

No. 10-844

In the Supreme Court of the United States

CARACO PHARMACEUTICAL LABORATORIES, LTD. AND
SUN PHARMACEUTICAL INDUSTRIES, LTD., PETITIONERS

v.

NOVO NORDISK A/S AND NOVO NORDISK, INC.,
RESPONDENTS

*ON WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

BRIEF FOR PETITIONERS

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QUESTION PRESENTED

Drugs approved by the Food & Drug Administration (FDA) often have multiple uses, some patented and some unpatented. In that situation, the Hatch-Waxman Act allows generic drug makers to market a drug for specific uses not claimed by any patent. But FDA lacks the expertise needed to determine whether particular uses are patented, so it defers to brand-name drug companies' descriptions of the scope of their patents. Thus, a brand-name company can block FDA's approval of a generic drug by submitting overbroad descriptions of its patent to the agency, such that a patent covering one use of the drug is effectively expanded to cover non-infringing uses.

To combat this problem, the Act authorizes courts to order brands to "correct" the "patent information" they submitted to FDA. If a brand files "an action for patent infringement" based on a patent covering "a use" of a drug, the Act permits the generic company to file a "counterclaim seeking an order requiring the [patent] holder to correct or delete the patent information submitted by the holder * * * on the ground that the patent does not claim * * * an approved method of using the drug." 21 U.S.C. § 355(j)(5)(C)(ii)(I). The Federal Circuit held that the counterclaim provision authorizes "delet[ing]" improperly listed patents but not "correct[ing]" information that misrepresents the scope of the patent. The question presented is:

Whether the Hatch-Waxman Act counterclaim provision (21 U.S.C. § 355(j)(5)(C)(ii)(I)) applies where (1) there is "an approved method of using the drug" that "the patent does not claim," and (2) the brand submits "patent information" to FDA that misstates the patent's scope, requiring "correct[ion]."

PARTIES TO THE PROCEEDINGS

Petitioners' original Rule 29.6 Statement, as amended on June 15, 2011, and supplemented by Respondents' Rule 29.6 Statement in the brief in opposition, remains accurate.

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GLOSSARY OF ABBREVIATIONS

Act Hatch-Waxman Act

ANDAAbbreviated New Drug Application

Counterclaim..... 21 U.S.C. § 355(j)(5)(C)(ii)(I)

FDA Food & Drug Administration

NDA..... New Drug Application

Orange Book.....FDA Orange Book: Approved
Drug Products With Thera-
peutic Equivalence Evalua-
tions

Paragraph IV21 U.S.C. § 355(j)(2)(A)(vii)(IV)

Section viii.....21 U.S.C. § 355(j)(2)(A)(viii)

INTRODUCTION

The Hatch-Waxman Act¹ provides a path to expedited FDA approval of generic drugs when a drug has multiple FDA-approved uses and a brand-name drug manufacturer’s patent claims at least one, but not all, of the approved uses. That path, set forth in “Section viii” of the Act, allows generic drug manufacturers to submit a “carved-out” product label that omits reference to potentially infringing uses. Pet. 6a.

Petitioners (“Caraco”) here sought FDA approval to sell generic repaglinide—a diabetes drug manufactured by respondents (“Novo”)—for two uses that Novo concedes do not infringe its patent. Nevertheless, to block approval, Novo told FDA that its patent *does* cover those non-infringing uses. As the district court held, Novo “seriously misrepresent[ed]” the patent’s scope. Pet. 70a. But FDA—which lacks the authority and expertise to construe patents—deferred to Novo’s overbroad description of its patent. FDA thus rejected Caraco’s carved-out label, thereby barring Caraco from marketing generic drugs for uses that all agree are non-infringing.

The question presented boils down to whether the Act remedies such gamesmanship. It does. It authorizes counterclaims to “correct or delete the patent information submitted by the [patent] holder” whenever there is “an approved method of using the drug”

¹ The “Hatch-Waxman Act” refers to the Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585 (1984), as amended by the Medicare Prescription Drug, Improvement, and Modernization Act of 2003, Pub. L. No. 108-173, 117 Stat. 2066 (2003).

that “the patent does not claim.” 21 U.S.C. § 355(j)(5)(C)(ii)(I).

Contrary to the Act’s text, structure, history, purpose, and interpretation by FDA, however, the court below held that Caraco has no remedy. Over a forceful dissent, the majority held that the counterclaim is unavailable because: (1) Novo’s patent claims *one* “approved method of using the drug” at issue, even though it “does not claim” two *other* “approved methods of using the drug”; and (2) the statute effectively permits only “delet[ing]” patents that should not have been listed with FDA at all, not “correct[ing]” inaccurate “patent information” that overstates the patent’s scope. Pet. 12a, 15a-16a.

The court below reached this result by announcing that the phrase “an approved method of us[e]” really means “*any* approved method of us[e].” Pet. 12a. (emphasis added). But Congress intentionally used the word “an,” not “any,” as confirmed by the use of “any” in the very next sentence and some 34 times in neighboring provisions. Moreover, the court read the term “patent information” as limited to “an erroneous patent number or expiration date” (Pet. 15a-16a)—*i.e.*, to exclude information about what “the patent does not claim”—contrary to both the statute’s text and FDA’s interpretation.

The Federal Circuit’s decision thus licenses brand manufacturers to craft overbroad descriptions of their patents, and thereby to “extend [their] monopol[ies] to unpatented uses.” Pet. 62a (Gajarsa, J., dissenting). Using a patent to block the marketing of concededly unpatented uses would be extraordinary under any statute, but especially one designed to expedite generic competition. This ruling must be reversed.

OPINIONS BELOW

The Federal Circuit's opinion (Pet. 1a-52a) is reported at 601 F.3d 1359. The Federal Circuit's decision denying rehearing and rehearing en banc (Pet. 53a-64a) is reported at 615 F.3d 1374. The relevant decisions of the District Court for the Eastern District of Michigan (Cohn, J.) (Pet. 65a-103a) are reported at 649 F. Supp. 2d 661 and 656 F. Supp. 2d 729.

JURISDICTION

In June 2005, Novo sued Caraco for patent infringement, asserting jurisdiction under 21 U.S.C. § 355(j)(5)(C)(i); 28 U.S.C. §§ 1331, 1338, 2201, and 2202; and 35 U.S.C. § 271(e)(2). Following the district court's injunction order in 2009 and a timely interlocutory appeal by Novo, the Federal Circuit entered judgment on April 14, 2010, and denied a timely rehearing petition on July 29, 2010. On October 18, 2010, the Chief Justice extended the time to petition for certiorari to December 23, 2010. This Court has jurisdiction under 28 U.S.C. § 1254(1), and granted certiorari on June 27, 2011.

STATUTORY AND REGULATORY PROVISIONS INVOLVED

Relevant statutory and regulatory provisions are set forth in the appendix to this brief. See App. 1a-116a (21 U.S.C. § 355); 117a-132a (21 C.F.R. § 314.53). The counterclaim provision at issue states:

(C) Civil action to obtain patent certainty.—

* * *

(ii) Counterclaim to infringement action.—

(I) In general.—If * * * the [NDA] holder * * * for the drug that is claimed by the patent or a use of

which is claimed by the patent brings a patent infringement action against the [ANDA] applicant, the [ANDA] applicant may assert a counterclaim seeking an order requiring the holder to correct or delete the patent information submitted by the holder under subsection (b) or (c) of this section on the ground that the patent does not claim either—

(aa) the drug for which the application was approved; or

(bb) an approved method of using the drug.

21 U.S.C. § 355(j)(5)(C)(ii)(I) (App. 55a).

STATEMENT

A. The structure of the Hatch-Waxman Act

The Hatch-Waxman Act governs FDA approval of new and generic drugs. 21 U.S.C. § 355. The Act is designed to “strike a balance between two competing policy interests: (1) inducing pioneering research and development of new drugs and (2) enabling competitors to bring low-cost, generic copies of those drugs to market.” *Caraco Pharm. Labs, Ltd. v. Forest Labs., Inc.*, 527 F.3d 1278, 1282 (Fed. Cir. 2008) (citations and brackets omitted).

To expedite FDA approval, the Act allows generic manufacturers to submit to FDA an abbreviated new drug application (ANDA) instead of a full-blown new drug application (NDA). 21 U.S.C. § 355(j)(2)(A). The timing of an ANDA’s approval depends largely on the scope of the patents covering the brand-name drug and, if necessary, resolution of litigation over patent infringement. Accordingly, NDA filings must identify all non-process patents that arguably protect the new drug. *Id.* § 355(b)(1), (c)(2). FDA lists these patents in its book of “Approved Drug Products With

Therapeutic Equivalence Evaluations”—the “Orange Book”—which alerts generics to the scope of claimed patent rights. Pet. 4a-5a.

As detailed below, the Act provides two different ways for generic manufacturers to address patents when seeking FDA approval. One way is the “Paragraph IV” process, which facilitates the resolution of patent infringement disputes between brand-name and generic companies; the other is the “Section viii” process, which avoids such litigation when generics seek to sell drugs for uses *not* covered by the brand’s patents. In both instances, “Congress sought to get generic drugs into the hands of patients at reasonable prices—fast.” *In re Barr Labs., Inc.*, 930 F.2d 72, 76 (D.C. Cir. 1991).

1. Paragraph IV certifications

The Paragraph IV process applies when a generic manufacturer seeks to market a drug arguably covered by an unexpired patent listed in the Orange Book, in which case “the generic is generally required to certify that the patent * * * is invalid or will not be infringed by the sale or use of the [generic] drug.” Pet. 24a. This is called a “Paragraph IV” certification. 21 U.S.C. § 355(j)(2)(A)(vii)(IV).

The Act treats a Paragraph IV certification as an artificial act of patent infringement, permitting the brand to sue the generic. 35 U.S.C. § 271(e)(2). Alternatively, if the brand fails to sue, the generic may file its own “[c]ivil action to obtain patent certainty.” 21 U.S.C. § 355(j)(5)(C). In either case, if the generic prevails in court and its ANDA otherwise qualifies, FDA must approve generic marketing on the date when the district court enters judgment. *Id.* § 355(j)(5)(B)(iii)(I).

2. Section viii applications

The Act also offers an alternative path to FDA approval—a “Section viii” statement. “Section viii addresses scenarios where a patent claims at least one, but not all, approved methods of using a drug.” Pet. 13a-14a. Section viii is typically invoked when the patent on a chemical compound used in a drug has expired, and the Orange Book lists a “method” patent—one covering a specific method of using the compound—that “does not claim a use for which the applicant is seeking approval.” 21 U.S.C. § 355(j)(2)(A)(viii) (App. 36a).

Normally, a generic drug label must be identical to that of the brand. *Id.* § 355(j)(2)(A)(v), (j)(4)(G); 21 C.F.R. § 314.94(a)(8)(iv). Section viii, however, allows a generic to “submit a proposed label to the FDA that does not contain [*i.e.*, carves out] the patented method of using the listed drug.” Pet. 5a. By obtaining approval to “delet[e] patented use[s] from its proposed label,” generics “avoid infringement.” Pet. 60a.

Importantly, however, when deciding whether to approve a carved-out label, FDA relies on the brand’s description of the scope of its patent. Pet. 6a; 21 C.F.R. § 314.53(f). FDA will not review the patent itself, because the agency lacks both the institutional “expertise in patent matters” and a “statutory basis” to interpret patents. *Applications for FDA Approval to Market a New Drug*, 68 Fed. Reg. 36676, 36683 (June 18, 2003) (“2003 Final Rule”). “[FDA’s] role in listing patents in the Orange Book is ‘ministerial’; it simply lists the patent information that it receives from brand manufacturers, expecting those parties to properly abide by the statutory and regulatory mandates.” Pet. 60a-61a n.4.

To enable FDA to review proposed carved-out labels, the patent information that brands submit to FDA includes what is known as a “use code narrative” (Pet. 4a) or simply a “patent use code” (JA500). “FDA approves the section viii statement only where there is no overlap between the proposed carve-out label * * * and the [brand’s] use code.” Pet. 6a. Unless the agency can confirm that the generic’s carved-out labeling avoids the brand’s use code, it will require that labeling to be identical to the brand’s. 21 U.S.C. § 355(j)(2)(A)(v), (j)(4)(G); 21 C.F.R. § 314.94(a)(8)(iv). Thus, accurate use codes are “essential to the [Act’s] operation.” Pet. 29a.

B. The Act’s counterclaim provision

Aware of brands’ efforts to “block generic competition by making unwarranted claims to patent coverage” (Pet. 25a), Congress enabled generics “in a Paragraph IV suit to assert a counterclaim challenging the accuracy of the ‘patent information’ submitted to the FDA” (Pet. 6a). As Congress provided:

(I) In general.—If * * * the [NDA] holder * * * for the drug that is claimed by the patent or a use of which is claimed by the patent brings a patent infringement action against the [ANDA] applicant, the [ANDA] applicant may assert a counterclaim seeking an order requiring the holder to correct or delete the patent information submitted by the holder under subsection (b) or (c) of this section on the ground that the patent does not claim either—

(aa) the drug for which the application was approved; or

(bb) an approved method of using the drug.

21 U.S.C. § 355(j)(5)(C)(ii)(I) (App. 55a).

This provision was not always part of the Act; and in 2001 the Federal Circuit ruled in *Mylan Pharmaceuticals, Inc. v. Thompson*, 268 F.3d 1323, that the Act did not authorize private actions to correct inaccurate patent listings. The generic there (Mylan) had filed a Section viii statement indicating that a listed patent did not claim a use for which Mylan sought approval. When FDA asked for clarification of the patent's scope, the brand responded that its patent *did* claim that use, prompting rejection of Mylan's Section viii statement. Mylan then sued, seeking an injunction requiring the brand to delist the patent. *Id.* at 1328. Describing Mylan's claim as "analogous to those barred in [a] long line of cases precluding private rights of action," the court rejected it. *Id.* at 1332.

Shortly thereafter, the Federal Trade Commission (FTC) published a lengthy study describing strategies that brands used to delay generic entry—including "improper Orange Book listings." FTC, *Generic Drug Entry Prior to Patent Expiration: An FTC Study*, v (July 2002). FTC "subpoenaed documents and information from brand-name and generic drug manufacturers, and examined instances since 1992 in which generic applicants filed an application with FDA seeking to enter the market with a generic version of a drug product prior to expiration of the brand-name drug products' patents." *Id.* at ii. Noting that generics lacked any means of challenging brands' patent information in court, FTC proposed that Congress permit generics to bring a counterclaim in patent infringement suits. *Id.* at v. Additionally, FTC stated that "it appears useful for the FDA to clarify its listing requirements." *Ibid.*

C. FDA's regulations

FDA acted first, amending its regulations in June 2003 to clarify the “need for accurate and detailed information related to the approved methods of use claimed in [listed] patent[s].” 68 Fed. Reg. at 36682. These “Submission of patent information” regulations contain special rules for method patents that claim one or more approved methods of using a listed drug. Under 21 C.F.R. § 314.53, brands must submit a description of each approved method of using the drug claimed by its patent, together with other information describing the scope of the related method patent's claims:

(P) Information on each method-of-use patent including the following:

- (1) Whether the patent claims one or more approved methods of using the approved drug product and a description of each approved method of use or indication and related patent claim of the patent being submitted;
- (2) Identification of the specific section of the approved labeling for the drug product that corresponds to the method of use claimed by the patent submitted; and
- (3) *The description of the patented method of use as required for publication.*

Id. § 314.53(c)(2)(ii)(P) (emphasis added) (App. 127a).

Brands must submit this patent description on FDA Form 3542 (*id.* § 314.53(c)(1)), which confirms that use codes must track the method patent's scope:

The use code designates a method of use patent that claims the approved indication or use of a

drug product. *Each approved use claimed by the patent should be separately identified in this section* and contain adequate information to assist * * * ANDA applicants in determining whether a listed method of use patent claims a use for which the * * * ANDA applicant is not seeking approval.

Pet. 214a (emphasis added); 68 Fed. Reg. at 36682-36683. Further, FDA requires brands to verify their patent information under penalty of perjury, cautioning that knowingly filing false information violates 18 U.S.C. § 1001. *Id.* at 36686.

Just months after FDA enacted these regulations on the “Submission of patent information,” Congress undertook to “close loopholes in the law and end the abusive practices in the pharmaceutical industry * * * which have cost consumer billions,” by allowing generics sued for infringement “to file a counterclaim to have the brand drug company * * * correct the patent information in FDA’s Orange Book.” 149 Cong. Rec. 31200 (2003) (Sen. Schumer).

Congress acted “with full awareness of the agency’s interpretation of [‘patent information’].” Pet. 37a. Indeed, FDA’s chief counsel twice testified concerning those regulations.² And as Senator Schumer, a leading sponsor, stated: “The bill provides a critical complement to the work the FDA has done in clarify-

² *Legislative and Regulatory Responses to the FTC Study on Barriers to Entry in the Pharmaceutical Marketplace: Hrg. Before S. Comm. on Judiciary*, 108th Cong. 5-10 (June 17, 2003); *Examining the Senate and House Versions of the “Greater Access to Affordable Pharmaceuticals Act”*: *Hrg. Before S. Comm. on Judiciary*, 108th Cong. 7-10 (Aug. 1, 2003) (each containing statements of D. Troy, Chief Counsel for FDA).

ing its regulations on patent listing, but it goes much further.” *Legislative and Regulatory Responses to the FTC Study on Barriers to Entry in the Pharmaceutical Marketplace: Hrg. Before S. Comm. on Judiciary*, 108th Cong. 19 (June 17, 2003) (“*Legislative and Regulatory Responses Hearing*”); accord 149 Cong. Rec. at 16689 (Sen. Hatch); *id.* at 15521 (Sen. Frist). Thus, in late 2003—just six months after FDA published its final rule—Congress enacted the counterclaim provision quoted above, employing the term “patent information” defined in the regulations and Form 3542.

D. Novo’s New Drug Application and Caraco’s Abbreviated New Drug Application

Novo holds an NDA for repaglinide, a diabetes drug sold as PRANDIN. Novo’s patent on the repaglinide compound expired in 2009. Pet. 7a.

In February 2005, Caraco became the first ANDA applicant seeking to sell generic repaglinide. Pet. 8a. Because Caraco filed a Paragraph IV certification, its proposed labeling had to list all FDA-approved uses of repaglinide. *Supra* at 6. In June 2005, Novo sued Caraco for patent infringement.

The asserted patent (the ’358 patent), which expires in 2018, claims the use of “repaglinide in combination with metformin,” another diabetes drug, to treat patients with type 2 diabetes. *Ibid.* This is one of three FDA-approved uses of repaglinide; the others are repaglinide by itself (monotherapy); and repaglinide combined with thiazolidinediones (TZDs). Pet. 7a. “Novo does not own patents claiming the other two approved methods of using repaglinide.” Pet. 8a.

Until 2009, Novo’s patent use code correctly described its patent as covering *only* “use of repaglinide

in combination with metformin to lower blood glucose.” Pet. 44a-45a.

E. Novo’s revised patent use code and FDA’s ruling on Caraco’s Section viii application

At FDA’s suggestion, when Novo’s patent on the repaglinine *compound* was nearing expiration, Caraco invoked Section viii, “declaring that Caraco was not seeking approval for the repaglinide-metformin combination therapy” and asking to carve out of the labeling any reference to that combination. Pet. 8a; JA166-176. Based on Novo’s original use code, and the lack of any overlap between that use code and Caraco’s proposed labeling, FDA ruled that Section viii approval would be proper. Pet. 8a.

But in “response to th[is] section viii ruling,” Novo broadened its use code to read: “a method for improving glycemic control in adults with type 2 diabetes mellitus.” Pet. 49a, see *id.* at 45a. Based on this broadened description of Novo’s patent, FDA “reversed itself and rejected Caraco’s proposed labeling carve-out”—requiring Caraco to include the patented repaglinide-metformin combination in its labeling. Pet. 46a. Thus, by misrepresenting the scope of its patent, Novo concocted a claim that Caraco’s labeling would infringe—effectively expanding the scope of Novo’s patent to cover *unpatented uses* until it expired in 2018. Further, by so broadly describing its patent on combination therapy, Novo effectively extended the term of its patent on the repaglinide *compound*, which expired in 2009, until 2018.

Caraco thus filed a counterclaim, seeking partial summary judgment and an injunction. Finding that Novo’s patent use code “seriously misrepresents the approved method of use covered by [the ’358 patent],”

the district court enjoined Novo to restore its original use code. Pet. 70a. Novo’s new use code is “so broad as to incorrectly suggest that the ’358 patent generically covers three (3) different FDA-approved methods of use of repaglinide,” the court explained, when in fact “the first two (2) uses are not covered.” Pet. 68a.³

F. The Federal Circuit’s divided ruling

In a ruling that spawned three opinions, a divided Federal Circuit panel (Rader, Clevenger, Dyk, JJ.) reversed.

First, reading the phrase “*an* approved method of use” to mean “*any* approved method of use,” the majority (per Rader, J.) reasoned that a counterclaim is available “only if the listed patent does not claim *any* approved methods of using the listed drug.” Pet. 12a (emphasis added). Although the word “any” appears elsewhere in the same provision (§ 355(j)(5)(C)(ii)(II)), the court never discussed this language, finding “no ambiguity in the statut[e].” Pet. 12a. Nor did the majority reconcile its ruling—which effectively limits the statute’s remedy to the “delet[ion]” of patents improperly listed in the Orange Book—with the statutory language permitting the “correct[ion]” of inaccurate “patent information.” Pet. 15a-16a.

³ The parties agreed to postpone trial on issues of patent validity and enforceability pending resolution of the appeal process. After the ruling below, the parties tried those issues in the district court, which held that the ’358 patent was both invalid and unenforceable. Opp. 46a-102a. Pursuant to the parties’ agreement, Novo’s appeal of those issues has been stayed pending this Court’s decision. See Dkt. 31, No. 2011-1223 (Fed. Cir. July 27, 2011) (stay order).

Second, the majority held that the term “patent information” is limited to “an erroneous patent number or expiration date” and “does not extend to the use code narrative.” Pet. 15a-16a. Although Hatch-Waxman does not define “patent information” (see 21 U.S.C. § 321), the majority asserted that the Act had an “express statutory definition” that precluded reading the term to include use codes. Pet. 15a-17a. And although FDA’s regulation, which “preceded the 2003 Amendment,” “appeared to include the use code narrative under the broader heading of ‘patent information,’” the court dismissed this fact as an “opaque timing observation.” Pet. 16a (citation omitted).

Judge Rader’s opinion “recognize[d] that a broad use code covering all uses of a pharmaceutical could” preclude use of Section viii. Pet. 13a-14a. In his view, a generic could use “a Paragraph IV lawsuit” to prove that its “use will not overlap with * * * the patented use.” *Ibid.* But that was incorrect, because a generic generally cannot avoid infringement without the benefit of Section viii carved-out labeling.

Judge Clevenger, who concurred, was “not as certain” that “Paragraph IV litigation will cleanly resolve the dispute.” Pet. 19a. As he recognized, “Caraco can no longer assert that its proposed labeling does not infringe.” Pet. 20a. And although he blamed FDA for purportedly creating the problem—on the mistaken understanding that “FDA’s request that Novo change its labeling” required changing the *use code*—he acknowledged that the outcome “upset the [Act’s] careful balance of interests.” *Ibid.*

Judge Dyk dissented, explaining that “the text is clear” in light of “the overall operation of the statutory scheme.” Pet. 41a. “[I]nterpreting ‘an approved

method’ * * * to mean ‘any’ approved method,” he observed, is “fundamentally inconsistent with the Supreme Court’s admonition * * * that ‘[u]ltimately, context determines meaning.’” Pet. 39a. Judge Dyk also disagreed that the counterclaim was limited to situations where the patent-in-suit should not have been listed in the Orange Book *at all*. Pet. 32a. As he recognized: “Viewing [the counterclaim] as limited to complete delisting would be inconsistent with the explicit statutory language, which provides for correction of Orange Book information” as well as “deleting” it. *Ibid*.

On the “patent information” question, Judge Dyk found the majority’s reading irreconcilable with both the text and FDA’s interpretation—“even if the language of the statute is ambiguous, and not (as I urge) plainly contrary to the majority’s interpretation.” Pet. 33a; see *id.* at 30a. Moreover, because “Congress utilized the FDA’s interpretation of ‘patent information’ * * * with full awareness,” he believed that interpretation was “binding.” Pet. 37a-38a.

Judge Dyk also clarified that FDA did not cause “Caraco’s predicament”—citing Novo’s admission that “FDA did not require [a new use code]” and explaining that “absolutely nothing in the statute or regulations * * * required Novo to change the use code to track [its labeling].” Pet. 47a-48a. But he agreed with Judge Clevenger that generics are “left without any remedy to correct an erroneous Orange Book listing” for “a method of use patent.” Pet. 51a. “Novo’s adoption of a broad use code for PRANDIN likely prevents Caraco from being able to disprove infringement,” he explained, “because Caraco is now compelled to include information regarding the patented combination therapy in its label.” Pet. 50a. In

short, “the majority’s crabbed view of the statute sanctions an unjustified manipulation of the Orange Book” and “cannot be what Congress intended.” Pet. 51a.

