United States District Court
Northern District of California

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

PLEXXIKON INC.,

Plaintiff,

v.

NOVARTIS PHARMACEUTICALS CORPORATION,

Defendant.

Case No.17-cv-04405-HSG (EDL)

ORDER ON DEFENDANT'S MOTION TO COMPEL DISCOVERY REGARDING DR. BRIDGES' EXPERT REPORT

Re: Dkt. No. 158

On April 29, 2019, the parties in this patent infringement case filed a joint letter brief regarding Defendant Novartis Pharmaceutical Corporation's motion to compel the production of materials considered by Plaintiff Plexxikon Inc.'s expert Dr. Alexander Bridges and also to compel his further deposition after the materials are produced. As discussed below, the Court grants Defendant's request to compel the production of certain documents relating to the synthetic routes that Dr. Bridges considered but did not ultimately use to the extent that the documents contain "facts or data," and also grants Defendant's request to compel a further deposition of Dr. Bridges on the Adesis documents recently produced and documents concerning the synthetic routes produced pursuant to this Order. Dr. Bridges' further deposition shall not exceed three hours in length. Counsel shall work together to determine the appropriate location. The May 2, 2019 expert discovery cut-off is extended for this purpose.

I. LEGAL STANDARD

Rule 26 requires a party to disclose the identity of its expert witnesses and to accompany that disclosure with a written report that contains, among other things, "the facts or data considered by the witness in forming" his opinions. Fed. R. Civ. P. 26(a)(2)(B)(ii). This requirement was amended in 2010 from the earlier formulation that required disclosure of the

"data or other information." Fed. R. Civ. P. 26, Advisory Committee Notes to the 2010 Amendment. The Advisory Committee explained that:

> The refocus of disclosure on "facts or data" is meant to limit disclosure to material of a factual nature by excluding theories or mental impressions of counsel. *At the same time, the intention is that "facts or data" be interpreted broadly to require disclosure of any material considered by the expert, from whatever source, that contains factual ingredients. The disclosure obligation extends to any facts or data "considered" by the expert in forming the opinions to be expressed*, not only those relied upon by the expert.

Id. (emphasis added).

Rule 26 protects "drafts of any report or disclosure" by an expert witness "regardless of the form in which the draft is recorded," as well as "communications between the party's attorney" and an expert witness who is required to disclose a report "regardless of the form of the communications." Fed. R. Civ. P. 26(b)(4)(B) & (C). These protections do not apply to communications between the expert and the party's attorney if the communications: (1) "relate to compensation for the expert's study or testimony;" (2) "identify facts or data that the party's attorney provided and that the expert considered in forming the opinions to be expressed;" or (3) "identify assumptions that the party's attorney provided and that the expert relied on in forming the opinions to be expressed." Fed. R. Civ. P. 26(b)(4)(C)(i)-(iii). These provisions were added in the 2010 Amendments to provide work-product protection against discovery regarding draft expert reports and most communications between expert witnesses and counsel. Fed. R. Civ. P. 26, Advisory Committee Notes to the 2010 Amendment.

II. DISCUSSION

Defendant has alleged, among other defenses, that Plaintiff's asserted patent claims are invalid for lack of enablement. This enablement requirement comes from Section 112 of the Patent Act, which provides that:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

35 U.S.C. § 112(a). In other words, "the specification must enable a person of ordinary skill in the

art to make and use the invention." Cephalon, Inc. v. Watson Pharmaceuticals, Inc., 707 F.3d 1330, 1336 (Fed. Cir. 2013). "This requirement is met when at the time of filing the application one skilled in the art, having read the specification, could practice the invention without 'undue experimentation.'" Id. (citing In re Wands, 858 F.2d 731, 736-37 (Fed. Cir. 1988)). The following factors are relevant to whether a disclosure requires undue experimentation:

> (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id. (citing Wands, 858 F.2d at 737); see also Vasudevan Software, Inc. v. MicroStrategy, Inc., 2013 WL 12174144, at *4 (N.D. Cal. Oct. 17, 2013)). Failed attempts to practice the invention are evidence of undue experimentation. Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 1372-73 (Fed. Cir. 1999).

