

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

JAZZ PHARMACEUTICALS, INC.,

Plaintiff,

v.

AVADEL CNS PHARMACEUTICALS, LLC,

Defendant.

C.A. No. 21-691-MN

**REPLY BRIEF IN SUPPORT OF DEFENDANT'S RENEWED MOTION FOR
PARTIAL JUDGMENT ON THE PLEADINGS**

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I. INTRODUCTION

Jazz’s decision to limit its opposition to solely a procedural objection, forgoing any substantive response, is calculated to further delay resolution of Avadel’s delisting counterclaim and prevent Avadel from introducing its new once-nightly sodium oxybate product to the narcolepsy market. But Jazz’s invocation of Rule 16 does not merit deferring consideration of Avadel’s motion. As FEDERAL RULE OF CIVIL PROCEDURE 1 mandates, the Rules “should be construed, administered, and employed by the court and the parties to secure the just, speedy, and inexpensive determination of every action and proceeding.” Delaying consideration of Avadel’s motion would not further those objectives.

When Avadel first filed its 12(c) motion on July 23, 2021, Jazz asked the Court to delay ruling on the bases that the issue was allegedly unripe and required claim construction to determine whether the ’963 patent claims are directed to systems or methods. D.I. 43. The Court rejected Jazz’s ripeness argument, but agreed that claim construction was necessary and denied Avadel’s motion without prejudice on that basis. D.I. 55. Now that the parties have disclosed their claim construction positions and the *Markman* hearing is fast approaching, Avadel renewed its 12(c) motion and explained why—under either party’s proposed construction—the ’963 patent is not Orange Book-listable. As Avadel additionally explained in its motion, given the exigent circumstances, Avadel respectfully requests that the Court rule on the merits of the motion as soon as practicable following its claim construction ruling.

Rather than take on the substance of Avadel’s motion and attempt to explain how the ’963 patent is properly listed in the Orange Book, Jazz’s opposition is (tellingly) entirely limited to procedural arguments that are intended to create further unjustified delay. According to Jazz’s opposition, which it styled as an “objection,” the Court should deny Avadel’s motion because the Scheduling Order required Avadel to seek leave before filing. Jazz is incorrect. Jazz’s procedural

“objection” is based on mischaracterizations of both Avadel’s motion and this Court’s procedures, and are (ironically) procedurally improper. Jazz could have raised its procedural argument in a responsive brief, along with any substantive arguments, but instead attempted to force a drawn-out two-step response process for a straightforward motion.

While the Court plainly has full discretion to manage its docket, the Scheduling Order did not require Avadel to seek leave to file its renewed 12(c) motion. The Scheduling Order requires only that parties seek leave to file “case dispositive motions” (*i.e.*, motions for summary judgment), not motions brought pursuant to Rule 12. Given that Jazz only opposed on this procedural ground and has now waived any substantive opposition, if the Court agrees, Avadel’s motion can be granted immediately. However, to the extent the Court disagrees, Avadel respectfully requests that the Court convert Avadel’s renewed motion and accompanying cover letter into a request for leave to file a renewed motion for judgment on the pleadings, and rule on Avadel’s renewed motion as promptly as possible.

II. ARGUMENT

A. AVADEL WAS NOT REQUIRED TO SEEK LEAVE BEFORE FILING ITS RENEWED 12(C) DELISTING MOTION

This Court’s procedures did not require Avadel to seek leave before filing its renewed motion for partial judgment on the pleadings, as Jazz contends.¹ D.I. 124 at 1 (citing D.I. 31 at ¶ 15). While Jazz argues that Avadel’s motion is a “case dispositive motion” requiring leave of Court, the Scheduling Order’s reference to “case dispositive motions” is addressed to summary

¹ The Court’s procedures also do not permit Jazz to make an “objection” to Avadel’s motion. If Jazz wanted to insist on forgoing responsive briefing (which is unjustified, as explained below), it should have at the very least followed the procedure outlined in paragraph 9 of the Scheduling Order, which states that “any motion to strike any pleading or other document shall be made pursuant to the discovery dispute procedure set forth in Paragraph 8(g) above.” D.I. 31 at ¶ 9.

judgment motions and does not encompass motions for judgment on the pleadings brought under Rule 12(c). Jazz's argument is inconsistent with the procedural posture of Avadel's motion, Jazz's own actions in litigating before this Court, prior precedent, and the Court's form scheduling orders.

First, Avadel filed a *renewed* motion for judgment on the pleadings, which refers back to its initial motion for judgment on its delisting counterclaim. D.I. 118 at 1. Notably, Jazz did not object to that motion on procedural grounds. Further, the Court did not deny Avadel's motion with prejudice; rather, the Court noted that "Defendants' arguments depend in no small part on claim construction" (D.I. 55 at 5), and "decline[d] to engage in claim construction at this early stage of the case." *Id.* at 6. This concern no longer exists. It makes little sense to suggest that although the initial motion was properly filed under the Court's procedures, as Jazz seems to recognize, it could not be renewed once the concerns that led to its denial without prejudice had been resolved absent additional motion practice.

Precedent from this district confirms that Avadel was not required to seek leave to file its renewed Rule 12 motion. In *Eli Lilly and Co. v. Eagle Pharmaceuticals, Inc.*, the Court ruled on the substance of a motion for judgment on the pleadings that was filed for the first time *after* a scheduling order was entered that included precisely the same provision Jazz argues prohibits such a motion: "[n]o case dispositive motions shall be filed without prior authorization of the Court." Exhibit A, C.A. No. 17-1293-MSG, D.I. 16 (Scheduling Order) at ¶ 10; Exhibit B, *Eli Lilly*, D.I. 50 (Memorandum Opinion ruling substantively on Defendants' motion for judgment on the pleadings). The same result should follow here. In fact, Jazz appears to agree that 12(c) motions are not verboten absent leave of Court, as it recently filed a motion for judgment on the pleadings in Case Number 22-487, despite that fact that the Court's form scheduling orders prohibit case

dispositive motions in cases where a jury trial has not been requested. *See* C.A. No. 22-487-MN, D.I. 24. Thus, Jazz’s actions speak louder than the words of its “Objection.”

Further, the Court’s form scheduling orders are consistent with Avadel’s understanding that the reference to “case dispositive motions” in the Scheduling Order refers to summary judgment motions, not Rule 12 motions. For example, paragraph 15 of the Court’s form patent scheduling order for non-ANDA cases is entitled “Case Dispositive Motions,” and specifically references Rule 56, restricts early motions for summary judgment, and specifies that the appropriate time for filing such motions is “four months prior to the pretrial conference.” Exhibit C at ¶ 15(a). Paragraph 15 goes on to require concise statements of fact “as to which the moving party contends there is no genuine issue to be tried” and requires the opposing party to submit a responsive statement of facts. *Id.* at ¶ 15(b). Finally, Paragraph 15 provides a combined page limit for all “case dispositive motions” and *Daubert* motions. *Id.* at ¶ 15(c). The reference to “case dispositive motions” in this context and at this phase of the case—shortly before the pretrial conference and alongside *Daubert* motions—appears to be a clear nod to summary judgment motions, and not a restriction on the timing or filing of Rule 12 motions.

Other Courts in this district have likewise distinguished between “case dispositive motions,” *i.e.*, summary judgment motions, and motions for judgment on the pleadings. For example, in *MAZ Encryption Techs. LLC v. Blackberry Corp.*, Judge Stark did not consider Defendant’s motion for judgment on the pleadings to be “an early case-dispositive motion,” which would have required leave pursuant to the Court’s Scheduling Order. C.A. No. 13-304-LPS, 2016 WL 5661981 at *10, n.5 (D. Del. Sep. 29, 2016). Specifically, the Court refused to consider an argument by Defendant that contradicted the specification of the asserted patent because Defendant chose to file a motion for judgment on the pleadings, which required the Court to treat

the statements in the specification as true. The Court noted that if the Defendant wanted to contradict the information in the pleadings, which would require a summary judgment motion rather than a motion for judgment on the pleadings, it “could have waited to press its § 101 issue *until the time for case-dispositive motions or sought leave to file an early case-dispositive motion.*” *Id.* This language indicates, of course, that Defendant’s motion for judgment on the pleadings was not an “early case-dispositive motion” under the scheduling order (and the practice in this District). *See also* Exhibit D, *CG Technology Development, LLC v. FanDuel, Inc.*, C.A. No. 17-1041-RGA, D.I. 375 (D. Del. Mar. 5, 2020) (addressing a 12(c) motion despite scheduling order’s restriction on early case dispositive motions).