G. The dissent from the denial of rehearing

Over a dissent by Judges Gajarsa and Dyk, the Federal Circuit denied en banc review. As Judge Gajarsa explained, “[b]oth constructions” adopted by the panel’s majority—its “overly narrow construction of ‘patent information’ and [its] overly broad construction of ‘an approved method of using the drug’”—“are irreconcilable with pre-existing FDA regulations, the text of the [Act], and Congressional intent.” Pet. 59a. He found it “especially troubling” that the panel “refuses to give effect to [FDA’s] interpretation” of “patent information,” given “Congress’s explicit approval of those regulations.” Pet. 63a.

Furthermore, brands now have “every incentive to * * * draft exceedingly broad use codes”—thus “subverting Section viii carve-out statements.” Pet. 62a, 60a. By “leav[ing] generic drug manufacturers without a remedy to challenge inaccurate Orange Book listings with respect to method of use patents,” Judge Gajarsa explained, the majority’s ruling “render[s] section viii a dead letter.” Pet. 59a, 62a. And holding “that counterclaim relief is not available because the [patent-in-suit] covered at least one approved use * * * effectively allows a patent holder to extend its monopoly to unpatented uses.” Pet. 62a. This “absurd result * * * contravenes the intent of Congress.” Pet. 63a.

SUMMARY OF ARGUMENT

I. The Federal Circuit’s decision is foreclosed by the text, structure, history, and purpose of the Hatch-

Waxman Act’s carefully crafted counterclaim provision. The counterclaim is available here because Caraco established that Novo’s patent “does not claim * * * an approved method of using the drug [repaglinide].” 21 U.S.C. § 355(j)(5)(C)(ii)(I). In fact, Novo’s patent does not claim *two* of repaglinide’s three approved uses. Yet Novo’s broadened use code says otherwise. Under the counterclaim’s plain terms, therefore, Caraco is entitled to “an order requiring” Novo to “correct” this inaccurate “patent information.” *Ibid.* As the United States explains, Caraco “properly invoked the counterclaim provision by alleging that, contrary to the apparent implication of the amended use code that [Novo] submitted to FDA, the ’358 patent does not claim the use of repaglinide as monotherapy, which is ‘an approved method of using the drug.’” U.S. Invitation Br. 12-13.

I.A. In reaching a contrary conclusion, the majority below committed two fundamental errors. *First*, it rewrote the phrase “*an* approved method of us[e]” to mean “*any* approved method of us[e]”—such that the Act “authorizes a counterclaim only if the listed patent does not claim any approved methods of using the listed drug.” Pet. 12a. This altered the statute’s meaning. Congress used the word “an,” not “any,” which appears in the very next sentence, nine times in the surrounding subsection, and 34 times in the Act’s ANDA provisions. Thus, there can be no question that Congress “act[ed] intentionally” in its “exclusion” of “any” from the counterclaim. See *Lopez v. Gonzales*, 594 U.S. 47, 55-56 (2006).

Further, “any” is an “expansive and unqualified” word (e.g., *Salinas v. United States*, 522 U.S. 52, 57 (1997)), and distinctions between terms such as “an” and “any” are particularly critical in laws such as the

Food, Drug & Cosmetic Act (FDCA), where the Court takes extra care “neither to add nor to subtract, neither to delete nor to distort” Congress’s phrasing. *Flemming v. Fla. Citrus Exch.*, 358 U.S. 153, 166 (1958). If anything, this is even more true under the finely tuned Hatch-Waxman Act (which amended the FDCA). As a leading sponsor of the 2003 amendments’ noted: “Change an ‘an’ to a ‘the’ and you go from huge savings to huge cost.” *Examining the Senate and House Versions of the “Greater Access to Affordable Pharmaceuticals Act”*: Hearing Before the Senate Comm. on the Judiciary, 108th Cong. 119 (Aug. 1, 2003) (“*Greater Access Hearing*”) (statement of Sen. Schumer). Yet changing an “an” is exactly what the court below did.

Other aspects of the counterclaim’s text and structure confirm that reversal is warranted. Most fundamentally, the statute places the burden of proof on “the ANDA applicant”—the generic. The statute asks not whether the *brand* can show that its patent *does claim* “an approved method,” but whether the *generic* can show “an approved method” that the patent “*does not claim*.” Plainly, Caraco has carried that burden.

The decision below also nullifies the statute’s language authorizing courts to order brands to “correct” inaccurate “patent information.” When a patent claims *no* approved use, it should not be listed in the Orange Book at all, and the remedy is “deleting” it. If the counterclaim addressed only that situation, however, Congress’s reference to “correct[ing]” patent information would become “inoperative or superfluous, void or insignificant.” See *Corley v. United States*, 129 S. Ct. 1558, 1566 (2009). Thus, reading the statute to effectively eliminate the word “correct” is “in-

consistent with the explicit statutory language.” Pet 32a (Dyk, J., dissenting).

I.B. *Second*, the court below erred in holding that Novo’s patent use code is not “patent information submitted * * * under subsection (b) or (c)” of section 505 of the FDCA. 21 U.S.C. § 355(j)(5)(C)(ii)(I). By that court’s reasoning, the term “patent information” “could only mean the patent number and expiration date,” as that is the only patent information actually “described” in Section 505(b). Pet. 15a. But a use code describes the *patent’s* scope, and thus is “*patent* information” within any fair reading of that term. And while several other Hatch-Waxman provisions refer to patent information “described in,” “required by,” or “prescribed by” the Act,⁴ the counterclaim uses different language. It speaks of patent information “submitted under” Sections 505(b) and (c)—language used throughout the Act to reference patent information submitted under FDA’s regulations. See also *Ardestani v. INS*, 502 U.S. 129, 135 (1991) (the term “under,” followed by a statutory provision, refers to regulatory proceedings subject to, or governed by, that provision).

Furthermore, this reading of “patent information” is consistent with FDA’s, which Congress adopted in enacting the counterclaim. Just months before Congress acted, FDA expressly invoked Sections 505(b) and (c) as the basis for its regulations governing “Submission of patent information”; and FDA Form 3542 states that all patent information “is provided in accordance with Section 505(b) and (c).” Pet. 211a. The “patent information” that FDA required included accurate and detailed use codes describing the scope

⁴ *E.g.*, 21 U.S.C. §§ 355(c)(2), 355(d)(6), 355(e)(4).

of the relevant patents. And Congress was both constructively and actually aware of this when it enacted the counterclaim. Given the similarity of phrasing between FDA's regulations and the counterclaim, it is evident that Congress was adopting FDA's definition in referring to "patent information * * * submitted under subsection (b) or (c) of section 505."

I.C. Reversal is also warranted because the Federal Circuit's readings of "an approved method" and "patent information" contravene "the structure of the 1984 Act taken as a whole." *Eli Lilly & Co. v. Medtronic, Inc.*, 496 U.S. 661, 669 (1990).

The point of the counterclaim statute is to provide a remedy for gamesmanship that delays generic competition. Yet the Federal Circuit read the statute in a manner that effectively licensed brands to block concededly non-infringing generic drugs, eliminated the statute's remedy for "correcting" patent information, and "eviscerate[d] Section viii." Pet. 62a (Gajarsa, J., dissenting). In effect, brands have been handed the ability to extend their patents to cover "unpatented uses." *Ibid.*

Given the complementary nature of the counterclaim and Section viii, it should take "strong evidence to persuade [the Court] that" Congress "create[d] an effective extension of the patent." *Eli Lilly*, 496 U.S. at 670, 673. Yet Novo cannot explain why Congress would authorize injunctions to "delete" misleading patent information when a patent claims *no* approved use, but not to "correct" misleading patent information used to block marketing for *a subset* of non-infringing uses. This is particularly true under an Act designed to expedite generic competition.

II. Because there is “an approved method of using the drug” that Novo’s patent “does not claim,” Caraco is entitled to an order requiring Novo to “correct” its use code. As the United States explains, “[a]n order to ‘correct or delete’ * * * patent information is appropriate * * * if the use code misleadingly suggests that the patent claims approved methods of use that it does not actually cover.” U.S. Invitation Br. 12. That is exactly the situation here. And there is no question what a “correct” use code looks like, as Novo’s original use code accurately detailed the only FDA-approved use claimed by Novo’s patent. This Court need only reinstate the district court’s injunction.

ARGUMENT

In interpreting Acts of Congress, this Court “begin[s]” with “the assumption that the ordinary meaning of the language chosen by Congress accurately expresses the legislative purpose.” *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2245 (2011). The Court pays particular attention to Congress’s phrasing choices in the FDCA, which “is a detailed and thorough piece of legislation” and is “quite specific” in “[i]ts treatment of many public health and food problems.” *Flemming*, 358 U.S. at 166 (citation omitted). In reading that Act, the Court is especially “mindful of [Congress’s] approach in terms of draftsmanship” and “sensitive to what Congress has written,” taking extra care only “to ascertain—neither to add nor to subtract, neither to delete nor to distort.” *Ibid.*

Congress drafted the counterclaim with just such precision. As a leading sponsor explained: To close “these loopholes,” “the devil is in the details. * * * Change an ‘an’ to a ‘the’ and you go from huge savings to huge cost. Senator Gregg and I saw multiple

examples of this as we worked out the technical details of the bill with the FDA. * * * The bill * * * is extremely carefully crafted.” *Greater Access Hearing, supra*, at 119 (statement of Sen. Schumer).

By changing the counterclaim’s plain language, overlooking its statutory context, and contravening its structure, history, and purpose, the decision below fails to respect Congress’s careful crafting, and must be reversed.

I. Under the Hatch-Waxman Act’s precisely drawn text, as well as its structure, history, and purpose, Caraco is entitled to bring a counterclaim.

A. The Federal Circuit’s reading of “does not claim an approved use” is textually untenable.

We begin with the specific words chosen by Congress. If a brand brings a patent infringement claim against a generic seeking FDA approval, the generic may bring a counterclaim:

(I) In general.—If * * * the [NDA] holder * * * for the drug that is claimed by the patent or a use of which is claimed by the patent brings a patent infringement action against the [ANDA] applicant, the [ANDA] applicant may assert a counterclaim seeking an order requiring the holder to correct or delete the patent information submitted by the holder under subsection (b) or (c) of this section on the ground that the patent does not claim either—

(aa) the drug for which the application was approved; or

(bb) an approved method of using the drug.

21 U.S.C. § 355(j)(5)(C)(ii)(I) (App. 55a).

Here, after being sued, Caraco filed a “counterclaim” establishing that the ’358 patent “does not claim * * * an approved method of using the drug” repaglinide. In fact, Caraco showed that Novo’s patent “does not claim” *either* repaglinide administered alone or repaglinide combined with TZDs—each of which is “an approved method of using the drug.”

The Federal Circuit rejected this sensible reading of the counterclaim. The court did not dispute that there is “an approved method of using the drug” that “the [’358] patent does not claim.” Rather, it held that “the counterclaim is available only if the * * * patent does not claim *any* approved methods,” because “*‘an approved method’ means ‘any approved method.’*” Pet. 12a, 13a (emphasis added). For several reasons, that reading is textually impermissible.

1. Substituting “any” for “an” alters the meaning of the counterclaim, and ignores the use of “any” in the next sentence.

Most importantly, Congress did not say “any”; it said “an.” “[C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there. When the statutory language is plain, the sole function of the courts—at least where the disposition required by the text is not absurd—is to enforce it according to its terms.” *Arlington Cent. Sch. Dist. Bd. of Educ. v. Murphy*, 548 U.S. 291, 296 (2006) (citations and quotations omitted). And the statutory language is plain here.

a. The counterclaim required Caraco to show that “the patent [in suit] does not claim * * * an approved method of using the drug.” Having made that show-

ing for two approved methods—repaglinide monotherapy and repaglinide combined with TZDs—Caraco should prevail. It is irrelevant that Caraco also could have prevailed if it had been able to show that the patent did not claim *any* approved use—in that “an” is necessarily satisfied if the broader “any” is satisfied. This is the natural effect of Congress choosing “an” rather than “any.”

By substituting “any” for “an,” the majority below changed the statute’s meaning. Unlike “an,” “any” is an “expansive and unqualified” word with a “wide reach” and a “sweeping” meaning. *Salinas*, 522 U.S. at 57 (“expansive, unqualified”); *Massachusetts v. EPA*, 549 U.S. 497, 528 (2007) (“sweeping”); *Boyle v. United States*, 129 S. Ct. 2237, 2243 (2009) (“obviously broad”; “wide reach”); accord *Kasten v. Saint-Gobain Performance Plastics Corp.*, 131 S. Ct. 1325, 1332 (2011) (“broad interpretation”); *Repub. of Iraq v. Beatty*, 129 S. Ct. 2183, 2189 (2009) (“of course * * * expansive”); *Ali v. Fed. Bureau of Prisons*, 552 U.S. 214, 219 (2008) (“broad”); *Dep’t of Housing & Urban Dev. v. Rucker*, 535 U.S. 125, 131 (2002) (“expansive”); *United States v. Gonzales*, 520 U.S. 1, 5 (1997) (“an expansive meaning, that is, one or some indiscriminately of whatever kind”) (citation omitted). As these many citations show, Congress knows how to use the expansive term “any.” Yet it did not do so in the counterclaim phrase at issue. Cf. *Chamber of Commerce of the United States of Am. v. Brown*, 554 U.S. 60, 72 (2008) (state statute; “expansive[]”); *Norfolk S. Ry. Co. v. Kirby*, 543 U.S. 14, 31-32 (2004) (“expansive” term in contract, lending “obvious” meaning).

That decision is all the more significant given that Congress used the term “any” in the very next sen-

tence: “Subclause (I) does not authorize the assertion of a claim described in subclause (I) in *any* civil action or proceeding other than a counterclaim described in subclause (I).” 21 U.S.C. § 355(j)(5)(C)(ii)(II) (emphasis added). Indeed, Congress used “any” nine more times in the surrounding subsection (21 U.S.C. § 355(j)(5)(C)) and 34 times in the ANDA provisions of the Hatch-Waxman Amendments (*id.* § 355(j)).

“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” See *Lopez*, 549 U.S. at 55 (internal quotation marks omitted). All the more so where a term appears in the very same provision. Congress’s refusal to use “any” in the phrase at issue thus confirms that “any” must not be read into that phrase. See *Sullivan v. Everhart*, 494 U.S. 83, 89-90 (1990) (interpreting a statute requiring HHS to correct mistaken payments of benefits to permit “netting” out multiple payments; explaining that, “[i]f Congress had in mind only * * * individual monthly payments * * * it would have been more natural to refer to ‘the correct amount of *any payment*,’ and to require adjustment ‘with respect to *any payment*,’ since the ‘fuller context’ showed that “[t]his terminology is used elsewhere in [the same provision]”).

Congress’s omission of “any” stands out even more given the legislative history, which warns: “Change an ‘an’ to a ‘the’ and you go from huge savings to huge cost.” *Greater Access Hearing, supra*, at 119 (emphasis added). “Change an ‘an’ is exactly what the court below did in substituting “any” for “an.” The result was to change the statute’s meaning, in violation of “what Congress has written” in this “detailed” and

“extremely carefully crafted” statute. *Ibid.*; *Flemming*, 358 U.S. at 166.

b. Remarkably, the Federal Circuit “detect[ed] no ambiguity” that Congress, in selecting the term “an,” really meant “any.” Pet. 12a. “When an indefinite article is preceded and qualified by a negative,” the majority reasoned, “standard grammar generally provides that ‘a’ means ‘any.’” *Ibid.* In support, the majority cited two dictionary examples showing that “an” can be qualified with a negative to mean “any.” *Ibid.* (“not a drop to drink”; “not a one”) (citations omitted).

But two examples of usage do not create rules of “standard grammar.” And the mere fact that “an,” when qualified by a negative, *can* mean “any,” does not show that it means “any” here. Cf. *Dist. of Col. v. Heller*, 554 U.S. 570, 588 (2008) (“the fact that [a] phrase was commonly used in a particular context does not show that it is limited to that context”). Indeed, as the dissent below noted, the examples chosen by the majority were taken from secondary definitions. Pet. 41a.

A simple illustration confirms that the meaning of “an” depends on how the word is being used. Suppose A writes to B with news that she had another child. When relating the challenges of having more children, A adds: “My taxes were higher than they should be because I did not claim an exemption.” Read in context, this statement does not suggest that A did not claim *any* exemptions—only that she did not claim an exemption *for the latest child*. Any contrary reading would ignore the context.

The same is true of the Federal Circuit’s reading of “an approved method” to mean “*any* approved me-

thod.” Just as tax exemptions must be claimed on an individualized basis, so too must approved uses of drugs. And just as the context of A’s statement makes clear that “an exemption” refers to a particular exemption, so too the context in which the counterclaim is brought (where the applicant seeks approval for a particular approved method of use) makes clear that the counterclaim provision refers to a single approved method of using the drug. See also *First Nat’l Bank of St. Louis v. Missouri*, 263 U.S. 640 (1924) (declining to read “an” to mean “any” in a statute providing that “the usual business of each national banking association shall be transacted at an office or banking house located in the place specified in its organization certificate”; stating that the statute “employing, as it does, the article ‘an’ to qualify words in the singular number, would confine the association to one”).

Other examples confirm the point. Suppose a student in a college history class with various assigned readings states: “I failed the final exam because I did not read an assigned text.” One would not conclude that the student did not read *any* assigned text—only that she failed to read a particular text that turned out to be critical. Similarly, suppose a patient whose condition required taking various medicines tells his doctor: “I had to be hospitalized because I did not take a prescribed medicine.” One would not naturally conclude that he failed to take *any* medicine.

We could go on—“He failed to obtain a conviction because he did not prove an element of the offense.” “They lost the case because they did not address an applicable precedent.” “The cake did not rise because I did not include an ingredient.” “We could not close on the house because we did not complete an impor-

tant form.” “I arrived at the party late because I did not make a necessary turn.” None of these examples is a slight to “standard grammar.” Pet. 12a. The examples violate no grammatical rules at all. They simply show that, in ordinary usage of negative assertions, whether “an” means “any” depends upon the context.

In short, inserting the categorical word “any” into the text was not a neutral interpretive decision; it changed the counterclaim’s meaning. “Any” is an “expansive” and “unqualified” term (*Salinas*, 522 U.S. at 57); and as Subsection II of the counterclaim confirms, Congress knew how to say “any” in a negative assertion when it wanted to. Its decision not to include that term in the phrase “does not claim an approved method of using the drug” must therefore be respected.

2. The structure of the counterclaim, which places the burden of proof on “the ANDA applicant” and authorizes courts to order brands to “correct or delete” inaccurate patent information, further supports reversal.

This ordinary reading of “an” is confirmed by its context. *Johnson v. United States*, 130 S. Ct. 1265, 1270 (2010) (“[u]ltimately, context determines meaning”). It is a “fundamental principle of statutory construction * * * that the meaning of a word cannot be determined in isolation, but must be drawn from the context in which it is used.” *Deal v. United States*, 508 U.S. 129, 132 (1993). Here, several aspects of the

immediate statutory context confirm that “an” does not mean “any.”⁵

a. *First*, it is “the ANDA applicant” that bears the burden of proof under the statute. According to Novo, Caraco cannot state a counterclaim because Novo has shown “that the patent-in-suit *does* claim an approved use.” Opp. 19 (emphasis added). But that is not what the counterclaim asks. It requires “the ANDA applicant” (the generic seeking “patent certainty”) to show that “the patent *does not* claim * * * an approved method of using the drug.” Thus, the counterclaim asks not whether the *brand* can show that its patent *does claim* “an approved method,” but whether the *generic* can point to “an approved method” that the patent “*does not* claim.” Ignoring this vital aspect of the Act’s text and structure, Novo invites the Court to read the statute backwards—as if the counterclaim placed the burden on the brand.

Novo’s reading also rests on a logical fallacy—namely, that whether the patent claims an approved method of use is necessarily an either-or proposition. Only if that were true could Novo’s showing that the patent claims one approved use defeat the counterclaim. Frequently, however, a drug has multiple approved uses, and the patent-in-suit claims only a subset of those uses. In those situations, it can simultaneously be true that the patent *both* (1) “claims an

⁵ Even “[a]ny’ can and does mean different things depending on the setting.” *Nixon v. Mo. Mun. League*, 541 U.S. 125, 132 (2004); see *Kasten*, 131 S. Ct. at 1332 (Scalia, J., dissenting) (“the modifier ‘any’ does not cause a word that is in context narrow to become broad. The phrase ‘to cash a check at any bank’ does not refer to a river bank, or even a blood bank.”).

approved method of use” *and* (2) “does not claim an approved method of use.” That is why the counterclaim’s structure—which turns on the generic’s ability to identify an approved use that the patent “does not claim”—is so important. See *Eli Lilly*, 496 U.S. at 669 (Hatch-Waxman must be read in light of “the structure of the * * * Act taken as a whole”).

Congress knew that certain drugs have multiple approved uses. As the counterclaim’s first phrase states, generics may bring counterclaims when, among other requirements, they are sued by “the [NDA] holder * * * for the drug that is claimed by the patent or *a* use of which is claimed by the patent.” (Emphasis added). Had Congress believed that the counterclaim applied only where there was *one* approved use, it would have been far more natural for Congress to refer to “*the* use of [the drug] claimed by the patent.” Similarly, generics invoking Section viii must certify that the “method of use patent * * * does not claim *a* use for which the applicant is seeking approval.” 21 U.S.C. § 355(j)(2)(A)(viii) (emphasis added). Thus, there is no question that the counterclaim was designed to address situations in which the listed patent claims some, but not all, approved uses.⁶

b. *Second*, the decision below overlooks the counterclaim’s phrase “*correct or delete* patent information.” (Emphasis added.) In fact, that decision offered no explanation why the term “correct” is not

⁶ This conclusion is consistent with the Dictionary Act. 1 U.S.C. § 1 (“unless the context indicates otherwise,” “words importing the singular include and apply to several persons, parties, or things”). By contrast, reading “an” as “any”—that is, not a single one—prevents “an” from referring to multiple unclaimed uses.

“render[ed] superfluous,” in violation of basic rules of statutory construction. See *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 112 (1991).

Under the ruling below, a counterclaim is available only where the patent listed in the Orange Book claims neither the drug at issue nor any approved method of using it—the problem in the *Mylan* case. *Supra* at 13-14. As the dissent recognized, however, the patent in those cases should not be listed *at all*, and the only proper remedy is “deleting” it. Pet. 32a (Dyk, J., dissenting). If the statute were limited to this situation, Congress’s reference to “correct[ing]” the brand’s patent information would serve no meaningful purpose. As Judge Dyk observed: “[V]iewing [the counterclaim] as limited to complete delisting would be inconsistent with the explicit statutory language, which provides for correction of Orange Book information” as well. *Ibid.* In fact, under the ruling below, the counterclaim would be unavailable even to correct an erroneous expiration date for a patent that claims either the drug or *any* approved method of use.

This Court need not look beyond the statute’s reference to “correct[ing]” patent information to see that Congress was not simply reversing *Mylan*. And even if *Mylan* had “prompted the *proposal* of [the counterclaim],” “whether that alone accounted for its *enactment* is quite a different question.” *Eli Lilly*, 496 U.S. at 670 n.3. But the legislative history further confirms the textual interpretation.

The year before the counterclaim was enacted, the FTC issued an extensive, 129-page study describing myriad strategies that brands used to delay generic entry, including “improper Orange Book listings.” FTC, *Generic Drug Entry Prior to Patent Expira-*

tion, v (July 2002). One solution the FTC proposed was to allow a generic to bring a counterclaim in the context of patent infringement litigation. *Ibid.*

The legislative history contains no significant discussion of *Mylan*, but repeatedly cites the FTC study. Congress heard testimony from the FTC's chairman multiple times. As one senator noted, "to believe that the patent laws are not being abused, is to ignore the mountain of testimony from consumers, industry analysts, and the Federal Trade Commission." 149 Cong. Rec. at 15514 (statement of Sen. McCain). And as the FTC's Chairman testified, "[c]onsistent with an FTC Study recommendation, both the Senate and House bills provide generic applicants a new tool to correct patent information listed in the Orange Book." *Greater Access Hearing, supra*, at 114 (statement of Chmn. T. Muris).

FDA likewise urged that, to resolve problems with the scope of patent use codes, "the courts are the appropriate mechanism." 68 Fed. Reg. 36683; see 149 Cong. Rec. at 16689 (statement of Sen. Hatch) ("both the [FTC] and the [FDA] played a constructive role in attempting to end several mechanisms * * * to game the system"). "In fact, when the FDA actually talked about closing these loopholes, it was made clear that legislation would be needed to finish the job." 149 Cong. Rec. at 15516 (statement of Sen. Schumer); accord *id.* at 31200. Thus, "[t]he bill provides a critical complement to the work the FDA has done in clarifying its regulations on patent listing, but it goes much further." *Legislative and Regulatory Responses Hearing, supra*, at 19. Specifically, "the provisions enforce the patent listing requirements at the FDA by allowing a generic applicant * * * to file a counterclaim to have the brand drug company delist the patent or

correct the patent information in FDA's Orange Book." 149 Cong. Rec. at 31200 (emphasis added).

Given this history, it is fanciful to say that the term "correct" might apply "[i]f an error were made," such as listing "the wrong patent number." Opp. 23. Congress did not face a "mountain of testimony" from consumers, industry analysts, FTC, and FDA because brands were error-prone—hitting the wrong keys and listing in the Orange Book patents for products other than new drug compounds and uses. Rather, "[w]hat [Congress] saw * * * was [that] there were games being played," and it "address[ed] those issues." 149 Cong. Rec. at 15517 (statement of Sen. Gregg).

