IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

THE MEDICINES COMPANY,	:	CIVIL ACTION
	:	NO. 09-750-ER
Plaintiff,	:	
	:	
v.	:	
	:	
TEVA PARENTERAL MEDICINES, INC., et al.,	:	
	:	
Defendants.	:	

O R D E R

AND NOW, this **19th** day of **May**, **2011**, upon consideration of the Special Master's Proposed Order (doc. no. 362), Plaintiff Medicines Co.'s Objections (doc. no. 362), and Defendant APP Pharmaceutical's Plaintiff Medicines Co.'s Objections (doc. no. 367), it is **ORDERED** that Plaintiff Medicines Co.'s Objections (doc. no. 362) are **SUSTAINED in part** and that Special Master's Proposed Order (doc. no. 362) is **NOT ADOPTED**.

It is further **ORDERED** that Plaintiff Medicines Co.'s Motion for Protective Order (doc. no. 319) is **GRANTED in part and DENIED in part**, as follows:

1. The motion is **GRANTED**[1] as to the unasserted

[1] Courts have found that there is no case in controversy regarding claims that are no longer alleged to be infringed. Hoffman-La Roche Inc. v. Mylan Inc., 2009 U.S. Dist. LEXIS 114784 (D.N.J. Dec. 9, 2009)(in folder materials for your review); Teradyne Inc. v. Hewlett-Packard Co., Civil Action No. 91-0344, 1994 U.S. Dist. LEXIS 8630, 1994 WL 317560 (N.D. Cal. June 21, 1994); Howes v. Zircon Corp., 992 F. Supp. 957, 959-60 (N.D. Ill. 1998); Therma-Tru Corp. v. Peachtree Doors Inc., Civil Action No.

89-73028, 1992 U.S. Dist. LEXIS 21305, 1992 WL 332100, at *4 (E.D. Mich. Feb. 25, 1992), aff'd in part, rev'd in part on other grounds, 44 F.3d 988 (Fed. Cir. 1995).

It is an open question as to whether a "case in controversy" exists regarding unasserted claims of the patents-in-suit, under the new law as espoused by the Supreme Court in MedImmune v. Genentech. 549 U.S. 118 (2007). As the burden falls with the party seeking declaratory relief, a finding that APP fails to show that there is a "case in controversy" as to the unasserted claims is supported by both Federal Circuit precedent and is consistent with the Supreme Court's direction in MedImmune.

In its response to Medco's objections, APP points to two cases for the proposition that when a patent defendant (declaratory judgment plaintiff) asserts a defense of invalidity against all claims, that this is sufficient to create a "case in controversey" to provide the Court jurisdiction over unasserted claims. APP Resp. 1 (citing Scanner Techs. Corp. v. ICOS Vision Sys. Corp., N.V., 528 F.3d 1365, 1383 (Fed. Cir. 2008); Teva Pharms., USA, Inc. v. Novartis Pharm. Corp., 482 F.3d 1330, 1340 (Fed. Cir. 2007). These cases are easily distinguishable. In Scanner, the Federal Circuit held that the district court had jurisdiction over all claims in the patent where the defendant (declaratory judgment plaintiff) was seeking a declaratory judgment that the patent in suit was unenforceable for inequitable conduct. In Teva, defendant (declaratory judgment plaintiff) sought declaratory judgment of related patents that had been listed in the Orange Book that the plaintiff did not assert in the case. In applying MedImmune, the Federal Circuit found that an injury-in-fact and thus, a case in controversy, did exist because the plaintiff could assert those related patents in a later suit against defendant. Teva Pharms.,, 482 F.3d 1330; see also Kearns v. General Motors Corp., 94 F.3d 1553 (Fed. Cir. 1996)(res judicata did not bar bringing infringement claim on different but related patents).

In this case, it seems that the justification for finding that an injury-in-fact under MedImmune is not present because Plaintiff cannot later bring a patent infringement suit against Defendant asserting infringement of the same patent on the unasserted claims. See Hemphill v. Kimberly-Clark Corp., 335 Fed. Appx. 964, 965 (Fed. Cir. 2008). As Plaintiff has represented to this Court that it is not asserting these claims, and thereby waiving its right to assert infringement on these claims, the Court finds that there is no case-in-controversy regarding the unasserted claims. Thus, discovery relating to the unasserted claims is not relevant unless APP can show that it can lead to relevant evidence regarding the asserted claims at issue.

claims of the patents-in-suit (topic 5).[2]

2. The Motion is **DENIED** as to Rule 30(b)(6) testimony relating to Plaintiff's '550 patent application and its prosecution (topic 6).[3]

AND IT IS SO ORDERED.

S/Eduardo C. Robreno
EDUARDO C. ROBRENO, J.

---

[2] While APP's Motion to Amend its Answer, to include a claim for declaratory judgment that the patents in suit are unenforceable for inequitable conduct, is still pending, the Court assumes, as the Special Master does, that this claim is not included in the current analysis. If the Motion is granted, the Court would then maintain jurisdiction over all claims. However, discovery regarding those claims would be limited to that relevant to the allegation of inequitable conduct.

Additionally, while the Court finds that there is no current case in controversy for the unasserted claims, there may be discovery regarding those claims that may be reasonably calculated to lead to the discovery of admissible evidence regarding the asserted claims. While Defendants may be able to make this argument to the Special Master, if the amount of discovery on the unasserted claims is significant, the Court will entertain a schedule change as there is only one month of fact discovery remaining.

[3] The Court agrees with the Special Master that testimony relating to the prosecution of the '550 patent is relevant and not overly burdensome as the '550 patent application was submitted on the same date and regarding the same product as the patents-in-suit.