Jazz’s argument that the scheduling order in *MAZ Encryption Techs* “permitted two types of dispositive motions” is unsupported and contradicted by the Court’s reasoning in deciding the motion. D.I. 124 at 2. A more logical reading of the Scheduling Order in *MAZ* is that the Court expected summary judgment briefing to be filed 180 days following the Court’s claim construction ruling and required leave to file any summary judgment motions more than 10 days before that date (“early” summary judgment motions). In other words, as is typical in this District, the Order created a 10-day window in which the parties could file summary judgment motions without leave of Court. The distinction Jazz attempts to draw between the alleged “two types of motions” is more appropriately read as a clarification (*i.e.*, the reference to Rule 56 makes explicit what is already implicit—that the cited portion of the scheduling order is geared toward summary judgment motions), not an indication that summary judgment motions are a subset of case dispositive motions. And in any event, the court’s ruling is clear—motions for judgment on the pleadings are not “case dispositive motions” in the context of such a Scheduling Order.

B. AVADEL SHOULD BE GRANTED LEAVE TO FILE ITS 12(C) MOTION IF LEAVE WAS REQUIRED

If the Court finds that Avadel was required to seek leave to file its motion, Avadel respectfully requests that the Court convert Avadel's renewed motion and accompanying cover letter into a request for leave. It is well within the Court's discretion to do so. *See, e.g., Hercules Incorporated v. Delaware Valley Scrap Co., Inc.*, Civil No. 08-4391-RMB-KMW, 2009 WL 10690434, at *1 (D.N.J. Sept. 23, 2009) (converting Defendant's motion to "re-instate" a third-party complaint into a motion seeking leave to file a third-party complaint).

As Avadel explained in the cover letter accompanying its motion, Avadel's renewed motion for partial judgment on the pleadings can and should be resolved contemporaneously with claim construction, or as soon as possible thereafter. D.I. 119. Doing so is the most efficient way to resolve this dispute, as there are no additional issues that require resolution to decide this motion, and ruling in Avadel's favor on claim construction is dispositive of Avadel's delisting counterclaim (which Jazz does not dispute). And, as Avadel explained and Jazz has not disputed, this Court need not even reach claim construction to decide this motion. Even if the Court were to adopt Jazz's proposed construction, the '963 patent should still be delisted. D.I. 118 at 9-11. Further, as established in Avadel's cover letter and brief, resolution of this dispute is time-sensitive. The FDA recently required Avadel to provide a Paragraph IV certification to Jazz's improperly listed '963 patent, which is delaying approval of Avadel's only product. D.I. 119; *id.* at 1-3. Thus, Avadel has established via its initial motion that there is good cause to grant leave and to grant the motion.

No additional briefing is necessary on Avadel's renewed motion for judgment on the pleadings. Jazz has already had a chance to be heard on Avadel's original motion, and clearly had the ability and wherewithal to express its substantive opposition. However, in the face of Avadel's

renewed motion, Jazz chose to file only a procedural objection in violation of the Court's Local Rules regarding motion briefing, and it is not entitled to submit any additional briefing. By choosing not to respond on the merits when it had the opportunity to do so, Jazz has waived any arguments it failed to include in its opposition. *See In re Asbestos Litigation Thorne v. Crane Co.*, C.A. No. 20-419-MN-SRF, 2022 WL 2178443 at *7 (D. Del. June 16, 2022) (finding that Plaintiffs waived an argument that "should have been" addressed in their answering brief but was not) (internal citations omitted).

To be clear, an "objection" is not a proper response to a motion—the appropriate action was for Jazz to file a responsive brief where it could have raised any procedural objections and responded on the merits, to the extent it could muster a substantive retort. *See* D. Del. LR 7.1.2. There is no justification for Jazz's failure to respond substantively, or for its suggestion that it should be awarded further briefing should the Court continue with deciding Avadel's motion. The *only reason* Jazz chose to proceed in this manner is that it recognized a potential opportunity to create further delay by raising a procedural objection and then dragging out its responsive briefing. Jazz's gamesmanship should not be rewarded with a second bite at the apple. Avadel respectfully requests that the Court rule on this motion as promptly as possible, including by declining any request for additional briefing by Jazz.

III. CONCLUSION

In light of the foregoing, Avadel respectfully requests that the Court reject Jazz's procedural gambit and address Avadel's motion for judgment on the pleadings on the merits. Or, in the alternative, Avadel respectfully requests that the Court convert Avadel's cover letter and renewed motion for judgement on the pleadings into a request for leave to file its motion, grant Avadel's request, and resolve the motion as promptly as possible. For the reasons stated in Avadel's initial motion, which Jazz chose not to dispute on the merits, Avadel respectfully requests

that this Court grant Avadel's motion for renewed judgment on the pleadings and require Jazz to delist the '963 patent.

Dated: July 14, 2022

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EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

| | | |
|------------------------------|---|------------------------------|
| ELI LILLY AND COMPANY, |) | |
| |) | |
| Plaintiff, |) | |
| |) | |
| v. |) | C.A. No. 17-1293 (VAC) (MPT) |
| |) | |
| EAGLE PHARMACEUTICALS, INC., |) | |
| |) | |
| Defendant. |) | |

SCHEDULING ORDER

This 10th day of January 18, 2018, the Court having conducted an initial Rule 16 scheduling and planning conference pursuant to Local Rule 16.2(a) on December 11, 2017, and the parties having determined after discussion that the matter cannot be resolved at this juncture by settlement, voluntary mediation, or binding arbitration;

IT IS ORDERED that:

1. Rule 26(a)(1) Initial Disclosures and E-Discovery Default Standard. Unless otherwise agreed to by the parties, the parties shall make their initial disclosures pursuant to Federal Rule of Civil Procedure 26(a)(1) within ten (10) days of the date of this Order. If they have not already done so, the parties are to review the Default Standard for Discovery of Electronic Documents, which is posted at <http://www.ded.uscourts.gov> (see Guidelines, Electronic Discovery Default Standard and Default Standard for Access to Source Code rev. 12/8/11), and is incorporated herein by reference.

2. Joinder of Other Parties and Amendment of Pleadings. All motions to join other parties, and to amend or supplement the pleadings shall be filed on or before February 16, 2018.

3. Discovery.

(a) Limitations. The limits on depositions and interrogatories set forth in Federal Rules of Civil Procedure 30 and 33 respectively shall apply. Each side is limited to a total of 25 requests for admission to the other side, although requests for authentication shall not count against this limit.

(b) Discovery Cut Off. All fact discovery shall be initiated so that it will be completed on or before December 7, 2018. The Court encourages the parties to serve and respond to contention interrogatories early in the case. Unless otherwise ordered by the Court, the limitations on discovery set forth in Local Rule 26.1 shall be strictly observed.

(c) Disclosure of Expert Testimony. Expert discovery shall be commenced to be completed by July 17, 2019. For the party who has the burden of proof on the subject matter, the initial Federal Rule 26(a)(2) disclosure of expert testimony is due on or before March 1, 2019. Rebuttal expert reports on the same subject matter identified by another party are due on or before May 14, 2019. Reply reports are due June 18, 2019. Along with the submissions of the expert reports, the parties shall advise of the dates and times of their experts' availability for deposition.

Unless extended by agreement of the parties or by order of the Court, expert depositions are limited to a maximum of 7 hours per expert.

To the extent any objection to expert testimony is made pursuant to the principles announced in *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993), as incorporated in Federal Rule of Evidence 702, it shall be made by motion, and any such motion and response thereto shall be set forth in the pretrial order, unless otherwise ordered by the Court.

(d) Supplementations under Rule 26(e) are due by January 10, 2019.

(e) Discovery Matters. Should counsel find they are unable to resolve a discovery matter or other matters covered by this provision,¹ the parties involved shall contact chambers at (302) 573-6173 to schedule a telephone conference. At that time, counsel shall advise which parties have disputes, and each moving party shall raise no more than three (3) issues per motion/teleconference. Thereafter, the moving party or parties shall each file a “Motion for Teleconference to Resolve Discovery Dispute(s).”²

The following procedures shall apply:

(1). Not less than seventy-two (72) hours prior to the conference, *excluding* weekends and holidays, the party seeking relief shall file a letter with the Court, not to exceed four (4) pages, in no less than 12 point font, outlining the issues in dispute and its position on those issues. Not less than forty-eight (48) hours prior to the conference, *excluding* weekends and holidays, any party opposing the application for relief may file a letter, not to exceed four (4) pages, in no less than 12 point font, outlining that party’s reason for its opposition.

(2). Attachments/Exhibits: Generally, there should be limited attachments or exhibits to the letters. For example, in a protective order dispute, only the provisions at issue should be attached. Similarly, regarding interrogatory/request for production issues, only the disputed interrogatory or request for production and the responses as they exist at the time of the letter submissions should be attached.³

¹ To meet the import of that phrase, counsel, including Delaware counsel, are expected to *verbally* discuss the issues/concerns before seeking the Court’s intervention.

² The suggested text for this motion can be found on the Court’s website in the “Forms” tab, under the heading “Discovery Matters—Motion to Resolve Discovery Disputes.”

³ The history through emails, letters and meet-and-confers resulting in modification of the original interrogatory or request for production shall not be attached. If the interrogatory or request for production is modified to which an objection remains, only the modified interrogatory/request for production and the answer/response shall be attached, and only the current positions of the parties shall be reflected in the letter submissions.

(3). To the extent factual issues are disputed or central to the Court's analysis,⁴ *non-conclusory*, sworn declarations, *only to the extent necessary* to establish the facts, shall be attached as exhibit(s).

