Appeal No. 17-1153

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

GRÜNENTHAL GMBH,

Plaintiffs-Appellees,

v.

ACTAVIS ELIZABETH LLC

Defendants-Appellants,

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY IN CASE NO. 2:13-CV-04507-CCC-MF ET AL., JUDGE CLAIRE C. CECCHI

ALKEM LABORATORIES' MOTION TO SUSPEND THE BRIEFING SCHEDULE

Imron T. Aly
Neil Lloyd
Jason G. Harp
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Chicago, IL 60606
(312) 258-5500

Attorneys for Alkem Laboratories Ltd.

December 14, 2016

CERTIFICATE OF INTEREST

I, Imron T. Aly, Counsel for Defendant-Appellant Alkem Laboratories Limited, certify the following:

1. The full name of every party or *amicus* represented by me is:

Alkem Laboratories Limited

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Alkem Laboratories Limited, as named in the caption, is the real party in interest.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

Alkem Laboratories Limited has no parent corporation and no publicly traded company owns more than 10 percent or more of its stock.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

James S. Richter
Melissa Steedle Bogad
Winston & Strawn LLP
One Riverfront Plaza
Suite 730
Newark, NJ 07102-5401

Imron T. Aly
Neil Lloyd
Jason G. Harp
SCHIFF HARDIN LLP
233 South Wacker Drive
Suite 6600
Chicago, IL 60606

Dated: December 14, 2016

Respectfully submitted,

/s/ Imron T. Aly
Imron T. Aly
SCHIFF HARDIN LLP

Pursuant to Federal Circuit Rules 26 and 27, Appellant Alkem Laboratories Limited ("Alkem") respectfully moves to suspend the briefing schedule triggered by its Notice of Appeal from the consolidated action below and the November 3, 2016 Notice of Docketing. Dkt. No. 1. The current deadline for Alkem's opening brief is January 3, 2017. Alkem respectfully suggests that the briefing be suspended until the trial court enters a Fed. R. Civ. P. 58 judgment concerning the trial court's September 30, 2016 opinion. No previous extensions have been granted for this deadline.

I. Procedural Background

On September 30, 2016, the trial court issued an opinion and order in the consolidated action. Case No. 2:13-cv-04507 (D.N.J.), Dkt. Nos. 536 and 537. Pursuant to the trial court's order (Dkt No. 537), the parties have met and conferred regarding a proposed final judgment. While the parties disagree about certain provisions in the proposed final judgment, Plaintiffs/Appellees Depomend, Inc. ("Depomed") and Grünenthal GmbH ("Grünenthal") (collectively, "Appellees") have submitted a proposed final judgment to the trial court. Dkt. No. 546. The trial court has not yet entered a final judgment.

Alkem filed its notice of appeal on October 28, 2016, within 30 days of the trial court's opinion, and a Notice of Docketing issued on November 3, 2016. Dkt. No. 1. On November 8, 2016, Appellees filed a Motion to Dismiss Appeal or, in

the Alternative, Motion to Deactivate, arguing that Alkem's appeal should be dismissed or deactivated because the trial court had not entered a Rule 58 judgment. Dkt. No. 7. Alkem filed its response on November 18, 2016, explaining its reasons for filing a notice of appeal before entry of a Rule 58 judgment. Dkt. No. 21.

II. Grounds for Extension

A suspension of the current briefing schedule until the trial court enters a Rule 58 judgment will conserve judicial resources and result in a more efficient resolution of the issues in a consolidated appeal. The trial court has not yet entered a Rule 58 judgment and appellees and the other two defendants in the consolidated action below have not yet filed notices of appeal. In the event Alkem's briefing schedule is not suspended, it is likely the Court will be addressing piecemeal the issues arising from the trial court's decision. Suspension of the current briefing schedule will allow the parties to be similarly situated upon entry of a Rule 58 judgment, allowing the Court to consider all the issues efficiently in a consolidated appeal.

III. Conclusion

For these reasons, Alkem respectfully requests that the Court suspend Alkem's briefing schedule until the trial court enters a Rule 58 judgment.

IV. Statement of Consent or Opposition

On December 12, 2016, Alkem's counsel contacted Depomed's and Grünenthal's counsel, asking if plaintiffs would agree to or, in the alternative, not oppose the instant motion. Exh. A. Depomed's counsel responded the same day and declined Alkem's request. Accordingly, Alkem believes that plaintiffs will oppose the relief sought in this motion and will file a response.

Respectfully submitted,

/s/ Imron T. Aly
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(312) 258-5500

Attorney for Defendant-Appellant Alkem Laboratories Limited.

DECLARATION OF JASON G. HARP

I, Jason G. Harp, declare:

1. I am a counsel at Schiff Hardin LLP, located at 233 South Wacker Drive, Suite 6600, Chicago, IL 60606 and am counsel of record for Defendant-Appellant Alkem Laboratories Limited ("Alkem"). I have personal knowledge of the matter set forth below and, if called to testify to them, could do so competently.

2. The trial court in Case No. 2:13-cv-04507 (D.N.J.) conducted a bench trial and issued an opinion on September 30, 2016. (Dkt. No. 536). On the same day, the trial court also issued an order enjoining Alkem pending entry of the final judgment. (Dkt. No. 537).

