DEPARTMENT OF HEALTH & HUMAN SERVICES

Food and Drug Administration
Rockville, MD 20857

SENT VIA ELECTRONIC MAIL

Dear Celecoxib ANDA Applicant:

This letter addresses the legal and regulatory scheme governing eligibility of abbreviated new drug application (ANDA) applicants for 180-day exclusivity under the Federal Food, Drug, and Cosmetic Act (FD&C Act) as it existed prior to December 8, 2003, in a situation involving a reissued patent. Our particular concern is whether a paragraph IV certification to a reissued patent gives rise to a new opportunity for 180-day exclusivity when one or more paragraph IV certifications to the original patent gave rise to the opportunity for 180-day exclusivity, a final court decision has issued determining that the original patent is invalid or not infringed, but subsequent to that decision, and prior to (a) any commercial marketing by a first applicant to the original patent, and (b) the agency needing to make a decision regarding 180-day exclusivity, the Patent and Trademark Office issues a reissued patent that references the original patent.[1]

I. STATUTORY AND REGULATORY BACKGROUND

A. ANDAs and Eligibility for 180-day Exclusivity

The Drug Price Competition and Patent Term Restoration Act of 1984 (Public Law 98-417) (the Hatch-Waxman Amendments) created section 505(j) of the FD&C Act (21 U.S.C. 355(j)). The Hatch-Waxman Amendments reflect Congress' efforts to balance the need to "make available more low cost generic drugs by establishing a generic drug approval procedure for pioneer drugs first approved after 1962" with new incentives for drug development in the form of marketing exclusivity and patent term extensions.[2] Section 505(j) of the FD&C Act established an abbreviated approval pathway for a drug product that is the same as a previously approved drug (the reference listed drug (RLD)) with respect to active ingredient, dosage form, route of administration, strength, labeling, and conditions of use, among other characteristics. An ANDA applicant also must demonstrate that its proposed product is bioequivalent to the RLD. An applicant that can meet the requirements under section 505(j) of the FD&C Act may rely upon the Agency's finding of safety and effectiveness for the RLD, and need not repeat the extensive nonclinical and clinical investigations required for approval of a full new drug application (NDA) submitted under section 505(b)(1) of the FD&C Act. The timing of approval for an ANDA is subject to the patent and marketing exclusivity protections accorded to the RLD.

[1] This situation most recently has come up in the matter of celecoxib capsules, 100 mg, 200 mg, and 400 mg. One or more applicants were first to file a paragraph IV certification to the original patent in November 2003. The original patent was found invalid in a Federal Circuit Court of Appeals mandate issued in May 2008. Information on a reissued patent was received by the agency on March 7, 2013. On that date, multiple applicants submitted paragraph IV certifications to the reissued patent. Proper notification by all applicants who submitted paragraph IV certifications on March 7 was sent on March 7, 2013. It is noted that each of these applicants also submitted a paragraph IV certification and sent notification on March 5 and 6, 2013.

[2] See House Report No. 98-857, part 1, at 14 (1984), reprinted in 1984 U.S.C.C.A.N. 2647 at 2647-2648.

Section 505(b)(1) of the FD&C Act requires the sponsor of an NDA to "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." Upon approval of an application under section 505(c) of the FD&C Act, FDA publishes the patent information provided by the drug product's sponsor in FDA's Approved Drug Products with Therapeutic Equivalence Evaluations (commonly known as the Orange Book), available on FDA's Web site. FDA's role in patent listing is ministerial. FDA has stated that it "will not evaluate a patent to assess whether the declaration is accurate or whether the patent has been appropriately submitted for listing. . . . We will, however, review the declaration for completeness and to determine that the information given by the NDA applicant or holder or patent owner indicates that the patent is eligible for listing."[3]

