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

HOSPIRA, INC.	)	
	)	
Plaintiff,	)	
	)	C.A. No. 16-cv-651
v.	)	C.A. No. 17-cv-7903
	)	
FRESENIUS KABI USA, LLC	)	Hon. Judge Rebecca R. Pallmeyer
	)	
Defendant.	)	

JOINT STIPULATION

This stipulation is made by and between Plaintiff Hospira, Inc. ("Hospira") and Defendant Fresenius Kabi USA, LLC ("Fresenius Kabi").

WHEREAS, on January 15, 2016, Hospira filed a Complaint against Fresenius Kabi for infringement of U.S. Patent Nos. 8,242,158; 8,338,470; 8,455,527; and 8,648,106, captioned *Hospira, Inc. v. Fresenius Kabi USA, LLC*, C.A. No. 16-cv-651 ("the First Action"), related to Fresenius Kabi's submission of Amended New Drug Application No. 208129 ("ANDA 208129") to the Food and Drug Administration seeking approval to market dexmedetomidine hydrochloride for injection, 80 mcg/20 mL, 200 mcg/50 mL, and 400 mcg/100 mL ("Fresenius Kabi's Proposed ANDA Products");

WHEREAS, on November 1, 2017, Hospira filed a Complaint against Fresenius Kabi for infringement of later-issued U.S. Patent No. 9,616,049, captioned *Hospira, Inc. v. Fresenius Kabi USA, LLC*, C.A. No. 17-cv-7903 ("the Second Action"), related to Fresenius Kabi's submission of ANDA 208129 to the Food and Drug Administration seeking approval to market Fresenius Kabi's Proposed ANDA Products;

WHEREAS, on December 1, 2017, Fresenius Kabi filed a Counterclaim in the Second Action asking for declaratory judgment of non-infringement and invalidity of U.S. Patent No. 9,320,712 and Hospira answered the Counterclaim on December 22, 2017;

WHEREAS, on November 27, 2017, the Court issued its Claim Construction Opinion and Order (D.I. 69) in the First Action, which the parties agree applies to the same claim terms in the Second Action;

WHEREAS, the parties jointly agreed to limit the number of claims asserted from each patent in the First and Second Action to simplify issues for expert discovery and trial;

It is hereby STIPULATED AND AGREED, subject to the approval of the Court, that:

1. Hospira asserts only these claims from all asserted patents and waives the assertion of all other claims: claims 6, 8, and 13 of U.S. Patent No. 8,455,527; claims 6 and 9 of U.S. Patent No. 8,648,106; claim 5 of U.S. Patent No. 9,320,712 and claims 4, 8, 13, and 14 of U.S. Patent No. 9,616,049. Fresenius Kabi will not assert counterclaims of non-infringement or invalidity of any other claims.

2. Fresenius Kabi hereby stipulates, in the First Action, that Fresenius Kabi's Proposed ANDA Products described in ANDA 208129, and/or the use of Fresenius Kabi's Proposed ANDA Products, would meet the limitations of claim 6 of U.S. Patent No. 8,455,527; and claims 6 and 9 of U.S. Patent No. 8,648,106 under 35 U.S.C. § 271(e) under the claim constructions entered in this action, to the extent these claims are valid and enforceable. This Stipulation does not limit or otherwise affect Fresenius Kabi's ability to defend against Hospira's asserted claims on any other ground, including, but not limited to, asserted defenses of invalidity and/or unenforceability.

3. Fresenius Kabi hereby stipulates, in the Second Action, that Fresenius Kabi's Proposed ANDA Products described in ANDA 208129, and/or the use of Fresenius Kabi's Proposed ANDA Products, would meet the limitations claim 5 of U.S. Patent No. 9,320,712 and claims 4, 8, 13, and 14 of U.S. Patent No. 9,616,049 under 35 U.S.C. § 271(e) under the claim constructions entered in this action, to the extent these claims are valid and enforceable. This Stipulation does not limit or otherwise affect Fresenius Kabi's ability to defend against Hospira's asserted claims on any other ground, including, but not limited to, asserted defenses of invalidity and/or unenforceability.

4. Fresenius Kabi withdraws the following invalidity theories that are the subject of Hospira's Motion to Strike Untimely Invalidity Contentions (*see* D.I. 81 at 5-6):

- Alleged invalidating prior use under 35 U.S.C. § 102(b) based on Investigational New Drug Application ("IND") No. 32,934 (Pages 35-37 of Fresenius Kabi's Amended Final Invalidity Contentions); and
- Alleged prior invention under Section 102(g) based on work relating to the IND (Pages 120-125 of Fresenius Kabi's Amended Final Invalidity Contentions).

5. The Revised Scheduling Order (Case No. 17-7903, D.I. 23) is amended as follows:

Event	Date
Fresenius Kabi's Non-Infringement Contentions (of '527 Claims 8 and 13)	March 26, 2018
Hospira's Response to Fresenius Kabi's Amended Final Invalidity Contentions	March 26, 2018
Close of Fact Discovery	April 2, 2018
Opening expert reports [Pl. Infringement, Secondary Considerations; Def. Invalidity]	April 16, 2018

Responsive expert reports [Pl. Validity; Def. Non-infringement, Secondary Considerations]	May 21, 2018
Close expert discovery	June 13, 2018
Hospira's draft Pre-trial Order	June 20, 2018
Final Pre-trial Order	July 2, 2018
Bench Trial	July 16-20, 2018
Fresenius Kabi Will Not Launch (Without Opinion) Before	August 17, 2018

ENTER:

Date: January 29, 2018

REBECCA R. PALLMEYER
United States District Judge