IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INTEGRA LIFESCIENCES CORP., INTEGRA LIFESCIENCES SALES LLC, CONFLUENT SURGICAL, INC., and INCEPT LLC,	)	
Plaintiffs,	)	
v.	)	Civil Action No. 15-819-LPS-CJB
HYPERBRANCH MEDICAL TECHNOLOGY, INC.,	)	
Defendant.	)	

MEMORANDUM ORDER

At Wilmington this **27th day of September, 2017**.

The Court has considered both Plaintiffs Integra LifeSciences Corp., Integra LifeSciences Sales LLC, Confluent Surgical, Inc. and Incept LLC's (collectively, "Plaintiffs") and Defendant HyperBranch Medical Technology, Inc.'s ("HyperBranch" or "Defendant") letter submissions, (D.I. 299, 302, 303, 305, 306), relating to Defendant's pending discovery dispute motion regarding 20 of its Requests for Admission ("RFAs") (the "Motion"), (D.I. 297), as well as the parties' arguments made during oral argument on July 12, 2017, (D.I. 327 (hereinafter, "Tr.")). The RFAs fall into six general categories, which the Court will address in turn.

I. STANDARD OF REVIEW

Under Federal Rule of Civil Procedure 36, a party may serve "a written request to admit . . . the truth of any matters . . . relating to . . . facts, the application of law to fact, or opinions about either[.]" Fed. R. Civ. P. 36(a). The purpose of Rule 36 is to facilitate proof with respect to the issues that cannot be eliminated from the case, and to narrow the issues for trial.

Tulip Computs., Int'l, B.V. v. Dell Comput. Corp., 210 F.R.D. 100, 107 (D. Del. 2002); Fed. R. Civ. P. 36 advisory committee's note to 1970 amendment.[1]

II. DISCUSSION

A. RFAs Nos. 23-30

With respect to the dispute regarding Defendant's RFAs Nos. 23-30, Defendant's Motion is GRANTED-IN-PART and DENIED-IN-PART. These RFAs seek admissions regarding features of certain chemical structures from the prior art, namely whether those structures read on certain limitations found in the claims at issue here. (D.I. 299 at 1; *id.*, ex. A at 5-6)

Plaintiffs first object on the basis that each of these RFAs "is a thinly veiled attempt to gain admissions that certain prior art teaches certain limitations" and that the RFAs are therefore improperly directed to legal conclusions. (D.I. 302 at 1; *see also* Tr. at 56-57) The Court finds that Plaintiffs' objection in this regard is not justified.

This Court has explained that RFAs that "seek legal conclusions are not allowed" (e.g., a request for a party to admit whether a patent is valid or is infringed). *Tulip Computs.*, 210 F.R.D. at 108; *see also Fulhorst v. United Techs. Auto., Inc.*, No. CIV. A. 96-577-JJF, 1997 WL 873548, at *2-3 (D. Del. Nov. 17, 1997). However, admittedly, "[t]he line between a request to admit a pure legal conclusion and the application of law to fact can be murky because the application of law to fact necessarily incorporates an admission as to what the law is." *Aventure Commc'ns*

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[1] The party objecting to an RFA (here, Plaintiffs) bears the burden of persuasion. Fed. R. Civ. P. 36(a)(6) ("Unless the court finds an objection justified, it must order that an answer be served."); *see also Shapiro v. Am.'s Credit Union*, No. 12-cv-5237 RBL, 2012 WL 5410660, at *2 (W.D. Wash. Nov. 6, 2012) ("The burden of persuasion lies on the party objecting to the requests for admission.").

Tech., L.L.C. v. MCI Commc'ns Servs., Inc., No. 5:07-cv-04095-JEG-RAW, 2008 WL 4280371, at *1 (N.D. Iowa Sept. 16, 2008).

