

No. _____

IN THE
Supreme Court of the United States

HOSPIRA, INC.,

Petitioner,

v.

ELI LILLY AND COMPANY,

*Respondent.*¹

APPLICATION FOR AN EXTENSION OF TIME TO FILE A PETITION FOR
WRIT OF CERTIORARI

TO THE HONORABLE JOHN G. ROBERTS, CHIEF JUSTICE OF THE UNITED STATES AND
CIRCUIT JUSTICE FOR THE FEDERAL CIRCUIT:

Under Supreme Court Rule 13.5, petitioner Hospira, Inc. (“Hospira”) respectfully requests an 18-day extension of time to file a petition for a writ of certiorari, to and including Monday, February 24, 2020.

1. The court of appeals issued its panel opinion and judgment on August 9, 2019 (Tab A, published at 933 F.3d 1320). The full court denied Hospira’s timely-filed petition for rehearing on November 8, 2019 (Tab B). This Court’s jurisdiction would be invoked under 28 U.S.C. § 1254.

¹ All parties are listed in the caption. Hospira is an indirect, wholly-owned subsidiary of Pfizer Inc. This application arises from Fed. Cir. Nos. 18-2126 and 18-2127. The opinion of the court of appeals addressed these appeals as well as a companion appeal (Fed. Cir. No. 18-2128), but the court issued a separate judgment in that companion appeal. The parties in the companion appeal were Appellee Eli Lilly & Company and Appellants Dr. Reddy’s Laboratories, Ltd. and Dr. Reddy’s Laboratories, Inc.

2. Absent an extension, the deadline for Hospira to file a petition for certiorari would be February 6, 2020. This application is filed more than ten days before that date.

3. This patent infringement case concerns the “doctrine of equivalents,” which extends the scope of a patent claim to cover subject matter that, while not expressly claimed, is deemed “equivalent” to the expressly-claimed subject matter. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 21 (1997). The basis for the doctrine of equivalents is that “language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). Thus, the doctrine prevents competitors from circumventing a patent by using “unimportant and insubstantial substitutes.” *Id.*

4. Prosecution history estoppel is a limitation on the doctrine of equivalents. It provides that when a patentee narrows a claim during patent prosecution for a “substantial reason related to patentability,” “the court should presume that the patentee surrendered all subject matter between the broader and the narrower language,” and therefore may not reclaim that subject matter under the doctrine of equivalents. *Festo*, 535 U.S. at 740-41. “Prosecution history estoppel ensures that the doctrine of equivalents remains tied to its underlying purpose. Where the original application once embraced the purported equivalent but the patentee narrowed his

claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question.” *Id.* at 734.

5. In *Festo*, this Court held that the presumption of estoppel may be rebutted “where the amendment cannot reasonably be viewed as surrendering a particular equivalent.” *Id.* at 740. The Court explained that this would occur when “the equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.” *Id.* at 740-41. The Court then went on to hold that “[t]he patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” *Id.* at 741.

6. In this case, the patentee initially sought patent protection on claims that included the claim term “antifolate”—a broad category of chemical compounds. Those claims were rejected over the prior art. The patentee then narrowed the claim term “antifolate” to “pemetrexed *disodium*”—one particular type of antifolate. The claims were then allowed.

7. Hospira developed a pemetrexed *ditromethamine* drug. Pemetrexed ditromethamine is a type of antifolate, and hence would have literally infringed the claims as originally drafted (and rejected). But pemetrexed ditromethamine is different

from pemetrexed disodium, and thus does not literally infringe the claims that the Patent Office actually allowed.

8. There was no dispute that the patentee could reasonably have drafted a claim covering Hospira's drug. For example, it could have claimed "pemetrexed and its salts." Nevertheless, the Federal Circuit declined to apply prosecution history estoppel. Instead, it held that the patentee had met its burden of proving that "the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question." *Festo*, 535 U.S. at 740. The court concluded, notwithstanding the patentee's express choice of claim language, that the patentee "did not need or intend to" exclude pemetrexed salt forms other than pemetrexed disodium. 933 F.3d at 1332. A divided Federal Circuit panel adopted similar reasoning in another case that issued the same week as the instant case. *Ajinomoto v. ITC*, 932 F.3d 1342 (Fed. Cir. 2019).

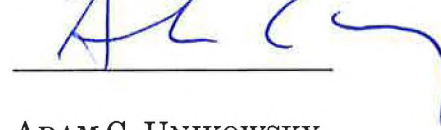
9. Thus, this case presents the question of whether prosecution history estoppel precludes application of the doctrine of equivalents where the patentee could have been reasonably expected to write its patent claim to literally encompass the alleged equivalent.

10. Hospira respectfully requests an 18-day extension of time, to and including February 24, 2020, to prepare its petition. The extension is sought to accommodate counsel's professional commitments in advance of the current deadline for filing a petition, including an oral argument before this Court on January 22, 2020.

January 24, 2020

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Respectfully submitted,



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