(4). A proposed order, attached as an exhibit, setting out in detail the nature of the relief requested, including the date by which the requested relief is to be completed.

The same procedure outlined above shall apply to protective order drafting disputes, except a "Joint Motion for Teleconference To Resolve Protective Order Dispute," shall be filed and the parties are limited to a total of three (3) issues with one submission each. The submissions shall include the party's proposal of the content for the disputed portion(s) of the protective order.

Should the Court find further briefing necessary upon conclusion of the telephonic conference, the Court will order it. Disputes or issues covered by the provisions contained herein regarding motions for extension of time for briefing case dispositive motions which are related to discovery matters are to be addressed in the first instance in accordance with this paragraph.

No motions to compel or motions for protective order shall be filed absent approval of the Court. Absent expressed approval of the Court following a discovery conference, no motions pursuant to FED. R. CIV. P. 37 shall be filed.

Counsel shall provide a list of the teleconference participants, either by including the list on a separate page with the letters, or fax to Chambers at 302-573-6445 at the same time the

⁴ For example, matters addressing attorney-client privilege, work product doctrine, common interest doctrine, sufficiency of privilege log and other similar issues often involve factual evidence for which affidavits may be required. *See RCA v. Data General*, C.A. No. 84-270-JJF, 1986 WL 15693 (D. Del. July 2, 1986); *Willemijn Houdstermaatschaap v. Apollo Computers, Inc.*, 707 F. Supp. 1429 (D. Del. 1989).

letters are efiled. If the list is included with the letters, it will not be counted as part of the page limitation for the letter submission.

(f) Fact Witnesses to be Called at Trial. Within ten (10) days following the close of expert discovery, the parties shall exchange a list containing each fact witness previously disclosed during discovery, including any expert witness who is also expected to provide fact testimony, whom it intends to call at trial. Within ten (10) days of this exchange, the parties shall exchange a list of each rebuttal fact witness whom it intends to call at trial. Parties shall have the right to depose any such fact witness not previously deposed in this case. Any deposition shall be held within twenty-one (21) days of the exchange of the rebuttal list and shall be limited to twenty (20) hours per side in the aggregate, unless extended by agreement or by order of the Court upon good cause shown.

4. Application to Court for Protective Order. Should counsel find it will be necessary to apply to the Court for a protective order specifying terms and conditions for the disclosure of confidential information, counsel should confer and attempt to reach an agreement on a proposed form of order and submit it to the Court within thirty (30) days from the date of this Order. Should counsel be unable to reach an agreement on a proposed form of protective order, the Default Discovery Confidentiality Order shall control. Absent agreement among the parties, the Default Standard of Access to Source Code shall control.

Any proposed protective order should include the following paragraph:

Other Proceedings. By entering this order and limiting the disclosure of information in this litigation, the Court does not intend to preclude another court from finding that information relevant and subject to disclosure in another case. Any person or party subject to this order who in other proceedings becomes subject to a motion to disclose another party's information designated "confidential" [the parties should list any other level of designation, such as "highly confidential," which may be provided

for in the protective order] pursuant to this order shall promptly notify that party of the motion so that party may have an opportunity to appear and be heard in the other proceeding.

5. Papers Filed Under Seal. When filing papers under seal, counsel should deliver to the Clerk an original and one copy of the papers.

6. ADR Process. To be discussed during the Rule 16 conference.

7. Interim Status Report. On September 7, 2018, counsel shall submit a joint interim report to the Court on the nature of the matters in issue and the progress of discovery to date.

8. Status Conference. On September 14, 2018 the Court will hold a Rule 16(a), (b) and (c) conference by telephone with counsel beginning at 10:30^{AM}. Plaintiff's counsel shall initiate the telephone call. At the time of this conference, counsel shall also be prepared to discuss the progress, if any, of settlement discussions and shall be prepared to discuss the possibility of setting up a settlement conference with the Court, counsel and their clients.

If all parties agree that there is nothing to report, nor anything to add to the interim status report or to this order, they shall notify the Court in writing before the conference is scheduled to occur, and the conference will be taken off of the Court's calendar.

9. Tutorial Describing the Technology and Matters in Issue. If the parties believe that a tutorial on the technology would be helpful, they may provide the Court by September 21, 2018 with a tutorial on the technology at issue. In that regard, each party may submit a videotape/CD of not more than 30 minutes. The parties may choose to present the tutorial in person. In either event, the tutorial should focus on the technology in issue and should not be used to argue the parties' claim construction contentions. If the parties choose to file videotapes/CDs, they should be filed under seal as part of the Court's file, subject to any protective order in effect. Each party may comment, in writing (in no more than 5 pages) on the opposing party's videotape/CD tutorial. Any such comment shall be filed within five business

(5) days of submission of the videotapes/CDs. As to the format selected, the parties should confirm the Court's technical abilities to access the information contained in the tutorial.

10. Case Dispositive Motions. No case dispositive motions shall be filed without prior authorization of the Court.

11. Claim Construction Issue Identification. If the Court does not find that a limited earlier claim construction would be helpful in resolving the case, on July 6, 2018, the parties shall exchange a list of those claim term(s)/phrase(s) that they believe need construction and their proposed claim construction of those term(s)/phrase(s). This document will not be filed with the court. Subsequent to exchanging that list, the parties will meet and confer to prepare a Joint Claim Construction Chart to be submitted on July 27, 2018. The parties' Joint Claim Construction Chart should identify for the Court the term(s)/phrase(s) of the claim(s) in issue, and should include each party's proposed construction of the disputed claim language with citation(s) only to the intrinsic evidence in support of their respective proposed constructions. A copy of the patent(s) in issue as well as those portions of the intrinsic record relied upon shall be submitted with this Joint Claim Construction Chart. In this joint submission, the parties shall not provide argument.

12. Claim Construction. Counsel must identify during the claim construction phase of the case any claim language that will have a meaning to a person of ordinary skill in the art that differs from the ordinary meaning. Any language not so identified will be construed according to its ordinary dictionary meaning.

The parties shall contemporaneously submit initial briefs on claim construction issues on August 24, 2018. The parties' answering/responsive briefs shall be contemporaneously submitted on September 21, 2018. No reply briefs or supplemental papers on claim construction

shall be submitted without leave of the Court. Local Rule 7.1.3(4) shall control the page limitation for initial (opening) and responsive (answering) briefs.


13. Hearing on Claim Construction. Beginning at ^{11:00}~~9:00~~ ^{A.M.} on October 12, 2018, the Court will hear evidence and argument on claim construction.

14. Applications by Motion. Except as otherwise specified herein, any application to the Court shall be by written motion filed with the Clerk. Unless otherwise requested by the Court, counsel shall not deliver copies of papers or correspondence to Chambers. Any non-dispositive motion should contain the statement required by Local Rule 7.1.1.

15. Pretrial Conference. On August 19, 2019 the Court will hold a Final Pretrial Conference in Chambers with counsel beginning at 9:30 am. Unless otherwise ordered by the Court, the parties should assume that filing the pretrial order satisfies the pretrial disclosure requirement of Federal Rule of Civil Procedure 26(a)(3). The parties shall file with the Court the joint proposed final pretrial order with the information required by the form of Final Pretrial Order which accompanies this Scheduling Order on or before August 12, 2019.

16. Motions in Limine. Motions *in limine* shall not be separately filed. All *in limine* requests and responses thereto shall be set forth in the proposed pretrial order. Each party shall be limited to five *in limine* requests, unless otherwise permitted by the Court. The *in limine* request and any response shall contain the authorities relied upon; each *in limine* request may be supported by a maximum of three pages of argument and may be opposed by a maximum of three pages of argument. If more than one party is supporting or opposing an *in limine* request, such support or opposition shall be combined in a single three (3) page submission, unless otherwise ordered by the Court. No separate briefing shall be submitted on *in limine* requests, unless otherwise permitted by the Court.

17. Trial. This matter is scheduled for a 5-day bench trial beginning at 9:30 a.m. on September 9, 2019 with the subsequent trial days beginning at 9:00 a.m. For the purpose of completing pretrial preparations, counsel should plan on each side being allocated a total of number of hours to present their case.



UNITED STATES MAGISTRATE JUDGE

EXHIBIT B

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

| | | |
|------------------------------|---|-----------------------|
| _____ |) | |
| ELI LILLY AND COMPANY, |) | |
| |) | |
| <i>Plaintiff,</i> |) | |
| |) | |
| v. |) | Civ. No. 17-1293- MSG |
| |) | |
| EAGLE PHARMACEUTICALS, INC., |) | |
| |) | |
| <i>Defendant.</i> |) | |
| _____ |) | |

M. GOLDBERG, J.

OCTOBER 25, 2018

MEMORANDUM OPINION

Plaintiff Eli Lilly & Company (“Lilly”) initiated this patent infringement action pursuant to the Hatch-Waxman Act in response to defendant Eagle Pharmaceuticals, Inc. (“Eagle”) filing a New Drug Application (“NDA”) with the U.S. Food and Drug Administration (“FDA”) seeking approval to manufacture and sell a pemetrexed injection, 25mg/mL, 500 mg vial product (the “NDA Product”) before the expiration of U.S. Patent No. 7,772,209 (“the ’209 patent”). Lilly is the assignee of the ’209 patent. Lilly also makes and sells ALIMTA®, a drug containing pemetrexed disodium that is used for treatment of various types of cancer. Lilly believes that Eagle’s NDA product will be marketed as a competing product to ALIMTA®.