In support of their objection, Plaintiffs rely heavily on *Pittway Corp. v. Fyrnetics, Inc.*, No. 91 C 2978, 1992 WL 12564602 (N.D. Ill. June 26, 1992). (D.I. 302 at 1; Tr. at 57, 62-63, 72) In that patent infringement action, the district court denied the defendant's motion to compel responses to RFAs that requested two types of admissions: (1) that certain references were "prior art" to the asserted patent under 35 U.S.C. §§ 102 and/or 103; and (2) that various elements in the prior art read on claim limitations. 1992 WL 12564602, at *11-12, *15. The *Pittway Corp.* Court concluded that both categories of requests improperly sought to obtain an admission of an ultimate legal conclusion in the case, rather than admissions of fact or of the application of law to fact. *Id.* at *12, *15. As to the first category, the court explained that "[s]everal admissions that certain art is prior art under 35 U.S.C. § 102 and/or 103 could be taken in combination or alone to show that the patent is invalid . . . . That is a legal conclusion which is improper to [r]equest in [RFAs]." *Id.* at *12. And with respect to the second category, the court concluded that "in combination [these RFAs] sought to obtain an admission of the ultimate legal conclusion in the case, rather than admissions of fact or of the application of law to fact." *Id.* at *15 (internal quotation marks and citation omitted).

Plaintiffs do not cite to the many cases following *Pittway* that have drawn a distinction between these two types of RFAs, and that have found RFAs falling into the latter category to address factual issues in dispute.[2] As one Court described the appropriate questions to ask in

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[2] *See, e.g., Jovanovich v. Redden Marine Supply, Inc.*, No. C10-924-RSM, 2011 WL 4459171, at *1 (W.D. Wash. Sept. 26, 2011) (rejecting plaintiffs' objections to RFAs requiring the plaintiff to apply its understanding of the claim elements of the asserted patent to

confronting the issue of whether an RFA improperly seeks admission of a legal conclusion: "does a given RFA address a disputed fact in the case and would an affirmative response reduce the burden on a jury at trial?" *Apple Inc. v. Samsung Elecs. Co.*, No. C 11-cv-1846 LHK (PSG), 2012 WL 952254, at *4 (N.D. Cal. Mar. 20, 2012).

In the Court's view, the answer to both of these questions would be "yes" as to the RFAs at issue here. Whether a prior art reference anticipates the claim limitations of a patentee's invention is a question of fact. *See Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 975 (Fed. Cir. 2010); *see also Apple*, 2012 WL 952254, at *4 ("These RFAs address factual issues in dispute, particularly whether Apple's asserted design patents are anticipated by prior art patents."). Obviousness is a question of law, but it is based on underlying factual determinations as to matters including the differences between the claims and the prior art. *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013). The RFAs at issue here seek admission as to whether certain chemical structures from asserted prior art include particular features found in the

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actual prior art fishing net configurations, and finding that the RFAs did not improperly seek a legal conclusion); *McKesson Info. Sols. LLC v. Epic Sys. Corp.*, CIVIL CASE NO. 1:06-CV-2965-JTC, 2009 WL 10636314, at *2 (N.D. Ga. Feb. 10, 2009) (concluding that RFAs asking plaintiff to admit that a system is prior art to the asserted patent improperly asks for a legal conclusion, while RFAs asking plaintiffs to admit that the prior art system had certain capabilities that matched certain terms in the patent-in-suit were properly directed to a question of fact); *Synventive Molding Sols., Inc. v. Husky Injection Molding Sys., Inc.*, 262 F.R.D. 365, 373-74 (D. Ver. 2009) (granting motion to compel responses to RFAs directed to whether prior art references disclose certain claim elements); *Sorensen v. Black & Decker Corp.*, Civil No. 06cv1572-BTM (CAB), 2007 WL 1615046, at *2 (S.D. Cal. June 1, 2007) (explaining that "[w]hat a reference discloses is a question of fact" and ruling that defendant may renew RFAs after claim construction, applying appropriately construed claims to the references and requesting that the plaintiff admit or deny that the element is disclosed by the reference); *Phillip M. Adams & Assocs., L.L.C. v. Dell, Inc.*, Civil No. 1:05-CV-64 TS, 2007 WL 128962, at *2 (D. Utah Jan. 11, 2007) (same).

