

IN THE UNITED STATES DISTRICT COURT  
IN THE DISTRICT OF DELAWARE

ELAN CORPORATION, PLC and )  
ELAN PHARMA INTERNATIONAL )  
LTD., )  
 )  
Plaintiffs, )  
 )  
v. ) Civ. No. 07-552-SLR  
 )  
TEVA PHARMACEUTICALS USA, )  
INC., )  
 )  
Defendants. )

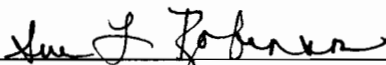
**MEMORANDUM ORDER**

At Wilmington this 7th day of March 2008, having heard oral argument on plaintiffs' motion to dismiss counts III and VI of defendant's counterclaims and to strike its third and sixth affirmative defenses; and having reviewed the papers submitted in connection with said motion;

IT IS ORDERED that said motion (D.I. 12) is denied without prejudice to renew. Although the court agrees with the basic proposition underlying the motion, that is, that attorneys are permitted to advocate for their own interpretation of the prior art before an examiner, nonetheless, arguments made to the PTO can form the basis for inequitable conduct defenses under certain circumstances. See, e.g., Young v. Lumenis, Inc., 492 F.3d 1336, 1349 (Fed. Cir. 2007) (“[G]ross mischaracterizations or unreasonable interpretations of the [prior art] reference” can support an inequitable conduct determination.). At this stage of the proceedings, the court is required to take

defendant's factual representations as true, that is, that the arguments made to the examiner involve intentional falsehoods about a material reference.

IT IS FURTHER ORDERED, however, that **no** discovery shall be taken regarding the intent prong of the inequitable conduct defense. Specifically, the deposition(s) of the prosecuting attorney(s) shall not be taken, nor shall interrogatories or document production requests be propounded that are related to such, absent further order of the court.

  
United States District Judge