An ANDA applicant must include a patent certification described in section 505(j)(2)(A)(vii) of the FD&C Act for each patent that claims the RLD or a method of using the drug for which the applicant is seeking approval and for which information is required to be filed under subsection 505(b) or 505(c) of the FD&C Act.[4] For each patent listed in the Orange Book, the ANDA applicant must submit either a paragraph III certification (indicating that the applicant does not seek approval until the date on which such patent will expire), a paragraph IV certification (certifying that such patent is invalid or will not be infringed by the manufacture, use, or sale of the drug product for which the ANDA is submitted and indicating that the applicant seeks approval before such patent expires), or, with respect to a method-of-use patent, a statement that the patent does not claim a use for which the ANDA applicant is seeking approval (section 505(j)(2)(A)(viii) of the FD&C Act).[5]

An applicant submitting a paragraph IV certification is required to give notice of the paragraph IV certification to the holder of the NDA for the RLD and each owner of the patent that is the subject of the certification.[6] Notice of a paragraph IV certification includes, among other things, "a detailed statement of the factual and legal basis of the applicant's opinion that the patent is not

---

[3] "Applications for FDA Approval to Market a New Drug: Patent Submission and Listing Requirements and Application of 30-Month Stays on Approval of Abbreviated New Drug Applications Certifying That a Patent Claiming a Drug Is Invalid or Will Not Be Infringed; Final Rule" (68 FR 36676 at 36687; June 18, 2003) ("June 2003 Final Rule"). It should be noted that certain sections of this final rule regarding the application of 30-month stays on approval of certain ANDAs and applications submitted under section 505(b)(2) of the Act were superseded by the Medicare Prescription Drug, Improvement, and Modernization Act of 2003 (MMA) (Public Law 108-173) and revoked by technical amendment (69 FR 11309; March 10, 2004).

[4] 21 CFR 314.94(a)(12).

[5] *Id.*

[6] When a paragraph IV certification is submitted in an amendment to a pending ANDA, notification is to be given "at the time at which the applicant submits the amendment." See section 505(j)(2)(B)(ii)(II) of the FD&C Act. See also section 505(j)(2)(B)(iii) of the pre-MMA statute ("notice … shall be given when the amended application is submitted.") If the applicant does not give notice when it submits the amendment to FDA, FDA will not treat the original receipt date as the relevant date for exclusivity purposes. Instead, the agency will look to the date the applicant actually sent the required notice, since that is the date the applicant effectively met the statutory requirements by having both submitted a paragraph IV certification and sent notice of the submission. See Letter dated January 28, 2003, from G. Buehler, Director, OGD, to ANDA Applicants for Gabapentin, Attachment at pages 6-8.

valid or will not be infringed" (section 505(j)(2)(B)(iv) of the FD&C Act) and it subjects the ANDA applicant to the risk that it will be sued for patent infringement. In addition, if the NDA holder or patent owner initiates a patent infringement action within 45 days after receiving notice of the paragraph IV certification, there will be a statutory 30-month stay of approval of the ANDA while the patent infringement litigation is pending (section 505(j)(5)(B)(iii) of the FD&C Act).

The 180-day exclusivity period described in section 505(j)(5)(B)(iv) of the FD&C Act provides an incentive for ANDA applicants to submit paragraph IV certifications to challenge listed patents that may be invalid, unenforceable, or not infringed by the drug product described in the ANDA. The first applicant to submit a substantially complete ANDA containing a paragraph IV certification may be eligible for a 180-day period of exclusivity during which FDA will not approve subsequent ANDAs for the same drug product that also contain a paragraph IV certification to the patent. Any exclusivity period would run for 180 days from either the first commercial marketing of the first applicant's drug product or from a court decision finding that the patent that is the subject of the paragraph IV certification is invalid or not infringed, whichever is earlier (see section 505(j)(5)(B)(iv) of the FD&C Act), during the unexpired term of the patent.[7]

In an August 2, 1999, response to citizen petitions from two generic drug firms addressing the exclusivity issue associated with the approval of ANDAs for cisplatin, FDA stated that the regulations governing pre-MMA 180-day exclusivity should be interpreted to award such exclusivity on a patent-by-patent basis.[8] That is, eligibility for 180-day exclusivity would be based on which company submitted the first paragraph IV certification challenging each listed patent. Therefore, in cases where multiple patents are listed, different applicants may have the first paragraph IV certification as to different patents and multiple ANDA applicants may simultaneously be eligible for 180-day exclusivity as to the particular patents on which they were first.