Novo cannot explain why Congress would trouble itself to create a counterclaim so that generics could obtain a court order forcing brands to correct typos—something brands already have an incentive to do.⁷ And, of course, even if Congress had done so, the remedy in that circumstance would be "deleting" the patent.

* * * * *

In sum, the interpretation adopted below is foreclosed by several aspects of the Act's text and structure: The counterclaim's use of "an" rather than "any"; its provision that courts may "correct *or* delete" inaccurate patent information; its reference to "a use" rather than "the use" claimed by the patent; and the fact that Congress placed the burden on the *generic* to

⁷ Because generics' Paragraph I-IV obligations—and thus the brand's opportunity to litigate before FDA approves the generic's ANDA—extend only to listed patents (21 U.S.C. § 355(j)(2)(A)(vii)(I)-(IV)), brands have ample incentive to fix mistaken patent numbers.

identify “an approved method” that the patent “*does not* claim.” The legislative history further confirms that the lower court’s reading is untenable.

B. Novo’s patent use code is “patent information submitted by the holder under subsection (b) or (c)” of Section 505.

The Federal Circuit further erred in holding that patent use codes are not “patent information submitted by the holder under subsection (b) or (c)” of section 505 of the FDCA. 21 U.S.C. § 355(j)(5)(C)(ii)(I). The meaning is plain. As explained below, a use code describing a patent’s scope is, in fact, “information” about a “patent,” and that information is submitted to the FDA under a regulation entitled “Submission of patent information.”

1. The counterclaim refers to patent information “submitted under” subsection 505(b) or (c), not patent information “described in” or “prescribed by” those subsections.

Like the court below (Pet. 15a), Novo insists that the counterclaim covers “information ‘submitted under’ (*and thus specified in*) Section 355(b) or (c).” Resp. Supp. Br. 4 (emphasis added). But the counterclaim does not say “specified in” or “described in.” It says “submitted * * * under.” And this language stands in contrast to other sections of the Act, which *do* refer to patent information “described in,” “required under,” or “prescribed by” subsections (b) or (c).⁸

⁸ *E.g.*, 21 U.S.C. § 355(c)(2) (“patent information *described in* subsection (b) * * * could not be filed with the submission of an application under subsection (b) of this section

Thus, when Congress intended to refer to the specific types of patent information described in subsection (b) or (c)—*i.e.*, patent numbers and expiration dates—it did so expressly. Yet Congress did not use such language in the counterclaim. Accord U.S. Invitation Br. 14 (“the counterclaim provision does not refer to patent information ‘required by’ or ‘specified in’ Sections 355(b) or (c), and the actual statutory language encompasses a broader range of information”). Rather, Congress used the phrase “submitted under,” phrasing it used throughout the Act when referring to patent information submitted under FDA regulations.⁹

Reading the Act “as a whole,” therefore, it is clear that Congress did not limit the courts’ ability to correct inaccurate “patent information” to cases involving incorrect patent numbers or expiries. See *Eli Lilly*, 496 U.S. at 669 (Hatch-Waxman must be read “as a whole”); see also *Ardestani*, 502 U.S. at 135 (the

because the application was filed before the patent information was *required under subsection (b)* of this section or a patent was issued after the application was approved under such subsection”) (emphasis added); *id.* § 355(d)(6) (“If the Secretary finds * * * the application failed to contain the patent information *prescribed by* subsection (b) of this section”) (emphasis added); *id.* § 355(e)(4) (“the patent information *prescribed by* subsection (c) of this section was not filed within thirty days * * *”) (emphasis added).

⁹ See 21 U.S.C. § 355(c)(2) (“Upon the *submission* of patent information *under* this subsection, the Secretary shall publish it.”) (emphasis added); *id.* § 355(j)(5)(D)(i)(I)(bb)(CC) (“The patent information *submitted under subsection (b) or (c)* of this section is withdrawn by the holder of the application approved under subsection (b) of this section.”) (emphasis added).

term “under,” followed by a statutory provision, refers to regulatory proceedings subject to, or governed by, that provision). And as the United States observes: “A use code is ‘patent information’ within any usual understanding of that term because it is ‘information’—a ‘description of the patented method of use,’ 21 C.F.R. § 314.53(c)(2)(ii)(P)(3)—about a ‘patent.’” U.S. Invitation Br. 13.

2. Novo submitted its use code under subsection 505(b) or (c).

The patent information here also was plainly “submitted under” Sections 505(b) and (c). FDA relied on those very provisions in promulgating its regulation, entitled “Submission of patent information.” 21 C.F.R. § 314.53. As FDA explained in the 2003 Final Rule, its “principal legal authority for the final rule is section 505 of the act”—in particular, “the patent submission * * * requirements” of “Section 505(b) and (c).” 68 Fed. Reg. at 36697-98.¹⁰

These regulations require brands to submit patent use code descriptions for method patents—*i.e.*, “[t]he description of the patented method of use as required for publication” in FDA’s Orange Book. 21 C.F.R.

¹⁰ Citing FDA comments from 2007, Novo suggests that the 2003 rule was based on FDA’s “general rulemaking authority and subsection (j),” as opposed to subsections (b) or (c). Opp. 27. But subsection (j) refers to ANDAs, not patent submission requirements for NDA holders. Moreover, the very pages cited by Novo reiterate that “the basis for requiring a description of each individual method of use for which a patent is submitted for listing” was discussed “in the June 2003 final rule” (72 Fed. Reg. at 21268)—namely, § 505(b) and (c). And even in 2007, FDA continued to invoke § 505(b). *Id.* at 21268-21689.

§ 314.53(c)(2)(ii)(P)(3). This submission must take a particular form. *Id.* § 314.53(c)(2)(ii); see 68 Fed. Reg. at 36686 (Form 3542 “requires * * * a description of the approved methods of use”); Pet. 211a (Form 3542). As Novo’s own “patent information” form states on the top, Novo’s submission was “provided in accordance with Section 505(b) and (c) of the Federal Food, Drug, and Cosmetic Act”:

Department of Health and Human Services Food and Drug Administration	Form Approved: OMB No. 0910-0513 Expiration Date: 7/31/10 See OMB Statement on Page 3.
PATENT INFORMATION SUBMITTED UPON AND AFTER APPROVAL OF AN NDA OR SUPPLEMENT <i>For Each Patent That Claims a Drug Substance (Active Ingredient), Drug Product (Formulation or Composition) and/or Method of Use</i>	NDA NUMBER 20-741
	NAME OF APPLICANT/NDA HOLDER Novo Nordisk Inc.
<i>The following is provided in accordance with Section 505(b) and (c) of the Federal Food, Drug, and Cosmetic Act.</i>	
TRADE NAME Prandin	

Pet. 211a; JA97. In sum, Novo’s patent use code was “submitted under” FDA’s “Submission of patent information” regulations and Sections 505(b) and (c) of the Act.

3. FDA reasonably interpreted “patent information” to include use codes.

The court below concluded otherwise by misconstruing the Act as including an “express statutory definition” that limits “patent information” to “the patent number and the expiration date.” Pet. 15a. But Hatch-Waxman contains no definition of “patent information,” let alone such a restrictive one. 21 U.S.C. § 321 (definitions). Pursuant to subsection 505(b), brands must file patent numbers and expirations of method patents *only* if they actually “claim[] a method of using such drug and with respect to which a claim of patent infringement could reasonably be asserted.” *Id.* § 355(b)(1)(G). Yet the statute provides FDA with no guidance to determine whether a me-

thod patent satisfies this criteria—a determination particularly relevant under Section viii.

Moreover, while subsection (b) states that “patent information” *includes* “the patent number and the expiration date” (*ibid.*), it does not preclude FDA from requiring “more specific information on the approved methods of use protected by a submitted patent”—which is “necessary” “[t]o effectively implement the [Paragraph IV] certification and section viii statement provisions” (68 Fed. Reg. at 36682, 36683). As FDA explained: “Only with this information can we determine what submission is required of [generics].” *Id.* at 36683. “[A]ccurate and detailed information related to the approved methods of use” is “essential” to FDA’s ability to “expedite [its] review of ANDA * * * applications that do not seek approval for all the approved uses”—a statutory duty. *Id.* at 36682, 36685.

At a minimum, therefore, FDA acted reasonably in reading the Act to authorize requiring such information as part of—*i.e.*, in a “submi[ssion] under”—the NDA process set forth in 21 U.S.C. § 355(b)-(c). *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 843-844 (1984) (where “Congress has explicitly left a gap for an agency to fill, [and] there is an express delegation of authority to the agency to elucidate a specific provision of the statute by regulation,” regulations “are given controlling weight unless * * * manifestly contrary to the statute”). Indeed, Novo has never challenged FDA’s authority to promulgate its “Submission of patent information” regulations.

4. Congress ratified FDA's definition of "patent information."

Even if FDA lacked such authority in the first instance, Congress ratified the agency's "Submission of patent information" requirements when it created the counterclaim. "[O]nce an agency's statutory construction has been 'fully brought to the attention of the public and the Congress,' and the latter has not sought to alter that interpretation although it has amended the statute in other respects, then presumably the legislative intent has been correctly discerned." *United States v. Rutherford*, 442 U.S. 544, 554 n.10 (1979) (invoking Congress's failure to reject FDA's interpretation of the FDCA upon amending the Act as support for ratification). And as Judge Dyk explained, "Congress was well aware of [FDA's] regulatory interpretation of 'patent information' when it enacted the counterclaim provision," providing "compelling evidence of legislative adoption." Pet. 36a, 37a (collecting legislative history); accord U.S. Invitation Br. 14.

Indeed, Congress not only had constructive knowledge of FDA's reading of "patent information" under Sections 505(b) and (c); it repeatedly heard testimony about and "cited approvingly" FDA's regulations (Pet. 36a) in the course of adopting the counterclaim.¹¹ As

¹¹ In addition to the many authorities collected by the dissent below (Pet. 36a), see 149 Cong. Rec. 31200 (statement of Sen. Schumer) ("the provisions enforce the patent listing requirements at the FDA by allowing a generic applicant to file a counterclaim to have the brand drug company delist the patent or correct the patent information in FDA's Orange Book."); *Legislative and Regulatory Responses Hearing, supra*, at 5-10 (statement of D. Troy, Chief Counsel for FDA); *Greater Access Hearing, supra*, at

the lead sponsor put it: “The bill provides a critical complement to the work the FDA has done in clarifying its regulations on patent listing, but it goes much further.” *Legislative and Regulatory Responses Hearing, supra*, at 19.

Moreover, Congress was legislating in the precise area of the regulations’ application, and adopted language that closely tracks the text of the regulations and Form 3542, both promulgated months earlier:

Counterclaim: “patent information submitted by the [NDA] holder under subsection (b) or (c) of [Section 505]”;

Regulation: “Submission of patent information” by an NDA applicant “under section 505(b) of the act” (21 C.F.R. § 314.53); “patent information * * * submitted under section 505(b) or (c)” (21 C.F.R. § 314.94(a)(12)(iii)(A) and (B));

Form 3542: “patent information submitted upon and after approval of an NDA” and “provided in accordance with Section 505(b) and (c) of the [FDCA]” (Pet. 211a).

As a comparison of the text of these authorities confirms, Congress’s use of the phrase “patent information submitted under” was no coincidence. Rather, Congress knew about, was referring to, and by

7-10 (same). In fact, FDA has required brands to submit more than patent numbers and expiries since 1994. See 59 Fed. Reg. 50338, 50363 (Oct. 3, 1994) (promulgating rules requiring submission of, among other things, a declaration that the patent covers a drug or its approved use).

adopting parallel language ratified FDA’s “Submission of patent information” regulations, which describe in detail what “patent information” is, and how it is to be “submitted.” 21 C.F.R. § 314.53. It is difficult to imagine a clearer case of ratification.

C. The counterclaim should not be read to permit brands to thwart competition by eviscerating Section viii and effectively extending the scope of their patents.

As we have shown, the Federal Circuit’s readings of the phrases “an approved method” and “patent information” are foreclosed by the Act’s text, structure, and extensive legislative history. Reversal is also warranted, however, because those readings contravene the broader structure and purpose of the Act and the patent laws. Indeed, it is no exaggeration to say that the decision below leads to absurd results—effectively writing Section viii out of the statute, eliminating the remedy of “correcting” patent information, and licensing brands to block non-infringing generic competition under a law designed to promote such competition.

By limiting the counterclaim to cases in which the brand’s patent does not claim “*any* approved use” of the drug, the ruling below “eviscerates Section viii”—“a critical provision” that “facilitates the approval and marketing of lower-cost generic drugs for uses no longer protected by a patent.” Pet. 62a, 59a (Gajarsa, J., dissenting). Brands are now free to use their patents to block the sale of generic drugs that concededly do not infringe—effectively extending their limited method-of-use patents “to unpatented uses.” *Id.* at 62a. That would be extraordinary under any statute, but it is particularly troubling under a law designed

to create “patent certainty” (21 U.S.C. § 355(j)(5)(C)(ii)(I)) and expedite generic competition. As Judge Gajarsa put it, that Caraco must “wait to launch its generic repaglinide product until 2018, the date on which Novo’s ’358 patent on the combination therapy expires—despite the fact that the ’358 patent concededly does not cover the use for which Caraco seeks to market the drug”—“is an untenable and absurd result.” Pet. 63a.

The Act does not require such a result. Rather, Section viii and the counterclaim were “meant generally to be complementary,” and this Court’s Hatch-Waxman precedent requires that they be read that way. *Eli Lilly*, 496 U.S. at 673-674.

1. The ruling below threatens to eviscerate Section viii.

Section viii enables generics to avoid infringement litigation where, as here, the generic seeks to market its drug solely for non-infringing uses. The ruling below, however, effectively “render[s] Section viii a dead letter” (Pet. 62a), in violation of the basic rule that “[a] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.” *Corley*, 129 S. Ct. at 1566 (quoting *Hibbs v. Winn*, 542 U.S. 88, 101 (2004)).

a. When a generic files a Paragraph IV certification, that constitutes an artificial act of infringement that obligates the brand either to sue or risk FDA approval of generic marketing. 35 U.S.C. § 271(e)(2). If the brand sues, FDA approval is generally stayed for 30 months or until the generic prevails—in which case FDA may approve the ANDA. 21 U.S.C. § 355(j)(5)(B)(iii). Further, if the generic is the first

ANDA filer, it is eligible for 180 days of market exclusivity before other generics can enter the market. *Id.* § 355(j)(5)(B)(iv). But generics must generally prevail in court to obtain FDA approval under Paragraph IV.

Section viii, by contrast, is designed to avoid litigation. It “facilitates the approval and marketing of lower-cost generic drugs for uses no longer protected by a patent.” Pet. 59a. Where the patent information submitted by the brand asserts that “a patent claims at least one, but not all, approved methods of using a drug” (Pet. 13a), Section viii allows the generic to certify that the patent “does not claim a use for which the applicant is seeking approval.” 21 U.S.C. § 355(j)(2)(A)(viii). The generic may submit carved-out labeling that does not refer to the patented uses (Pet. 6a); and if the FDA approves it, litigation is unnecessary. But even if it is the first Section viii filer, a generic cannot obtain 180 days of marketing exclusivity under Section viii.

Paragraph IV and Section viii thus offer tradeoffs. Prevailing in Paragraph IV suits holds the promise of a non-infringement or invalidity ruling—enabling the generic to sell its drug for *all* approved uses—and for first filers 180 days of marketing exclusivity. Section viii offers only the ability to market drugs for *some* approved uses, with no prospect of marketing exclusivity. Yet Section viii avoids the “hazard[s] of sparking costly litigation.” *Teva Pharms. USA, Inc. v. Sebelius*, 595 F.3d 1303, 1305 (D.C. Cir. 2010). It is therefore “essential to the [Act’s] operation.” Pet. 29a.

b. The decision below “eviscerates Section viii.” Pet. 62a (Gajarsa, J., dissenting). The ruling creates

“every incentive” for brands “to follow Novo’s lead and draft exceedingly broad use codes,” “thereby insulating themselves from generic competition.” *Ibid.*

Overbroad use codes eliminate the option of using Section viii. Normally, a generic drug’s labeling must be “the same as the labeling approved for the [branded] drug.” 21 U.S.C. § 355(j)(2)(A)(v). FDA will thus accept proposed carved-out labeling only if it can determine that the proposed labeling avoids the patent as described in the brand’s use code. Pet. 6a. An overbroad use code makes that impossible. As a result, generics can reach the market early only through protracted Paragraph IV litigation—where their approval will depend on proving patent *invalidity*—when they should not even have to litigate.

To be sure, even without Section viii, some generics might reach the market by winning a Paragraph IV suit. But the point of Section viii is that a generic should not have to litigate *at all*, because carved-out labeling altogether avoids infringement. Being forced to litigate is thus a direct affront to Congress’s ultimate goal of “get[ting] generic drugs into the hands of patients at reasonable prices—fast.” *Barr Labs.*, 930 F.2d at 76. And delaying the sale of what otherwise would be *concededly* non-infringing drugs while generics litigate patent validity is an “absurd result.” Pet. 63a.

c. Moreover, by eliminating the Act’s check on allowing brands to overstate their patents, the decision below “effectively allows a patent holder to extend its monopoly to unpatented uses.” Pet. 62a. This is especially troubling under Hatch-Waxman. In other markets, competitors that wish to market allegedly infringing products can launch at risk and litigate

later. But marketing drugs requires FDA approval. *Eli Lilly*, 496 U.S. at 670-671. Thus, if brands can bottle up the approval process, generics are excluded from the market even where there is concededly no risk of infringement. The counterclaim prevents such “gam[ing] of the system,” but the ruling below renders that provision “a virtual nullity.” Pet. 59a, 60a.

In sum, the fractured decision below gives brands “another way to game the system.” Pet. 60a (Gajarsa, J., dissenting). Brands “now have every incentive” to “submit[] overbroad and inaccurate use codes,” thus “subverting [generics] carve-out statements,” “delaying the onset of generic competition,” and “rendering Section viii a dead letter.” *Id.* at 60a, 62a.

2. *Eli Lilly* requires “strong evidence” to support reading the Act to permit an effective expansion of a patent’s scope, and such evidence is absent here.

Structural problems such as these, which effectively expand the reach of a patent, are telltale signs of misinterpretation under *Eli Lilly*. There, faced with a Hatch-Waxman provision that (unlike the counterclaim) was “not plainly comprehensible on anyone’s view,” this Court turned to “the structure of the 1984 Act taken as a whole.” 496 U.S. at 669; accord *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 133 (2000) (“A court must * * * interpret the statute as a symmetrical and coherent regulatory scheme and fit, if possible, all parts into a harmonious whole.”) (citations and quotation marks omitted). A similar analysis requires reversal here.

In *Lilly*, the Court considered the safe harbor of 35 U.S.C. § 271(e)(1), which exempts from patent in-

fringement the use of “a patented invention * * * for uses reasonably related to the development and submission of information” to FDA “under a Federal law which regulates the manufacture, use, or sale of drugs.” The question was whether this safe harbor extended to medical devices. The answer would be no, of course, if “a Federal law” referred “to those individual provisions of federal law that regulate drugs.” 496 U.S. at 665. But devices would be covered if “a Federal law” referred to “the entirety of any Act * * * at least some of whose provisions regulate drugs.” *Id.* at 665-666.

Given conflicting textual signals, the Court chose the reading that best “fit” Hatch-Waxman’s provisions together to cure twin patent-term “distortions” targeted by Congress. *Id.* at 674. On the one hand, during a patent’s infancy, a manufacturer might spend years developing a device and waiting for FDA approval; on the other hand, as the patent aged, competitors were forced to wait for the patent’s expiration even to begin research and development. *Id.* at 670-671. To correct these “dual distorting effects,” the Court observed, Hatch-Waxman established, on the front end, a term extension for patents relating to products subject to lengthy regulatory delays and, on the back end, a safe harbor for experimentation. *Id.* at 672. Since these provisions were “meant generally to be complementary,” the Court was not surprised that “[a]ll of the products eligible for a patent term extension” were “subject to [the safe harbor].” *Id.* at 673-674.

Because makers of devices were expressly entitled to the term extension on the front end, the Court held that competitors were implicitly covered by the safe harbor on the back end. That is, the Court chose the

reading of the safe harbor provision that “*appears to create a perfect ‘product’ fit between the two sections.*” *Id.* at 674 (emphasis added). To do otherwise, the Court explained, would “leave in place an anticompetitive restriction at the end of the monopoly term” and “simultaneously expand the monopoly term itself.” *Id.* at 672. “It would take strong evidence to persuade us that this is what Congress wrought, and there is no such evidence here.” *Id.* at 673.

Like the patent-term extension and safe harbor in *Eli Lilly*, Section viii and the counterclaim were “meant generally to be complementary.” *Ibid.* Indeed, Section viii cannot function properly apart from the counterclaim, which precludes brands from thwarting Section viii carve-outs by filing overbroad patent use codes. *Supra* at 42-45. Therefore, the Court should read the counterclaim to create a “fit between the two sections.” 496 U.S. at 674. This means reading “an” to mean “an,” “patent information” to mean what Congress and FDA said it means, and “correct” to have teeth. Otherwise, a brand can effectively “extend its monopoly to unpatented uses.” Pet. 62a. As in *Eli Lilly*, it “take[s] strong evidence to persuade us that this is what Congress wrought, and there is no such evidence here.” *Id.* at 673.

In sum, to construe the counterclaim as the court below construed it, “one must posit” both “a good deal of legislative imprecision” and “an implausible substantive intent as well.” *Id.* at 679. This Court should not read the Hatch-Waxman Act that way. *Ibid.*

II. Caraco is entitled to an order enjoining Novo to reinstate its original patent use code.

As we have explained, Novo’s ’358 patent *does not* claim an approved use of repaglinide (indeed, it does

not claim two approved uses). Yet the parties are in Paragraph IV litigation precisely because Novo's use code led FDA to believe that its patent *does* claim those approved uses of repaglinide. By definition, therefore, Novo's patent use code is incorrect, and Caraco's counterclaim warrants entry of an injunction requiring its correction.

A. Having satisfied the requirements of the counterclaim, Caraco is entitled to an injunction.

Where a generic manufacturer shows that “the patent does not claim * * * an approved method of using the drug,” the counterclaim authorizes courts, on that basis, to enter “an order requiring the [patent] holder to *correct* or delete the patent information submitted by the holder.” 21 U.S.C. § 355(j)(5)(C)(ii)(I) (emphasis added). Thus, “correct” does not describe a *standard* to avoid liability under the counterclaim; it prescribes a *remedy* that becomes available once the counterclaim has been satisfied. And because Caraco has satisfied the counterclaim, it is entitled to an injunction requiring that Novo's use code be brought into conformity with the scope of its patent. As the United States encapsulates the framework: “An order to ‘correct or delete’ * * * patent information is appropriate * * * if the use code misleadingly suggests that the patent claims approved methods of use that it does not actually cover.” U.S. Invitation Br. 12.

It follows that Novo cannot be heard to say that, even if the counterclaim has been satisfied, nothing needs correcting. *E.g.*, Opp. 30-31. As we have shown, Novo is blocking Caraco's Section viii carved-out labeling by describing its patent in an overbroad

manner. Caraco was compelled to invoke the counterclaim to show the discrepancy between Novo's patent and its use code. Having successfully done so, Novo's Orange Book listing necessarily requires correcting.

The remedy is simple—restore Novo's original use code. Novo does not dispute that this description of its patent—"use of repaglinide in combination with metformin to lower blood glucose" (JA99)—was correct. Indeed, to this day Novo uses this precise language to describe the '358 patent in reference to its repaglinide-metformin combination product. JA52, 549 (use code U-546). Thus, this Court need only reinstate the district court's injunction requiring Novo to resubmit its original use code.

B. Under the ordinary meaning, structure, and purpose of the Hatch-Waxman Act's counterclaim provision, Novo's patent use code was not "correct."

Even if "correct" described a standard for avoiding liability under the counterclaim, rather than a remedy for satisfying the counterclaim, this Court should still enjoin Novo to correct its patent use code. Under any reasonable standard, that use code is incorrect.

1. "Correct" means "to make or set right" and "to alter or adjust so as to bring to some standard or required condition." *Webster's Ninth New Collegiate Dictionary* 293 (1983). By the statute's terms, therefore, courts may order that a brand's patent information be "set right" or "altered" to "bring [it] to some standard or required condition." *Ibid.*

The counterclaim itself provides the standard: The brand's patent information must inform the reader which "approved method[s] of using the drug"

the brand's patent "does not claim." 21 U.S.C. § 355(j)(5)(C)(ii)(I). And the point of the required use code is to describe the patent's scope, so FDA and generics can determine whether infringing uses may be carved out from the generic's labeling.

As the district court found, Novo's expanded use code—first submitted when FDA agreed to approve Caraco's Section viii statement—"is so broad as to incorrectly suggest that its patent generically covers three (3) different FDA-approved methods of use," when "it admits that the first two (2) uses are not covered." Pet. 68a. Accordingly, Novo's use code must be "corrected" to enable FDA and generics to tell that the '358 patent "does not claim" repaglinide as monotherapy or repaglinide in combination with TZDs—each of which is "an approved method of using the drug." No fact-finding or legal analysis is required.

