

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

MERCK SHARP & DOHME CORP.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civ. No. 14-874-SLR
	)	
TEVA PHARMACEUTICALS USA, INC.,	)	
	)	
Defendant.	)	

**MEMORANDUM ORDER**

At Wilmington this <sup>3<sup>rd</sup></sup> day of September, 2015, having heard argument on, and having reviewed the papers submitted in connection with, the parties' proposed claim construction;

IT IS ORDERED that the disputed claim language of U.S. Patent No. 6,127,353 ("the '353 patent") shall be construed consistent with the tenets of claim construction set forth by the United States Court of Appeals for the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), as follows:

**1. "[Mometasone furoate] monohydrate"<sup>1</sup> and "mometasone furoate monohydrate."<sup>2</sup>** "Mometasone furoate monohydrate." The patented invention "relates to the novel compound mometasone furoate monohydrate, process for its preparation and pharmaceutical compositions containing said compound." (Abstract) The specification states that "[t]he present invention provides mometasone furoate monohydrate of formula I . . . ." (1:32-33) It further describes the "characteristics" of the

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<sup>1</sup> Found in claim 1.

<sup>2</sup> Found in claim 6.

“composition of matter . . . . mometasone furoate monohydrate,” including molecular formula and weight. (1:58-60) The court declines to add defendant’s additional language, “that is not formed spontaneously from anhydrous mometasone furoate in aqueous suspension,” to the claim construction. Such limiting language is not supported by “[a]n examination of the [limitation at issue] in the context of the written description and prosecution history . . . ,”<sup>3</sup> *cf. Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1143 (Fed. Cir. 2005), and adds ambiguity to the scope of the claims.

**2. “Pharmaceutical composition comprising mometasone furoate monohydrate:”**<sup>4</sup> “Composition suitable for treatment that contains mometasone furoate monohydrate.” The specification explains that “[m]ometasone furoate is known to be useful in the treatment of inflammatory conditions.” (1:14-15) Claim 6 is an independent claim, reciting “[a] pharmaceutical composition comprising mometasone furoate monohydrate in a carrier consisting essentially of water.” (8:14-16) The language “composition suitable for treatment” in the parties’ proposed constructions explains the disputed limitation to the jury. The language proposed by defendant, “composition suitable for treatment that contains a therapeutically effective amount of mometasone furoate monohydrate” adds language inconsistent with the plain meaning of the claim limitation.<sup>5</sup> This conclusion is reinforced by examining certain dependent

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<sup>3</sup> During prosecution, the applicant distinguished certain prior art, pointing out that it did not specifically disclose the compound at issue, mometasone furoate monohydrate. (D.I. 103, ex. 2 at MRK\_NAS02607850)

<sup>4</sup> Found in claim 6.

<sup>5</sup> The court declines to address defendant’s enablement arguments in connection with this claim construction exercise. In any event, there is nothing in the claim language, specification, or prosecution history requiring that mometasone furoate monohydrate be used as the active pharmaceutical ingredient in the pharmaceutical composition of claim

claims, which delineate amounts of “mometasone furoate monohydrate.” (6:33-34, claim 2; 8:17-20, claim 7)

3. The court has provided a construction in quotes for the claim limitations at issue. The parties are expected to present the claim construction to the jury consistently with any explanation or clarification herein provided by the court, even if such language is not included within the quotes

  
\_\_\_\_\_  
United States District Judge

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6, the only circumstance that would justify defendant’s additional limitation, “a therapeutically effective amount of” mometasone furoate monohydrate.