

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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REGENERON PHARMACEUTICALS, :
INC., :

Plaintiff, :

-v- :

MERUS B.V., :

Defendant. :
-----X

REGENERON PHARMACEUTICALS, :
INC., :

Plaintiff, :

-v- :

ABLEXIS LLC, :

Defendant. :
-----X

KATHERINE B. FORREST, District Judge:

14 Civ. 1650 (KBF)

MEMORANDUM
DECISION & ORDER

14 Civ. 1651(KBF)

On March 11, 2014, Regeneron Pharmaceuticals, Inc. (“Regeneron”) commenced this patent infringement action against Merus B.V. (“Merus”) (Case No. 14 Civ. 1650) and Ablexis LLC (“Ablexis”) (Case No. 14 Civ. 1651). On May 5, 2014, this Court held a joint initial pre-trial conference.

Regeneron has moved to compel responses to a series of contention interrogatories it has served on both defendants; defendants resist responding at this point in time but have committed to responding within a short period of time following this Court’s decision on claim construction. Specifically, Regeneron seeks to compel responses Regeneron’s contention interrogatories on infringement issues

no later than June 16, 2014, four weeks after service of Regeneron's initial infringement contentions. (Pl.'s 5/22 Ltr. at 1-2.) Defendants propose to serve their responses two weeks after the Court's ruling on claim construction.¹ (Id.)

For the reasons set forth below, Regeneron's motion is DENIED.

I. THE CONTENTION INTERROGATORIES

Regeneron seeks to compel answers to three contention interrogatories:

Interrogatory No. 8:

Describe with particularity all bases on which [Ablexis/Merus] contends that any alleged infringement of the '018 patent is not willful, and describe with specificity all facts and circumstances concerning Your awareness of the existence of the '018 Patent and the '018 Patent Family, and all communications with Regeneron regarding the '018 Patent and the '018 Patent Family, including a description of when you first became aware of the '018 Patent and '018 Patent Family, an identification of who at [Ablexis/Merus] was aware of the '018 Patent and the '018 Patent Family, a description of how You became aware of the '018 Patent and the '018 Patent Family, and a description of any actions You took in response to Your awareness.

Interrogatory No. 9:

On a claim-by-claim basis, describe with particularity all bases for any [Ablexis/Merus] contention that it is not infringing and has not infringed (either directly or indirectly, and either literally or under the doctrine of equivalents) any claim of the '018 Patent, including an identification of all Documents, facts or evidence concerning, or which allegedly support, provide a basis for, contradict, or otherwise are relevant to, [Ablexis's/Merus's] position.

Interrogatory No. 10:

Other than non-infringement and invalidity, describe with particularity all bases for any [Ablexis/Merus] contention that Regeneron should not prevail on its claim of infringement, or its request for injunctive relief, including an identification of all

¹ In its opposition to Regeneron's letter motion, Ablexis proposes that it provide responses to the contention interrogatories two weeks after the Court's claim construction or the close of fact discovery, whichever comes first. (Ablexis' 5/27 Ltr. at 3.)

Documents, facts, or evidence concerning, or which allegedly support, provide a basis for, contradict, or otherwise are relevant to, [Ablexis's/Merus's] position.

(Pl.'s 5/22 Ltr., Exs. C, D.)

II. INDIVIDUAL AND LOCAL PATENT RULES

This Court – that is, this Judge – has specific rules governing procedures in patent cases. (See Individual Practices in Civil Cases, Ex. B (“Judge Forrest’s Procedures for Patent Cases”) (“Ind. R.”), last updated May 1, 2014, available at <http://www.nysd.uscourts.gov/judge/Forrest>.) In addition, on April 5, 2013, the Southern District of New York adopted Local Patent Rules, also governing procedures in patent cases. (S.D.N.Y. Loc. Pat. R., M10-468 (LAP), available at http://www.nysd.uscourts.gov/rules/Standing_Order_In_re_Local_Patent_Rules.pdf.) These rules function as adjuncts to the Federal Rules of Civil Procedure and the district’s Local Rules governing discovery and disclosure obligations.

This Court’s rules require substantial disclosure according to specific timeframes: infringement contentions are to be served not later than 14 days after the initial pre-trial conference. See Ind. R. 1(a). Such contentions must be set forth with a particular level of specificity. See Ind. R. 1(a)(i)-(viii). Fourteen days following service of these contentions, the party asserting infringement must produce certain groups of documents. See Ind. R. 1(b).

Following these disclosures, each party opposing a claim of patent infringement must serve its invalidity contentions (if any) within 14 days – again,

with required specificity. See Ind. R. 1(c). That same party is required to produce certain categories of documents within 14 days thereafter. See Ind. R. 1(d).

