

No. A

IN THE
Supreme Court of the United States

DR. REDDY'S LABORATORIES, LTD. AND DR. REDDY'S LABORATORIES, INC.,
Petitioners,

v.

ELI LILLY & COMPANY,
Respondent.

**APPLICATION FOR AN 18-DAY 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, petitioners Dr. Reddy's Laboratories, Ltd. and Dr. Reddy's Laboratories, Inc. ("Dr. Reddy's") respectfully request an 18-day extension of time to file a petition for a writ of certiorari, to and including Monday, February 24, 2020.¹

¹ All parties are listed in the caption. Petitioners' parent company is Dr. Reddy's Laboratories, S.A. Although the court of appeals issued an opinion addressing two companion appeals together (Fed. Cir. Nos. 18-2128 and 18-2126), it issued separate judgments in each in each appeal. This application arises from No. 18-2128. In Appeal No. 18-2126, the parties were Eli Lilly & Company, and Hospira, Inc.

1. The court of appeals issued its panel opinion and judgment on August 9, 2019 (Tab A, published 933 F.3d 1320). The full court denied Dr. Reddy'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.

2. Without an extension, the deadline to file the petition for certiorari would be February 6, 2020. This application is filed more than 10 days before that date.

3. This case presents an important question concerning the scope of patent law's doctrine of equivalents. "The doctrine of equivalents is premised on language's inability to capture the essence of innovation," *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002), and allows patent holders to assert claims for infringement for products and processes that are not within the literal scope of the patent's claims. The claims provide notice to the public of what the patented invention is, and thus of what conduct will constitute infringement. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129-30 (2014). Under the doctrine of equivalents, patentees may allege infringement by products or processes that are "equivalent" or "insubstantially different" from what is literally claimed. *Warner-Jenkinson Co. v. Hilton Davis*

Chem. Co., 520 U.S. 17, 39-40 (1997). The doctrine of equivalents thus “renders the scope of patents less certain,” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002), and “when applied broadly, conflicts with the definitional and public-notice functions” of patent claims. *Warner-Jenkinson*, 520 U.S. at 29.

4. This Court’s precedent emphasizes that the doctrine of equivalents is part of patent law, but must be carefully cabined. Even with the doctrine of equivalents, “[a] patent holder should know what he owns, and the public should know what he does not.” *Festo*, 535 U.S. at 731. Prosecution history estoppel is an important tool for the public to know what a patent holder does not own. For more than 100 years, productive companies considering their competitors’ intellectual property have been entitled to assume that when a patent applicant has changed its claims in prosecution from broader to narrower, the scope between the original and narrowed claims is surrendered—*i.e.*, the patentee would be estopped in litigation from contending that the surrendered territory is covered by the patent literally or under the doctrine of equivalents. *See, e.g., Shepard v. Carrigan*, 116 U.S. 593, 598 (1886); *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942).

5. In 2002, in *Festo*, this Court announced three exceptions to the doctrine of prosecution history estoppel. Prosecution history estoppel does not apply where the patentee “could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” 535 U.S. at 740-41. One such exceptional circumstance is where “the rationale underlying the amendment [to the patent claims] may bear no more than a tangential relation to the equivalent in question.” *Id.*

6. Since this Court announced the “tangential” exception, the Federal Circuit has taken two diametrically opposite approaches to what that exception means.

6a. Under one approach, “tangential” refers to when a patent applicant adds multiple limitations to a claim at the same time, not all of which relate to an examiner’s rejection. Equivalents to the unrelated limitations may fall within the tangential exception. *See, e.g., Ajinomoto v. ITC*, 932 F.3d 1342, 1363 (Fed. Cir. 2019) (Dyk, J., dissenting); *Honeywell Int’l Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316 (Fed. Cir. 2008); *Biagro W. Sales, Inc. v. Grow More Inc.*, 423 F.3d 1296, 1306 (Fed. Cir. 2005). That approach respects the public-notice function of a patent’s

claims and prosecution history, and it avoids the obvious gamesmanship that would result if patent holders could invoke the “tangential” exception merely by arguing that, in retrospect, they narrowed their claims too much in response to an examiner’s rejection. *See, e.g., Int’l Rectifier Corp. v. IXYS Corp.*, 515 F.3d 1353, 1359 (Fed. Cir. 2008) (the “decision to claim ... using a limiting term ... *whether or not required to overcome the...* rejection, cannot be described as only tangential.”); *Integrated Tech. Corp. v. Rudolph Techs., Inc.*, 734 F.3d 1352, 1358 (Fed. Cir. 2013).

