

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

HOSPIRA, INC.)	
)	
Plaintiff,)	C.A. Nos. 1:16-cv-00651
)	1:17-cv-07903
v.)	
)	Hon. Rebecca R. Pallmeyer
FRESENIUS KABI USA, LLC)	
)	PUBLIC VERSION—REDACTED
Defendant.)	

**MEMORANDUM IN SUPPORT OF FRESENIUS KABI'S
MOTION FOR PARTIAL SUMMARY JUDGMENT ON PRIOR SALE**

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..

The parties currently dispute whether the terms of the contracts establish a prior sale occurred involving a dexmed-in-glass product, a legal part of the prior art test. As set forth below, the 1994 agreement between Orion and Abbott Laboratories constitutes a sale and offer for sale of dexmedetomidine (“dexmed”) as a matter of law. The undisputed terms of that agreement: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Under Federal Circuit precedent created by Hospira by the same lawyers as in this case, the Orion agreement constitutes a sale of the IND and an offer for sale of dexmed ampoules.

The Court, therefore, should determine as a matter of law that [REDACTED]

[REDACTED] Given the limited and strictly legal nature of this determination, the issue of whether [REDACTED] [REDACTED] can and should be resolved before trial.

We expect at trial that Hospira will dispute whether the prior art makes its asserted patents invalid. But the issue in this motion is focused on the legal issue: showing that [REDACTED] [REDACTED] the subject of a prior sale, one part of the prior art test that can be addressed now. We asked Hospira to so stipulate, but they did not agree, necessitating this motion. Resolution of this legal issue will streamline the trial by eliminating unnecessary testimony on these issues and to focus on whether the IND and other prior art invalidates the asserted claims.

BACKGROUND

Dexmed is an old drug, and had been used in glass for two decades before Hospira obtained patents on that combination. Dexmed, an injectable drug used primarily to sedate

patients, was already developed [REDACTED]

[REDACTED] (LR56.1 ¶ 4.) Orion and Farnos obtained a patent on dexmed in March 1990. (*Id.*) [REDACTED]

[REDACTED]

(LR56.1 ¶ 5.) An IND explains all of the details about a drug product, so that clinical studies can be done, which then is used to submit an NDA, or New Drug Application. [REDACTED]

[REDACTED] (LR56.1 ¶ 6.)

Like most INDs, the dexmed IND [REDACTED]

[REDACTED]

[REDACTED] (LR56.1 ¶ 5.) These details will be used at trial to show that Hospira's invention had already been done in the prior art. [REDACTED]

[REDACTED] (*Id.*)

The first sale: Orion sells dexmed IND to Abbott, and offers to sell ampoules as part of a License and Supply Agreement.

The legal issue is whether the IND was the subject of a commercial sale, which despite the IND's confidential nature would make it prior art. [REDACTED]

[REDACTED] (LR56.1 ¶ 7.) [REDACTED]

[REDACTED] (LR56.1 ¶¶ 8, 9.) The culmination of the agreement was noted in public press releases. (LR56.1 ¶ 9.)

[REDACTED]

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