

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

JANSSEN BIOTECH, INC. ET AL,	)	
Plaintiffs,	)	
	)	
v.	)	C.A. No. 15-10698-MLW
	)	16-11117-MLW
	)	
CELLTRION HEALTHCARE CO. INC.,	)	
ET AL.,	)	
Defendants.	)	

MEMORANDUM AND ORDER

WOLF, D.J.

February 15, 2017

These consolidated actions, both alleging infringement of U.S. Patent No. 7,598,083 (the "'083 Patent"), were scheduled for trial beginning on February 13, 2017. At a scheduling conference on January 18, 2017, the parties requested that the court address certain legal issues concerning the appropriate measure of damages and plaintiffs' entitlement to a permanent injunction if defendants are found to have infringed the '083 Patent. The court subsequently ordered the parties to file memoranda addressing the issues raised by the parties. See January 19, 2017 Order (Docket No. 387) at ¶2. The parties submitted initial memoranda on January 25 and responses on January 31, 2017. See Docket Nos. 412, 414, 441, 445.

In their initial memorandum, defendants argued for the first time that plaintiffs failed to join all co-owners of the '083 Patent in either action and, therefore, lacked standing. See Docket No. 414 at 8-10. A plaintiff's failure to join all co-owners in an

action for patent infringement requires dismissal without prejudice for lack of jurisdiction. See Taylor v. Taylor Made Plastics, Inc., 565 F. App'x 888, 889 (Fed. Cir. 2014). Defendants contend that, pursuant to the Biologics Price Competition and Innovation Act ("BPCIA"), dismissal without prejudice would limit plaintiffs' potential damages to a reasonable royalty on the product covered by the '083 Patent because any subsequent suit would be filed more than 30 days after the parties agreed, pursuant to 42 U.S.C. §262(1)(4), to a list of patents that would be subject to an infringement action. See 35 U.S.C. §271(e)(6)(A) & (B); Amgen Inc. v. Apotex, 827 F. 3d 1052, 1058 (Fed. Cir. 2016). Plaintiffs contend that the 30-day period never began running because defendants did not properly participate in the process prescribed by the BPCIA before suit was filed.

The court subsequently allowed further briefing on the standing issue. See Docket Nos. 459, 470. In a February 6, 2017 Memorandum and Order, the court ordered the parties to prepare to address, at the February 7 and 8, 2017 pretrial conference, whether plaintiffs could cure any standing defect by joining any non-party co-owners of the '083 Patent, an issue the parties had not discussed in their memoranda. See Docket Nos. 475, 476.

On February 8, 2017, the court heard oral argument on the issue of standing and found that it raises serious questions concerning its jurisdiction. As the parties agreed, those

questions required the postponement of trial to permit the filing of a motion to dismiss for lack of jurisdiction and, possibly, limited additional discovery. See Feb. 8, 2017 Transcript at 78-79; Docket No. 486 at 1-2; Docket No. 487 at 1. On February 14, 2017, the court conducted a conference by telephone and scheduled briefing and oral argument on the issue of standing. As the parties represented that the court's guidance on the proper measure of damages if defendants are found to have infringed the '083 Patent would in any event be helpful to them, the court agreed to hear argument on that issue while the motion to dismiss is being briefed.

In view of the foregoing, as stated at the February 14, 2017 conference, it is hereby ORDERED that:

1. Plaintiffs shall, by February 22, 2017, file a motion to dismiss for lack of standing because plaintiffs allegedly failed to join all co-owners of the '083 Patent.
2. Defendants shall respond by March 8, 2017.
3. Plaintiffs shall, by March 15, 2017, file a reply.
4. Defendants shall, by March 22, 2017, file a surreply.
5. The parties shall, by March 13, 2017, confer and report whether the defendants seek discovery related to the issue of standing, whether the plaintiffs agree to provide the requested discovery, and, if they do not agree, explain their respective

positions. If discovery is necessary, the court will adjust the deadlines for filing the reply and surreply.

6. A hearing shall be held on February 22, 2017, at 9:30 a.m., and continue, if necessary, on February 23 and 24, 2017, to address the appropriate measure of damages, including the impact of the BPCIA on plaintiff's entitlement to lost profits in the event that this action is dismissed without prejudice. The court may also address defendant Hospira Inc.'s Motion for Partial Summary Judgment of Non-infringement (Docket No. 264). The court will inform the parties before the February 22, 2017 hearing of the order in which it intends to address the foregoing issues.

7. A representative of each party with full settlement authority shall attend the hearing commencing on February 22, 2017. The parties shall, by February 15, 2017, each identify its representative for the court. Defendants shall designate an individual whose authority to agree to a settlement will not be affected if the court allows Hospira's Motion for Partial Summary Judgment.

8. The parties shall order the transcript of the February 14, 2017 conference.

  
UNITED STATES DISTRICT JUDGE