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SHIRE LLC and SUPERNUS PHARMACEUTICALS, INC
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1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE NORTHERN DISTRICT OF CALIFORNIA
3 SAN FRANCISCO DIVISION

4 SHIRE LLC and SUPERNUS
PHARMACEUTICALS, INC.,

5 Plaintiffs,

6 v.

7 IMPAX LABORATORIES, INC.,
8 WATSON PHARMACEUTICALS, INC.,
9 WATSON LABORATORIES, INC.-FLORIDA,
WATSON PHARMA, INC., and ANDA, INC.,

10 Defendants.

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12 _____
IMPAX LABORATORIES, INC.,

13 Counterclaimant,

14 v.

15 SHIRE LLC, SUPERNUS
PHARMACEUTICALS, INC., AMY F.T.
16 ARNSTEN, PH.D., PASKO RAKIC, M.D., and
ROBERT D. HUNT, M.D.,

17 Counterdefendants.
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) Civil Action No. 10-CV-05467 RS

) **JOINT STIPULATION TO**
) **DISMISS IMPAX'S**
) **COUNTERCLAIM REGARDING**
) **THE '290 PATENT AND AMY F.T.**
) **ARNSTEN, PASKO RAKIC, AND**
) **ROBERT D. HUNT; TO AMEND**
) **INVALIDITY CONTENTIONS; AND**
) **NOT TO APPEAL FINDING OF**
) **NON-INFRINGEMENT OF THE '290**
) **PATENT**

) **Honorable Richard Seeborg**

1 WHEREAS, on August 22, 2012, Plaintiffs filed a Second Amended Complaint [Dkt.
2 No. 210] that removed all allegations of infringement of U.S. Patent No. 5,854,290 (“the ’290
3 patent”), including Counts 1-4 for infringement, direct infringement, induced infringement, and
4 contributory infringement and including Prayers for Relief 1 and 4-11. (*Compare* Dkt. No. 19
5 *with* Dkt. No. 210.);

6 WHEREAS, on August 20, 2012, the Court granted summary judgment that Impax’s
7 proposed ANDA products do not and cannot infringe any claim of the ’290 patent. (*See* Dkt
8 No. 208.);

9 WHEREAS, on March 22, 2012, the ’290 patent was dedicated to the public;

10 WHEREFORE, in view of the dedication of all claims of the ’290 patent to the public
11 and the Court’s grant of summary judgment of non-infringement regarding the ’290 patent,
12 Plaintiffs Shire LLC and Supernus Pharmaceuticals, Inc. (collectively, “Plaintiffs”), Amy F.T.
13 Arnsten, Pasko Rakic, and Robert Hunt (collectively, “’290 Inventors”) and Defendant Impax
14 Laboratories, Inc. (“Impax”), through their respective counsel of record, hereby stipulate and
15 agree as follows:

16 1) The following, all of which pertain to the ’290 patent, are dismissed with
17 prejudice pursuant to Fed. R. Civ. P. 41(a) and 41(c):

18 a) Impax’s First Counterclaim, Declaration of Noninfringement of the ’290
19 Patent, (*see* Impax’s Answer to Second Amended Complaint (Dkt No. 212) at ¶¶ 22-
20 23);

21 b) Impax’s Fourth Counterclaim, Declaration of Invalidity of the ’290
22 Patent, (*see* Impax’s Answer to Second Amended Complaint (Dkt No. 212) at ¶¶ 28-
23 29);

24 c) Impax’s Eighth Counterclaim, Declaration of Unenforceability of the
25 ’290 Patent, (*see* Impax’s Answer to Second Amended Complaint (Dkt No. 212) at
26 ¶¶ 36-45); and

27 d) Impax’s Demands for Judgment B, E, and H, (*see* Impax’s Answer to
28 Second Amended Complaint (Dkt No. 212)); and

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e) '290 Inventors Amy F.T. Arnsten, Pasko Rakic, and Robert D. Hunt.

2) Impax will not take any discovery from any party or third party that would be relevant to only claims or counterclaims regarding the '290 patent and will not seek any discovery, whether relevant to the '290 patent or not, from any of the '290 Inventors.

3) The dismissal of Impax's First, Fourth, and Eighth Counterclaims and Demands for Judgment B, E, and H, and the dismissal of the '290 Inventors, is without prejudice to these claims being raised regarding products other than the Impax products presently proposed in ANDA No. 202238 and does not impact Impax's right to seek a finding of exceptional case or an award of fees or costs against Plaintiffs under 35 U.S.C. § 285 arising out of the litigation of the '290 patent. This is not a judgment that this case is exceptional or that any person is liable for such an award if granted.

4) Plaintiffs will not appeal, or otherwise dispute or contest, the Court's finding that the Impax products presently proposed in ANDA No. 202238 do not infringe the '290 patent, and will not oppose entry of a corresponding final judgment. (See Dkt. No. 208.)

5) Pursuant to Local Rule 7-1, Impax may amend its Invalidity Contentions once more to include additional prior art references discovered after the Court's ruling on claim construction, which were produced to Plaintiffs prior to October 5, 2012, a list of which is attached hereto as Exhibit A. Impax's Fifth Amended Invalidity Contentions shall comply with the applicable Local Rules regarding form and content and shall be served within 14 days of the Court's Order approving this Stipulation.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 10, 2012

By: /s/ Benjamin A. Katzenellenbogen
William R. Zimmerman
Sheila N. Swaroop
Benjamin A. Katzenellenbogen
Colin B. Heideman

Attorneys for Defendant
IMPAX LABORATORIES, INC.

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TROUTMAN SANDERS LLP

Dated: October 10, 2012

By: /s/ Joseph R. Robinson
Joseph R. Robinson
Heather Morehouse Ettinger
Matthew Murphey

Attorneys for Plaintiffs
SHIRE LLC and SUPERNUS
PHARMACEUTICALS, INC

SIGNATURE ATTESTATION

Pursuant to Civil L.R. 5-1, I hereby attest that concurrence in the filing of the foregoing document has been obtained from counsel for Plaintiffs Shire LLC and Supernus Pharmaceuticals, Inc., as indicated by a “conformed” signature (s/).

By: /s/ Benjamin A. Katzenellenbogen
Benjamin A. Katzenellenbogen

PURSUANT TO STIPULATION, IT IS SO ORDERED.

Dated: 10/15/12



HONORABLE RICHARD SLEBORG
UNITED STATES DISTRICT JUDGE

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