IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF
ILLINOIS EASTERN DIVISION

HOSPIRA, INC. Plaintiff, v. FRESENIUS KABI USA, LLC, Defendants.	C.A. No. 1:16-cv-00651 C.A. No. 1:17-cv-07903 (Consolidated) Hon. Rebecca R. Pallmeyer **PUBLIC VERSION—REDACTED**

LOCAL RULE 56.1 STATEMENT IN SUPPORT OF FRESENIUS KABI'S MOTION FOR PARTIAL SUMMARY JUDGMENT ON PRIOR SALE

I. Parties and Jurisdiction

1. The parties are Hospira, Inc. ("Hospira") and Fresenius Kabi USA, LLC ("Fresenius Kabi"), both with operations in this District. Complaint, *Hospira, Inc. v. Fresenius Kabi USA, LLC*, No. 1:16-cv-00651 (N.D. Ill. Jan. 15, 2016), D.I. 1, No. 1:17-cv-07903 (N.D. Ill. Nov. 1, 2017), D.I. 1.

2. Subject matter jurisdiction arises under the patent laws of the United States. *Id.* The parties have consented to subject matter jurisdiction, personal jurisdiction, and venue in this case. *Id.*; Answer, *Hospira, Inc. v. Fresenius Kabi USA, LLC*, No. 1:16-cv-00651 (N.D. Ill. Jan. 19, 2016), D.I. 10, No. 1:17-cv-07903 (N.D. Ill. Dec. 1, 2017), D.I. 18.

II. Background

3. An investigational new drug application ("IND") is a submission to the United States Food and Drug Administration ("FDA") that explains all of the details about a drug product, so that clinical studies can be done, which then is used to submit a New Drug Application ("NDA"). 21 C.F.R. §§ 312.1(a), 312.20.

III. The Dexmedetomidine Agreements

4. [redacted])[1], and obtained U.S. Patent No. 4,910,214 claiming dexmedetomidine in March 1990. *See Hospira, Inc. v. Sandoz Inc.*, No. 09–4591, 2012 WL 1587688, *1 (D.N.J. May 4, 2012).

[1] Citations to Ex. __ refer to the exhibits to the Declaration of Tara L. Kurtis in Support of Fresenius Kabi's Motion for Partial Summary Judgment On Prior Sale, filed contemporaneously herewith.

5. [redacted]

6. [redacted]

A. Orion License and Supply Agreement with Abbott

7. [redacted]

8. [redacted]

9. [redacted] The public was aware of the successful completion of these negotiations and the fact that Abbott had obtained the right to bring a dexmedetomidine drug product to market in the United States. (*See*, *e.g.*, Ex. E, FK-DEXMED0196073.)

1. Sale of the Dexmedetomidine IND

10. [redacted]

11. [redacted]

12. [redacted]

13. [redacted]

14. [redacted]

15. [redacted]

16. [redacted]

17. [redacted]

18. [redacted]

19. [redacted]

20. [redacted]

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