Nos. 2017-1153, -2048, -2049, -2050

United States Court of Appeals for the Federal Circuit

GRUNENTHAL GMBH, DEPOMED, INC.,

Plaintiffs-Cross-Appellants,

v.

ALKEM LABORATORIES LIMITED, WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED, WEST-WARD PHARMACEUTICALS CORP.,

Defendants-Appellants,

ACTAVIS ELIZABETH LLC,

Defendant-Appellee,

ACTAVIS LABORATORIES UT, INC.,

Defendant.

Appeals from the United States District Court for the District of New Jersey, in Case Nos. 2:13-cv-04507-CCC-MF, 2:13-cv-06929-CCC-MF, 2:13-cv-07803-CCC-MF, 2:14-cv-03941-CCC-MF, 2:14-cv-04617-CCC-MF, 2:15-cv-06797-CCC-MF, Judge Claire C. Cecchi.

REPLY AND RESPONSE BRIEF FOR APPELLANTS WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED AND WEST-WARD PHARMACEUTICALS CORP.

Terrence J. Connolly
LATHAM & WATKINS LLP
885 Third Avenue
New York, NY 10022
(212) 906-1200

Kenneth G. Schuler
LATHAM & WATKINS LLP
330 North Wabash Avenue
Suite 2800
Chicago, IL 60611
(312) 876-7700

(*continued on inside cover*)

Gregory K. Sobolski
LATHAM & WATKINS LLP
505 Montgomery Street
Suite 2000
San Francisco, CA 94111
(415) 391-0600

Robert J. Gajarsa
LATHAM & WATKINS LLP
555 Eleventh Street, NW
Suite 1000
Washington, DC 20004
(202) 637-2200

Counsel for Defendant-Appellants West-Ward Pharmaceuticals International Limited and West-Ward Pharmaceuticals Corp.

January 31, 2018

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Nos. 2017-1153, -2048, -2049, -2050

GRUNENTHAL GMBH, DEPOMED, INC.

v.

ALKEM LABORATORIES LIMITED, WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED, WEST-WARD PHARMACEUTICALS CORP.

ACTAVIS ELIZABETH LLC,

ACTAVIS LABORATORIES UT, INC.

CERTIFICATE OF INTEREST

Counsel for:

☐ (petitioner) ☒ (appellant) ☐ (respondent) ☐ (appellee)

☐ (amicus) ☐ (other)

West-Ward Pharmaceuticals International Limited

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full name of party represented by me:	**2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:**	**3. Parent corporations and publicly held companies that own 10 % or more of stock in the party**
West-Ward Pharmaceuticals International Limited	N/A	West-Ward Pharmaceuticals International Limited is a wholly owned subsidiary of Hikma Pharmaceuticals PLC, which is a publicly

		held corporation traded on the London Stock Exchange under the symbol HIK.L. No other publicly held corporation owns 10% or more of the stock in West-Ward Pharmaceuticals International Limited.

4. The names of all law firms and the partners or associates that appeared for the party or amicus curiae now represented by me in the trial court or agency or are expected to appear in this court **(and who have not or will not enter an appearance in this case)** are:

Latham & Watkins LLP: Lauren K. Sharkey, Alexander E. Long (no longer with the firm), Melissa A. Brand (no longer with the firm)

GIBBONS P.C.: Amy M. Handler

SILLS CUMMIS & GROSS P.C.: Beth S. Rose, Vincent R. Lodato

EPSTEIN BECKER & GREEN, PC: Theodora T. McCormick

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

Endo Pharmaceuticals Inc., Grunenthal GMBH v. Teva Pharmaceuticals USA, Inc., Actavis Inc., Actavis South Atlantic LLC, Watson Pharmaceuticals, Inc., Amneal Pharmaceuticals Of New York, LLC, Roxane Laboratories, Inc., Amneal Pharmaceuticals, LLC, Thorx Laboratories, Inc., Barr Laboratories, Inc., Ranbaxy, Inc., Ranbaxy Pharmaceuticals, Inc., Sun Pharmaceutical Industries, Ltd., Impax Laboratories, Inc., consolidated Appeal Nos. 2015-2021, -2022, -2023, -2024, -2025, -2026, -2028, -2031, -2033, -2034, -2035, -2041, -2042, -2046, -2047, -2049, -2059, -2060 and 2016-1025, -1060, -1117, -1118.

January 31, 2018
Date

/s/ Kenneth G. Schuler
Signature of counsel

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Nos. 2017-1153, -2048, -2049, -2050

GRUNENTHAL GMBH, DEPOMED, INC.

v.

ALKEM LABORATORIES LIMITED, WEST-WARD PHARMACEUTICALS INTERNATIONAL LIMITED, WEST-WARD PHARMACEUTICALS CORP.

ACTAVIS ELIZABETH LLC,

ACTAVIS LABORATORIES UT, INC.

CERTIFICATE OF INTEREST

Counsel for:

☐ (petitioner) ☒ (appellant) ☐ (respondent) ☐ (appellee)

☐ (amicus) ☐ (other)

West-Ward Pharmaceuticals Corp.

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full name of party represented by me:	**2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:**	**3. Parent corporations and publicly held companies that own 10 % or more of stock in the party**
West-Ward Pharmaceuticals Corp.	N/A	West-Ward Pharmaceuticals Corp. is a wholly owned subsidiary of Hikma Pharmaceuticals PLC, which is a publicly held corporation traded on the London Stock

		Exchange under the symbol HIK.L. No other publicly held corporation owns 10% or more of the stock in West-Ward Pharmaceuticals Corp.

4. The names of all law firms and the partners or associates that appeared for the party or amicus curiae now represented by me in the trial court or agency or are expected to appear in this court **(and who have not or will not enter an appearance in this case)** are:

Latham & Watkins LLP: Lauren K. Sharkey, Alexander E. Long (no longer with the firm), Melissa A. Brand (no longer with the firm)

GIBBONS P.C.: Amy M. Handler

SILLS CUMMIS & GROSS P.C.: Beth S. Rose, Vincent R. Lodato

EPSTEIN BECKER & GREEN, PC: Theodora T. McCormick

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

Endo Pharmaceuticals Inc., Grunenthal GMBH v. Teva Pharmaceuticals USA, Inc., Actavis Inc., Actavis South Atlantic LLC, Watson Pharmaceuticals, Inc., Amneal Pharmaceuticals Of New York, LLC, Roxane Laboratories, Inc., Amneal Pharmaceuticals, LLC, Thorx Laboratories, Inc., Barr Laboratories, Inc., Ranbaxy, Inc., Ranbaxy Pharmaceuticals, Inc., Sun Pharmaceutical Industries, Ltd., Impax Laboratories, Inc., consolidated Appeal Nos. 2015-2021, -2022, -2023, -2024, -2025, -2026, -2028, -2031, -2033, -2034, -2035, -2041, -2042, -2046, -2047, -2049, -2059, -2060 and 2016-1025, -1060, -1117, -1118.

January 31, 2018	*/s/ Kenneth G. Schuler*
Date	Signature of counsel

TABLE OF CONTENTS

Page

CERTIFICATES OF INTEREST i

TABLE OF AUTHORITIES x

INTRODUCTION 1

COUNTER STATEMENT OF THE ISSUES FOR CROSS-APPEAL 1

SUMMARY OF THE ARGUMENT IN RESPONSE TO CROSS-APPEAL 2

REPLY FOR WEST-WARD'S APPEAL 5

I. THE '364 CLAIMS ARE NOT SUPPORTED BY AN ADEQUATE DISCLOSURE OF UTILITY 5

A. The Threshold For Adequate Disclosure Of Utility Is Not Low 5

B. The Use Of Tapentadol For Treating Pain Does Not Establish Utility For The '364 Claims 6

C. The Supposed Stability Of Form A Under Ambient Conditions Does Not Establish Utility For The '364 Claims 10

D. NUCYNTA And The ANDA Products Do Not Establish Utility For The '364 Claims 13

II. THE ASSERTED CLAIMS OF THE '130 PATENT ARE ANTICIPATED BY THE '737 PATENT 14

A. Cross-Appellants' Response Confirms That Anticipation Cannot Be Reasonably Disputed If The Noninfringement Judgment Is Reversed 14

B. Cross-Appellants Fail To Justify The District Court's Flawed Finding Of No Anticipation 15

III. THE ASSERTED CLAIMS OF THE '130 PATENT ARE INVALID FOR OBVIOUSNESS-TYPE DOUBLE PATENTING OVER THE '593 PATENT 19

Page

A. Cross-Appellants Concede That The Asserted '130 Claims Are Not Patentably Distinct If "Pain" Includes "Polyneuropathic Pain" In The '593 Patent 19

B. Cross-Appellants Fail To Show That The Asserted '130 Claims Are Not Patentably Distinct If "Pain" Is Limited To "Nociceptive Pain" In The '593 Patent 21

1. The Undisputed Facts Prove That The '130 Claims Are Not Patentably Distinct 21

2. There Was No Waiver Of The Obvious-Variant Argument 22

3. Unclaimed Features Cannot Save The Claims 23

4. There Was No Relevant Controversy Over The Use Of Opioids To Treat Neuropathic Pain 24

5. There Was No Legally Probative Evidence Of Secondary Considerations Of Nonobviousness 28

6. There Is No Dispute That The District Court Erred In Refusing To Consider The PTO's Rejection Of The Asserted '130 Claims 34

ARGUMENT IN RESPONSE TO CROSS-APPEAL 34

I. STANDARD OF REVIEW 35

II. STATEMENT OF JOINDER 36

III. THE JUDGMENT OF NO INDUCED INFRINGEMENT OF THE '130 PATENT SHOULD BE AFFIRMED 36

A. The District Court Correctly Found That West-Ward's ANDA Product Will Not Induce Infringement 36

B. Cross-Appellants Fail To Show Clear Error In The District Court's Finding Of No Inducement 39

Page

1. Reversal Is Precluded By The Uncontested Findings Of The District Court 39

2. Cross-Appellants' Only Theory Of Inducement Is Meritless 41

3. Cross-Appellants' Criticisms Of The District Court's Findings Are Meritless 48

IV. THE JUDGMENT OF NO CONTRIBUTORY INFRINGEMENT OF THE '130 PATENT SHOULD BE AFFIRMED 54

A. The District Court Correctly Found That West-Ward's ANDA Product Will Not Contribute To Infringement Of The '130 Patent 54

B. Cross-Appellants Fail To Show Clear Error In The District Court's Finding Of No Contributory Infringement 57

C. Alternatively, The Judgment Of No Contributory Infringement Should Be Affirmed Because The Accused Product Is Not Especially Made Or Adapted For Infringement Of The '130 Patent 61

CONCLUSION 63

TABLE OF AUTHORITIES

Page(s)

CASES

Allen Engineering Corp. v. Bartelli Industries, Inc.,
299 F.3d 1336 (Fed. Cir. 2002) 16

Allergan, Inc. v. Sandoz Inc.,
796 F.3d 1293 (Fed. Cir. 2015) 35

Amazon.com, Inc. v. Barnesandnoble.com, Inc.,
239 F.3d 1343 (Fed. Cir. 2001) 14

Amgen Inc. v. F. Hoffman-La Roche Ltd.,
580 F.3d 1340 (Fed. Cir. 2009) 20, 31

Anderson v. City of Bessemer City,
470 U.S. 564 (1985).....36, 44, 56

AstraZeneca LP v. Apotex, Inc.,
633 F.3d 1042 (Fed. Cir. 2010) .....*passim*

In re Bill of Lading Transmission & Processing System Patent Litigation,
681 F.3d 1323 (Fed. Cir. 2012) 57

Bristol-Myers Squibb Co. v. Teva Pharmaceuticals USA, Inc.,
752 F.3d 967 (Fed. Cir. 2014) 32

Brooktree Corp. v. Advanced Micro Devices, Inc.,
977 F.2d 1555 (Fed. Cir. 1992) 5

Brown & Williamson Tobacco Corp. v. Philip Morris Inc.,
229 F.3d 1120 (Fed. Cir. 2000) 29

Crocs, Inc. v. International Trade Commission,
598 F.3d 1294 (Fed. Cir. 2010) 29

Demaco Corp. v. F. Von Langsdorff Licensing Ltd.,
851 F.2d 1387 (Fed. Cir. 1988) 29, 30

Page(s)

DSU Medical Corp. v. JMS Co.,
471 F.3d 1293 (Fed. Cir. 2006) 36, 41

Eli Lilly & Co. v. Teva Parenteral Medicines, Inc.,
845 F.3d 1357 (Fed. Cir. 2017) 42

