IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ABBVIE INC. and ABBVIE BIOTECHNOLOGY LTD	:	
v.	:	CIVIL NO. 17-cv-01065-MSG-RL
BOEHRINGER INGELHEIM INTERNATIONAL GMBH, BOEHRINGER INGELHEIM PHARMACEUTICALS, INC., and BOEHRINGER INGELHEIM FREMONT, INC.	:	

ORDER CONCERNING Doc. No. 327

The plaintiffs (collectively, "AbbVie") have moved to require more complete responses from the defendants (collectively, "Boehringer") to the plaintiffs' Interrogatories No. 22 and No. 23. Doc. No. 327 ("AV Mot."). Boehringer has responded. *See* Doc. No. 334 ("BI Opp."). I will deny AbbVie's motion.

Interrogatory No. 22 asks for the basis of Boehringer's "safe harbor" defense. AV Mot. at 3 (page references are to ECF pagination). Boehringer has

> explained that it would assert safe harbor only "[t]o the extent that Plaintiffs claim that the manufacture and clinical use of the BLA Product is an act of infringement." (D.I. 327, Ex. B at 39 (emphasis added).) In other words, if AbbVie were to assert actual infringement based on Boehringer's conduct relating to its aBLA (which it cannot do before the notice of commercial marketing), Boehringer has made clear it will assert its statutory rights provided by 35 U.S.C. § 271(e) against such a contention.

BI Opp at 4. The probative value of the information sought by the interrogatory is remote and unlikely to be material to the resolution of issues in this first phase of the litigation, which is triggered by the "artificial infringement" created by the filing of a biosimilar application with the FDA. *See Sandoz Inc. v. Amgen Inc.*, 137 S.Ct. 1664,

1670-71 (2017) (explaining the nature of "artificial infringement" and the purpose of phasing BPCIA litigation). At this juncture the potential value of the discovery is outweighed by its burdensomeness. *See* Fed. R. Civ. Pro. 26(b)(1).

> AbbVie's Interrogatory No. 23
>
> requests basic information from BI about when it first learned of the Patents-in-Suit (or the applications leading to them), including . . . "the timing thereof and the identification of the individuals who first learned of any of the Patents-in-Suit and the circumstances through which they first learned of any of the Patents-in-Suit."

AV Mot. at 6 (footnote omitted). AbbVie claims that the information is relevant to show inducement of infringement. *Id.* Encouraging, recommending, or promoting direct infringement gives rise to liability for infringement under 35 U.S.C. § 271(b). *See Takeda Pharm. U.S.A., Inc. v. W.-Ward Pharm. Corp.,* 785 F.3d 625, 631 (Fed. Cir. 2015). A theory of inducement does not make sense in the first phase of a case involving "artificial infringement," under the BPCIA. The BPCIA was designed to *encourage* the "artificial infringement" triggered by an aBLA filing, rather than penalize the filing of an aBLA by making the application – or preparatory steps – a potential source of liability for inducement of infringement. *Cf. Sandoz*, 137 S.Ct. at 1672, 1675 (the BPCIA is designed to "encourage" the applicant to obtain a declaratory judgment on the patent issues before going to market with a biosimilar and risking actual infringement claims). Boehringer has not given notice of intent to commercially market its product. AbbVie's theory is not a substantial basis for the discovery requested, at this stage of the litigation.

AbbVie also argues that it needs the discovery to show that Boehringer copied or designed around AbbVie's patents. AV Mot. at 6. The patents in suit issued in or after 2015. BI Opp. at 6-7. The patents-in-suit were not in existence "early on in the design

development phase" of the accused product. *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1352 (Fed. Cir. 2012). The likelihood that evidence exists of copying or designing around as to the satellite patents at issue in this case seems remote, at best. AbbVie has not made any showing that such evidence is likely to be found. Sifting through corporate documents to determine when Boehringer employees first became aware of the patents-in-suit promises to be an expensive and time-consuming effort. The burden of the discovery sought, as to Interrogatory No. 23, is disproportionate to whatever value it might have to the resolution of issues in this phase of the case. *See* Fed. R. Civ. Pro. 26(b)(1).

Accordingly, on this 15th day of April, 2019, it is **ORDERED** that AbbVie's motion (Doc. No. 327) is **DENIED.**

BY THE COURT:

s/Richard A. Lloret
RICHARD A. LLORET
U.S. MAGISTRATE JUDGE