relevant claim language. To be sure, such admissions could indeed ultimately be used to help prove up an ultimate legal issue in the case, but that does not change the fact that they themselves are directed to factual questions. Additionally, the answers to RFAs like these would surely narrow the issues for trial. *See, e.g.*, *McKesson Info. Sols. LLC v. Epic Sys. Corp.*, CIVIL CASE NO. 1:06-CV-2965-JTC, 2009 WL 10636314, at *1-2 (N.D. Ga. Feb. 10, 2009) (RFAs that ask for admissions regarding the claim elements present in a prior art system enable defendants to focus their invalidity cases on the claim elements whose obviousness is truly in dispute).

With the Court concluding that Plaintiffs' above-referenced objection to RFAs Nos. 23-30 is not well-taken, that leaves the issue of whether Plaintiffs should otherwise be compelled to provide more complete responses to these RFAs. Currently, beyond their objection set out above, Plaintiffs deny these requests as written, asserting in response to each RFA that "no meaningful response is possible in the absence of specific definitions and additional information[.]" (D.I. 299, ex. B at 7-15)

Whether "no meaningful response" is possible as to these RFAs is not an easy issue to decipher. On their face, the RFAs implicate technical and complicated subject matter. But the Court can at least reach the following conclusions regarding this issue.

First, the Court is not persuaded by Plaintiffs' argument that they cannot respond to at least some of these RFAs because those RFAs refer to a chemical formula depicting polymer structures having "n" groups, and because Defendant failed to provide values for "n" in the formulas. (D.I. 302 at 1-2) With "n" undefined, Plaintiffs assert, "n" could be zero or one, and in such circumstances the structure would not depict a polymer. (*Id.* at 1; Tr. at 60, 65) This argument misses the mark, in the Court's view, because Defendant has *defined* the relevant

chemical structures at issue *to be polymers*. For example, RFA No. 23 asks Plaintiffs to "[a]dmit that Rhee SG-PEG includes at least two electrophilic functional groups." (D.I. 299, ex. A at 5) The Definition corresponding to this RFA states that "[t]he term 'Rhee SG-PEG' refers to a *four arm polyethylene glycol polymer*" with a particular chemical structure. (*Id.* at 2 (emphasis added)) Plaintiffs assert that they cannot respond to RFA No. 23 because Defendant failed to provide values for "n" with respect to the chemical structure recited therein, and that it therefore may not depict a "'polyethylene glycol polymer'" because "n" could be zero or one. (D.I. 302 at 1) But with the very Definition in Defendant's RFAs telling us that Rhee SG-PEG is, in fact, "a four-arm polyethylene glycol *polymer*," Plaintiffs' response is not valid. With the structure defined to be a polymer, that necessarily means that "n" has a value that allows for the structure to be a polymer, and thus "n" is not going to be zero or one. (*See* Tr. at 43 ("You don't get to a polymer unless you have more than [n] equals one."); *see also id.* at 42-46)[3] Accordingly, with respect to any of RFA Nos. 23-30 as to which Plaintiffs' sole basis for refusing to answer is that Defendant did not provide a value for "n," Plaintiffs shall provide a complete and sufficient response to any such RFA.[4]

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[3] The Court's conclusion in this regard is underscored by the prosecution history relating to claim 15 in United States Patent No. 8,535,705, which recites a method of making a hydrogel wherein "at least one of the precursors is selected to further comprise a chemical group having [a] formula" that included "n." (D.I. 1, ex. F, col. 32:11-13) In response to the Examiner's objection that "n" was not defined, the patentees explained that "'n' in this context denotes a polymer, with the group inside the parentheses being repeated n-times. This terminology is well-established in the polymer arts." (D.I. 305, ex. M at 8)

[4] It appears that at least RFA Nos. 23, 25, 29 and 30 fall into this category. (D.I. 302 at 1-2)