B. Reissued Patents

Section 252 of the Title 35, U.S. Code, addresses amendments and correction of patents. Section 252 establishes the effect of reissued patents:

[7] To determine availability of 180-day exclusivity for ANDAs referencing a particular RLD, FDA applies the version of the statute in effect at the time the first substantially complete ANDA referencing the RLD and containing a paragraph IV certification was submitted. The version of section 505(j)(5)(B)(iv) of the FD&C Act in effect at the time of submission of the first substantially complete ANDA referencing Celebrex Capsules containing a paragraph IV certification is the version in effect prior to enactment of the MMA. The MMA amended this and other provisions of the FD&C Act. Unless otherwise noted, all statutory references in this memorandum reflect the pre-MMA version of the Act. See generally, Letter dated April 15, 2009, from G. Buehler, Director, Office of Generic Drugs, to ANDA Applicant regarding 180-day exclusivity for topiramate sprinkle capsules.

[8] See Letter from J. Woodcock to R. Green, S. Sklar, and K. Beardsley, FDA Docket No. 99P-1271/PSA1 and PSA2, at 4 (Aug. 2, 1999) (concluding that the regulations at 21 CFR 314.107(c)(1) direct a patent-by-patent inquiry in determining 180-day exclusivity because they specify that an application will be delayed by 180-day exclusivity if it contains a paragraph IV certification and is for the same listed drug for which a previous paragraph IV certification for the same patent has been received) ("Cisplatin Decision").

> The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.
>
> A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

A patent generally may be reissued to correct certain errors in the scope of claims or defects in a specification or drawing that otherwise would have invalidated, in whole or in part, the patent (35 U.S.C. 251(a)). In addition, if the application for reissue is submitted within two years from the grant of the original patent, a reissued patent may be granted with an enlarged scope of claims (35 U.S.C. 251(d)). Accordingly, a reissued patent may affect the patent certification or statement submitted by an ANDA applicant and the infringement claims that could be asserted by the patent owner or NDA holder.

A reissued patent is identified by the U.S. Patent and Trademark Office (PTO) with the letters "RE" preceding the patent number. A reissued patent references the original patent on its face and has the same expiration date as the original patent because the patent is reissued for the unexpired part of the term of the original patent (35 U.S.C. 251(a)). To provide timely notice of patent reissuance to pending and potential ANDA applicants, FDA expects an NDA holder to submit patent information on a reissued patent to FDA within 30 days after the date of patent reissuance (section 505(c)(2) of the FD&C Act). If the scope of claims was narrowed or broadened upon reissuance, the NDA applicant or holder is expected to submit the reissued patent for listing in the Orange Book with a revised designation of whether the patent claims the drug substance, drug product, and/or a method or use, or with a revised use code, as appropriate

(21 CFR 314.53). An ANDA applicant, in turn, must amend its patent certification and to address the patent, as reissued, as required by FDA's regulations.[9]

An original patent that has been reissued remains listed in the Orange Book until FDA has determined that no first ANDA applicant is eligible for 180-day exclusivity as to the patent or the 180-day exclusivity period associated with that patent has expired. Such an original patent that qualified a first applicant for 180-day exclusivity remains listed even if the scope of the reissued patent is narrowed such that the reissued patent is no longer eligible for listing pursuant to section 505(b)(1) or 505(c)(2) of the FD&C Act and even if the NDA holder has requested, as required, that the original patent or patent information be removed from listing in the Orange Book ("patent delisting").[10] (Thus, the fact that the original patent technically is surrendered upon reissuance is not relevant to FDA's assessment of a first applicant's eligibility for 180-day exclusivity based on its certification to the original patent.[11])