In re Fisher,
421 F.3d 1365 (Fed. Cir. 2005) 13

Fresenius USA, Inc. v. Baxter International, Inc.,
582 F.3d 1288 (Fed. Cir. 2009) 8, 33

Golden Blount, Inc. v. Robert H. Peterson Co.,
438 F.3d 1354 (Fed. Cir. 2006) 61

In re GPAC Inc.,
57 F.3d 1573 (Fed. Cir. 1995) 32

Hydril Co. LP v. Grant Prideco LP,
474 F.3d 1344 (Fed. Cir. 2007) 62

i4i Ltd. Partnership v. Microsoft Corp.,
598 F.3d 831 (Fed. Cir. 2010) 58

Inwood Laboratories, Inc. v. Ives Laboratories, Inc.,
456 U.S. 844 (1982).....36

J.T. Eaton & Co. v. Atlantic Paste & Glue Co.,
106 F.3d 1563 (Fed. Cir. 1997) 29, 32

Juicy Whip, Inc. v. Orange Bang, Inc.,
185 F.3d 1364 (Fed. Cir. 1999) 5

Liebel-Flarsheim Co. v. Medrad, Inc.,
358 F.3d 898 (Fed. Cir. 2004) 15

Lucent Technologies, Inc. v. Gateway, Inc.,
580 F.3d 1301 (Fed. Cir. 2009) 61

Medichem, S.A. v. Rolabo, S.L.,
437 F.3d 1157 (Fed. Cir. 2006) 56

Page(s)

Osram Sylvania, Inc. v. American Induction Technologies, Inc.,
701 F.3d 698 (Fed. Cir. 2012) 18

Otsuka Pharmaceutical Co. v. Torrent Pharmaceuticals Ltd.,
99 F. Supp. 3d 461 (D.N.J. 2015).....50

Parker v. Flook,
437 U.S. 584 (1978).....10

In re Petering,
301 F.2d 676 (C.C.P.A. 1962).....17, 18, 21

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) 15, 20

Pickholtz v. Rainbow Technologies, Inc.,
260 F. Supp. 2d 980 (N.D. Cal. 2003).....58

Rasmusson v. SmithKline Beecham Corp.,
413 F.3d 1318 (Fed. Cir. 2005) 6, 7, 8

Sanofi v. Watson Laboratories Inc.,
875 F.3d 636 (Fed. Cir. 2017) 42, 43, 57

In re Selmi,
156 F.2d 96 (C.C.P.A. 1946).....6

Shire LLC v. Amneal Pharmaceuticals, LLC,
No. 11-3781 (SRC), 2014 WL 2861430 (D.N.J. June 23, 2014).....53

Simmons Fastener Corp. v. Illinois Tool Works, Inc.,
739 F.2d 1573 (Fed. Cir. 1984) 31

SmithKline Beecham Corp. v. Apotex Corp.,
439 F.3d 1312 (Fed. Cir. 2006) 40

Sony Corp. of America v. Universal City Studios, Inc.,
464 U.S. 417 (1984).....58

Source Vagabond Systems Ltd. v. Hydrapak, Inc.,
753 F.3d 1291 (Fed. Cir. 2014) 16

Page(s)

Takeda Pharmaceutical Co. v. Doll,
561 F.3d 1372 (Fed. Cir. 2009) 31

Takeda Pharmaceuticals U.S.A., Inc. v. West-Ward Pharmaceutical Corp.,
785 F.3d 625 (Fed. Cir. 2015) 41, 42, 45

Thorner v. Sony Computer Entertainment America LLC,
669 F.3d 1362 (Fed. Cir. 2012) 15

Toshiba Corp. v. Imation Corp.,
681 F.3d 1358 (Fed. Cir. 2012) 57

United States ex rel. Polansky v. Pfizer, Inc.,
822 F.3d 613 (2d Cir. 2016) 47

Vita-Mix Corp. v. Basic Holding, Inc.,
581 F.3d 1317 (Fed. Cir. 2009) 3, 54, 56, 57, 58

Warner-Lambert Co. v. Apotex Corp.,
316 F.3d 1348 (Fed. Cir. 2003) 42, 49

WBIP, LLC v. Kohler Co.,
829 F.3d 1317 (Fed. Cir. 2016) 29, 30, 32

STATUTES

35 U.S.C. § 271(c) 4, 61

OTHER AUTHORITY

Fed. R. App. P. 28(i) 5, 36

INTRODUCTION

Cross-Appellants want to have their cake and eat it too. To argue against obviousness of the '364 patent, they proclaim that Form A "is a 'new' compound with 'new' and distinct characteristics"; but when it comes to proving adequate disclosure of utility, they declare that a POSITA was "*not* presented with a new drug or medicament" in Form A of tapentadol. Grunenthal Response Brief ("GRB") 39, 60.[1] And to argue against invalidity of the '130 patent, Cross-Appellants proclaim that "severe pain" must "refer only to nociceptive pain" because the "test data" in the '737 and '593 patents is from a "nociceptive pain model"; but when it comes to proving infringement, they declare that such "severe pain" must refer to "all forms" of pain, regardless of the factual finding (uncontested on appeal) that the test data remaining in the carved-out label is only from a nociceptive pain model. *See* Depomed Response Brief (DRB) 37-38, 65. Facts and logic cannot twist so easily: either the '364 patent is obvious, or it lacks adequate disclosure of utility; and either the '130 patent is invalid, or it is not infringed. Cross-Appellants cannot have it both ways.

COUNTER STATEMENT OF THE ISSUES FOR CROSS-APPEAL

(1) Whether the district court committed "clear error" in finding that West-Ward's ANDA product will not induce infringement of claims 1 and 2 of the

[1] All emphases added in this brief unless otherwise noted.

'130 patent when West-Ward carved out the only indication for treating a type of polyneuropathic pain and the label now contains no reference to, or data relating to, neuropathic pain.

(2) Whether the district court committed "clear error" in finding that West-Ward's ANDA products will not contribute to infringement of claims 1 and 2 of the '130 patent when there are substantial noninfringing uses of tapentadol and West-Ward's ANDA product is not especially made or especially adapted to infringe the asserted claims.

SUMMARY OF THE ARGUMENT IN RESPONSE TO CROSS-APPEAL

1. The district court did not commit "clear error" in finding that West-Ward's ANDA product will not induce infringement of the '130 patent. There logically can be no finding of specific intent here: West-Ward carved out the only approved use (Indication 2) for treating a form of polyneuropathic pain (diabetic peripheral neuropathy ("DPN")), which is affirmative evidence that it does not intend for physicians to infringe; the proposed label does not indirectly encourage treatment of DPN (a finding undisputed on appeal); the only study remaining in the carved-out label (the CLBP study) concerns nociceptive pain, not polyneuropathic pain (another finding undisputed on appeal); and treatment of polyneuropathic pain is off-label under Indication 1, which is the reason that (carved-out) Indication 2 was necessary in the first place.

Cross-Appellants' claims of clear error fail. Induced infringement is not proven by showing "some users" might infringe after reading the accused drug label—specific intent is the relevant touchtone, and it cannot be shown here. The noninfringing uses of the ANDA product prove that following the label instructions will not inevitably lead to infringement. The district court properly addressed whether the carved-out label still encouraged the treatment of DPN, because Cross-Appellants argued that it did (a position they abandon on appeal). West-Ward's carve-out logically negates an inference of specific intent. And prescribers would not believe that Indication 1 covers the treatment of polyneuropathic pain, since there is no test data in the carved-out label for neuropathic pain.

2. The district court did not commit "clear error" in finding that West-Ward's extended-release ANDA product will not contribute to infringement of the '130 patent. There is no dispute that there was "extensive evidence" that the product's noninfringing uses were not "unusual, far-fetched, illusory, impractical, occasional, aberrant, or experimental," including how long-acting opioids, such as NUCYNTA ER, were used in practice to treat severe chronic pain that was not polyneuropathic. Appx174; *Vita-Mix Corp. v. Basic Holding, Inc.*, 581 F.3d 1317, 1327 (Fed. Cir. 2009). Cross-Appellants simply demand proof of a high frequency of noninfringing use, but this Court has never held the substantiality inquiry to be a

"*quantitative one*" based on such frequency. DRB73. Even if it were, the testimony of Cross-Appellants' expert that 5% of nociceptive pain suffers required around-the-clock opioid treatment does not reveal the absolute number of such patients or the relative numbers of such patients compared to those similarly suffering from polyneuropathic pain. And that percentage likely equates to thousands of patients—an indisputably substantial number. Moreover, even if such testimony were a *prima facie* showing that shifted the burden of production to West-Ward, it was met by the "extensive evidence" West-Ward presented to prove Tapentadol ER was suitable for substantial noninfringing use. Appx174.

The judgment of no contributory infringement can be affirmed on the alternative ground that West-Ward's extended-release ANDA product was not "especially made or especially adapted" for infringement of the '130 patent. 35 U.S.C. § 271(c). Cross-Appellants did not even argue that it was (and therefore cannot do so now). Nor could they—West-Ward's carve-out of Indication 2 leaves nothing that tailors the product to the treatment of polyneuropathic pain.

REPLY FOR WEST-WARD'S APPEAL[2]

I. THE '364 CLAIMS ARE NOT SUPPORTED BY AN ADEQUATE DISCLOSURE OF UTILITY

As West-Ward explained in its principal brief, the lack of utility in the '364 patent is readily apparent. *See* West-Ward's Principal Brief ("BB") 28-42. None of Cross-Appellants' four arguments in response has merit.

A. The Threshold For Adequate Disclosure Of Utility Is Not Low

Cross-Appellants contend that the "threshold of utility is not high"—the invention just has to be "capable of providing some identifiable benefit," GRB53 (quoting *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366 (Fed. Cir. 1999)), and not be "*totally incapable* of achieving a useful result," *id.* (emphasis in original) (quoting *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992)). But those principles apply to what *type* of utility can qualify under § 101—deliberate deception of consumers for commercial, but not practical, purpose (*Juicy Whip*, 185 F.3d at 1366-37) and practical impossibility of a claimed invention (*Brooktree*, 977 F.2d at 1571). The *type* of utility is not at issue here—no one disputes that stable pharmaceutical compounds *could* have utility.

The question in this case instead is whether such claimed utility was

---

[2] West-Ward joins, expressly adopts, and incorporates Alkem's reply brief. *See* Fed. R. App. P. 28(i).

adequately disclosed in the specification of the '364 patent. The answer to that question turns on whether the disclosure of the claimed utility was not vague and would be accepted by those of skill in the art "without question" as "obviously correct" or otherwise supported by "experimental proof" of the claimed utility. *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1323-24 (Fed. Cir. 2005). The sole contention of utility in the '364 patent fails to satisfy that substantial burden here, and Cross-Appellants fail to show otherwise.[3] *See* BB28-42.

B. The Use Of Tapentadol For Treating Pain Does Not Establish Utility For The '364 Claims

Cross-Appellants argue that the district court was correct to find adequate disclosure of utility because "the '364 patent discloses that Form A of tapentadol hydrochloride is useful for treating pain." GRB54. That simply mimics the district court's legally flawed logic.

Cross-Appellants begin with the same incorrect proposition as the district court: the "'"'364 patent explicitly references the '737 patent, which teaches that tapentadol hydrochloride is useful for treating pain,'" and it was "generally known

[3] Cross-Appellants believe that the utility of an invention does not have to be "new" or "different" over prior art. GRB53 (citing *In re Selmi*, 156 F.2d 96, 99 (C.C.P.A. 1946)). The district court did too. As West-Ward explained, that is error, particularly where (as here) the claimed utility is supposedly an improvement over prior art. *See* BB39.

in the art that tapentadol hydrochloride was useful as an analgesic." GRB54 (quoting Appx146). As West-Ward explained though (BB39-42), relying on what the '737 patentees disclosed about Form B of tapentadol cannot substantiate utility for the supposedly novel Form A of tapentadol. That is blackletter law: unless it would be accepted without question, proof of utility for a new formulation of an existing compound must be substantiated by more than mere reference to the properties of a related compound. *See id.*

To that flawed base, Cross-Appellants add the district court's theory that "there is no dispute that Form A of tapentadol hydrochloride is useful as an analgesic." Appx146; *see* GRB54-56. But the lack of such dispute exists *now*—nothing was known about the properties of Form A of tapentadol when the '364 patent was filed, since that form was supposedly novel and unknown at that time. *See* BB37. Such hindsight evidence and reasoning cannot support utility, and that legal error alone requires reversal of the district court's factual finding. *See id.*; *Rasmusson*, 413 F.3d at 1322-23 (utility is measured from the filing date of the patent).