Novo's original use code—which described its patent as covering only the "use of repaglinide in combination with metformin to lower blood glucose" (Pet. 44a; JA99)—was "correct" under this standard. It informed interested parties that the '358 patent "does not claim an approved method of using the drug" repaglinide, facilitating FDA's review and approval of Caraco's Section viii carve-out labeling.

The same cannot be said of Novo's newly minted use code: "a method for improving glycemic control in adults with type 2 diabetes mellitus." Pet. 45a. That use code "seriously misrepresents the approved method of use covered by [the patent]." Pet. 70a. The original use code should be ordered reinstated.

2. Faced with the ordinary meaning of "correct," the most Novo can say is that "[t]he counterclaim gives the [courts] no license to force Novo to choose

between two truthful alternatives.” Opp. 30. This is sophistry. The counterclaim’s applicability is not triggered by a submission to FDA that is “untrue” or “false” in some hyper-literal or abstract sense. Indeed, in contrast to other provisions of the Act, the counterclaim does not turn on whether the brand makes “an untrue statement of material fact” (21 U.S.C. § 355(j)(4)(K)) or a statement that is “false or misleading in any particular” (*id.* § 355(d)(7)). It turns on whether the information is “correct” in light of what the brand’s patent “does not claim.”

But even if truth were the standard, Novo’s use code could not fairly be described as truthful. “[T]he meaning of a word cannot be determined in isolation, but must be drawn from the context in which it is used.” *Deal*, 508 U.S. at 132. A patent is a property right, and “patent claims” define the “boundary of the patent monopoly.” *Gen. Foods Corp. v. Studiengesellschaft Kohle*, 972 F.2d 1272, 1274 (Fed. Cir. 1992) (citation and quotation marks omitted). Thus, this Court has “liken[ed] patent claims to the description of real property in a deed ‘which sets the bounds to the grant which it contains.’” *Ibid.* (quoting *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917)). And no one would reasonably defend as “truthful” a landowner’s claim that he owned more land than his deed indicates.

So too here. When a statute creates a cause of action to “correct” patent information that fails to describe what a patent “does not claim,” it is neither “truthful” nor “correct” to describe what the patent does claim in an overbroad way. Otherwise, brands could routinely submit patent use codes claiming “a method of treating disease,” thereby blocking possible carved-out labeling under any circumstance. That is

not sensible, particularly considering the meaning of the term “patent claim” and the point of the use code exercise—to describe the scope of the patent.

3. The surrounding text, statutory structure, and overall purpose of the counterclaim all confirm that whether “patent information” is “correct” for purposes of the counterclaim depends on whether it identifies the “approved method of use” that the related patent “does not claim.” Cf. *Sullivan*, 494 U.S. at 90 (looking to “fuller context” of statute to define “correct amount”). In light of the history of the 2003 amendments, the term “correct” signals Congress’s intent to give generics a judicial remedy for the games brands have played with Orange Book patent information. *Supra* at 30-33. The natural reading of “correct” also fits precisely with Congress’s express purpose. By enabling both FDA and generics to tell what a patent “does not claim,” that reading promotes “patent certainty.” 21 U.S.C. § 355(j)(5)(C)(ii)(I).

But even if the term “correct” reflected “legislative imprecision” (*Eli Lilly*, 496 U.S. at 679), Novo could not explain why Congress would want courts to order “deleting” misleading patent information when brands’ patents claim *no* approved use, but not “correcting” misleading patent information for *some subset of* approved uses. One tactic blocks generic marketing as well as another. And “submission of an overbroad or otherwise misleading use code can cause the same practical harm (unjustified delay in a generic drug’s entry into the market) as does the listing of a patent that claims *no* approved uses of the relevant drug.” U.S. Invitation Br. 16.

C. FDA’s regulations confirm that, to be “correct,” the patent use code must be accurate, detailed, and tailored to the patent’s scope.

The ordinary reading of “correct” is confirmed by FDA’s regulations, which Congress ratified in adopting the counterclaim provision. *Supra* at 39-41.

1. In promulgating the 2003 Final Rule, FDA repeatedly insisted that, to serve its statutory purpose, “the description of the approved use” must be “accurate and detailed.” 68 Fed. Reg. at 36682.¹² As FDA explained, “it is necessary that an NDA holder submit more specific information on the approved methods of use protected by a submitted patent. Only with this information can we determine what submission is required of the ANDA * * * applicants referencing the approved drug.” *Id.* at 36683.

¹² *E.g.*, 68 Fed. Reg. at 36682 (“[W]e do require identification of individual claims for method-of-use patents,” as “[t]his information will expedite our review of ANDA * * * applications that do not seek approval for all the approved uses. In determining whether an ANDA applicant can ‘carve out’ the method of use * * * we will rely on the description of the approved use provided by the NDA holder”); *ibid.* (“[FDA] require[s] the NDA applicant or holder to identify specifically the approved uses claimed by the method-of-use patent, with reference to the approved labeling,” which “permit[s] ANDA * * * applicants, and us, to assess whether the ANDA * * * applicant is seeking approval for a use the sponsor states is claimed in the listed patent, and thus determine whether the applicant must submit a [Paragraph IV] patent certification or may submit a section viii statement”).

Accordingly, FDA regulations require brand-name manufacturers to state “[w]hether the patent claims one or more approved methods of using the approved drug product *and* a description of *each* approved method of use or indication *and related patent claim* of the patent being submitted.” 21 C.F.R. § 314.53 (c)(2)(ii)(P)(1) (emphasis added). Additionally, brands must “identif[y] * * * the specific section of the approved labeling for the drug product that corresponds to the method of use claimed by the patent submitted; and * * * [*t]he description of the patented method of use.*” *Id.* § 314.53 (c)(2)(ii)(P)(2)-(3) (emphasis added). As the instructions for Form 3542 state: “Each approved use claimed by the patent should be separately identified * * * and contain adequate information to assist * * * ANDA applicants in determining whether a listed method of use patent claims a use for which the * * * ANDA is not seeking approval.” Pet. 214a. And brands must certify the accuracy of their submissions under penalty of perjury. Pet. 213a.

Judged by the “standard” or “required condition” of these regulatory requirements (*Webster’s, supra*), Novo’s patent information is not “correct.” The relevant claim of the ’358 patent describes a specific method of treatment: “A method for treating non-insulin dependent diabetes mellitus (NIDDM) *comprising administering to a patient in need of such treatment repaglinide in combination with metformin.*” JA96 (emphasis added). By contrast, Novo’s use code states generally: “a method for improving glycemic control in adults with type 2 diabetes mellitus.” Pet. 45a. That submission does not provide a meaningful “description of the patented method of

use” that is “related” to the “approved method of use or indication.”¹³

2. Having failed to satisfy FDA’s straightforward tailoring requirement, Novo maintains that FDA allows a brand “to base its use code narrative on the approved method of use *or* indication for the drug.” Opp. 30-31. Brands need not characterize the patent at all, the argument goes, so long as the description “tracks the approved indication.” Opp. 31. But if that were true, there would be no point to providing use codes, because they would reveal nothing about the patent’s scope.

Nor is that what the regulation says. If a brand relies on an indication, the regulation requires the brand to tie that indication to the “related patent claim” by identifying “the specific section of the approved labeling * * * that corresponds to the method of use claimed by the patent submitted; and * * * [t]he description of the patented method of use.” 21 C.F.R. § 314.53(c)(2)(ii)(P)(1)-(3). As the district court noted, FDA requires use codes to “accurately describe each approved method of use *claimed* by a patent listed in the Orange Book. The narrative is limited to those approved uses of the drug product that the patent claims.” Pet. 93a. But while Novo’s patent use code loosely tracks Prandin’s indication, the ’358 patent does not claim that indication. Indeed, the indication bears no relation to the patent. Thus, for Novo’s use code to be “correct,” more specificity was re-

¹³ Although Prandin now has only one indication, the label still lists three distinct, approved uses: (1) as monotherapy; (2) in combination with TZDs; and (3) in combination with metformin. JA278-282.

quired—language showing *which* approved use is claimed by the patent. See 68 Fed. Reg. at 36682.

3. Aware of this difficulty, Novo attempts to pass the buck to FDA, which in 2007 required changes to the labeling of diabetes drugs, including Prandin. Opp. 31; see also Pet. 47a (Dyk, J.) (discussing this history); Pet. 20a (Clevenger, J.) (suggesting that FDA “gummed up the works”). But labels and use codes are two different things. As Judge Dyk explained, “absolutely nothing in the statute or regulations * * * required Novo to change the use code to track this new indication.” Pet. 47a-48a. Indeed, at oral argument below, Novo admitted that “FDA did not direct or request that Novo change its use code to reflect the new indication, nor was Novo required under FDA regulations to make such a change.” Pet. 48a (citing oral argument transcript).

As FDA wrote to Novo in 2009, patent use codes remain critical to the agency’s ability to administer the statute: FDA “relies on [patentees] to craft an accurate and complete description of the relevant patent claims (to form the basis of the use code) and to identify the approved labeling that corresponds to those claims.” JA372. FDA “determines which labeling corresponds to a submitted patent (and thus which labeling may be available to carve out) by relying on the use code for that patent submitted by the sponsor.” *Ibid.* This correspondence leaves no room for interpretation. FDA never asked Novo to change its patent use code. Instead, it consistently required Novo to describe its patent accurately and precisely, to facilitate evaluation of Section viii ANDAs. Nor is there any way to construe this correspondence as authorizing a patent use code that merely tracks a labeled indication that the ’358 patent does not claim.

* * * * *

In sum, FDA's "patent information" regulatory requirements confirm what is required by the counterclaim's text: The brand's "patent information" must reveal what its patent "does not claim." Because Novo's patent use code fails to do so, it requires correction. Thus, the Court should reinstate the district court's injunction.

CONCLUSION

For the foregoing reasons, the judgment of the court of appeals should be reversed and the district court's injunction reinstated.

Respectfully submitted.

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UNITED STATES CODE

Title 21—Food and Drugs

Chapter 9—Federal Food, Drug, and Cosmetic Act

Subchapter V—Drugs and Devices

Part A—Drugs and Devices

§ 355. New drugs

(a) Necessity of effective approval of application

No person shall introduce or deliver for introduction into interstate commerce any new drug, unless an approval of an application filed pursuant to subsection (b) or (j) of this section is effective with respect to such drug.

(b) Filing application; contents

- (1) Any person may file with the Secretary an application with respect to any drug subject to the provisions of subsection (a) of this section. Such person shall submit to the Secretary as a part of the application (A) full reports of investigations which have been made to show whether or not such drug is safe for use and whether such drug is effective in use; (B) a full list of the articles used as components of such drug; (C) a full statement of the composition of such drug; (D) a full description of the methods used in, and the facilities and controls used for, the manufacture, processing, and packing of such drug; (E) such samples of such drug and of the articles used as components thereof as the Secretary may require; (F) specimens of the labeling

proposed to be used for such drug, and (G) any assessments required under section 355c of this title. The applicant shall file with the application the patent number and the expiration date of any patent which claims the drug for which the applicant submitted the application or which claims a method of using such drug and 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. If an application is filed under this subsection for a drug and a patent which claims such drug or a method of using such drug is issued after the filing date but before approval of the application, the applicant shall amend the application to include the information required by the preceding sentence. Upon approval of the application, the Secretary shall publish information submitted under the two preceding sentences. The Secretary shall, in consultation with the Director of the National Institutes of Health and with representatives of the drug manufacturing industry, review and develop guidance, as appropriate, on the inclusion of women and minorities in clinical trials required by clause (A).

- (2) An application submitted under paragraph (1) for a drug for which the investigations described in clause (A) of such paragraph and relied upon by the applicant for approval of the application were not conducted by or for the applicant and for which the applicant has not obtained a right of reference or use from

the person by or for whom the investigations were conducted shall also include—

- (A) a certification, in the opinion of the applicant and to the best of his knowledge, with respect to each patent which claims the drug for which such investigations were conducted or which claims a use for such drug for which the applicant is seeking approval under this subsection and for which information is required to be filed under paragraph (1) or subsection (c) of this section—
 - (i) that such patent information has not been filed,
 - (ii) that such patent has expired,
 - (iii) of the date on which such patent will expire, or
 - (iv) that such patent is invalid or will not be infringed by the manufacture, use, or sale of the new drug for which the application is submitted; and
 - (B) if with respect to the drug for which investigations described in paragraph (1)(A) were conducted information was filed under paragraph (1) or subsection (c) of this section for a method of use patent which does not claim a use for which the applicant is seeking approval under this subsection, a statement that the method of use patent does not claim such a use.
- (3) Notice of opinion that patent is invalid or will not be infringed

- (A) Agreement to give notice—An applicant that makes a certification described in paragraph (2)(A)(iv) shall include in the application a statement that the applicant will give notice as required by this paragraph.
- (B) Timing of Notice—An applicant that makes a certification described in paragraph (2)(A)(iv) shall give notice as required under this paragraph—
 - (i) if the certification is in the application, not later than 20 days after the date of the postmark on the notice with which the Secretary informs the applicant that the application has been filed; or
 - (ii) if the certification is in an amendment or supplement to the application, at the time at which the applicant submits the amendment or supplement, regardless of whether the applicant has already given notice with respect to another such certification contained in the application or in an amendment or supplement to the application.
- (C) Recipients of Notice—An applicant required under this paragraph to give notice shall give notice to—
 - (i) each owner of the patent that is the subject of the certification (or a representative of the owner designated to receive such a notice); and

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- (ii) the holder of the approved application under this subsection for the drug that is claimed by the patent or a use of which is claimed by the patent (or a representative of the holder designated to receive such a notice).
- (D) Contents of Notice—A notice required under this paragraph shall—
 - (i) state that an application that contains data from bioavailability or bioequivalence studies has been submitted under this subsection for the drug with respect to which the certification is made to obtain approval to engage in the commercial manufacture, use, or sale of the drug before the expiration of the patent referred to in the certification; and
 - (ii) include a detailed statement of the factual and legal basis of the opinion of the applicant that the patent is invalid or will not be infringed.
- (4)(A) An applicant may not amend or supplement an application referred to in paragraph (2) to seek approval of a drug that is a different drug than the drug identified in the application as submitted to the Secretary.
- (B) With respect to the drug for which such an application is submitted, nothing in this subsection or subsection (c)(3) of this section prohibits an applicant from amending or supplementing the applica-

tion to seek approval of a different strength.

- (5)(A) The Secretary shall issue guidance for the individuals who review applications submitted under paragraph (1) or under section 262 of Title 42, which shall relate to promptness in conducting the review, technical excellence, lack of bias and conflict of interest, and knowledge of regulatory and scientific standards, and which shall apply equally to all individuals who review such applications.
- (B) The Secretary shall meet with a sponsor of an investigation or an applicant for approval for a drug under this subsection or section 262 of Title 42 if the sponsor or applicant makes a reasonable written request for a meeting for the purpose of reaching agreement on the design and size of clinical trials intended to form the primary basis of an effectiveness claim or, with respect to an applicant for approval of a biological product under section 262(k) of Title 42, any necessary clinical study or studies. The sponsor or applicant shall provide information necessary for discussion and agreement on the design and size of the clinical trials. Minutes of any such meeting shall be prepared by the Secretary and made available to the sponsor or applicant upon request.
- (C) Any agreement regarding the parameters of the design and size of clinical trials of a

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new drug under this paragraph that is reached between the Secretary and a sponsor or applicant shall be reduced to writing and made part of the administrative record by the Secretary. Such agreement shall not be changed after the testing begins, except—

- (i) with the written agreement of the sponsor or applicant; or
 - (ii) pursuant to a decision, made in accordance with subparagraph (D) by the director of the reviewing division, that a substantial scientific issue essential to determining the safety or effectiveness of the drug has been identified after the testing has begun.
- (D) A decision under subparagraph (C)(ii) by the director shall be in writing and the Secretary shall provide to the sponsor or applicant an opportunity for a meeting at which the director and the sponsor or applicant will be present and at which the director will document the scientific issue involved.
- (E) The written decisions of the reviewing division shall be binding upon, and may not directly or indirectly be changed by, the field or compliance division personnel unless such field or compliance division personnel demonstrate to the reviewing division why such decision should be modified.
- (F) No action by the reviewing division may be delayed because of the unavailability

of information from or action by field personnel unless the reviewing division determines that a delay is necessary to assure the marketing of a safe and effective drug.

- (G) For purposes of this paragraph, the reviewing division is the division responsible for the review of an application for approval of a drug under this subsection or section 262 of Title 42 (including all scientific and medical matters, chemistry, manufacturing, and controls).
- (6) An application submitted under this subsection shall be accompanied by the certification required under section 282(j)(5)(B) of Title 42. Such certification shall not be considered an element of such application.
- (c) Period for approval of application; period for, notice, and expedition of hearing; period for issuance of order**
 - (1) Within one hundred and eighty days after the filing of an application under subsection (b) of this section, or such additional period as may be agreed upon by the Secretary and the applicant, the Secretary shall either—
 - (A) Approve the application if he then finds that none of the grounds for denying approval specified in subsection (d) of this section applies, or
 - (B) Give the applicant notice of an opportunity for a hearing before the Secretary under subsection (d) of this section on the question whether such application is ap-

provable. If the applicant elects to accept the opportunity for hearing by written request within thirty days after such notice, such hearing shall commence not more than ninety days after the expiration of such thirty days unless the Secretary and the applicant otherwise agree. Any such hearing shall thereafter be conducted on an expedited basis and the Secretary's order thereon shall be issued within ninety days after the date fixed by the Secretary for filing final briefs.

- (2) If the patent information described in subsection (b) of this section could not be filed with the submission of an application under subsection (b) of this section because the application was filed before the patent information was required under subsection (b) of this section or a patent was issued after the application was approved under such subsection, the holder of an approved application shall file with the Secretary the patent number and the expiration date of any patent which claims the drug for which the application was submitted or which claims a method of using such drug and 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. If the holder of an approved application could not file patent information under subsection (b) of this section because it was not required at the time the application was approved, the holder shall file such information under this subsection not later than thir-

ty days after September 24, 1984, and if the holder of an approved application could not file patent information under subsection (b) of this section because no patent had been issued when an application was filed or approved, the holder shall file such information under this subsection not later than thirty days after the date the patent involved is issued. Upon the submission of patent information under this subsection, the Secretary shall publish it.

- (3) The approval of an application filed under subsection (b) of this section which contains a certification required by paragraph (2) of such subsection shall be made effective on the last applicable date determined by applying the following to each certification made under subsection (b)(2)(A) of this section:
 - (A) If the applicant only made a certification described in clause (i) or (ii) of subsection (b)(2)(A) of this section or in both such clauses, the approval may be made effective immediately.
 - (B) If the applicant made a certification described in clause (iii) of subsection (b)(2)(A) of this section, the approval may be made effective on the date certified under clause (iii).
 - (C) If the applicant made a certification described in clause (iv) of subsection (b)(2)(A) of this section, the approval shall be made effective immediately unless, before the expiration of 45 days after the date on which the notice described in

subsection (b)(3) of this section is received, an action is brought for infringement of the patent that is the subject of the certification and for which information was submitted to the Secretary under paragraph (2) or subsection (b)(1) of this section before the date on which the application (excluding an amendment or supplement to the application) was submitted. If such an action is brought before the expiration of such days, the approval may be made effective upon the expiration of the thirty-month period beginning on the date of the receipt of the notice provided under subsection (b)(3) of this section or such shorter or longer period as the court may order because either party to the action failed to reasonably cooperate in expediting the action, except that—

- (i) if before the expiration of such period the district court decides that the patent is invalid or not infringed (including any substantive determination that there is no cause of action for patent infringement or invalidity), the approval shall be made effective on—
 - (I) the date on which the court enters judgment reflecting the decision; or
 - (II) the date of a settlement order or consent decree signed and entered by the court stating that the

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patent that is the subject of the certification is invalid or not infringed;

- (ii) if before the expiration of such period the district court decides that the patent has been infringed—
 - (I) if the judgment of the district court is appealed, the approval shall be made effective on—
 - (aa) the date on which the court of appeals decides that the patent is invalid or not infringed (including any substantive determination that there is no cause of action for patent infringement or invalidity); or
 - (bb) the date of a settlement order or consent decree signed and entered by the court of appeals stating that the patent that is the subject of the certification is invalid or not infringed; or
 - (II) if the judgment of the district court is not appealed or is affirmed, the approval shall be made effective on the date specified by the district court in a court order under section 271(e)(4)(A) of Title 35;
- (iii) if before the expiration of such period the court grants a preliminary injunction prohibiting the applicant

from engaging in the commercial manufacture or sale of the drug until the court decides the issues of patent validity and infringement and if the court decides that such patent is invalid or not infringed, the approval shall be made effective as provided in clause (i); or

- (iv) if before the expiration of such period the court grants a preliminary injunction prohibiting the applicant from engaging in the commercial manufacture or sale of the drug until the court decides the issues of patent validity and infringement and if the court decides that such patent has been infringed, the approval shall be made effective as provided in clause (ii).

In such an action, each of the parties shall reasonably cooperate in expediting the action.

(D) Civil action to obtain patent certainty

- (i) Declaratory judgment absent infringement action

(I) In general—No action may be brought under section 2201 of Title 28, by an applicant referred to in subsection (b)(2) of this section for a declaratory judgment with respect to a patent which is the subject of the certification referred to in subparagraph (C) unless—

- (aa) the 45-day period referred to in such subparagraph has expired;
 - (bb) neither the owner of such patent nor the holder of the approved application under subsection (b) of this section for the drug that is claimed by the patent or a use of which is claimed by the patent brought a civil action against the applicant for infringement of the patent before the expiration of such period; and
 - (cc) in any case in which the notice provided under paragraph (2)(B) relates to noninfringement, the notice was accompanied by a document described in subclause (III).
- (II) Filing of civil action—If the conditions described in items (aa), (bb), and as applicable, (cc) of subclause (I) have been met, the applicant referred to in such subclause may, in accordance with section 2201 of Title 28, bring a civil action under such section against the owner or holder referred to in such subclause (but not against any owner or holder that has brought such a civil action against the applicant, unless that civil action was dismissed

without prejudice) for a declaratory judgment that the patent is invalid or will not be infringed by the drug for which the applicant seeks approval, except that such civil action may be brought for a declaratory judgment that the patent will not be infringed only in a case in which the condition described in subclause (I)(cc) is applicable. A civil action referred to in this subclause shall be brought in the judicial district where the defendant has its principal place of business or a regular and established place of business.

- (III) Offer of confidential access to application—For purposes of subclause (I)(cc), the document described in this subclause is a document providing an offer of confidential access to the application that is in the custody of the applicant referred to in subsection (b)(2) of this section for the purpose of determining whether an action referred to in subparagraph (C) should be brought. The document providing the offer of confidential access shall contain such restrictions as to persons entitled to access, and on the use and disposition of any information accessed, as would apply had a protective order been entered

for the purpose of protecting trade secrets and other confidential business information. A request for access to an application under an offer of confidential access shall be considered acceptance of the offer of confidential access with the restrictions as to persons entitled to access, and on the use and disposition of any information accessed, contained in the offer of confidential access, and those restrictions and other terms of the offer of confidential access shall be considered terms of an enforceable contract. Any person provided an offer of confidential access shall review the application for the sole and limited purpose of evaluating possible infringement of the patent that is the subject of the certification under subsection (b)(2)(A)(iv) of this section and for no other purpose, and may not disclose information of no relevance to any issue of patent infringement to any person other than a person provided an offer of confidential access. Further, the application may be redacted by the applicant to remove any information of no relevance to any issue of patent infringement.

(ii) Counterclaim to infringement action

- (I) In general—If an owner of the patent or the holder of the approved application under subsection (b) of this section for the drug that is claimed by the patent or a use of which is claimed by the patent brings a patent infringement action against the applicant, the applicant may assert a counterclaim seeking an order requiring the holder to correct or delete the patent information submitted by the holder under subsection (b) of this section or this subsection on the ground that the patent does not claim either—
 - (aa) the drug for which the application was approved; or
 - (bb) an approved method of using the drug.
- (II) No independent cause of action—Subclause (I) does not authorize the assertion of a claim described in subclause (I) in any civil action or proceeding other than a counterclaim described in subclause (I).
 - (iii) No damages—An applicant shall not be entitled to damages in a civil action under clause (i) or a counterclaim under clause (ii).
- (E)(i) If an application (other than an abbreviated new drug application) submitted under subsection (b) of

this section for a drug, no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other application under subsection (b) of this section, was approved during the period beginning January 1, 1982, and ending on September 24, 1984, the Secretary may not make the approval of another application for a drug for which the investigations described in clause (A) of subsection (b)(1) of this section and relied upon by the applicant for approval of the application were not conducted by or for the applicant and for which the applicant has not obtained a right of reference or use from the person by or for whom the investigations were conducted effective before the expiration of ten years from the date of the approval of the application previously approved under subsection (b) of this section.

- (ii) If an application submitted under subsection (b) of this section for a drug, no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other application under subsection (b) of this section, is approved after September 24, 1984, no application which refers to the drug for which the subsection (b) application was submitted and for which the in-

vestigations described in clause (A) of subsection (b)(1) of this section and relied upon by the applicant for approval of the application were not conducted by or for the applicant and for which the applicant has not obtained a right of reference or use from the person by or for whom the investigations were conducted may be submitted under subsection (b) of this section before the expiration of five years from the date of the approval of the application under subsection (b) of this section, except that such an application may be submitted under subsection (b) of this section after the expiration of four years from the date of the approval of the subsection (b) application if it contains a certification of patent invalidity or noninfringement described in clause (iv) of subsection (b)(2)(A) of this section. The approval of such an application shall be made effective in accordance with this paragraph except that, if an action for patent infringement is commenced during the one-year period beginning forty-eight months after the date of the approval of the subsection (b) application, the thirty-month period referred to in subparagraph (C) shall be extended by such amount of time (if any) which is required for seven and one-half years to have elapsed from the date of ap-

proval of the subsection (b) application.