3. For the reasons set forth in Alkem's Response (Dkt. No. 21) to Plaintiffs/Appellees Depomend, Inc. ("Depomed") and Grünenthal GmbH ("Grünenthal") (collectively, "Appellees") Motion to Dismiss Appeal or, in the Alternative, Motion to Deactivate (Dkt. No. 7), Alkem filed a Notice of Appeal on October 28, 2016. The Court issued a Notice of Docketing on November 3, 2016 setting certain dates, including a briefing schedule. (Dkt. No. 1). Pursuant to that schedule, Alkem's opening brief would be due on January 3, 2016.

4. Pursuant to the trial court's order (Dkt. No. 537), the parties have met and conferred regarding a proposed final judgment, and while the parties disagree about certain provisions in the proposed final judgment, Appellee's have submitted

a proposed final judgment to the trial court. The trial court has not yet entered a judgment pursuant to Fed. R. Civ. P. 58. To my knowledge, the Appellees and the other defendants in the consolidated action below have not yet filed notices of appeal.

5. On December 12, 2016, I sent an email to counsel for Appellees asking whether Appellees would agree to or, in the alternative, not oppose the instant motion to suspend Alkem's briefing schedule until the trial court entered a Rule 58 judgment. Later that day, Jaysen Chung, counsel for Depomed, declined Alkem's request. A true and correct copy of that e-mail exchange is attached hereto as Exhibit A.

I declare under penalty of perjury that the foregoing is true and correct. Executed on December 14, 2016.

/s/ Jason G. Harp
Jason G. Harp

CERTIFICATE OF SERVICE

I, Jason G. Harp, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

I am an attorney with the law firm of Schiff Hardin LLP.

On December 14, 2016, I electronically filed the foregoing ALKEM LABORATORIES' MOTION TO SUSPEND BRIEFING SCHEDULE with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of the filing to all counsel for the parties registered as CM/ECF users.

December 14, 2016 /s/ Jason G. Harp
Jason G. Harp

EXHIBIT A

Harp, Jason G.

From: Chung, Jaysen S. <JSChung@gibsondunn.com>
Sent: Monday, December 12, 2016 4:04 PM
To: Harp, Jason G.; Sitzman, Michael; Best, Timothy P.; Ranney, Christine; GrunenthalPls:Lewris, Bill; GrunenthalPls:Wadler, Linda; GrunenthalPls:Bianco, Krista; GrunenthalPls:McIntyre, Kristi; GrunenthalPls:Tridico, Anthony
Cc: Aly, Imron T.; Lloyd, Neil; Hsu, John K.; Wallace, Joel M.; Patel, Sailesh K.; Riaz, Ahmed M.T.
Subject: RE: tapentadol: Appeal No. 17-1153

Jason,

Thank you for your email. Unfortunately, because of the actions that Alkem has taken with regard to this appeal, Plaintiffs are confined in what they can do to assist you in this matter. Based on the status of the underlying action at the district court, our pending motion to dismiss at the Federal Circuit, and the exchanges we have had on this issue, Plaintiffs will enter into a stipulated dismissal of Alkem's appeal. If Alkem is now prepared to do that, please prepare a draft of the stipulation that we may review.

Best,

Jaysen S. Chung

GIBSON DUNN

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From: Harp, Jason G. [mailto:JHarp@schiffhardin.com]
Sent: Monday, December 12, 2016 8:05 AM
To: Chung, Jaysen S. <JSChung@gibsondunn.com>; Sitzman, Michael <MSitzman@gibsondunn.com>; Best, Timothy P. <TBest@gibsondunn.com>; Ranney, Christine <CRanney@gibsondunn.com>; GrunenthalPls:Lewris, Bill <bill.lewris@finnegan.com>; GrunenthalPls:Wadler, Linda <linda.wadler@finnegan.com>; GrunenthalPls:Bianco, Krista <krista.bianco@finnegan.com>; GrunenthalPls:McIntyre, Kristi <kristi.mcintyre@finnegan.com>; GrunenthalPls:Tridico, Anthony <Anthony.tridico@finnegan.com>
Cc: AlkemDefs:Ialy <ialy@schiffhardin.com>; Lloyd, Neil <nlloyd@schiffhardin.com>; AlkemDefs:Hsu, J. <jhsu@schiffhardin.com>; AlkemDefs:Wallace, J. <jwallace@schiffhardin.com>; AlkemDefs:Patel, S. <spatel@schiffhardin.com>; AlkemDefs:Riaz, Ahmed M.T. <ARiaz@schiffhardin.com>
Subject: tapentadol: Appeal No. 17-1153

Counsel:

Alkem's opening brief in the above-referenced appeal, based on the Court's Nov. 3 docketing statement, is Jan. 3. In light of plaintiffs' pending motion regarding Alkem's notice of appeal and the fact that the District Court has not yet entered final judgment, would plaintiffs be agreeable to a joint or unopposed motion seeking a suspension of Alkem's current briefing schedule until a Rule 58 judgment is entered?

Regards,

Jason

Jason G. Harp
Counsel

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