United States Court of Appeals for the Federal Circuit

NALPROPION PHARMACEUTICALS, INC.,
Plaintiff-Appellee

v.

ACTAVIS LABORATORIES FL, INC.,
Defendant-Appellant

2018-1221

Appeal from the United States District Court for the District of Delaware in No. 1:15-cv-00451-RGA, Judge Richard G. Andrews.

Decided: August 15, 2019

DOMINICK A. CONDE, Venable LLP, New York, NY, argued for plaintiff-appellee. Also represented by CHRISTOPHER P. BORELLO, JOSHUA DANIEL CALABRO, ZACHARY GARRETT, BRENDAN M. O'MALLEY.

JONATHAN D. BALL, Greenberg Traurig LLP, New York, NY, argued for defendant-appellant. Also represented by SCOTT JOSEPH BORNSTEIN, JUSTIN ALBANO MACLEAN, RICHARD CHARLES PETTUS.

Before PROST, *Chief Judge,* LOURIE and WALLACH, *Circuit Judges.*

Opinion for the court filed by *Circuit Judge* LOURIE.

Opinion dissenting in part filed by *Chief Judge* PROST.

LOURIE, *Circuit Judge.*

Actavis Laboratories FL, Inc. ("Actavis") appeals from the judgment of the U.S. District Court for the District of Delaware that (1) its proposed naltrexone hydrochloride and bupropion hydrochloride extended-release tablets, which are the subject of Abbreviated New Drug Application No. 208043 (the "ANDA product"), would infringe claim 1 of U.S. Patent 7,375,111 ("the '111 patent"), claims 26 and 31 of U.S. Patent 7,462,626 ("the '626 patent"), and claim 11 of U.S. Patent 8,916,195 ("the '195 patent"); (2) the asserted claims are not invalid; (3) the effective date of any FDA approval of ANDA No. 208043 shall be no earlier than the latest expiration of the '111, '626, and '195 patents; and (4) Actavis is permanently enjoined from manufacturing, using, or selling its ANDA product before the expiration of the patents in suit. *Orexigen Therapeutics, Inc. v. Actavis Labs. FL, Inc.*, 282 F. Supp. 3d 793 (D. Del. 2017) ("*Decision*"); Final Judgment, *Orexigen Therapeutics, Inc. v. Actavis Labs. FL, Inc.*, No. 1:15-cv-451 (D. Del. Oct. 26, 2017), ECF No. 186. Because we conclude that the district court did not err in finding claim 11 of the '195 patent not invalid for lack of written description, but did err in finding that claim 1 of the '111 patent and claims 26 and 31 of the '626 patent would not have been obvious in view of the prior art, we affirm-in-part and reverse-in-part.

BACKGROUND

Appellee Nalpropion Pharmaceuticals, Inc. ("Nalpropion")[1] holds New Drug Application No. 200063 for and markets Contrave® for weight management in overweight or obese adults. Relevant here are the three Orange Book-listed patents for Contrave® that Nalpropion asserted against Actavis: the '626, '195, and '111 patents.

The '626 patent is drawn to a method for treating overweight or obesity comprising (1) diagnosing an individual as suffering from overweight or obesity by body mass index, (2) administering bupropion in an amount effective to induce weight loss, and (3) administering naltrexone in an

---

[1] Takeda Pharmaceutical Company Limited ("Takeda Ltd."), Takeda Pharmaceuticals International GmbH, Takeda Pharmaceuticals USA, Inc. ("Takeda USA"), and Takeda Pharmaceuticals, America, Inc. (collectively, "Takeda") and Orexigen Therapeutics, Inc. ("Orexigen") filed this suit in the District of Delaware. At the time of filing, Orexigen owned all three patents in suit, Takeda Ltd. was the exclusive licensee of the patents, and Takeda USA held approved New Drug Application No. 200063 for extended-release tablets containing 8 mg of naltrexone hydrochloride and 90 mg of bupropion hydrochloride. During the litigation, Orexigen acquired all of Takeda's rights to Contrave®, including ownership of the NDA. Stipulation and Order at 1, *Orexigen Therapeutics, Inc. v. Actavis Labs. FL, Inc.*, No. 1:15-cv-451 (D. Del. Oct. 5, 2017), ECF No. 92. After this appeal was taken, however, Orexigen commenced bankruptcy proceedings under Chapter 11 of Title 11 of the United States Code in the U.S. Bankruptcy Court for the District of Delaware and transferred ownership of the patents-in-suit to Nalpropion. Unopposed Motion for Substitution of Nalpropion Pharms. Inc. for Orexigen Therapeutics, Inc. at 1, *Nalpropion Pharm. Inc. v. Actavis Labs. FL, Inc.*, No. 18-1221 (Fed. Cir. Aug. 28, 2018), ECF No. 30.

amount effective to enhance the weight loss activity of bupropion. '626 patent col. 38 l. 60–col. 39 l. 4. Nalpropion asserted claims 26 and 31. Claim 26 depends from claim 25, which recites:

> A method of treating overweight or obesity, comprising administering a weight loss effective amount of a first and second compound to an individual who has been diagnosed as suffering from overweight or obesity in order to treat said overweight or obesity, wherein said first compound is bupropion, or a pharmaceutically acceptable salt thereof, and said second compound is naltrexone, or a pharmaceutically acceptable salt thereof, and wherein the weight loss activity of said first and second compounds is enhanced compared to the administration of the same amount of either compound alone.

Id. col. 40 ll. 16–26. Claim 26 adds the additional limitation that naltrexone and bupropion "are administered together." *Id.* col. 40. ll. 27–30. Claim 30 depends from claim 25 and requires that at least one of the drugs be in a "sustained-release formulation," *id.* col. 40 ll. 41–44, while claim 31, which depends from claim 30, requires that the drugs be "administered in a single oral dosage form," *id.* col. 40 ll. 45–49.

The '195 patent is also directed to methods of treating overweight or obesity, but the claims are drawn to specific dosages of sustained-release naltrexone and bupropion that achieve a specific dissolution profile. At issue here is claim 11:

> A method of treating overweight or obesity having reduced adverse effects comprising orally administering daily about 32 mg of naltrexone and about 360 mg of bupropion, or pharmaceutically acceptable salts thereof, to a person in need thereof, wherein the bupropion or pharmaceutically

> acceptable salt thereof is administered as a sustained release formulation, wherein the naltrexone or pharmaceutically acceptable salt thereof is administered as a sustained release formulation, and wherein said sustained release formulation of naltrexone has an in vitro naltrexone dissolution profile in a dissolution test of USP Apparatus 2 Paddle Method at 100 rpm in a dissolution medium of water at 37° C. of:
>
> > a) between 39% and 70% of naltrexone released in one hour;
> >
> > b) between 62% and 90% of naltrexone released in two hours; and
> >
> > c) at least 99% in 8 hours;
> >
> > wherein about 16 mg of said sustained release formulation of naltrexone or a pharmaceutically acceptable salt thereof is administered twice daily, and about 180 mg of said sustained release formulation of bupropion or a pharmaceutically acceptable salt thereof is administered twice daily.

'195 patent col. 31 l. 5–col. 32 l. 3.

Finally, the '111 patent is directed to a composition of sustained-release bupropion and naltrexone for affecting weight loss. Asserted here is claim 1:

> A composition for affecting weight loss comprising:
>
> > (a) a sustained release formulation of bupropion or a pharmaceutically acceptable salt thereof in an amount effective to induce weight loss in an individual; and
> >
> > (b) a sustained release formulation of naltrexone or a pharmaceutically acceptable salt thereof in an amount effective to

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.