Cross-Appellants also proclaim that reliance on the analgesic properties of Form A is proper because the "'364 patent explains that 'Form A [...] has the same pharmacological activity as Form B,'" and a POSITA "would have no reason whatsoever to doubt this statement" because (i) the forms have "identical chemical

structure," (ii) "it is only the crystalline structure that is different," (iii) "when tapentadol hydrochloride is dissolved … no crystal structure remains," and (iv) the "analgesic properties of the compound tapentadol hydrochloride remain the same whether it starts as Form A or B." GRB55 (citation omitted). But such pharmacological activity was not the asserted basis for utility below. *See* BB33 n.11; Appx17714 (noting statement regarding same pharmacological activity but arguing that increased stability for advantageous use in pharmaceutical compositions was the disclosed utility); Appx17811; *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1296 (Fed. Cir. 2009) (arguments not raised below are waived). And multiple *ipse dixit* statements based on facts not disclosed in the '364 patent and not otherwise discovered until after the '364 patent was filed could not support that claim anyway. *See Rasmusson*, 413 F.3d at 1323.

Moreover, a POSITA would not accept the statement "'without question'" as "'obviously correct'" without some confirmatory "experimental proof." *Id.* at 1323-24 (citation omitted). When the '364 patent was filed, Form A (supposedly) had never been publically disclosed or tested, it was known that polymorphs like Form A could have unpredictable properties, and Form A (supposedly) was a new compound with different and unpredictable properties that made it novel over Form B—indeed, such unpredictable properties of Form A (and polymorphs generally) was a basis for the district court's (flawed) holding that the '364 claims

are valid over the '737 patent. *See* BB39-42; Appx128-137; Appx397 (1:58-63); Appx9767; Appx9796-9799; Appx10773-10774; Appx10913-10914.

At bottom, Cross-Appellants' theory is premised on the idea that Form A was *not* a new drug with potentially new, unknown properties—"[h]ere," they claim, a "[POSITA] is not presented with a new drug or medicament, but with a new crystalline structure of a drug that has *already been described and tested*." GRB59-60. That is why, according to Cross-Appellants, "this case is unlike the cases upon which West-Ward relies," including *Brenner*, *In re Kirk*, and *Rasmussen*. GRB55; *see* GRB59-60. But the idea that Form A was *not* supposed to be a new drug is pure litigation-driven fantasy. The '364 patentees promised the PTO that Form A *was* a new form of tapentadol "different from the form already known (Form B)" (Appx397 (1:58-63)), and the district court found the '364 patent to be nonobvious for that very reason (*see* BB36-37; Appx128-137). Cross-Appellants even argue in favor of nonobviousness on appeal by asserting that Form A was "a 'new' compound with 'new' and distinct characteristics." GRB39. A POSITA, therefore, would have every reason in the world to doubt an *ipse dixit* statement such as "Form A … has the same pharmacological activity as Form B" at the time the '364 patent was filed. Cross-Appellants cannot have their cake and

eat it too—either Form A was not supported by an adequate disclosure of utility or it was obvious.[4]

C. The Supposed Stability Of Form A Under Ambient Conditions Does Not Establish Utility For The '364 Claims

There is no merit to either of Cross-Appellants' suggestions for how utility of the '364 claims is adequately disclosed by the statement that Form A "is more stable under ambient conditions" than Form B. GRB56.

First, Cross-Appellants simply reiterate the district court's belief that such a statement is not vague because "all of the witnesses appeared to understand" it to mean that "Form A is the form that tends to persist (and that Form B will tend to convert to Form A) at room temperature." Appx147; *see* GRB56 (quoting Appx147). They cite nothing, though, beyond the same flawed evidence relied on by the district court. *See* GRB56-57; BB32-33, 38-39. And Cross-Appellants ignore (as the district court erroneously did) that experts on both sides (as well as one of the '364 inventors) agreed that the statement "more stable under ambient conditions" was vague since "ambient conditions" could include a multitude of

[4] Cross-Appellants miss the import of *Parker v. Flook*, 437 U.S. 584 (1978). *See* GRB56. There, the Supreme Court taught that the definition and scope of a claimed invention cannot vary according to the section of the Patent Act that is being applied—precisely what Cross-Appellants wish to do here. *See Flook*, 437 U.S. at 590.

factors, none of which is identified as the relevant "ambient condition[]" against which to measure stability. *See* BB38-39.

Second, Cross-Appellants insist that Example 16 adequately discloses data to support that claim of utility for Form A. GRB57. The "evidence in this case," they assert, "is undisputed that Form A is more thermodynamically stable than Form B at room temperature." *Id.* That clearly is not true. Beyond their own expert's testimony, Cross-Appellants cite only the testimony of West-Ward's expert, Dr. Matzger, to support that supposedly "undisputed" fact. *See id.* (citing Appx9829, Appx9844). But Dr. Matzger did not testify that Example 16 shows that "Form A is more thermodynamically stable than Form B at room temperature." To the contrary, Dr. Matzger testified that: "I don't find [the stated utility] supported by anything in the patent"; "Example 16 certainly is ambiguous"; and demonstrating "conversion" "from A to B" at a certain temperature or range (i.e., 40-50°C) only reveals how "*at that temperature*" "B is more stable." Appx9845-9846. That is why additional data *at room temperature* was necessary to support a claim of stability *at room temperature* (assuming that is how to read ambient conditions). *See* BB40-42. At the very least, a POSITA would need to know the temperature at which Form B converts to Form A to set some bounds of stability—though that alone would be inadequate too. *See* Appx9845-9846. While Cross-Appellants complain that failures to disclosure such data do not "remove the

utility of the invention" (GRB58), that information was logically necessary to adequately support *disclosure* of utility.

Indeed, the need for additional data is indisputable in light of Cross-Appellants' proclamation that the threat to the novelty of Form A from reading Example 16 in their favor (*see* BB40-41) is "false" and "ridiculous." GRB58. Cross-Appellants' entire theory of how Example 16 proves stability of Form A at room temperature (and the one that the district court bought hook, line, and sinker) is that Form A converts to Form B at 40-50°C, so Form A, not B, is the stable form of tapentadol "at temperatures ***below*** 40°C," which include room temperature. *Id.* (emphasis in original). But Example 16 contains no such data at room temperature.

Equally significant is the fact that Cross-Appellants' argument is predicated on the notion that it is allegedly "undisputed that Form B is metastable at room temperature and that it ***can persist at room temperature for years***." GRB58. That statement hardly squares with the lone statement of utility recited in the specification, that Form A is "more stable under ambient conditions." Appx398 (4:13-16).

And the stability of Form B at room temperature was not "undisputed." GRB58. As Dr. Matzger explained, Form B could be considered "*meta*stable" because it is "motivated to convert to [Form A]," so, at room temperature, "Form B

is metastable … *and* … *also unstable*." Appx9830. Additional expert testimony from Dr. Steed confirmed that fact: "[F]orm B simply doesn't persist at room temperature. It's unstable." Appx9607.[5] That scientists still debate the issue today in light of additional data underscores the fact that the absence of data in the specification is dispositive and that scientists would not have believed the unsupported statement of utility.

D. NUCYNTA And The ANDA Products Do Not Establish Utility For The '364 Claims

Cross-Appellants cursorily assert that Form A "indisputably" has "substantial utility" because "it is being used as an analgesic by hundreds of thousands of NUCYNTA patients, and Defendants seek to use it in their own products." GRB60. That proposition barely warrants response. NUCYNTA and the ANDA products have no bearing on the utility analysis in this case: they did not exist at the time the '364 patent was filed, and their benefits were obviously not disclosed in the patent. *See, e.g.*, *In re Fisher*, 421 F.3d 1365, 1371 (Fed. Cir. 2005) (utility analysis turns on invention "as disclosed in its current form," not "at some future date after further research" after the patent is filed).

---

[5] For that same reason, there is little to glean from Dr. Steed's supposed concession regarding Example 16. *See* GRB57-58; Appx148. Dr. Steed concluded that Example 16 could show that Form A is stable at room temperature but that would mean "[F]orm B simply doesn't persist at room temperature" *because "[i]t's unstable*." Appx9607. According to Cross-Appellants, though, that could not be correct.

II. THE ASSERTED CLAIMS OF THE '130 PATENT ARE ANTICIPATED BY THE '737 PATENT

If West-Ward's noninfringement judgment for claims 1 and 2 of the '130 patent is reversed, the claims should be invalidated as anticipated by the '737 patent and judgment entered in West-Ward's favor on that alternative basis.

A. Cross-Appellants' Response Confirms That Anticipation Cannot Be Reasonably Disputed If The Noninfringement Judgment Is Reversed

As they did below, Cross-Appellants argue on appeal that West-Ward's extended release ANDA product should be found to infringe claims 1 and 2 of the '130 patent because the term "pain" in the lone indication for which West-Ward seeks approval encompasses polyneuropathic pain. *See, e.g.*, DRB61-77; Appx9490-9491; Appx11917-11918; *see also* Appx11189-11190, Appx11197-11201. But terms of art cannot be read "one way to avoid anticipation and another to find infringement." *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citation omitted). If there is infringement, "pain" in the claims of the '737 patent must be read equally broadly and would expressly (or, at the very least, inherently) anticipate the '130 claims. *See* BB43-46.

Cross-Appellants' effort to cast the issue as one involving "severe" pain (DRB31) is unavailing. The prior art—including the '737 patent and '593 patents—already disclosed tapentadol for the "treatment of severe pain." *See* Appx56787-56793; Appx56800-56804; BB42-49.

B. Cross-Appellants Fail To Justify The District Court's Flawed Finding Of No Anticipation

Cross-Appellants raise four points in response to West-Ward's showing of error in the district court's anticipation decision—none has merit.

First, Cross-Appellants argue that the district court was correct to limit the ordinary meaning of "pain" to "nociceptive pain" in the '737 patent because the mouse-writhing test discloses "analgesic data" only for that type of pain and West-Ward failed to present any "proper basis" to otherwise expand the meaning of the term "pain." DRB40; *see* DRB38. That flips claim construction on its head; terms of art are assigned their ordinary meaning and then evidence must be presented to narrow them—not the other way around. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc). Here, Cross-Appellants do not dispute that the plain and ordinary meaning of "pain" and "severe pain" were broad terms that included neuropathic pain. *See* BB9-10; DRB7, 65. Accordingly, only a "clear and unmistakable disclaimer" by the patentees could narrowly "redefine" the meaning of "pain" to be "purely nociceptive pain." *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1366-67 (Fed. Cir. 2012). And the mouse writhing test does not qualify as such a disclaimer. *See* BB47-49; *see also, e.g.*, *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004) (claims should not be limited to a disclosed embodiment even if it is the only embodiment disclosed). Indeed, if that test has lexicographical effect, then the only "mammal"

covered by the treatment methods of the '737 patent (and the '593 patent) would be a mouse—a point Cross-Appellants unsurprisingly do not dispute. *See* BB49.

Second, Cross-Appellants repeatedly suggest that neuropathic pain could not be covered by the '737 claims because then the claims would be invalid for lack of enablement. *See* DRB37, 40. "It is not [a court's] function," however, "to rewrite claims to preserve their validity." *Allen Eng'g Corp. v. Bartelli Indus., Inc.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002); *Source Vagabond Sys. Ltd. v. Hydrapak, Inc.*, 753 F.3d 1291, 1301 (Fed. Cir. 2014). In addition, the '737 patent is presumed enabled as a matter of law, which Cross-Appellants do not dispute. *See* BB48-49; DRB40-41 (disputing enablement as factual but not legal matter). And Cross-Appellants did not overcome that presumption at trial. Indeed, Cross-Appellants' concern over enablement because the claims would require "undue experimentation" if they covered neuropathic pain is unsupported by any citation and is illogical. *See* DRB41. There is nothing difficult in administering tapentadol to mice or men suffering neuropathic pain, and Cross-Appellants' expert, Dr. Brown, freely admitted that she and other physicians were already administering opioids to treat neuropathic pain in 1994. *See* Appx11163.

Third, Cross-Appellants suggest that West-Ward waived any argument "relating to the scope of the genus of 'pain' or 'severe' pain." DRB39. That is false. West-Ward argued below that "pain" was an "umbrella term" that refers to

"both nociceptive and neuropathic pain," a "POSA in 1994 would understand the term 'pain' to refer to a genus of few species," and when reading the term, "a POSA would immediately envisage the two mechanisms of pain—neuropathic and nociceptive—and the two locations of pain within each mechanism, thus totaling four species of 'pain': mononeuropathic, polyneuropathic, somatic, and visceral." Appx18548-18549; Appx10628, Appx10630; Appx11918.