Second, with respect to RFA No. 24, the record indicates that Plaintiffs are capable of providing a further substantive response. (D.I. 299, ex. B at 9) RFA No. 24 asks Plaintiffs to admit that a particular chemical structure "includes two chemically hydrolytically degradable ester bonds per electrophilic functional group[,]" (*id.*, ex. A at 5), and Plaintiffs' response denied the request "as stated" on the basis that "sufficient information is not available" to enable them to further admit or deny the request, (*id.*, ex. B at 9). Yet in their letter brief and at oral argument, Plaintiffs set out an actual substantive reason for their denial. (D.I. 302 at 2; *see also* Tr. at 66-67) Since it now appears that Plaintiffs are able to provide a complete and substantive response to RFA No. 24, Plaintiffs shall do so.

Finally, with respect to the remainder of these RFAs, the Court is not in a position to fairly assess the parties' additional respective arguments. (D.I. 299 at 2-3; D.I. 302 at 2) These are technical issues pertaining to chemical structures, and essentially all the Court has to go on is attorney argument in the form of the parties' letters and the oral argument transcript. The parties do not attach expert declarations in support of their respective positions as to why these RFAs can or cannot be substantively responded to.

Defendant is not left without a remedy, however, with respect to these remaining RFAs. Should Defendant "prove the truth of what was not admitted at trial[, it may] then move the Court for its reasonable expenses incurred in making that proof, including reasonable attorney's fees." *Salazar v. Bocanegra*, No. 12cv0053 MV/LAM, 2012 WL 12903998, at *1 (D.N.M. July 27, 2012); *see also Nat'l Semiconductor Corp. v. Ramtron Int'l Corp.*, 265 F. Supp. 2d 71, 74 (D.D.C. 2003) ("While the Federal Rules . . . forc[e] one party to pay when she refuses to stipulate [to a fact set out in an RFA] and her opponent is put to her proof, they certainly cannot

be construed as requiring a court to examine into the reason why a party will not stipulate."); Fed. R. Civ. P. 37(c)(2); (Tr. at 56).

B. RFA No. 34

With respect to the dispute regarding Defendant's RFA No. 34, Defendant's Motion is DENIED. This RFA asks Plaintiffs to admit that "none of the applications for the Patents-in-Suit expressly disclosed the use of 'polyethyleneimine,' 'PEI,' or 'Lupasol' prior to the filing of continuation-in-part Application No. 12/156,085 on May 29, 2008." (D.I. 299, ex. A at 7) Plaintiffs objected on the ground that the RFA is not limited to a singular fact that can be admitted or denied, but instead requires answers about multiple facts (e.g., multiple terms and multiple patent applications). (*Id.*, ex. B at 17; *see also* D.I. 302 at 2; Tr. at 72-73 (Plaintiffs' counsel noting that this RFA "is directed to three different terms across six patents")) The Court agrees with Plaintiffs' position.[5]

An RFA is required to be simple and direct, and "limited to singular relevant facts." *Bovarie v. Schwarzenegger*, Civil No. 08cv1661 LAB (NLS), 2011 WL 719206, at *6 (S.D. Cal. Feb. 22, 2011) (internal quotation marks and citations omitted). The parties' Scheduling Order permits "a maximum of 50 requests for admission . . . for each side[,]" (D.I. 173 at ¶ 8(c)), and

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[5] In their letter, Plaintiffs also objected on another basis—that this RFA is improperly "directed to the legal issue of the proper priority date for certain claims." (D.I. 302 at 3) However, Plaintiffs did not clearly make out this objection in response to the RFA. (D.I. 299, ex. B at 17) Even had they done so, the Court would not agree that Plaintiffs were justified in objecting on this basis. The United States Court of Appeals for the Federal Circuit has explained that "[d]etermination of a priority date is purely a question of law *if the facts underlying that determination are undisputed.*" *Bradford Co. v. Conteyor N. Am., Inc.*, 603 F.3d 1262, 1268 (Fed. Cir. 2010) (emphasis added). RFA No. 34 does not require Plaintiffs to admit that particular patent claims have particular priority dates, but instead seeks admission of multiple facts that may be relevant to that issue.