Neither the FD&C Act nor FDA's regulations directly address the effect of patent reissuance on the approval of a pending ANDA. Although FDA believes it is appropriate to require ANDA applicants to amend their ANDAs to certify to a timely filed reissued patent,[12] FDA does not consider a reissued patent to be a new and distinct patent for purposes of 180-day exclusivity. Instead, FDA has generally treated the original patent and the reissued patent as a single "bundle"[13] of patent rights, albeit patent rights that may have changed with reissuance, for purposes of administering the patent certification requirements of the FD&C Act and any 30-month stay of approval or 180-day exclusivity period that may relate to a paragraph IV certification to the original patent. Thus, under the pre-MMA scheme, a 30-month stay of approval arising from litigation based on a paragraph IV certification to the original patent remains in effect after the patent is reissued (assuming the litigation giving rise to the stay continues), and any applicant eligible for 180-day exclusivity based on a paragraph IV certification to the original patent remains eligible for that exclusivity after patent reissuance.

FDA's approach to reissued patents is intended to consistently and predictably implement the FD&C Act and reflect the nature of reissued patents while preserving FDA's ministerial role in

---

[9] 21 CFR 314.94(a)(12)(viii)(C)(1).

[10] See, e.g., Letter dated May 7, 2008, from G. Buehler, Director, Office of Generic Drugs (OGD), to W. Rakoczy, regarding 180-day exclusivity for acarbose tablets at 7, note 13 (Docket No. FDA-2007-N-0445-0026) ("Because immediate removal of patent information from the Orange Book upon withdrawal of the patent information by the NDA holder could result in ANDA applicants withdrawing corresponding patent certifications prematurely and thus undermining a first applicant's exclusivity, FDA will leave information related to withdrawn patents in the Orange Book until it has determined that any related 180-day exclusivity has expired"). See also *Ranbaxy v. Leavitt*, 469 F.3d 120, 125 (D.C. Cir. 2006) ("*Ranbaxy*") (holding that permitting NDA holders to strategically delist patents from the Orange Book to strip ANDA applicants of exclusivity is "inconsistent with the structure of the statute"); *Teva Pharms. USA, Inc. v. Sebelius*, 595 F.3d 1303 (D.C. Cir. 2010) (reaffirming conclusions of *Ranbaxy* in post-MMA context).

[11] See 37 CFR 1.178(a) (stating that the application for reissue constitutes an offer to surrender the patent).

[12] 21 CFR 314.94(a)(12)(viii)(C)(1).

[13] See *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 875 (Fed. Cir. 1991) ("A patent provides its owner with the right to exclude others from making, using, and selling the claimed invention. It is, in effect, a bundle of rights which may be divided and assigned, or retained in whole or in part." (internal citations omitted)).

patent listings.[14] We note that FDA's treatment of reissued patents for 180-day exclusivity and 30-month stay purposes is consistent with the statutory treatment of reissued patents generally, including the provision that allows a pending cause of action based on the original patent to continue after reissuance to the extent that claims of the original and reissued patent are substantially identical (see 35 U.S.C. 252). It is also consistent with the limitation on reissuance to the unexpired part of the term of the original patent (see 35 U.S.C. 251(a)). Additionally, it is consistent with the requirement that "no new matter shall be introduced into the application for reissue" (35 U.S.C. 251(a)).

II. DISCUSSION

As a preliminary matter, we note that it is FDA's practice to make decisions on eligibility for 180-day exclusivity in the context of specific ANDAs that are otherwise eligible for approval. This approach is taken because there are many factors that may influence eligibility for exclusivity up to the time an application is ready for approval (e.g., patent expiration or withdrawal of ANDA) and could thus render a premature eligibility determination incorrect. When the Agency makes an approval decision with respect to an ANDA, it will generally inform an applicant affected by 180-day exclusivity that, for example, it is (1) a first applicant and entitled to exclusivity, or (2) eligible only for a tentative approval because one or more first applicants are eligible for 180-day exclusivity.