Currently pending is Eagle’s motion for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c). (D.I. 28). I have subject matter jurisdiction over this action pursuant to 28 U.S.C.

§§ 1331 and 1338(a). Venue is proper under 28 U.S.C. §§ 1391 and 1400(b).¹ For the reasons set forth below, I will deny Eagle's motion for judgment on the pleadings.

I. BACKGROUND

A. Procedural History

On August 7, 2017, Eagle advised Lilly that it had submitted NDA No. 209472 to the FDA, seeking to market its own pemetrexed product based on Lilly's ALIMTA®, and that it had submitted a certification pursuant to 21 U.S.C. § 355(b)(2)(A)(iv) that Lilly's '209 patent will not be infringed by the manufacture, use, offer for sale, sale, or importation of Eagle's NDA product, or alternatively, that the '209 patent is invalid. (D.I. 7 at ¶ 1). Lilly then sued Eagle under 35 U.S.C. § 271(e)(2), alleging that the use of Eagle's proposed NDA Product will infringe the '209 patent either literally or under the doctrine of equivalents and that Eagle will induce and contribute to that infringement. (D.I. 1).

Eagle answered Lilly's complaint on October 3, 2017, and asserted counterclaims for, inter alia, declaratory judgment of non-infringement. (D.I. 7). On October 24, 2017, Lilly answered Eagle's counterclaims, denying some of the factual allegations and denying that Eagle was entitled to any relief whatsoever. (D.I. 12). On May 31, 2018, Eagle filed this motion, which has been fully briefed. (D.I. 28; D.I. 35; D.I. 40).

B. The '209 Patent

The '209 Patent has two independent claims, claims 1 and 12, both directed to a method of administering pemetrexed disodium. Claim 1 reads:

¹ On May 18, 2017, Chief Judge D. Brooks Smith of the United States Court of Appeals for the Third Circuit designated me as a visiting judge for the District of Delaware, pursuant to 28 U.S.C. § 292(b), to handle this and other Delaware cases.

A method for administering pemetrexed disodium to a patient in need thereof comprising administering an effective amount of folic acid and an effective amount of a methylmalonic acid lowering agent followed by administering an effective amount of pemetrexed disodium, wherein the methylmalonic acid lowering agent is selected from the group consisting of vitamin B12, hydroxycobalamin, cyano-10-chlorocobalamin, aquocobalamin perchlorate, aquo-10-cobalamin perchlorate, azidocobalamin, cobalamin, cyanocobalamin, or chlorocobalamin.

(D.I. 1-1 at 10:60-65). Claim 12 reads:

An improved method for administering pemetrexed disodium to a patient in need of chemotherapeutic treatment, wherein the improvement comprises:

- a) administration of between about 350 µg and about 1000 µg of folic acid prior to the first administration of pemetrexed disodium;
- b) administration of about 500 µg to about 1500 µg of vitamin B12, prior to the first administration of pemetrexed disodium; and
- c) administration of pemetrexed disodium.

II. STANDARD OF REVIEW

A. Motion for Judgment on the Pleadings

A Rule 12(c) motion will not be granted “unless the movant clearly establishes that no material issue of fact remains to be resolved and that he is entitled to judgment as a matter of law.” *Jablonski v. Pan Am. World Airways, Inc.*, 863 F.2d 289, 290 (3d Cir. 1988). The court must view the facts and inferences to be drawn from the pleadings in the light most favorable to the non-moving party. *Green v. Fund Asset Mgmt., L.P.*, 245 F.3d 214, 220 (3d Cir. 2001); *Janney Montgomery Scott, Inc. v. Shepard Niles, Inc.*, 11 F.3d 399, 406 (3d Cir. 1993). However, the court need not adopt conclusory allegations or statements of law. *In re Gen. Motors Class E Stock Buyout Sec. Litig.*, 694 F. Supp. 1119, 1125 (D. Del. 1988). “The purpose of judgment on the pleadings is to dispose of claims where the material facts are undisputed and judgment can be entered on the competing pleadings and exhibits thereto, and documents

incorporated by reference.” *Venetec Int’l, Inc. v. Nexus Med., LLC*, 541 F. Supp. 2d 612, 617 (D. Del. 2008). “The issue is not whether a plaintiff will ultimately prevail but whether the claimant is entitled to offer evidence to support the claims.” *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1426 (3d Cir. 1997).

B. Infringement

Eagle’s Product is not yet on the market because it has not received final FDA approval (and cannot receive it due to the 30-month stay triggered by this suit). Thus, the inquiry is whether Eagle’s Product would infringe based on the content of its NDA. *See AstraZeneca Pharms. LP v. Apotex Corp.*, 669 F.3d 1370, 1376-77, 79 (Fed. Cir. 2012). It is an act of infringement to submit an NDA “if the purpose of such submission is to obtain approval . . . to engage in the commercial manufacture, use, or sale of a drug . . . claimed in a patent . . . before the expiration of such patent.” 35 U.S.C. § 271(e)(2). The filing of an NDA alone does not prove infringement. *Glaxo, Inc. v. Novopharm, Ltd.*, 110 F.3d 1562, 1570 (Fed. Cir. 1997). Rather, the patentee must show, using “traditional patent infringement analysis,” that “the alleged infringer will likely market an infringing product.” *Id.* at 1569-70; *see also Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1365–66 (Fed. Cir. 2003).

Traditional infringement analysis employs a two-step inquiry. First, the court must construe the asserted claims to ascertain their meaning and scope. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979–81 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996). Second, the trier-of-fact must compare the properly construed claims with the accused infringing product. *Id.* Step one is a question of law, and step two is a question of fact. *Id.* Infringement may be proven under one of two theories: literal infringement or the doctrine of equivalents. *Id.*; *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1582 (Fed. Cir. 1995). Literal infringement

occurs when each element of at least one claim of the patent is found in the alleged infringer's product. *Panduit Corp. v. Dennison Mfg. Co.*, 836 F.2d 1329, 1330 n. 1 (Fed. Cir. 1987). The party asserting infringement has the burden of proof and must meet its burden by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988).

III. DISCUSSION

Eagle argues that its NDA Product cannot literally infringe the '209 patent, because the active pharmaceutical ingredient in its NDA Product is “[p]emetrexed, also known as pemetrexed diacid.” (D.I. 29 at 1-2). The '209 patent requires use of “pemetrexed disodium,” which Eagle claims “is not pemetrexed disodium.” (*Id.* at 2).

According to Lilly, the claims of the '209 patent are not directed to a product, but to a method of administering pemetrexed disodium. (D.I. 35 at 2). Thus, “the question for literal infringement is not whether [Eagle's NDA Product] contains pemetrexed disodium when it is in the vial from the factory, but whether administering [the NDA Product] according to its labeling (the prescribing information for physicians and patient information) is ‘administering pemetrexed disodium’ as that phrase is used in the '209 patent.” (*Id.* at 2-3). Lilly takes the position that it is.

Lilly also argues that administering pemetrexed disodium consists of giving patients an intravenous solution containing pemetrexed and sodium ions, separate from one another. (*Id.* at 1-3). Specifically, ALIMTA® is sold in the form of a solid compound where pemetrexed is ionically bonded to sodium. (*Id.*). Because a solid compound cannot be administered to patients intravenously, ALIMTA® must be dissolved in a liquid solution. (*Id.*). In solution, pemetrexed and sodium separate, or “dissociate,” from each other, and it is pemetrexed—not pemetrexed

disodium—that actually gets into and kills cancer cells. (*Id.*). Lilly claims the evidence will show that administering Eagle’s NDA Product in accordance with its proposed labeling involves administering a solution covered by the ’209 patent.

To resolve the parties’ dispute, I must first determine the scope of the claims in the ’209 patent, including the meaning of “administering pemetrexed disodium.” Questions of claim construction are not suitable for resolution on a Rule 12 motion. *Nalco Co. v. Chem-Mod, LLC*, 883 F.3d 1337, 1349 (Fed. Cir. 2018) (claim construction disputes are “not suitable for resolution on a motion to dismiss”). Accordingly, for the reasons stated, Eagle’s motion for judgment on the pleadings is denied. (D.I. 28). An appropriate order will be entered.

EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

| | | |
|--------------|---|-----------------------|
| [PLAINTIFF], |) | |
| |) | |
| Plaintiff, |) | |
| |) | |
| v. |) | C.A. No. 00-0000 (MN) |
| |) | |
| [DEFENDANT], |) | |
| |) | |
| Defendant. |) | |

[PROPOSED] SCHEDULING ORDER [PATENT, NON-ANDA]

This _____ day of _____, 20____, the Court having conducted an initial Rule 16(b) scheduling conference pursuant to Local Rule 16.1(b), and the parties having determined after discussion that the matter cannot be resolved at this juncture by settlement, voluntary mediation, or binding arbitration;

IT IS HEREBY ORDERED that:

1. Rule 26(a)(1) Initial Disclosures and E-Discovery Default Standard. Unless otherwise agreed to by the parties, the parties shall make their initial disclosures pursuant to Federal Rule of Civil Procedure 26(a)(1) within five (5) days of the date the Court enters this Order. If they have not already done so, the parties are to review the Court’s Default Standard for Discovery, Including Discovery of Electronically Stored Information (“ESI”), which is posted at <http://www.ded.uscourts.gov> (see Other Resources, Default Standard for Discovery) and is incorporated herein by reference.

2. Joinder of Other Parties and Amendment of Pleadings. All motions to join other parties, and to amend or supplement the pleadings, shall be filed on or before [DATE]. Unless otherwise ordered by the Court, any motion to join a party or motion to amend the pleadings shall be made pursuant to the procedures set forth in Paragraphs 8(g) and 9.

3. Application to Court for Protective Order. Should counsel find it will be necessary to apply to the Court for a protective order specifying terms and conditions for the disclosure of confidential information, counsel should confer and attempt to reach an agreement on a proposed form of order and submit it to the Court within ten (10) days from the date the Court enters this Order. Should counsel be unable to reach an agreement on a proposed form of order, counsel must follow the provisions of Paragraph 8(g) below.

Any proposed protective order must include the following paragraph:

Other Proceedings. By entering this order and limiting the disclosure of information in this case, the Court does not intend to preclude another court from finding that information may be relevant and subject to disclosure in another case. Any person or party subject to this order who becomes subject to a motion to disclose another party's information designated "confidential" [the parties should list any other level of designation, such as "highly confidential," which may be provided for in the protective order] pursuant to this order shall promptly notify that party of the motion so that the party may have an opportunity to appear and be heard on whether that information should be disclosed.

4. Papers Filed Under Seal. In accordance with section G of the Revised Administrative Procedures Governing Filing and Service by Electronic Means, a redacted version of any sealed document shall be filed electronically within seven (7) days of the filing of the sealed document.

5. Courtesy Copies. The parties shall provide to the Court two (2) courtesy copies of all briefs and any other document filed in support of any briefs (*i.e.*, appendices, exhibits, declarations, affidavits etc.). This provision also applies to papers filed under seal. All courtesy copies shall be double-sided.

6. ADR Process. This matter is referred to a magistrate judge to explore the possibility of alternative dispute resolution.

7. Disclosures. Absent agreement among the parties, and approval of the Court:

(a) By [DATE], Plaintiff shall identify the accused product(s), including accused methods and systems, and its damages model, as well as the asserted patent(s) that the accused product(s) allegedly infringe(s). Plaintiff shall also produce the file history for each asserted patent.

(b) By [DATE], Defendant shall produce core technical documents related to the accused product(s), sufficient to show how the accused product(s) work(s), including but not limited to non-publicly available operation manuals, product literature, schematics, and specifications. Defendant shall also produce sales figures for the accused product(s).

(c) By [DATE], Plaintiff shall produce an initial claim chart relating each known accused product to the asserted claims each such product allegedly infringes.

(d) By [DATE], Defendant shall produce its initial invalidity contentions for each asserted claim, as well as the known related invalidating references.

(e) By [DATE], Plaintiff shall provide final infringement contentions.

(f) By [DATE], Defendant shall provide final invalidity contentions.

8. Discovery. Unless otherwise ordered by the Court or agreed to by parties, the limitations on discovery set forth in the Federal Rules shall be strictly observed.

(a) Fact Discovery Cut Off. All fact discovery in this case shall be initiated so that it will be completed on or before [DATE].

(b) Document Production. Document production shall be substantially complete by [DATE].

(c) Requests for Admission. A maximum of ___ requests for admission are permitted for each side.

(d) Interrogatories.

i. A maximum of ___ interrogatories, including contention interrogatories, are permitted for each side.

ii. The Court encourages the parties to serve and respond to contention interrogatories early in the case. In the absence of agreement among the parties, contention interrogatories, if filed, shall first be addressed by the party with the burden of proof. The adequacy of all interrogatory answers shall be judged by the level of detail each party provides (*i.e.*, the more detail a party provides, the more detail a party shall receive).

(e) Depositions.

i. Limitation on Hours for Deposition Discovery. Each side is limited to a total of ___ hours of taking testimony by deposition upon oral examination.

ii. Location of Depositions. Any party or representative (officer, director, or managing agent) of a party filing a civil action in this district court must ordinarily be required, upon request, to submit to a deposition at a place designated within this district. Exceptions to this general rule may be made by order of the Court. A defendant who becomes a counterclaimant, cross-claimant, or third-party plaintiff shall be considered as having filed an action in this Court for the purpose of this provision.

(f) Disclosure of Expert Testimony.

i. Expert Reports. For the party who has the initial burden of proof on the subject matter, the initial Federal Rule of Civil Procedure 26(a)(2) disclosure of expert testimony is due on or before [DATE]. The supplemental disclosure to contradict or rebut evidence on the same matter identified by another party is due on or before [DATE]. Reply expert reports from the party with the initial burden of proof are due on or before [DATE]. No other

expert reports will be permitted without either the consent of all parties or leave of the Court. Along with the submissions of the expert reports, the parties shall advise of the dates and times of their experts' availability for deposition.

ii. Expert Report Supplementation. The parties agree they **[will] [will not]** permit expert declarations to be filed in connection with motions briefing (including case-dispositive motions).

iii. Objections to Expert Testimony. To the extent any objection to expert testimony is made pursuant to the principles announced in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993), as incorporated in Federal Rule of Evidence 702, it shall be made by motion no later than the deadline for dispositive motions set forth herein, unless otherwise ordered by the Court. Briefing on such motions is subject to the page limits set out in connection with briefing of case dispositive motions.

iv. Expert Discovery Cut-Off. All expert discovery in this case shall be initiated so that it will be completed on or before **[DATE]**.

(g) Discovery Matters and Disputes Relating to Protective Orders.

i. Any discovery motion filed without first complying with the following procedures will be denied without prejudice to renew pursuant to these procedures.

ii. Should counsel find, after a reasonable effort pursuant to Local Rule 7.1.1 that they are unable to resolve a discovery matter or a dispute relating to a protective order, the parties involved in the discovery matter or protective order dispute shall contact the Court's Judicial Administrator to schedule an argument.

iii. On a date to be set by separate order, generally not less than four (4) days prior to the conference, the party seeking relief shall file with the Court a letter, not to exceed

three (3) pages, outlining the issues in dispute and its position on those issues. On a date to be set by separate order, but generally not less than three (3) days prior to the conference, any party opposing the application for relief may file a letter, not to exceed three (3) pages, outlining that party's reasons for its opposition.

iv. The parties shall provide to the Court two (2) courtesy copies of its discovery letter and any other document filed in support of any letter (*i.e.*, appendices, exhibits, declarations, affidavits etc.). This provision also applies to papers filed under seal. All courtesy copies shall be double-sided.

v. Should the Court find further briefing necessary upon conclusion of the conference, the Court will order it. Alternatively, the Court may choose to resolve the dispute prior to the conference and will, in that event, cancel the conference.

9. Motions to Amend / Motions to Strike.

(a) Any motion to amend (including a motion for leave to amend) a pleading or any motion to strike any pleading or other document shall be made pursuant to the discovery dispute procedure set forth in Paragraph 8(g) above.

(b) Any such motion shall attach the proposed amended pleading as well as a “redline” comparison to the prior pleading or attach the document to be stricken.

10. Technology Tutorials. Although technology tutorials are not required by the Court, they are appreciated and, if any party chooses to file such a tutorial, it shall be submitted on or before the date that the Joint Claim Construction Brief is filed.

11. Claim Construction Issue Identification. On [DATE], the parties shall exchange a list of those claim term(s)/phrase(s) that they believe need construction and their proposed claim construction of those term(s)/phrase(s). This document will not be filed with the Court. Subsequent

to exchanging that list, the parties will meet and confer to prepare a Joint Claim Construction Chart to be submitted two weeks prior to service of the opening claim construction brief. The parties' Joint Claim Construction Chart should identify for the Court the term(s)/phrase(s) of the claim(s) in issue, and should include each party's proposed construction of the disputed claim language with citation(s) only to the intrinsic evidence in support of their respective proposed constructions. Intrinsic evidence (including copies of the patent(s) at issue) shall NOT be attached to the joint claim construction chart and, instead, the parties shall include a joint appendix with the joint claim construction brief, and the joint appendix shall include a copy of the patent(s) at issue and portions of all relevant intrinsic evidence that would have otherwise been included with the joint claim construction chart, as well as any additional evidence cited in the parties' briefing.

