

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

KING PHARMACEUTICALS, INC.,
KING PHARMACEUTICALS RESEARCH
AND DEVELOPMENT, INC., AND
PHARMACEUTICAL IP HOLDING, INC.,

Plaintiffs,

v.

SANDOZ, INC.,

Defendants.

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SEP - 8 2010

AT 8:30
WILLIAM T. WALSH
CLERK

Civil Action No. 08-5974 (GEB)

ORDER

This matter having come before the Court upon numerous motions by King Pharmaceuticals, Inc. and King Pharmaceuticals Research and Development, Inc. (collectively "King"), Pharmaceutical IP Holding, Inc. ("Pharma IP"), King and Pharma IP (collectively "plaintiffs"), and Sandoz Inc. ("Sandoz"); and the Court having reviewed the parties' submissions and having held oral argument on September 3, 2010; and for the reasons stated on the record on that date;

IT IS ON THIS 7th day of September, 2010; hereby

ORDERED that King's motion to deem certain Requests for Admission admitted (Doc. No. 176) is GRANTED in part and DENIED in part as further set forth on the record; and it is

further

ORDERED and plaintiffs' motion to strike the Beebe reference from Sandoz's Answer and Counterclaims (Doc. No. 178) is GRANTED; and it is further

ORDERED that Sandoz's motion to compel Pharma IP to produce adequately prepared 30(b)(6) experts (Doc. No. 167) is moot because of an agreement of the parties, and therefore, DENIED; and it is further

ORDERED that Sandoz's motion to compel the production of documents by Pharma IP (Doc. No. 162) is moot because of an agreement of the parties, and therefore, DENIED; and it is further

ORDERED that Sandoz's motion to compel King to produce adequately prepared 30(b)(6) experts (Doc. No. 174) is DENIED; and it is further

ORDERED that Sandoz's appeal from Magistrate Judge Douglas E. Arpert's ruling denying its motion to amend its invalidity contentions (Doc. No. 184) is DENIED and Judge Arpert's ruling is AFFIRMED; and it is further

ORDERED that Sandoz's motion to compel King to produce documents and re-open the depositions of two of King's experts (Doc. No. 185) is DENIED; and it is further

ORDERED that plaintiffs' motion in limine to preclude Sandoz from proffering arguments and evidence not set forth in its invalidity contentions (Doc. No. 233) is GRANTED with respect to Sandoz's utility and enablement contentions, but is otherwise DENIED; and it is further

ORDERED that plaintiffs' motion in limine to preclude Sandoz from mentioning certain prior litigation (Doc. No. 234) is GRANTED; and it is further

ORDERED that plaintiffs' motion in limine to preclude Sandoz from offering evidence

or argument regarding the alleged benefits of generic pharmaceutical products (Doc. No. 235) is moot due to an agreement of the parties, and therefore, DENIED; and it is further

ORDERED that plaintiffs' motion in limine to preclude certain information pertaining to CorePharma (Doc. No. 236) is GRANTED; and it is further

ORDERED that plaintiffs' motion in limine to exclude Mutual's citizen petition and related FDA correspondence (Doc. No. 237) is GRANTED without prejudice; and it is further

ORDERED that plaintiffs' motion in limine to exclude the expert testimony of Michael Mayersohn (Doc. No. 238) is DENIED without prejudice; and it is further

ORDERED that plaintiffs' motion in limine to preclude Sandoz from mentioning plaintiffs' motion for a preliminary injunction or any related factual findings (Doc. No. 239) is GRANTED; and it is further

ORDERED that Sandoz's motions in limine (Doc. No. 215) are GRANTED in part and DENIED in part, such that

i) Sandoz's motion to preclude Frederick Peter Guengerich, Ph.D. from testifying that prior art references that do not mention metaxalone "teach away" from the invention disclosed in the '566 patent is DENIED;

ii) Sandoz's motion to preclude Fredrick Peter Guengerich, Ph.D. from testifying the prior art references disclosing a dosage regimen for metaxalone are not relevant prior art because said references fail to disclose actually providing metaxalone to a patient is moot because of an agreement of the parties, and therefore, DENIED;

iii) Sandoz's motion to preclude plaintiffs from proffering evidence of secondary considerations of non-obviousness is DENIED;

iv) Sandoz's motion to preclude plaintiffs' witnesses from testifying with respect to

Sandoz's non-metaxalone products is moot, and therefore, DENIED;

v) Sandoz's motion for claim construction of several phrases in the patent is moot, and therefore, DENIED;

vi) Sandoz's motion for claim construction concerning whether the affect on plasma concentration, safety, and/or efficacy referenced in the "informing" step of the claims must be a consequence of P450 activity is moot, and therefore, DENIED;

vii) Sandoz's motion to exclude cumulative expert testimony is DENIED;

viii) Sandoz's motion to preclude plaintiffs from relying on arguments/evidence outside of plaintiffs' local Patent Rule Contentions is DENIED;

ix) Sandoz's motion to exclude irrelevant evidence concerning plaintiffs' Contested Fact Nos. 32, 33, and 161 is DENIED;

x) Sandoz's motion to preclude expert testimony from Drs. Gusmorino, Barber, and Elia concerning general practices in the medical industry is DENIED;

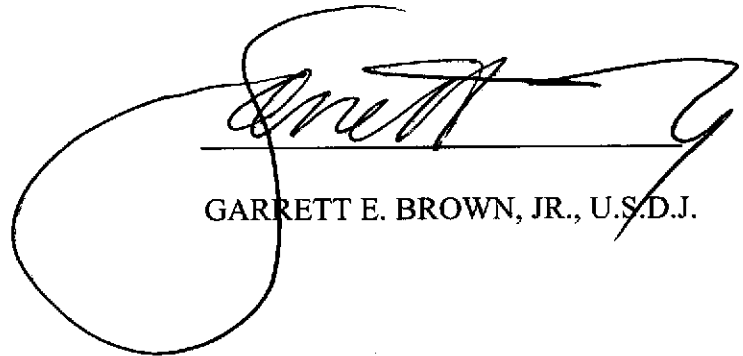
xi) Sandoz's motion to exclude testimony of Drs. Barber and Elia concerning intent, motive, state of mind, and claim interpretation is GRANTED;

xii) Sandoz's motion to exclude the testimony of Dr. Gusmorino concerning paragraphs 15 and 18 of his expert report was withdrawn, and therefore, DENIED;

xiii) Sandoz's motion to exclude all the testimony of Dr. Guengerich concerning invalidity as irrelevant and to exclude paragraphs 18, 19, and 21 as improperly offering claim construction is moot because of an agreement of the parties, and therefore, DENIED;

xiv) Sandoz's motion to strike plaintiff Pharma IP's Third Supplemental objections and Responses to defendant's Interrogatory No. 5 as untimely and to preclude plaintiffs from asserting a conception date in July, 2005 is DENIED;

xv) Sandoz's motion for summary judgment that claims 1-3, 5-12, and 14-22 of U.S. Patent No. 7,122,566 are invalid for anticipation in view of *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 2010 U.S. App. LEXIS 15947 (Fed. Cir. Aug. 2, 2010) will be considered as a Rule 50 motion.



GARRETT E. BROWN, JR., U.S.D.J.