Fourth, Cross-Appellants argue that, even if there is no waiver, knowing the limited size of the genus of "pain" would not enable a POSITA to envisage polyneuropathic pain when reading the '737 patent because that type of pain is "wholly separate and distinct" from nociceptive pain. DRB39-40. But Cross-Appellants misread *Petering* as holding that "disparities and variations in the species of the genus" is only what matters for the inherency question. DRB39. This Court's predecessor said no such thing in that case; the word "disparities" does not even appear in the opinion. The Court stated that "it is not the mere number of compounds in this limited class [of 20 species] which is significant here but, rather, … the limited number of variations" that would have allowed a skilled chemist to readily "draw[] each structural formula." *In re Petering*, 301 F.2d 676, 681-82 (C.C.P.A. 1962). The reason—as the Court rationally explained—was that, when faced with a chemical-formula genus that contains several undisclosed potential "permutations" of species defined by shifting side chains with hydroxyl

groups, the mental effort required to recreate and envisage each structural permutation to envisage each species logically depends, in large part, on the scope of the "variations" in the chemical structure instigated by changes to the hydroxyl groups that define the genus. *Id.*

There is nothing so complex here, though, that defines the relevant genus. The species of "pain" are not undisclosed and do not require mental agility to decipher based on undefined permutations to a complex chemical formula—they are predefined well-known biological terms that are limited in number. *See* BB9-10, 43. Thus, Cross-Appellants' focus on the differences between the types of "pain" based on "predictive" treatment outcomes misses the point. DRB39-40. Given the well-known limited number of types of "pain," a POSITA encountering the term would immediately envisage all types of pain, including polyneuropathic pain. *See Osram Sylvania, Inc. v. American Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012) ("relative size of a genus" is of "critical importance"); BB42-44. Indeed, during prosecution of the '130 patent, the Examiner found that "pain" in the '737 patent was inclusive of polyneuropathic pain. Appx56802. Cross-Appellants do not contest that fact.

III. THE ASSERTED CLAIMS OF THE '130 PATENT ARE INVALID FOR OBVIOUSNESS-TYPE DOUBLE PATENTING OVER THE '593 PATENT

If West-Ward's noninfringement judgment for claims 1 and 2 of the '130 patent were reversed, the claims should be invalidated for obviousness-type double patenting ("ODP") over the '593 patent and judgment entered in West-Ward's favor on that alternative basis. As West-Ward detailed in its principal brief (BB53-59), regardless of the meaning of "pain" in the '593 patent, claims 1 and 2 of the '130 are not patently distinct from claim 117 of the '593 patent—either the term is inclusive of "polyneuropathic pain," so there is no substantive difference between the claims, or the term is limited to "nociceptive pain," so treating polyneuropathic pain would be obvious in light of claim 117.[6] Cross-Appellants' arguments in response are unavailing and largely recycle the district court's errors of law and logic.

A. Cross-Appellants Concede That The Asserted '130 Claims Are Not Patentably Distinct If "Pain" Includes "Polyneuropathic Pain" In The '593 Patent

Cross-Appellants do not contest invalidity for ODP if "pain" in the '593 patent encompasses polyneuropathic pain. *See* DRB42-44. That concession ends the ODP inquiry if that construction is adopted. *See* BB54-57. They insist though

[6] Cross-Appellants do not dispute that claim 117 of the '593 patent properly qualifies as the earlier claim in the ODP analysis here.

(as for anticipation by the '737 patent) the term "pain" in claim 117 of the '593 patent should not be read to encompass polyneuropathic pain. *See* DRB42-44.[7] As discussed, there is no merit to that argument—particularly if the noninfringement judgment for the '130 patent is reversed because "pain" is read to encompass polyneuropathic pain in the accused label. *See supra* II.B.

And there can be little doubt that "pain" would be read broadly to encompass polyneuropathic pain for ODP purposes. Cross-Appellants do not contest that the priority date for the '130 patent (March 2007) is the relevant reference point for the ODP analysis here. *See Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1355 (Fed. Cir. 2009); Appx91 (same). Contrary to Cross-Appellants' suggestion (DRB43), at that time, numerous objective published literature and peer-reviewed studies confirm it was "well-known" that opioids (including tapentadol's parent compound, tramadol) were effective and recommended for treating neuropathic pain. *See* BB11-14, 54-55; Appx10635-10636; Appx11794; *infra* III.B.4. Those objective references are not irrelevant "extrinsic references" (DRB43) for claim construction—they confirm that a POSITA in March 2007 would easily "envisage each member of th[e] limited class" of types of "pain" referenced in the '593 patent, thus rendering the claims of

[7] Cross-Appellants demand "clear and convincing evidence" (DRB44) for the construction of "pain," but no such burden of proof exists, even if a term is determinative of validity. *See, e.g.*, *Phillips*, 415 F.3d at 1312-17.

the '130 patent not patentably distinct. *See Petering*, 301 F.2d at 681-82; BB54-57. Indeed, the '130 patent expressly teaches that "substances effective in treating nociceptive pain" were known to be, at least, "slightly effective, in treating neuropathic pain." Appx430 (2:44-48). Dr. Christoph, an inventor on the '130 patent, even publicly declared prior to the filing of the '130 patent that opioids were known to "play an *important role* in the treatment of chronic pain," which includes neuropathic pain—a concession Cross-Appellants do not contest or acknowledge. Appx56647; *see* Appx56648-56650. And physicians, including Cross-Appellants' own expert, Dr. Brown, were prescribing opioids to treat neuropathic pain in routine practice over a decade prior to the filing of the '130 patent. *See, e.g.*, Appx10642-10643, Appx10646-10648; Appx11163 (Dr. Brown admitting that "[she] and other physicians prescribe[d] opioids for neuropathic pain" in 1994).

B. Cross-Appellants Fail To Show That The Asserted '130 Claims Are Not Patentably Distinct If "Pain" Is Limited To "Nociceptive Pain" In The '593 Patent

1. The Undisputed Facts Prove That The '130 Claims Are Not Patentably Distinct

Cross-Appellants do not dispute that, at the effective filing date for the '130 patent, it was well-known: (i) tapentadol was a tramadol-derived opioid compound useful for treating "severe pain," and (ii) tramadol and other opioids were actually used for treating polyneuropathic pain. *See* BB58; DRB41-61; *see also*

Appx10642-10643, Appx10646-10648; Appx11163. Those two conceded facts logically prove that it would have been obvious to a POSITA that tapentadol would treat polyneuropathic pain. *See* Appx10635-10648. Indeed, a POSITA would also know that the PTO agreed that the '130 patent was obvious in view of the '737 patent because it (just like the '593 patent) already disclosed tapentadol for the "treatment of severe pain." *See* Appx56787-56793; Appx56800-56804. Cross-Appellants do not dispute that fact either.

2. There Was No Waiver Of The Obvious-Variant Argument

Cross-Appellants assert that West-Ward "never rais[ed] an 'obvious variant' argument or even us[ed] the phrase." DRB45. That is false. West-Ward expressly argued below that the "asserted claims of the '130 are invalid for obviousness-type double patenting" because, *inter alia*, "Claims 1, 2, 3, and 6 of the '130 patent … at least cover an *obvious variant* of claim 117 of the '593 patent." Appx18204-18206; Appx18271-18273; *see* Appx18429; Appx18582. As West-Ward explained, "even if 'severe pain' in the '593 patent meant only nociceptive pain, then … [i]t was entirely obvious to treat neuropathic pain" in light of "the '593 patent disclosures" and "the abundance of literature showing that tramadol and opioids generally had been used to treat neuropathic pain and DPN in particular." Appx18206; Appx18273.

3. Unclaimed Features Cannot Save The Claims

Cross-Appellants theorize that the '130 claims could not be obvious because opioids would not be an expected "effective treatment" for neuropathic pain when the '130 patent was filed, since any "effective treatment" would "involve many considerations other than simply lowering pain score, such as a patient's quality of life," "side effects," and addictive properties, and opioids were associated with all of those negative outcomes. DRB47; *see* DRB48. That was also the district court's primary objection to obviousness—the "standard was not to prescribe opioids for neuropathic pain," given their supposed "side effects." Appx186-187.

But neither the district court nor Cross-Appellants can simply rewrite the claims to save them. The '130 claims do not include a requirement for "effective treatment": their "method of treating" requires only "administering to said subject an *effective polyneuropathic pain inhibiting amount* of [tapentadol]." Appx438 (cl.1). The plain ambit of the claims is focused on an effective dosage amount for inhibiting pain—nothing else. Indeed, "effective treatment" does not even appear in the claims. And there is no dispute that the prior art claim recites administering "an effective analgesic amount" of tapentadol. Appx387; Appx452; *see* Appx459.

Nor is there anything separately in the specification of the '130 patent that implicitly requires "effective treatment" to be part of the claimed methods. According to Cross-Appellants, "the specification explains that 'treat[ment]' of

neuropathic pain is 'effective[]' *only where there are no 'excessive side effects*.'" DRB48 (alterations in DRB) (quoting Appx430 (2:40-42)). But unedited by Cross-Appellants' convenient omissions, that portion of the written description states that one of the various objectives of the patentees "was to provide a new method of effectively treating neuropathic pain without excessive side effects." Appx430 (2:40-42). Nothing in that statement implies that the *claimed* treatment methods must be effective because they are free of "excessive side effects." *See* BB60.

4. There Was No Relevant Controversy Over The Use Of Opioids To Treat Neuropathic Pain

Cross-Appellants parrot the district court's belief that it would not have been obvious to treat neuropathic pain with opioids because there was "controversy" over such treatment—but they add nothing of merit to defend the district court's view. *See* DRB48-52; Appx185-189.

Cross-Appellants reiterate how the district court relied on the statement by their expert, Dr. Brown, that the "standard was not to prescribe opioids for neuropathic pain." DRB49 (quoting Appx11163); Appx186 (same). But reliance on that statement was legal error. Dr. Brown testified that "*in 1994*," the "standard was not to prescribe opioids for neuropathic pain." Appx11163. It is undisputed that the relevant time frame for the ODP analysis here is the March 2007 priority date for the '130 patent. *See supra* III.A. Reliance on that statement was clear

factual error too. Dr. Brown immediately admitted that "[she] and other physicians prescribe[d] opioids for neuropathic pain at that time"—a fact that the district court never considered. Appx11163. Dr. Brown never suggested that such treatment occurred only in "rare instances." DRB49. And it is irrelevant that such opioid administration may have been a second-line treatment chosen "'out of desperation'"—such second-line treatment occurred and was seemingly ubiquitous at the time. *Id.* (quoting Appx11163); *see* Appx18403; Appx18556; Appx10642 (Dr. Buvanendran acknowledging same use of opioids); BB12-14, 54-55.

Cross-Appellants also tout how the district court believed that "prior art references confirmed the existence of the widespread controversy" over the use of opioids to treat neuropathic pain. DRB49-50 (citing Appx185-188). Yet Cross-Appellants do not contest the legal error of the district court's reliance on three such references published *after* the filing date of the '130 patent to establish that controversy—a legal error that alone independently requires, at minimum, vacatur and remand. *See* BB63. And Cross-Appellants do not even respond to the teachings from Hollingshead, Harati, and Freeman. *See* DRB48-52; BB12-14, 54-55. Instead, they focus on Namaka, Dworkin, Gilron, and Baron; but their interpretations of those references are meritless.

Addressing Namaka, Cross-Appellants simply repeat the district court's mantra that the reference discussed the "debate[]" over the use of opioids to treat

"chronic neuropathic pain." DRB50; Appx188. But like the district court, they wholly ignore how the reference expressly concludes that there was an "evidence-based rationale for the use of narcotics in neuropathic pain," including studies that proved opioids were effective to treat "post-nerve injury," "peripheral neuropathic pain," and "severe diabetic neuropathy." Appx58372. Cross-Appellants' expert, Dr. Brown, even conceded that Namaka taught that there was such an "evidence-based rationale" for using narcotics to treat neuropathic pain—a concession Cross-Appellants conveniently ignore and the district court erroneously failed to address. Appx11168.

Cross-Appellants' treatment of Dworkin is equally baseless. They suggest that the reference teaches how, even with "well-established [neuropathic pain] medications, *effectiveness is unpredictable*, dosing can be *complicated*, analgesic onset is *delayed*, and *side effects are common*." DRB50 (alteration and emphasis in DRB) (quoting Appx58438). But by that logic, none of those factors (including the "side effects" Cross-Appellants repeatedly claim to make opioid treatment not "effective") should have dissuaded the use of opioids to treat neuropathic pain, since they apparently plagued "well-established [neuropathic pain] medications" too. *Id.* Regardless, as West-Ward explained (BB62), Dworkin expressly teaches that "[o]pioid analgesics and tramadol *are recommended* as generally second-line treatments that can be considered for first-line use in select clinical circumstances."