- (iii) If an application submitted under subsection (b) of this section for a drug, which includes an active ingredient (including any ester or salt of the active ingredient) that has been approved in another application approved under subsection (b) of this section, is approved after September 24, 1984, and if such application contains reports of new clinical investigations (other than bioavailability studies) essential to the approval of the application and conducted or sponsored by the applicant, the Secretary may not make the approval of an application submitted under subsection (b) of this section for the conditions of approval of such drug in the approved subsection (b) application effective before the expiration of three years from the date of the approval of the application under subsection (b) of this section if the investigations described in clause (A) of subsection (b)(1) of this section and relied upon by the applicant for approval of the application were not conducted by or for the applicant and if the applicant has not obtained a right of reference or use from the person by or for whom the investigations were conducted.

- (iv) If a supplement to an application approved under subsection (b) of this section is approved after September 24, 1984, and the supplement contains reports of new clinical investigations (other than bioavailability¹ studies) essential to the approval of the supplement and conducted or sponsored by the person submitting the supplement, the Secretary may not make the approval of an application submitted under subsection (b) of this section for a change approved in the supplement effective before the expiration of three years from the date of the approval of the supplement under subsection (b) of this section if the investigations described in clause (A) of subsection (b)(1) of this section and relied upon by the applicant for approval of the application were not conducted by or for the applicant and if the applicant has not obtained a right of reference or use from the person by or for whom the investigations were conducted.
- (v) If an application (or supplement to an application) submitted under subsection (b) of this section for a drug, which includes an active ingredient (including any ester or salt of the active ingredient) that has been approved in another application under subsection (b) of this section, was ap-

¹ So in original. Probably should be "bioavailability."

proved during the period beginning January 1, 1982, and ending on September 24, 1984, the Secretary may not make the approval of an application submitted under this subsection and for which the investigations described in clause (A) of subsection (b)(1) of this section and relied upon by the applicant for approval of the application were not conducted by or for the applicant and for which the applicant has not obtained a right of reference or use from the person by or for whom the investigations were conducted and which refers to the drug for which the subsection (b) application was submitted effective before the expiration of two years from September 24, 1984.

- (4) A drug manufactured in a pilot or other small facility may be used to demonstrate the safety and effectiveness of the drug and to obtain approval for the drug prior to manufacture of the drug in a larger facility, unless the Secretary makes a determination that a full scale production facility is necessary to ensure the safety or effectiveness of the drug.

(d) Grounds for refusing application; approval of application; “substantial evidence” defined

If the Secretary finds, after due notice to the applicant in accordance with subsection (c) of this section and giving him an opportunity for a hearing, in accordance with said subsection, that (1) the investiga-

tions, reports of which are required to be submitted to the Secretary pursuant to subsection (b) of this section, do not include adequate tests by all methods reasonably applicable to show whether or not such drug is safe for use under the conditions prescribed, recommended, or suggested in the proposed labeling thereof; (2) the results of such tests show that such drug is unsafe for use under such conditions or do not show that such drug is safe for use under such conditions; (3) the methods used in, and the facilities and controls used for, the manufacture, processing, and packing of such drug are inadequate to preserve its identity, strength, quality, and purity; (4) upon the basis of the information submitted to him as part of the application, or upon the basis of any other information before him with respect to such drug, he has insufficient information to determine whether such drug is safe for use under such conditions; or (5) evaluated on the basis of the information submitted to him as part of the application and any other information before him with respect to such drug, there is a lack of substantial evidence that the drug will have the effect it purports or is represented to have under the conditions of use prescribed, recommended, or suggested in the proposed labeling thereof; or (6) the application failed to contain the patent information prescribed by subsection (b) of this section; or (7) based on a fair evaluation of all material facts, such labeling is false or misleading in any particular; he shall issue an order refusing to approve the application. If, after such notice and opportunity for hearing, the Secretary finds that clauses (1) through (6) do not apply, he shall issue an order approving the application. As used in this subsection and subsection (e) of this section, the term "substantial evidence" means evidence consisting of adequate and well-controlled

investigations, including clinical investigations, by experts qualified by scientific training and experience to evaluate the effectiveness of the drug involved, on the basis of which it could fairly and responsibly be concluded by such experts that the drug will have the effect it purports or is represented to have under the conditions of use prescribed, recommended, or suggested in the labeling or proposed labeling thereof. If the Secretary determines, based on relevant science, that data from one adequate and well-controlled clinical investigation and confirmatory evidence (obtained prior to or after such investigation) are sufficient to establish effectiveness, the Secretary may consider such data and evidence to constitute substantial evidence for purposes of the preceding sentence.

(e) Withdrawal of approval; grounds; immediate suspension upon finding imminent hazard to public health

The Secretary shall, after due notice and opportunity for hearing to the applicant, withdraw approval of an application with respect to any drug under this section if the Secretary finds (1) that clinical or other experience, tests, or other scientific data show that such drug is unsafe for use under the conditions of use upon the basis of which the application was approved; (2) that new evidence of clinical experience, not contained in such application or not available to the Secretary until after such application was approved, or tests by new methods, or tests by methods not deemed reasonably applicable when such application was approved, evaluated together with the evidence available to the Secretary when the application was approved, shows that such drug is not shown to be safe for use under the conditions of use upon the

basis of which the application was approved; or (3) on the basis of new information before him with respect to such drug, evaluated together with the evidence available to him when the application was approved, that there is a lack of substantial evidence that the drug will have the effect it purports or is represented to have under the conditions of use prescribed, recommended, or suggested in the labeling thereof; or (4) the patent information prescribed by subsection (c) of this section was not filed within thirty days after the receipt of written notice from the Secretary specifying the failure to file such information; or (5) that the application contains any untrue statement of a material fact: Provided, That if the Secretary (or in his absence the officer acting as Secretary) finds that there is an imminent hazard to the public health, he may suspend the approval of such application immediately, and give the applicant prompt notice of his action and afford the applicant the opportunity for an expedited hearing under this subsection; but the authority conferred by this proviso to suspend the approval of an application shall not be delegated. The Secretary may also, after due notice and opportunity for hearing to the applicant, withdraw the approval of an application submitted under subsection (b) or (j) of this section with respect to any drug under this section if the Secretary finds (1) that the applicant has failed to establish a system for maintaining required records, or has repeatedly or deliberately failed to maintain such records or to make required reports, in accordance with a regulation or order under subsection (k) of this section or to comply with the notice requirements of section 360(k)(2) of this title, or the applicant has refused to permit access to, or copying or verification of, such records as required by paragraph (2) of such subsection; or (2) that on the basis of new information

before him, evaluated together with the evidence before him when the application was approved, the methods used in, or the facilities and controls used for, the manufacture, processing, and packing of such drug are inadequate to assure and preserve its identity, strength, quality, and purity and were not made adequate within a reasonable time after receipt of written notice from the Secretary specifying the matter complained of; or (3) that on the basis of new information before him, evaluated together with the evidence before him when the application was approved, the labeling of such drug, based on a fair evaluation of all material facts, is false or misleading in any particular and was not corrected within a reasonable time after receipt of written notice from the Secretary specifying the matter complained of. Any order under this subsection shall state the findings upon which it is based. The Secretary may withdraw the approval of an application submitted under this section, or suspend the approval of such an application, as provided under this subsection, without first ordering the applicant to submit an assessment of the approved risk evaluation and mitigation strategy for the drug under section 355-1(g)(2)(D) of this title.

(f) Revocation of order refusing, withdrawing or suspending approval of application

Whenever the Secretary finds that the facts so require, he shall revoke any previous order under subsection (d) or (e) of this section refusing, withdrawing, or suspending approval of an application and shall approve such application or reinstate such approval, as may be appropriate.

(g) Service of orders

Orders of the Secretary issued under this section shall be served (1) in person by any officer or employee of the Department designated by the Secretary or (2) by mailing the order by registered mail or by certified mail addressed to the applicant or respondent at his last-known address in the records of the Secretary.

(h) Appeal from order

An appeal may be taken by the applicant from an order of the Secretary refusing or withdrawing approval of an application under this section. Such appeal shall be taken by filing in the United States court of appeals for the circuit wherein such applicant resides or has his principal place of business, or in the United States Court of Appeals for the District of Columbia Circuit, within sixty days after the entry of such order, a written petition praying that the order of the Secretary be set aside. A copy of such petition shall be forthwith transmitted by the clerk of the court to the Secretary, or any officer designated by him for that purpose, and thereupon the Secretary shall certify and file in the court the record upon which the order complained of was entered, as provided in section 2112 of Title 28. Upon the filing of such petition such court shall have exclusive jurisdiction to affirm or set aside such order, except that until the filing of the record the Secretary may modify or set aside his order. No objection to the order of the Secretary shall be considered by the court unless such objection shall have been urged before the Secretary or unless there were reasonable grounds for failure so to do. The finding of the Secretary as to the facts, if supported by substantial evidence, shall be conclusive. If any

person shall apply to the court for leave to adduce additional evidence, and shall show to the satisfaction of the court that such additional evidence is material and that there were reasonable grounds for failure to adduce such evidence in the proceeding before the Secretary, the court may order such additional evidence to be taken before the Secretary and to be adduced upon the hearing in such manner and upon such terms and conditions as to the court may seem proper. The Secretary may modify his findings as to the facts by reason of the additional evidence so taken, and he shall file with the court such modified findings which, if supported by substantial evidence, shall be conclusive, and his recommendation, if any, for the setting aside of the original order. The judgment of the court affirming or setting aside any such order of the Secretary shall be final, subject to review by the Supreme Court of the United States upon certiorari or certification as provided in section 1254 of Title 28. The commencement of proceedings under this subsection shall not, unless specifically ordered by the court to the contrary, operate as a stay of the Secretary's order.

(i) Exemptions of drugs for research; discretionary and mandatory conditions; direct reports to Secretary

- (1) The Secretary shall promulgate regulations for exempting from the operation of the foregoing subsections of this section drugs intended solely for investigational use by experts qualified by scientific training and experience to investigate the safety and effectiveness of drugs. Such regulations may, within the discretion of the Secretary, among other conditions relating to the protection of

the public health, provide for conditioning such exemption upon—

- (A) the submission to the Secretary, before any clinical testing of a new drug is undertaken, of reports, by the manufacturer or the sponsor of the investigation of such drug, of preclinical tests (including tests on animals) of such drug adequate to justify the proposed clinical testing;
- (B) the manufacturer or the sponsor of the investigation of a new drug proposed to be distributed to investigators for clinical testing obtaining a signed agreement from each of such investigators that patients to whom the drug is administered will be under his personal supervision, or under the supervision of investigators responsible to him, and that he will not supply such drug to any other investigator, or to clinics, for administration to human beings;
- (C) the establishment and maintenance of such records, and the making of such reports to the Secretary, by the manufacturer or the sponsor of the investigation of such drug, of data (including but not limited to analytical reports by investigators) obtained as the result of such investigational use of such drug, as the Secretary finds will enable him to evaluate the safety and effectiveness of such drug in the event of the filing of an application pursuant to subsection (b) of this section; and

- (D) the submission to the Secretary by the manufacturer or the sponsor of the investigation of a new drug of a statement of intent regarding whether the manufacturer or sponsor has plans for assessing pediatric safety and efficacy.
- (2) Subject to paragraph (3), a clinical investigation of a new drug may begin 30 days after the Secretary has received from the manufacturer or sponsor of the investigation a submission containing such information about the drug and the clinical investigation, including—
- (A) information on design of the investigation and adequate reports of basic information, certified by the applicant to be accurate reports, necessary to assess the safety of the drug for use in clinical investigation; and
 - (B) adequate information on the chemistry and manufacturing of the drug, controls available for the drug, and primary data tabulations from animal or human studies.
- (3)(A) At any time, the Secretary may prohibit the sponsor of an investigation from conducting the investigation (referred to in this paragraph as a “clinical hold”) if the Secretary makes a determination described in subparagraph (B). The Secretary shall specify the basis for the clinical hold, including the specific information available to the Secretary which served

as the basis for such clinical hold, and confirm such determination in writing.

- (B) For purposes of subparagraph (A), a determination described in this subparagraph with respect to a clinical hold is that—
 - (i) the drug involved represents an unreasonable risk to the safety of the persons who are the subjects of the clinical investigation, taking into account the qualifications of the clinical investigators, information about the drug, the design of the clinical investigation, the condition for which the drug is to be investigated, and the health status of the subjects involved; or
 - (ii) the clinical hold should be issued for such other reasons as the Secretary may by regulation establish (including reasons established by regulation before November 21, 1997).
 - (C) Any written request to the Secretary from the sponsor of an investigation that a clinical hold be removed shall receive a decision, in writing and specifying the reasons therefor, within 30 days after receipt of such request. Any such request shall include sufficient information to support the removal of such clinical hold.
- (4) Regulations under paragraph (1) shall provide that such exemption shall be conditioned upon the manufacturer, or the sponsor of the investigation, requiring that experts using

such drugs for investigational purposes certify to such manufacturer or sponsor that they will inform any human beings to whom such drugs, or any controls used in connection therewith, are being administered, or their representatives, that such drugs are being used for investigational purposes and will obtain the consent of such human beings or their representatives, except where it is not feasible or it is contrary to the best interests of such human beings. Nothing in this subsection shall be construed to require any clinical investigator to submit directly to the Secretary reports on the investigational use of drugs. The Secretary shall update such regulations to require inclusion in the informed consent documents and process a statement that clinical trial information for such clinical investigation has been or will be submitted for inclusion in the registry data bank pursuant to subsection (j) of section 282 of Title 42.

(j) Abbreviated new drug applications

- (1) Any person may file with the Secretary an abbreviated application for the approval of a new drug.
- (2)(A) An abbreviated application for a new drug shall contain—
 - (i) information to show that the conditions of use prescribed, recommended, or suggested in the labeling proposed for the new drug have been previously approved for a drug listed under paragraph (7) (hereinafter in

this subsection referred to as a “listed drug”);

- (ii)(I) if the listed drug referred to in clause (i) has only one active ingredient, information to show that the active ingredient of the new drug is the same as that of the listed drug;
- (II) if the listed drug referred to in clause (i) has more than one active ingredient, information to show that the active ingredients of the new drug are the same as those of the listed drug, or
- (III) if the listed drug referred to in clause (i) has more than one active ingredient and if one of the active ingredients of the new drug is different and the application is filed pursuant to the approval of a petition filed under subparagraph (C), information to show that the other active ingredients of the new drug are the same as the active ingredients of the listed drug, information to show that the different active ingredient is an active ingredient of a listed drug or of a drug which does not meet the requirements of section 321(p) of this title, and such other information respecting the different active ingredient with respect

to which the petition was filed as the Secretary may require;

- (iii) information to show that the route of administration, the dosage form, and the strength of the new drug are the same as those of the listed drug referred to in clause (i) or, if the route of administration, the dosage form, or the strength of the new drug is different and the application is filed pursuant to the approval of a petition filed under subparagraph (C), such information respecting the route of administration, dosage form, or strength with respect to which the petition was filed as the Secretary may require;
- (iv) information to show that the new drug is bioequivalent to the listed drug referred to in clause (i), except that if the application is filed pursuant to the approval of a petition filed under subparagraph (C), information to show that the active ingredients of the new drug are of the same pharmacological or therapeutic class as those of the listed drug referred to in clause (i) and the new drug can be expected to have the same therapeutic effect as the listed drug when administered to patients for a condition of use referred to in clause (i);

- (v) information to show that the labeling proposed for the new drug is the same as the labeling approved for the listed drug referred to in clause (i) except for changes required because of differences approved under a petition filed under subparagraph (C) or because the new drug and the listed drug are produced or distributed by different manufacturers;
- (vi) the items specified in clauses (B) through (F) of subsection (b)(1) of this section;
- (vii) a certification, in the opinion of the applicant and to the best of his knowledge, with respect to each patent which claims the listed drug referred to in clause (i) or which claims a use for such listed drug for which the applicant is seeking approval under this subsection and for which information is required to be filed under subsection (b) or (c) of this section—
 - (I) that such patent information has not been filed,
 - (II) that such patent has expired,
 - (III) of the date on which such patent will expire, or
 - (IV) that such patent is invalid or will not be infringed by the manufacture, use, or sale of the new drug for which the application is submitted; and

- (viii) if with respect to the listed drug referred to in clause (i) information was filed under subsection (b) or (c) of this section for a method of use patent which does not claim a use for which the applicant is seeking approval under this subsection, a statement that the method of use patent does not claim such a use.

The Secretary may not require that an abbreviated application contain information in addition to that required by clauses (i) through (viii).

- (B) Notice of opinion that patent is invalid or will not be infringed
 - (i) Agreement to give notice—An applicant that makes a certification described in subparagraph (A)(vii)(IV) shall include in the application a statement that the applicant will give notice as required by this subparagraph.
 - (ii) Timing of notice—An applicant that makes a certification described in subparagraph (A)(vii)(IV) shall give notice as required under this subparagraph—
 - (I) if the certification is in the application, not later than 20 days after the date of the postmark on the notice with which the Secretary informs the applicant that the application has been filed; or

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- (II) if the certification is in an amendment or supplement to the application, at the time at which the applicant submits the amendment or supplement, regardless of whether the applicant has already given notice with respect to another such certification contained in the application or in an amendment or supplement to the application.
- (iii) Recipients of notice—An applicant required under this subparagraph to give notice shall give notice to—
- (I) each owner of the patent that is the subject of the certification (or a representative of the owner designated to receive such a notice); and
 - (II) the holder of the approved application under subsection (b) of this section for the drug that is claimed by the patent or a use of which is claimed by the patent (or a representative of the holder designated to receive such a notice).
- (iv) Contents of notice—A notice required under this subparagraph shall—
- (I) state that an application that contains data from bioavailability or bioequivalence studies has been submitted under this subsection for the drug with respect

to which the certification is made to obtain approval to engage in the commercial manufacture, use, or sale of the drug before the expiration of the patent referred to in the certification; and

- (II) include a detailed statement of the factual and legal basis of the opinion of the applicant that the patent is invalid or will not be infringed.
- (C) If a person wants to submit an abbreviated application for a new drug which has a different active ingredient or whose route of administration, dosage form, or strength differ from that of a listed drug, such person shall submit a petition to the Secretary seeking permission to file such an application. The Secretary shall approve or disapprove a petition submitted under this subparagraph within ninety days of the date the petition is submitted. The Secretary shall approve such a petition unless the Secretary finds—
- (i) that investigations must be conducted to show the safety and effectiveness of the drug or of any of its active ingredients, the route of administration, the dosage form, or strength which differ from the listed drug; or
 - (ii) that any drug with a different active ingredient may not be adequately evaluated for approval as safe and ef-

fective on the basis of the information required to be submitted in an abbreviated application.

- (D)(i) An applicant may not amend or supplement an application to seek approval of a drug referring to a different listed drug from the listed drug identified in the application as submitted to the Secretary.
 - (ii) With respect to the drug for which an application is submitted, nothing in this subsection prohibits an applicant from amending or supplementing the application to seek approval of a different strength.
 - (iii) Within 60 days after December 8, 2003, the Secretary shall issue guidance defining the term “listed drug” for purposes of this subparagraph.
- (3)(A) The Secretary shall issue guidance for the individuals who review applications submitted under paragraph (1), which shall relate to promptness in conducting the review, technical excellence, lack of bias and conflict of interest, and knowledge of regulatory and scientific standards, and which shall apply equally to all individuals who review such applications.
- (B) The Secretary shall meet with a sponsor of an investigation or an applicant for approval for a drug under this subsection if the sponsor or applicant makes a reasonable written request for a meeting for

the purpose of reaching agreement on the design and size of bioavailability and bioequivalence studies needed for approval of such application. The sponsor or applicant shall provide information necessary for discussion and agreement on the design and size of such studies. Minutes of any such meeting shall be prepared by the Secretary and made available to the sponsor or applicant.

- (C) Any agreement regarding the parameters of design and size of bioavailability and bioequivalence studies of a drug under this paragraph that is reached between the Secretary and a sponsor or applicant shall be reduced to writing and made part of the administrative record by the Secretary. Such agreement shall not be changed after the testing begins, except—
 - (i) with the written agreement of the sponsor or applicant; or
 - (ii) pursuant to a decision, made in accordance with subparagraph (D) by the director of the reviewing division, that a substantial scientific issue essential to determining the safety or effectiveness of the drug has been identified after the testing has begun.
- (D) A decision under subparagraph (C)(ii) by the director shall be in writing and the Secretary shall provide to the sponsor or applicant an opportunity for a meeting at which the director and the sponsor or applicant will be present and at which the

director will document the scientific issue involved.

- (E) The written decisions of the reviewing division shall be binding upon, and may not directly or indirectly be changed by, the field or compliance office personnel unless such field or compliance office personnel demonstrate to the reviewing division why such decision should be modified.
 - (F) No action by the reviewing division may be delayed because of the unavailability of information from or action by field personnel unless the reviewing division determines that a delay is necessary to assure the marketing of a safe and effective drug.
 - (G) For purposes of this paragraph, the reviewing division is the division responsible for the review of an application for approval of a drug under this subsection (including scientific matters, chemistry, manufacturing, and controls).
- (4) Subject to paragraph (5), the Secretary shall approve an application for a drug unless the Secretary finds—
- (A) the methods used in, or the facilities and controls used for, the manufacture, processing, and packing of the drug are inadequate to assure and preserve its identity, strength, quality, and purity;
 - (B) information submitted with the application is insufficient to show that each of

the proposed conditions of use have been previously approved for the listed drug referred to in the application;

- (C)(i) if the listed drug has only one active ingredient, information submitted with the application is insufficient to show that the active ingredient is the same as that of the listed drug;
- (ii) if the listed drug has more than one active ingredient, information submitted with the application is insufficient to show that the active ingredients are the same as the active ingredients of the listed drug, or
- (iii) if the listed drug has more than one active ingredient and if the application is for a drug which has an active ingredient different from the listed drug, information submitted with the application is insufficient to show—
 - (I) that the other active ingredients are the same as the active ingredients of the listed drug, or
 - (II) that the different active ingredient is an active ingredient of a listed drug or a drug which does not meet the requirements of section 321(p) of this title, or no petition to file an application for the drug with the different ingredient was approved under paragraph (2)(C);

- (D)(i) if the application is for a drug whose route of administration, dosage form, or strength of the drug is the same as the route of administration, dosage form, or strength of the listed drug referred to in the application, information submitted in the application is insufficient to show that the route of administration, dosage form, or strength is the same as that of the listed drug, or
- (ii) if the application is for a drug whose route of administration, dosage form, or strength of the drug is different from that of the listed drug referred to in the application, no petition to file an application for the drug with the different route of administration, dosage form, or strength was approved under paragraph (2)(C);
- (E) if the application was filed pursuant to the approval of a petition under paragraph (2)(C), the application did not contain the information required by the Secretary respecting the active ingredient, route of administration, dosage form, or strength which is not the same;
- (F) information submitted in the application is insufficient to show that the drug is bioequivalent to the listed drug referred to in the application or, if the application was filed pursuant to a petition approved under paragraph (2)(C), information submitted in the application is insuffi-

cient to show that the active ingredients of the new drug are of the same pharmacological or therapeutic class as those of the listed drug referred to in paragraph (2)(A)(i) and that the new drug can be expected to have the same therapeutic effect as the listed drug when administered to patients for a condition of use referred to in such paragraph;

- (G) information submitted in the application is insufficient to show that the labeling proposed for the drug is the same as the labeling approved for the listed drug referred to in the application except for changes required because of differences approved under a petition filed under paragraph (2)(C) or because the drug and the listed drug are produced or distributed by different manufacturers;
- (H) information submitted in the application or any other information available to the Secretary shows that (i) the inactive ingredients of the drug are unsafe for use under the conditions prescribed, recommended, or suggested in the labeling proposed for the drug, or (ii) the composition of the drug is unsafe under such conditions because of the type or quantity of inactive ingredients included or the manner in which the inactive ingredients are included;
- (I) the approval under subsection (c) of this section of the listed drug referred to in the application under this subsection has

been withdrawn or suspended for grounds described in the first sentence of subsection (e) of this section, the Secretary has published a notice of opportunity for hearing to withdraw approval of the listed drug under subsection (c) of this section for grounds described in the first sentence of subsection (e) of this section, the approval under this subsection of the listed drug referred to in the application under this subsection has been withdrawn or suspended under paragraph (6), or the Secretary has determined that the listed drug has been withdrawn from sale for safety or effectiveness reasons;

- (J) the application does not meet any other requirement of paragraph (2)(A); or
 - (K) the application contains an untrue statement of material fact.
- (5)(A) Within one hundred and eighty days of the initial receipt of an application under paragraph (2) or within such additional period as may be agreed upon by the Secretary and the applicant, the Secretary shall approve or disapprove the application.
- (B) The approval of an application submitted under paragraph (2) shall be made effective on the last applicable date determined by applying the following to each certification made under paragraph (2)(A)(vii):
- (i) If the applicant only made a certification described in subclause (I) or (II)

of paragraph (2)(A)(vii) or in both such subclauses, the approval may be made effective immediately.