Plaintiff disclosed Dr. Bridges as a rebuttal expert. He opined in his report that Plaintiff's patent claims are not invalid for lack of enablement. See Ex. B. To support this opinion, Dr. Bridges created synthetic routes for two compounds. Id. At his April 18, 2019 deposition, Dr. Bridges testified that he considered "at least half a dozen" different synthetic routes for making one of the compounds before settling on the synthetic routes he ultimately used. See Ex. A at 64:6-10 (Q: "How many different synthetic routes did you consider for making Compound 2?" A: "Probably at least half a dozen pretty closely related variants on the route, some of which I probably discarded on the spot."). According to Defendant, Dr. Bridges did not disclose these unused synthetic routes. Dr. Bridges also testified that he ran a total of 33 reactions, some that were unsuccessful and not disclosed in his report:

> Q: Did you run any reactions that are not reported in your expert report?
>
> A: The – there were, I think, 33 reactions run in total. The expert report clearly reports on a synthesis of the compound, and that in each case, we'll use a particular example of a reaction. And – and rather obviously, if you're going from A to B to C to D, you only will report reactions which successfully carried out each of those steps.
>
> Q: Did you actually conduct reactions that did not successfully carry out one or more of those steps?

> A: Yes.
>
> Q: Now, is that disclosed in your expert report?
>
> A: No, other than in the correction, where I said that it was the third attempt at the Suzuki which gave us the product on the road to dabrafenib.

Id. 61:7-25. Dr. Bridges confirmed that he did not report the items that did not work "as far as the experimentals are concerned." Id. at 62:19-24. He explained that "[i]t is not in any way professional practice to write up experimentals on reactions which did not work." Id. 62:24-63:1.

Defendant's motion to compel relates to two categories of records that contain evidence of Dr. Bridges' undisclosed work: (1) laboratory notebooks and records reflecting work done by Adesis, apparently a contract research organization; and (2) documentation of different synthetic routes or protocols Dr. Bridges considered for the preparation of the compounds.

As to the first category – laboratory notebooks and records reflecting Adesis's work – Plaintiff produced those materials to Defendant after Dr. Bridges' deposition. The remaining issue regarding these materials is whether Defendant is entitled to a further deposition of Dr. Bridges. Plaintiff responds that a further deposition is not appropriate because Defendant did not lay a proper foundation for obtaining further discovery on the Adesis documents. First, Plaintiff argues that Defendant knew about the Adesis materials because Dr. Bridges' report discloses that he worked with Adesis and that some of the reactions that Adesis attempted did not work, but did not ask for the Adesis documents prior to the deposition. See Ex. B, ¶ 54 (Dr. Bridges' rebuttal report) (explaining that a reaction described in the literature "proved to be impractically slow" and he made changes). Second, Plaintiff argues that Defendant did not ask Dr. Bridges at his deposition whether he considered the Adesis records.

Plaintiff does not dispute that the Adesis materials that Plaintiff provided to Defendant after the deposition are factual materials that Dr. Bridges must disclose if he considered them in drafting his expert report. While Plaintiff faults Defendant for not asking Dr. Bridges if he considered the Adesis materials in his deposition and for not asking for these materials before the deposition, Plaintiff does not deny that Dr. Bridges considered the Adesis materials. Since Adesis appears to have carried out the synthetic routes that Dr. Bridges devised, it is difficult to imagine

that Dr. Bridges did not consider the materials Adesis prepared in executing its work on this case at Dr. Bridges' direction. Indeed, in his deposition when he testified about the amount of time it took Adesis to synthesize the compounds, Dr. Bridges testified that a laboratory notebook was signed by an Adesis chemist on a particular date, which indicates that he reviewed the notebook. See Ex. A at 82:10-25. Dr. Bridges had an affirmative duty to disclose the materials under Rule 26(a)(2)(B)(ii) and, by failing to disclose them with his report, he deprived Defendant of the opportunity to effectively depose him regarding the documents. Accordingly, the Court grants Defendant's request for a follow-on deposition concerning these documents.

