IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

NOVARTIS PHARMACEUTICALS CORPORATION, et al.,	:	
Plaintiffs,	:	
v.	:	Civil Action No. 16-431-RGA Consolidated
BRECKENRIDGE PHARMACEUTICAL, INC., et al.,	:	
Defendants.	:	

MARKMAN ORDER

The parties dispute the claim construction of "solid mixture," which occurs in the first independent claims of asserted U.S. Patent Nos. 7,297,703 and 7,741,338. As it happens, I have construed the very term in the very same patents in a prior case brought by the very same Plaintiffs, albeit against a different defendant. *See Novartis v. Par*, 2015 WL 7566615 (D. Del. Nov. 23, 2015). I have reread my opinion in the earlier case, and have considered Novartis's arguments in the joint claim construction brief. (D.I. 76). Defendants argue that Novartis is collaterally estopped, and, in any event, the claim construction is correct. Novartis says collateral estoppel does not apply because Novartis did not have a "full and fair opportunity to litigate" it in the earlier proceeding, and there was no final judgment for which the construction was essential. On the second part of this argument, Defendants concede that the law is "unsettled" on the final judgment requirement. (*Id.* at 25). Defendants argue, and I agree, that the "full and fair opportunity to litigate" is not persuasive. Indeed, I am surprised that Novartis makes the argument. Novartis was able to submit two briefs on the issue (No. 14-1494, D.I. 89) and be

heard at oral argument eleven days after the joint claim construction brief was filed, where "solid mixture" was the only term being argued. (*Id.*, D.I. 95). Could the schedule have been more leisurely? Yes. But there was plenty of time for Novartis (which does not lack for capable lawyers) to fully and fairly present its arguments. Thus, as far as I am concerned, the only issue on "collateral estoppel" is the final judgment issue. I think that is a question of law which, under the circumstances, I do not need to decide.

I think my prior claim construction is correct. There is no negative limitation that a "solid mixture" "is not a pharmaceutical composition." (D.I. 76 at 1). The main point of my earlier opinion is that an independent claim which excludes pharmaceutical compositions cannot have a dependent claim that requires a pharmaceutical composition. A substance that infringes a dependent claim must also infringe the independent claim from which it depends. Thus, if an independent claim excludes pharmaceutical compositions, a dependent claim must also exclude pharmaceutical compositions. I am not persuaded by Novartis's argument (*see* D.I. 76 at 16-20) to the contrary. Novartis's proposed construction is rejected. Defendants' proposed construction, to which Novartis does not otherwise object (*see id.* at 2 n.4), is adopted.

IT IS SO ORDERED this 25 day of April 2018.

Richard G. Andrews
United States District Judge