

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS**

TEVA PHARMACEUTICALS  
INTERNATIONAL GMBH and  
TEVA PHARMACEUTICALS  
USA, INC.,

Plaintiffs,

v.

ELI LILLY AND COMPANY,

Defendant.

Civil Action No.  
1:18-cv-12029-ADB

**JOINT CLAIM CONSTRUCTION STATEMENT PURSUANT TO L.R. 16.6(E)(1)(D)**

Pursuant to Local Rule 16.6(e)(1)(D) and the Court’s Scheduling Order (D.I. 47), Plaintiffs Teva Pharmaceuticals International GMBH and Teva Pharmaceuticals USA, Inc. (collectively, “Teva”) and Defendant Eli Lilly and Company (“Lilly”) hereby provide the following joint statement regarding claim construction. The parties seek the Court’s assistance in resolving disputes regarding the construction of six claim terms, which are set forth in the attached joint claim construction chart (Exhibit A) in the order the parties suggest they be construed. Also provided in the joint claim construction chart are the parties’ respective positions on each term. The parties have also provided agreed constructions for two terms.

Lilly contends that terms 1-3 are indefinite under 35 U.S.C. § 112, second paragraph, and proposes constructions of these terms only in the alternative. Lilly further contends that it is appropriate for the Court to address the indefiniteness of certain terms during claim construction. *See e.g., Uniloc 2017, LLC v. Paychex, Inc.*, No. 19-11272, Dkt # 22 (D. Mass. Jan. 13, 2020).

(“The court is no stranger to considering indefinite arguments as a part of the claim construction process . . . . The parties may include indefiniteness arguments in their claim construction briefing, and may seek leave for, if justified, expanded page limits.”); *Typemock, Ltd. v. Telerik, Inc.*, 2018 WL 4189692 (D. Mass. Aug. 31 2018) (consideration of indefiniteness as part of *Markman* claim construction). Contrary to Teva’s position below, Lilly contends that there is no “general practice” to defer consideration of indefiniteness until after the claim construction stage. The cases upon which Teva relies merely state that there may be reasons to defer consideration of indefiniteness, such as when an extensive factual inquiry is required, which is not the case here. *See, e.g., Amax, Inc. v. ACCO Brands Corp.*, 282 F. Supp. 3d 432, 442 (D. Mass. 2017) (citing *Koninklijke Philips Elecs. N.V. v. Zoll Med. Corp.*, 914 F. Supp. 2d 89, 100 (D. Mass. 2012) and *3-D Matrix, Inc. v. Menicon Co.*, Civil Action No. 14-cv-10205-IT, 2016 U.S. Dist. LEXIS 3096, at \*41 (D. Mass. Jan. 11, 2016) (“there are reasons” to defer ruling on indefiniteness, e.g., if the inquiry is largely factual)). Moreover, the Federal Circuit has affirmed findings of indefiniteness that were made at the claim construction stage. *See, e.g., Noah Sys. Inc. v. Intuit Inc.*, 675 F.3d 1302, 1308 (Fed. Cir. 2012). Lilly reserves the right to raise indefiniteness of other claim terms as disclosed to Teva under Local Rule 16.6(d)(4) in accordance with the case schedule.

Teva disagrees that terms 1-3 are indefinite and objects to Lilly raising this dispositive issue as to some terms, but not others, during claim construction. Teva also contends that addressing indefiniteness at this stage would be contrary to the general practice to defer consideration of indefiniteness and other issues of validity until after fact and expert discovery have been completed. *See, e.g., Ethicon Endo-Surgery, Inc. v. Covidien LP*, No. CV 16-12556-LTS, 2018 WL 3104078, at \*7 (D. Mass. June 21, 2018) (“Given the burden on Ethicon to establish indefiniteness by clear and convincing evidence, as well as the potentially dispositive and patent-

invalidating effect of an indefiniteness finding, it is appropriate to defer resolution of this question until the close of all discovery, when a fuller record is available.”); *Amax, Inc. v. ACCO Brands Corp.*, 282 F. Supp. 3d 432, 442 (D. Mass. 2017) (“Because the determination is likely to be determinative, many courts have declined to address indefiniteness arguments at the claim construction stage.”); *Sunrise Techs., Inc. v. Cimcon Lighting, Inc.*, 280 F. Supp. 3d 238, 247 (D. Mass. 2017) (“As an initial matter, the Court notes that indefiniteness should be resolved at the summary judgment stage rather than upon claim construction.”). Moreover, Teva disagrees that Lilly’s indefiniteness defenses do not raise substantial questions of disputed facts, and contends that adjudication of these dispositive defenses before discovery is complete would be inappropriate. Teva does not believe construction of terms 1-3 is necessary in view of their express definitions in the specification but, in the event the terms require construction, Teva proposes a construction.

Dated: August 14, 2020

/s/ Elaine Herrmann Blais

Douglas J. Kline (BBO# 556680)  
Elaine Herrmann Blais (BBO# 656142)  
Robert Frederickson III (BBO# 670111)  
Joshua S. Weinger (BBO# 690814)  
Alexandra Lu (BBO# 691114)  
Eric Romeo (BBO# 691591)  
Martin C. Topol (BBO# 696020)  
GOODWIN PROCTER LLP  
100 Northern Avenue  
Boston, MA 02210  
Tel.: (617) 570-1000  
Fax: (617) 523-1231  
dkline@goodwinlaw.com  
eblais@goodwinlaw.com  
rfrederickson@goodwinlaw.com  
jweinger@goodwinlaw.com  
alu@goodwinlaw.com  
eromeo@goodwinlaw.com  
mtopol@goodwinlaw.com

I. Neel Chatterjee (*pro hac vice*)  
Goodwin Procter LLP  
601 Marshall St.  
Redwood City, CA 94063  
Tel.: (650) 752-3100  
Fax: (650) 853-1038  
nchatterjee@goodwinlaw.com

Natasha Daughtrey (*pro hac vice*)  
GOODWIN PROCTER LLP  
601 S. Figueroa St.  
Los Angeles, CA 90017  
Tel.: (213) 426-2500  
Fax: (213) 623-1673  
ndaughtrey@goodwinlaw.com

*Attorneys for Plaintiffs*

Respectfully submitted,

/s/ Emily R. Gabranski (with permission)

Andrea L. Martin (BBO 666117)  
BURNS & LEVINSON LLP  
125 High Street  
Boston, MA 02110-1624  
(617) 345-3000  
amartin@burnslev.com

Charles E. Lipsey  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP  
Two Freedom Square  
11955 Freedom Square  
Reston, VA 20190-5675  
Charles.Lipsey@finnegan.com

William B. Raich  
Danielle A. Duszczyszyn  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP  
901 New York Avenue, NW  
Washington, DC 20001-4413  
William.Raich@finnegan.com  
Danielle.Duszczyszyn@finnegan.com

Emily R. Gabranski (BBO 694417)  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP  
2 Seaport Lane  
Boston, MA 02210-2001  
Emily.Gabranski@finnegan.com

Mark J. Stewart  
Sanjay M. Jivraj  
Eli Lilly and Company  
Lilly Corporate Center Patent Dept.  
Indianapolis, IN 46285  
stewart\_mark@lilly.com  
jivraj\_sanjay@lilly.com

*Attorneys for Defendant*

**CERTIFICATE OF SERVICE**

I, Elaine Herrmann Blais, hereby certify that a copy of the foregoing document, filed through the CM/ECF system, will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies shall be served by first class mail postage prepaid on all counsel of record who are not served through the CM/ECF system on August 14, 2020.

/s/ Elaine Herrmann Blais