this Court's Local Rule 26.1(a) dictates that "[e]ach subpart of a[] . . . request shall be counted as a separate . . . request." D. Del. LR 26.1(a). RFA No. 34 exceeds the boundaries set out for this case and by the Local Rules in requiring an assessment of multiple factual inquiries (e.g., Does Application X expressly disclose polyethyleneimine? Does Application X expressly disclose PEI? Does Application X expressly disclose Lupasol? Does Application Y expressly disclose polyethyleneimine?, etc.). Plaintiffs' objection is therefore well-taken. *See, e.g.*, *Bovarie*, 2011 WL 719206, at *7 (denying motion to compel response to an RFA where defendant correctly objected to the RFA on the basis that it, *inter alia*, was a compound RFA); *Tulip Computs.*, 210 F.R.D. at 108 (denying defendant's request for more adequate responses to its RFAs where those RFAs, *inter alia*, contained "compound statements").[6]

C. RFAs Nos. 36-37

With respect to the dispute regarding Defendant's RFAs Nos. 36-37, Defendant's Motion is GRANTED. These RFAs ask Plaintiffs to admit that they are "aware" that "DuraSeal Xact" and "DuraSeal" (Plaintiffs' sealant products) have been "used" off-label in cranial and

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[6] Despite the objection, Plaintiffs went on to "deny this request as stated[,]" (D.I. 299, ex. B at 17), and they have argued that this response was appropriate and fulfilled their obligations, (D.I. 302 at 3). With respect to the substance of Plaintiffs' response beyond its objection, the Court notes that had it not agreed with that objection, it would have gone on to find that Plaintiffs did not satisfy their obligations under Rule 36. Plaintiffs did not simply deny the request, but instead denied the request "as stated" with no further substantive explanation as to what, specifically, was wrong with the request. (D.I. 299, ex. B at 17) Rule 36(a)(4) requires that if an RFA is not admitted, the responding party's "answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it." Fed. R. Civ. P. 36(a)(4). Plaintiffs' vague response fails to articulate *why* it is that the RFA is denied *as written*. As other courts have explained, "[t]he denial of a [RFA] 'as written' without further explanation is evasive. . . . and is tantamount to a failure to answer." *Janko v. Fresh Market, Inc.*, Civil Action No. 13-648-RLB, 2015 WL 4714928, at *2 (M.D. La. Aug. 5, 2015) (internal quotation marks and citations omitted) (citing cases).

spinal applications, respectively. (D.I. 299, ex. A at 7) In their responsive letter and at oral argument, Plaintiffs did not really press the objections that they made in their responses (i.e., that the RFAs do not include only one specific statement that can be admitted or denied and that they are irrelevant to the case). (*Id.*, ex. B at 18-19) Instead, they raised a new assertion—that the term "aware" is ambiguous. Plaintiffs assert that "aware" could be directed to Plaintiffs' actual direct knowledge, Plaintiffs' knowledge of third-person hearsay statements indicating that such uses have occurred, or Plaintiffs' knowledge of facts from which one might conclude that off-label uses have likely occurred. (D.I. 302 at 3; Tr. at 73-74 (Plaintiffs' counsel asserting that the ambiguous meaning of "'aware' is a really big issue here"))

The Court is not persuaded by this objection for at least three reasons. First, if it was truly a "really big issue," then Plaintiffs would have surely made an objection based on the purported ambiguity of "aware" in their responses . . . but they did not. Second, if the word "aware" is so ambiguous and vague, presumably Plaintiffs themselves would not have used the term throughout their responses . . . but they did. (*See, e.g.*, D.I. 299, ex. B at 18 ("Plaintiffs . . . are currently unaware of any off-label promotion"); *id.* at 23 ("Plaintiffs are aware of many reasons, why some former customers of DuraSeal may currently no longer purchase DuraSeal")) And third, even were there a good reason to say that the meaning of "aware" was somewhat inexact, the responding party "should supply its own definition and admit or deny, or qualify its admission or denial to make it accurate and responsive." *Lauter v. Anoufrieva*, Case No. CV 07-6811 JVS(JC), 2009 WL 10672595, at *2 (C.D. Cal. Mar. 30, 2009).