Appx58437. Cross-Appellants have no response to that undisputed fact or how the district court improperly failed to consider it.

As for Gilron, Cross-Appellants concede that it "demonstrates that opioids were 'found to be effective for *reducing* neuropathic pain.'" DRB51 (citing BB62). That is a full-stop concession—it proves that a POSITA understood that opioids were effective for reducing neuropathic pain, the district court's contrary conclusion was admittedly wrong, and reversal is due. *See* BB58-59. The only response Cross-Appellants can muster is reversion to the same argument that the '130 claims require "*effectively treating* polyneuropathic pain." DRB51. But, again, that unclaimed feature is legally irrelevant here. *See supra* III.B.3; BB59-61.

And Cross-Appellants' response to Baron is simply misrepresentation. As West-Ward explained (BB13, 55), Baron established a well-founded basis to recommend the use of tramadol (and other opioids) for the treatment of neuropathic pain (which should make obviousness an almost forgone conclusion here). Cross-Appellants ignore that and attempt to bury Baron in one misleading sentence:

> Defendants' Baron reference likewise acknowledged that [*sic*] the "widespread opinion" that neuropathic pain is not "opioid sensitive."

DRB50 (quoting Appx58414). Read in full, though, Baron states:

> *Non opioid* analgesics (NSAIDS, …) are of little efficacy in neuropathic pain. *These substances* are *not* contained in treatment algorithms for neuropathic pain due to lack of evidence and possible serious side effects in long term use …. *However, in contrast to widespread opinion, neuropathic pain has been shown to be opioid sensitive*. *Tramadol has been shown to be effective in painful* [DPN]. *Ocycodon for example demonstrated a positive treatment effect in* patients suffering from post-herpetic neuralgia and [DPN]. Strong opiates should be reserved for *severe* or refractory *pain*. … [P]atients with *chronic*, non-malignant *pain can be treated safely and effectively over long periods with strong opiates*, without developing tolerance or tachyphyllaxis.

Appx58414. The teaching of Baron is thus clear, not "*equivocal*" (DRB51)—it plainly informs a POSITA that opioids, including tapentadol's parent compound, tramadol, can be used safely and effectively to treat neuropathic pain, polyneuropathic pain, and DPN. The district court's choice to ignore Baron (and the teachings of the other prior art references) was clear error.

5. There Was No Legally Probative Evidence Of Secondary Considerations Of Nonobviousness

There was no legal relevance to the evidence of secondary considerations on which the district court relied here. *See* BB64-68. According to Cross-Appellants, though, West-Ward "wholly misunderstands the nexus requirement" for secondary considerations. DRB60. They claim that (i) a "presumption of nexus" applies to that evidence, which West-Ward failed to rebut; (ii) anything related to the "compound" tapentadol can presumptively qualify as evidence of secondary

considerations; and (iii) there is no requirement that unexpected results be "'tied to the difference between' the methods of the later-expiring and earlier-expiring patents." DRB53, 57, 60-61 (citation omitted). None of those three points has merit.

First, there was no applicable "presumption of nexus" for West-Ward to rebut. DRB53. When a patentee's commercialized product is the invention disclosed and claimed, a rebuttable "presumption" of a nexus can apply to evidence of commercial success, praise, and copying—not long-felt need or unexpected results. *See Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1311 (Fed. Cir. 2010) (presumption available for evidence of commercial success, praise, and copying); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000) (presumption available for commercial success); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (same); *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988) (same); *cf. WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1330 & n.4 (Fed. Cir. 2016) (applying presumption in passing to evidence of long-felt need, but not explaining why).

And even if such a presumption were potentially applicable, it would only apply if the commercialized product were "*coextensive*" with the patented invention—a requirement that Cross-Appellants wholly ignore. *Brown &*

Williamson, 229 F.3d at 1130. That is indisputably *not* the case here—Tapentadol ER and NUCYNTA ER admittedly have (substantial) uses beyond treating polyneuropathic pain. *See infra* Argument In Response To Cross-Appeal III.B.1-2, IV.A-B. Thus, there was no applicable presumption of nexus here for West-Ward to rebut, and the burden remained on Cross-Appellants to prove a "legally sufficient relationship between that which is patented and that which is sold"—proof that Cross-Appellants failed to present. *Demaco*, 851 F.2d at 1392; *see* BB64-68.

Second, Cross-Appellants cannot create a nexus for their (supposed) evidence of secondary considerations by rewriting the claims to cover tapentadol generally. *See* DRB60-61 (The "evidence that tapentadol is effective in treating polyneuropathic pain with lower side effects is unquestionably *'tied to' the compound* (tapentadol), and *tapentadol* (and the use thereof to treat polyneuropathic pain) indisputably 'is the invention disclosed and claimed in the ['130] patent.'"). This Court's case law is clear that any nexus must be linked to "the invention disclosed and *claimed* in the patent." *WBIP*, 829 F.3d at 1329 (citation omitted). Here, the compound tapentadol was *not* claimed in the '130 patent—only the *use of* tapentadol to treat polyneuropathic pain was. *See* Appx438 (cls. 1, 2). Cross-Appellants' evidence of secondary considerations of nonobviousness must be tied to that patented *method*—not the tapentadol

compound in general. *See Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir. 1984); BB67.

Accordingly, as West-Ward explained (BB67-68), none of the evidence of long-felt need relied upon by the district court is legally relevant here. Neither "'extended release' of tapentadol hydrochloride [n]or 'lower side effects'" is part of the claimed method. DRB61; *see* Appx194 (relying on same). And that conclusion does not change based on any of the additional evidence highlighted by Cross-Appellants on appeal. As an initial matter, most of the evidence is legally irrelevant because it was published after 2007. *See, e.g.*, DRB59-60 (citing Appx60542 (published in 2009), Appx58599, Appx58602 (from 2011), Appx60530 (from 2011)); BB63; *Amgen*, 580 F.3d at 1355-58; *Takeda Pharm. Co. v. Doll*, 561 F.3d 1372, 1378 (Fed. Cir. 2009). Regardless, all of the evidence relates to opioid *side effects*, *tolerability* of opioids generally, adherence to therapy protocols for the tapentadol *compound*, *side effects* of the tapentadol *compound* generally, and lower *side effects* of the tapentadol *compound* generally. *See* DRB59-60. None of those is a feature of the claimed invention here—treatment with an "effective polyneuropathic *pain inhibiting amount* of [tapentadol]." Appx438 (cl. 1); *see* BB59-61.

Third, Cross-Appellants complain that there is no requirement for unexpected results be "tied to the difference between" the methods of the "later-

expiring and earlier-expiring patents" in the ODP analysis. DRB57 (citing BB65-66). But there has never been any meaningful dispute in this Court's case law otherwise. Any evidence of secondary considerations must be linked "to the merits of the claimed invention *beyond what was readily available in the prior art*." *J.T. Eaton*, 106 F.3d at 1571; *see also WBIP*, 829 F.3d at 1331 ("It is certainly true that there must be 'a nexus between the evidence and the merits of the claimed invention.'" (quoting *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995)). And this Court has expressly held that "evidence of unexpected results must establish that there is a difference between the results obtained and those of the closest prior art, and that the difference would not have been expected by [a POSITA]." *Bristol-Myers Squibb Co. v. Teva Pharm. USA, Inc.*, 752 F.3d 967, 977 (Fed. Cir. 2014). Thus, in context of the ODP analysis here, where the "prior art" inquiry focuses on the earlier-expiring treatment method in claim 117 of the '593 patent, any evidence of secondary considerations must be tied to the unexpected results (or long-felt need, for that matter) of using tapentadol hydrochloride to treat polyneuropathic pain (the '130 claims) instead of using tapentadol to treat nociceptive pain (assuming claim 117 of the '593 patent is read that way). *See* BB65-66. Accordingly, none of the evidence relied upon by the district court to find unexpected results is legally relevant here. *See id.*; Appx191-193.

Nor is there any relevance to or insight gained from the "data" in the '130 patent that Cross-Appellants argue "unexpectedly showed that tapentadol selectively inhibits neuropathic pain over nociceptive pain." DRB55-56. As an initial matter, Cross-Appellants have waived reliance on any such data by not presenting it below. *See Fresenius*, 582 F.3d at 1296 (arguments not raised below are waived). In any event, even if preserved, Cross-Appellants' argument concerning that new "data" is incomprehensible. There is nothing in "Table 1" of the '130 patent that refers to types of pain—the table is a list of types of compounds. DRB56 (citing Table 1 as referring to "neuropathic pain" and "nociceptive pain"); Appx434 (Table 1) (listing compounds). Table 2 of the '130 patent does not contain any reference to "diabetes." DRB56; *see* Appx435. The "Tab I" in the '737 patent to which Cross-Appellants cite does not appear to exist. DRB56 (citing Appx56848 at "Tab I"). The testimony cited by Cross-Appellants (DRB56 (citing Appx11731)) refers to neuropathic and nociceptive pain pathways, but not *poly*neuropathic pain. *See* Appx11731. And the remaining citations provided by Cross-Appellants are to entire internal Grunenthal studies on pain, with no guidance at all regarding their relevance. *See* DRB56 (citing, in whole, Appx56619-56633, Appx56577-56591).

6. There Is No Dispute That The District Court Erred In Refusing To Consider The PTO's Rejection Of The Asserted '130 Claims

As West-Ward explained, the district court erred in suggesting that the PTO's repeat rejections of the '130 claims as *prima facie* obvious over the '737 patent were of no probative value. BB63-64; *see* Appx190. Cross-Appellants have no response—because there is no meritorious one. Indeed, Cross-Appellants do not dispute that the Examiner found there was a *prima facie* case of obviousness for the '130 claims and that the reason for allowance of the claims during prosecution was solely secondary considerations of nonobviousness—evidence that is lacking here. *See* BB63-64. Instead, Cross-Appellants only argue that secondary considerations of nonobviousness can overcome a strong *prima facie* case of obviousness. *See* DRB54. But the inability of secondary considerations to do so cannot be seriously disputed, particularly in an ODP analysis that focuses on claim comparisons and certainly where, as here, there is no legally relevant evidence of such considerations in the record. *See* BB64 (collecting case law); BB64-68 (discussing inapplicability of Cross-Appellants' secondary considerations evidence).

ARGUMENT IN RESPONSE TO CROSS-APPEAL

The district court correctly found that West-Ward's extended-release ANDA product (Tapentadol ER) will not induce or contribute to the infringement of

claims 1 or 2 of the '130 patent. Cross-Appellants cannot show any clear error in that judgment. There is no proof of any specific intent by West-Ward to cause physicians to treat polyneuropathic pain—indeed, the affirmative act of carving out Indication 2 and all references to neuropathic pain and data logically prevents any such finding. And the substantial noninfringing uses for Tapentadol ER preclude a finding of contributory infringement. The noninfringement judgment in favor of West-Ward therefore should be affirmed.

Even if there were a basis for reversing the non-infringement finding, the patent would then be clearly invalid. Cross-Appellants argue that the '130 patent should remain valid because "pain" means only nociceptive not polyneuropathic pain, yet, in a complete about-face, they proclaim that West-Ward must induce and contribute to physicians infringing that same patent because "pain" does, in fact, encompass polyneuropathic pain. The meaning of "pain" cannot be read one way as Cross-Appellants wish for validity and then a complete opposite way to sustain infringement. Claims 1 and 2 of the '130 patent cannot be both valid and infringed by West-Ward.

I. STANDARD OF REVIEW

Infringement is a question of fact, and the district court's findings supporting a judgment of noninfringement after a bench trial are reviewed for clear error. *Allergan, Inc. v. Sandoz Inc.*, 796 F.3d 1293, 1303 (Fed. Cir. 2015). Mere

disagreement with the district court's reasoning does not allow reversal; clear error requires a "definite and firm conviction that a mistake has been made." *Inwood Labs., Inc. v. Ives Labs., Inc*., 456 U.S. 844, 855 (1982). Thus, "[i]f the district court's account of the evidence is plausible in light of the record viewed in its entirety" or "[w]here there are two permissible views of the evidence," there is no clear error even if the Court "would have weighed the evidence differently." *Anderson v. City of Bessemer City*, 470 U.S. 564, 573-74 (1985).

