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**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

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HOFFMANN-LA ROCHE INC.,	:	
	:	
Plaintiff,	:	
	:	
v.	:	Civil Action No. 08-4060 (SRC)(MAS)
	:	
MUTUAL PHARMACEUTICAL	:	<b>FIRST AMENDED COMPLAINT</b>
COMPANY, INC.,	:	
	:	<i>Document electronically filed.</i>
Defendants.	:	
-----	:	
	X	

Plaintiff Hoffmann-La Roche Inc. for its First Amended Complaint against Mutual Pharmaceutical Company, Inc., alleges as follows:

**NATURE OF THE ACTION**

1. This is an action for patent infringement arising under the Food and Drug and Patent Laws of the United States, Titles 21 and 35, respectively. Plaintiff Hoffmann-La Roche Inc. brings this action to enforce its patent rights covering Boniva<sup>®</sup> Ibandronate Sodium 150 mg

tablets, the first bisphosphonate drug approved in the United States for once-monthly dosing to treat osteoporosis. (“Boniva<sup>®</sup> Once-Monthly”).

### **PARTIES**

2. Plaintiff Hoffmann-La Roche Inc. (“Roche”) is a company organized and existing under the laws of the State of New Jersey with its principal place of business at 340 Kingsland Street, Nutley, New Jersey, 07110.

3. On information and belief, Defendant Mutual Pharmaceutical Company, Inc. (“Mutual”) is a Pennsylvania corporation having its corporate offices and principal place of business at 1100 Orthodox Street, Philadelphia, Pennsylvania, 19124.

### **JURISDICTION AND VENUE**

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a), 35 U.S.C. § 271, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201-02.

5. On information and belief, Mutual is in the business of preparing generic prescription pharmaceuticals that it distributes in the State of New Jersey and throughout the United States.

6. On information and belief, Mutual has maintained continuous and systematic contacts with the State of New Jersey.

7. On information and belief, Mutual plans to continue to maintain continuous and systematic contacts with the State of New Jersey, including, but not limited to, its aforesaid

business of preparing generic prescription pharmaceuticals that it distributes in the State of New Jersey, and its attendance at pharmaceutical industry conferences held within the State of New Jersey.

8. On further information and belief, at least a portion of the development and testing work in support of Mutual's ANDA for its proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product was performed in New Jersey utilizing contract testing laboratories located in New Jersey.

9. On information and belief, Mutual plans to continue to use at least some of those same contract testing laboratories located in New Jersey in Mutual's future commercial manufacturing and testing of its proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product.

10. On information and belief, Mutual has contracted with companies located in the State of New Jersey who have supplied and will continue to supply ingredients that Mutual has used in the preparation and filing of its ANDA and that Mutual will continue to use in Mutual's commercial manufacturing of its proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product.

11. On information and belief, Mutual Pharmaceutical Company, Inc. has previously consented to personal jurisdiction in this District in several cases as plaintiffs and defendants, including a pending related action filed in this District, Hoffmann-La Roche Inc. v. Mutual Pharmaceutical Company, Inc., Civ. No. 07-4350 (SRC)(MAS).

12. On information and belief, this Court has personal jurisdiction over Mutual by virtue of, *inter alia*, the facts alleged in paragraphs 5-11.

13. Venue is proper in this District under 28 U.S.C. §§ 1391 and 1400(b).

### **STATEMENT OF FACTS**

14. This action arises because of Mutual's efforts to gain approval from the United States Food and Drug Administration ("FDA") to market a generic version of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to the expiration of Roche's patent rights covering it. The FDA approved Roche's Boniva<sup>®</sup> Once-Monthly drug product for marketing in the United States under Plaintiff Roche's New Drug Application ("NDA") No. 21-455, pursuant to section 505(b) of the Federal Food Drug and Cosmetics Act ("FFDCA"), 21 U.S.C. § 355(b).

15. With the passage of the Hatch-Waxman Act in 1984, the FFDCA provisions regarding the generic drug approval process were amended in several important respects. One provision requires innovator drug companies to submit patent information to the FDA "with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner engaged in the manufacture, use, or sale of the drug." 21 U.S.C. § 355(b)(1). The FDA then publishes the submitted patent information in a publication entitled "Approved Drug Products with Therapeutic Equivalence Evaluations" (commonly referred to as the "Orange Book"). Whenever a new patent is issued, the innovator drug company must submit the patent information to the FDA not later than thirty days after the patent was issued. 21 U.S.C. § 355(c)(2). The FDA publishes new patent information in updates to the Orange Book.

