

**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

Honorable Rebecca Pallmeyer

JOINT CLAIM CONSTRUCTION CHART

Pursuant to Local Patent Rule 4.2(f), the Plaintiff Hospira, Inc. (“Hospira”) and Defendant Fresenius Kabi USA, LLC (“Defendant”) have provided herein their respective constructions for the disputed terms of U.S. Patent Nos. 8,242,158 (“the ‘158 patent”); 8,338,470 (“the ‘470 patent”); 8,455,527 (“the ‘527 patent”); and 8,648,106 (“the ‘106 patent”) (collectively, the “patents-in-suit”) in the form of a joint claim construction chart.

Additionally, pursuant to Local Patent Rule 4.2(f), the parties propose that the claim construction hearing be limited to attorney argument with each side having ninety (90) minutes to present its claim construction arguments. The parties propose, subject to the Court’s preference on how to hear argument on claim construction, proceeding term-by-term, with each party presenting all arguments for a term before moving to the next term. Subject to the Court’s preference, the terms will be argued in the order that they are presented in the chart below. The parties do not believe that fact or expert testimony is necessary for the claim construction hearing, unless the Court believes such testimony would be helpful.

Order of Presentation

The parties disagree regarding the appropriate order and manner of presentation.

Plaintiff's Position:

As the patentee, Hospira should go first in presenting argument on its own patents. At trial, the patentee typically proceeds with its case first. This approach should apply here, where briefing is complete and both parties have provided their positions. Therefore, Hospira requests that it be allowed to make its arguments first, followed by the Defendant's response, and then any rebuttal arguments by each party (if necessary).

Defendant's Position:

Local Patent Rule 4.2 and the Comment thereto require the alleged infringer to brief claim construction issues prior to the patentee "to promote a meaningful exchange regarding the contested points." This goal is best served by hearing the parties' arguments in the order of the briefing as dictated by the Local Patent Rules with Defendant presenting all terms (with opportunity to reserve time for rebuttal) followed by Plaintiff's response and Defendant's rebuttal (if necessary).

What is customary in other cases and other Districts is not what the Local Patent Rules provide here, and for good reason. In this District, the defendant is asked to brief and present first because it is treated as the moving party raising issues with the scope of the claims as part of the patent challenge. As such, Defendant requests the parties follow the Local Patent Rules and Defendant present its argument first for each term.

JOINT CLAIM CONSTRUCTION CHART

Patent / Claim(s)	Term	Hospira Construction	Fresenius Construction
Patents-in-suit, all asserted claims	“ready to use”	“formulated to be suitable for administration to a patient upon manufacture without dilution or reconstitution	“suitable for administration to a patient without requiring dilution”
Patents-in-suit, all asserted claims	“sealed glass container”	“glass container closed to maintain the sterility by having a seal or another closure that passes closure integrity testing”	“closed tightly to prevent unwanted materials entering or exiting the glass container”
'527 Patent, Claim 8	“intensive care unit”	“any setting that provides care to critically ill patients, typically characterized by high nurse-to-patient ratios, continuous medical supervision, and intensive monitoring”	“any setting that provides care to critically ill patients,” or “any setting that provides intensive care”

In addition, the parties agree on constructions for the following terms:

Patent / Claim(s)	Term	Hospira and Fresenius Agreed Construction
'158 patent, claim 1 '470 patent, claims 1-4 '527 patent, claims 1-5 '106 patent, claims 1-6	“dexmedetomidine”	“substantially pure, optically active dextrorotary stereoisomer of medetomidine, as the free base or pharmaceutically acceptable salt”
'158 patent, claim 1 '470 patent, claim 1 '106 patent, claim 1	“subject”	“a human, a non-human mammal or a non-human animal”
'527 patent, claims 1, 8-10	“patient”	“a human, a non-human mammal or a non-human animal”
'527 patent, claim 1	“effective amount”	“amount sufficient to produce the desired effect”

Dated: December 6, 2016

HOSPIRA, INC.

By: /s/ Bradford P. Lyerla

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

I, Yusuf Esat, an attorney at the law firm of Jenner & Block LLP, certify that on December 6, 2016 the foregoing JOINT CLAIM CONSTRUCTION CHART was electronically served on counsel of record via email.

/s/ Yusuf Esat
Yusuf Esat