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

	X
AMERICAN REGENT, INC.,	: Honorable Brian R, Martinotti, USDJ
	:
	:
Plaintiff,	: Civil Action No. 25 CV 2224 (BRM)(CLW)
v.	:
	:
	:
HIKMA PHARMACEUTICALS USA INC.,	: <b>DEFENDANT HIKMA</b>
	: <b>PHARMACEUTICALS USA INC.’S</b>
Defendant.	: <b>ANSWER, SEPARATE DEFENSES, AND</b>
	: <b>COUNTERCLAIMS</b>
	:
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Defendant Hikma Pharmaceuticals USA Inc. (“Hikma”), by and through its undersigned counsel, provide the following answers, separate defenses and counterclaims to the Complaint of patent infringement (“Complaint”) (Civ. No. 25-cv-2224, D.I. 1) of Plaintiff American Regent, Inc., (“ARI” or “Plaintiff”). This pleading is based upon Hikma’s knowledge as to its own

activities, and upon information and belief as to other matters. Pursuant to Fed. R. Civ. P. 8(b)(3), Hikma denies all allegations in Plaintiff's Complaint except those admitted specifically below.

### **NATURE OF THIS ACTION**

1. This is an action for patent infringement under the patent laws of the United States, 35 U.S.C. § 100 *et. seq.*, arising from Hikma's submission to the United States Food and Drug Administration ("FDA") of Abbreviated New Drug Application No. 219369 ("the ANDA") which contained a certification of the type described in Section 505(j)(2)(A)(vii)(IV) of the Federal Food, Drug, and Cosmetic Act ("Paragraph IV Certification") seeking approval to engage in the commercial manufacture, use, sale, and/or importation of generic versions of ARI's Tralement® (trace elements injection 4\*, USP) drug product in 1 mL single-dose and 5 mL vials ("the ANDA Products") prior to the expiration of United States Patent Nos. 11,786,548 (the "'548 patent"), 11,975,022 (the "'022 patent"), 11,998,565 (the "'565 patent"), 12,150,956 (the "'956 patent"), and 12,150,957 (the "'957 patent") (collectively, the "Patents-in-Suit").

**ANSWER:** Hikma admits that it submitted ANDA No. 219369 ("the ANDA") to the FDA seeking approval to commercially market a generic version of Tralement® (trace elements injection 4\*, USP) drug product in 1 mL single-dose and 5 mL vials ("the ANDA Products") prior to the expiration of the '548 patent, the '022 patent, the '565 patent, the '956 patent, and the '957 patent. Hikma further admits that Plaintiff's Complaint purports to bring an action for patent infringement under the patent laws of the United States, 35 U.S.C. § 100 *et. seq.*, but denies that Plaintiff is entitled to any relief. Hikma otherwise denies any remaining allegations of this paragraph.

### **THE PARTIES**

2. ARI is a corporation organized and existing under the laws of the State of New York, with a principal place of business at 5 Ramsey Road, Shirley, New York 11967.

**ANSWER:** Upon information and belief, admitted.

3. On information and belief, Hikma is an American corporation organized and existing under the laws of the State of Delaware with its principal place of business at 200 Connell Drive, 4th Floor, Berkeley Heights, New Jersey 07922.

**ANSWER:** Hikma admits it is an American corporation organized and existing under the

laws of the State of Delaware with its principal place of business at 200 Connell Drive, 4<sup>th</sup> Floor, Berkeley Heights, New Jersey 07922.

### **JURISDICTION AND VENUE**

4. This is a civil action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 100 *et. seq.*, and jurisdiction is proper under 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that Plaintiff's Complaint purports to bring an action for patent infringement under the patent laws of the United States, 35 U.S.C. § 100 *et. seq.* Hikma does not contest subject matter jurisdiction for the purposes of this action only, and expressly reserves the right to contest subject matter jurisdiction in any other case as to any party. Hikma otherwise denies any remaining allegations of this paragraph.

5. On information and belief, this Court has personal jurisdiction over Hikma under the New Jersey state long arm statute and consistent with due process of law because Hikma has extensive contacts with the State of New Jersey, has its principal place of business in New Jersey, and regularly does business in this judicial district. Further, Hikma plans to sell the ANDA Products in the State of New Jersey, which provides an independent basis for personal jurisdiction here.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest personal jurisdiction for the purposes of this action only, and expressly reserves the right to contest personal jurisdiction in any other case as to any party. Hikma otherwise denies any remaining allegations of this paragraph.

6. This Court further has personal jurisdiction over Hikma because Hikma has purposefully availed itself of the rights and benefits of New Jersey law by engaging in systematic and continuous contact with the State of New Jersey. On information and belief, Hikma is registered to do business in New Jersey under Entity Identification No. 0100487525. On information and belief, Hikma regularly and continuously transacts business within New Jersey, including by making pharmaceutical products for sale in New Jersey and selling pharmaceutical products in New Jersey. On information and belief, Hikma derives substantial revenue from the

sale of those products in New Jersey and has availed itself of the privilege of conducting business within New Jersey.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest personal jurisdiction for the purposes of this action only, and expressly reserves the right to contest personal jurisdiction in any other case as to any party.

7. This Court has personal jurisdiction over Hikma because, on information and belief, Hikma derives substantial revenue from directly or indirectly selling generic pharmaceutical products and/or pharmaceutical ingredient(s) used in generic pharmaceutical products sold throughout the United States, including in this judicial district.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest personal jurisdiction for the purposes of this action only, and expressly reserves the right to contest personal jurisdiction in any other case as to any party.

8. On information and belief, Hikma is in the business of, among other things, manufacturing, marketing, importing, offering for sale, and selling pharmaceutical products, including generic drug products, throughout the United States, including in this judicial district. .

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest personal jurisdiction for the purposes of this action only, and expressly reserves the right to contest personal jurisdiction in any other case as to any party.

9. This Court has personal jurisdiction over Hikma because, *inter alia*, Hikma has committed an act of patent infringement under 35 U.S.C. § 271(e)(2) and intends a future course of conduct that includes acts of patent infringement in New Jersey. These acts have led and will lead to foreseeable harm and injury to ARI in New Jersey. Further, on information and belief, following approval of the ANDA, Hikma will make, use, import, sell, and/or offer for sale the ANDA Products in the United States, including in New Jersey, prior to the expiration of the Asserted Patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

10. This Court also has personal jurisdiction over Hikma because it has previously availed itself of the legal protections of the State of New Jersey by, among other things, not contesting jurisdiction in this judicial district, and pursuing counterclaims in this judicial district, including in at least *Celgene Corporation v. Hikma Pharmaceuticals USA Inc.*, No. 2:21-cv-10398 (D.N.J.); and *Axsome Malta Ltd. et al v. Alkem Laboratories Ltd., et al.*, No. 2:23-cv-20354 (D.N.J.).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest personal jurisdiction for the purposes of this action only, and expressly reserves the right to contest personal jurisdiction in any other case as to any party.