The Local Patent Rules 1-9 cover essentially the same areas as this Court's Individual Rules, with different (and more generous) timeframes. See S.D.N.Y. Loc. Pat. R. Those rules also explicitly provide that the Local Civil Rules apply where not inconsistent with the Local Patent Rules. See S.D.N.Y. Loc. Pat. R. 1(a).

III. FEDERAL AND LOCAL DISCOVERY RULES

Rule 33 of the Federal Rules of Civil Procedure governs propounding and answering interrogatories. Subpart (a)(2) provides that an interrogatory is not objectionable "merely" because it asks for an opinion or contention, "but the court may order that the interrogatory need not be answered until designated discovery is complete, or until a pretrial conference or some other time." Fed. R. Civ. P. 33(a)(2).

Local Rule 33.3 provides that "[u]nless otherwise ordered by the Court," at the commencement of discovery interrogatories are limited to those seeking identifying information regarding potential witnesses, document custodians, damages, insurance policies, etc. See S.D.N.Y. Loc. R. 33.3(a). Subpart (c) of the Local Rules provides that contention interrogatories "may" be served at the "conclusion of other discovery" and "at least 30 days prior to the discovery cut-off date," unless the Court has ordered otherwise. See S.D.N.Y. Loc. R. 33.3(a).

IV. CASE LAW AND CONTENTION INTERROGATORIES

The majority of courts in this district adhere to Local Rule 33.3 and allow contention interrogatories after substantial discovery has occurred. See, e.g.,

Erchonia Corp. v. Bisson, M.D., No. 07 Civ 8696 (DLC), 2011 WL 3904600, *7-8 (S.D.N.Y. Aug. 26, 2011); Kyoei Fire & Marine Ins. Co. v. M/V Maritime Antalya, 248 F.R.D. 126, 157 (S.D.N.Y. 2007); see also 7 James Wm. Moore, et al., Moore's Federal Practice § 33.02(2)(b)(3d ed. 2007) ("The better view is that contention interrogatories are appropriate, but only after both sides have had an opportunity to conduct discovery.").

V. DISCUSSION

There is no special "patent rule" that provides for contention interrogatories at the outset of a case. There are, however, significant alternative means for the parties to obtain additional particularity regarding allegations: this Court's Individual Rules provide for virtually immediate disclosure of plaintiff's infringement contentions, followed by a document production, followed by disclosure of any invalidity contentions, followed (again) by a document production. And so on. The Local Patent Rules provide similarly.

This Court sees no reason, and the parties have proffered none that is persuasive, to vary its normal practices here. The case upon which plaintiff relies for the proposition that patent cases somehow have a special affinity for contention interrogatories, Woods v. DeAngelo Marine Exhaust, 692 F.3d 1272, 1280 (Fed. Cir. 2012), stands for the unremarkable proposition that after significant discovery has occurred, such interrogatories can narrow issues and simplify trial preparation. Indeed, in certain instances that may be true. But there, the form of contention

interrogatory was aimed at invalidity – a type of interrogatory which this Court’s Individual Rules already provide shall be answered by defendants in the near term.

Moreover, while the contention interrogatory in Woods was propounded five months after the commencement of discovery, the defendant refused to provide a substantive answer at that time. Instead, almost a year later – and the day before discovery closed and less than two months before trial – he provided specific information suggesting anticipation. Id. at 1277. Under such circumstances, the Court rather unsurprisingly found that such disclosure came too late. Id. at 1277-78. Woods does not stand for the proposition that a defendant must – at the outset of the case – draw a ring fence around himself by disclosing all of the ways in which he has not done that of which plaintiff has accused him. No rule provides for such unusual disclosure and this Court will not Order it in this case.

Indeed, the contention interrogatories as to which plaintiff here seeks answers would inappropriately require the defendants to commit to certain positions regarding non-infringement when the basis for infringement has not yet been fully clarified. This, as the old saying goes, puts the cart before the horse.

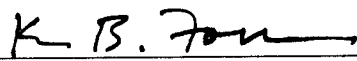
The Court appreciates that plaintiff is seeking a way to proceed efficiently and expeditiously. Close adherence to the Court’s Individual Rules, along with a near-in Markman hearing (already scheduled for September 12, 2014 at 9:00 a.m.), shall do much to achieve that. Indeed, at the initial pre-trial conference all parties agreed that a close of fact discovery in November 2014, a close of expert discovery in

January 2015, and a trial date in June 2015 are not only feasible, but desirable. The Court will work with the parties towards that end.

For the reasons set forth above, plaintiff's motion to compel responses to contention interrogatories at this stage of the case is DENIED.

SO ORDERED.

Dated: New York, New York
May 28, 2014



KATHERINE B. FORREST
United States District Judge