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7 **UNITED STATES DISTRICT COURT**  
8 **SOUTHERN DISTRICT OF CALIFORNIA**  
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10 GEN-PROBE INCORPORATED,  
11  
12 vs. Plaintiff,  
13 BECTON DICKINSON AND COMPANY,  
14 Defendant.  
15

CASE NO. 09-cv-2319 – BEN (NLS)  
**ORDER GRANTING IN PART  
MOTION TO REQUIRE GEN-  
PROBE TO LIMIT THE NUMBER  
OF ASSERTED CLAIMS**  
[Doc. No. 193]

16 This is a patent infringement action. Plaintiff Gen-Probe Incorporated (“Gen-Probe”) alleges  
17 that Defendant Becton Dickinson & Company (“BD”) infringes two families of closely-related patents  
18 that encompass and facilitate the use of fully automated, self-contained systems intended for detecting  
19 the DNA or RNA nucleic acids of infectious organisms. Presently before the Court is BD’s motion  
20 to require Gen-Probe to limit the number of asserted claims.

21 At issue are seven patents: five patents comprising the “Automation Patents” and two patents  
22 comprising the “Penetrable Cap Patents.” The Automation Patents<sup>1</sup> describe an automated method  
23 of nucleic acid-based testing, a method for detecting the presence of a particular pathogen in a sample.  
24 Nucleic acid-based testing involves the creation of a complimentary nucleotide sequence that a target  
25 pathogen will bind to through complementary base pairing. The Penetrable Cap Patents<sup>2</sup> describe the  
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27 <sup>1</sup> U.S. Patent Nos. 7,118,892 (the ‘892 Patent), 7,560,255 (the ‘255 Patent), 7,482,143 (the ‘143  
28 Patent), 7,560,256 (the ‘256 Patent), and 7,542,652 (the ‘652 Patent).

<sup>2</sup> U.S. Patent Nos. 6,893,612 (the ‘612 Patent) and 7,294,308 (the ‘308 Patent).

1 removable caps affixed by physicians onto sample tubes used to hold specimens collected from their  
2 patients and sent to laboratories for testing on such automated instrument systems. The Penetrable Cap  
3 Patents use a seal or seals on a collection vessel that are penetrated by a fluid transfer device.

4 Gen-Probe filed the initial complaint on October 19, 2009, and a First Amended Complaint  
5 on April 22, 2011. The Court issued its Claim Construction Order on November 15, 2011, and an  
6 Amended Claim Construction Order on November 22, 2011. On December 15, 2011, Gen-Probe  
7 served its Final Infringement Contentions on BD. Pursuant to Magistrate Judge Stormes's order, BD  
8 must serve its Final Invalidity Contentions on Gen-Probe twenty days after this Court rules on the  
9 present motion to limit the number of asserted claims. A hearing on the motion was held on February  
10 3, 2012. For the reasons set forth below, the Court **GRANTS IN PART** the motion to limit claims.

## 11 **DISCUSSION**

### 12 **I. Parties' arguments**

13 Gen-Probe's Final Infringement Contentions assert 92 claims over six patents against BD. BD  
14 argues that this vast number of claims creates an unnecessarily large burden on the court and the  
15 parties, especially on BD who will be required to spend around \$250,000 on its Final Infringement  
16 Contentions. Moreover, BD argues that a case involving such a vast number of claims will be  
17 particularly unmanageable, and might overwhelm the jury. Accordingly, consistent with the practice  
18 of some other district courts, BD asks the Court to require Gen-Probe to limit the number of its  
19 asserted claims to ten. Apart from allowing for a just and speedy resolution, BD argues that this would  
20 also significantly narrow and focus expert discovery, and would streamline the issues for the jury. As  
21 a practical effect, BD asserts that many of the claims over the six patents are virtually duplicative, and  
22 therefore unnecessary for ultimate determination of BD's liability. Moreover, BD asserts that in light  
23 of the Court's Claim Construction Order, Gen-Probe cannot in good faith maintain some of its claims.<sup>3</sup>

24 In its opposition, Gen-Probe does not challenge the Court's authority and discretion to limit  
25 the number of claims for trial. Moreover, it indicates that it is not opposed to limiting the number of  
26 claims at the appropriate time. Gen-Probe's main concern, however, is that BD is trying to gain a  
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28 <sup>3</sup> BD expressly notes, however, that it is not asking at this time that the Court enter summary judgment in its favor or otherwise rule on the merits as to those claims.

1 tactical advantage because BD has not yet served its Final Invalidity Contentions and has expressly  
2 declined to affirm that it will not raise new invalidity and obviousness defenses. Accordingly, Gen-  
3 Probe asserts that to require it to limit its claims at this time, before the Final Invalidity Contentions  
4 are served, would be premature and would deny it due process. Gen-Probe also asserts that its claims  
5 are not duplicative and still have merit, even considering the Court's Claim Construction Order.  
6 Moreover, Gen-Probe objects to BD's attempt to have the Court rule on the merits of some of the  
7 claims without a properly-supported summary judgment motion.

