NOT FOR PUBLICATION

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

IN RE DEPOMED PATENT LITIGATION	Civil Action No.: 13-4507 (CCC-MF) Civil Action No.: 15-6797 (CCC-MF) **ORDER**

CECCHI, District Judge.

This matter comes before the Court on a consolidated[1] Hatch-Waxman patent infringement action brought by Plaintiffs Depomed, Inc. ("Depomed") and Grünenthal GmbH ("Grünenthal") (collectively, "Plaintiffs"). The Defendants in the consolidated action are Actavis Elizabeth LLC, Actavis UT, Actavis LLC, Actavis, Inc. (collectively, "Actavis"), Roxane Laboratories, Inc. ("Roxane"), and Alkem Laboratories Ltd. ("Alkem"). It appearing that:

1. Defendants have sought approval from the United States Food and Drug Administration ("FDA") to market generic versions of Plaintiffs' NUCYNTA® tapentadol hydrochloride products.
2. Plaintiffs have asserted claims in three patents against Defendants: U.S. Patent No. RE39,593 (the "'593 patent"), U.S. Patent No. 7,994,364 (the "'364 patent"), and U.S. Patent No. 8,536,130 (the "'130 patent").
3. This Court conducted a bench trial in this matter beginning March 9, 2016 through March 23, 2016. The parties submitted post-trial briefing and proposed findings of

[1] This case, docket number 13-4507, is the lead case in the consolidated action. The member cases are 13-7803, 13-6929, 14-3941, 14-4617, and 15-6797.

fact and conclusions of law on April 18, 2016. Closing arguments were held on April 27, 2016.

4. The parties stipulated to bifurcation of Actavis's third counterclaim to correct or delete the FDA use code for the '130 patent. [*See* ECF No. 407.] On May 9, 2016, this Court entered a Consent Order, adjourning that bifurcated hearing without date. [ECF No. 465.] The parties have represented to the Court that they have requested clarification from the FDA on the current status of the use code.

Accordingly, for the reasons set forth in this Court's accompanying Opinion,

IT IS on this 30th date of September, 2016

ORDERED that no finding of invalidity shall issue as to the '593 patent; and it is further

ORDERED that no finding of invalidity shall issue as to the '364 patent; and it is further

ORDERED that no finding of unenforceability shall issue as to the '364 patent; and it is further

ORDERED that no finding of invalidity shall issue as to the '130 patent; and it is further

ORDERED that, pursuant to the March 4, 2016 Stipulated Order of Infringement, all Defendants infringe the asserted claims of the '593 patent; and it is further

ORDERED that, pursuant to the March 4, 2016 Stipulated Order of Infringement, all Defendants infringe the asserted claims of the '364 patent; and it is further

ORDERED that only Defendant Alkem induces infringement of claims 1, 2, 3, and 6 of the '130 patent; and it is further

ORDERED that no finding of induced infringement shall issue against Defendants Actavis and Roxane as to the '130 patent; and it is further

ORDERED that no finding of contributory infringement shall issue against any of the Defendants as to the '130 patent; and it is further

ORDERED that, in order to maintain the status quo until the Court enters final judgment, and in light of the findings set forth above and in the accompanying Opinion, Defendants are hereby enjoined from launching their generic tapentadol hydrochloride products; and it is further

ORDERED that the parties are directed to submit a proposed form of judgment consistent with this Order and the accompanying Opinion; and it is further

ORDERED that Actavis's third counterclaim to correct or delete the FDA use code for the '130 patent is hereby **SEVERED** from this action and returned to Case No. 15-6797, which shall be reopened by the Clerk; and it is further

ORDERED that the accompanying Opinion will be unsealed on Friday October 21, 2016 unless an appropriate motion to seal same (pursuant to Local Civil Rule 5.3(c)) is filed by October 14, 2016.

SO ORDERED.

CLAIRE C. CECCHI, U.S.D.J.