Therefore, in this letter, we are not making a determination with respect to 180-day exclusivity in a particular case, because we will not make such a determination until such time as an applicant or subsequent applicant is ready for approval. Rather, this letter clarifies the regulatory framework to be applied to the relevant ANDAs when such exclusivity determination is made.

As mentioned at the outset, this consideration by the agency is done under the pre-MMA version of the statute. Under the pre-MMA statute, 180-day exclusivity is based on a patent-by-patent scheme, and it is possible to have multiple periods of exclusivity stemming from paragraph IV certifications submitted to different patents.[15]

A. Reissued Patents and 180-Day Exclusivity

The first issue addressed in this letter is how to regard the relation of an original patent and its reissue for 180-day exclusivity purposes. In short, should these be regarded for exclusivity purposes as one patent giving rise to a single exclusivity period or two patents with the potential to give rise to two separate exclusivity periods?

Although there is not a great deal of precedent with respect to 180-day exclusivity and reissued patents, the Agency previously has taken the following actions involving reissued patents in a pre-MMA context. In these cases, FDA has consistently applied its single "bundle" of patent rights approach regarding reissued patents and 180-day exclusivity and has concluded that the original and reissued patent together give rise to a single 180-day exclusivity period.

---

[14] See, e.g., "[ANDA] Regulations; Patent and Exclusivity Provisions; Final Rule" (59 FR 50338 at 50349, October 3, 1994); June 2003 Final Rule at 36683 and 36687.

[15] See Cisplatin Decision, at 4. .

- Mircette (an oral contraceptive consisting of desogestrel/ethinyl estradiol and ethinyl estradiol tablets). Mircette was approved on April 22, 1998. The NDA for Mircette is 20-713, and was held by Organon, Inc. Duramed Pharmaceuticals, Inc., submitted the first ANDA (75863) with a paragraph IV certification to the patents listed for Mircette.[16] When Duramed submitted ANDA 75863 in May 2000, the only patent listed for Mircette was U.S. Patent No. 4,921,843 (the '843 patent). The reissue of the '843 patent (i.e., RE35,724) was listed after Duramed's ANDA was received, and Duramed was the first ANDA applicant to submit a paragraph IV certification to the reissued patent, which it submitted on April 11, 2001. Barr Laboratories, Inc. became the holder of ANDA 75863 prior to its approval. Barr was sued on the reissued patent, and in a district court decision of December 6, 2001, Barr was found not to infringe the reissued patent. In its April 5, 2002 approval letter, FDA noted that Barr was the first to file a substantially complete ANDA containing paragraph IV certifications to the listed "patents," and that Barr's 180-day exclusivity period began approximately four months earlier, on December 6, 2001, the date of the court's decision on the reissued patent.[17] This action, which limited Barr's exclusivity to barely two months, and which did not award a separate period of exclusivity based on its paragraph IV certification to the original patent, was never challenged by Barr.

- Ultracet (tramadol HCl and acetaminophen tablets). On April 21, 2005, FDA approved ANDA 76475, filed by Kali Laboratories, Inc. (Kali), and granted Kali a period of 180-day exclusivity as the first applicant to submit a paragraph IV certification to U.S. Patent No. 5,336,691 (the '691 patent).[18] Kali began commercial marketing of its product the same day ANDA 76745 was approved. On August 1, 2006, the '691 patent was reissued as U.S. Patent No. RE39,221 (the RE'221 patent).[19] Apotex was the first applicant to submit a paragraph IV certification to the RE'221 patent. Alphapharm Pty Ltd. (Alphapharm) subsequently amended its tentatively approved ANDA 077858 to include a paragraph IV certification to the RE'221 patent. Alphapharm was not first to file a paragraph IV certification on either the '691 patent or the RE'221 patent. Within 45 days of receipt of Alphapharm's notice of the paragraph IV certification to the RE'221 patent, the NDA holder initiated a patent infringement action against Alphapharm. This resulted in a 30-month stay of approval[20] that subsequently terminated upon dismissal of the patent infringement action. Although FDA previously had "determined that paragraph IV certifications to a patent submitted after approval of an ANDA may result in an additional period of exclusivity under section 505(j)(5)(B)(iv) for another applicant referencing the