Moreover, Plaintiffs' only substantive "response" to these RFAs was to state that "they are currently unaware of any off-label *promotion*" of these products. (D.I. 299, ex. B at 18-19

(emphasis added)) These RFAs, however, do not seek admissions regarding off-label *promotion* of the products—they seek admissions regarding off-label *use*. These responses therefore violate Rule 36(a)(4)'s requirement that a denial "must fairly respond to the *substance of the matter*[.]" Fed. R. Civ. P. 36(a)(4) (emphasis added). As it now stands, Defendant has no substantive responses to the RFAs that it actually propounded.

For these reasons, Plaintiffs shall provide complete and sufficient responses to RFAs Nos. 36-37. And since Plaintiffs have set forth three admittedly plausible definitions of "aware" in their briefing here (set out above), Plaintiffs should respond to the RFAs by assuming that "aware" can mean any of those three things in this context.

D. RFAs Nos. 38-39

With respect to the dispute regarding Defendant's RFAs Nos. 38-39, Defendant's Motion is GRANTED. These RFAs ask the Plaintiffs to admit that an amide linkage and a carbonate linkage, respectively, is hydrolytically biodegradable. (D.I. 299, ex. A at 7) Plaintiffs asserted in response, *inter alia*, that they could not provide substantive responses to these requests "in the absence of specific definitions" as to the "multiple compounds and/or multiple conditions" at issue therein. (*Id.*, ex. B at 19-21) In their letter brief, Plaintiffs further explain that a review by their expert Dr. Mays confirmed that the RFAs "could not be admitted because the requests provided no definition of 'hydrolytically biodegradable' and further provided no chemical conditions under which the amide or carbonate linkages are placed" as "an amide linkage may react differently when placed under different chemical conditions." (D.I. 302 at 3; *see also* D.I. 306 at 2)

The Court is not persuaded by Plaintiffs' response. As for Dr. Mays' assertion that the Defendant failed to provide a specific definition of "hydrolytically biodegradable," the Court disagrees. Defendant's RFAs instructed that "Plaintiffs shall answer the following requests for admission *as they relate to the Asserted Claims*[.]" (D.I. 299, ex. A at 5 (emphasis added)) As Defendant points out, (D.I. 299 at 4), the asserted patents that contain the asserted claims themselves state that "[t]he polymers preferably also have a *hydrolytically biodegradable* portion or linkage, for example an ester, carbonate, or an amide linkage." (*See, e.g.*, *id.*, ex. H, col. 6:44-47 (emphasis added))[7] And as for Plaintiffs' further assertion that "an amide linkage may react differently when placed under different chemical conditions[,]" (D.I. 302 at 3), to the extent that the issue provides a basis for qualifying an answer, Plaintiffs are permitted to do so pursuant to Federal Rule of Civil Procedure 36(a)(4).

For these reasons, Plaintiffs shall provide complete and sufficient responses to RFAs Nos. 38 and 39.

E. RFA No. 43

With respect to the dispute regarding Defendant's RFA No. 43, Defendant's Motion is DENIED. This RFA asks Plaintiffs to admit that a particular reference "is prior art to every asserted claim of the Patents-in-Suit." (D.I. 299, ex. A at 8) Plaintiffs objected on the ground that the RFA is not limited to a singular fact that can be admitted or denied, but instead is directed to multiple facts in requiring an admission or denial with respect to multiple asserted

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[7] Indeed, citing this very language, Dr. Mays' own expert report (previously submitted in conjunction with the preliminary injunction proceedings) explains that one of the asserted patents "teaches that amide linkages, such as those created by reacting the preferred NHS ester of a first precursor with a primary amine of a second precursor is a hydrolytically biodegradable linkage." (D.I. 10, ex. 13 at ¶ 454)

claims. (*Id.*, ex. B at 23) Despite the objection, Plaintiffs went on to "deny this request as written." (*Id.*)

