

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY  
CAMDEN VICINAGE

SOUTHERN RESEARCH INSTITUTE,  
et al.,

Plaintiffs,

v.

ABON PHARMACEUTICALS LLC,

Defendant.

Civil No. 12-4709-JEI-KMW

**ORDER**

This matter is before the Court by way of an informal dispute between the parties regarding the scope of Defendant Abon Pharmaceuticals LLC's invalidity contentions; and the Court having reviewed the submissions and having held a telephone conference on December 23, 2013 to address this matter, finds as follows:

1. In this discovery dispute, Plaintiffs, Southern Research Institute and Genzyme Corporation, allege that on October 3, 2013, in violation of Local Patent Rule 3.7, Defendant attempted to informally amend its invalidity contentions to add U.S. Patent No. 5,106,837 ("Carson '837 patent") to its list of invalidity references. See L. Pat. R. 3.7 (providing that the "[a]mendment of any contentions, disclosures, or other documents required to be filed or exchanged pursuant to these Local Patent Rules may be made only by order of the Court upon a timely application and showing of good cause."). In support of its position, Plaintiffs argue that while Defendant referenced the Carson '837 patent in a footnote in the "Disclosure of Prior Art

References Pursuant to L. Pat. R. 3.3(a) & (b)" section of its invalidity contentions, this reference was not sufficient pursuant to L. Pat. R. 3.3 because the footnote did not state or imply that Defendant intended to rely upon same. Further, in December of 2012, Plaintiffs indicate that they expressly stated, by way of footnote, that its position was that Defendant had not asserted the Carson '837 patent and, in response to same, Defendant was silent on the issue for ten months. Plaintiffs also argue that they would be prejudiced if the Court were to find that Defendant can properly rely on the Carson '837 patent because Dr. Carson has already been disposed, they would have to seek other non-party discovery and the parties are now set to begin the expert discovery phase of litigation. Thus, Plaintiffs contend that Defendant should be precluded from relying on the Carson '837 patent as prior art in support of its anticipation arguments pursuant to 35 U.S.C. § 102 (a), (b), or (e) or its obviousness arguments under 35 U.S.C. § 103.

2. In response, Defendant avers that it is not seeking to amend its invalidity contentions because the Carson '837 patent was previously disclosed in its invalidity contentions along with its intent to rely on same. Defendant argues that it disclosed the Carson '837 patent when it identified a related prior art reference, International Publication No. 89/08658 ("Carson '658 publication"). Defendant avers that the two patent documents derive from the same patent application and have an identical technical disclosure. The only difference between the two references is that the Carson '658 publication was published from an application with the same substance filed with the World Intellectual Property Organization for patent protection in European countries while the Carson '837 patent issued from an application filed in the United States. Thus, Defendant states its invalidity analysis for the Carson '658 publication and the

Carson '837 patent are exactly the same and even provides, in many instances, parallel citations to the Carson '837 patent while discussing the Carson '658 publication in its invalidity contentions. Further, Defendant indicates that it produced both the Carson '658 publication and the Carson '837 patent with its original invalidity contentions.

3. Here, the Court finds that Defendant is not attempting to informally amend its invalidity contentions to include the Carson '837 patent as said patent was disclosed in the original invalidity contentions. While the Court recognizes that there were some deficiencies in disclosing same, it cannot be disputed that Defendant contemporaneously disclosed the Carson '837 patent in its disclosure of the Carson '658 publication, albeit by way of footnote expressly referencing the Carson '837 patent.<sup>1</sup> In this instance, the method of disclosure provides the required notice because the Carson '658 publication and the Carson '837 patent derive from the same patent application, have identical technical information and, to this end, Defendant clearly states that its analysis for both patents is the same. Indeed, Plaintiffs cannot deny notice of the Carson '837 patent because they noted, in a footnote no less, that Defendant had not asserted the Carson '837 patent. Thus, clearly Plaintiffs had some thought that Defendant was asserting the Carson '837 patent, however, Plaintiffs chose to take a contrary position. Now, Plaintiffs attempt to use its footnote as a sword to argue that Defendant's failure to respond to its footnote equates to acquiescence to its conclusion. The Court rejects this argument and finds that Defendant was not obligated to provide further response to Plaintiffs' statement. In fact, the Court is more disturbed by the notion that such a pivotal issue regarding the course of the litigation was

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<sup>1</sup>Although Defendant did not include the date of issue in the footnote, the footnote expressly cites to the actual patent which contains the date of issue and same was provided to Plaintiffs.

presented and same was not the subject of a conference between the parties or between the parties and the Court. Plainly stated, Plaintiffs' decision to proceed as though the Carson '837 patent had not been asserted was at its own peril as the Court finds that same was asserted despite the deficiencies contained in Defendant's invalidity contentions.

4. Accordingly, the only issue left for the Court to address is the resulting prejudice to Plaintiffs in light of the Court's findings. Plaintiffs argue that they have already deposed Dr. Carson, they would need to conduct additional non-party discovery, and it is prejudiced by the fact that the parties were set to commence the expert discovery phase of this case. Defendant is not convinced by Plaintiffs' need for additional discovery on the Carson '837 patent because any discovery sought by Plaintiffs uniformly sought information on the "Carson Patents" which was defined to include both the Carson '658 publication and the Carson '837 patent. The Court finds that it will permit Plaintiffs to conduct any additional discovery necessary to adequately address Defendant's assertion of the Carson '837 patent. Same is necessary because if Plaintiffs were proceeding as if the Carson '837 patent had not been asserted in the case, Plaintiffs' strategy surely differed in some manner and, therefore, Plaintiffs would be prejudiced if additional discovery were not permitted. However, the Court in no way anticipates extensive discovery in light of the fact that the patents have identical technical disclosures and Defendant concedes that its analysis with regard to both patents is identical.

Consequently, IT IS this 10<sup>th</sup> day of **January, 2014**, hereby,

**ORDERED** that Plaintiffs' request that Defendant be precluded from relying on the Carson '837 patent as prior art in

support of its anticipation arguments pursuant to 35 U.S.C. § 102 (a), (b), or (e) or its obviousness arguments under 35 U.S.C. § 103 is hereby **DENIED** in light of the Court's finding that the patent was disclosed in Defendant's original invalidity contentions; and it is further

**ORDERED** that the factual discovery deadline is hereby extended to **January 31, 2014** to enable Plaintiffs to conduct any additional discovery it deems necessary with respect to the Carson '837 patent which includes re-deposing Dr. Carson; and it is further

**ORDERED** that the Court will conduct a telephone status conference on **January 31, 2014 at 2:30 p.m.** to set the expert discovery deadlines. Counsel for Plaintiffs shall initiate the call to the Court.

s/ Karen M. Williams  
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KAREN M. WILLIAMS  
United States Magistrate Judge

cc: Hon. Joseph E. Irenas