

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

In re: OXYCONTIN ANTITRUST LITIGATION

PURDUE PHARMA L.P., THE P.F.
LABORATORIES, INC., PURDUE
PHARMACEUTICALS L.P., RHODES
TECHNOLOGIES, and GRÜNENTHAL
GMBH,

Plaintiffs,

-against-

AMNEAL PHARMACEUTICALS, LLC,
Defendant.

PURDUE PHARMA L.P., THE P.F.
LABORATORIES, INC., PURDUE
PHARMACEUTICALS L.P., and
RHODES TECHNOLOGIES,

Plaintiffs,

-against-

MYLAN PHARMACEUTICALS INC. and
MYLAN INC.,

Defendants.

PURDUE PHARMA L.P., THE P.F.
LABORATORIES, INC., PURDUE
PHARMACEUTICALS L.P., and
RHODES TECHNOLOGIES,

Plaintiffs,

-against-

EPIC PHARMA, LLC,

Defendant.

04 Md. 1603 (SHS)

ORDER

This document relates to:

11 Civ. 8153 (SHS)

12 Civ. 2959 (SHS)

13 Civ. 683 (SHS)

SIDNEY H. STEIN, U.S. District Judge.

In the above-captioned actions, plaintiffs claim that defendants have infringed a variety of patents. In *Purdue Pharma L.P. et al. v. Amneal Pharms., LLC*, Case No. 11 Civ. 8153, plaintiffs allege infringement of four patents: U.S. Patent No. 7,674,799; U.S. Patent No. 7,647,800; and U.S. Patent No. 7,683,072 (collectively, “the Low-ABUK Patents”); as well as U.S. Patent No. 7,776,314 (“the ‘314 Patent”). (See Compl. ¶ 23.) In *Purdue Pharma L.P. et al. v. Mylan Pharms. Inc. et al.*, Case No. 12 Civ. 2959, plaintiffs allege infringement of the three Low-ABUK Patents. (See Compl. ¶ 23.) In *Purdue Pharma L.P. et al. v. Epic Pharma, LLC*, Case No. 13 Civ. 683, plaintiffs again allege infringement of the three Low-ABUK Patents. (See Compl. ¶ 19.)

On January 14, 2014, this Court issued findings of fact and conclusions of law in *Purdue Pharma L.P. et al. v. Teva Pharms., USA, Inc.*, Case Nos. 11 Civ. 2037 and 12 Civ. 5083. (See Case No. 04 Md. 1603, Dkt. No. 634.) The Court held, inter alia, that the Low-ABUK Patents and the ‘314 Patent are invalid. On the same day, the Court ordered plaintiffs to show cause “why they are not collaterally estopped from asserting the Low-ABUK Patents and why the Court should not dismiss all claims in these litigations that rely on the Low-ABUK Patents.” (Case No. 04 Md. 1603, Dkt. No. 635.)

Plaintiffs responded in a submission dated January 24 that although they intend to appeal the *Teva* decision, they “agree[] that collateral estoppel based on the *Teva* decision precludes Plaintiffs’ claims for relief” in the three-above captioned actions. (See Case No. 04 Md. 1603, Dkt. No. 638 at 1.)

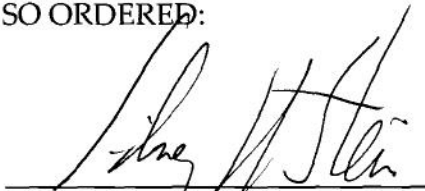
Although the order to show cause referred only to the Low-ABUK Patents, plaintiffs recognize that collateral estoppel applies with equal force to the ‘314 Patent. (See *id.* (conceding that all claims for relief in “the 2011 *Amneal* action” — which asserts both the Low-ABUK Patents and the ‘314 Patent — are precluded).) Plaintiffs are correct. With respect to the ‘314 Patent, the Court decided the *Teva* actions in the defendant’s favor on alternative grounds: (1) that the defendant did not infringe the ‘314 Patent and (2) that, in any event, the ‘314 Patent is invalid. (See Case No. 04 Md. 1603, Dkt. No. 634, at 98, 106.) “The general rule in [the Second] Circuit is that ‘if a court decides a case on two grounds, each is good estoppel.’” *Gelb v. Royal Globe Ins. Co.*, 798 F.2d 38, 45 (2d Cir. 1986) (quoting *Irving Nat’l*

Bank v. Law, 10 F.2d 721, 724 (2d Cir. 1926)); see *Purdy v. Zeldes*, 337 F.3d 253, 258 n.6 (2d Cir. 2003).¹

Because the Court found in *Purdue Pharma L.P. et al. v. Teva Pharms., USA, Inc.*, Case Nos. 11 Civ. 2037 and 12 Civ. 5083, that the Low-ABUK Patents and the '314 Patent are invalid (see Case No. 04 Md. 1603, Dkt. No. 634), plaintiffs are precluded from arguing that those patents are valid in the above-captioned actions. The Court therefore directs that the above-captioned actions be dismissed.

Dated: New York, New York
January 29, 2014

SO ORDERED:



Sidney H. Stein, U.S.D.J.

¹ The above-captioned actions recite patent claims within the exclusive appellate jurisdiction of the U.S. Court of Appeals for the Federal Circuit. However, "the application of general collateral estoppel principles . . . is not a matter within the exclusive jurisdiction of [that] court." *Pharmacia & Upjohn v. Mylan Pharms.*, 170 F.3d 1373, 1381 (Fed. Cir. 1999). Rather, the applicable law is "the law of the circuit in which the district court [] sits." *Id.*