

## BD Wins Ruling Over Two Abbott Glucose Strip Patents

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*Monday, Apr 07, 2008* --- A federal judge has ruled that Becton Dickinson and Co. did not infringe two Abbott Laboratories patents for blood-glucose test strips, but infringement claims regarding two other patents can move forward.

U.S. District Judge Martin J. Jenkins of the Northern District of California also held in his Thursday ruling that Abbott's infringement claims regarding one of the test-strip patents could be asserted against Bayer Healthcare LLC and BD under the doctrine of equivalents. The judge denied Roche Diagnostics Corp.'s bid for summary judgment of noninfringement of another patent.

Abbott had filed four different lawsuits in the California court, alleging that Becton Dickinson and Nova Biomedical Corp., which had respectively sold and manufactured a glucose strip, infringed four patents and Roche Diagnostics Corp. and Bayer Healthcare LLC infringed two. The cases were related for pretrial purposes.

Thursday's order regarded several summary judgment motions claiming the asserted patents were invalid or noninfringed.

Judge Jenkins ruled that Bayer's Microfill and Autodisc strips, as well as BD/Nova strips, did not literally infringe U.S. Patent Number 5,820,551 but held that whether equivalents of the company's accused products infringed the patent was a triable issue.

Judge Jenkins also denied Roche's motion for summary judgment of noninfringement of U.S. Patent Number 6,592,745 through its Aviva system.

Regarding BD/Nova's test strips, which BD no longer markets, the judge granted summary judgment of noninfringement regarding U.S. Patent Number 6,143,164 and the '745 patent.

Judge Jenkins also denied BD/Nova's motion for summary judgment of invalidity regarding U.S. Patent Number 5,638,890 and found that several claims for the '745 patent were anticipated and therefore invalid.

In a separate ruling on Thursday, Judge Jenkins also allowed BD/Nova to add a prior public use defense in their invalidity contentions regarding the '890 patent. The new defense is based on an alleged clinical trial that Abbott conducted in the U.S. in the fall of 1994, which BD/Nova did not learn about

until the end of discovery.

Bradford J. Badke, the lead attorney for BD/Nova in the cases, said he was pleased with the decision.

He said the defendants filed a joint motion to have the cases reassigned to another judge after Judge Jenkins was appointed by Gov. Arnold Schwarzenegger as a justice for California's First District Court of Appeal.

Abbott did not immediately return a request for comment on Monday.

Abbott had previously tangled in the case with Roche and Bayer over a 2003 settlement reached between Abbott and Johnson & Johnson subsidiary LifeScan Inc. to settle a Massachusetts suit.

Roche and Bayer claimed that the deal involved one of the same patents asserted in the California case and could potentially undermine Abbott's lost profits and royalty claims. However, Magistrate Judge Bernard Zimmerman found the settlement was not relevant to the case and denied a motion to compel its discovery.

The California suit isn't the first time the case participants have tangled in court.

In November, Roche Diagnostics Operations Inc. sued Abbott Diabetes Care Inc., Bayer Healthcare LLC, Diagnostic Devices Inc., LifeScan Inc., Nova Biomedical Corp. and Sanvita Inc. of infringing two blood-glucose test-strip patents in the U.S. District Court for the District of Delaware.

Among the allegedly infringing products are Abbott's electrochemical sensor products sold under the FreeStyle, Precision Xtra and Optimum trade names; Bayer's Ascensia Breeze and Ascensia Contour; Diagnostic Devices' Prodigy Advance; LifeScan's OneTouch product line; and products sold under Nova and Sanvita's NovaMax trade name.

The patents in Abbott's lawsuit involve various aspects of the glucose monitoring.

The '551 patent refers to a glucose test strip, used in the process of testing glucose levels in an individual's blood. The patent, titled "Strip electrode with screen printing," was issued in 1998 by the U.S. Patent and Trademark Office to four inventors at MediSense Inc. MediSense was purchased by Abbott in 1998 for nearly \$900 million.

The '745 patent, which protects another complex method of testing glucose levels in vitro, was issued in 2003 to eight inventors at TheraSense Inc., a company that gained notoriety in 2000 with a new form of glucose monitoring. TheraSense was purchased by Abbott for \$1.2 billion in 2004 and merged with MediSense to form Abbott Diabetes Care.

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The patents are U.S. Patent Numbers 5,638,890; 5,820,551; 6,143,164; and 6,592,745.

Abbott is represented in the matter by Baker Botts LLP and Munger Tolles & Olson LLP. BD and Nova are represented by Ropes & Gray LLP. Roche is represented by Kecker & Van Nest LLP and Barnes & Thornburg LLP. Bayer is represented by Morrison & Foerster LLP and Amster Rothstein & Ebenstein.

The case is TheraSense Inc. v. Becton Dickinson and Co., case number 04-cv-21223, in the U.S. District Court for the Northern District of California.