16. In compliance with that statutory obligation, Plaintiff Roche has submitted patent information to the FDA in connection with its NDA No. 21-455 for Roche's Boniva<sup>®</sup> Once-Monthly drug product, and the FDA has published same in the Orange Book on or about August 14, 2008.

17. The Hatch-Waxman Act further amended the FDCA to permit generic drug companies to gain approval of generic copies of innovator drugs (also called the "reference drug" or "listed drug") by referencing studies performed by the innovator, without having to expend the same considerable investment in time and resources. Thus, generic drug companies are permitted to file what is referred to as an Abbreviated New Drug Application ("ANDA") under 21 U.S.C. § 355(j). When filing an ANDA, generic drug companies are required, *inter alia*, to review the patent information that the FDA listed in the Orange Book for the reference drug and make a statutory certification (commonly called "patent certification") with respect to same. This statutory patent certification is mandatory with respect to any patent which claims the listed drug or which claims a use for such listed drug for which the generic drug company is seeking approval and for which information is required to be filed under 21 U.S.C. §§ 355(b) or (c).

18. The generic drug company may state that it does not seek FDA approval to market its generic drug product prior to patent expiration (a "Paragraph III certification"). 21 U.S.C. § 355(j)(2)(A)(vii)(III). Alternatively, the generic drug company may seek FDA approval to market its generic drug product prior to patent expiration by stating in its ANDA that it challenges whether the listed patent is "invalid or will not be infringed ..." (commonly called a "Paragraph IV certification"). 21 U.S.C. § 355 (j)(2)(A)(vii)(IV).

19. On information and belief, Mutual has filed ANDA No. 78-996 with the FDA seeking approval to market a 150 mg generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to expiration of Roche's patent rights.

20. On or about July 30, 2007, Roche received letters signed by E. Brendan Magrab, Esq., Executive Vice President of Commercial Operations, General Counsel of Mutual, purporting to be notice of Mutual Pharmaceutical's filing of an ANDA seeking to market a generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product and allegedly containing a Paragraph IV certification required by 21 U.S.C. § 355(j)(2)(B)(i) and (ii), with respect to two of Roche's patents that are currently listed in the Orange Book for Roche's Boniva<sup>®</sup> Once-Monthly drug product. (Mutual's "Original Paragraph IV Notice").

21. Mutual's Original Paragraph IV Notice to Roche states Mutual's intention to seek approval to market a generic version of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to expiration of two of Roche's patents listed in the Orange Book, namely U.S. Patent No. 7,192,938, expiring May 6, 2023, and U.S. Patent No. 6,294,196, expiring October 7, 2019. Notwithstanding the United States Patent and Trademark Office's grant of patent protection to Roche, Mutual asserts in its Paragraph IV Notice that these patents are invalid, unenforceable, or would not be infringed.

22. On September 11, 2007, Roche filed an action for patent infringement of both of the '938 and '196 Patents in Hoffmann-La Roche Inc. v. Mutual Pharmaceutical Company, Inc., Civil Action No. 07-4350 (SRC)(MAS), which action is currently pending before this Court.

23. On or about December 4, 2008, Roche received a letter from E. Brendan Magrab, Esq., Executive Vice President of Commercial Operations, General Counsel for URL Pharma, Inc., URL Distribution, Mutual Pharmaceutical Company, Inc., and AR Scientific, Inc., purporting to be a notice of Mutual's Paragraph IV certification required by 21 U.S.C. § 355(j)(2)(B)(i) and (ii), with respect to Roche's '957 patent that is currently listed in the Orange Book. (Mutual's "Second Paragraph IV Notice").

24. Mutual's Second Paragraph IV Notice to Roche states Mutual's intention to seek approval to market a generic version of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to expiration of Roche's patent listed in the Orange Book, namely U.S. Patent No. 7,410,957, expiring May 6, 2023. Notwithstanding the United States Patent and Trademark Office's grant of patent protection to Roche, Mutual asserts in its Paragraph IV Notice that the '957 patent is invalid, unenforceable, or would not be infringed.

25. Mutual's efforts to seek FDA approval to market a generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to expiration of Roche's patent creates a justiciable controversy between Roche and Mutual with respect to the subject matter of Mutual's purported ANDA and Roche's patent identified in Mutual's Paragraph IV Notice.

### COUNT ONE

26. Plaintiff Roche alleges paragraphs 1 through 25 above as if set forth again.

27. On August 12, 2008, the United States Patent and Trademark Office duly and legally issued Bauss *et al.*, U.S. Patent No. 7,410,957 ("the '957 Patent") to Plaintiff Roche. A true and correct copy of the '957 Patent is attached hereto as **Exhibit A**. The '957 Patent was

issued from U.S. Patent Application Serial No. 10/430,007, filed May 6, 2003, and is related to the '938 Patent, which issued on March 20, 2007.