II. STATEMENT OF JOINDER

Cross-Appellants do not distinguish between Actavis's and West-Ward's proposed ANDA labels for infringement purposes. *See* DRB61-77; *see also* Appx155 n.30 (district court's "factual findings and legal conclusions" for Actavis "also apply to [West-Ward]"). West-Ward therefore expressly joins, adopts, and incorporates Actavis's response brief. *See* Fed. R. App. P. 28(i).

III. THE JUDGMENT OF NO INDUCED INFRINGEMENT OF THE '130 PATENT SHOULD BE AFFIRMED

A. The District Court Correctly Found That West-Ward's ANDA Product Will Not Induce Infringement

To establish induced infringement, Cross-Appellants bore the burden to prove that West-Ward "possessed specific intent to encourage another's infringement." *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) (en banc in relevant part); *see* DRB62 (acknowledging that burden); Appx154.

They argued below that the accused ANDA label was sufficient circumstantial evidence of such intent because: (i) despite the carve-out, the proposed label encourages the treatment of DPN (a type of polyneuropathic pain) because DPN "falls within Tapentadol ER's first indication" and providers would research to discover the carved-out DPN studies; (ii) the only study remaining in the label after the carve out—the CLBP study—involved patients suffering from polyneuropathic pain, so it would cause providers to use tapentadol to treat polyneuropathic pain; and (iii) Indication 1 concerns severe chronic pain, which is broad enough to encompass polyneuropathic pain, including DPN. Appx17841; Appx18001; *see* Appx157; Appx17872-17873; Appx17706-17709; *see also* Appx158-159 (discussing Cross-Appellants' briefing below in which they argued that "[t]he treatment of DPN falls within Tapentadol ER's first indication" (citation omitted)).[8]

The district court soundly rejected each of those factual theories. First, it logically found there was nothing in the label that evidenced a specific intent to encourage the use of Tapentadol ER for the treatment of DPN because the DPN indication and study were both carved out of the proposed label; treatment of

[8] Cross-Appellants argued below that two additional statements in West-Ward's accused label would lead physicians to use the drug to treat polyneuropathic pain. Appx17708-17709. Those additional statements are not at issue in this appeal. *See* DRB61-77; BB23 n.7.

DPN—and all neuropathic pain—was "off-label" and not covered by the remaining Indication 1; and the "fact that [West-Ward] has specifically carved out Indication 2 (and 'actively and voluntarily removed any reference to' DPN) is evidence that [West-Ward] does not specifically intend to encourage the use of the product for the treatment of DPN." Appx158-160.

Second, the district court correctly found that inclusion of the CLPB study in the accused label did not evidence any specific intent by West-Ward to induce treatment of polyneuropathic pain because "CLBP is generally considered to be nociceptive in nature"; the study was one "of nociceptive pain" and did "not investigate efficacy of [T]apentadol ER for neuropathic pain"; "a physician likely would not make any assessment of whether [West-Ward]'s product was useful for neuropathic pain based on the CLBP study in [West-Ward]'s label"; it was doubtful that "a physician would consider prescribing a product for polyneuropathic pain based solely on the CLBP study in [West-Ward]'s label"; and the "act of removing the DPN indication and any reference to DPN from its label is evidence that [West-Ward] does not intend for its product to be used to treat polyneuropathic pain." Appx160-163; *see also* Appx18370-18377; Appx18193.

Third, the district court correctly found that Indication 1 did not evidence any specific intent to induce infringement. That physicians might understand "severe chronic pain" to encompass polyneuropathic pain (a logical impossibility if

the validity of the '130 patent is affirmed) and therefore use Tapentadol ER to treat such pain is irrelevant—mere "knowledge of infringing uses" does not establish specific intent. Appx157. And, as the district court concluded, "treatment of polyneuropathic pain" is not "an on-label use of [West-Ward]'s product in this case" because "[West-Ward]'s label contains only Indication 1 supported only by the CLBP study"—which, as discussed, was found to not address neuropathic or polyneuropathic pain or support the use of tapentadol to treat such pain. Appx164. Thus, the district court properly concluded that there were no "instructions" in the accused label (the only evidence of specific intent advanced by Cross-Appellants) from which it could "infer" a specific "affirmative intent to infringe the patent." Appx164.

B. Cross-Appellants Fail To Show Clear Error In The District Court's Finding Of No Inducement

1. Reversal Is Precluded By The Uncontested Findings Of The District Court

On appeal, Cross-Appellants do not appeal the district court's factual findings that (i) the proposed ANDA label did not encourage the treatment of DPN and (ii) the CLBP study did not address neuropathic pain or somehow encourage or enable providers to use Tapentadol ER to treat polyneuropathic pain. DRB61-72.[9]

[9] The CLBP study is only mentioned in the *background fact* section of Depomed's brief, but Cross-Appellants make no substantive arguments in response

As a result, those findings by the district court, and their underlying rationale, cannot be disputed and must be accepted as true for purposes of appeal. *See, e.g.*, *SmithKline Beecham*, 439 F.3d at 1319 ("[A]rguments not raised in the opening brief are waived.").

That strategic choice by Cross-Appellants ends any practical dispute about induced infringement here. The district court's non-infringement determination is undeniably plausible in light of those factual determinations, which alone merits affirmance. Cross-Appellants are left only with their argument that the term "severe chronic pain" in Indication 1 is generally known to physicians to be broad enough to encompass polyneuropathic pain (indeed, that is the only argument they press). *See* DRB62-72. But without encouraging the treatment of DPN or including a study exhibiting the efficacy of tapentadol for treating neuropathic or polyneuropathic pain, there is nothing *in the accused label* that teaches a physician that the ANDA product could be useful and appropriate for the treatment of polyneuropathic pain. That physicians' independent knowledge of pain treatments from *outside* the label might encourage them to nevertheless infringe establishes only potential knowledge of possible infringing use, which, as the district court

---

to the district court's findings. *See* DRB18-19, 20, 22, 61-72; *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("[M]ere statements of disagreement with the district court" regarding "factual disputes" do not equate to a "developed argument" that is preserved for appeal.).

correctly concluded, cannot sustain a finding of inducement. *See* Appx157; *see also Takeda Pharm. U.S.A., Inc. v. West-Ward Pharm. Corp.*, 785 F.3d 625, 630-32, 634 (Fed. Cir. 2015) (mere knowledge of potential infringement is insufficient; relying on knowledge outside the label for "implicit encouragement" not permissible; and "speculation about how physicians may act based on vague label language" cannot sustain a finding of specific intent). The finding of no inducement should be affirmed independently on this ground alone.

2. Cross-Appellants' Only Theory Of Inducement Is Meritless

Despite abandoning the majority of their arguments on inducement, Cross-Appellants insist that the district court committed clear error because Indication 1 by itself is sufficient proof that West-Ward's label will induce infringement. According to them, induced infringement "[i]n the Hatch-Waxman context" is established when an ANDA label "*will cause at least some users*" to practice the claims. DRB63-64 (quoting *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1060 (Fed. Cir. 2010)). Here, they contend, since an "indication" in a drug label identifies an "intended use" and polyneuropathic pain is a form of "severe chronic pain," Indication 1 includes polyneuropathic pain and "will cause at least some users" of Tapentadol ER to infringe. DRB65-66. That theory fails on three fronts.

First, Cross-Appellants misunderstand this Court's case law. Induced infringement requires specific intent to cause another to infringe. *DSU*, 471 F.3d

at 1306 (en banc in relevant part). In the ANDA context, a patentee can rely on the proposed label as circumstantial evidence from which to infer that state of mind. *See, e.g.*, *Sanofi v. Watson Labs. Inc.*, 875 F.3d 636, 644-45 (Fed. Cir. 2017). But a patentee cannot rely solely on the fact that a label might ultimately cause "some users" to infringe because they read it and then infringe. *See, e.g.*, *Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1365 (Fed. Cir. 2003) ("[I]ntent to induce infringement cannot be inferred even when the defendant has actual knowledge that some users of its product may be infringing the patent."); *Takeda*, 785 F.3d at 630-31 (same). Nor can a patentee rely on the fact that a label simply "'describ[es] the infringing mode'" or speculate "about how physicians may act" based on "vague label language." *Takeda*, 785 F.3d at 631-32. Rather, an ANDA label can constitute circumstantial evidence of an accused infringer's specific intent to cause infringement only when it contains "unambiguous" instructions that "encourage, recommend, or promote" infringement. *Eli Lilly & Co. v. Teva Parenteral Medicines, Inc.*, 845 F.3d 1357, 1369 (Fed. Cir. 2017); *see Takeda*, 785 F.3d at 631-32.

Contrary to Cross-Appellants' contention, this Court in *AstraZeneca* did not fashion a different test that a finding of specific intent requires only "label instructions [that] '*will cause at least some users*' to infringe." DRB63 (emphasis in DRB) (quoting *AstraZeneca*, 633 F.3d at 1060). In that case, the district court

found that clear instructions in the accused label to titrate down to an effective dose would "inevitably" and "necessarily" lead some users ("many users," according to the district court) to infringe the patent because such titration would lead to the patented "once-daily dosing." 633 F.3d at 1049, 1055, 1060. But that was *not* the only evidence of specific intent. The FDA had "explicitly" informed Apotex that, despite a proposed carve-out of once-daily dosing language, the "downward titration" required by its label "may involve once-daily dosing." *Id.* at 1058. Apotex was "aware of and certainly concerned about the potential infringement problem posed by its label" after the FDA's notice, but pushed forward without pursuing any of several available options to revise its label to otherwise avoid once-daily dosing. *Id.* at 1059. In light of *all* those facts, the district court found that Apotex had specific intent to induce infringement. *Id.* That "some users" would "inevitably" infringe by following the instructions in the label was likely necessary, but certainly not sufficient, for that finding. *Id.* at 1057; *see id.* at 1059-60; *see also Sanofi*, 875 F.3d at 644-45 (affirming finding of specific intent because, in part, alleged infringers "kn[e]w that their proposed labels would actually cause physicians to [infringe]" approximately 77% of the time *and* they took no steps to mitigate that risk).

Second, even if a "some-infringement-equals-intent" rule from *AstraZeneca* did exist, it would not control here. There is no instruction in West-Ward's label to

treat patients with "severe chronic pain" who are suffering from polyneuropathic pain, so nothing in the label will "inevitably" or "necessarily" cause physicians to infringe the '130 patent. *See AstraZeneca*, 633 F.3d at 1049, 1055, 1060. As the district court reasoned, nothing in "[West-Ward's] label" will "'*cause*'" a physician to use Tapentadol ER to treat patients with polyneuropathic pain—there are no studies or other supporting data in the accused label to teach or encourage a physician to treat patients with polyneuropathic pain. Appx165-166 (emphasis in original). Not only is that finding about the disclosure in the label plausible, Cross-Appellants did not, and cannot now, challenge it. *See supra* III.B.1. And, as the district court explained, "following the label instruction[s]" will not "'necessarily lead'" to infringement because doctors "can and likely will follow the instructions" to treat pain other than polyneuropathic pain, so "to the extent doctors prescribe [West-Ward]'s product for infringing polyneuropathic pain treatments, it will not be because they have been encouraged by [West-Ward]'s label to do so." Appx166. Because the district court's non-infringement determination is more than "plausible" given that unchallenged evidence, there can be no clear error. *Anderson*, 470 U.S. at 574.

Indeed, Cross-Appellants are left to argue that some physicians will rely on their knowledge of "severe chronic pain" *from outside the label* to understand that tapentadol could be used to treat polyneuropathic pain and then choose to prescribe

Tapentadol ER for that purpose. *See* DRB65-66. But this Court has limited the potential inference of specific intent from any inevitable infringement (i.e., per *AstraZeneca*) to when readers of the accused label do "*not have to consult anything outside of the label to infringe*." *Takeda*, 785 F.3d at 634. That impermissible inference, however, is precisely what Cross-Appellants demand here to derive "implicit encouragement" from the extra-label meaning of "severe chronic pain." *Id.*

Third, Cross-Appellants' theory of induced infringement assumes it was "undisputed" that the "severe chronic pain indication … includes polyneuropathic pain." DRB65. That is false. Tellingly, to substantiate the supposed "undisputed" nature of that foundational fact for their infringement theory, Cross-Appellants only cite a single snippet of contentious testimony from one of West-Ward's experts who immediately clarified his testimony to be that the "label states … that it's useful for the treatment of moderate and moderate to severe chronic pain in adults who require around the clock treatment[,] [b]ut it does not specifically instruct the physician to prescribe it for polyneuropathic pain." Appx10676; *see* DRB65 (citing Appx10675). That there is nothing else for Cross-Appellants to cite in support is not surprising though. West-Ward vigorously argued below that Indication 1 does *not* encompass treatment of polyneuropathic pain and, thus, any such use would be "off-label." *See, e.g.*, Appx18190. And as discussed (*supra*

III.A), the district court expressly found that "treatment of polyneuropathic pain" is *not* "an on-label use" under Indication 1 in light of its finding (which Cross-Appellants do not challenge on appeal) that there is no study or data left in the carved-out label to support the use of tapentadol for the treatment of neuropathic or polyneuropathic pain. Appx164.

