

United States District Court,  
N.D. California, San Francisco Division.

**The REGENTS OF the UNIVERSITY OF CALIFORNIA, Abbott Molecular Inc., and Abbott Laboratories Inc,**  
Plaintiffs.

v.  
**DAKO NORTH AMERICA, INC. and Dako Denmark A/S,**  
Defendants.  
**and Related Counterclaim,**  
and Related Counterclaims.

No. C 05-03955 MHP

**April 14, 2009.**

Lynn H. Pasahow, Michael J. Shuster, Heather N. Mewes, Carolyn Chang, Ryan A. Tyz, Fenwick & West LLP, Mountain View, CA, for Plaintiffs/Counterclaim-Defendants the Regents of the University of California, Abbott Molecular Inc., and Abbott Laboratories Inc.

Thomas H. Jenkins (Admitted Pro Hac Vice), Anthony C. Tridico (Admitted Pro Hac Vice), Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., Washington, D.C., Tina E. Hulse, Wesley Derrick, Sarah E. Craven, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L .P., Palo Alto, CA, for Defendants/Counterclaim-Plaintiffs Dako North America, Inc. and Dako Denmark A/S.

## **STIPULATION AND ORDER RE SUPPLEMENTAL CLAIM CONSTRUCTION**

**MARILYN H. PATEL, District Judge.**

WHEREAS, hearing on the parties' supplemental claim construction briefing on the proper construction of "blocking nucleic acid" is currently scheduled for April 23, 2009;

WHEREAS, the parties have since met and conferred and agree to a construction of "blocking nucleic acid";

Plaintiffs The Regents of the University of California, Abbott Molecular Inc. and Abbott Laboratories Inc. ("plaintiffs") and defendants Dako North America, Inc. and Dako Denmark A/S ("Dako") hereby stipulate as follows:

- 1) The parties agree that "blocking nucleic acid" should be construed to mean "nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA";
- 2) The hearing on the parties' supplemental claim construction briefing scheduled for April 23, 2009 is made

moot by this construction and is therefore taken off-calendar;

3) The hearing on Dako's Motion for Partial Summary Judgment of Noninfringement (Docket No. 269) scheduled for April 23, 2009 is made moot by this construction and is therefore taken off-calendar;

4) The hearing on Plaintiffs' Motion for Summary Judgment of Infringement (Docket No. 265) and Dako's Motion in Limine to Exclude Testimony of Mark E. Nusbaum (Docket No. 276) also scheduled for April 23, 2009 will proceed;

5) Dako will have until April 17, 2009 to amend the Expert Report of Robert H. Singer, Ph.D. ("Singer Report") to address the amended construction of "blocking nucleic acid." Any amendment to the Singer Report will be limited to Dr. Singer's opinions regarding written description and enablement under 35 U.S.C. s. 112 para. 1 that arise solely because of the amendment to the construction of "blocking nucleic acid." Specifically, any amendment will be limited to addressing any written description or enablement argument that arises from the difference in the scope of an invention that covers use of "repetitive-sequence-enriched DNA or RNA" and an invention that covers use of "nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA." No other amendment to the Singer Report is allowed by this stipulation;

6) The parties agree that the opinions in the Expert Report of Dr. James Coull ("Coull Report") that the use of PNA in the accused *HER2* and *TOP2A* is not equivalent to the use of "blocking nucleic acid" as claimed in the '841 patent shall apply as well to the use of PNA in Dako's other accused products;

7) Plaintiffs will have until May 1, 2009 to amend the Rebuttal Expert Report of Dr. Mary E. Harper ("Harper Rebuttal Report") to respond to any amendments to the Singer Report;

8) Dako will make Dr. Singer available to plaintiffs for deposition to address any amendment to the Singer Report. Plaintiffs will make Dr. Harper available for a supplemental deposition if plaintiffs re-depose Dr. Singer;

9) Any amendment to the parties' expert reports will have no effect on motions for summary judgment. Specifically, any amendment to the Singer Report or the Harper Rebuttal Report will not be used to supplement any of the parties' pending motions for summary judgment. Nor will any amendment to the Singer Report or the Harper Rebuttal Report be used as a basis to bring any new motion for summary judgment;

10) Neither party will contend that this stipulation or any action taken pursuant to it supports any change to the existing pretrial or trial schedule other than as provided herein.

## **ORDER**

Pursuant to the foregoing Stipulation, and good cause appearing, the Court hereby orders as follows:

1) The parties agree that "blocking nucleic acid" should be construed to mean "nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA";

2) The hearing on the parties' supplemental claim construction briefing scheduled for April 23, 2009 is made

moot by this construction and is therefore taken off-calendar;

3) The hearing on Dako's Motion for Partial Summary Judgment of Noninfringement (Docket No. 269) scheduled for April 23, 2009 is made moot by this construction and is therefore taken off-calendar;

4) The hearing on Plaintiffs' Motion for Summary Judgment of Infringement (Docket No. 265) and Dako's Motion in Limine to Exclude Testimony of Mark E. Nusbaum (Docket No. 276) also scheduled for April 23, 2009 will proceed;

5) Dako will have until April 17, 2009 to amend the Expert Report of Robert H. Singer, Ph.D. ("Singer Report") to address the amended construction of "blocking nucleic acid." Any amendment to the Singer Report will be limited to Dr. Singer's opinions regarding written description and enablement under 35 U.S.C. s. 112 para. 1 that arise solely because of the amendment to the construction of "blocking nucleic acid." Specifically, any amendment will be limited to addressing any written description or enablement argument that arises from the difference in the scope of an invention that covers use of "repetitive-sequence-enriched DNA or RNA" and an invention that covers use of "nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA." No other amendment to the Singer Report is allowed by this stipulation;

6) The parties agree that the opinions in the Expert Report of Dr. James Coull ("Coull Report") that the use of PNA in the accused *HER2* and *TOP2A* is not equivalent to the use of "blocking nucleic acid" as claimed in the '841 patent shall apply as well to the use of PNA in Dako's other accused products;

7) Plaintiffs will have until May 1, 2009 to amend the Rebuttal Expert Report of Dr. Mary E. Harper ("Harper Rebuttal Report") to respond to any amendments to the Singer Report;

8) Dako will make Dr. Singer available to plaintiffs for deposition to address any amendment to the Singer Report. Plaintiffs will make Dr. Harper available for a supplemental deposition if plaintiffs re-depose Dr. Singer;

9) Any amendment to the parties' expert reports will have no effect on motions for summary judgment. Specifically, any amendment to the Singer Report or the Harper Rebuttal Report will not be used to supplement any of the parties' pending motions for summary judgment. Nor will any amendment to the Singer Report or the Harper Rebuttal Report be used as a basis to bring any new motion for summary judgment;

10) Except as provided in this order, the pretrial and trial schedule previously established remains in effect.

**IT IS SO ORDERED.**

N.D.Cal., 2009.

Regents of University of California v. Dako North America, Inc.

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