

LEXSEE

**BAYER AG and MILES INC., Plaintiffs, - against - BARR LABORATORIES,  
INC., Defendant.**

**92 Civ. 0381 (WK)**

**UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF  
NEW YORK**

**1996 U.S. Dist. LEXIS 13032**

**September 5, 1996, Decided  
September 9, 1996, FILED**

**PRIOR HISTORY:** [\*1] Original Opinion of June 5, 1996, Reported at: 1996 U.S. Dist. LEXIS 7725.

**DISPOSITION:** Bayer's motion to strike denied.

**CASE SUMMARY:**

**PROCEDURAL POSTURE:** Plaintiff corporation moved for reargument following a decision that denied its motion for partial summary judgment against defendant corporation regarding the allowable time period in which to file an application pursuant to 35 U.S.C.S. § 119 and 35 U.S.C.S. § 102(d).

**OVERVIEW:** In an action brought by plaintiff against defendant regarding the allowable time period in which to file an application, the district court denied plaintiff's motion for partial summary judgment, holding that 35 U.S.C.S. § 119 did not modify 35 U.S.C.S. § 102(d). Plaintiff moved for reargument, arguing that the court's holding eliminated the one-year grace period under 35 U.S.C.S. § 119. The court disagreed, noting that had plaintiff's second United States application been filed in July 1982, instead of on October 22, 1982, the statutory bar of 35 U.S.C.S. § 102(d) would have been inapplicable because of the 12-month grace period incorporated into this section. After plaintiff's series of foreign applications filed in August and September of 1981, it had 12 months within which to file a counterpart United States application. However, instead of doing so, it filed a second German application on October 29, 1981, and filed a

second United States application on October 22, 1982, more than 12 months after the initial series of foreign applications. Accordingly, plaintiff's motion was denied.

**OUTCOME:** Plaintiff's motion for reargument of the court's decision denying it partial summary judgment in its action against defendant regarding the allowable time period in which to file an application was denied.

**CORE TERMS:** summary judgment, reargument, partial, modify, statutory bar, grace period, counterpart

**COUNSEL:** For Plaintiffs: Richard G. Greco, Esq., Kaye, Scholer, Fierman, Hays & Handler, New York, NY.

For Defendant: Myron Cohen, Esq., Thomas C. Pontani, Esq., Cohen, Pontani, Lieberman & Pavane, New York, NY. Bruce R. Genderson, Esq., Glenn J. Pfadenhauer, Esq., Maria L. Acebal, Esq., Williams & Connolly, Washington, D.C.

**JUDGES:** WHITMAN KNAPP, SENIOR U.S.D.J.

**OPINION BY:** WHITMAN KNAPP

**OPINION:**

**MEMORANDUM AND ORDER**

**WHITMAN KNAPP, SENIOR D.J.**

In our Memorandum and Order of June 5, 1996, we concluded that 35 U.S.C. § 119 does not modify 35 U.S.C. § 102(d) and accordingly denied the parties' respective motions for partial summary judgment. Plaintiff Bayer AG ("Bayer") has moved for reargument.

In its motion for reargument, Bayer's main contention is that our conclusion eliminates § 119's one-year grace period. This is incorrect. Had Bayer's second United States application been filed in July, 1982, instead of on October 22, 1982, the statutory bar of § 102(d) would have been inapplicable because of the twelve-month grace period incorporated into this section. After [\*2] Bayer's series of foreign applications filed in August and September of 1981, Bayer had twelve months within which to file a counterpart United States application. However, instead of doing so, Bayer filed a second German application on October 29, 1981 and filed a second United States application on October 22, 1982, more than twelve months after the initial series of foreign applications. As noted in our prior Order, allowing § 119 to modify § 102(d) would give foreign applicants two years within which to file counterpart applica-

tions in the United States, a result which we find unreasonable. We find Bayer's remaining contentions to be without merit. Accordingly, we decline to disturb our holding.

Bayer has also moved to strike the affidavit of John Witherspoon, proffered by counsel for defendant Barr Laboratories, Inc. ("Barr") during the May 10 oral argument on the parties' respective motions for partial summary judgment, in support of its contention that § 119's foreign priority dates are irrelevant in applying the statutory bar of § 102(d). As we have not considered Mr. Witherspoon's affidavit, either now or previously, we leave for trial the question of whether it would [\*3] be there admissible, in whole or in part. Accordingly, Bayer's motion to strike is denied.

**SO ORDERED.**

September 5, 1996  
New York, New York

WHITMAN KNAPP, SENIOR U.S.D.J.