- (ii) If the applicant made a certification described in subclause (III) of paragraph (2)(A)(vii), the approval may be made effective on the date certified under subclause (III).
- (iii) If the applicant made a certification described in subclause (IV) of paragraph (2)(A)(vii), the approval shall be made effective immediately unless, before the expiration of 45 days after the date on which the notice described in paragraph (2)(B) is received, an action is brought for infringement of the patent that is the subject of the certification and for which information was submitted to the Secretary under subsection (b)(1) or (c)(2) of this section before the date on which the application (excluding an amendment or supplement to the application), which the Secretary later determines to be substantially complete, was submitted. If such an action is brought before the expiration of such days, the approval shall be made effective upon the expiration of the thirty-month period beginning on the date of the receipt of the notice provided under paragraph (2)(B)(i) or such shorter or longer period as the court may order because either party to the action failed to reasonably coo-

perate in expediting the action, except that—

- (I) if before the expiration of such period the district court decides that the patent is invalid or not infringed (including any substantive determination that there is no cause of action for patent infringement or invalidity), the approval shall be made effective on—
 - (aa) the date on which the court enters judgment reflecting the decision; or
 - (bb) the date of a settlement order or consent decree signed and entered by the court stating that the patent that is the subject of the certification is invalid or not infringed;
- (II) if before the expiration of such period the district court decides that the patent has been infringed—
 - (aa) if the judgment of the district court is appealed, the approval shall be made effective on—the
 - (AA) the date on which the court of appeals decides that the patent is invalid or not infringed (including any substantive de-

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termination that there is no cause of action for patent infringement or invalidity); or

(BB) the date of a settlement order or consent decree signed and entered by the court of appeals stating that the patent that is the subject of the certification is invalid or not infringed; or

(bb) if the judgment of the district court is not appealed or is affirmed, the approval shall be made effective on the date specified by the district court in a court order under section 271(e)(4)(A) of Title 35;

(III) if before the expiration of such period the court grants a preliminary injunction prohibiting the applicant from engaging in the commercial manufacture or sale of the drug until the court decides the issues of patent validity and infringement and if the court decides that such patent is invalid or not infringed, the approval shall be made effective as provided in subclause (I); or

(IV) if before the expiration of such period the court grants a preliminary injunction prohibiting the

applicant from engaging in the commercial manufacture or sale of the drug until the court decides the issues of patent validity and infringement and if the court decides that such patent has been infringed, the approval shall be made effective as provided in subclause (II).

In such an action, each of the parties shall reasonably cooperate in expediting the action.

(iv) 180-day exclusivity period

(I) Effectiveness of application—Subject to subparagraph (D), if the application contains a certification described in paragraph (2)(A)(vii)(IV) and is for a drug for which a first applicant has submitted an application containing such a certification, the application shall be made effective on the date that is 180 days after the date of the first commercial marketing of the drug (including the commercial marketing of the listed drug) by any first applicant.

(II) Definitions—In this paragraph:

(aa) 180-day exclusivity period—The term “180-day exclusivity period” means the 180-day period ending on the day before the date on which an application submitted by an ap-

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plicant other than a first applicant could become effective under this clause.

- (bb) First applicant—As used in this subsection, the term “first applicant” means an applicant that, on the first day on which a substantially complete application containing a certification described in paragraph (2)(A)(vii)(IV) is submitted for approval of a drug, submits a substantially complete application that contains and lawfully maintains a certification described in paragraph (2)(A)(vii)(IV) for the drug.
- (cc) Substantially complete application—As used in this subsection, the term “substantially complete application” means an application under this subsection that on its face is sufficiently complete to permit a substantive review and contains all the information required by paragraph (2)(A).
- (dd) Tentative approval
 - (AA) In general—The term “tentative approval” means notification to an applicant by the Secre-

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tary that an application under this subsection meets the requirements of paragraph (2)(A), but cannot receive effective approval because the application does not meet the requirements of this subparagraph, there is a period of exclusivity for the listed drug under subparagraph (F) or section 355a of this title, or there is a 7-year period of exclusivity for the listed drug under section 360cc of this title.

(BB) Limitation—A drug that is granted tentative approval by the Secretary is not an approved drug and shall not have an effective approval until the Secretary issues an approval after any necessary additional review of the application.

(C) Civil action to obtain patent certainty

(i) Declaratory judgment absent infringement action

(I) In general—No action may be brought under section 2201 of Title 28, by an applicant under paragraph (2) for a declaratory

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judgment with respect to a patent which is the subject of the certification referred to in subparagraph (B)(iii) unless—

- (aa) the 45-day period referred to in such subparagraph has expired;
 - (bb) neither the owner of such patent nor the holder of the approved application under subsection (b) of this section for the drug that is claimed by the patent or a use of which is claimed by the patent brought a civil action against the applicant for infringement of the patent before the expiration of such period; and
 - (cc) in any case in which the notice provided under paragraph (2)(B) relates to noninfringement, the notice was accompanied by a document described in subclause (III).
- (II) Filing of civil action—If the conditions described in items (aa), (bb), and as applicable, (cc) of subclause (I) have been met, the applicant referred to in such subclause may, in accordance with section 2201 of Title 28, bring a civil action under such section against the owner or holder referred to in such subclause (but

not against any owner or holder that has brought such a civil action against the applicant, unless that civil action was dismissed without prejudice) for a declaratory judgment that the patent is invalid or will not be infringed by the drug for which the applicant seeks approval, except that such civil action may be brought for a declaratory judgment that the patent will not be infringed only in a case in which the condition described in subclause (I)(cc) is applicable. A civil action referred to in this subclause shall be brought in the judicial district where the defendant has its principal place of business or a regular and established place of business.

- (III) Offer of confidential access to application—For purposes of subclause (I)(cc), the document described in this subclause is a document providing an offer of confidential access to the application that is in the custody of the applicant under paragraph (2) for the purpose of determining whether an action referred to in subparagraph (B)(iii) should be brought. The document providing the offer of confidential access shall contain such restrictions as to persons entitled to access, and on the

use and disposition of any information accessed, as would apply had a protective order been entered for the purpose of protecting trade secrets and other confidential business information. A request for access to an application under an offer of confidential access shall be considered acceptance of the offer of confidential access with the restrictions as to persons entitled to access, and on the use and disposition of any information accessed, contained in the offer of confidential access, and those restrictions and other terms of the offer of confidential access shall be considered terms of an enforceable contract. Any person provided an offer of confidential access shall review the application for the sole and limited purpose of evaluating possible infringement of the patent that is the subject of the certification under paragraph (2)(A)(vii)(IV) and for no other purpose, and may not disclose information of no relevance to any issue of patent infringement to any person other than a person provided an offer of confidential access. Further, the application may be redacted by the applicant to remove any information of no

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relevance to any issue of patent infringement.

- (ii) Counterclaim to infringement action
 - (I) In general—If an owner of the patent or the holder of the approved application under subsection (b) of this section for the drug that is claimed by the patent or a use of which is claimed by the patent brings a patent infringement action against the applicant, the applicant may assert a counterclaim seeking an order requiring the holder to correct or delete the patent information submitted by the holder under subsection (b) or (c) of this section on the ground that the patent does not claim either—
 - (aa) the drug for which the application was approved; or
 - (bb) an approved method of using the drug.
 - (II) No independent cause of action—Subclause (I) does not authorize the assertion of a claim described in subclause (I) in any civil action or proceeding other than a counterclaim described in subclause (I).
- (iii) No damages—An applicant shall not be entitled to damages in a civil ac-

tion under clause (i) or a counterclaim under clause (ii).

(D) Forfeiture of 180-day exclusivity period

(i) Definition of forfeiture event—In this subparagraph, the term “forfeiture event”, with respect to an application under this subsection, means the occurrence of any of the following:

(I) Failure to market —The first applicant fails to market the drug by the later of—

(aa) the earlier of the date that is—

(AA) 75 days after the date on which the approval of the application of the first applicant is made effective under subparagraph (B)(iii); or

(BB) 30 months after the date of submission of the application of the first applicant; or

(bb) with respect to the first applicant or any other applicant (which other applicant has received tentative approval), the date that is 75 days after the date as of which, as to each of the patents with respect to which the first applicant submitted and lawfully maintained a certification

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qualifying the first applicant for the 180-day exclusivity period under subparagraph (B)(iv), at least 1 of the following has occurred:

- (AA) In an infringement action brought against that applicant with respect to the patent or in a declaratory judgment action brought by that applicant with respect to the patent, a court enters a final decision from which no appeal (other than a petition to the Supreme Court for a writ of certiorari) has been or can be taken that the patent is invalid or not infringed.
- (BB) In an infringement action or a declaratory judgment action described in subitem (AA), a court signs a settlement order or consent decree that enters a final judgment that includes a finding that the patent is invalid or not infringed.
- (CC) The patent information submitted under subsection (b) or (c) of this section is withdrawn by the

holder of the application approved under subsection (b) of this section.

- (II) Withdrawal of application—The first applicant withdraws the application or the Secretary considers the application to have been withdrawn as a result of a determination by the Secretary that the application does not meet the requirements for approval under paragraph (4).
- (III) Amendment of certification—The first applicant amends or withdraws the certification for all of the patents with respect to which that applicant submitted a certification qualifying the applicant for the 180-day exclusivity period.
- (IV) Failure to obtain tentative approval—The first applicant fails to obtain tentative approval of the application within 30 months after the date on which the application is filed, unless the failure is caused by a change in or a review of the requirements for approval of the application imposed after the date on which the application is filed.
- (V) Agreement with another applicant, the listed drug application holder, or a patent owner—The first applicant enters into an

agreement with another applicant under this subsection for the drug, the holder of the application for the listed drug, or an owner of the patent that is the subject of the certification under paragraph (2)(A)(vii)(IV), the Federal Trade Commission or the Attorney General files a complaint, and there is a final decision of the Federal Trade Commission or the court with regard to the complaint from which no appeal (other than a petition to the Supreme Court for a writ of certiorari) has been or can be taken that the agreement has violated the antitrust laws (as defined in section 12 of Title 15, except that the term includes section 45 of Title 15 to the extent that that section applies to unfair methods of competition).

- (VI) Expiration of all patents—All of the patents as to which the applicant submitted a certification qualifying it for the 180-day exclusivity period have expired.
- (ii) Forfeiture—The 180-day exclusivity period described in subparagraph (B)(iv) shall be forfeited by a first applicant if a forfeiture event occurs with respect to that first applicant.

- (iii) Subsequent applicant—If all first applicants forfeit the 180-day exclusivity period under clause (ii)—
 - (I) approval of any application containing a certification described in paragraph (2)(A)(vii)(IV) shall be made effective in accordance with subparagraph (B)(iii); and
 - (II) no applicant shall be eligible for a 180-day exclusivity period.
- (E) If the Secretary decides to disapprove an application, the Secretary shall give the applicant notice of an opportunity for a hearing before the Secretary on the question of whether such application is approvable. If the applicant elects to accept the opportunity for hearing by written request within thirty days after such notice, such hearing shall commence not more than ninety days after the expiration of such thirty days unless the Secretary and the applicant otherwise agree. Any such hearing shall thereafter be conducted on an expedited basis and the Secretary's order thereon shall be issued within ninety days after the date fixed by the Secretary for filing final briefs.
- (F)(i) If an application (other than an abbreviated new drug application) submitted under subsection (b) of this section for a drug, no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other applica-

tion under subsection (b) of this section, was approved during the period beginning January 1, 1982, and ending on September 24, 1984, the Secretary may not make the approval of an application submitted under this subsection which refers to the drug for which the subsection (b) application was submitted effective before the expiration of ten years from the date of the approval of the application under subsection (b) of this section.

- (ii) If an application submitted under subsection (b) of this section for a drug, no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other application under subsection (b) of this section, is approved after September 24, 1984, no application may be submitted under this subsection which refers to the drug for which the subsection (b) application was submitted before the expiration of five years from the date of the approval of the application under subsection (b) of this section, except that such an application may be submitted under this subsection after the expiration of four years from the date of the approval of the subsection (b) application if it contains a certification of patent invalidity or noninfringement described in subclause (IV) of paragraph (2)(A)(vii). The ap-

proval of such an application shall be made effective in accordance with subparagraph (B) except that, if an action for patent infringement is commenced during the one-year period beginning forty-eight months after the date of the approval of the subsection (b) application, the thirty-month period referred to in subparagraph (B)(iii) shall be extended by such amount of time (if any) which is required for seven and one-half years to have elapsed from the date of approval of the subsection (b) application.

- (iii) If an application submitted under subsection (b) of this section for a drug, which includes an active ingredient (including any ester or salt of the active ingredient) that has been approved in another application approved under subsection (b) of this section, is approved after September 24, 1984, and if such application contains reports of new clinical investigations (other than bioavailability studies) essential to the approval of the application and conducted or sponsored by the applicant, the Secretary may not make the approval of an application submitted under this subsection for the conditions of approval of such drug in the subsection (b) application effective before the expiration of three years from the date

of the approval of the application under subsection (b) of this section for such drug.

- (iv) If a supplement to an application approved under subsection (b) of this section is approved after September 24, 1984, and the supplement contains reports of new clinical investigations (other than bioavailability studies) essential to the approval of the supplement and conducted or sponsored by the person submitting the supplement, the Secretary may not make the approval of an application submitted under this subsection for a change approved in the supplement effective before the expiration of three years from the date of the approval of the supplement under subsection (b) of this section.
- (v) If an application (or supplement to an application) submitted under subsection (b) of this section for a drug, which includes an active ingredient (including any ester or salt of the active ingredient) that has been approved in another application under subsection (b) of this section, was approved during the period beginning January 1, 1982, and ending on September 24, 1984, the Secretary may not make the approval of an application submitted under this subsection which refers to the drug for which the subsection (b) application was sub-

mitted or which refers to a change approved in a supplement to the subsection (b) application effective before the expiration of two years from September 24, 1984.

- (6) If a drug approved under this subsection refers in its approved application to a drug the approval of which was withdrawn or suspended for grounds described in the first sentence of subsection (e) of this section or was withdrawn or suspended under this paragraph or which, as determined by the Secretary, has been withdrawn from sale for safety or effectiveness reasons, the approval of the drug under this subsection shall be withdrawn or suspended—
 - (A) for the same period as the withdrawal or suspension under subsection (e) of this section or this paragraph, or
 - (B) if the listed drug has been withdrawn from sale, for the period of withdrawal from sale or, if earlier, the period ending on the date the Secretary determines that the withdrawal from sale is not for safety or effectiveness reasons.
- (7)(A)(i) Within sixty days of September 24, 1984, the Secretary shall publish and make available to the public—
 - (I) a list in alphabetical order of the official and proprietary name of each drug which has been approved for safety and effectiveness under subsection (c) of this

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section before September 24, 1984;

- (II) the date of approval if the drug is approved after 1981 and the number of the application which was approved; and
 - (III) whether in vitro or in vivo bioequivalence studies, or both such studies, are required for applications filed under this subsection which will refer to the drug published.
- (ii) Every thirty days after the publication of the first list under clause (i) the Secretary shall revise the list to include each drug which has been approved for safety and effectiveness under subsection (c) of this section or approved under this subsection during the thirty-day period.
 - (iii) When patent information submitted under subsection (b) or (c) of this section respecting a drug included on the list is to be published by the Secretary, the Secretary shall, in revisions made under clause (ii), include such information for such drug.
- (B) A drug approved for safety and effectiveness under subsection (c) of this section or approved under this subsection shall, for purposes of this subsection, be considered to have been published under subparagraph (A) on the date of its approval

or September 24, 1984, whichever is later.

- (C) If the approval of a drug was withdrawn or suspended for grounds described in the first sentence of subsection (e) of this section or was withdrawn or suspended under paragraph (6) or if the Secretary determines that a drug has been withdrawn from sale for safety or effectiveness reasons, it may not be published in the list under subparagraph (A) or, if the withdrawal or suspension occurred after its publication in such list, it shall be immediately removed from such list—
 - (i) for the same period as the withdrawal or suspension under subsection (e) of this section or paragraph (6), or
 - (ii) if the listed drug has been withdrawn from sale, for the period of withdrawal from sale or, if earlier, the period ending on the date the Secretary determines that the withdrawal from sale is not for safety or effectiveness reasons.

A notice of the removal shall be published in the Federal Register.

- (8) For purposes of this subsection:
 - (A)(i) The term “bioavailability” means the rate and extent to which the active ingredient or therapeutic ingredient is absorbed from a drug and becomes available at the site of drug action.

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- (ii) For a drug that is not intended to be absorbed into the bloodstream, the Secretary may assess bioavailability by scientifically valid measurements intended to reflect the rate and extent to which the active ingredient or therapeutic ingredient becomes available at the site of drug action.
- (B) A drug shall be considered to be bioequivalent to a listed drug if—
- (i) the rate and extent of absorption of the drug do not show a significant difference from the rate and extent of absorption of the listed drug when administered at the same molar dose of the therapeutic ingredient under similar experimental conditions in either a single dose or multiple doses; or
 - (ii) the extent of absorption of the drug does not show a significant difference from the extent of absorption of the listed drug when administered at the same molar dose of the therapeutic ingredient under similar experimental conditions in either a single dose or multiple doses and the difference from the listed drug in the rate of absorption of the drug is intentional, is reflected in its proposed labeling, is not essential to the attainment of effective body drug concentrations on chronic use, and is considered medically insignificant for the drug.

- (C) For a drug that is not intended to be absorbed into the bloodstream, the Secretary may establish alternative, scientifically valid methods to show bioequivalence if the alternative methods are expected to detect a significant difference between the drug and the listed drug in safety and therapeutic effect.
- (9) The Secretary shall, with respect to each application submitted under this subsection, maintain a record of—
- (A) the name of the applicant,
 - (B) the name of the drug covered by the application,
 - (C) the name of each person to whom the review of the chemistry of the application was assigned and the date of such assignment, and
 - (D) the name of each person to whom the bioequivalence review for such application was assigned and the date of such assignment.

The information the Secretary is required to maintain under this paragraph with respect to an application submitted under this subsection shall be made available to the public after the approval of such application.

- (10)(A) If the proposed labeling of a drug that is the subject of an application under this subsection differs from the listed drug due to a labeling revision described under clause (i), the drug that is the subject of such application shall, notwithstanding

any other provision of this chapter, be eligible for approval and shall not be considered misbranded under section 352 of this title if—

- (i) the application is otherwise eligible for approval under this subsection but for expiration of patent, an exclusivity period, or of a delay in approval described in paragraph (5)(B)(iii), and a revision to the labeling of the listed drug has been approved by the Secretary within 60 days of such expiration;
 - (ii) the labeling revision described under clause (i) does not include a change to the “Warnings” section of the labeling;
 - (iii) the sponsor of the application under this subsection agrees to submit revised labeling of the drug that is the subject of such application not later than 60 days after the notification of any changes to such labeling required by the Secretary; and
 - (iv) such application otherwise meets the applicable requirements for approval under this subsection.
- (B) If, after a labeling revision described in subparagraph (A)(i), the Secretary determines that the continued presence in interstate commerce of the labeling of the listed drug (as in effect before the revision described in subparagraph (A)(i)) adversely impacts the safe use of the

drug, no application under this subsection shall be eligible for approval with such labeling.

(k) Records and reports; required information; regulations and orders; access to records

- (1) In the case of any drug for which an approval of an application filed under subsection (b) or (j) of this section is in effect, the applicant shall establish and maintain such records, and make such reports to the Secretary, of data relating to clinical experience and other data or information, received or otherwise obtained by such applicant with respect to such drug, as the Secretary may by general regulation, or by order with respect to such application, prescribe on the basis of a finding that such records and reports are necessary in order to enable the Secretary to determine, or facilitate a determination, whether there is or may be ground for invoking subsection (e) of this section. Regulations and orders issued under this subsection and under subsection (i) of this section shall have due regard for the professional ethics of the medical profession and the interests of patients and shall provide, where the Secretary deems it to be appropriate, for the examination, upon request, by the persons to whom such regulations or orders are applicable, of similar information received or otherwise obtained by the Secretary.
- (2) Every person required under this section to maintain records, and every person in charge or custody thereof, shall, upon request of an

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officer or employee designated by the Secretary, permit such officer or employee at all reasonable times to have access to and copy and verify such records.

- (3) Active postmarket risk identification
 - (A) Definition—In this paragraph, the term “data” refers to information with respect to a drug approved under this section or under section 262 of Title 42, including claims data, patient survey data, standardized analytic files that allow for the pooling and analysis of data from disparate data environments, and any other data deemed appropriate by the Secretary.
 - (B) Development of postmarket risk identification and analysis methods—The Secretary shall, not later than 2 years after September 27, 2007, in collaboration with public, academic, and private entities—
 - (i) develop methods to obtain access to disparate data sources including the data sources specified in subparagraph (C);
 - (ii) develop validated methods for the establishment of a postmarket risk identification and analysis system to link and analyze safety data from multiple sources, with the goals of including, in aggregate—
 - (I) at least 25,000,000 patients by July 1, 2010; and

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- (II) at least 100,000,000 patients by July 1, 2012; and
 - (iii) convene a committee of experts, including individuals who are recognized in the field of protecting data privacy and security, to make recommendations to the Secretary on the development of tools and methods for the ethical and scientific uses for, and communication of, postmarketing data specified under subparagraph (C), including recommendations on the development of effective research methods for the study of drug safety questions.
- (C) Establishment of the postmarket risk identification and analysis system
- (i) In general—The Secretary shall, not later than 1 year after the development of the risk identification and analysis methods under subparagraph (B), establish and maintain procedures—
 - (I) for risk identification and analysis based on electronic health data, in compliance with the regulations promulgated under section 264(c) of the Health Insurance Portability and Accountability Act of 1996, and in a manner that does not disclose individually identifiable health information in violation of paragraph (4)(B);

- (II) for the reporting (in a standardized form) of data on all serious adverse drug experiences (as defined in section 355-1(b) of this title) submitted to the Secretary under paragraph (1), and those adverse events submitted by patients, providers, and drug sponsors, when appropriate;
- (III) to provide for active adverse event surveillance using the following data sources, as available:
 - (aa) Federal health-related electronic data (such as data from the Medicare program and the health systems of the Department of Veterans Affairs);
 - (bb) private sector health-related electronic data (such as pharmaceutical purchase data and health insurance claims data); and
 - (cc) other data as the Secretary deems necessary to create a robust system to identify adverse events and potential drug safety signals;
- (IV) to identify certain trends and patterns with respect to data accessed by the system;
- (V) to provide regular reports to the Secretary concerning adverse

event trends, adverse event patterns, incidence and prevalence of adverse events, and other information the Secretary determines appropriate, which may include data on comparative national adverse event trends; and

- (VI) to enable the program to export data in a form appropriate for further aggregation, statistical analysis, and reporting.
- (ii) Timeliness of reporting—The procedures established under clause (i) shall ensure that such data are accessed, analyzed, and reported in a timely, routine, and systematic manner, taking into consideration the need for data completeness, coding, cleansing, and standardized analysis and transmission.
- (iii) Private sector resources—To ensure the establishment of the active post-market risk identification and analysis system under this subsection not later than 1 year after the development of the risk identification and analysis methods under subparagraph (B), as required under clause (i), the Secretary may, on a temporary or permanent basis, implement systems or products developed by private entities.
- (iv) Complementary approaches—To the extent the active postmarket risk

identification and analysis system under this subsection is not sufficient to gather data and information relevant to a priority drug safety question, the Secretary shall develop, support, and participate in complementary approaches to gather and analyze such data and information, including—

- (I) approaches that are complementary with respect to assessing the safety of use of a drug in domestic populations not included, or underrepresented, in the trials used to approve the drug (such as older people, people with comorbidities, pregnant women, or children); and
 - (II) existing approaches such as the Vaccine Adverse Event Reporting System and the Vaccine Safety Datalink or successor databases.
- (v) Authority for contracts—The Secretary may enter into contracts with public and private entities to fulfill the requirements of this subparagraph.
- (4) Advanced analysis of drug safety data
- (A) Purpose—The Secretary shall establish collaborations with public, academic, and private entities, which may include the Centers for Education and Research on Therapeutics under section 299b-1 of Title 42, to provide for advanced analysis

of drug safety data described in paragraph (3)(C) and other information that is publicly available or is provided by the Secretary, in order to—

- (i) improve the quality and efficiency of postmarket drug safety risk-benefit analysis;
 - (ii) provide the Secretary with routine access to outside expertise to study advanced drug safety questions; and
 - (iii) enhance the ability of the Secretary to make timely assessments based on drug safety data.
- (B) Privacy—Such analysis shall not disclose individually identifiable health information when presenting such drug safety signals and trends or when responding to inquiries regarding such drug safety signals and trends.
- (C) Public process for priority questions—At least biannually, the Secretary shall seek recommendations from the Drug Safety and Risk Management Advisory Committee (or any successor committee) and from other advisory committees, as appropriate, to the Food and Drug Administration on—
- (i) priority drug safety questions; and
 - (ii) mechanisms for answering such questions, including through—
 - (I) active risk identification under paragraph (3); and

- (II) when such risk identification is not sufficient, postapproval studies and clinical trials under subsection (o)(3) of this section.
- (D) Procedures for the development of drug safety collaborations
- (i) In general—Not later than 180 days after the date of the establishment of the active postmarket risk identification and analysis system under this subsection, the Secretary shall establish and implement procedures under which the Secretary may routinely contract with one or more qualified entities to—
 - (I) classify, analyze, or aggregate data described in paragraph (3)(C) and information that is publicly available or is provided by the Secretary;
 - (II) allow for prompt investigation of priority drug safety questions, including—
 - (aa) unresolved safety questions for drugs or classes of drugs; and
 - (bb) for a newly-approved drugs, safety signals from clinical trials used to approve the drug and other preapproval trials; rare, serious drug side effects; and the safety of use in domestic populations not

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included, or underrepresented, in the trials used to approve the drug (such as older people, people with comorbidities, pregnant women, or children);

- (III) perform advanced research and analysis on identified drug safety risks;
 - (IV) focus postapproval studies and clinical trials under subsection (o)(3) of this section more effectively on cases for which reports under paragraph (1) and other safety signal detection is not sufficient to resolve whether there is an elevated risk of a serious adverse event associated with the use of a drug; and
 - (V) carry out other activities as the Secretary deems necessary to carry out the purposes of this paragraph.
- (ii) Request for specific methodology—The procedures described in clause (i) shall permit the Secretary to request that a specific methodology be used by the qualified entity. The qualified entity shall work with the Secretary to finalize the methodology to be used.
- (E) Use of analyses—The Secretary shall provide the analyses described in this paragraph, including the methods and re-

sults of such analyses, about a drug to the sponsor or sponsors of such drug.