[16] Letter dated April 5, 2002, from G. Buehler, Director, OGD, to C. Mundkur, Barr, at 2.

[17] Id.

[18] Letter dated April 21, 2005, from G. Buehler, Director, OGD, to W.S. Groner, Kali.

[19] U.S. Patent No. RE39,221.

[20] We note that Alphapharm's original certification to the '691 patent was a paragraph III. Determining that there should be a 30- month stay associated with the paragraph IV certification and associated infringement action on the RE221 patent is consistent with a single "bundle" of patent rights in regard to an original patent and its reissue because the original patent was listed at the time Alphapharm's ANDA was filed and therefore the first paragraph IV certification to either the original (or its reissue) were eligible to give rise to a 30-month stay of approval.

same drug product,"[21] FDA did not grant a second round of 180-day exclusivity to the first applicant to submit a paragraph IV certification to the RE'221 patent. Accordingly, full approval of Alphapharm's ANDA on September 26, 2008, was not blocked by any alleged 180-day exclusivity on the RE'221 patent. This approach reflected FDA's view that the rights to 180-day exclusivity for a reissued patent are not distinguishable from the rights to 180-day exclusivity on the original patent. Because FDA already had granted 180-day exclusivity to Kali's ANDA 076475 based on the '691 patent and that exclusivity had run, FDA did not grant a second round of exclusivity to the first applicant to submit a paragraph IV certification to the RE'221 patent. Thus, Alphapharm, a subsequent applicant on the RE '221 patent was not blocked by another applicant's exclusivity (in spite of the fact that the exclusivity was governed by pre-MMA rules).

- Adderall XR (mixed salts of a single-entity amphetamine product) extended-release capsules. Barr was first to file paragraph IV certifications on two original patents. On April 1, 2009, Barr initiated marketing of an authorized generic.[22] Reissued patents were submitted for listing on March 18, 2010, and February 25, 2011.[23] On April 7, 2010, Actavis submitted a citizen petition claiming it was entitled to 180-day exclusivity by virtue of being the first to file a paragraph IV certification to the reissued patent listed in March 2010. Docket No. FDA-2010-P-0188. On June 21, 2012, Actavis withdrew the citizen petition.[24] On June 22, 2012, FDA approved ANDA 77302 of Actavis. This was the first ANDA approved for a generic equivalent to Adderall XR. Although the approval letter did not discuss 180-day generic drug exclusivity,[25] FDA concluded that Barr triggered its 180-day exclusivity on the two original patents when it began marketing an authorized generic, and the reissued patents were not treated as new and distinct patents for purposes of giving rise to new periods of 180-day exclusivity. The fact that no subsequent ANDA was approved within 180 days of Actavis' commercial marketing does not alter the analysis.

As noted above, in each of these three decisions, FDA treated the original and reissued patent as a single "bundle" of patent rights. In the case of Mircette, Barr (the first to file a paragraph IV certification with respect to the '843 patent for Mircette) made no objection to FDA's decision that a single 180-day exclusivity period was triggered by the court's decision that the reissued patent was not infringed even though, at the time of its ANDA approval, only about two months remained on its 180-day exclusivity period.

---

[21] See Letter dated June 1, 2004, from G. Buehler, Director, OGD, to K. Beardsley and C. Shepard regarding 180-day exclusivity for metformin HCl extended-release tablets, 500 mg, at 2.