11. Venue is further proper in this Court under 28 U.S.C. §§ 1391 and/or 1400(b).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest venue for the purposes of this action only, and expressly reserves the right to contest venue in any other case as to any party. Hikma otherwise denies any remaining allegations of this paragraph.

12. On information and belief, venue is proper in this judicial district under 28 U.S.C. §§ 1391 and 1400(b) at least because, on information and belief, Hikma submitted the ANDA with a Paragraph IV Certification from its Berkeley Heights, New Jersey place of business and therefore Hikma has committed acts of infringement and has a regular and established place of business in New Jersey for the purposes of venue.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma does not contest venue for the purposes of this action only, and expressly reserves the right to contest venue in any other case as to any party.

13. On information and belief, Hikma has taken steps in New Jersey, including preparing the ANDA, submitting the ANDA to the FDA, and communicating with the FDA

regarding the ANDA, that indicate its intent to market the ANDA Products. As set forth above, on information and belief, if the ANDA is approved, Hikma intends to commit acts of patent infringement in New Jersey, including marketing, distributing, offering for sale, and/or selling the ANDA Products.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations of this paragraph.

### **BACKGROUND**

14. ARI holds New Drug Application (“NDA”) No. 209376 for Tralement<sup>®</sup> (trace elements injection 4\*, USP), which was approved by the FDA on July 2, 2020 and which ARI manufactures and sells in this judicial district and throughout the United States.

**ANSWER:** Hikma admits that the FDA’s website indicates that ARI is the holder of New Drug Application (“NDA”) No. 209376 for Tralement<sup>®</sup> (trace elements injection 4\*, USP). Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph and therefore denies the same.

15. Tralement<sup>®</sup> is the first and only FDA-approved multi-trace element injection for patients weighing at least 10 kg. The FDA has approved both the 1 mL and 5 mL forms of Tralement<sup>®</sup>; ARI markets a 1 mL Tralement<sup>®</sup> product.

**ANSWER:** Hikma admits that the FDA’s website indicates that Tralement<sup>®</sup> was approved for both the 1mL and the 5mL forms of Tralement<sup>®</sup>. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph and therefore denies the same.

16. Tralement<sup>®</sup> is a combination of trace elements (zinc sulfate, cupric sulfate, manganese sulfate, and selenious acid) indicated in adult and pediatric patients weighing at least 10 kg as a source of zinc, copper, manganese, and selenium for parenteral nutrition when oral or enteral nutrition is not possible, insufficient, or contraindicated.

**ANSWER:** Hikma admits that the FDA’s website indicates that Tralement<sup>®</sup> is a combination of trace elements (zinc sulfate, cupric sulfate, manganese sulfate, and selenious acid)

and that its prescribing information states that Tralement<sup>®</sup> is indicated in adult and pediatric patients weighing at least 10 kg as a source of zinc, copper, manganese, and selenium for parenteral nutrition when oral or enteral nutrition is not possible, insufficient, or contraindicated. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph and therefore denies the same.

17. Tralement<sup>®</sup>, as well as the use of Tralement<sup>®</sup> in accordance with its label, is covered by one or more claims of Patents-in-Suit.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of the remaining allegations of this paragraph and therefore denies the same.

18. ARI is the owner of the '548 patent, which is entitled "Trace element compositions, methods of making and use" and was duly and legally issued on October 17, 2023. A copy of the '548 patent is attached as Exhibit 1.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that on its face, the '548 patent indicates it was issued on October 17, 2023, and is entitled "Trace element compositions, methods of making and use." Hikma admits that a purported copy of the '548 patent is attached to the complaint as Exhibit 1. Hikma also admits that the patent assignment database indicates that the '548 patent is assigned to ARI. Hikma denies that the '548 patent was duly and legally issued. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

19. The '548 patent has been listed in connection with Tralement<sup>®</sup> in the FDA's publication Approved Drug Products with Therapeutic Equivalence Evaluations (the "Orange Book").

**ANSWER:** Hikma admits that the '548 patent is listed in the FDA's Orange Book in connection with Tralement®.

20. As indicated in the Orange Book, the patent expiration date for the '548 patent is July 1, 2041.

**ANSWER:** Hikma admits that the '548 patent is presently listed in the FDA's Orange Book with an expiration date of July 1, 2041. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

21. ARI is the owner of the '022 patent, which is entitled "Trace element compositions, methods of making and use" and was duly and legally issued on May 7, 2024. A copy of the '022 patent is attached as Exhibit 2.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that on its face, the '022 patent indicates it was issued on May 7, 2024, and is entitled "Trace element compositions, methods of making and use." Hikma admits that a purported copy of the '022 patent is attached to the complaint as Exhibit 2. Hikma also admits that the patent assignment database indicates that the '022 patent is assigned to ARI. Hikma denies that the '022 patent was duly and legally issued. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

22. The '022 patent has been listed in connection with Tralement® in the Orange Book.

**ANSWER: :** Hikma admits that the '022 patent is listed in the FDA's Orange Book in connection with Tralement®.

23. As indicated in the Orange Book, the patent expiration date for the '022 patent is



July 1, 2041.

**ANSWER:** Hikma admits that the '022 patent is presently listed in the FDA's Orange Book with an expiration date of July 1, 2041. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

24. ARI is the owner of the '565 patent, which is entitled "Trace element compositions, methods of making and use" and was duly and legally issued on June 4, 2024. A copy of the '565 patent is attached as Exhibit 3.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that on its face, the '565 patent indicates it was issued on June 4, 2024, and is entitled "Trace element compositions, methods of making and use." Hikma admits that a purported copy of the '565 patent is attached to the complaint as Exhibit 3. Hikma also admits that the patent assignment database indicates that the '565 patent is assigned to ARI. Hikma denies that the '565 patent was duly and legally issued. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

25. The '565 patent has been listed in connection with Tralement<sup>®</sup> in the Orange Book.

**ANSWER:** Hikma admits that the '565 patent is listed in the FDA's Orange Book in connection with Tralement<sup>®</sup>.

26. As indicated in the Orange Book, the patent expiration date for the '565 patent is July 1, 2041.

**ANSWER:** Hikma admits that the '565 patent is presently listed in the FDA's Orange Book with an expiration date of July 1, 2041. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and

therefore denies the same.