The second issue is the production of documents relating to the synthesis routes that Dr. Bridges considered but did not ultimately use when he tried to recreate the patented invention. Plaintiff argues that these methods do not form the basis of any opinions contained in his report, citing his deposition testimony that there was no experimentation performed on the discarded routes. See Ex. A at 64:20-65:4. Yet during his deposition, Dr. Bridges testified that he considered the rejected synthetic routes in making Compound 2. See id. at 64:6-10.

Instead, Plaintiff contends that the documents about the synthetic routes that Dr. Bridges did not use are "at most the equivalent of drafts of his expert report" or protected communications to the extent that they were shared with counsel. Jt. Ltr. at 5. In Davita Healthcare Partners, Inc. v. United States, 128 Fed. Cl. 584, 590-91 (Fed. Cl. 2016), which Plaintiff relies upon, the court held that the expert's spreadsheets, scripts, analyses, and presentations that she communicated to counsel were protected under Rule 26(b)(4)(C) because they "reflect counsel's mental impressions and result from the expert's and counsel's collaborative efforts to organize, marshal, and present data." Id. at 591. The Davita court also held that the expert's spreadsheets, graphs, presentations, and charts were protected under Rule 26(b)(4)(B), "so long as the documents were prepared by the testifying expert to be included in draft expert reports." Id.

While Plaintiff is correct in theory that "[d]ocuments regarding methods Dr. Bridges chose not to use are independently protected from disclosure to the extent they were prepared for and sent to counsel," Jt. Ltr. at 6, Plaintiff has not shown here that Dr. Bridges did so. Therefore, the unused synthetic routes that Dr. Bridges considered are not protected from disclosure under Rule

26(b)(4)(C). Plaintiff has also not established that any of these documents could be considered draft reports. For example, Plaintiff has not asserted that Dr. Bridges intended to include these documents in his report, that they were actually included in earlier versions of his report, or that the documents represent summaries and conclusions that might reasonably be expected to be included in a draft report. See Salazar v. Ryan, 2017 WL 2633522, at *2 (D. Ariz. June 19, 2017) (citing Deangelis v. Corzine, 2016 WL 93862, at *3-4 (S.D.N.Y. Jan. 7, 2016) in discussing factors courts use to determine if documents are protected from disclosure as draft expert reports).

Thus, Defendant's entitlement to documents about the unused synthetic routes boils down to whether the documents contain "facts or documents" that Dr. Bridges considered in forming his opinions or whether they merely contain "alternative analyses, testing methods, or approaches to the issues" that may be inquired about but were not mandatory to disclose. See Fed. R. Civ. P. 26, Advisory Committee Notes to the 2010 Amendment (explaining that Rules 26(b)(4)(B) and 26(b)(4)(C) "do not impede discovery about the opinions to be offered by the expert or the development, foundation, or basis of those opinions," including questions about "alternative analyses, testing methods, or approaches to the issues on which they are testifying, whether or not the expert considered them in forming the opinions expressed"); see also Republic of Ecuador v. Mackay, 742 F.3d 860, 870 (9th Cir. 2014). It is possible that documents about the unused synthetic routes fall into either category. To the extent that there are documents that contain "factual ingredients" about the unused synthetic routes that Dr. Bridges considered, Plaintiff must produce those documents to Defendant. Fed. R. Civ. P. 26, Advisory Committee Notes to the 2010 Amendment ("'facts or data' [should] be interpreted broadly to require disclosure of any material considered by the expert, from whatever source, that contains factual ingredients"). Given that Dr. Bridges will be redeposed on the Adesis documents, additional questioning on this limited universe of documents about the rejected synthetic routes will not create undue burden or expense that outweighs the likely benefit that comes from this incremental discovery.

III. CONCLUSION

The Court grants Defendant's request to compel the production of documents relating to the synthetic routes that Dr. Bridges considered but did not ultimately use to the extent that the

documents contain "facts or data," and also grants Defendant's request to compel a further deposition of Dr. Bridges on the Adesis documents recently produced and the synthetic routes documents produced pursuant to this Order. Dr. Bridges' further deposition shall not exceed three hours in length. Counsel shall work together to determine the appropriate location. The May 2, 2019 expert discovery cut-off is extended for this purpose

IT IS SO ORDERED.

Dated: May 3, 2019

ELIZABETH D. LAPORTE
United States Magistrate Judge

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Northern District of California