[22] See Press Release. available at http://staging-retail.ccbn.com/releasetext.asp?ticker=teva.ta&coid=73925&client=cb&release=1555727. See also NDA 21-303 (Adderall XR), 2009 Annual Report, section 1.13.4, at 1-2.

[23] See submissions on these dates to NDA 21-303 (Adderall XR). These reissued patents were both listed within 30 days of their respective issuances.

[24] Docket No. FDA-2010-P-0188.

[25] Letter dated June 22, 2012, from K. Webber, Dep. Dir., Office of Pharmaceutical Science, CDER, to J. Jadeja, Actavis.

In light of section 505's silence on the effect of reissued patents and our treatment of an original and reissued patent as a single "bundle" of rights for purposes of 180-day exclusivity as described in the precedent above, we believe that when a paragraph IV certification has been made to an original patent, subsequent paragraph IV certifications to a reissued patent that references the original patent should not be the basis for separate periods of 180-day exclusivity.

As described above, section 505 of the FD&C Act is silent as to the effect of reissued patents on 180-day exclusivity. We believe that our interpretation of the Act is reasonable and is consistent with principles of patent law, including that: (1) a pending cause of action based on the original patent continues after reissuance to the extent that claims of the original and reissued patent are substantially identical (see 35 U.S.C. 252); (2) the limitation on reissuance to the unexpired part of the term of the original patent (see 35 U.S.C. 251(a)); and (3) the requirement that "no new matter shall be introduced into the application for reissue" (35 U.S.C. 251(a)).

Our interpretation of the statutory ambiguity also is consistent with the objectives of the Hatch-Waxman Amendments and provides a predictable approach that is consistent with our ministerial role in patent listing decisions.

B. Effect of a Court Decision on the Original Patent that Occurred Before the Patent Was Reissued

Although the agency has previously addressed the effect of a reissued patent on 180-day exclusivity, the situation addressed in this letter presents a question of first impression: in the pre-MMA context, what effect on eligibility for 180-day exclusivity should be given to a court decision on the original patent when such a court decision does not speak to a reissue of the original patent, and in fact is made prior to the existence of the reissued patent?

Under pre-MMA law, the 180-day exclusivity period is triggered, and begins to run, by one of two events: (1) the date FDA receives notice from the first applicant of first commercial marketing; or (2) the date of a decision of a court action holding the subject patent invalid or not infringed (section 505(j)(5)(B)(iv)).

In the three cases described above, exclusivity was deemed to have been triggered –

- by a court decision on the reissued patent (Mircette), and
- by commercial marketing (Ultracet and Adderall XR).

In the situation addressed in this letter, no applicant has begun commercial marketing of the product. Thus, because we believe that the reissued patent cannot be the basis for a new period of 180-day exclusivity, the situation presents the question of whether a prior court decision on the original patent triggered (and exhausted) any exclusivity to which a first applicant on the original patent was entitled. If the answer is "yes," one or more other applicants potentially could be eligible for approval at the same time as the first applicant on the original patent. If the answer is "no," eligibility for 180-day exclusivity would remain intact for the first applicant on the original patent.

Some might take the position that the reissued patent can be the basis for a new period of 180-day exclusivity such that even if one or more first applicants' exclusivity was triggered and exhausted by the court decision on the original patent, one or more first applicants remain eligible for exclusivity based on paragraph IV certifications to the reissued patent. Others might argue that 180-day exclusivity for the original patent was triggered and exhausted by the earlier court decision, reissuance of a patent does not create a new patent independent of the original patent to which it relates, and a paragraph IV certification to the reissued patent does not entitle an ANDA applicant to exclusivity.

