

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

IMPAX LABORATORIES INC., et al.,	:	
	:	
Plaintiffs,	:	
	:	
v.	:	Civil Action No. 14-984-RGA
	:	Consolidated
LANNETT HOLDINGS INC., et al.,	:	
	:	
Defendants.	:	

ORDER ON MOTIONS IN LIMINE

In connection with the pretrial conference scheduled for August 26, 2016, each side has filed three motions in limine. (D.I. 113-1 at 135-77). The Court now resolves them.

Plaintiffs' MIL #1. Defendants agreed at the claim construction hearing that zolmitriptan, as used in the claims, includes "ionically bonded forms of zolmitriptan." I noted that in my claim construction opinion. (D.I. 60 at 8). No reasonable lawyer reading the opinion could reach the conclusion that my ruling excluded "ionically bonded forms of zolmitriptan." Defendants' argument to the contrary is rejected. Plaintiffs' MIL #1 is **GRANTED**.

Plaintiffs' MIL #2. I am not persuaded that Dr. Gizurarson's "Obviousness Ground 10" preserves thousands of potential obviousness combinations. I looked at paragraphs 168 and 218 of his report (D.I. 114-1 at 199-203, 228-31), and I think they are much more limited than Plaintiffs suggest. Further, it seems to me that questions about the make-up of "Sumatriptan Nasal Spray" is an issue for cross-examination. Plaintiffs' MIL #2 is **DENIED**.

Plaintiffs' MIL #3. Plaintiffs seek to exclude three witnesses. As to Plucinski, a disclosure that a third-party has "one or more technical witnesses" with discoverable information

is not a disclosure of every technical person at the third-party. Nor does another witness mentioning his name during a deposition (apparently taken after the close of fact discovery) count as a disclosure. Plucinski has not been deposed. Even now, Defendants make no meaningful proffer of what Plucinski might say. Pursuant to *Meyers v. Pennypack Woods Home Ownership Assn.*, 559 F.2d 894, 904-05 (3d Cir. 1977), Plucinski is excluded. There is no evidence that he is an important witness, Defendants have another witness (Dr. Gao) from the same company, there is incremental prejudice to the orderly preparation for trial (scheduled for Sept. 6, 2016), and there is no plausible excuse for why Defendants did not identify him during discovery, and, in this case, I think that supports a finding of bad faith. Thus, as to Plucinski, Plaintiffs' MIL #3 is **GRANTED**, and Plucinski is excluded as a witness. As to Potti, Defendants' primary argument is that he was timely disclosed, and that any suggestion they made that would have the effect of saying that he had insufficient knowledge to testify about the "formulation" of the accused product was irrelevant because he will instead testify about the "components" of the accused product. I am dubious about this distinction, but, nevertheless, since Plaintiffs seem to suggest that a deposition would suffice as a remedy, I will not exclude Potti. Defendants are to make Potti available for a deposition not to exceed three hours no later than September 1, 2016. Thus, as to Potti, Plaintiffs' MIL #3 is **DENIED** as to exclusion. As to Kelly, MIL #3 is **DISMISSED** as moot because he has no testimony relevant to the trial.

Defendants' MIL #1. Defendants seek to exclude Plaintiffs from calling four witnesses. Two of them (Stephens and Bedrosian) are Lannett employees who were deposed and who Plaintiffs intend to call only by deposition designation. (D.I. 113-1 at 115). So they are not actually at issue. (*Id.* at 157 n.1; *id.* at 161). Dr. Gao is identified by Defendants as both an expert and fact witness it will call. (*Id.* at 118-19). Dr. Gao was deposed twice. Clearly, if

Plaintiffs actually call Dr. Gao live at trial,¹ they are going to cover the ground that has already been plowed. Any failure by Plaintiffs to comply with any rule is certainly harmless. As to Clark, who was one of Plaintiffs' Rule 30(b)(6) witnesses, he is proffered as a witness to testify on the same topics on which he has been deposed. There is no unfairness, and no prejudice to Defendants, if he indeed testifies at trial on those same topics. Defendants' MIL #1 is **DISMISSED** as moot as to Stephens and Bedrosian, and otherwise **DENIED**.

Defendants' MIL #2. Defendants state that Plaintiffs cannot prove that "Zomig NS" embodies the patents, thus making testimony about secondary considerations irrelevant. There is back and forth about whether Plaintiffs show this or not. This is not a summary judgment motion, but that is what the dispute is about, that is, whether Plaintiffs have enough evidence to create a disputed issue of material fact. Thus, Defendants' MIL #2 is **DENIED** without prejudice. Defendants should make any appropriate objections at the proper time.

Defendants' MIL #3. I construed the preambles as limiting. I did not construe the preambles, which consist in relevant part of the words, "pharmaceutical formulation suitable for intranasal administration." Thus, the preambles are given their "ordinary and customary" meaning to persons of ordinary skill in the art at the relevant time. Claim construction is an issue for the court, not for the experts. Thus, I do not think any expert ought to be telling me what the term means. The time for claim construction has passed. As an aside, if an expert testifies that the accused product, or some prior art product, is (or is not) suitable for intranasal administration because it can (or can not) be absorbed by nasal membranes, I think I will be able evaluate that testimony. In other words, I think the "pharmaceutical formulation suitable for intranasal

¹ I do not think Plaintiffs will call Dr. Gao live. In the fourteen or so ANDA trials I have presided over, I feel fairly confident in saying I have never seen one side call as a "fact witness" someone associated with the other side.

administration” is pretty understandable “even to a lay judge[.]” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005)(en banc). Thus, Defendants’ MIL #3 is **DISMISSED** as moot, since both sides are precluded from providing expert testimony that the plain and ordinary meaning of “suitable for intranasal administration” is this or that.

IT IS SO ORDERED this 24 day of August 2016.


United States District Judge