(F) Qualified entities

- (i) In general—The Secretary shall enter into contracts with a sufficient number of qualified entities to develop and provide information to the Secretary in a timely manner.
- (ii) Qualification—The Secretary shall enter into a contract with an entity under clause (i) only if the Secretary determines that the entity has a significant presence in the United States and has one or more of the following qualifications:
 - (I) The research, statistical, epidemiologic, or clinical capability and expertise to conduct and complete the activities under this paragraph, including the capability and expertise to provide the Secretary de-identified data consistent with the requirements of this subsection.
 - (II) An information technology infrastructure in place to support electronic data and operational standards to provide security for such data.
 - (III) Experience with, and expertise on, the development of drug safety and effectiveness research using electronic population data.

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- (IV) An understanding of drug development or risk/benefit balancing in a clinical setting.
- (V) Other expertise which the Secretary deems necessary to fulfill the activities under this paragraph.
- (G) Contract requirements—Each contract with a qualified entity under subparagraph (F)(i) shall contain the following requirements:
 - (i) Ensuring privacy—The qualified entity shall ensure that the entity will not use data under this subsection in a manner that—
 - (I) violates the regulations promulgated under section 264(c) of the Health Insurance Portability and Accountability Act of 1996;
 - (II) violates sections 552 or 552a of Title 5 with regard to the privacy of individually-identifiable beneficiary health information; or
 - (III) discloses individually identifiable health information when presenting drug safety signals and trends or when responding to inquiries regarding drug safety signals and trends.

Nothing in this clause prohibits lawful disclosure for other purposes.

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- (ii) Component of another organization—
If a qualified entity is a component of another organization—
 - (I) the qualified entity shall establish appropriate security measures to maintain the confidentiality and privacy of such data; and
 - (II) the entity shall not make an unauthorized disclosure of such data to the other components of the organization in breach of such confidentiality and privacy requirement.
- (iii) Termination or nonrenewal—If a contract with a qualified entity under this subparagraph is terminated or not renewed, the following requirements shall apply:
 - (I) Confidentiality and privacy protections—The entity shall continue to comply with the confidentiality and privacy requirements under this paragraph with respect to all data disclosed to the entity.
 - (II) Disposition of data—The entity shall return any data disclosed to such entity under this subsection to which it would not otherwise have access or, if returning the data is not practicable, destroy the data.

- (H) Competitive procedures—The Secretary shall use competitive procedures (as defined in section 403(5) of Title 41) to enter into contracts under subparagraph (G).
 - (I) Review of contract in the event of a merger or acquisition—The Secretary shall review the contract with a qualified entity under this paragraph in the event of a merger or acquisition of the entity in order to ensure that the requirements under this paragraph will continue to be met.
 - (J) Coordination—In carrying out this paragraph, the Secretary shall provide for appropriate communications to the public, scientific, public health, and medical communities, and other key stakeholders, and to the extent practicable shall coordinate with the activities of private entities, professional associations, or other entities that may have sources of drug safety data.
- (5) The Secretary shall—
- (A) conduct regular, bi-weekly screening of the Adverse Event Reporting System database and post a quarterly report on the Adverse Event Reporting System Web site of any new safety information or potential signal of a serious risk identified by Adverse Event Reporting System within the last quarter;

- (B) report to Congress not later than 2 year² after September 27, 2007 on procedures and processes of the Food and Drug Administration for addressing ongoing post market safety issues identified by the Office of Surveillance and Epidemiology and how recommendations of the Office of Surveillance and Epidemiology are handled within the agency; and
- (C) on an annual basis, review the entire backlog of postmarket safety commitments to determine which commitments require revision or should be eliminated, report to the Congress on these determinations, and assign start dates and estimated completion dates for such commitments.

(l) Public disclosure of safety and effectiveness data

- (1) Safety and effectiveness data and information which has been submitted in an application under subsection (b) of this section for a drug and which has not previously been disclosed to the public shall be made available to the public, upon request, unless extraordinary circumstances are shown—
 - (A) if no work is being or will be undertaken to have the application approved,
 - (B) if the Secretary has determined that the application is not approvable and all legal appeals have been exhausted,

² So in original. Probably should be “years”.

- (C) if approval of the application under subsection (c) of this section is withdrawn and all legal appeals have been exhausted,
 - (D) if the Secretary has determined that such drug is not a new drug, or
 - (E) upon the effective date of the approval of the first application under subsection (j) of this section which refers to such drug or upon the date upon which the approval of an application under subsection (j) of this section which refers to such drug could be made effective if such an application had been submitted.
- (2) Action package for approval
- (A) Action package—The Secretary shall publish the action package for approval of an application under subsection (b) of this section or section 262 of title 42 on the Internet Web site of the Food and Drug Administration—
 - (i) not later than 30 days after the date of approval of such application for a drug no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other application under this section or section 262 of Title 42; and
 - (ii) not later than 30 days after the third request for such action package for approval received under section 552 of Title 5 for any other drug.

- (B) Immediate publication of summary review—Notwithstanding subparagraph (A), the Secretary shall publish, on the Internet Web site of the Food and Drug Administration, the materials described in subparagraph (C)(iv) not later than 48 hours after the date of approval of the drug, except where such materials require redaction by the Secretary.
- (C) Contents—An action package for approval of an application under subparagraph (A) shall be dated and shall include the following:
 - (i) Documents generated by the Food and Drug Administration related to review of the application.
 - (ii) Documents pertaining to the format and content of the application generated during drug development.
 - (iii) Labeling submitted by the applicant.
 - (iv) A summary review that documents conclusions from all reviewing disciplines about the drug, noting any critical issues and disagreements with the applicant and within the review team and how they were resolved, recommendations for action, and an explanation of any nonconcurrency with review conclusions.
 - (v) The Division Director and Office Director's decision document which includes—

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- (I) a brief statement of concurrence with the summary review;
 - (II) a separate review or addendum to the review if disagreeing with the summary review; and
 - (III) a separate review or addendum to the review to add further analysis.
- (vi) Identification by name of each officer or employee of the Food and Drug Administration who—
- (I) participated in the decision to approve the application; and
 - (II) consents to have his or her name included in the package.
- (D) Review—A scientific review of an application is considered the work of the reviewer and shall not be altered by management or the reviewer once final.
- (E) Confidential information—This paragraph does not authorize the disclosure of any trade secret, confidential commercial or financial information, or other matter listed in section 552(b) of Title 5.

(m) “Patent” defined

For purposes of this section, the term “patent” means a patent issued by the United States Patent and Trademark Office.

(n) Scientific advisory panels

- (1) For the purpose of providing expert scientific advice and recommendations to the Secretary

regarding a clinical investigation of a drug or the approval for marketing of a drug under this section or section 262 of Title 42, the Secretary shall establish panels of experts or use panels of experts established before November 21, 1997, or both.

- (2) The Secretary may delegate the appointment and oversight authority granted under section 394 of this title to a director of a center or successor entity within the Food and Drug Administration.
- (3) The Secretary shall make appointments to each panel established under paragraph (1) so that each panel shall consist of—
 - (A) members who are qualified by training and experience to evaluate the safety and effectiveness of the drugs to be referred to the panel and who, to the extent feasible, possess skill and experience in the development, manufacture, or utilization of such drugs;
 - (B) members with diverse expertise in such fields as clinical and administrative medicine, pharmacy, pharmacology, pharmacoeconomics, biological and physical sciences, and other related professions;
 - (C) a representative of consumer interests, and a representative of interests of the drug manufacturing industry not directly affected by the matter to be brought before the panel; and
 - (D) two or more members who are specialists or have other expertise in the particular

disease or condition for which the drug under review is proposed to be indicated.

Scientific, trade, and consumer organizations shall be afforded an opportunity to nominate individuals for appointment to the panels. No individual who is in the regular full-time employ of the United States and engaged in the administration of this chapter may be a voting member of any panel. The Secretary shall designate one of the members of each panel to serve as chairman thereof.

- (4) The Secretary shall, as appropriate, provide education and training to each new panel member before such member participates in a panel's activities, including education regarding requirements under this chapter and related regulations of the Secretary, and the administrative processes and procedures related to panel meetings.
- (5) Panel members (other than officers or employees of the United States), while attending meetings or conferences of a panel or otherwise engaged in its business, shall be entitled to receive compensation for each day so engaged, including traveltime, at rates to be fixed by the Secretary, but not to exceed the daily equivalent of the rate in effect for positions classified above grade GS-15 of the General Schedule. While serving away from their homes or regular places of business, panel members may be allowed travel expenses (including per diem in lieu of subsistence) as authorized by section 5703 of Title 5, for persons in the Government service employed intermittently.

- (6) The Secretary shall ensure that scientific advisory panels meet regularly and at appropriate intervals so that any matter to be reviewed by such a panel can be presented to the panel not more than 60 days after the matter is ready for such review. Meetings of the panel may be held using electronic communication to convene the meetings.
- (7) Within 90 days after a scientific advisory panel makes recommendations on any matter under its review, the Food and Drug Administration official responsible for the matter shall review the conclusions and recommendations of the panel, and notify the affected persons of the final decision on the matter, or of the reasons that no such decision has been reached. Each such final decision shall be documented including the rationale for the decision.
- (8) Redesignated (7)

(o) Postmarket studies and clinical trials; labeling

- (1) In general—A responsible person may not introduce or deliver for introduction into interstate commerce the new drug involved if the person is in violation of a requirement established under paragraph (3) or (4) with respect to the drug.
- (2) Definitions—For purposes of this subsection:
 - (A) Responsible person—The term “responsible person” means a person who—
 - (i) has submitted to the Secretary a covered application that is pending; or

- (ii) is the holder of an approved covered application.
 - (B) Covered application—The term “covered application” means—
 - (i) an application under subsection (b) of this section for a drug that is subject to section 353(b) of this title; and
 - (ii) an application under section 262 of Title 42.
 - (C) New safety information; serious risk—The terms “new safety information”, “serious risk”, and “signal of a serious risk” have the meanings given such terms in section 355-1(b) of this title.
- (3) Studies and clinical trials
- (A) In general—For any or all of the purposes specified in subparagraph (B), the Secretary may, subject to subparagraph (D), require a responsible person for a drug to conduct a postapproval study or studies of the drug, or a postapproval clinical trial or trials of the drug, on the basis of scientific data deemed appropriate by the Secretary, including information regarding chemically-related or pharmacologically-related drugs.
 - (B) Purposes of study or clinical trial—The purposes referred to in this subparagraph with respect to a postapproval study or postapproval clinical trial are the following:

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- (i) To assess a known serious risk related to the use of the drug involved.
 - (ii) To assess signals of serious risk related to the use of the drug.
 - (iii) To identify an unexpected serious risk when available data indicates the potential for a serious risk.
- (C) Establishment of requirement after approval of covered application—The Secretary may require a postapproval study or studies or postapproval clinical trial or trials for a drug for which an approved covered application is in effect as of the date on which the Secretary seeks to establish such requirement only if the Secretary becomes aware of new safety information.
- (D) Determination by Secretary
- (i) Postapproval studies—The Secretary may not require the responsible person to conduct a study under this paragraph, unless the Secretary makes a determination that the reports under subsection (k)(1) of this section and the active postmarket risk identification and analysis system as available under subsection (k)(3) of this section will not be sufficient to meet the purposes set forth in subparagraph (B).
 - (ii) Postapproval clinical trials—The Secretary may not require the responsible person to conduct a clinical trial

under this paragraph, unless the Secretary makes a determination that a postapproval study or studies will not be sufficient to meet the purposes set forth in subparagraph (B).

- (E) Notification; timetables; periodic reports
- (i) Notification—The Secretary shall notify the responsible person regarding a requirement under this paragraph to conduct a postapproval study or clinical trial by the target dates for communication of feedback from the review team to the responsible person regarding proposed labeling and postmarketing study commitments as set forth in the letters described in section 101(c) of the Food and Drug Administration Amendments Act of 2007.
 - (ii) Timetable; periodic reports—For each study or clinical trial required to be conducted under this paragraph, the Secretary shall require that the responsible person submit a timetable for completion of the study or clinical trial. With respect to each study required to be conducted under this paragraph or otherwise undertaken by the responsible person to investigate a safety issue, the Secretary shall require the responsible person to periodically report to the Secretary on the status of such study including whether any difficulties in completing

the study have been encountered. With respect to each clinical trial required to be conducted under this paragraph or otherwise undertaken by the responsible person to investigate a safety issue, the Secretary shall require the responsible person to periodically report to the Secretary on the status of such clinical trial including whether enrollment has begun, the number of participants enrolled, the expected completion date, whether any difficulties completing the clinical trial have been encountered, and registration information with respect to the requirements under section 282(j) of Title 42. If the responsible person fails to comply with such timetable or violates any other requirement of this subparagraph, the responsible person shall be considered in violation of this subsection, unless the responsible person demonstrates good cause for such noncompliance or such other violation. The Secretary shall determine what constitutes good cause under the preceding sentence.

- (F) Dispute resolution—The responsible person may appeal a requirement to conduct a study or clinical trial under this paragraph using dispute resolution procedures established by the Secretary in regulation and guidance.

- (4) Safety labeling changes requested by Secretary
 - (A) New safety information—If the Secretary becomes aware of new safety information that the Secretary believes should be included in the labeling of the drug, the Secretary shall promptly notify the responsible person or, if the same drug approved under subsection (b) of this section is not currently marketed, the holder of an approved application under subsection (j) of this section.
 - (B) Response to notification—Following notification pursuant to subparagraph (A), the responsible person or the holder of the approved application under subsection (j) of this section shall within 30 days—
 - (i) submit a supplement proposing changes to the approved labeling to reflect the new safety information, including changes to boxed warnings, contraindications, warnings, precautions, or adverse reactions; or
 - (ii) notify the Secretary that the responsible person or the holder of the approved application under subsection (j) of this section does not believe a labeling change is warranted and submit a statement detailing the reasons why such a change is not warranted.
 - (C) Review—Upon receipt of such supplement, the Secretary shall promptly re-

view and act upon such supplement. If the Secretary disagrees with the proposed changes in the supplement or with the statement setting forth the reasons why no labeling change is necessary, the Secretary shall initiate discussions to reach agreement on whether the labeling for the drug should be modified to reflect the new safety information, and if so, the contents of such labeling changes.

- (D) Discussions—Such discussions shall not extend for more than 30 days after the response to the notification under subparagraph (B), unless the Secretary determines an extension of such discussion period is warranted.
- (E) Order—Within 15 days of the conclusion of the discussions under subparagraph (D), the Secretary may issue an order directing the responsible person or the holder of the approved application under subsection (j) of this section to make such a labeling change as the Secretary deems appropriate to address the new safety information. Within 15 days of such an order, the responsible person or the holder of the approved application under subsection (j) of this section shall submit a supplement containing the labeling change.
- (F) Dispute resolution—Within 5 days of receiving an order under subparagraph (E), the responsible person or the holder of the approved application under subsection (j) of this section may appeal using

dispute resolution procedures established by the Secretary in regulation and guidance.

- (G) Violation—If the responsible person or the holder of the approved application under subsection (j) of this section has not submitted a supplement within 15 days of the date of such order under subparagraph (E), and there is no appeal or dispute resolution proceeding pending, the responsible person or holder shall be considered to be in violation of this subsection. If at the conclusion of any dispute resolution procedures the Secretary determines that a supplement must be submitted and such a supplement is not submitted within 15 days of the date of that determination, the responsible person or holder shall be in violation of this subsection.
- (H) Public health threat—Notwithstanding subparagraphs (A) through (F), if the Secretary concludes that such a labeling change is necessary to protect the public health, the Secretary may accelerate the timelines in such subparagraphs.
- (I) Rule of construction—This paragraph shall not be construed to affect the responsibility of the responsible person or the holder of the approved application under subsection (j) of this section to maintain its label in accordance with existing requirements, including subpart B of part 201 and sections 314.70 and

601.12 of title 21, Code of Federal Regulations (or any successor regulations).

- (5) Non-delegation—Determinations by the Secretary under this subsection for a drug shall be made by individuals at or above the level of individuals empowered to approve a drug (such as division directors within the Center for Drug Evaluation and Research).

(p) Risk evaluation and mitigation strategy

- (1) In general—A person may not introduce or deliver for introduction into interstate commerce a new drug if—
 - (A)(i) the application for such drug is approved under subsection (b) or (j) of this section and is subject to section 353(b) of this title; or
 - (ii) the application for such drug is approved under section 262 of Title 42; and
 - (B) a risk evaluation and mitigation strategy is required under section 355-1 of this title with respect to the drug and the person fails to maintain compliance with the requirements of the approved strategy or with other requirements under section 355-1 of this title, including requirements regarding assessments of approved strategies.
- (2) Certain postmarket studies—The failure to conduct a postmarket study under section 356 of this title, subpart H of part 314, or subpart E of part 601 of title 21, Code of Federal Regulations (or any successor regula-

tions), is deemed to be a violation of paragraph (1).

(q) Petitions and civil actions regarding approval of certain applications

(1) In general

(A) Determination—The Secretary shall not delay approval of a pending application submitted under subsection (b)(2) or (j) of this section because of any request to take any form of action relating to the application, either before or during consideration of the request, unless—

- (i) the request is in writing and is a petition submitted to the Secretary pursuant to section 10.30 or 10.35 of title 21, Code of Federal Regulations (or any successor regulations); and
- (ii) the Secretary determines, upon reviewing the petition, that a delay is necessary to protect the public health.

Consideration of the petition shall be separate and apart from review and approval of any application.

(B) Notification—If the Secretary determines under subparagraph (A) that a delay is necessary with respect to an application, the Secretary shall provide to the applicant, not later than 30 days after making such determination, the following information:

- (i) Notification of the fact that a determination under subparagraph (A) has been made.
 - (ii) If applicable, any clarification or additional data that the applicant should submit to the docket on the petition to allow the Secretary to review the petition promptly.
 - (iii) A brief summary of the specific substantive issues raised in the petition which form the basis of the determination.
- (C) Format—The information described in subparagraph (B) shall be conveyed via either, at the discretion of the Secretary—
- (i) a document; or
 - (ii) a meeting with the applicant involved.
- (D) Public disclosure—Any information conveyed by the Secretary under subparagraph (C) shall be considered part of the application and shall be subject to the disclosure requirements applicable to information in such application.
- (E) Denial based on intent to delay—If the Secretary determines that a petition or a supplement to the petition was submitted with the primary purpose of delaying the approval of an application and the petition does not on its face raise valid scientific or regulatory issues, the Secretary may deny the petition at any point based

on such determination. The Secretary may issue guidance to describe the factors that will be used to determine under this subparagraph whether a petition is submitted with the primary purpose of delaying the approval of an application.

- (F) Final agency action—The Secretary shall take final agency action on a petition not later than 180 days after the date on which the petition is submitted. The Secretary shall not extend such period for any reason, including—
- (i) any determination made under subparagraph (A);
 - (ii) the submission of comments relating to the petition or supplemental information supplied by the petitioner; or
 - (iii) the consent of the petitioner.
- (G) Extension of 30-month period—If the filing of an application resulted in first-applicant status under subsection (j)(5)(D)(i)(IV) of this section and approval of the application was delayed because of a petition, the 30-month period under such subsection is deemed to be extended by a period of time equal to the period beginning on the date on which the Secretary received the petition and ending on the date of final agency action on the petition (inclusive of such beginning and ending dates), without regard to whether the Secretary grants, in whole or in part,

or denies, in whole or in part, the petition.

- (H) Certification—The Secretary shall not consider a petition for review unless the party submitting such petition does so in written form and the subject document is signed and contains the following certification: “I certify that, to my best knowledge and belief: (a) this petition includes all information and views upon which the petition relies; (b) this petition includes representative data and/or information known to the petitioner which are unfavorable to the petition; and (c) I have taken reasonable steps to ensure that any representative data and/or information which are unfavorable to the petition were disclosed to me. I further certify that the information upon which I have based the action requested herein first became known to the party on whose behalf this petition is submitted on or about the following date: _____. If I received or expect to receive payments, including cash and other forms of consideration, to file this information or its contents, I received or expect to receive those payments from the following persons or organizations: _____. I verify under penalty of perjury that the foregoing is true and correct as of the date of the submission of this petition.”, with the date on which such information first became known to such party and the names of such persons or organizations inserted

in the first and second blank space, respectively.

- (I) Verification—The Secretary shall not accept for review any supplemental information or comments on a petition unless the party submitting such information or comments does so in written form and the subject document is signed and contains the following verification: “I certify that, to my best knowledge and belief: (a) I have not intentionally delayed submission of this document or its contents; and (b) the information upon which I have based the action requested herein first became known to me on or about _____. If I received or expect to receive payments, including cash and other forms of consideration, to file this information or its contents, I received or expect to receive those payments from the following persons or organizations: _____. I verify under penalty of perjury that the foregoing is true and correct as of the date of the submission of this petition.”, with the date on which such information first became known to the party and the names of such persons or organizations inserted in the first and second blank space, respectively.
- (2) Exhaustion of administrative remedies
 - (A) Final agency action within 180 days –The Secretary shall be considered to have taken final agency action on a petition if—

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- (i) during the 180-day period referred to in paragraph (1)(F), the Secretary makes a final decision within the meaning of section 10.45(d) of title 21, Code of Federal Regulations (or any successor regulation); or
 - (ii) such period expires without the Secretary having made such a final decision.
- (B) Dismissal of certain civil actions—If a civil action is filed against the Secretary with respect to any issue raised in the petition before the Secretary has taken final agency action on the petition within the meaning of subparagraph (A), the court shall dismiss without prejudice the action for failure to exhaust administrative remedies.
- (C) Administrative record—For purposes of judicial review related to the approval of an application for which a petition under paragraph (1) was submitted, the administrative record regarding any issue raised by the petition shall include—
- (i) the petition filed under paragraph (1) and any supplements and comments thereto;
 - (ii) the Secretary's response to such petition, if issued; and
 - (iii) other information, as designated by the Secretary, related to the Secretary's determinations regarding the issues raised in such petition, as long

as the information was considered by the agency no later than the date of final agency action as defined under subparagraph (2)(A), and regardless of whether the Secretary responded to the petition at or before the approval of the application at issue in the petition.

- (3) Annual report on delays in approvals per petitions—The Secretary shall annually submit to the Congress a report that specifies—
 - (A) the number of applications that were approved during the preceding 12-month period;
 - (B) the number of such applications whose effective dates were delayed by petitions referred to in paragraph (1) during such period;
 - (C) the number of days by which such applications were so delayed; and
 - (D) the number of such petitions that were submitted during such period.
- (4) Exceptions—This subsection does not apply to—
 - (A) a petition that relates solely to the timing of the approval of an application pursuant to subsection (j)(5)(B)(iv) of this section; or
 - (B) a petition that is made by the sponsor of an application and that seeks only to have the Secretary take or refrain from

taking any form of action with respect to that application.

(5) Definitions

(A) Application—For purposes of this subsection, the term “application” means an application submitted under subsection (b)(2) or (j) of this section.

(B) Petition—For purposes of this subsection, other than paragraph (1)(A)(i), the term “petition” means a request described in paragraph (1)(A)(i).

(r) Postmarket drug safety information for patients and providers

(1) Establishment—Not later than 1 year after September 27, 2007, the Secretary shall improve the transparency of information about drugs and allow patients and health care providers better access to information about drugs by developing and maintaining an Internet Web site that—

(A) provides links to drug safety information listed in paragraph (2) for prescription drugs that are approved under this section or licensed under section 262 of Title 42; and

(B) improves communication of drug safety information to patients and providers.

