

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

BIO-TECHNOLOGY GENERAL )  
CORP., )  
 )  
Plaintiff, )  
 )  
v. ) C.A. No. 02-235-SLR  
 )  
NOVO NORDISK A/S )  
and NOVO NORDISK )  
PHARMACEUTICALS, INC., )  
 )  
Defendants. )

**MEMORANDUM ORDER**

**I. INTRODUCTION**

On April 1, 2002, plaintiff Bio-Technology General Corporation ("BTG") filed the present action pursuant to 35 U.S.C. § 146 seeking review of a Decision on Preliminary Motions and Final Judgment entered on March 12, 2002 by the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (the "Board"). (D.I. 1) This court has jurisdiction over the action pursuant to 28 U.S.C. §§ 1331, 1338. Presently before the court is a request by plaintiff to take the deposition of Dr. Steven Hughes, a non-testifying expert retained by defendants. (D.I. 43) For the reasons that follow, plaintiff's request is denied.

**II. BACKGROUND**

Defendant Novo Nordisk A/S is the owner of United States

Patent No. 5,633,352 ("the '352 patent") entitled "Biosynthetic Human Grown Hormone" which issued on May 27, 1997. On February 13, 1998, plaintiff filed an application for a patent in the Patent Office entitled "Bacterially Derived Authentic Human Growth Hormone." The Board subsequently declared an interference between plaintiff's application and the '352 patent. On March 12, 2002, the Board entered a Decision on Preliminary Motions and Final Judgment adverse to plaintiff and in favor of defendant.

Plaintiff now seeks review of the Board's decision in this court pursuant to 35 U.S.C. § 146. In a related matter, on April 30, 2002, Novo Nordisk A/S and Novo Nordisk Pharmaceuticals, Inc. filed suit against BTG and Teva Pharmaceuticals USA, Inc. for infringement of the '352 patent through their activities involving Tev-Tropin™ brand human growth hormone ("hGH").

### **III. DISCUSSION**

#### **A. Fed. R. Civ. P. 26(b) (4) (B)**

In opposition to plaintiff's request, defendants argue that Dr. Hughes has been retained by them as a non-testifying expert and, therefore, his deposition by plaintiff is precluded by Rule 26(b) (4) (B) which states:

A party may, through interrogatories or by deposition, discover facts known or opinions held by an expert who has been retained or specially employed by another party in anticipation of litigation or preparation for trial and who is not expected to be called as a witness at trial, only as provided in Rule 35(b) or upon a showing of exceptional circumstances under which it is impracticable for the party seeking discovery to obtain facts or opinions on the same subject by other means.

Defendants argue that the exception under Rule 35(b) is not applicable here nor can plaintiff demonstrate "exceptional circumstances" warranting deviation from the Rule.

Plaintiff argues that Rule 26(b)(4)(B) is inapplicable to the present circumstances because it seeks to depose Dr. Hughes about opinions he developed in an unrelated case prior to being retained by defendants. (D.I. 43) In support of its argument, plaintiff asserts that the protections afforded in Rule 26(b)(4)(B) apply only to facts and opinions developed in connection with a non-testifying expert's work in the case at bar, not to facts known or opinions held by an expert prior to their work on a current case. Any rule to the contrary would allow a party to shield otherwise discoverable facts and opinions from discovery simply by retaining individuals knowledgeable about those facts.

The court agrees with plaintiff. Rule 26(b)(4)(B) is designed to promote fairness by precluding unreasonable access to an opposing party's diligent trial preparation. See Advisory Committee Notes, Fed. R. Civ. P. 26(b)(4)(B); Ager v. Jane C. Stormont Hosp. & Training School for Nurses, 622 F.2d 496, 502 (10th Cir. 1980). While cases directly on point are sparse, the majority of courts that have addressed the issue of whether Rule 26(b)(4)(B)'s protections apply solely to a non-testifying expert's work on a specific case have held that the Rule may only be used to shield an expert's opinions about the specific case

they are retained for<sup>1</sup> or any closely related litigation.<sup>2</sup>

The only case found by the court that holds that Rule 26(b)(4)(B) protects expert opinions in one case from all discovery in any subsequent litigation is Shipes v. BIC Corp.<sup>3</sup> In Shipes, the district court held that Rule 26(b)(4)(B) applies "to facts known and opinions held by an expert who was retained by a party in anticipation of any litigation." In reaching its conclusion, the court analogized Rule 26(b)(4)(B) to Rule 26(b)(3) in which the court stated: "While the caselaw may be silent on the interpretation of Rule 26(b)(4), the same phrase 'in anticipation of litigation' is used in Rule 26(b)(3) concerning work product and courts have not required work product to be case specific." Id. at 309, n.9 (quoting Fine v. Facet

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<sup>1</sup>See, e.g., Arkwright Mut. Ins. Co. v. National Union Fire Ins. Co., 148 F.R.D. 552, 556 (S.D. W. Va. 1993) (holding Rule 26(b)(4)(B)'s protections apply only to facts known and opinions held by experts in anticipation of a specific litigation.); Barkwell v. Sturm Ruger Co., Inc., 79 F.R.D. 444 (D. Alaska 1978); Sullivan v. Sturm Ruger & Co., Inc., 80 F.R.D. 489 (D. Montana 1978) ; Grinnell Corp. v. Hackett, 70 F.R.D. 326 (D.R.I. 1976).