We conclude that the "court-decision-trigger" provision of section 505(j)(5)(B)(iv) is ambiguous regarding a scenario in which an ANDA applicant makes a paragraph IV certification to an original patent, a court finds the patent invalid, and the Patent and Trademark Office reissues the patent before any other applicant has an ANDA that is in a position "to be made effective not earlier than one hundred and eighty days" after a triggering event. In these circumstances, the statute is ambiguous regarding whether such a court decision should be considered to hold "the patent which is the subject of the certification to be invalid or not infringed."

For the reasons described below, we conclude that not considering the court decision on the original patent to be a triggering event under these circumstances best reconciles the complicated intersection between the Hatch-Waxman Amendments and patent law, while allowing FDA to administer the Act in a manner that is fair, predictable, and consistent with the goal of bringing generic products to the market.

A court decision regarding the validity of an original patent is not dispositive as to the validity of the reissued patent or the issue of whether the reissued patent is infringed. As a matter of law, the reissued patent is considered presumptively valid. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1139 (Fed. Cir. 1985) ("Following examination by the Patent and Trademark Office, a duly issued patent is presumed valid, as is a duly reissued patent."). Further, "[t]he object of a patentee applying for a reissue is … to rectify any error which may have been found to have arisen from his inadvertence or mistake." McCormick Harvesting Mach. Co. v. C. Aultman & Co., 18 S.Ct. 443, 169 U.S. 606, 42 L.Ed. 875 (1898). The reissued patent "has the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form." 35 U.S.C. 252 (emphasis added). It follows, therefore, under the agency's view of the relation between the original and reissued patent for exclusivity purposes, that upon the listing of a reissued patent, a prior court decision on the invalidity or non-infringement of the original patent should not be considered an event triggering exclusivity. The contrary view would introduce an incongruity into the statutory framework. This view would consider the court decision on the original patent to be sufficient to trigger (and exhaust) 180-day exclusivity, while at the same time considering the patent at issue in that case to be in effect in its reissued form. Our interpretation of the ambiguous court-decision-trigger provision to find that there has been no triggering event in this situation avoids this conflict.

We believe that this interpretation is reasonable and best allows the agency to administer the Hatch-Waxman Amendments in a predictable manner that encourages generic competition. As described above, we believe that our single "bundle" of rights approach is consistent with patent law, furthers the objectives of the Hatch-Waxman Amendments, and provides a predictable framework that is consistent with our ministerial role in patent listing. Under this approach, we must resolve a statutory ambiguity regarding whether a court decision on an original patent

triggers exclusivity when the original patent is later reissued. We believe that considering a court decision on the original patent not to be a triggering event in these cases is consistent with the statutory scheme, and is fair to the ANDA applicants who first took on the risk of litigation by certifying to the original patent.

As noted above, in previous decisions, exclusivity was deemed to have been triggered by either a court decision on the reissued patent or commercial marketing. In both the commercial marketing cases (Ultracet and Adderall XR), the commercial marketing began, and 180 days had run, before the reissued patents in question had been issued. Commercial marketing by a first to file applicant, regardless of when it happens, triggers 180-day exclusivity. The commercial-marketing-trigger provision is not subject to the same statutory ambiguity as the court-decision-trigger provision regarding reissued patents.

III. CONCLUSION

The agency concludes that for purposes of 180-day exclusivity, upon the listing of a reissued patent, a prior court decision on the original patent is not regarded as having triggered 180-day exclusivity for the single bundle of patent rights represented by the original and reissued patent. In such a case, eligibility for 180-day exclusivity is only available to the applicant that first filed a paragraph IV certification to the original patent, and that applicant must make a timely submission of a paragraph IV certification to the reissued patent to remain eligible for 180-day exclusivity.

Sincerely yours,

{See appended electronic signature page}

Kathleen Uhl, M.D.
Acting Director
Office of Generic Drugs
Center for Drug Evaluation and Research

This is a representation of an electronic record that was signed electronically and this page is the manifestation of the electronic signature.

/s/

KATHLEEN UHL
04/24/2014