

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

GENZYME CORPORATION and
MOUNT SINAI SCHOOL OF MEDICINE
OF NEW YORK UNIVERSITY,

Plaintiffs,

v.

TRANSKARYOTIC THERAPIES, INC.,

Defendant.

C.A. No. 00-677 GMS

ORDER

IT IS HEREBY ORDERED:

1. On December 14, 2001 the Court heard oral argument from the parties on Plaintiffs' Motion for Reargument (D.I. 196) and entered an order (D.I. 199) denying Plaintiffs' Motion for Reargument and clarifying that the term "exogenous," as used in the construction of "chromosomally integrated" set forth in the Court's *Markman* order of November 28, 2001 (D.I. 162 at 1) means "exogenous to the host cell, not exogenous to the chromosomal site."
2. Plaintiffs concede that based solely on the above claim construction of "chromosomally integrated" they cannot prevail on the issue of infringement of any claim of U.S. Patent No. 5,356,804, either literally or under the doctrine of equivalents. Accordingly, the Court orders that TKT's Motion for Summary Judgment of Noninfringement (D.I. 181) be

granted and all claims in Plaintiffs' complaint for patent infringement and declaratory judgment against TKT be dismissed, with prejudice.

3. Judgment will thus be entered in TKT's favor on TKT's counterclaims for declaratory judgment of non-infringement. Otherwise, the remaining issues in TKT's counterclaims are dismissed, without prejudice, as moot.

4. TKT's request to supplement the summary judgment record is denied. Additionally, the Declaration of Dr. Thea D. Tlsty (D.I. 174) [with the attached exhibits, including the letter from the U.S. Food and Drug Administration ("FDA")] and TKT's list of documents for in camera review (not docketed) are stricken from the record.

5. Fact discovery is closed as of December 21, 2001, with the exception of the following discovery, which shall go forward only if Plaintiffs appeal the grant of TKT's Motion for Summary Judgment of Noninfringement (D.I. 181) and this case is remanded by the Federal Circuit to this Court for further proceedings on the issue of infringement:

Plaintiffs' Witnesses:

- (i) 30(b)(6) topics 3 and 9 of TKT's notice served on 8/9/01 not yet addressed;
- (ii) 30(b)(6) damages topics noticed 12/3/01;
- (iii) 30(b)(6) and document discovery on damages topics previously noticed, where in need of supplementation;

Defendant's Witnesses:

- (i) 30(b)(6) damages topics noticed 7/27/01 not yet addressed;
- (ii) 30(b)(6) damages topics noticed 11/16/01;
- (iii) 30(b)(6) and document discovery on damages topics previously noticed, where in need of supplementation;
- (iv) deposition testimony from Abbott Laboratories and discovery from Cambrex Bio Sciences, Inc., pursuant to subpoenas dated 9/18/01 and 11/01/01, respectively.

6. The Court reserves decision on all further issues raised by the pleadings including costs, attorneys' fees and expenses.

7. Except as set forth above, the March 18, 2002 trial date and pre-trial schedule previously ordered by this Court are adjourned and all pending motions are denied as moot, without prejudice to refiling such motions in the event that this case is remanded for further proceedings on the issue of infringement.

SO ORDERED, this 31st day of January, 2002

Gregory M. Sleet
UNITED STATES DISTRICT JUDGE