27. ARI is the owner of the '956 patent, which is entitled "Trace element compositions, methods of making and use" and was duly and legally issued on November 26, 2024. A copy of the '956 patent is attached as Exhibit 4.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that on its face, the '956 patent indicates it was issued on November 26, 2024, and is entitled "Trace element compositions, methods of making and use." Hikma admits that a purported copy of the '956 patent is attached to the complaint as Exhibit 4. Hikma also admits that the patent assignment database indicates that the '956 patent is assigned to ARI. Hikma denies that the '956 patent was duly and legally issued. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

28. The '956 patent has been listed in connection with Tralement<sup>®</sup> in the Orange Book.

**ANSWER:** Hikma admits that the '956 patent is listed in the FDA's Orange Book in connection with Tralement<sup>®</sup>.

29. As indicated in the Orange Book, the patent expiration date for the '956 patent is July 1, 2041.

**ANSWER:** Hikma admits that the '956 patent is presently listed in the FDA's Orange Book in connection with ARI's Tralement<sup>®</sup> drug product indicating an expiration date of July 1, 2041. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

30. ARI is the owner of the '957 patent, which is entitled "Trace element compositions, methods of making and use" and was duly and legally issued on November 26, 2024. A copy of the '957 patent is attached as Exhibit 5.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To

the extent a response is required, Hikma admits that on its face, the '957 patent indicates it was issued on November 26, 2024 and is entitled "Trace element compositions, methods of making and use." Hikma admits that a purported copy of the '957 patent is attached to the complaint as Exhibit 5. Hikma also admits that the patent assignment database indicates that the '957 patent is assigned to ARI. Hikma denies that the '957 patent was duly and legally issued. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

31. The '957 patent has been listed in connection with Tralement® in the Orange Book.

**ANSWER:** Hikma admits that the '957 patent is listed in the FDA's Orange Book in connection with Tralement®.

32. As indicated in the Orange Book, the patent expiration date for the '957 patent is July 1, 2041.

**ANSWER:** Hikma admits that the '957 patent is presently listed in the FDA's Orange Book with an expiration date of July 1, 2041. Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph, and therefore denies the same.

33. By letter dated February 14, 2025 ("the Notice Letter"), Hikma notified ARI that, pursuant to the Federal Food, Drug, and Cosmetic Act that Hikma had submitted to the FDA the ANDA with a Paragraph IV Certification to seek approval to engage in the commercial manufacture, use, offer for sale, sale, and/or importation of the ANDA Products prior to the expiration of the Patents-in-Suit.

**ANSWER:** Hikma admits that Hikma sent ARI a Notice Letter dated February 14, 2025 which notified ARI that Hikma filed ANDA No. 219369 seeking approval to engage in the commercial manufacture, use, offer for sale, sale, and/or importation of the ANDA Products prior

to the expiration of the Patents-in-Suit.

34. On information and belief, Hikma was responsible for preparing the ANDA which contained a Paragraph IV Certification.

**ANSWER:** Hikma admits that it submitted ANDA No. 219369 which contained a Paragraph IV certification. Hikma denies any remaining allegations of this paragraph.

35. On information and belief, Hikma submitted the ANDA to the FDA, which contained a Paragraph IV Certification asserting that the Patents-in-Suit will not be infringed by the manufacture, use, offer for sale, sale, or importation of the ANDA Products, or alternatively, that the Patents-in-Suit are invalid.

**ANSWER:** Hikma admits that it submitted ANDA No. 219369 which contained a Paragraph IV certification asserting that the Patents-in-Suit will not be infringed by the manufacture, use, offer for sale, sale, or importation of the ANDA Products, or alternatively, that the Patents-in-Suit are invalid.

36. On information and belief, the ANDA Products are generic versions of Tralement<sup>®</sup> (trace elements injection 4\*, USP), as it is the reference listed drug in the ANDA, containing the same or equivalent ingredients in the same or equivalent amounts.

**ANSWER:** Hikma admits that the Hikma ANDA Product is a generic version of ARI's Tralement<sup>®</sup> (trace elements injection 4\*, USP) product. Hikma otherwise denies any remaining allegations of this paragraph.

37. In the Notice Letter, Hikma disclosed that the ANDA Products are Trace Elements Injection 4\* USP, (3 mg Zn/mL, 0.3 mg Cu/mL, 55 mcg Mn/mL and 60 mcg Se/mL) single-dose vials; (3 mg Zn/mL, 0.3 mg Cu/mL, 55 mcg Mn/mL and 60 mcg Se/mL) 5 mL Pharmacy Bulk Package vials.

**ANSWER:** Hikma admits Hikma disclosed in its Notice Letter that the ANDA Products are Trace Elements Injection 4\* USP, (3 mg Zn/mL, 0.3 mg Cu/mL, 55 mcg Mn/mL and 60 mcg Se/mL) single-dose vials; (3 mg Zn/mL, 0.3 mg Cu/mL, 55 mcg Mn/mL and 60 mcg Se/mL) 5 mL Pharmacy Bulk Package vials.

38. On information and belief, the ANDA Products contains zinc, copper, manganese, and selenium in the same or equivalent amounts as Tralement<sup>®</sup>.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma admits that the Hikma ANDA Product is a generic version of ARI's Tralement<sup>®</sup> (trace elements injection 4\*, USP) product. Hikma otherwise denies any remaining allegations of this paragraph.

39. On information and belief, the ANDA will feature the same or equivalent chemical and therapeutic properties as Tralement<sup>®</sup>.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma lacks information or knowledge sufficient to form a belief as to the truth or falsity of any remaining allegations of this paragraph and therefore denies the same.

#### **COUNT I: INFRINGEMENT OF THE '548 PATENT**

40. ARI realleges paragraphs 1–39 as if fully set forth herein.

**ANSWER:** To the extent an answer to Paragraph 40 is required, Hikma incorporates by reference its answers to the foregoing paragraphs as if fully set forth herein.