6b. Under the other approach, panels of the Federal Circuit accept precisely that sort of gamesmanship and treat the “tangential” exception as a prosecution remorse exception. In this case, the Federal Circuit panel held that the tangential exception applied where the patentee “did not need or intend to” surrender as much claim scope in prosecution as it did to avoid prior art. *Eli Lilly*, 933 F.3d at 1332. Instead of the public-notice and limits-of-language principles this Court’s precedent emphasizes, the Federal Circuit panel here relied on what it called the “equitable” and “case-specific” nature of the doctrine of equivalents. *Id.* at 1333-34. A growing body of Federal Circuit decisions has taken the same approach, including a divided decision issued the same week. *See, e.g., Ajinomoto*,

932 F.3d at 1352-56; *Regents of Univ. of Cal. v. Dakocytomation Cal. Inc.*, 517 F.3d 1364, 1377-79 (Fed. Cir. 2008); *Insituform Techs., Inc. v. Cat Contracting, Inc.*, 385 F.3d 1360, 1367-71 (Fed. Cir. 2004). As dissents in two of those cases have pointed out, the approach these cases take to the “tangential” exception is wrong. *Ajinomoto*, 932 F.3d at 1362 (Dyk, J., dissenting); *Regents*, 517 F.3d at 1381 (Prost, J., dissenting). If a patentee’s remorse over giving prior art a wide berth rather than a narrow one is enough to escape prosecution history, then the tangential exception will swallow the rule of prosecution history estoppel, and the patentee’s competitors will be left to guess at what the patents might be used to cover in litigation.

7. The proper scope of the tangential exception is squarely presented here. It resolves the entire case. All agree that if the exception applies, Eli Lilly prevails on its infringement claims, and if it does not Dr. Reddy’s prevails. In prosecution, Eli Lilly narrowed its claims to avoid prior art. Its original claims recited “antifolate” (a category of drugs); its amended claims recited “*pemetrexed disodium*” (a single compound in that category). Relying on this Court’s precedent, Dr. Reddy’s designed around Lilly’s claims by using one of the surrendered compounds—“pemetrexed

ditromethamine.” This is not a case where where the patentee “could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” *Festo*, 535 U.S. at 740-41. Had Eli Lilly desired broader claims that included Dr. Reddy’s product, it could easily have drafted them. Nonetheless, Eli Lilly sued Dr. Reddy’s, alleging infringement under the doctrine of equivalents. The district court and the Federal Circuit held that even though Eli Lilly surrendered “pemetrexed ditromethamine” in prosecution, the tangential exception applied because Eli Lilly’s claim amendment was “inartful ... prudential in nature, and *did not need or intend to cede other pemetrexed salts.*” 933 F.3d at 1332 (emphasis added). As a result of the approach the Federal Circuit took, Dr. Reddy’s was punished for relying on this Court’s precedent and the public record of Eli Lilly’s prosecution history, and Eli Lilly was permitted to expand its patent claims in litigation to cover compounds it had surrendered to obtain its patent. Had the Federal Circuit taken the opposite approach (§6a, *supra*), it would have easily rejected Eli Lilly’s arguments and held Eli Lilly to the consequences of the choices it made in prosecution.

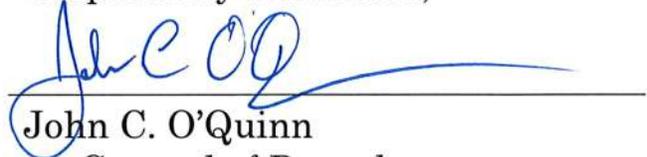
8. The proper approach to the “tangential” exception is fundamentally important. Under the broad approach that some Federal Circuit panels take, the “tangential” exception undermines an important longstanding limit on the doctrine of equivalents and threatens the public-notice function of patent claims. This Court and the Federal Circuit have both acknowledged the importance of the doctrine of equivalents. *Festo*, 535 U.S. at 731; *Warner-Jenkinson*, 520 U.S. at 29; *Litton Sys., Inc. v. Honeywell, Inc.*, 145 F.3d 1472, 1472 (Fed. Cir. 1998) (Plager, J., dissenting from denial of rehearing en banc) (“There is perhaps no question more important to the health of patents than the scope and application of the judicially-created doctrine of equivalents.”).

9. Dr. Reddy’s respectfully requests an extension of time to accommodate its counsel’s other professional obligations during the time allotted to prepare a petition for certiorari. The allotted time to prepare the petition has overlapped with Thanksgiving and the winter holidays, and with several other deadlines, hearings, and oral arguments in other cases (including two appeals with overlapping expedited briefing schedules). The relatively short extension requested here should permit sufficient time to prepare the petition for this Court’s review. Dr. Reddy’s

respectfully requests an 18-day extension of time, to and including Monday, February 24, 2020.

January 22, 2020

Respectfully submitted,



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