Cross-Appellants' supposedly "undisputed" theory is also entirely devoid of logic. DPN is one of the "all forms" of "severe chronic pain" that Cross-Appellants believe to be encompassed by Indication 1. DRB65. That means, however, that *Indication 2* for the treatment of DPN would have been entirely unnecessary because, if Cross-Appellants were correct, treatment of DPN would have been covered already as an on-label use by Indication 1. That is farcical—Indication 2 exists precisely because treating polyneuropathic pain is off-label and not covered under Indication 1; Janssen (the predecessor-in-interest to Depomed for the NUCYNTA NDA, *see* BB9) recognized that it could not recommend, encourage, or promote NUCYNTA for the treatment of any kind of neuropathic pain during the period when only Indication 1 existed; Janssen therefore paid "approximately *$50 million dollars* to conduct the study necessary to get approval for Indication 2"; and Indication 2 increased the expected revenue from NUCYNTA ER by an extraordinary amount. Appx159-160; *see* Appx18375-18377; Appx18190 & n.11 (detailing increase in sales from Indication 2); *see also*

Appx53062, Appx53065, Appx53069, Appx53086, Appx53088. West-Ward and Actavis even agree that they cannot promote their Tapentadol ER products for treatment of polyneuropathic pain without Indication 2. Appx18190; Appx18380-18381. And Cross-Appellants did not even bother to assert the DPN claims of the '130 patent against West-Ward (which they did against Alkem for including Indication 2, *see* BB24 n.9), despite their theory that treatment of that type of pain is covered by Indication 1. Clearly the district court was correct that Indication 1 does not cover the use of Tapentadol ER for the treatment of polyneuropathic pain; but at a minimum, its view of the evidence was plausible, which is all that is required for affirmance.

Cross-Appellants also suggest that it is somehow "agreed" that "a drug's 'indication' by definition instructs as to" what the ANDA holder believes to be "'its *intended* use or uses.'" DRB64 (quoting *United States ex rel. Polansky v. Pfizer, Inc.*, 822 F.3d 613, 615 (2d Cir. 2016)). As they admit, though, they plucked that "intended use" definition from a Second Circuit opinion—not the factual record here. Indeed, Cross-Appellants even state that the experts in this case only "agreed that an indication" concerns "*approved uses*"—not the specific intent of an ANDA holder. DRB64. Cross-Appellants' sleight of hand cannot fill the logical lacuna in their argument.

At bottom, Cross-Appellants' theory of proof for induced infringement is too myopic to be correct: it entirely ignores the undisputed fact that West-Ward took *affirmative* steps to *avoid* encouraging infringement by carving out Indication 2, references to any DPN study, and references to neuropathic pain. *See* Appx18190; Appx18380. Thus, entirely unlike the accused infringer in *AstraZeneca*, for example, West-Ward has taken every step it can to avoid infringement of the '130 patent. *Cf.* 633 F.3d at 1059-60. Therefore, even if some physicians might read "severe chronic pain" in Indication 1 to encompass polyneuropathic pain and nevertheless infringe, it is not reasonable to infer from that sole argument that West-Ward has a specific intent to cause physicians to use Tapentadol ER to infringe the '130 patent.

3. Cross-Appellants' Criticisms Of The District Court's Findings Are Meritless

Beyond their flawed theory of inducement, Cross-Appellants lodge five complaints against the district court. None has merit.

First, they chide the district court for committing legal error by relying on "'substantial noninfringing uses'" of tapentadol to "preclude a finding of specific intent." DRB67. But the court did no such thing. The court reasoned that, even if applicable, *AstraZeneca*'s "some-user" test would not control here because the fact that "doctors can and likely will follow the instructions on [West-Ward]'s label" to use tapentadol in "noninfringing" ways means that following the accused label

instructions would not "'*necessarily lead*'" to infringement. Appx166 (quoting *AstraZeneca*, 633 F.3d at 1049). That was a logical application of *AstraZeneca* to the specific facts here based on the court's plausible view of all the evidence, not an absolute legal bar to finding specific intent based on "'substantial noninfringing uses.'" DRB67.

And this Court has never held that "non-infringing uses" are universally "*irrelevant*" as a matter of law to the inducement inquiry. DRB67 (emphasis in DRB). Even in *AstraZeneca* (Cross-Appellants' foundational case), this Court reaffirmed that "substantial non-infringing uses" *can* prevent an inference of specific intent in certain circumstances. 633 F.3d at 1059; *see also Warner-Lambert*, 316 F.3d at 1365 (specific intent cannot not be inferred as a matter of law where 97.9% of uses were noninfringing).

Second, Cross-Appellants criticize the district court for "incorrectly focus[ing] on whether Actavis and West-Ward 'intend[] for [their] products to be used to treat DPN.'" DRB68. The asserted claims, they protest, "recite the treatment of polyneuropathic pain generally," "are not limited to DPN, which is only *one type* of polyneuropathic pain," and the "carve-out of the DPN indication has absolutely no bearing on whether their labels will 'cause at least some users'" to infringe. DRB69 (emphasis in DRB). But the district court spent several supposedly "completely irrelevant" (*id.*) pages discussing DPN *because Cross-*

Appellants argued below that Indication 1 covered DPN despite the carve-out. *See* Appx158-160; Appx17706-17709; Appx17872-17873; Appx17841; Appx18001. Responding to that argument, the district court declared that the DPN carve-out is express "evidence that [West-Ward] does not specifically intend to encourage the use of the product for the treatment of DPN." Appx160. The logical relevance of that statement cannot be disputed, and Cross-Appellants' hypocritical attempt to suggest otherwise falls flat.

Nor can it be reasonably disputed that West-Ward's carve-out has "bearing" (DRB69) on the inducement question as it relates to polyneuropathic pain generally. Affirmative attempts to redraft label language to avoid encouraging infringement is strong (and logically indisputable) evidence that an ANDA applicant does not possess a specific intent to induce infringement. *Cf. AstraZeneca*, 633 F.3d at 1059-60 (affirming finding of specific intent where label language was known to cause inevitable infringement *and* ANDA holder refused to redraft the language to avoid infringement); *see also Otsuka Pharm. Co. v. Torrent Pharm. Ltd.*, 99 F. Supp. 3d 461, 485 (D.N.J. 2015) ("voluntarily remov[ing] any reference to the allegedly infringing indication … belies any suggestion" that defendants "acted with the specific intention to encourage infringement" and "negate[s] any reasonable inference of an active intent to induce infringement"). Thus, as the district court correctly found, carving out the only indication covering

a type of polyneuropathic pain, along with all references to neuropathic and polyneuropathic pain and studies addressing them, demonstrates that "[West-Ward] does not intend for its product to be used to treat polyneuropathic pain" and lacks the specific intent required for inducement. Appx163-164.

Third, Cross-Appellants attack the district court for not finding that it would be "'readily apparent to [a] customer' reading 'the label' that … West-Ward's severe chronic pain indication instructs that the drug's 'intended uses' includes polyneuropathic pain." DRB69-70 (alteration in original) (quoting Appx168). But that is just a slightly repackaged version of the Cross-Appellants' theory of inducement, which, as discussed, has no merit. *See supra* III.B.2. And the district court's specific discussion of what would be "readily apparent to [a] customer" (if that is the focus of Cross-Appellants' objection) was merely a response to a series of nonbinding district court opinions cited by Cross-Appellants related to how "magic words" in the label matching the language of the patent are not required for a finding of inducement. Appx167-168. That point is hardly debatable.

Fourth, Cross-Appellants complain that the "district court directly contradicted the undisputed expert testimony" by finding that "the 'treatment of polyneuropathic pain' was *not* 'an on-label use" under Indication 1. DRB70 (emphasis in DRB). Again, Cross-Appellants repeat the baseless suggestion that it was "undisputed that polyneuropathic pain falls within the severe chronic pain

indication and thus the infringing use would squarely be an 'on-label' use." *Id.* But as discussed, those points were obviously disputed, and the district court was correct in concluding that polyneuropathic pain would be an "off-label" use since "Indication 1 [is] supported only by the CLBP study," which does not concern neuropathic pain—an entirely plausible finding that cannot be clear error given that the court's factual interpretation of that study is not an issue raised on appeal. Appx164; *see supra* III.B.1-2. Cross-Appellants only add that the district court cited to a section of its opinion discussing intent to induce treatment of DPN, which they believe was error to include in the first place. DRB70-71. As addressed previously, though, there was no error committed by the district court in discussing DPN. *See supra* III.B.3. And the court likely intended the cross-reference ("Section IV.D.i.1.a.i") to identify its prior discussion of the CLBP study ("Section IV.D.i.1.a.ii"), which was the section relevant to the court's point. *See* Appx164 ("Indication 1 [is] supported only by the CLBP study"). Such a minor oversight (a difference of just one "i" in a lengthy cross-reference) can hardly be unexpected in a 167-page opinion.

Fifth, Cross-Appellants complain that they never argued "'the mere fact that a use is on-label ends the inducement inquiry,'" as the district court believed, but instead suggested that when an "infringing use is indisputably contained within the indication of the label, the court need look no further to conclude that there will be

induced infringement." DRB71 (quoting Appx164-165). But there is no decipherable difference between those positions. Cross-Appellants theorize that inducement is inescapable if an infringing use is on-label—plain and simple. As discussed, that is not the proper inducement analysis though, which instead focuses on specific intent and allows considerations of affirmative evidence outside the final label to show that such intent is lacking. *See supra* III.B.3. And, in any event, the district court's determination that West-Ward lacked specific intent to encourage infringement is entirely plausible given the wealth of evidence showing that DPN is off-label with regard to Indication 1. *See supra* IV.A-B.2.

And while Cross-Appellants complain that the district court's error led it to improperly ignore some sort of demarcation in this Court's case law regarding off-label and on-label uses, they never bother to explain how any such distinction would matter. *See* DRB71. Nor could they. The touchtone of the inducement inquiry is specific intent, not whether a use is on-label or not. Indeed, an on-label use might be adequate to infer intent in certain circumstances, but other factors (e.g., affirmative steps to avoid infringement—such as a carve-out) could prevent any such inference and properly do here. *See supra* III.B.2-3. Or, as the district court put it, in some instances, "permission is different from encouragement," so a permitted on-label use does not necessarily equate to a recommendation or encouragement to engage in that use. Appx165; *see* Appx154-155; *Shire LLC v.*

Amneal Pharm., *LLC*, No. 11-3781 (SRC), 2014 WL 2861430, at *5 (D.N.J. June 23, 2014) (instruction in label to take drug "with or without food" did not equate to instruction to take drug in patented way "with food" because "permission is different from encouragement"), *rev'd in part on other grounds*, 802 F.3d 1301 (Fed. Cir. 2015). Moreover, the treatment of polyneuropathic pain with tapentadol is not an on-label use under Indication 1 anyway, as extensively discussed above, so reliance on off-label cases (as Cross-Appellants read them) would not be error. *See supra* III.B.2-3.

IV. THE JUDGMENT OF NO CONTRIBUTORY INFRINGEMENT OF THE '130 PATENT SHOULD BE AFFIRMED

A. The District Court Correctly Found That West-Ward's ANDA Product Will Not Contribute To Infringement Of The '130 Patent

The district court correctly found that there could be no contributory infringement because Tapentadol ER is suitable for substantial noninfringing uses. *See* Appx172-175. The existence of such noninfringing uses for the ANDA product was "undisputed." Appx173. The only relevant question was whether such uses qualified as "substantial" under § 271(c). Appx173. The court found that they did because they were "not unusual, far-fetched, illusory, impractical, occasional, aberrant, or experimental." *Vita-Mix Corp. v. Basic Holding, Inc.*, 581 F.3d 1317, 1327 (Fed. Cir. 2009); *see* Appx173. There was no clear error in that finding.