41. Hikma's submission of the ANDA with a Paragraph IV Certification to obtain approval to engage in the commercial manufacture, use, offer for sale, sale and/or importation of the ANDA Product in or into the United States, prior to the expiration of the Patents-in-Suit, constitutes direct and indirect infringement of the '548 patent pursuant to 35 U.S.C. § 271(e)(2)(A), either literally or under the doctrine of equivalents.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

42. On information and belief, the ANDA Products, if approved by the FDA, will be manufactured, used, offered for sale, sold, and/or imported in or into the United States by Hikma or on its behalf, and will be administered by patients and/or medical practitioners in the United States according to the directions and instructions in the proposed package insert, which will constitute direct infringement by patients and/or medical practitioners of one or more claims of the '548 patent, under 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents. On

information and belief, the administration of the ANDA Products will occur with Hikma's specific intent and encouragement, and will be conduct that Hikma knows or should know will occur. On information and belief, Hikma will actively induce, encourage, aid, and abet that conduct by patients and/or medical practitioners, with knowledge and specific intent that the conduct will be in contravention of ARI's rights under the '548 patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

43. On information and belief, Hikma's manufacture, use, offer for sale, sale, and/or importation of the ANDA Products, once the ANDA with a Paragraph IV Certification is approved by the FDA, would constitute direct infringement under 35 U.S.C. § 271(a), induced infringement under 35 U.S.C. § 271(b), and/or contributory infringement under 35 U.S.C. § 271(c) of one or more claims of the '548 patent, either literally or under the doctrine of equivalents. On information and belief, Hikma intends that the ANDA Products be used by patients and medical professionals. Also, on information and belief, Hikma knows that the ANDA Products are especially made or adapted for use in infringing the '548 patent, and that the ANDA Products are not suitable for substantial non-infringing use.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

44. ARI will be irreparably harmed if Hikma is permitted to make, use, sell, offer to sell, and/or import the ANDA Products in or into the United States, and is not enjoined from doing so. ARI is entitled to relief provided by 35 U.S.C. §§ 271(e)(4) and/or 283, including an order of this Court that the effective date of approval of the ANDA be a date that is not earlier than the expiration date of the '548 patent, or any later expiration of exclusivity for the '548 patent to which ARI is or becomes entitled, and an injunction against such infringement. ARI does not have an adequate remedy at law.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

45. Hikma has had knowledge of the '548 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification and was aware that submission of the ANDA with a Paragraph IV Certification constituted an act of infringement under 35 U.S.C. § 271(e)(2).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma was aware of the '548 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification. Hikma otherwise denies the allegations

of this paragraph.

46. This case is “exceptional,” and ARI is entitled to an award of reasonable attorneys’ fees under 35 U.S.C. § 285.

**ANSWER:** Denied.

**COUNT II: INFRINGEMENT OF THE ’022 PATENT**

47. ARI realleges paragraphs 1–46 as if fully set forth herein.

**ANSWER:** To the extent an answer to Paragraph 47 is required, Hikma incorporates by reference its answers to the foregoing paragraphs as if fully set forth herein.

48. Hikma’s submission of the ANDA with a Paragraph IV Certification to obtain approval to engage in the commercial manufacture, use, offer for sale, sale and/or importation of the ANDA Products in or into the United States, prior to the expiration of the ’022 patent, constitutes infringement of the ’022 patent pursuant to 35 U.S.C. § 271(e)(2)(A), either literally or under the doctrine of equivalents.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

49. On information and belief, the ANDA Products, if approved by the FDA, will be manufactured, used, offered for sale, sold, and/or imported in or into the United States by Hikma or on its behalf, and will be administered by patients and/or medical practitioners in the United States according to the directions and instructions in the proposed package insert, which will constitute direct infringement by patients and/or medical practitioners of one or more claims of the ’022 patent, under 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents. On information and belief, the administration of the ANDA Products will occur with Hikma’s specific intent and encouragement, and will be conduct that Hikma knows or should know will occur. On information and belief, Hikma will actively induce, encourage, aid, and abet that conduct by patients and/or medical practitioners, with knowledge and specific intent that the conduct will be in contravention of ARI’s rights under the ’022 patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

50. On information and belief, Hikma’s manufacture, use, offer for sale, sale, and/or importation of the ANDA Products, once the ANDA with a Paragraph IV Certification is approved by the FDA, would constitute induced infringement under 35 U.S.C. § 271(b) and contributory infringement under 35 U.S.C. § 271(c) of one or more claims of the ’022 patent, either literally or under the doctrine of equivalents. On information and belief, Hikma intends that

the ANDA Products be used by patients and medical professionals. Also, on information and belief, Hikma knows that the ANDA Products are especially made or adapted for use in infringing the '022 patent, and that the ANDA Products are not suitable for substantial non-infringing use.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

51. ARI will be irreparably harmed if Hikma is permitted to make, use, sell, offer to sell, and/or import the ANDA Products in or into the United States, and is not enjoined from doing so. ARI is entitled to relief provided by 35 U.S.C. §§ 271(e)(4) and/or 283, including an order of this Court that the effective date of approval of the ANDA be a date that is not earlier than the expiration date of the '022 patent, or any later expiration of exclusivity for the '022 patent to which ARI is or becomes entitled, and an injunction against such infringement. ARI does not have an adequate remedy at law.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

52. Hikma has had knowledge of the '022 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification and was aware that submission of the ANDA with a Paragraph IV Certification constituted an act of infringement under 35 U.S.C. § 271(e)(2).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma was aware of the '022 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification. Hikma otherwise denies the allegations of this paragraph.

53. This case is “exceptional,” and ARI is entitled to an award of reasonable attorneys’ fees under 35 U.S.C. § 285.

**ANSWER:** Denied.

### **COUNT III: INFRINGEMENT OF THE '565 PATENT**

54. ARI realleges paragraphs 1–53 as if fully set forth herein.

**ANSWER:** To the extent an answer to Paragraph 54 is required, Hikma incorporates by reference its answers to the foregoing paragraphs as if fully set forth herein.



55. Hikma's submission of the ANDA with a Paragraph IV Certification to obtain approval to engage in the commercial manufacture, use, offer for sale, sale and/or importation of the ANDA Products in or into the United States, prior to the expiration of the '565 patent, constitutes infringement of the '565 patent pursuant to 35 U.S.C. § 271(e)(2)(A), either literally or under the doctrine of equivalents.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

56. On information and belief, the ANDA Products, if approved by the FDA, will be manufactured, used, offered for sale, sold, and/or imported in or into the United States by Hikma or on its behalf, and will be administered by patients and/or medical practitioners in the United States according to the directions and instructions in the proposed package insert, which will constitute direct infringement by patients and/or medical practitioners of one or more claims of the '565 patent, under 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents. On information and belief, the administration of the ANDA Products will occur with Hikma's specific intent and encouragement, and will be conduct that Hikma knows or should know will occur. On information and belief, Hikma will actively induce, encourage, aid, and abet that conduct by patients and/or medical practitioners, with knowledge and specific intent that the conduct will be in contravention of ARI's rights under the '565 patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