12. Claim Construction Briefing. The Plaintiff shall serve, but not file, its opening brief, not to exceed 20 pages, on [DATE]. The Defendant shall serve, but not file, its answering brief, not to exceed 30 pages, on [DATE]. The Plaintiff shall serve, but not file, its reply brief, not to exceed 20 pages, on [DATE]. The Defendant shall serve, but not file, its sur-reply brief, not to exceed 10 pages, on [DATE]. No later than [DATE], the parties shall file a Joint Claim Construction Brief. The parties shall copy and paste their unfiled briefs into one brief, with their positions on each claim term in sequential order, in substantially the form below. If the joint brief as submitted is more than 80 pages, the parties must certify that the page limits (or equivalent word counts) in the Scheduling Order have been complied with and provide a brief explanation (e.g., formatting issues, listing of agreed-upon terms) as to why the brief is longer than 80 pages.

JOINT CLAIM CONSTRUCTION BRIEF

I. Agreed-Upon Constructions

II. Disputed Constructions

[TERM 1]

1. Plaintiff's Opening Position
2. Defendant's Answering Position
3. Plaintiff's Reply Position
4. Defendant's Sur-Reply Position

[TERM 2]

1. Plaintiff's Opening Position
2. Defendant's Answering Position
3. Plaintiff's Reply Position
4. Defendant's Sur-Reply Position

The parties need not include any general summaries of the law relating to claim construction. If there are any materials that would be submitted in an index, the parties shall submit them in a Joint Appendix.

13. Hearing on Claim Construction. Beginning at _____ on [DATE], the Court will hear argument on claim construction. The parties need not include any general summaries of the law relating to claim construction in their presentations to the Court. The parties shall notify the Court, by joint letter submission, no later than the date on which their joint claim construction brief is filed: (i) whether they request leave to present testimony at the hearing; and (ii) the amount of time they are requesting be allocated to them for the hearing.

Provided that the parties comply with all portions of this Scheduling Order, and any other orders of the Court, the parties should anticipate that the Court will issue its claim construction

order within sixty (60) days of the conclusion of the claim construction hearing. If the Court is unable to meet this goal, it will advise the parties no later than sixty (60) days after the conclusion of the claim construction hearing.

14. Supplementation. Absent agreement among the parties, and approval of the Court, no later than [DATE] the parties must finally supplement, *inter alia*, the identification of all accused products and of all invalidity references.

15. Case Dispositive Motions.

(a) All case dispositive motions, an opening brief, and affidavits, if any, in support of the motion shall be served and filed on or before [DATE] [a date approximately four months prior to the pretrial conference, the four months being calculated from the conclusion of the briefing]. Briefing will be presented pursuant to the Court's Local Rules. No case dispositive motion under Rule 56 may be filed more than ten (10) days before the above date without leave of the Court.

(b) Concise Statement of Facts Requirement. Any motion for summary judgment shall be accompanied by a separate concise statement, not to exceed six (6) pages, which details each material fact which the moving party contends is essential for the Court's resolution of the summary judgment motion (not the entire case) and as to which the moving party contends there is no genuine issue to be tried. Each fact shall be set forth in a separate numbered paragraph and shall be supported by specific citation(s) to the record.

Any party opposing the motion shall include with its opposing papers a response to the moving party's concise statement, not to exceed six (6) pages, which admits or disputes the facts set forth in the moving party's concise statement on a paragraph-by-paragraph basis. To the extent a fact is disputed, the basis of the dispute shall be supported by specific citation(s) to the

record. Failure to respond to a fact presented in the moving party's concise statement of facts shall indicate that fact is not in dispute for purposes of summary judgment. The party opposing the motion may also include with its opposing papers a separate concise statement, not to exceed four (4) pages, which sets forth material facts as to which the opposing party contends there is a genuine issue to be tried. Each fact asserted by the opposing party shall also be set forth in a separate numbered paragraph and shall be supported by specific citation(s) to the record.

The moving party shall include with its reply papers a response to the opposing party's concise statement of facts, not to exceed four (4) pages, on a paragraph-by-paragraph basis. Failure to respond to a fact presented in the opposing party's concise statement of facts shall indicate that fact remains in dispute for purposes of summary judgment.

(c) Page limits combined with Daubert motion page limits. Each party is permitted to file as many case dispositive motions as desired provided, however, that each ***SIDE*** will be limited to a combined total of 40 pages for all opening briefs, a combined total of 40 pages for all answering briefs, and a combined total of 20 pages for all reply briefs regardless of the number of case dispositive motions that are filed. In the event that a party files, in addition to a case dispositive motion, a Daubert motion to exclude or preclude all or any portion of an expert's testimony, the total amount of pages permitted for all case dispositive and Daubert motions shall be increased to 50 pages for all opening briefs, 50 pages for all answering briefs, and 25 pages for all reply briefs for each ***SIDE***.¹

¹ The parties must work together to ensure that the Court receives no more than a *total* of 250 pages (*i.e.*, 50 + 50 + 25 regarding one side's motions, and 50 + 50 + 25 regarding the other side's motions) of briefing on all case dispositive motions and *Daubert* motions that are covered by this scheduling order and any other scheduling order entered in any related case that is proceeding on a consolidated or coordinated pretrial schedule.

16. Applications by Motion. Except as otherwise specified herein, any application to the Court shall be by written motion. Any non-dispositive motion should contain the statement required by Local Rule 7.1.1.

17. Motions in Limine. Motions *in limine* shall not be separately filed. All *in limine* requests and responses thereto shall be set forth in the proposed pretrial order. Each *SIDE* shall be limited to three (3) *in limine* requests, unless otherwise permitted by the Court. The *in limine* request and any response shall contain the authorities relied upon; each *in limine* request may be supported by a maximum of three (3) pages of argument, may be opposed by a maximum of three (3) pages of argument, and the side making the *in limine* request may add a maximum of one (1) additional page in reply in support of its request. If more than one party is supporting or opposing an *in limine* request, such support or opposition shall be combined in a single three (3) page submission (and, if the moving party, a single one (1) page reply), unless otherwise ordered by the Court. No separate briefing shall be submitted on *in limine* requests, unless otherwise permitted by the Court.

18. Pretrial Conference. On [DATE], the Court will hold a pretrial conference in Court with counsel beginning at _____. Unless otherwise ordered by the Court, the parties should assume that filing the pretrial order satisfies the pretrial disclosure requirement of Federal Rule of Civil Procedure 26(a)(3). The parties shall file with the Court the joint proposed final pretrial order in compliance with Local Rule 16.3(c) and the Court's Preferences and Procedures for Civil Cases not later than seven (7) days before the pretrial conference. Unless otherwise ordered by the Court, the parties shall comply with the timeframes set forth in Local Rule 16.3(d)(1)-(3) for the preparation of the joint proposed final pretrial order.

The parties shall provide the Court two (2) double-sided courtesy copies of the joint proposed final pretrial order and all attachments. The proposed final pretrial order shall contain a table of contents and the paragraphs shall be numbered.

19. Jury Instructions, Voir Dire, and Special Verdict Forms. Where a case is to be tried to a jury, pursuant to Local Rules 47.1(a)(2) and 51.1 the parties should file (i) proposed voir dire, (ii) preliminary jury instructions, (iii) final jury instructions, and (iv) special verdict forms seven (7) business days before the final pretrial conference. This submission shall be accompanied by a courtesy copy containing electronic files of these documents, in Microsoft Word format, which may be submitted by e-mail to mn_civil@ded.uscourts.gov.

20. Trial. This matter is scheduled for a ___ day jury trial beginning at 9:30 a.m. on [DATE], with the subsequent trial days beginning at 9:00 a.m. Until the case is submitted to the jury for deliberations, the jury will be excused each day at 4:30 p.m. The trial will be timed, as counsel will be allocated a total number of hours in which to present their respective cases.

21. Judgment on Verdict and Post-Trial Status Report. Within seven (7) days after a jury returns a verdict in any portion of a jury trial, the parties shall jointly submit a form of order to enter judgment on the verdict. At the same time, the parties shall submit a joint status report, indicating among other things how the case should proceed and listing any post-trial motions each party intends to file.

22. Post-Trial Motions. Unless otherwise ordered by the Court, all **SIDES** are limited to a maximum of 20 pages of opening briefs, 20 pages of answering briefs, and 10 pages of reply briefs relating to any post-trial motions filed by that side, no matter how many such motions are filed.

The Honorable Maryellen Noreika
United States District Judge

EXHIBIT D

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CG TECHNOLOGY DEVELOPMENT, LLC,
INTERACTIVE GAMES LIMITED, and
INTERACTIVE GAMES LLC,
Plaintiffs,

v.

FANDUEL, INC.,

Defendant.