<sup>2</sup>See, e.g., Employer's Reinsurance Corp. v. Clarendon Nat'l Ins. Co., 213 F.R.D. 422 (D. Kan. 2003) (holding Rule 26(b)(4)(B)'s protections extended to closely related subsequent litigation); In re Agent Orange Prod. Liab. Lit., 105 F.R.D. 577, 580 (C.D.N.Y. 1985) (holding Rule 26(b)(4)(B)'s protections extended to a closely related case that was part of the same multidistrict litigation); Hernsdorfer v. American Motors Corp., 96 F.R.D. 13, 15 (W.D.N.Y. 1982) (holding Rule 26(b)(4)(B)'s protections applied where the information sought was prepared for the subject litigation and all other similar litigation against the defendants).

<sup>3</sup> 154 F.R.D. 301 (M.D. Ga. 1994).

Aerospace Products Co., 133 F.R.D. 439, 445 (S.D.N.Y. 1990)).

However, the Shipes court failed to note that the court in Fine also stated that while the work product rule is not case specific, the work product rule "protects material prepared for any litigation or trial as long as **they were prepared by or for a party to the subsequent litigation.**" Fine, 133 F.R.D. at 445 (emphasis added). Thus, this court rejects the broad reading of Rule 26(b)(4)(B) embraced in Shipes and adopts the more narrow construction adopted by the majority of district courts that have addressed the issue.

Upon applying this holding to the facts of the case at bar, the court concludes that Rule 26(b)(4)(B) is inapplicable. Here, plaintiff seeks to depose Dr. Hughes about facts and opinions he developed for previous litigation involving Genentech, who is not a party to this suit. Furthermore, the previous litigation did not involve any of the current defendants. Although Rule 26(b)(4)(B) shields Dr. Hughes from any discovery related to facts or opinions he has developed related to the present case, it does not shield him from discovery concerning opinions he had concerning previous unrelated lawsuits. Therefore, the standard for determining whether or not plaintiff may depose Dr. Hughes is Fed. R. Civ. P. 45(c)(3)(B)(ii), not Rule 26(b)(4)(B).

**B. Fed. R. Civ. P. 45(c)(3)(B)(ii)**

Federal Rule of Civil Procedure 45(c)(3)(B)(ii) provides:

If a subpoena . . . requires disclosure of an

unretained expert's opinion or information not describing specific events or occurrences in dispute and resulting from the expert's study made not at the request of any party . . . . the court may, to protect a person subject to or affected by the subpoena, quash or modify the subpoena or, if the party in whose behalf the subpoena is issued shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship and assures that the person to whom the subpoena is addressed will be reasonably compensated, the Court may order appearance or production only upon specified conditions.

This subparagraph of Rule 45 was added during the 1991 Amendments to recognize "[a] growing problem . . . [of] the use of subpoenas to compel the giving of evidence and information by unretained experts," and to "provide appropriate protection for the intellectual property of the non-party witnesses . . . ." Schering Corp. v. Amgen Inc., 1998 U.S. Dist. LEXIS 13452, \*6 (D. Del. 1998). Accordingly, an unretained expert has the right "to withhold their expertise, at least unless the party seeking it makes the kind of showing required for a conditional denial of a motion to quash as provided for in the final sentence of subparagraph (c) (3) (B) . . . ." Id. at \*7.

The last sentence of subparagraph (c) (3) (B) requires a party seeking discovery to (1) show a substantial need for the testimony or material that cannot be otherwise met without undue hardship and (2) assure that the person to whom the subpoena is addressed will be reasonably compensated.

In determining whether a court should exercise its discretion to allow compelled testimony of an unretained expert,

this court has examined the following factors: (1) the degree to which the expert is being called because of his knowledge of facts relevant to the case rather than in order to give opinion testimony; (2) the difference between testifying to a previously formed or expressed opinion and forming a new one; (3) the possibility that, for other reasons, the witness is a unique expert; (4) the extent to which the calling party is able to show the unlikelihood that any comparable witness will willingly testify; and (5) the degree to which the witness is able to show that he has been oppressed by having to continually testify. Id. at \*8-9 (quoting Kaufman v. Edelstein, 539 F.2d 811, 822 (2d Cir. 1976)).

Applying these factors to the case at bar, the court concludes that plaintiff has not demonstrated a substantial need for the testimony or material that cannot be otherwise met without undue hardship. Based on plaintiff's representation of the topics about which it seeks to depose Dr. Hughes, the court finds that Dr. Hughes does not possess any unique facts relevant to the case or subject matter that plaintiff cannot obtain from other retained experts.

#### **IV. CONCLUSION**

For the reasons stated, plaintiff's request to take the deposition of Dr. Steven Hughes is denied.

Sue L. Robinson  
United States District Judge