57. On information and belief, Hikma's manufacture, use, offer for sale, sale, and/or importation of the ANDA Products, once the ANDA with a Paragraph IV Certification is approved by the FDA, would constitute direct infringement under 35 U.S.C. § 271(a), induced infringement under 35 U.S.C. § 271(b), and contributory infringement under 35 U.S.C. § 271(c) of one or more claims of the '565 patent, either literally or under the doctrine of equivalents. On information and belief, Hikma intends that the ANDA Products be used by patients and medical professionals. Also, on information and belief, Hikma knows that the ANDA Products are especially made or adapted for use in infringing the '565 patent, and that the ANDA Products are not suitable for substantial non-infringing use.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

58. ARI will be irreparably harmed if Hikma is permitted to make, use, sell, offer to sell, and/or import the ANDA Products in or into the United States, and is not enjoined from doing so. ARI is entitled to relief provided by 35 U.S.C. §§ 271(e)(4) and/or 283, including an order of this Court that the effective date of approval of the ANDA be a date that is not earlier than the expiration date of the '565 patent, or any later expiration of exclusivity for the '565 patent to which ARI is or becomes entitled, and an injunction against such infringement. ARI does not have an adequate remedy at law.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

59. Hikma has had knowledge of the the '565 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification and was aware that submission of the ANDA with a Paragraph IV Certification constituted an act of infringement under 35 U.S.C. § 271(e)(2).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma was aware of the '565 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification. Hikma otherwise denies the allegations of this paragraph.

60. This case is “exceptional,” and ARI is entitled to an award of reasonable attorneys’ fees under 35 U.S.C. § 285.

**ANSWER:** Denied.

#### **COUNT IV: INFRINGEMENT OF THE '956 PATENT**

61. ARI realleges paragraphs 1–60 as if fully set forth herein.

**ANSWER:** To the extent an answer to Paragraph 60 is required, Hikma incorporates by reference its answers to the foregoing paragraphs as if fully set forth herein.

62. Hikma’s submission of the ANDA with a Paragraph IV Certification to obtain approval to engage in the commercial manufacture, use, offer for sale, sale and/or importation of the ANDA Products in or into the United States, prior to the expiration of the '956 patent, constitutes direct and indirect infringement of the '956 patent pursuant to 35 U.S.C. § 271(e)(2)(A), either literally or under the doctrine of equivalents.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

63. On information and belief, the ANDA Products, if the ANDA is approved by the FDA, will be manufactured, used, offered for sale, sold, and/or imported in or into the United States by Hikma or on its behalf, and will be administered by patients and/or medical practitioners in the United States according to the directions and instructions in the proposed package insert, which will constitute direct infringement by patients and/or medical practitioners of one or more claims of the '956 patent, under 35 U.S.C. § 271(a), either literally or under the doctrine of

equivalents. On information and belief, the administration of the ANDA Products will occur with Hikma's specific intent and encouragement, and will be conduct that Hikma knows or should know will occur. On information and belief, Hikma will actively induce, encourage, aid, and abet that conduct by patients and/or medical practitioners, with knowledge and specific intent that the conduct will be in contravention of ARI's rights under the '956 patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

64. On information and belief, Hikma's manufacture, use, offer for sale, sale, and/or importation of the ANDA Products, once the ANDA with a Paragraph IV Certification is approved by the FDA, would constitute direct infringement under 35 U.S.C. § 271(a), induced infringement under 35 U.S.C. § 271(b), and contributory infringement under 35 U.S.C. § 271(c) of one or more claims of the '956 patent, either literally or under the doctrine of equivalents. On information and belief, Hikma intends that the ANDA Products be used by patients and medical professionals. Also, on information and belief, Hikma knows that the ANDA Products are especially made or adapted for use in infringing the '956 patent, and that the ANDA Products are not suitable for substantial non-infringing use.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

65. ARI will be irreparably harmed if Hikma is permitted to make, use, sell, offer to sell, and/or import the ANDA Products in or into the United States, and is not enjoined from doing so. ARI is entitled to relief provided by 35 U.S.C. §§ 271(e)(4) and/or 283, including an order of this Court that the effective date of approval of the ANDA be a date that is not earlier than the expiration date of the '956 patent, or any later expiration of exclusivity for the '956 patent to which ARI is or becomes entitled, and an injunction against such infringement. ARI does not have an adequate remedy at law.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

66. Hikma has had knowledge of the '956 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification and was aware that submission of the ANDA with a Paragraph IV Certification constituted an act of infringement under 35 U.S.C. § 271(e)(2).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma was aware of the '956 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification. Hikma otherwise denies the allegations

of this paragraph.

67. This case is “exceptional,” and ARI is entitled to an award of reasonable attorneys’ fees under 35 U.S.C. § 285.

**ANSWER:** Denied.

**COUNT V: INFRINGEMENT OF THE ’957 PATENT**

68. ARI realleges paragraphs 1–67 as if fully set forth herein.

**ANSWER:** To the extent an answer to Paragraph 68 is required, Hikma incorporates by reference its answers to the foregoing paragraphs as if fully set forth herein.

69. Hikma’s submission of the ANDA with a Paragraph IV Certification to obtain approval to engage in the commercial manufacture, use, offer for sale, sale and/or importation of the ANDA Products in or into the United States, prior to the expiration of the ’957 patent, constitutes direct and indirect infringement of the ’957 patent pursuant to 35 U.S.C. § 271(e)(2)(A), either literally or under the doctrine of equivalents.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

70. On information and belief, the ANDA Products, if approved by the FDA, will be manufactured, used, offered for sale, sold, and/or imported in or into the United States by Hikma or on its behalf, and will be administered by patients and/or medical practitioners in the United States according to the directions and instructions in the proposed package insert, which will constitute direct infringement by patients and/or medical practitioners of one or more claims of the ’957 patent, under 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents. On information and belief, the administration of the ANDA Products will occur with Hikma’s specific intent and encouragement, and will be conduct that Hikma knows or should know will occur. On information and belief, Hikma will actively induce, encourage, aid, and abet that conduct by patients and/or medical practitioners, with knowledge and specific intent that the conduct will be in contravention of ARI’s rights under the ’957 patent.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

71. On information and belief, Hikma’s manufacture, use, offer for sale, sale, and/or importation of the ANDA Products, once the ANDA with a Paragraph IV Certification is approved by the FDA, would constitute direct infringement under 35 U.S.C. § 271(a), induced infringement under 35 U.S.C. § 271(b), and contributory infringement under 35 U.S.C. § 271(c) of one or more claims of the ’957 patent, either literally or under the doctrine of equivalents. On

information and belief, Hikma intends that the ANDA Products be used by patients and medical professionals. Also, on information and belief, Hikma knows that the ANDA Products are especially made or adapted for use in infringing the '957 patent, and that the ANDA Products are not suitable for substantial non-infringing use.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

72. ARI will be irreparably harmed if Hikma is permitted to make, use, sell, offer to sell, and/or import the ANDA Products in or into the United States, and is not enjoined from doing so. ARI is entitled to relief provided by 35 U.S.C. §§ 271(e)(4) and/or 283, including an order of this Court that the effective date of approval of the ANDA be a date that is not earlier than the expiration date of the '957 patent, or any later expiration of exclusivity for the '957 patent to which ARI is or becomes entitled, and an injunction against such infringement. ARI does not have an adequate remedy at law.

