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The Honorable Richard A. Jones

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

UNIGEN PHARMACEUTICALS, INC.,

Plaintiff,

v.

WALGREEN COMPANY,

Defendant.

CASE NO. C07-0471RAJ
ORDER

I. INTRODUCTION

This matter comes before the court on the motion (Dkt. # 36) of Defendant Walgreen Company (“Walgreen”) for summary judgment that the patent it is accused of infringing is invalid. The court has reviewed the motion together with all documents filed in support and in opposition. Based on that review, the court directs Plaintiff Unigen Pharmaceuticals, Inc. (“Unigen”) to submit additional briefing in accordance with this order, and directs the clerk to RENOTE Walgreen’s motion as stated at the conclusion of this order.

II. BACKGROUND

Unigen accuses Walgreen of infringing United States Patent No. 7,192,611 (“the ‘611 Patent”). The parties have commenced discovery, but their initial briefs regarding

1 claim construction in advance of the Markman hearing in this matter are not due until
2 June 13, 2008.

3 In the instant motion, Walgreen asserts that the invention disclosed in United
4 States Patent No. 5,650,433 (“the ‘433 Patent”) anticipates the ‘611 Patent, and thus
5 renders it invalid under 35 U.S.C. § 102(b).
6

7 **III. DISCUSSION**

8 Among other defenses, Unigen responds to the instant motion with the assertion
9 that it would be improper for the court to assess the validity of its patent in advance of
10 claim construction. The court acknowledges that determining the validity of a patent
11 before construing its claims is improper. *See, e.g., Akamai Techs., Inc. v. Cable &*
12 *Wireless Internet Servs., Inc.*, 344 F.3d 1186, 1195 n.4 (Fed Cir. 2003) (“Before the
13 factual question of anticipation may be addressed, a court must first properly construe the
14 claims before it.”); *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1319 (Fed. Cir. 2004)
15 (noting that “analysis of anticipation should [begin] by construing [claim] limitations”).
16

17 In this case, however, the apparent similarity between the ‘433 Patent and the
18 patent-in-suit suggests that the court may more efficiently resolve this dispute by
19 considering Walgreen’s motion in advance of formal claim construction.

20 The court therefore directs Unigen to submit, within two weeks of this order, a
21 proposed claim construction for each of the asserted claims of the patent-in-suit. Unigen
22 should not offer argument in favor its proposed claim construction, but should ensure that
23 it submits sufficient explanation to permit the court to understand its proposed claim
24 construction. Unigen will not be bound by its proposed claim construction except in the
25 court’s consideration of the motions before it. Unigen may advance a different
26 interpretation of its claims during the formal claim construction in this litigation. The
27 only requirement the court places upon the claim construction that Unigen submits in
28

