

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

AMGEN INC. and AMGEN
MANUFACTURING, LIMITED,

Plaintiffs,

v.

HOSPIRA, INC. and PFIZER, INC.,

Defendants.

Civil Action No. 20-0201-CFC

ORDER

I have reviewed the parties' competing proposals for summary judgment practice on the issue of noninfringement (D.I. 75). Plaintiffs seek the opportunity for additional discovery "to the extent that Defendants' proposed motion for summary judgment raises factual issues regarding the effect of the salt concentrations used in Defendants' process." D.I. 75 at 3–4. Defendants counter that their motion will not raise factual issues regarding the effect of salt concentrations and that further discovery is unnecessary because I ruled at the claim construction hearing that the salt concentration range limitation of the asserted claims is not functional. D.I. 75 at 5. In Defendants' words, "the discovery [Plaintiffs] seek[] can only be arguably relevant to a functional limitation

and would allow for inappropriate importation of the functional limitation in the preamble of increasing dynamic capacity.” D.I. 75 at 5.

I agree that the additional discovery sought by Plaintiffs is not necessary for summary judgment practice to move forward. Plaintiffs’ expert—Dr. Richard Wilson—testified credibly at the June 11 hearing that he does not know “why the lower limit appears in the claims.” Tr. of June 11, 2021 Hr’g at 140:25–141:1. *See also* Tr. at 143:25–6. (“Q. But you can’t come up with any rationale for why the patentee put numbers in the claim, can you? A. No, not that I would be comfortable really talking about.”), 153:6–12 (Dr. Wilson testifying that he was “puzzled” about why the salt concentration limitation was defined numerically). And both sides agree that the preambles to the asserted claims are limiting and require that the dynamic capacity of a hydrophobic interaction chromatography column be increased. D.I. 62 at 10, 16.

The purpose of the June 11 hearing was to provide both sides an opportunity to adduce whatever evidence they deemed necessary for the Court to construe the salt concentration limitation and streamline the case for a potential summary judgment motion based on that construction. *See* Tr. of Apr. 6, 2021 Hr’g at 6:9–9–17 (Plaintiffs’ counsel stating that “what we had understood, Your Honor, was that the purpose of this streamlining here would be for the Court to construe what has been called the concentration limitation or the about limitation, but about [0].1

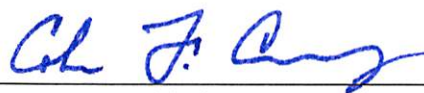
molar to about 1.0 molar language with a view to seeing whether that did, in fact, provide a basis for the defendants to then presumably move for summary judgment of noninfringement with respect to the lower limit and so that was what we understood this to be focused on.”). Plaintiffs initially sought to file before the hearing supplemental briefing and expert declarations to address “the technical significance of the concentrations of the first and second salts in this limitation, and how a skilled person would understand the invention.” D.I. 68 at 2. Plaintiffs stated during the April 6, 2021 teleconference that they made this request because they “felt . . . that . . . it might make the [June 11] proceeding more productive if everyone got the facts out on the table in advance [of the hearing].” Tr. of Apr. 6, 2021 Hr’g at 5:21–23. But once Defendants made clear during the April 6, 2021 teleconference that they would not pursue an indefiniteness defense, Plaintiffs agreed to forgo prehearing discovery and briefing and to present along with Defendants at the June 11 hearing expert testimony “about the technical considerations here, about the kind of pros and cons of using these high and low amounts and such like and what a skilled person would understand in that regard.” *Id.* at 5:15–18, 10:25–11:24. I confirmed during the June 11 hearing without objection from Plaintiffs that the hearing was convened precisely so that the parties could create the complete record on which any summary judgment motion based on the salt concentration limitation would proceed. *See* Tr. of June 11, 2021 Hr’g

at 120:23–121:5 (THE COURT: “[T]he whole purpose of this hearing was, I thought an efficient way to manage the case . . . [—]to tee this issue [of the salt limitations] up and to make sure both sides, and, in particular, the [P]laintiff[s] . . . had an opportunity to establish a full record. . . . [S]o that meant if I’m Mr. Groombridge, I’ve got to adduce all the extrinsic evidence that I believe is necessary to state my case and have the terms construed the way Amgen wants it. So the objection [of Defendants to the introduction of two articles not produced by Plaintiffs before the hearing] is overruled. [The articles] are made part of the record. MS. HANSTEAD: Thank you, Your Honor. MR. GROOMBRIDGE: With that, Your Honor, we can go to cross[-examination of the witness.]”).

Accordingly, I reject Plaintiffs’ proposal.

NOW THEREFORE, at Wilmington this Fourteenth day of July in 2021, **IT IS HEREBY ORDERED** that the briefing schedule for the Defendants’ motion for summary judgment on the issue of noninfringement is as follows:

Deadline	Date
Defendants' Opening Brief and Concise Statement of Facts	August 6, 2021
Plaintiffs' Answering Brief and Concise Statement of Facts	September 3, 2021
Defendants' Reply Brief	October 18, 2021



Chief Judge