The Court agrees that Plaintiffs are justified in objecting to the RFA, as there is not one single asserted claim at issue in this lawsuit—there are multiple asserted claims. Because RFA No. 43 requests a response regarding multiple claims across multiple patents, it is not directed to ascertaining a singular fact and is therefore improper, as explained above.[8]

F. RFAs Nos. 44-49

With respect to the dispute regarding Defendant's RFAs No. 44-49, Defendant's Motion is GRANTED. These RFAs ask Plaintiffs to admit that (1) "some former customers" of DuraSeal no longer purchase the product for reasons not related to HyperBranch's alleged infringement; (2) "some former customers of DuraSeal" purchased fibrin glue as an alternative or replacement for DuraSeal; (3) "not all former customers of DuraSeal have purchased [accused product] Adherus"; (4) "Integra has lost sales of DuraSeal for reasons not related to HyperBranch's alleged infringement"; (5) "Integra has lost sales of DuraSeal because the price

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[8] In their letter, Plaintiffs also objected on the basis that this RFA is improperly "directed to the purely legal argument [of] whether a reference is prior art to a claim at issue." (D.I. 302 at 3) However, Plaintiffs did not make this objection in response to the RFA. (D.I. 299, ex. B at 23) Had they done so, the Court would agree that Plaintiffs were further justified in objecting on this basis. The issue of whether a reference is prior art is a legal question, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 578 F. Supp. 2d 698, 709-10 (D. Del. 2008), and, as set out above with respect to the dispute regarding RFAs Nos. 23-30, courts have denied motions to compel responses to RFAs that ask the plaintiff to admit that a system or reference is prior art to an asserted patent, *see, e.g.*, *McKesson Info. Sols. LLC*, 2009 WL 10636314, at *2 (explaining that an RFA asking the plaintiff to admit that "'the HealthMagic system is prior art to the '898 patent'. . . asks for a legal conclusion and is, therefore, improper").

offered for DuraSeal was too high"; and (6) "Integra has lost sales of DuraSeal because its applicator is prone to clogging." (D.I. 299, ex. A at 8-9)

Plaintiffs objected to each of these RFAs on the grounds that the requests are "vague, incomplete and [are] not limited to only one specific statement which can be admitted or denied as [they are] directed to multiple former customers." (*Id.*, ex. B at 23-27) The Court does not find Plaintiffs' objections justifiable here, for a few reasons.

First, the Court does not agree with Plaintiffs' suggestion that no response is required because the RFAs are directed to "multiple former customers." The Court views these requests, to the contrary, as appropriately directed to singular factual inquiries. An RFA that asks Plaintiffs to admit, for example, that some (i.e., more than one) former customers of DuraSeal bought fibrin glue instead of DuraSeal is not necessarily asking Plaintiffs to individually discuss the purchasing patterns of a long list of specific customers. Plaintiffs might need to (or want to) reference specific customers in the process of providing a complete, fact-based answer to this kind of an RFA. But the question itself does not directly flout the spirit or letter of the Local Rule against subparts.

Second, in their letter and at oral argument, Plaintiffs asserted, for example, that the inherent ambiguity of words such as "some" and "too high" in these requests leave the RFAs too ambiguous to answer. (D.I. 302 at 4; Tr. at 76-77) That objection is baseless. "Some" and "too high" are not difficult concepts. If words like these are off limits for purposes of propounding RFAs, soon there will be no words left to use. The meanings of these RFAs are not so unclear as to prevent Plaintiffs from responding. *See Susko v. City of Weirton*, Civil Action No. 5:09-CV-1, 2010 WL 1881933, at *14 (N.D.W.V. May 7, 2010) (finding plaintiff's objection to the RFA on

the basis that the word "raised" is unclear to be "unfounded" and requiring plaintiff to provide a complete response to said RFA); *cf. Marchand v. Mercy Med. Ctr.*, 22 F.3d 933, 936 (9th Cir. 1994) (noting that parties responding to RFAs "should focus on the goal of the [Federal] Rules [of Civil Procedure], full and efficient discovery, not evasion and word play"). Even were there some justifiable basis to say that the meaning of these terms in the RFAs was inexact (and there really isn't), the responding party "should supply its own definition and admit or deny, or qualify its admission or denial to make it accurate and responsive." *Lauter*, 2009 WL 10672595, at *2.