Civil Action No. 1:17-cv-01041-RGA

MEMORANDUM OPINION

Daniel M. Silver, Alexandra M. Joyce, MCCARTER & ENGLISH, LLP, Wilmington, DE;
Robert F. Shaffer (argued), Scott A. Allen, Abdul Ghani S. Hamadi, FINNEGAN,
HENDERSON, FARABOW, GARRETT & DUNNER, LLP, Washington, DC;

Attorneys for Plaintiffs

Kenneth L. Dorsney, MORRIS JAMES LLP, Wilmington, DE; Eric A. Buresh, Megan J.
Redmond (argued), Carrie A. Bader, ERISE IP, P.A., Overland Park, KS;

Attorneys for Defendant

March 5, 2020



ANDREWS, U.S. DISTRICT JUDGE:

Before the Court is Defendant's Rule 12(c) Motion for Judgment on the Pleadings. (D.I. 340). The Court has considered the parties' briefing. (D.I. 341, 348, 350). The Court heard oral argument on February 13, 2020. (D.I. 374).

I. BACKGROUND

Plaintiffs filed this action on April 8, 2016 in the District of Nevada, eventually alleging infringement of twelve patents including U.S. Patent No. 8,771,058 ("the '058 patent"). (D.I. 31). The District of Nevada transferred the instant case to this Court on July 27, 2017. (D.I. 219). Defendant has been successful at invalidating asserted claims. (D.I. 341 at 1). Claim 6 of the '058 patent is the only remaining claim at issue.

The '058 patent is directed to determining game configurations on a mobile device based on the location of that device. ('058 patent, Abstract, col. 12:22-28, col. 60:2-28). Claim 6 is dependent on claim 1. The Patent Trial and Appeal Board found claim 1 invalid under § 103. (D.I. 341, Ex. A at 48). Claim 1 reads as follows:

1. A method comprising:
 - determining a first location of a mobile gaming device;
 - determining a first game configuration associated with the first location;
 - generating, by a computer system, a first game outcome using the first game configuration;
 - instructing a display screen of the mobile gaming device to display an indication of the first game outcome;
 - determining a first payout associated with the first game outcome;
 - crediting a player account with a first amount based on the first payout;
 - determining a second location of the mobile gaming device, wherein the second location is different from the first location;
 - determining a second game configuration associated with the second location, wherein the second game configuration is different from the first game configuration;
 - generating, by the computer system, a second game outcome using the second game configuration;
 - instructing the display screen of the mobile gaming device to display an indication of the second game outcome;
 - determining a second payout associated with the second game outcome; and

crediting the player account with a second amount based on the second payout.

Claim 6 reads:

6. The method of 1, in which determining the first game configuration includes: accessing a lookup table which contains an ordered list of locations and associated game configurations; finding within the lookup table the first location; and determining that the first game configuration is associated with the first location.

At claim construction, I determined that “lookup table” means “an array or matrix of data that contains items that are searched.” (D.I. 337 at 4).

II. LEGAL STANDARD

A. Rule 12(c)

A motion for judgment on the pleadings under Federal Rule of Civil Procedure 12(c) is reviewed under the same standard as a Rule 12(b)(6) motion to dismiss when the Rule 12(c) motion alleges that the plaintiff failed to state a claim upon which relief can be granted. *See Turbe v. Gov't of the Virgin Islands*, 938 F.2d 427, 428 (3d Cir. 1991); *Revell v. Port Auth.*, 598 F.3d 128, 134 (3d Cir. 2010). The court must accept the factual allegations in the complaint and take them in the light most favorable to the non-moving party. *See Erickson v. Pardus*, 551 U.S. 89, 94 (2007); *Christopher v. Harbury*, 536 U.S. 403, 406 (2002). “When there are well-ple[d] factual allegations, a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief.” *Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009). The court must “draw on its judicial experience and common sense” to make the determination. *See id.* In ruling on a motion for judgment on the pleadings, the court is generally limited to the pleadings. *Mele v. Fed. Reserve Bank of N.Y.*, 359 F.3d 251, 257 (3d Cir. 2004). The court may, however, consider documents incorporated into the pleadings and those that are in the public record. *Pension Ben. Guar. Corp. v. White Consol. Indus., Inc.*, 998 F.2d 1192, 1196 (3d Cir. 1993).

B. 35 U.S.C. § 101

Section 101 of the Patent Act defines patent-eligible subject matter. It provides:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has recognized an implicit exception for three categories of subject matter not eligible for patentability—laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The purpose of these carveouts is to protect the “basic tools of scientific and technological work.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012). “[A] process is not unpatentable simply because it contains a law of nature or a mathematical algorithm,” as “an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Id.* at 1293–94 (cleaned up). “[T]o transform an unpatentable law of nature into a patent-eligible application of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Id.* at 1294 (emphasis omitted).

The Supreme Court reaffirmed the framework laid out in *Mayo* “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. First, the court must determine whether the claims are drawn to a patent-ineligible concept. *Id.* If the answer is yes, the court must look to “the elements of the claim both individually and as an ‘ordered combination’” to see if there is an “‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original). “A claim that

recites an abstract idea must include ‘additional features’ to ensure that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].” *Id.* at 2357. Further, “the prohibition against patenting abstract ideas cannot be circumvented by attempting to limit the use of [the idea] to a particular technological environment.” *Id.* at 2358 (quoting *Bilski v. Kappos*, 561 U.S. 593, 610-11 (2010)). Thus, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* For this second step, the machine-or-transformation test can be a “useful clue,” although it is not determinative. *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014).

“Whether a claim is drawn to patent-eligible subject matter under § 101 is an issue of law,” and “is a matter of both claim construction and statutory construction.” *In re Bilski*, 545 F.3d 943, 951 (Fed. Cir. 2008), *aff’d sub nom. Bilski v. Kappos*, 561 U.S. 593 (2010). “Claim construction is a question of law” *In re Nuijten*, 500 F.3d 1346, 1352 (Fed. Cir. 2007). At *Alice* step two, however, “[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

III. DISCUSSION

A. Law of the Case

“The law-of-the-case doctrine generally provides that when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case.” *Musacchio v. United States*, 136 S. Ct. 709, 716 (2016) (cleaned up). Plaintiffs argue that the law-of-the-case doctrine applies here because the Nevada court already decided that the claims of the ’058 patent are not directed to a patent-ineligible abstract idea. (D.I. 348 at 1). Plaintiffs

contend that this should end the § 101 analysis and that I should deny Defendant's motion without further consideration. (*Id.*).

In Plaintiffs' associated case against Bwin.Party, the Nevada court determined that representative claim 19 of the '058 patent was not abstract and therefore denied Bwin.Party's motion to dismiss under § 101 ("Nevada I"). *CG Tech. Dev., LLC v. Bwin.Party (USA), Inc.*, 2016 WL 6089696, at *4-5 (D. Nev. Oct. 18, 2016). Plaintiffs argue that because the instant case was consolidated with the *Bwin.Party* case, this Court is bound by the Nevada I decision. (D.I. 348 at 2). I do not agree. The Nevada court consolidated the related cases for pretrial purposes after it issued the Nevada I decision. *See CG Tech. Dev., LLC v. FanDuel, Inc.*, Case No. 2:16-cv-00801-RCJ-VCF, D.I. 92 (D. Nev. Dec. 12, 2016). That consolidation does not mean a previous decision in one case (*Bwin.Party*) retroactively applies to the other consolidated cases.

Plaintiffs further argue that because, after the consolidation, the Nevada court again determined that claim 19 was not abstract ("Nevada II"), the consolidated cases are therefore bound by that decision. (D.I. 374 at 32:12-17). This argument fails because of the posture of the Nevada II decision, which denied Bwin.Party's motion for reconsideration of the Nevada I decision. *CG Tech. Dev., LLC v. Bwin.Party (USA), Inc.*, Case No. 2:16-cv-00871-RCJ-VCF, D.I. 63 (D. Nev. Jan. 4, 2017). In the Nevada II decision, the district court affirmed its Nevada I decision that denied Bwin.Party's motion to dismiss under § 101. *Id.* The Nevada II decision did not address any of the consolidated cases or mention that the *Bwin.Party* case had been consolidated with others in the interim period. *Id.* The Nevada II decision was not entered on the consolidated docket, but rather on that of the *Bwin.Party* case. Neither the Nevada I decision

nor the Nevada II decision are part of the “same case” as the instant case. The law-of-the-case doctrine does not apply.

B. Abstract Idea

To distinguish patents that claim ineligible concepts “from those that claim patent-eligible applications of those concepts . . . we [first] determine whether the claims at issue are directed to [an abstract idea].” *Alice*, 134 S. Ct. at 2355. “The ‘abstract ideas’ category embodies ‘the longstanding rule that an idea of itself is not patentable.’” *Id.* (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). “The Supreme Court has not established a definitive rule to determine what constitutes an ‘abstract idea’ sufficient to satisfy the first step of the *Mayo/Alice* inquiry.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016). The Supreme Court has recognized, however, that “fundamental economic practice[s],” *Bilski*, 561 U.S. at 611, “method[s] of organizing human activity,” *Alice*, 134 S. Ct. at 2356, and mathematical algorithms, *Benson*, 409 U.S. at 64, are abstract ideas. In navigating the parameters of such categories, courts have generally sought to “compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334. “[S]ome improvements in computer-related technology when appropriately claimed are undoubtedly not abstract.” *Id.* at 1335. “[I]n determining whether the claims are directed to an abstract idea, we must be careful to avoid oversimplifying the claims because ‘[a]t some level, all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (alterations in original) (quoting *Alice*, 134 S. Ct. at 2354).