As the court soundly concluded when rejecting Cross-Appellants' argument that use for treating nociceptive and mononeuropathic pain would be "rare and insubstantial," there was "extensive evidence of substantial noninfringing uses" for Tapentadol ER. Appx174. Cross-Appellants' expert admitted that West-Ward's label "instruct[s] users to administer the product[] for pain that is *not polyneuropathic*." Appx174; *see* Appx9491; Appx18386; *see also* Appx9516-9517. Multiple experts testified how they used long-acting opioids, including NUCYNTA ER, to treat chronic non-polyneuropathic pain that is severe enough to require around-the-clock medication. Appx174; *see* Appx18387-18388; Appx9225-9228; Appx9516-9517; Appx10620-10623, Appx10670-10671, Appx10682-10684, Appx10687-10688; Appx11892-11894; *see also* Appx9227 (discussing such types of pain listed on demonstrative slide); Appx70018 (same slide). And expert testimony clearly established that numerous medical conditions causing nociceptive and mononeuropathic pain would benefit from Tapentadol ER—several of which were even admitted to be noninfringing by Cross-Appellants' expert, Dr. Brown. Appx174-175; *see* Appx18387; Appx9225-9228; Appx10620, Appx10682-10683; Appx9499; *see also* Appx17874-17875.

Accordingly, there can be little rational dispute that the accused ANDA product is suitable for substantial noninfringing use. Indeed, treatment of severe chronic nociceptive pain is the *only* on-label use for Tapentadol ER, as it is the

only use supported by a study (the CLBP study) disclosed in the accused label (a factual finding that is uncontested on appeal and therefore must be accepted as true). *See supra* III.B.1. An on-label use for an accused drug product (like treatment of nociceptive pain here) simply cannot be "impractical," "aberrant," or "experimental." *See Vita-Mix*, 581 F.3d at 1327.

At bottom, the district court's determination of substantial noninfringing uses centered on a dispute between the experts. *See* Appx174-175 (discussing competing expert testimony). Ultimately, the court agreed with the rational, well-supported testimony of West-Ward's and Actavis's experts. *See* Appx173-175. While Cross-Appellants disagree with that choice, the district court's review of the evidence was plausible, and its decision to credit one set of experts over another is not clear error. *See, e.g.*, *Anderson*, 470 U.S. at 574-75 (the decision to credit one witness when there is conflicting testimony can "virtually never be clear error"); *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1171 (Fed. Cir. 2006) ("'great deference'" due to "'district court's decisions regarding credibility of witnesses'" under "clear error standard").

B. Cross-Appellants Fail To Show Clear Error In The District Court's Finding Of No Contributory Infringement

Cross-Appellants raise two meritless arguments to attack the district court's factual conclusion that the accused ANDA product is suitable for substantial noninfringing use.

First, Cross-Appellants argue that determining substantial noninfringing use is a "quantitative" inquiry that turns on the "frequency" of noninfringing uses. DRB72-74. That is not the law. This Court has made clear that frequency is *not* an essential or necessary factor in determining substantiality. *See, e.g.*, *Vita-Mix*, 581 F.3d at 1327 ("Vita-Mix focused only on the frequency of infringing use ... which does not speak to the substantiality of the non-infringing use in this case.").[10] Instead, as this Court has repeatedly held, "[n]on-infringing uses are substantial [under § 271(c)] when they are not unusual, far-fetched, illusory, impractical, occasional, aberrant, or experimental." *Toshiba Corp. v. Imation Corp.*, 681 F.3d 1358, 1362 (Fed. Cir. 2012). And such qualities apply even to *individual* products and *individual* uses—"*a* substantial non-infringing *use* is *any use* that is 'not unusual, far-fetched, illusory, impractical, occasional, aberrant, or experimental.'" *In re Bill of Lading Transmission & Processing Sys. Patent Litig.*,

[10] While this Court mentioned that *Vita-Mix* was a "non-pharmaceutical" case in *Sanofi* (*see* DRB73 n.5), it did not distinguish *Vita-Mix* on that ground and was not even discussing contributory infringement in that context. *See* 875 F.3d at 646.

681 F.3d 1323, 1337 (Fed. Cir. 2012); *see also Vita–Mix*, 581 F.3d at 1327 (focusing on substance, not quantity, of uses).

To be sure, when assessing the suitability of a product for substantial noninfringing use, a fact-finder is "*allowed* to *consider* not only the use's frequency, but also the use's practicality, the invention's intended purpose, and the intended market." *i4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831, 851 (Fed. Cir. 2010). But Cross-Appellants misrepresent that holding of the Court—it does not in any way *require* that the suitability analysis center on "'*frequency*'" to become "'essentially a *quantitative one*'" looking only for "a '*significant number*'" of non-infringing uses. DRB73 (emphasis in DRB) (selectively quoting *i4i*, 598 F.3d at 851, and quoting *Pickholtz v. Rainbow Techs., Inc.*, 260 F. Supp. 2d 980, 989 (N.D. Cal. 2003)). Indeed, the 15-year-old district court opinion from which Cross-Appellants pluck their "quantitative" test misinterprets Supreme Court case law and has never been adopted by this Court. *See Pickholtz*, 260 F. Supp. 2d at 989 (citing to *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 442-43 (1984)). *But see Sony Corp.*, 464 U.S. at 442-56 (to determine whether product is "merely be capable of substantial noninfringing uses" does not require "explor[ing] *all* the different potential uses" or determining "how much use" by product users exists—"one potential" type of use can be "substantial" (emphasis in original)).

Second, Cross-Appellants claim that the noninfringing uses of Tapentadol ER are too "rare" to be considered substantial. DRB74-77. But they present no relevant evidence that such "noninfringing uses" would be "extremely *rare*." DRB74-75 (emphasis in DRB). They argue that "less than 5%" of patients with nociceptive pain or mononeuropathic pain required "around-the-clock opioid treatment," and, for some conditions, the number was "less than 1%." DRB75; *but see* Appx11894-11895 (same expert admitting that mononeuropathic pain rate has not "ever really been documented" but a guess would be "five percent"). Even accepting those statements as true, they reveal nothing but a *relative* comparison of the patients requiring around-the-clock treatment versus the number of patients *within each respective class of pain*. Those facts thus prove nothing about the *absolute* frequency of such treatment. Indeed, to the contrary, given the prevalence of such types of pain and "hundreds of thousands of NUCYNTA patients" (GRB60), such low percentages likely represent thousands of patients—a substantial number by any measure. *See, e.g.*, Appx9218-9219 (80 to 90 percent of lower back pain not polyneuropathic); Appx9507-9508 (as little as 18 percent of CLBP potentially neuropathic); Appx53018 (same); Appx9512 (only 37 percent of CLBP neuropathic); Appx10618 (two-thirds or more of severe CLBP nociceptive, and vast majority of rest "mononeuropathic"); Appx10620-10622 (discussing noninfringing uses); Appx10623 ("of course" a "substantial number of patients"

receiving NUCYNTA "fall within indication one but outside the scope of claims 1 and 2"); Appx11893-11894 (Cross-Appellants' expert admitting that "at least five percent" of all "chronic low back pain patients with severe pain have a pure nociceptive cause"). Indeed, the CLBP study that is included in the accused label involved nearly 1,000 patients—hardly "aberrant." *See* Appx9510; Appx49827-49837; Appx56882.

And without absolute numbers, Cross-Appellants' evidence reveals nothing about the relative frequency of *noninfringing versus infringing uses*. Such a comparison logically requires knowing the comparative patient population sizes of nociceptive, mononeuropathic pain, and polyneuropathic pain that are being discussed. That one expert supposedly testified "polyneuropathic pain *often* requires 'around-the-clock opioid treatment" does not help. DRB75 (citing Appx9389). As an initial matter, the expert actually stated that "chronic pain" is "often" "neuropathic" pain, not "*poly*neuropathic" pain, and she did not state that "polyneuropathic pain" somehow "*often* requires" around-the-clock opioid treatment. *Id.*; Appx9388-9389. Regardless, that treatment could be "often" required is so vague that its relevance could only be a product of Cross-Appellants' imagination.

Thus, Cross-Appellants present no relevant evidence of non-substantiality—and certainly nothing amounting to a *prima facie* showing that shifted the burden

to West-Ward to come forward with evidence showing that the actual "frequency of such uses was *not* rare." DRB76 (emphasis in DRB). Even if there were such a shift in burden of *production* though (not proof, which always remains with the patentee), West-Ward (and Actavis) met it by putting forth expert testimony that demonstrated multiple noninfringing uses for Tapentadol ER (*see supra* IV.A-B), evidence that the district court credited and found to be "extensive." Appx174-175; *see Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1363-64 (Fed. Cir. 2006) (after *prima facie* case established, "burden of production" shifts to accused infringer to "introduce some evidence" demonstrating use in a non-infringing way).

C. Alternatively, The Judgment Of No Contributory Infringement Should Be Affirmed Because The Accused Product Is Not Especially Made Or Adapted For Infringement Of The '130 Patent

Though the district court never reached the issue, to sustain a finding of contributory infringement, Cross-Appellants had to prove that the accused ANDA product was "especially made or especially adapted" for infringement of the '130 patent. 35 U.S.C. § 271(c); *see Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1320 (Fed. Cir. 2009) (explaining that § 271(c) requires proof that an accused product is "a material part of the invention" and that the accused infringer acts "knowing the same to be especially made or especially adapted for use in an

infringement of [the] patent"); Appx173 (addressing "material part" element of § 271(c) but not "especially made or especially adapted" requirement).

Cross-Appellants presented no evidence to support such a finding though. They did not argue the point in post-trial briefing, and their expert on the topic could not even provide an opinion that the ANDA product was especially made or adapted for treating polyneuropathic pain. *See, e.g.*, Appx9516. And it is clear that West-Ward's ANDA product is deliberately made and adapted to *avoid* infringement of the '130 patent: because of West-Ward's carve-out, any infringing use of the ANDA product is *off-label*, and there are no references or data in the label that would tailor the product for use in treating polyneuropathic pain. *See supra* III.B; Appx164; BB22-24, 44; Appx9207-9208; Appx9494, Appx9499; Appx18197-18198; Appx18385-18387.

Accordingly, even if the Court somehow were to see clear error in the district court's finding that Tapentadol ER is "suitable for substantial noninfringing use" under § 271(c), the judgment of no contributory infringement should be affirmed on the alternative ground that the accused ANDA product is not especially made or adapted to infringe the '130 patent. *See Hydril Co. LP v. Grant Prideco LP*, 474 F.3d 1344, 1351 (Fed. Cir. 2007) (district court's judgment may be affirmed "on any ground shown by the record, even though that was not the basis of the district court's decision").

CONCLUSION

For the foregoing reasons and those presented in West-Ward's principal brief and the briefs it has joined, the Court should (i) reverse the district court's judgment that claims 1, 2, 3, and 25 of the '364 patent were not proven invalid along with the attendant injunctions related to that patent; (ii) affirm the district court's judgment of noninfringement for claims 1 and 2 of the '130 patent in favor of West-Ward; and (iii) if that noninfringement judgment were reversed, hold that those claims of the '130 patent are invalid instead.

Dated: January 31, 2018

Respectfully submitted,

/s/ Kenneth G. Schuler

Kenneth G. Schuler
LATHAM & WATKINS LLP
330 North Wabash Avenue
Suite 2800
Chicago, IL 60611
(312) 876-7700

Terrence J. Connolly
LATHAM & WATKINS LLP
885 Third Avenue
New York, NY 10022
(212) 906-1200

Gregory K. Sobolski
LATHAM & WATKINS LLP
505 Montgomery Street
Suite 2000
San Francisco, CA 94111
(415) 391-0600

Robert J. Gajarsa
LATHAM & WATKINS LLP
555 Eleventh Street, NW
Suite 1000
Washington, DC 20004
(202) 637-2200

Counsel for Defendant-Appellants West-Ward Pharmaceuticals International Limited and West-Ward Pharmaceuticals Corp.

CERTIFICATE OF SERVICE

I hereby certify that on January 31, 2018, I electronically filed the foregoing Reply and Response Brief for Appellants West-Ward Pharmaceuticals International Limited and West-Ward Pharmaceuticals Corp. with the United States Court of Appeals for the Federal Circuit through the Court's CM/ECF system. All parties are represented by registered CM/ECF users and will be served by the CM/ECF system.

/s/ Kenneth G. Schuler
Kenneth G. Schuler

CERTIFICATE OF COMPLIANCE WITH RULE 32

Pursuant to Fed. Cir. R. 28.1(c) and Fed. R. App. P. 32(g), I hereby certify that this brief complies with the type-volume limitations of Fed. R. App. P. 28.1(e) and Fed. Cir. R. 28.1(b)(1)(A) because it contains 13,979 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b).

I further certify that this brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) because this brief was prepared using Microsoft Word 2016 in 14-point Times New Roman font.

/s/ Kenneth G. Schuler
Kenneth G. Schuler