8 Ultimately, Gen-Probe asserts that it should be required to limit its claims only after the Final  
9 Invalidity Contentions are served. In the alternative, Gen-Probe suggests the Court require it to limit  
10 its claims to sixty at this time, and further require it to limit the number to thirty after BD's Final  
11 Invalidity Contentions are served. If the Court accepts this suggestion, Gen-Probe also seeks an order  
12 requiring BD to limit its Final Invalidity Contentions to no more than one anticipatory reference and  
13 one obviousness combination consisting of three or fewer references per asserted claim.

14 In its reply, BD asserts there is no support for Gen-Probe's proposed two-step "final" exchange  
15 of Final Infringement Contentions and Final Invalidity Contentions. Moreover, BD objects to Gen-  
16 Probe's request that it limit its anticipatory references and obviousness combinations, arguing instead  
17 that this should be done at a later time by an appropriate motion.

## 18 **II. Analysis**

19 The Federal Circuit has held that requiring a plaintiff patentee to limit its claims to a certain  
20 number from a large number of asserted claims is permissible as long as the district court leaves open  
21 the door for the assertion of additional claims upon a showing of good cause or need. *See In re Katz*  
22 *Interactive Call Processing Litig.*, 639 F.3d 1303, 1310-12 (Fed. Cir. 2011) (concluding that the  
23 district court did not abuse its discretion in limiting a plaintiff patentee to sixty-four claims from 1,975  
24 asserted claims); *see also Stamps.com Inc. v. Endicia, Inc.*, 437 Fed. App'x 897, 902-03 (Fed. Cir.  
25 2011) (concluding that the district court did not abuse its discretion in refusing to allow additional  
26 claims, having previously required plaintiff to limit its asserted claims from 629 to fifteen). As the  
27 Federal Circuit explained: "When the claimant is in the best position to narrow the dispute, allocating  
28 the production burden to the claimant will benefit the decision-making process and therefore will not

1 offend due process unless the burden allocation unfairly prejudices the claimant's opportunity to  
2 present its claim." *In re Katz*, 639 F.3d at 1311.

3 An order limiting the number of claims could come prematurely. *See id.* at 1313 n.9 ("It is also  
4 conceivable that a claim selection order could come too early in the discovery process, denying the  
5 plaintiff the opportunity to determine whether particular claims might raise separate issues of  
6 infringement or invalidity in light of the defendants' accused products and proposed defenses."). In  
7 this case, the Court is satisfied that the posture of the case and the vast number of claims asserted in  
8 Gen-Probe's Final Infringement Contentions support requiring Gen-Probe to limit the number of its  
9 claims at this time. Nonetheless, the Court is not persuaded by BD's arbitrary choice of ten claims,  
10 especially when Gen-Probe still has not had the opportunity to consider BD's Final Invalidity  
11 Contentions. Accordingly, adopting in part Gen-Probe's alternative recommendation, the Court  
12 believes that requiring Gen-Probe to limit its claims to thirty is appropriate at this time.

13 The Court is mindful that requiring Gen-Probe to conclusively limit the number of its asserted  
14 claims at this time could potentially result in its inability to assert some viable and non-duplicative  
15 claims at trial. Accordingly, to address any due process concerns, the Court will allow Gen-Probe to  
16 substitute or supplement its chosen claims after BD serves its Final Invalidity Contentions. However,  
17 as the Federal Circuit noted, because "due process is not merely a theoretical concern, the plaintiff  
18 must be able to show that it has lost some tangible right." *Id.* at 1312. Thus, if after the Final  
19 Invalidity Contentions are served, Gen-Probe wishes to substitute or supplement its claims, it would  
20 be required to identify those unasserted claims that, in its view, "raise separate legal issues from those  
21 raised by the asserted claims." *See id.* Gen-Probe can satisfy its burden by showing that those  
22 unselected claims present unique issues as to liability or damages. *See id.*

23 Finally, addressing Gen-Probe's request that the Court require BD to limit the number of its  
24 asserted anticipatory references and obviousness combinations in the Final Invalidity Contentions, the  
25 Court believes such an order would be premature at this time. Rather, after the Final Invalidity  
26 Contentions are served, if Gen-Probe believes that the number of BD's anticipatory references or  
27 obviousness combinations is unduly large or burdensome, then Gen-Probe could move the Court by  
28 an appropriate motion to require BD to limit the number of its asserted defenses.

1 **CONCLUSION**

2 BD's motion to limit the number of Gen-Probe's asserted claims is **GRANTED IN PART**.  
3 Within **21 days** of the filing of this Order, Gen-Probe shall reduce its infringement contentions to **no**  
4 **more than thirty (30) claims**. Within **20 days** of Gen-Probe's service of its reduced number of  
5 claims, BD shall serve its Final Invalidity Contentions. This Order is without prejudice to Gen-Probe  
6 requesting, by an appropriate motion, to substitute or supplement its asserted claims upon a showing  
7 of good cause or need. This Order is also without prejudice to Gen-Probe bringing at a later time a  
8 motion requesting that the Court order BD to limit the number of its asserted defenses.

9 **IT IS SO ORDERED.**

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11 Date: February 21, 2012

  
12 Honorable Roger T. Benitez  
13 United States District Judge  
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