Defendant asserts that claim 6 of the ’058 patent is directed to an abstract idea because it “falls within the category of ‘method[s] of organizing human activity.’” (D.I. 341 at 4).

Plaintiffs respond that claim 6 is not abstract because it is a specific improvement of the “operation of a mobile gaming device and the way it displays game configurations to an end user.” (D.I. 348 at 8). For the following reasons, I determine that claim 6 of the ’058 patent is directed to the abstract idea of “determining game configuration based on location.”

Claim 6 of the ’058 patent is a method claim that depends on independent claim 1. The method embodies the basic concept of determining game configuration based on the location of a mobile device. The steps of the method can be summarized as follows: (1) determining the location of a mobile gaming device (’058 patent, col. 60:3); (2) using a lookup table to determine the game configuration associated with that location (*id.* col. 60:47-51); and (3) implementing that game configuration (*id.* col. 60:6-14). These are basic steps of determining the configuration of a game based on the location of a mobile device, a method of organizing human activity.

Plaintiffs argue that claim 6 is not directed to an abstract idea because it “recites an improvement that alters the operation [of] traditional mobile gaming devices in a very specific way using specific data structures.” (D.I. 348 at 9). To support this argument, Plaintiffs rely on cases where the Federal Circuit has found “similar” inventions non-abstract and patentable. (*Id.*) Plaintiffs point to *Enfish*, where the Federal Circuit determined that claims which focused on “an improvement to computer functionality itself, not on . . . tasks for which a computer is used in its ordinary capacity,” were not abstract under *Alice*. 822 F.3d at 1336. Plaintiffs contend that claim 6 is similar in that it teaches an improvement to a traditional gaming system because it forces the gaming devices to “function differently based on the determined geofencing.” (D.I. 348 at 9). The claims in *Enfish*, however, are not similar to claim 6. In *Enfish*, the claims were “specifically directed to a self-referential table for a computer database”

that is designed to “improve the way a computer stores and retrieves data in memory.” 822 F.3d at 1337, 1339 (emphasis omitted). Rather than improving the function of a computer itself, claim 6 employs a generic data structure, a lookup table, to determine the game configuration associated with a location.

Plaintiffs also rely on *SRI International, Inc. v. Cisco Systems, Inc.*, 930 F.3d 1295 (Fed. Cir. 2019). In that case, the Federal Circuit found the claims, which taught a specific technique of using network monitors to identify intruders into the network, to be “directed to an improvement in computer network technology” and therefore not abstract. *SRI International*, 930 F.3d at 1303. The Federal Circuit distinguished the claims at issue in *SRI International* from those in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016): “The *Electric Power* claims were drawn to using computers as tools to solve a power grid problem, rather than improving the functionality of computers and computer networks themselves” like the claims in *SRI International*. *Id.* at 1304. The claims at issue in *Electric Power* were directed to “[a] method of detecting events on an interconnected electric power grid in real time over a wide area and automatically analyzing the events on the interconnected electric power grid.” *Electric Power*, 830 F.3d at 1351. The Federal Circuit determined that those claims were focused “on the combination of [] abstract-idea processes. The advance [the claims] purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Id.* at 1354. Thus, the Federal Circuit determined that the claims were directed to an abstract idea. *Id.*

Claim 6 is similar to the claims in *Electric Power*, not to those in *SRI International*. Like the *Electric Power* claims, claim 6 is directed to “the combination of [] abstract idea processes.”

Id. Determining the location of a mobile gaming device, determining the game configuration associated with that location, and implementing that game configuration are each “independently abstract ideas that use computers as tools.” *Id.*

Plaintiffs further argue that *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) supports their argument that claim 6 is patentable. (D.I. 348 at 10). In that case, the Federal Circuit held that the claims at issue were directed to a “specific asserted improvement in computer animation.” *McRO*, 387 F.3d at 1314. Because the patent “incorporat[ed] the specific features of the rules as claim limitations,” the Federal Circuit found that the claims were “limited to a specific process for automatically animating characters using particular information and techniques” and were therefore not directed to patent-ineligible subject matter. *Id.* at 1316. Plaintiffs argue that the lookup table of claim 6 is similar “specific structure” to that in *McRO*. (D.I. 348 at 10). I disagree. The “specific structure” in *McRO* was the combined order of the specific, subjective rules that were the means of automating lip synchronization. *McRO*, 387 F.3d at 1315. Claim 6, however, merely uses a generic data structure, a lookup table, “as a tool to automate conventional activity.” *Id.* at 1314. Claim 6 describes searching a data structure in an ordinary fashion to find the game configuration associated with a location.

Therefore, claim 6 of the '058 patent is directed to the abstract idea of “determining game configuration based on location.”

C. Inventive Concept

The decision that a patent is directed to an abstract idea “does not render the subject matter ineligible.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). Having decided that claim 6 is directed to an abstract idea, the Court must next

“determine whether the [claim does] significantly more than simply describe the abstract method.” *Ulramercial*, 772 F.3d at 715. Since “a known idea, or one that is routine and conventional, is not inventive in patent terms,” this analysis “favors inquiries analogous to those undertaken for determination of patentable invention.” *Internet Patents*, 790 F.3d at 1346. Indeed, the Federal Circuit has noted that the two stages of the *Alice* two-step inquiry “are plainly related” and “involve overlapping scrutiny of the content of the claims” *Elec. Power Grp.*, 830 F.3d at 1353. Furthermore, neither “[a] simple instruction to apply an abstract idea on a computer,” nor “claiming the improved speed or efficiency inherent with applying the abstract idea on a computer” satisfies the requirement of an “inventive concept.” *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015); *see also Bancorp Servs., LLC v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”).

Plaintiff argues that claim 6 of the '058 patent has an inventive concept because it provides a solution “to the real-world need to address the implications of differing jurisdictions and their effect on permitted game configurations.” (D.I. 348 at 12-13). At oral argument, Plaintiff pointed to *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) to support the notion that there can be an inventive concept as long as there is a “nonconventional, nonroutine arrangement of what would otherwise be considered conventional and routine limitations.” (D.I. 374 at 38:24, 39:2-7). In *Bascom*, the Federal Circuit determined that the claims at issue contained an inventive concept “in the non-conventional and non-generic arrangement of known, conventional pieces.” *Bascom*, 827 F.3d at 1350. The patent in *Bascom* taught an improvement to internet content filtering that “could be adapted to many different

users' preferences while also installed remotely in a single location.” *Id.* The Federal Circuit determined that the “patent describe[d] how its particular arrangement of elements is a technical improvement over prior art ways of filtering such content” rather than the claims merely instructing that the abstract idea of filtering be carried out by generic computer components. *Id.*

Claim 6 of the '058 patent, however, does not have a “particular arrangement of elements” that creates an inventive concept. The limitations of claim 6 instead teach the basic steps for using a conventional lookup table.

The specification of the '058 patent identifies a lookup table as an “example” of “a computer data structure [that] may be used to keep a record” of game configurations “in different locations.” ('058 patent, col. 6:7-12). At claim construction, the parties agreed that the term “lookup table” has a plain and ordinary meaning understood by those of skill in the art at the time of the patent, which has a priority date of February 15, 2007. (D.I. 337 at 4; D.I. 31-10 at 1). To resolve this meaning, I turned to the definition of “lookup table” in the Computer Desktop Encyclopedia, Version 20.4 (2007). (*Id.*). I determined that “lookup table” means “an array or matrix of data that contains items that are searched.” (*Id.*).¹ The fact that the patent does not specifically define a lookup table but instead refers to it as an example of a data structure that may be used, and the fact that the plain and ordinary meaning of “lookup table” was readily discerned from an encyclopedia entry, demonstrate that a lookup table is a conventional and well-known data structure. A lookup table itself is not an inventive concept.

In claim 6, the lookup table is also used in a conventional way; it is searched to find the game configuration associated with a location. Searching a lookup table used to store game configurations associated with locations is not an inventive concept sufficient to transform a

¹ This usage is similar to that in the 2002 Microsoft Computer Dictionary (D.I. 306-1 at 419 of 445): “a previously constructed table of values.”

patent-ineligible abstract idea into an eligible one. See *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290–91 (Fed. Cir. 2018) (“If a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.”); *Berkheimer*, 881 F.3d at 1370 (holding that the claim limitations “amount to no more than performing the abstract idea of parsing and comparing data with conventional computer components” and thus lacked an inventive concept). Thus, viewed separately or as an ordered combination, the elements of claim 6 do not recite an inventive concept, and cannot transform the abstract idea into a patent-eligible application.

IV. CONCLUSION

Defendant gambled with a Rule 12(c) motion and won the jackpot. For the foregoing reasons, the Court GRANTS Defendant’s Motion for Judgment on the Pleadings (D.I. 340). An accompanying order will issue.