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma denies the allegations in this paragraph.

73. Hikma has had knowledge of the the '957 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification and was aware that submission of the ANDA with a Paragraph IV Certification constituted an act of infringement under 35 U.S.C. § 271(e)(2).

**ANSWER:** This paragraph contains legal conclusions to which no answer is required. To the extent a response is required, Hikma was aware of the '957 patent since at least the date Hikma submitted the ANDA with a Paragraph IV Certification. Hikma otherwise denies the allegations of this paragraph.

74. This case is “exceptional,” and ARI is entitled to an award of reasonable attorneys’ fees under 35 U.S.C. § 285.

**ANSWER:** Denied.

### **RESPONSE TO PRAYER FOR RELIEF**

The remainder of ARI’s Complaint recites a prayer for relief for which no response is required. To the extent a response is required, Hikma denies that ARI is entitled to any remedy or relief.

### **SEPARATE DEFENSES**

Hikma asserts the following defenses without prejudice to the denials in this Answer, and without admitting any allegations of the Complaint not otherwise admitted. Hikma does not assume the burden of proof on any such defenses, except as required by applicable law with respect to the particular defense asserted. Hikma reserves the right to assert other defenses and/or to otherwise supplement this Answer upon discovery of facts or evidence rendering such action appropriate.

#### **FIRST DEFENSE**

Each purported claim in the Complaint, in whole or in part, is barred for failure to state a claim upon which relief can be granted.

#### **SECOND DEFENSE**

The claims of the '548 patent are invalid for failure to comply with the statutory provisions of Title 35 of the United States Code, including without limitation sections 101, 102, 103, and/or 112, or other judicially created bases for invalidity.

#### **THIRD DEFENSE**

Hikma does not infringe, either literally or under the doctrine of equivalents, any valid and enforceable claim of the '548 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not infringe any valid and enforceable claim of the Patents-in-Suit.

#### **FOURTH DEFENSE**

Hikma has not, does not, and will not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the '548 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not induce the infringement of, or

contribute to the infringement of, any valid and enforceable claim of the Patents-in-Suit.

#### **FIFTH DEFENSE**

The claims of the '548 patent are barred in whole or in part by the doctrine of prosecution history estoppel, judicial estoppel, and/or other equitable doctrines.

#### **SIXTH DEFENSE**

The claims of the '022 patent are invalid for failure to comply with the statutory provisions of Title 35 of the United States Code, including without limitation sections 101, 102, 103, and/or 112, or other judicially created bases for invalidity.

#### **SEVENTH DEFENSE**

Hikma does not infringe, either literally or under the doctrine of equivalents, any valid and enforceable claim of the '022 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not infringe any valid and enforceable claim of the Patents-in-Suit.

#### **EIGHTH DEFENSE**

Hikma has not, does not, and will not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the '022 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the Patents-in-Suit.

#### **NINTH DEFENSE**

The claims of the '022 patent are barred in whole or in part by the doctrine of prosecution history estoppel, judicial estoppel, and/or other equitable doctrines.

**TENTH DEFENSE**

The claims of the '565 patent are invalid for failure to comply with the statutory provisions of Title 35 of the United States Code, including without limitation sections 101, 102, 103, and/or 112, or other judicially created bases for invalidity.

**ELEVENTH DEFENSE**

Hikma does not infringe, either literally or under the doctrine of equivalents, any valid and enforceable claim of the '565 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not infringe any valid and enforceable claim of the Patents-in-Suit.

**TWELTH DEFENSE**

Hikma has not, does not, and will not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the '565 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the Patents-in-Suit.

**THIRTEENTH DEFENSE**

The claims of the '565 patent are barred in whole or in part by the doctrine of prosecution history estoppel, judicial estoppel, and/or other equitable doctrines.

**FOURTEENTH DEFENSE**

The claims of the '956 patent are invalid for failure to comply with the statutory provisions of Title 35 of the United States Code, including without limitation sections 101, 102, 103, and/or 112, or other judicially created bases for invalidity.

**FIFTEENTH DEFENSE**

Hikma does not infringe, either literally or under the doctrine of equivalents, any valid and



enforceable claim of the '956 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not infringe any valid and enforceable claim of the Patents-in-Suit.

#### **SIXTEENTH DEFENSE**

Hikma has not, does not, and will not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the '956 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the Patents-in-Suit.

#### **SEVENTEENTH DEFENSE**

The claims of the '956 patent are barred in whole or in part by the doctrine of prosecution history estoppel, judicial estoppel, and/or other equitable doctrines.

#### **EIGHTEENTH DEFENSE**

The claims of the '957 patent are invalid for failure to comply with the statutory provisions of Title 35 of the United States Code, including without limitation sections 101, 102, 103, and/or 112, or other judicially created bases for invalidity.

#### **NINETEENTH DEFENSE**

Hikma does not infringe, either literally or under the doctrine of equivalents, any valid and enforceable claim of the '957 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not infringe any valid and enforceable claim of the Patents-in-Suit.

#### **TWENTIETH DEFENSE**

Hikma has not, does not, and will not induce the infringement of, or contribute to the infringement of, any valid and enforceable claim of the '957 patent. If the products that are the subject of ANDA No. 219369 were marketed, Hikma would not induce the infringement of, or

contribute to the infringement of, any valid and enforceable claim of the Patents-in-Suit.

#### **TWENTY-FIRST DEFENSE**

The claims of the '957 patent are barred in whole or in part by the doctrine of prosecution history estoppel, judicial estoppel, and/or other equitable doctrines.

#### **TWENTY-SECOND DEFENSE**

Hikma's actions in defending this case do not give rise to an exceptional case under 35 U.S.C. § 285.

#### **TWENTY-FOURTH DEFENSE**

Any additional defenses or counterclaims that discovery may reveal.