As for Plaintiffs' substantive answers to RFAs Nos. 44-49, Plaintiffs provided the same blanket response for each:

> Plaintiffs deny this request as written as there is insufficient information provided to admit or deny this request. Plaintiffs are aware of former customers of DuraSeal that are no longer purchasing any product in the synthetic dural sealant market (e.g., former customers who have closed down, retired or otherwise stopped utilizing synthetic dural sealants). To the extent former DuraSeal customers are still in the market to purchase and use synthetic dural sealants like DuraSeal, Plaintiffs are aware of many reasons, why some former customers of DuraSeal may currently no longer purchase DuraSeal, including HyperBranch's offering products into the market for synthetic dural sealants, such as the Adherus AutoSpray Dural Sealant and Adherus AutoSpray Extended Tip (ET) Dural Sealants as the only other FDA approved synthetic dural sealant in the United States.

(D.I. 299, ex. B at 23-27) As previously noted, the Rules make clear that Plaintiffs had to respond with specificity to the substance of the matter. *See* Fed. R. Civ. P. 36(a)(4) (requiring that a "denial must fairly respond to the substance of the matter" and that a partial denial or qualified response must "specify the part admitted and qualify or deny the rest"); Fed. R. Civ. P. 37(a)(4) ("[A]n evasive or incomplete disclosure, answer, or response must be treated as a failure

to disclose, answer, or respond."). In the Court's view, Plaintiffs' one-size-fits-all response to the six RFAs at issue here does not fulfill this obligation, as it does not sufficiently respond to the substance of each unique RFA.[9]

For instance, RFA No. 45 asks for an admission or denial that some former customers of DuraSeal purchased fibrin glue instead of DuraSeal, yet nothing in Plaintiffs' response even makes reference to the term "fibrin glue." (*See* Tr. at 53-54) [redacted] (D.I. 299, ex. D at 214-15) Turning to RFA No. 46, though it asks Plaintiffs to admit that not all former customers of DuraSeal have purchased Adherus, Plaintiffs' answer does not directly respond to that particular question. (*Id.*, ex. B at 24-25) Instead, Plaintiffs state that they are aware of former DuraSeal customers *that are no longer purchasing any* synthetic dural sealant. Is that an admission that Plaintiffs are aware that these customers (or at least some of them) did not ever purchase Adherus? By evading the actual words used in Defendant's question, Plaintiffs avoid providing a responsible answer to the question that Defendant *actually asked.* Plaintiffs' responses to the other RFAs in this group similarly fail to forthrightly admit or deny (or provide an appropriate qualification as to) the applicable request.

For these reasons, Plaintiffs must provide complete and sufficient responses to RFAs Nos. 44-49.

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[9] It is a good indicator that a party has not sufficiently responded to RFAs when the six RFAs ask six *different* questions and yet the responding party provides *the same* answer to all six questions.

III. CONCLUSION

For the reasons stated above, the Court ORDERS that, by no later than **October 9, 2017**, Plaintiffs shall respond to Defendant's RFAs Nos. 24, 36, 37, 38, 39, 44, 45, 46, 47, 48 and 49, as well as those remaining disputed RFAs (of the group including RFA Nos. 23 and 25-30) for which Plaintiffs' sole objection is that Defendant failed to provide a value for "n."

Because this Memorandum Order may contain confidential information, it has been released under seal, pending review by the parties to allow them to submit a single, jointly proposed, redacted version (if necessary) of the order. Any such redacted version shall be submitted no later than **October 2, 2017**, for review by the Court, along with a detailed explanation as to why disclosure of any proposed redacted material would "work a clearly defined and serious injury to the party seeking closure." *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir. 1994) (internal quotation marks and citation omitted). The Court will subsequently issue a publicly-available version of its Memorandum Order.

Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE