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**COUNSEL LISTED ON SIGNATURE PAGE**

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

THE REGENTS OF THE UNIVERSITY  
OF CALIFORNIA, ABBOTT  
MOLECULAR INC., and ABBOTT  
LABORATORIES INC.,

Plaintiffs,

v.

DAKO NORTH AMERICA, INC. and  
DAKO DENMARK A/S,

Defendants.

Case No. C-05-03955 MHP

**STIPULATION AND ~~PROPOSED~~ ORDER  
REGARDING INFRINGEMENT**

Judge: Marilyn Hall Patel

**AND RELATED COUNTERCLAIMS**

To facilitate the narrowing of issues for the Court and jury at trial, plaintiffs The Regents of the University of California, Abbott Molecular Inc., and Abbot Laboratories Inc. and defendants Dako North America, Inc. and Dako Denmark A/S (“Dako”) stipulate, for the purposes of this litigation only, as follows:

1) Dako does not contest that its HER2 FISH pharmDX kit, *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH DNA Probe products have been and continue to be used in the United States to practice all limitations of claims 1, 5, 6, 11, 12, and 13 of U.S. Patent No. 5,447,841 (“the ’841 patent”) except the “blocking nucleic acid” limitation.

STIPULATION RE:  
INFRINGEMENT

CASE NO. C-05-03955 MHP

FENWICK & WEST LLP  
ATTORNEYS AT LAW  
MOUNTAIN VIEW

1           2)       Dako does not contest that the *BCR FISH DNA Probe* product has been and  
2 continues to be used in the United States to practice all limitations of claims 7 and 8 of the '841  
3 patent except the "blocking nucleic acid" limitation.

4           3)       Accordingly, the only issue in dispute on Plaintiffs' claim of infringement of the  
5 '841 patent is whether the PNA blocking probes in Dako's *HER2 FISH pharmDX kit*,  
6 *TOP2A/CEN-17 FISH Probe Mix*, *EGFR/CEN-7 FISH Probe Mix* and *BCR FISH DNA Probe*  
7 products, or the PNA blocking probes and total human DNA in Dako's *EGFR/CEN-7 FISH*  
8 *Probe Mix* and *BCR FISH DNA Probe* products are equivalent to the "blocking nucleic acid"  
9 limitation of claims 1, 5, 6, 7, 8, 11, 12, and 13.

10          4)       The jury shall be instructed that if it finds that Dako's PNA blocking probes alone  
11 or in combination with total human DNA are equivalent to the "blocking nucleic acid" limitation,  
12 then it should find infringement of claims 1, 5, 6, 7, 8, 11, 12, and 13. The jury shall also be  
13 instructed on the doctrine of equivalents. However, the parties agree that the jury does not need  
14 to be instructed on direct infringement, literal infringement, and indirect infringement (*see* N.D.  
15 Cal. Model Patent Jury Instructions Nos. 3.2, 3.3, 3.8, 3.9, and 3.10).

16          5)       The only interrogatories on infringement in the jury verdict form shall be as  
17 follows:

- 18           a. Has the University and Abbott proven that it is more likely than not that Dako's  
19 PNA blocking probes are equivalent to the "blocking nucleic acid" limitation of  
20 claims 1, 5, 6, 7, 8, 11, 12, and 13 of the '841 patent, and that Dako therefore  
21 infringes those claims?
- 22           b. Has the University and Abbott proven that it is more likely than not that Dako's  
23 PNA blocking probes in combination with total human DNA probes are equivalent  
24 to the "blocking nucleic acid" limitation of claims 1, 5, 6, 7, 8, 11, 12, and 13 of  
25 the '841 patent, and that Dako therefore infringes those claims?

26          6)       If the jury finds in favor of the UC and Abbott on the first interrogatory, and this  
27 verdict survives post-trial motions under Fed. R. Civ. P. 50., then the court shall enter judgment  
28 as follows:

- 1 a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit,  
2 *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH  
3 DNA Probe products directly infringes claims 1, 5, 6, 11, 12, and 13 of the '841  
4 patent;
- 5 b. Dako and its customers' use in the United States of the *BCR* FISH DNA Probe  
6 product directly infringes claims 7 and 8 of the '841 patent.
- 7 c. Dako is liable for inducement of infringement under 35 U.S.C. § 271(b); and  
8 d. Dako is liable for contributory infringement under 35 U.S.C. § 271(c).

9 7) If the jury finds against the UC and Abbott on the first interrogatory, but finds in  
10 favor of the UC and Abbott on the second interrogatory, and this verdict survives post-trial  
11 motions under Fed. R. Civ. P. 50, then the Court shall enter judgment as follows:

- 12 a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit  
13 and *TOP2A/CEN-17* FISH Probe Mix do not infringe any of the asserted claims of  
14 the '841 patent;
- 15 b. Dako and its customers' use in the United States of the *EGFR/CEN-7* FISH Probe  
16 Mix and *BCR* FISH DNA Probe products directly infringes claims 1, 5, 6, 11, 12,  
17 13, of the '841 patent;
- 18 c. Dako and its customers' use in the United States of the *BCR* FISH DNA Probe  
19 product directly infringes claims 7 and 8 of the '841 patent;
- 20 d. Dako is liable for inducement of infringement under 35 U.S.C. § 271(b); and  
21 e. Dako is liable for contributory infringement under 35 U.S.C. § 271(c).

22 8) If the jury finds against the UC and Abbott on both interrogatories, and this  
23 verdict survives post-trial motions under Fed. R. Civ. P. 50, then the Court shall enter judgment  
24 as follows:

- 25 a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit,  
26 *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix, and *BCR* FISH  
27 DNA Probe do not infringe any of the asserted claims of the '841 patent.

28 9) Consistent with the stipulation regarding representative products, the Court shall

1 also enter similar judgments with respect to Dako's other accused products.

2  
3 Dated: April 24, 2009

FENWICK & WEST LLP

4 By:                         /s/ Carolyn Chang  
                        Carolyn Chang

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24  
25 Dated: April 24, 2009

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Attorneys for Defendants  
DAKO NORTH AMERICA, INC. and DAKO  
DENMARK A/S

**ORDER**

Pursuant to the foregoing Stipulation, and good cause appearing, the Court hereby orders as follows:

- 1) Dako will not contest that its HER2 FISH pharmDX kit, *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH DNA Probe products have been and continue to be used in the United States to practice all limitations of claims 1, 5, 6, 11, 12, and 13 of U.S. Patent No. 5,447,841 (“the ’841 patent”) except the “blocking nucleic acid” limitation.
- 2) Dako will not contest that the *BCR* FISH DNA Probe product has been and continues to be used in the United States to practice all limitations of claims 7 and 8 of the ’841 patent except the “blocking nucleic acid” limitation.
- 3) Accordingly, the only issue in dispute on Plaintiffs’ claim of infringement of the ’841 patent is whether the PNA blocking probes in Dako’s *HER2* FISH pharmDX kit, *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH DNA Probe products, or the PNA blocking probes and total human DNA in Dako’s *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH DNA Probe products are equivalent to the “blocking nucleic acid” limitation of claims 1, 5, 6, 7, 8, 11, 12, and 13.
- 4) The jury shall be instructed that if it finds that Dako’s PNA blocking probes alone or in combination with total human DNA are equivalent to the “blocking nucleic acid” limitation, then it should find infringement of claims 1, 5, 6, 7, 8, 11, 12, and 13. The jury shall also be instructed on the doctrine of equivalents. The jury does not need to be instructed on direct infringement, literal infringement, and indirect infringement (*see* N.D. Cal. Model Patent Jury Instructions Nos. 3.2, 3.3, 3.8, 3.9, and 3.10).
- 5) The only interrogatories on infringement in the jury verdict form shall be as follows:
  - a. Has the University and Abbott proven that it is more likely than not that Dako’s PNA blocking probes are equivalent to the "blocking nucleic acid" limitation of claims 1, 5, 6, 7, 8, 11, 12, and 13 of the ’841 patent, and that Dako therefore infringes those claims?

1           b. Has the University and Abbott proven that it is more likely than not that Dako's  
2           PNA blocking probes in combination with total human DNA probes are equivalent  
3           to the "blocking nucleic acid" limitation of claims 1, 5, 6, 7, 8, 11, 12, and 13 of  
4           the '841 patent, and that Dako therefore infringes those claims?

5       6) If the jury finds in favor of the UC and Abbott on the first interrogatory, and this verdict  
6       survives post-trial motions under Fed. R. Civ. P. 50., then the court shall enter judgment  
7       as follows:

8           a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit,  
9           *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix and *BCR* FISH  
10          DNA Probe products directly infringes claims 1, 5, 6, 11, 12, and 13 of the '841  
11          patent;

12          b. Dako and its customers' use in the United States of the *BCR* FISH DNA Probe  
13          product directly infringes claims 7 and 8 of the '841 patent.

14          c. Dako is liable for inducement of infringement under 35 U.S.C. § 271(b); and

15          d. Dako is liable for contributory infringement under 35 U.S.C. § 271(c).

16       7) If the jury finds against the UC and Abbott on the first interrogatory, but finds in favor of  
17       the UC and Abbott on the second interrogatory, and this verdict survives post-trial  
18       motions under Fed. R. Civ. P. 50, then the Court shall enter judgment as follows:

19           a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit  
20           and *TOP2A/CEN-17* FISH Probe Mix do not infringe any of the asserted claims of  
21           the '841 patent;

22           b. Dako and its customers' use in the United States of the *EGFR/CEN-7* FISH Probe  
23           Mix and *BCR* FISH DNA Probe products directly infringes claims 1, 5, 6, 11, 12,  
24           13, of the '841 patent;

25           c. Dako and its customers' use in the United States of the *BCR* FISH DNA Probe  
26           product directly infringes claims 7 and 8 of the '841 patent;

27           d. Dako is liable for inducement of infringement under 35 U.S.C. § 271(b); and

28           e. Dako is liable for contributory infringement under 35 U.S.C. § 271(c).

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8) If the jury finds against the UC and Abbott on both interrogatories, and this verdict survives post-trial motions under Fed. R. Civ. P. 50, then the Court shall enter judgment as follows:

a. Dako and its customers' use in the United States of the *HER2* FISH pharmDX kit, *TOP2A/CEN-17* FISH Probe Mix, *EGFR/CEN-7* FISH Probe Mix, and *BCR* FISH DNA Probe do not infringe any of the asserted claims of the '841 patent.

9) Consistent with the stipulation regarding representative products, the Court shall also enter similar judgments with respect to Dako's other accused products.

**IT IS SO ORDERED.**

Dated: 4/30, 2009

