. 61,868
Lead Attorney for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above-captioned “JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. § 42.71” was served in its entirety on May 11, 2018, upon the following parties via electronic mail upon the following counsel of record for the Petitioner:

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