

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

SHIRE VIROPHARMA INCORPORATED	:	
	:	CIVIL ACTION
Plaintiff,	:	
	:	
v.	:	
	:	NO. 17-414
CSL BEHRING LLC and CSL BEHRING GMBH	:	
	:	
Defendants.	:	

ORDER

AND NOW, this 17th day of September, 2020, upon consideration of whether I may proceed with a bench trial on the issue of alleged inequitable conduct, and upon review of the parties’ letter submissions regarding whether there are “common factual issues” between the invalidity counterclaim and the inequitable conduct counterclaim (D.I. 318, 322, 323, 325), I find as follows:

1. Plaintiff maintains several patents for products designed for the treatment of a rare genetic disorder known as hereditary angioedema (“HAE”). In 2017, Plaintiffs brought suit alleging that Defendants’ U.S. sales of their product HAEGARDA, which is likewise designed for the prophylactic treatment of HAE, infringes on Plaintiffs’ patents. Defendants responded with counterclaims for (a) the invalidity of Plaintiff’s patents-in-suit, and (b) inequitable conduct.
2. Claim construction, fact discovery, and expert discovery are completed. Chief Magistrate Judge Mary Pay Thyngge has also engaged in efforts to settle this matter. Aside from pending Daubert motions, this case is trial ready on the three essential issues in this case— infringement, invalidity, and inequitable conduct.
3. In an effort to move this case forward, I sought the parties’ input regarding how to proceed in light of the current COVID-19 pandemic. The latest standing order for the United States

District Court for the District of Delaware, dated September 1, 2020, states that “all civil and criminal jury selections and jury trials in the District of Delaware scheduled to begin before September 15, 2020, are continued pending further Order of the Court.” This order also notes that, when jury trials recommence, criminal matters will be given priority.

4. In response to my inquiries, Defendants have indicated that they are willing to proceed with a bench trial on all issues. Plaintiff has declined to waive its right to a jury trial. By way of order dated July 29, 2020, I noted that, under the Seventh Amendment and prevailing Federal Circuit law, Plaintiff is indeed entitled, as a matter of right, to a jury trial on both the infringement and invalidity claims. In re Lockwood, 50 F.3d 966 (Fed. Cir. 1995), vacated sub nom., American Airlines, Inc. v. Lockwood, 515 U.S. 1182 (1995).
5. Given that both Plaintiff’s infringement claim and Defendants’ invalidity counterclaim must be tried before a jury, and in light of the current limitation on jury trials, I explored with counsel whether a bench trial could proceed solely on Defendants’ counterclaim for inequitable conduct.
6. As noted in my July 29, 2020 order, a bench trial on inequitable conduct may proceed prior to a jury trial on infringement/invalidity only if the legal and equitable claims do not share “common factual issues.” See Shum v. Intel Corp., 499 F.3d 1272 (Fed. Cir. 2007); Celgene Corp. v. Barr Labs., Inc., No. 07-286, 2008 WL 2447354, at *2 (D.N.J. June 13, 2008).
7. Accordingly, I directed the parties to each file a no more than two-page letter that would concisely set forth a summary of evidence each party intended to introduce regarding the inequitable conduct and invalidity claims.
8. The parties each filed two letters, and also chose to attach approximately 1,000 pages of exhibits (836 from Plaintiff and 140 from Defendants). Because there was no context given

for any of these documents and because their submission was in violation of my Order, I have not considered these exhibits.

9. Nonetheless, having reviewed the parties' letters, I find that there is a risk of overlapping factual issues on the inequitable conduct and invalidity claims such that a bench trial on equitable conduct should not proceed before a jury trial on the other two claims. While it is difficult to fully understand the proofs to be presented for each claim without actually hearing the evidence in a courtroom, both the inequitable conduct and the invalidity claims appear to involve issues as to whether certain C1-INH research performed by others existed prior to Plaintiff's patents and whether Plaintiff's inventors should have disclosed that research to the PTO.
10. I have spoken with Chief Judge Leonard Stark regarding trial scheduling. Counsel are advised that once Delaware courtrooms are cleared for civil trials, a trial date will be selected forthwith.

WHEREFORE, it is hereby **ORDERED** that a trial date will not presently be set. In the interim, the previously-filed Daubert motions will be reviewed and resolved.

BY THE COURT:

/s/ Mitchell S. Goldberg
MITCHELL S. GOLDBERG, J.