(2) Internet Web site—The Secretary shall carry out paragraph (1) by—

(A) developing and maintaining an accessible, consolidated Internet Web site with easily searchable drug safety informa-

tion, including the information found on United States Government Internet Web sites, such as the United States National Library of Medicine's Daily Med and Medline Plus Web sites, in addition to other such Web sites maintained by the Secretary;

- (B) ensuring that the information provided on the Internet Web site is comprehensive and includes, when available and appropriate—
 - (i) patient labeling and patient packaging inserts;
 - (ii) a link to a list of each drug, whether approved under this section or licensed under such section 262, for which a Medication Guide, as provided for under part 208 of title 21, Code of Federal Regulations (or any successor regulations), is required;
 - (iii) a link to the registry and results data bank provided for under subsections (i) and (j) of section 282 of Title 42;
 - (iv) the most recent safety information and alerts issued by the Food and Drug Administration for drugs approved by the Secretary under this section, such as product recalls, warning letters, and import alerts;
 - (v) publicly available information about implemented RiskMAPs and risk evaluation and mitigation strategies under subsection (o) of this section;

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- (vi) guidance documents and regulations related to drug safety; and
 - (vii) other material determined appropriate by the Secretary;
- (C) providing access to summaries of the assessed and aggregated data collected from the active surveillance infrastructure under subsection (k)(3) of this section to provide information of known and serious side-effects for drugs approved under this section or licensed under such section 262 of Title 42;
- (D) preparing, by 18 months after approval of a drug or after use of the drug by 10,000 individuals, whichever is later, a summary analysis of the adverse drug reaction reports received for the drug, including identification of any new risks not previously identified, potential new risks, or known risks reported in unusual number;
- (E) enabling patients, providers, and drug sponsors to submit adverse event reports through the Internet Web site;
- (F) providing educational materials for patients and providers about the appropriate means of disposing of expired, damaged, or unusable medications; and
- (G) supporting initiatives that the Secretary determines to be useful to fulfill the purposes of the Internet Web site.
- (3) Posting of drug labeling—The Secretary shall post on the Internet Web site established un-

der paragraph (1) the approved professional labeling and any required patient labeling of a drug approved under this section or licensed under such section 262 of Title 42 not later than 21 days after the date the drug is approved or licensed, including in a supplemental application with respect to a labeling change.

- (4) Private sector resources—To ensure development of the Internet Web site by the date described in paragraph (1), the Secretary may, on a temporary or permanent basis, implement systems or products developed by private entities.
- (5) Authority for contracts—The Secretary may enter into contracts with public and private entities to fulfill the requirements of this subsection.
- (6) Review—The Advisory Committee on Risk Communication under section 360bbb-6 of this title shall, on a regular basis, perform a comprehensive review and evaluation of the types of risk communication information provided on the Internet Web site established under paragraph (1) and, through other means, shall identify, clarify, and define the purposes and types of information available to facilitate the efficient flow of information to patients and providers, and shall recommend ways for the Food and Drug Administration to work with outside entities to help facilitate the dispensing of risk communication information to patients and providers.

(s) Referral to advisory committee

Prior to the approval of a drug no active ingredient (including any ester or salt of the active ingredient) of which has been approved in any other application under this section or section 262 of Title 42, the Secretary shall—

- (1) refer such drug to a Food and Drug Administration advisory committee for review at a meeting of such advisory committee; or
- (2) if the Secretary does not refer such a drug to a Food and Drug Administration advisory committee prior to the approval of the drug, provide in the action letter on the application for the drug a summary of the reasons why the Secretary did not refer the drug to an advisory committee prior to approval.

(t) Database for authorized generic drugs

- (1) In general

(A) Publication—The Commissioner shall—

- (i) not later than 9 months after September 27, 2007, publish a complete list on the Internet Web site of the Food and Drug Administration of all authorized generic drugs (including drug trade name, brand company manufacturer, and the date the authorized generic drug entered the market); and
- (ii) update the list quarterly to include each authorized generic drug included in an annual report submitted to the Secretary by the sponsor of a

listed drug during the preceding 3-month period.

- (B) Notification—The Commissioner shall notify relevant Federal agencies, including the Centers for Medicare & Medicaid Services and the Federal Trade Commission, when the Commissioner first publishes the information described in subparagraph (A) that the information has been published and that the information will be updated quarterly.
- (2) Inclusion—The Commissioner shall include in the list described in paragraph (1) each authorized generic drug included in an annual report submitted to the Secretary by the sponsor of a listed drug after January 1, 1999.
- (3) Authorized generic drug—In this section, the term “authorized generic drug” means a listed drug (as that term is used in subsection (j) of this section) that--
 - (A) has been approved under subsection (c) of this section; and
 - (B) is marketed, sold, or distributed directly or indirectly to retail class of trade under a different labeling, packaging (other than repackaging as the listed drug in blister packs, unit doses, or similar packaging for use in institutions), product code, labeler code, trade name, or trade mark than the listed drug.

(u) Certain drugs containing single enantiomers

- (1) In general—For purposes of subsections (c)(3)(E)(ii) and (j)(5)(F)(ii) of this section, if an application is submitted under subsection (b) of this section for a non-racemic drug containing as an active ingredient (including any ester or salt of the active ingredient) a single enantiomer that is contained in a racemic drug approved in another application under subsection (b) of this section, the applicant may, in the application for such non-racemic drug, elect to have the single enantiomer not be considered the same active ingredient as that contained in the approved racemic drug, if—
- (A)(i) the single enantiomer has not been previously approved except in the approved racemic drug; and
 - (ii) the application submitted under subsection (b) of this section for such non-racemic drug—
 - (I) includes full reports of new clinical investigations (other than bioavailability studies)—
 - (aa) necessary for the approval of the application under subsections (c) and (d) of this section; and
 - (bb) conducted or sponsored by the applicant; and
 - (II) does not rely on any investigations that are part of an applica-

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tion submitted under subsection (b) of this section for approval of the approved racemic drug; and

- (B) the application submitted under subsection (b) of this section for such non-racemic drug is not submitted for approval of a condition of use—
 - (i) in a therapeutic category in which the approved racemic drug has been approved; or
 - (ii) for which any other enantiomer of the racemic drug has been approved.

(2) Limitation

- (A) No approval in certain therapeutic categories—Until the date that is 10 years after the date of approval of a non-racemic drug described in paragraph (1) and with respect to which the applicant has made the election provided for by such paragraph, the Secretary shall not approve such non-racemic drug for any condition of use in the therapeutic category in which the racemic drug has been approved.
- (B) Labeling—If applicable, the labeling of a non-racemic drug described in paragraph (1) and with respect to which the applicant has made the election provided for by such paragraph shall include a statement that the non-racemic drug is not approved, and has not been shown to be safe and effective, for any condition of use of the racemic drug.

(3) Definition

(A) In general—For purposes of this subsection, the term “therapeutic category” means a therapeutic category identified in the list developed by the United States Pharmacopeia pursuant to section 1395w-104(b)(3)(C)(ii) of Title 42 and as in effect on September 27, 2007.

(B) Publication by Secretary—The Secretary shall publish the list described in subparagraph (A) and may amend such list by regulation.

(4) Availability—The election referred to in paragraph (1) may be made only in an application that is submitted to the Secretary after September 27, 2007, and before October 1, 2012.

(v) Antibiotic drugs submitted before November 21, 1997

(1) Antibiotic drugs approved before November 21, 1997

(A) In general—Notwithstanding any provision of the Food and Drug Administration Modernization Act of 1997 or any other provision of law, a sponsor of a drug that is the subject of an application described in subparagraph (B)(i) shall be eligible for, with respect to the drug, the 3-year exclusivity period referred to under clauses (iii) and (iv) of subsection (c)(3)(E) and under clauses (iii) and (iv) of subsection (j)(5)(F), subject to the requirements of such clauses, as applicable.

- (B) Application; antibiotic drug described
 - (i) Application—An application described in this clause is an application for marketing submitted under this section after October 8, 2008 in which the drug that is the subject of the application contains an antibiotic drug described in clause (ii).
 - (ii) Antibiotic drug—An antibiotic drug described in this clause is an antibiotic drug that was the subject of an application approved by the Secretary under section 357 of this title (as in effect before November 21, 1997).
- (2) Antibiotic drugs submitted before November 21, 1997, but not approved
 - (A) In general—Notwithstanding any provision of the Food and Drug Administration Modernization Act of 1997 or any other provision of law, a sponsor of a drug that is the subject of an application described in subparagraph (B)(i) may elect to be eligible for, with respect to the drug—
 - (i)(I) the 3-year exclusivity period referred to under clauses (iii) and (iv) of subsection (c)(3)(E) and under clauses (iii) and (iv) of subsection (j)(5)(F), subject to the requirements of such clauses, as applicable; and
 - (II) the 5-year exclusivity period referred to under clause (ii) of subsection (c)(3)(E) and under clause

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- (ii) of subsection (j)(5)(F), subject to the requirements of such clauses, as applicable; or
 - (ii) a patent term extension under section 156 of Title 35 subject to the requirements of such section.
 - (B) Application; antibiotic drug described
 - (i) Application—An application described in this clause is an application for marketing submitted under this section after October 8, 2008 in which the drug that is the subject of the application contains an antibiotic drug described in clause (ii).
 - (ii) Antibiotic drug—An antibiotic drug described in this clause is an antibiotic drug that was the subject of 1 or more applications received by the Secretary under section 357 of this title (as in effect before November 21, 1997), none of which was approved by the Secretary under such section.
- (3) Limitations
 - (A) Exclusivities and extensions—Paragraphs (1)(A) and (2)(A) shall not be construed to entitle a drug that is the subject of an approved application described in subparagraphs (1)(B)(i) or (2)(B)(i), as applicable, to any market exclusivities or patent extensions other than those exclusivities or extensions described in paragraph (1)(A) or (2)(A).

- (B) Conditions of use—Paragraphs (1)(A) and (2)(A)(i) shall not apply to any condition of use for which the drug referred to in subparagraph (1)(B)(i) or (2)(B)(i), as applicable, was approved before October 8, 2008.
- (4) Application of certain provisions—Notwithstanding section 125, or any other provision, of the Food and Drug Administration Modernization Act of 1997, or any other provision of law, and subject to the limitations in paragraphs (1), (2), and (3), the provisions of the Drug Price Competition and Patent Term Restoration Act of 1984 shall apply to any drug subject to paragraph (1) or any drug with respect to which an election is made under paragraph (2)(A).

CODE OF FEDERAL REGULATIONS

TITLE 21—FOOD AND DRUGS

CHAPTER I. FOOD AND DRUG ADMINISTRATION,
DEPARTMENT OF HEALTH AND
HUMAN SERVICES

Part 314. Applications for FDA Approval to Market
a New Drug—
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Subpart B. Applications

Sec. 314.53 Submission of patent information.

(a) Who must submit patent information. This section applies to any applicant who submits to FDA a new drug application or an amendment to it under section 505(b) of the act and § 314.50 or a supplement to an approved application under § 314.70, except as provided in paragraph (d)(2) of this section.

(b) Patents for which information must be submitted and patents for which information must not be submitted—

(1) General requirements. An applicant described in paragraph (a) of this section shall submit the required information on the declaration form set forth in paragraph (c) of this section for each patent that claims the drug or a method of using the drug that is the subject of the new drug application or amendment or supplement to it and with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner of the patent engaged in the manufacture, use, or sale of the drug product. For purposes of this part, such patents consist of drug substance (active ingredient) patents, drug prod-

uct (formulation and composition) patents, and method-of-use patents. For patents that claim the drug substance, the applicant shall submit information only on those patents that claim the drug substance that is the subject of the pending or approved application or that claim a drug substance that is the same as the active ingredient that is the subject of the approved or pending application. For patents that claim a polymorph that is the same as the active ingredient described in the approved or pending application, the applicant shall certify in the declaration forms that the applicant has test data, as set forth in paragraph (b)(2) of this section, demonstrating that a drug product containing the polymorph will perform the same as the drug product described in the new drug application. For patents that claim a drug product, the applicant shall submit information only on those patents that claim a drug product, as is defined in § 314.3, that is described in the pending or approved application. For patents that claim a method of use, the applicant shall submit information only on those patents that claim indications or other conditions of use that are described in the pending or approved application. The applicant shall separately identify each pending or approved method of use and related patent claim. For approved applications, the applicant submitting the method-of-use patent shall identify with specificity the section of the approved labeling that corresponds to the method of use claimed by the patent submitted. Process patents, patents claiming packaging, patents claiming metabolites, and patents claiming intermediates are not covered by this section, and information on these patents must not be submitted to FDA.

(2) Test Data for Submission of Patent Information for Patents That Claim a Polymorph. The test data, referenced in paragraph (b)(1) of this section, must include the following:

(i) A full description of the polymorphic form of the drug substance, including its physical and chemical characteristics and stability; the method of synthesis (or isolation) and purification of the drug substance; the process controls used during manufacture and packaging; and such specifications and analytical methods as are necessary to assure the identity, strength, quality, and purity of the polymorphic form of the drug substance;

(ii) The executed batch record for a drug product containing the polymorphic form of the drug substance and documentation that the batch was manufactured under current good manufacturing practice requirements;

(iii) Demonstration of bioequivalence between the executed batch of the drug product that contains the polymorphic form of the drug substance and the drug product as described in the NDA;

(iv) A list of all components used in the manufacture of the drug product containing the polymorphic form and a statement of the composition of the drug product; a statement of the specifications and analytical methods for each component; a description of the manufacturing and packaging procedures and in-process controls for the drug product; such specifications and analytical methods as are necessary to assure the identity, strength, quality, purity, and

bioavailability of the drug product, including release and stability data complying with the approved product specifications to demonstrate pharmaceutical equivalence and comparable product stability; and

(v) Comparative in vitro dissolution testing on 12 dosage units each of the executed test batch and the new drug application product.

(c) Reporting requirements—

(1) General requirements. An applicant described in paragraph (a) of this section shall submit the required patent information described in paragraph (c)(2) of this section for each patent that meets the requirements described in paragraph (b) of this section. We will not accept the patent information unless it is complete and submitted on the appropriate forms, FDA Forms 3542 or 3542a. These forms may be obtained on the Internet at <http://www.fda.gov> by searching for “forms”.

(2) Drug substance (active ingredient), drug product (formulation or composition), and method-of-use patents—

(i) Original Declaration. For each patent that claims a drug substance (active ingredient), drug product (formulation and composition), or method of use, the applicant shall submit FDA Form 3542a. The following information and verification is required:

(A) New drug application number;

(B) Name of new drug application sponsor;

(C) Trade name (or proposed trade name) of new drug;

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- (D) Active ingredient(s) of new drug;
- (E) Strength(s) of new drug;
- (F) Dosage form of new drug;
- (G) United States patent number, issue date, and expiration date of patent submitted;
- (H) The patent owner's name, full address, phone number and, if available, fax number and e-mail address;
- (I) The name, full address, phone number and, if available, fax number and e-mail address of an agent or representative who resides or maintains a place of business within the United States authorized to receive notice of patent certification under sections 505(b)(3) and 505(j)(2)(B) of the act and §§ 314.52 and 314.95 (if patent owner or new drug application applicant or holder does not reside or have a place of business within the United States);
- (J) Information on whether the patent has been submitted previously for the new drug application;
- (K) Information on whether the expiration date is a new expiration date if the patent had been submitted previously for listing;
- (L) Information on whether the patent is a product-by-process patent in which the product claimed is novel;
- (M) Information on the drug substance (active ingredient) patent including the following:

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(1) Whether the patent claims the drug substance that is the active ingredient in the drug product described in the new drug application or supplement;

(2) Whether the patent claims a polymorph that is the same active ingredient that is described in the pending application or supplement;

(3) Whether the applicant has test data, described in paragraph (b)(2) of this section, demonstrating that a drug product containing the polymorph will perform the same as the drug product described in the new drug application or supplement, and a description of the polymorphic form(s) claimed by the patent for which such test data exist;

(4) Whether the patent claims only a metabolite of the active ingredient; and

(5) Whether the patent claims only an intermediate;

(N) Information on the drug product (composition/formulation) patent including the following:

(1) Whether the patent claims the drug product for which approval is being sought, as defined in § 314.3; and

(2) Whether the patent claims only an intermediate;

(O) Information on each method-of-use patent including the following:

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(1) Whether the patent claims one or more methods of using the drug product for which use approval is being sought and a description of each pending method of use or related indication and related patent claim of the patent being submitted; and

(2) Identification of the specific section of the proposed labeling for the drug product that corresponds to the method of use claimed by the patent submitted;

(P) Whether there are no relevant patents that claim the drug substance (active ingredient), drug product (formulation or composition) or method(s) of use, for which the applicant is seeking approval and with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner of the patent engaged in the manufacture, use, or sale of the drug product;

(Q) A signed verification which states: "The undersigned declares that this is an accurate and complete submission of patent information for the NDA, amendment or supplement pending under section 505 of the Federal Food, Drug, and Cosmetic Act. This time-sensitive patent information is submitted pursuant to 21 CFR 314.53. I attest that I am familiar with 21 CFR 314.53 and this submission complies with the requirements of the regulation. I verify under penalty of perjury that the foregoing is true and correct."; and

(R) Information on whether the applicant, patent owner or attorney, agent, representative or other authorized official signed the form; the name of the person; and the full address, phone number and, if available, the fax number and e-mail address.

(ii) Submission of patent information upon and after approval. Within 30 days after the date of approval of its application or supplement, the applicant shall submit FDA Form 3542 for each patent that claims the drug substance (active ingredient), drug product (formulation and composition), or approved method of use. FDA will rely only on the information submitted on this form and will not list or publish patent information if the patent declaration is incomplete or indicates the patent is not eligible for listing. Patent information must also be submitted for patents issued after the date of approval of the new drug application as required in paragraph (c)(2)(ii) of this section. As described in paragraph (d)(4) of this section, patent information must be submitted to FDA within 30 days of the date of issuance of the patent. If the applicant submits the required patent information within the 30 days, but we notify an applicant that a declaration form is incomplete or shows that the patent is not eligible for listing, the applicant must submit an acceptable declaration form within 15 days of FDA notification to be considered timely filed. The following information and verification statement is required:

(A) New drug application number;

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- (B) Name of new drug application sponsor;
- (C) Trade name of new drug;
- (D) Active ingredient(s) of new drug;
- (E) Strength(s) of new drug;
- (F) Dosage form of new drug;
- (G) Approval date of new drug application or supplement;
- (H) United States patent number, issue date, and expiration date of patent submitted;
- (I) The patent owner's name, full address, phone number and, if available, fax number and e-mail address;
- (J) The name, full address, phone number and, if available, fax number and e-mail address of an agent or representative who resides or maintains a place of business within the United States authorized to receive notice of patent certification under sections 505(b)(3) and 505(j)(2)(B) of the act and §§ 314.52 and 314.95 (if patent owner or new drug application applicant or holder does not reside or have a place of business within the United States);
- (K) Information on whether the patent has been submitted previously for the new drug application;
- (L) Information on whether the expiration date is a new expiration date if the patent had been submitted previously for listing;

(M) Information on whether the patent is a product-by-process patent in which the product claimed is novel;

(N) Information on the drug substance (active ingredient) patent including the following:

(1) Whether the patent claims the drug substance that is the active ingredient in the drug product described in the approved application;

(2) Whether the patent claims a polymorph that is the same as the active ingredient that is described in the approved application;

(3) Whether the applicant has test data, described at paragraph (b)(2) of this section, demonstrating that a drug product containing the polymorph will perform the same as the drug product described in the approved application and a description of the polymorphic form(s) claimed by the patent for which such test data exist;

(4) Whether the patent claims only a metabolite of the active ingredient; and

(5) Whether the patent claims only an intermediate;

(O) Information on the drug product (composition/formulation) patent including the following:

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(1) Whether the patent claims the approved drug product as defined in § 314.3; and

(2) Whether the patent claims only an intermediate;

(P) Information on each method-of-use patent including the following:

(1) Whether the patent claims one or more approved methods of using the approved drug product and a description of each approved method of use or indication and related patent claim of the patent being submitted;

(2) Identification of the specific section of the approved labeling for the drug product that corresponds to the method of use claimed by the patent submitted; and

(3) The description of the patented method of use as required for publication;

(Q) Whether there are no relevant patents that claim the approved drug substance (active ingredient), the approved drug product (formulation or composition) or approved method(s) of use and with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner of the patent engaged in the manufacture, use, or sale of the drug product;

(R) A signed verification which states: "The undersigned declares that this is an accurate and complete submission of patent in-

formation for the NDA, amendment or supplement approved under section 505 of the Federal Food, Drug, and Cosmetic Act. This time-sensitive patent information is submitted pursuant to 21 CFR 314.53. I attest that I am familiar with 21 CFR 314.53 and this submission complies with the requirements of the regulation. I verify under penalty of perjury that the foregoing is true and correct.”; and

(S) Information on whether the applicant, patent owner or attorney, agent, representative or other authorized official signed the form; the name of the person; and the full address, phone number and, if available, the fax number and e-mail address.

(3) No relevant patents. If the applicant believes that there are no relevant patents that claim the drug substance (active ingredient), drug product (formulation or composition), or the method(s) of use for which the applicant has received approval, and with respect to which a claim of patent infringement could reasonably be asserted if a person not licensed by the owner of the patent engaged in the manufacture, use, or sale of the drug product, the applicant will verify this information in the appropriate forms, FDA Forms 3542 or 3542a.

(4) Authorized signature. The declarations required by this section shall be signed by the applicant or patent owner, or the applicant's or patent owner's attorney, agent (representative), or other authorized official.

(d) When and where to submit patent information--

(1) Original application. An applicant shall submit with its original application submitted under this part, including an application described in section 505(b)(2) of the act, the information described in paragraph (c) of this section on each drug (ingredient), drug product (formulation and composition), and method of use patent issued before the application is filed with FDA and for which patent information is required to be submitted under this section. If a patent is issued after the application is filed with FDA but before the application is approved, the applicant shall, within 30 days of the date of issuance of the patent, submit the required patent information in an amendment to the application under § 314.60.

(2) Supplements.

(i) An applicant shall submit patent information required under paragraph (c) of this section for a patent that claims the drug, drug product, or method of use for which approval is sought in any of the following supplements:

(A) To change the formulation;

(B) To add a new indication or other condition of use, including a change in route of administration;

(C) To change the strength;

(D) To make any other patented change regarding the drug, drug product, or any method of use.

(ii) If the applicant submits a supplement for one of the changes listed under paragraph (d)(2)(i) of this section and existing patents for which information has already been submitted

to FDA claim the changed product, the applicant shall submit a certification with the supplement identifying the patents that claim the changed product.

(iii) If the applicant submits a supplement for one of the changes listed under paragraph (d)(2)(i) of this section and no patents, including previously submitted patents, claim the changed product, it shall so certify.

(iv) The applicant shall comply with the requirements for amendment of formulation or composition and method of use patent information under paragraphs (c)(2)(ii) and (d)(3) of this section.

(3) Patent information deadline. If a patent is issued for a drug, drug product, or method of use after an application is approved, the applicant shall submit to FDA the required patent information within 30 days of the date of issuance of the patent.

(4) Copies. The applicant shall submit two copies of each submission of patent information, an archival copy and a copy for the chemistry, manufacturing, and controls section of the review copy, to the Central Document Room, Center for Drug Evaluation and Research, Food and Drug Administration, 5901-B Ammendale Rd., Beltsville, MD 20705-1266. The applicant shall submit the patent information by letter separate from, but at the same time as, submission of the supplement.

(5) Submission date. Patent information shall be considered to be submitted to FDA as of the date the information is received by the Central Document Room.

(6) Identification. Each submission of patent information, except information submitted with an original application, and its mailing cover shall bear prominent identification as to its contents, i.e., "Patent Information," or, if submitted after approval of an application, "Time Sensitive Patent Information."

(e) Public disclosure of patent information. FDA will publish in the list the patent number and expiration date of each patent that is required to be, and is, submitted to FDA by an applicant, and for each use patent, the approved indications or other conditions of use covered by a patent. FDA will publish such patent information upon approval of the application, or, if the patent information is submitted by the applicant after approval of an application as provided under paragraph (d)(2) of this section, as soon as possible after the submission to the agency of the patent information. Patent information submitted by the last working day of a month will be published in that month's supplement to the list. Patent information received by the Agency between monthly publication of supplements to the list will be placed on public display in FDA's Division of Freedom of Information. A request for copies of the file shall be sent in writing to the Division of Freedom of Information (ELEM-1029), Food and Drug Administration, 12420 Parklawn Dr., Element Bldg., Rockville, MD 20857.

(f) Correction of patent information errors. If any person disputes the accuracy or relevance of patent information submitted to the agency under this section and published by FDA in the list, or believes that an applicant has failed to submit required patent information, that person must first notify the agency in writing stating the grounds for disagreement. Such

notification should be directed to the Office of Generic Drugs, OGD Document Room, Attention: Orange Book Staff, at the address identified on FDA's Web site 7500 Standish Pl., Rockville, MD 20855. The agency will then request of the applicable new drug application holder that the correctness of the patent information or omission of patent information be confirmed. Unless the application holder withdraws or amends its patent information in response to FDA's request, the agency will not change the patent information in the list. If the new drug application holder does not change the patent information submitted to FDA, a 505(b)(2) application or an abbreviated new drug application under section 505(j) of the act submitted for a drug that is claimed by a patent for which information has been submitted must, despite any disagreement as to the correctness of the patent information, contain an appropriate certification for each listed patent.

[59 FR 50363, Oct. 3, 1994; 68 FR 36703, June 18, 2003; 69 FR 13473, March 23, 2004; 74 FR 9766, March 6, 2009; 74 FR 36605, July 24, 2009; 76 FR31470, June 1, 2011]