

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND

WARNER CHILCOTT COMPANY, LLC

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Plaintiff,

*

v.

*

Civil Action No.:

LUPIN LIMITED

*

Laxmi Towers, B Wing

Bandra Kurla Complex

*

Bandra (East)

Mumbai, Maharashtra 400 051, India

*

SERVE ON: RESIDENT AGENT

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Sailesh K. Patel, Esquire

Schiff Hardin LLP

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6600 Sears Tower

Chicago, Illinois 60606

*

and

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LUPIN PHARMACEUTICALS, INC.

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Harborplace Tower

111 South Calvert Street, 21st Floor

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Baltimore, Maryland 21202

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SERVE ON: RESIDENT AGENT

*

Vinta Gupta

Harborplace Tower

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111 South Calvert Street, 21st Floor

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Baltimore, Maryland 21202

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Defendants.

* * * * *

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Warner Chilcott Company, LLC, by its undersigned attorneys, brings this action against Defendants Lupin Limited and Lupin Pharmaceuticals, Inc. (collectively “Lupin”), and hereby alleges as follows:

THE PARTIES

1. Plaintiff Warner Chilcott Company, LLC (“Warner Chilcott”) is a corporation organized and existing under the laws of Puerto Rico, having offices at Union St., Road 195, Km 1.1, Fajardo, Puerto Rico.
2. Upon information and belief, Defendant Lupin Limited (“Lupin Ltd.”) is a corporation organized and existing under the laws of India.
3. Upon information and belief, Defendant Lupin Pharmaceuticals, Inc. (“LPI”) is a wholly owned subsidiary of Lupin Ltd. and is a corporation organized and existing under the laws of the Commonwealth of Virginia. LPI has a principal place of business located at 111 S. Calvert Street, 21st Floor, Baltimore, MD 21202.
4. Upon information and belief, Lupin conducts business in the State of Maryland.

JURISDICTION AND VENUE

5. This is an action for patent infringement arising under the patent laws of the United States, Title 35, United States Code. This Court has subject matter jurisdiction over this action based on 28 U.S.C. §§ 1331 and 1338(a).
6. This Court has personal jurisdiction over Lupin by virtue of the fact that Lupin conducts business in the State of Maryland, has availed itself of the rights and benefits of Maryland law, and has engaged in substantial and continuing contacts with the State.
7. To the extent that Lupin Ltd. successfully contends it is not doing business in the State of Maryland, jurisdiction over Lupin Ltd. in Maryland is also proper under Federal Rule of Civil Procedure 4(k)(2).
8. Venue is proper in this Court under 28 U.S.C. §§ 1391(b) and (c) and 28 U.S.C. § 1400(b).

COUNT I
CLAIM FOR INFRINGEMENT OF THE '394 PATENT

9. Warner Chilcott is the holder of New Drug Application (“NDA”) No. 21-871, now sold under the trademark Loestrin® 24 Fe, which contains the active ingredients norethindrone acetate and ethinyl estradiol. Loestrin® 24 Fe was approved by the United States Food and Drug Administration (“FDA”) on February 17, 2006 and is indicated for the prevention of pregnancy in women who elect to use it as a method of contraception. Loestrin® 24 Fe is sold as a 28-day oral contraceptive regimen which includes 24 active tablets comprising 1 mg norethindrone acetate, and 0.02 mg ethinyl estradiol followed by 4 ferrous fumarate tablets (placebo).

10. U.S. Patent No. 5,552,394 (“the ‘394 patent”) entitled “Low Dose Oral Contraceptives with Less Breakthrough Bleeding and Sustained Efficacy” lawfully issued from the United States Patent and Trademark Office on September 3, 1996. A copy of the ‘394 patent is attached as Exhibit A.

11. Warner Chilcott owns the entire right, title and interest in the ‘394 patent.

12. The ‘394 patent relates to a method of female contraception, which comprises *inter alia* monophasically administering a combination comprising 0.02 mg of ethinyl estradiol and 1 mg of norethindrone acetate for 24 days of a 28 day cycle.

13. The ‘394 patent covers the use of Loestrin® 24 Fe in accordance with the labeling approved by the FDA and is listed in the *FDA Approved Drug Products with Therapeutic Equivalence Evaluations* (“the Orange Book”) for that product.

14. Upon information and belief, Lupin submitted to the FDA an Abbreviated New Drug Application (“ANDA”) filed under 21 U.S.C. § 355(j), to obtain approval to engage in the commercial manufacture, use, or sale of a generic version of Loestrin® 24 Fe prior to the expiration of the ‘394 patent.

15. Upon information and belief, Lupin's ANDA directed to its proposed generic Loestrin® 24 Fe product has been assigned No. 91-398.

16. Upon information and belief, the composition that is the subject of Lupin's ANDA is directed to 24 tablets containing 1 mg norethindrone, 0.02 mg ethinyl estradiol and 4 tablets containing ferrous fumarate.

17. Upon information and belief, Lupin's ANDA was submitted with a certification pursuant to 21 U.S.C. § 355(j)(2)(A)(vii)(IV) of the Federal Food, Drug and Cosmetic Act that the '394 patent is purportedly invalid, unenforceable, and/or will not be infringed by the manufacture, use or sale of Lupin's ANDA product.

18. Upon information and belief, Lupin sent notice of that certification to Warner Chilcott on or about July 30, 2009. Warner Chilcott received Lupin's notice letter on or about July 31, 2009.

19. By filing its ANDA under 21 U.S.C. § 355(j), for the purpose of obtaining approval to engage in the manufacture, use or sale of its ANDA product before the expiration of the '394 patent, Lupin has committed an act of infringement pursuant to 35 U.S.C. § 271(e)(2)(A). Further, the manufacture, use or sale of Lupin's proposed ANDA product will also infringe one or more claims of the '394 patent.

20. Upon approval of Lupin's ANDA, Lupin will actively induce and/or contribute to infringement of the '394 patent.

21. Warner Chilcott is entitled to relief provided by 35 U.S.C. § 271(e)(4), including an order from this Court that the effective date of the approval of Lupin's ANDA be a date that is not earlier than the expiration date of the '394 patent, or any later expiration of exclusivity to which Warner Chilcott becomes entitled.

22. This is an exceptional case, and Warner Chilcott is entitled to its costs and reasonable attorney fees.

23. Warner Chilcott has already brought an action on the same claims in the District of Delaware, Civ. Action No. 09-673. Warner Chilcott is filing the instant action as a protective measure. Despite having previously consented to personal jurisdiction in the District of Delaware, Lupin has thus far refused to respond to Warner Chilcott's requests to consent to jurisdiction in Delaware on these claims. Warner Chilcott therefore is filing this second action out of an abundance of caution. Warner Chilcott expects that its first-filed action will proceed in the District of Delaware, in which case this second action would be unnecessary and will be voluntarily dismissed.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests the following relief:

- (a) Judgment that Lupin has infringed one or more claims of the '394 patent by submitting ANDA No. 91-398;
- (b) A permanent injunction be issued restraining and enjoining Defendants Lupin Ltd. and Lupin Pharmaceuticals, Inc., their officers, agents, attorneys, and employees, and those acting in privity or concert with them, and their successors and assigns, from engaging in the commercial manufacture, use, offer to sell, or sale within the United States, or importation into the United States, of compositions that would infringe, induce infringement and/or contribute to infringement of the '394 patent;
- (c) An order that the effective date of any approval of Lupin's ANDA No. 91-398, be a date that is not earlier than the expiration of the '394 patent, or any later expiration of exclusivity to which Plaintiff becomes entitled;