28. Roche's '957 Patent discloses and claims, *inter alia*, a method of treating osteoporosis by commencing treatment by orally administering to a subject in need of such treatment, on a single day, a first dose in the form of a tablet, wherein the tablet comprises an amount of a pharmaceutically acceptable salt of ibandronic acid that is equivalent to about 150 mg of ibandronic acid and continuing the treatment by orally administering, once monthly on a single day, a tablet comprising an amount of a pharmaceutically acceptable salt of ibandronic acid that is equivalent to about 150 mg of ibandronic acid.

29. Plaintiff Roche is the assignee of the '957 Patent and owns all rights, title and interest in the '957 Patent, including all rights needed to bring this action in Plaintiff Roche's own name.

30. Roche's '957 Patent is a patent with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by Roche engaged in the manufacture, use, or sale of Roche's Boniva<sup>®</sup> Once-Monthly drug product.

31. The '957 Patent is listed in the Orange Book, maintained by the FDA, as a patent "with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner engaged in the manufacture, use, or sale of the drug." 21 U.S.C. § 355(b)(1).

32. Additionally, healthcare providers administering and/or patients using Mutual's proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product within the United States



in the manner and for the indications described in Mutual's ANDA will be direct infringers of Roche's '957 Patent under 35 U.S.C. § 271(a). On information and belief, the healthcare providers' and/or patients' infringing use of Mutual's proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product in a method claimed in Roche's '957 Patent will occur with Mutual's inducement and with Mutual's intent, knowledge, and encouragement.

33. Mutual has committed an act of infringement of the '957 Patent that creates a justiciable case or controversy between Roche and Mutual. Pursuant to 35 U.S.C. § 271(e)(2)(A), Mutual committed an act of infringement by filing an ANDA with a Paragraph IV certification that seeks FDA marketing approval for Mutual's generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product prior to expiration of Roche's '957 Patent. This Court has subject matter jurisdiction with respect to this action to declare Roche's rights under the '957 Patent.

34. Plaintiff Roche is entitled to the relief provided by 35 U.S.C. § 271(e)(4), including, *inter alia*, an order of this Court that the effective date of approval for Mutual's ANDA be a date which is not earlier than the May 6, 2023 expiration date of the '957 Patent.

35. Plaintiff Roche is entitled to a declaration that, if Mutual commercially manufactures, uses, offers for sale or sells Mutual's proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product within the United States, imports Mutual's proposed generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product into the United States, or induces or contributes to such conduct, Mutual would infringe the '957 Patent under 35 U.S.C. § 271.

36. Plaintiff Roche will be irreparably harmed by Mutual's infringing activities unless those activities are enjoined by this Court. Plaintiff Roche does not have an adequate remedy at law.

37. This is an exceptional case and Roche is entitled to an award of reasonable attorneys fees from Mutual.

**RELIEF SOUGHT**

**WHEREFORE**, Plaintiff requests:

- A) A judgment and decree that the '957 Patent is valid and enforceable;
- B) A judgment that Mutual infringed Roche's '957 Patent under 35 U.S.C. § 271(e)(2)(A) by submitting the aforesaid ANDA with a Paragraph IV Certification seeking to market Mutual's generic version of Boniva<sup>®</sup> Once-Monthly prior to the expiration of the '957 patent;
- C) An Order pursuant to 35 U.S.C. § 271(e)(4) that the effective date of any FDA approval of Mutual's ANDA No. 78-996 be a date that is not earlier than the expiration date for the '957 Patent;
- D) A judgment that Mutual would infringe and induce infringement of Roche's '957 Patent upon marketing of Mutual's generic copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product after grant of FDA approval and during the unexpired term of Roche's '957 Patent;
- E) A permanent injunction pursuant to 35 U.S.C. § 271 restraining and enjoining Mutual and its officers, agents, servants and employees, and those persons in active concert or participation with any of them, from engaging in the commercial manufacture, use, offer to sell, or sale within the United States, or importation into the United States, of the proposed generic

copy of Roche's Boniva<sup>®</sup> Once-Monthly drug product identified in this Complaint, and any other product that infringes or induces or contributes to the infringement of the '957 Patent, prior to the expiration date of the '957 Patent;

- F) An award of attorneys fees from Mutual under 35 U.S.C. § 285; and
- G) Such other and further relief as the Court may deem just and proper.

Dated: December 12, 2008

Respectfully submitted,

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