

UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY

CHAMBERS OF  
CATHY L. WALDOR  
UNITED STATES MAGISTRATE JUDGE

MARTIN LUTHER KING COURTHOUSE  
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ROOM 4040  
NEWARK, NJ 07101  
973-776-7862

**LETTER ORDER**

**Re: Corcept Therapeutics, Inc. v. Teva Pharmaceuticals USA, Inc.  
Civil Action No. 2:18-cv-03632-SDW-CLW**

This matter comes before the Court on the parties' letter dispute concerning the inclusion of patent prosecution and FDA bars in the Discovery Confidentiality Order ("DCO"). (DE 69-72). For the reasons below, the Court declines to impose Defendant Teva Pharmaceuticals, USA Inc.'s ("Teva") proposed patent prosecution and FDA bar.

Teva seeks to include a DCO provision that would bar outside and in-house counsel who receive information designated as Confidential pursuant to the DCO from participating in patent prosecution and FDA correspondence related to formulations of mifepristone, the drug product at issue in this Hatch-Waxman litigation. (DE 69, at p. 1). Teva seeks to impose this patent prosecution and FDA bar during the pendency of the litigation and for two years after its conclusion, including any appeals. (*Id.* at p. 2).

Plaintiff Corcept Therapeutics, Inc. ("Corcept") opposes Teva's proposed patent prosecution and FDA bar. (DE 70). Corcept indicates that it will designate Vice President of Legal Gary Francesconi as its representative under the DCO, and it has represented that Francesconi "does not have involvement with" patent prosecution and FDA correspondence. (DE 70, at p. 5).

As an alternative, Corcept proposes a DCO provision that bars attorneys who receive Confidential Information from using that information for patent prosecution or FDA petitions. (DE 70, at p. 2). Corcept's proposed language provides in part: "All Confidential Information...shall be used by a recipient thereof solely for the purposes of this litigation and not for any business, regulatory, commercial or competitive purposes, including, but not limited to, filing or prosecuting patent applications or any communicating or petitioning activity with the FDA." (*Id.*).

"[A] party seeking imposition of a patent prosecution bar must show that the information designated to trigger the bar, the scope of activities prohibited by the bar, the duration of the bar, and the subject matter covered by the bar reasonably reflect the risk presented by the disclosure of proprietary competitive information." *In re Deutsche Bank Tr. Co. Americas*, 605 F.3d 1373, 1381 (Fed. Cir. 2010). Here, Teva has not met its threshold burden of establishing that its proposed patent prosecution and FDA bar is a reasonable precautionary measure. In light of Corcept's designation of Francesconi and its representation that he is not involved in competitive decision-

making, Teva's fears about the improper or inadvertent use of Confidential Information are speculative at this point.

The Court's denial of Teva's application is without prejudice. If new, particularized concerns arise about the use of Confidential Information, Teva may renew its request for a patent prosecution and FDA bar.

**Conclusion**

Teva's request to include a two-year patent prosecution and FDA bar in the Discovery Confidentiality Order is **DENIED**. The parties are directed to meet and confer and submit a proposed Discovery Confidentiality Order, consistent with this Order, by June 11, 2019.

**SO ORDERED**

**Dated: June 4, 2019**

*s/Cathy L. Waldor*  
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**CATHY L. WALDOR**  
**United States Magistrate Judge**