#### **COUNTERCLAIMS**

For its Counterclaims against American Regent, Inc. ("Counterclaim Defendant/Plaintiff"), Counterclaim Plaintiff/Defendant Hikma Pharmaceuticals USA Inc. ("Hikma" or "Counterclaim Plaintiff/Defendant"), states as follows:

#### **THE PARTIES**

1. On information and belief and as it pled in its Complaint, ARI is a corporation organized and existing under the laws of the State of New York, with a principal place of business at 5 Ramsey Road, Shirley, New York 11967.

2. Hikma is a corporation organized and existing under the laws of Delaware, having a place of business at 200 Connell Drive, 4th Floor, Berkeley Heights, New Jersey 07922.

#### **JURISDICTION AND VENUE**

3. These counterclaims arise under the patent laws of the United States and the

Declaratory Judgment Act. This Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

4. This Court has personal jurisdiction over Counterclaim Defendant/Plaintiff on the basis of, *inter alia*, its contacts with New Jersey relating to the subject matter of this action, including having filed suit.

5. Venue is proper under 28 U.S.C. §§ 1391 and 1400.

### **BACKGROUND**

6. Upon information and belief, ARI holds approved New Drug Application (“NDA”) No. 209376 for the Tralement<sup>®</sup> drug product (trace elements injection 4\*, USP).

7. An NDA must include, among other things, the number of any patent that claims the “drug” or a “method of using [the] drug” for which the NDA was submitted and for which a claim of patent infringement could reasonably be asserted against an authorized party. *See* 21 U.S.C. § 355(b)(1), -(c)(2); 21 C.F.R. § 314.53(b), -(c)(2).

8. Upon approval of the NDA, the U.S. Food and Drug Administration (“FDA”) publishes patent information for the approved drug in the “Approved Drug Products with Therapeutic Equivalence Evaluations,” commonly known as the “Orange Book.” *See* 21 U.S.C. § 355(j)(7)(A)(iii).

9. U.S. Patent No. 11,786,548 (“the ’548 patent”), entitled “Trace element compositions, methods of making and use,” issued on October 17, 2023.

10. Upon information and belief based upon the United States Patent Office’s assignment database, ARI is the assignee of the ’548 patent.

11. U.S. Patent No. 11,975,022 (“the ’022 patent”), entitled “Trace element compositions, methods of making and use,” issued on May 7, 2024.

12. Upon information and belief based upon the United States Patent Office's assignment database, ARI is the assignee of the '022 patent.

13. U.S. Patent No. 11,998,565 ("the '565 patent"), entitled "Trace element compositions, methods of making and use," issued on June 4, 2024.

14. Upon information and belief based upon the United States Patent Office's assignment database, ARI is the assignee of the '565 patent.

15. U.S. Patent No. 12,150,956 ("the '956 patent"), entitled "Trace element compositions, methods of making and use," issued on November 26, 2024.

16. Upon information and belief based upon the United States Patent Office's assignment database, ARI is the assignee of the '956 patent.

17. U.S. Patent No. 12,150,957 ("the '957 patent"), entitled "Trace element compositions, methods of making and use," issued on November 26, 2024.

18. Upon information and belief based upon the United States Patent Office's assignment database, ARI is the assignee of the '957 patent.

19. Hikma submitted Abbreviated New Drug Application ("ANDA") No. 219369 ("the ANDA") to obtain FDA approval to market generic versions of ARI's Tralement<sup>®</sup> drug product prior to the expiration of the '548, '022, '565, '956 or '957 patents (the "Patents-in-Suit").

20. Upon information and belief, Counterclaim Defendant/Plaintiff caused the Patents-in-Suit to be listed in the Orange Book for NDA No. 209376.

21. Pursuant to 21 U.S.C. § 355(j)(2)(B), Hikma notified Counterclaim Defendant/Plaintiff by letter dated February 14, 2025 (the "Hikma Notice Letter") that Hikma had submitted a Paragraph IV Certification for its ANDA with respect to the Patents-in-Suit. The Hikma Notice Letter, which is incorporated herein by reference, contained a detailed statement

of the factual and legal bases for Hikma's Paragraph IV Certification that the claims of the Patents-in-Suit are invalid, not infringed, and/or unenforceable.

22. On April 1, 2025, Counterclaim Defendant/Plaintiff filed this instant lawsuit alleging infringement of the Patents-in-Suit.

## **COUNT I**

### **(Declaratory Judgment of Invalidity or Unenforceability of the '548 Patent)**

23. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 22 of its Counterclaims as though fully set forth herein.

24. Counterclaim Defendant/Plaintiff alleges ownership of the '548 patent and has brought claims against Hikma alleging infringement of the '548 patent.

25. One or more claims of the '548 patent are invalid under one or more provisions of 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

26. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringes, has infringed, and/or will infringe a valid and enforceable claim of the '548 patent.

27. Hikma is entitled to a declaration that all claims of the '548 patent are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

## **COUNT II**

### **(Declaratory Judgment of Non-Infringement of the '548 Patent)**

28. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 27 of its Counterclaims as though fully set forth herein.

29. Counterclaim Defendant/Plaintiff alleges ownership of the '548 patent and has

brought claims against Hikma alleging infringement of the '548 patent.

30. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringe, have infringed, and/or will infringe a valid and enforceable claim of the '548 patent.

31. Hikma has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of the '548 patent and is not liable for such infringement.

32. Hikma is entitled to a declaration that the manufacture, use, or sale of Hikma's ANDA Product would not infringe any valid or enforceable claim of the '548 patent.

### **COUNT III**

#### **(Declaratory Judgment of Invalidity or Unenforceability of the '022 Patent)**

33. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 32 of its Counterclaims as though fully set forth herein.

34. Counterclaim Defendant/Plaintiff alleges ownership of the '022 patent and has brought claims against Hikma alleging infringement of the '022 patent.

35. One or more claims of the '022 patent are invalid under one or more provisions of 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

36. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringes, has infringed, and/or will infringe a valid and enforceable claim of the '022 patent.

37. Hikma is entitled to a declaration that all claims of the '022 patent are invalid under

35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

#### **COUNT IV**

##### **(Declaratory Judgment of Non-Infringement of the '022 Patent)**

38. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 37 of its Counterclaims as though fully set forth herein.

39. Counterclaim Defendant/Plaintiff alleges ownership of the '022 patent and has brought claims against Hikma alleging infringement of the '022 patent.

40. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringe, have infringed, and/or will infringe a valid and enforceable claim of the '022 patent.

41. Hikma has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of the '022 patent and is not liable for such infringement.

42. Hikma is entitled to a declaration that the manufacture, use, or sale of Hikma's ANDA Product would not infringe any valid or enforceable claim of the '022 patent.

#### **COUNT V**

##### **(Declaratory Judgment of Invalidity or Unenforceability of the '565 Patent)**

43. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 42 of its Counterclaims as though fully set forth herein.

44. Counterclaim Defendant/Plaintiff alleges ownership of the '565 patent and has brought claims against Hikma alleging infringement of the '565 patent.

45. One or more claims of the '565 patent are invalid under one or more provisions of

35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

46. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringes, has infringed, and/or will infringe a valid and enforceable claim of the '565 patent.

47. Hikma is entitled to a declaration that all claims of the '565 patent are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

### **COUNT VI**

#### **(Declaratory Judgment of Non-Infringement of the '565 Patent)**

48. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 24 of its Counterclaims as though fully set forth herein.

49. Counterclaim Defendant/Plaintiff alleges ownership of the '565 patent and has brought claims against Hikma alleging infringement of the '565 patent.

50. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringe, have infringed, and/or will infringe a valid and enforceable claim of the '565 patent.

51. Hikma has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of the '565 patent and is not liable for such infringement.

52. Hikma is entitled to a declaration that the manufacture, use, or sale of Hikma's ANDA Product would not infringe any valid or enforceable claim of the '565 patent.



## **COUNT VII**

### **(Declaratory Judgment of Invalidity or Unenforceability of the '956 Patent)**

53. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 52 of its Counterclaims as though fully set forth herein.

54. Counterclaim Defendant/Plaintiff alleges ownership of the '956 patent and has brought claims against Hikma alleging infringement of the '956 patent.

55. One or more claims of the '956 patent are invalid under one or more provisions of 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

56. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringes, has infringed, and/or will infringe a valid and enforceable claim of the '956 patent.

57. Hikma is entitled to a declaration that all claims of the '956 patent are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

## **COUNT VIII**

### **(Declaratory Judgment of Non-Infringement of the '956 Patent)**

58. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 57 of its Counterclaims as though fully set forth herein.

59. Counterclaim Defendant/Plaintiff alleges ownership of the '956 patent and has brought claims against Hikma alleging infringement of the '956 patent.

60. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringe, have infringed, and/or will infringe a valid and enforceable

claim of the '956 patent.

61. Hikma has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of the '956 patent and is not liable for such infringement.

62. Hikma is entitled to a declaration that the manufacture, use, or sale of Hikma's ANDA Product would not infringe any valid or enforceable claim of the '956 patent.

### **COUNT IX**

#### **(Declaratory Judgment of Invalidity or Unenforceability of the '957 Patent)**

63. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1 through 62 of its Counterclaims as though fully set forth herein.

64. Counterclaim Defendant/Plaintiff alleges ownership of the '957 patent and has brought claims against Hikma alleging infringement of the '957 patent.

65. One or more claims of the '957 patent are invalid under one or more provisions of 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

66. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringes, has infringed, and/or will infringe a valid and enforceable claim of the '957 patent.

67. Hikma is entitled to a declaration that all claims of the '957 patent are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112, and/or other judicially-created bases for invalidity.

### **COUNT X**

#### **(Declaratory Judgment of Non-Infringement of the '957 Patent)**

68. Hikma re-alleges and incorporates by reference the allegations in Paragraphs 1

through 68 of its Counterclaims as though fully set forth herein.

69. Counterclaim Defendant/Plaintiff alleges ownership of the '957 patent and has brought claims against Hikma alleging infringement of the '957 patent.

70. There is an actual, substantial, continuing, and justiciable controversy between the parties regarding whether the filing of Hikma's ANDA and/or the commercial marketing of Hikma's ANDA Product infringe, have infringed, and/or will infringe a valid and enforceable claim of the '957 patent.

71. Hikma has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of the '957 patent and is not liable for such infringement.

72. Hikma is entitled to a declaration that the manufacture, use, or sale of Hikma's ANDA Product would not infringe any valid or enforceable claim of the '957 patent.

#### **PRAYER FOR RELIEF**

WHEREFORE, Hikma respectfully requests judgment in its favor and against Counterclaim Defendant/Plaintiff as follows:

- a. Declaring that the filing of Hikma's ANDA No. 219369 ("the ANDA") has not infringed and does not infringe any valid and enforceable claim of the Patents-in-Suit;
- b. Declaring that the manufacture, use, offer to sell, sale, and/or importation into the United States of the ANDA does not, and would not, if marketed, infringe any valid and enforceable claim of the Patents-in-Suit;
- c. Declaring that each claim of the Patents-in-Suit is invalid;
- d. Declaring this an exceptional case in favor of Hikma and awarding its attorneys' fees pursuant to 35 U.S.C. § 285 and/or under all applicable statutes and rules in common law

that would be appropriate;

e. Awarding costs and expenses under all applicable statutes and rules in common law

that would be appropriate; and

f. Awarding any and all such other relief as the Court determines to be just and proper.

MIDLIGE RICHTER LLC  
*Attorneys for Defendant*  
*Hikma Pharmaceuticals USA Inc.*  
By: s/ James S Richter  
James S. Richter  
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DATED: June 6, 2025

OF COUNSEL:

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**LOCAL CIVIL RULE 11.2 CERTIFICATION**

Pursuant to Local Civil Rule 11.2, I hereby certify, to the best of my knowledge, the same drug and patents are at issue in the following actions currently pending in this District:

- *American Regent, Inc. f/k/a Luitpold Pharmaceuticals, Inc. v. Somerset Therapeutics, LLC et al.*, Civil Action No. 2:24-cv-01022 (D.N.J.)
- *American Regent, Inc. f/k/a Luitpold Pharmaceuticals, Inc. v. Cipla USA, Inc. et al.*, Civil Action No. 2:24-cv-08435 (D.N.J.)
- *American Regent, Inc. f/k/a Luitpold Pharmaceuticals, Inc. v. Hikma*

*Pharmaceuticals USA Inc. f/k/a West-Ward Pharmaceuticals Corp.*, Civil Action  
No. 2:25-cv-02224 (D.N.J.)

- *American Regent, Inc. v. Amneal Pharmaceuticals of New York, LLC et al.*, Civil  
Action No. 2:25-cv-02642 (D.N.J.)

Hikma is not aware of any other action in any court or any pending arbitration or  
administrative proceeding related to this matter.

s/James S. Richter  
James S. Richter

DATED: June 6, 2025

**CERTIFICATE OF SERVICE**

The undersigned attorney certifies that a copy of Hikma's foregoing Answer, Separate  
Defenses, and Counterclaims was filed via ECF and served on all counsel of record by electronic  
mail on June 6, 2025.

s/James S. Richter  
James S. Richter

DATED: June 6, 2025