

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BAYER AG, :
 :
 Plaintiff, :
 :
 v. : Civil Action No. 95-8-JJF
 :
 SONY ELECTRONICS, INC., et al., :
 :
 Defendants. :

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Attorney for Plaintiff.

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Attorney for Defendant.

MEMORANDUM OPINION

December 20, 2001
Wilmington, Delaware

FARNAN, DISTRICT JUDGE

Presently before the Court in this patent infringement action are letters to the Court regarding discovery disputes. (D.I. 409, 410, 411, 414, 415, 416, 418, 419, 420). For the reasons discussed, the Court will grant in part and deny in part the requests.

BACKGROUND

Plaintiff Bayer AG ("Bayer") filed this action against Defendant Sony Electronics, Inc. ("SEL") for infringement of United States Patent No. 4,290,799 ("the '799 Patent") through the sale of recording media containing certain metal powders. (D.I. 1). Subsequently, Bayer filed a second action against Sony Corporation, Inc. ("Sony") and Defendant Dowa Mining Co. ("Dowa") (collectively, "Defendants"), which was eventually consolidated with the first action for actively inducing SEL's infringement of the '799 Patent. The instant disputes arose during discovery in the consolidated action.

STANDARD OF REVIEW

Under the Federal Rules of Civil Procedure 26(b)(1), the parties "may obtain discovery regarding any matter ... that is relevant to the claim or defense of any party.... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence." Fed.R.Civ.P. 26(b)(1).

DISCUSSION

I. Dr. Schroeder

Defendants request that the Court order Bayer to make Dr. Schroeder available for deposition prior to trial if Bayer intends to call him live at trial. (D.I. 418 at 2). Bayer objects to this request because Dr. Schroeder, who is no longer a Bayer employee, has already been deposed for seventy-six hours over thirteen days. (D.I. 415 at 1). The Court is persuaded by Defendants' submissions that Dr. Schroeder's previous depositions are now stale and that because new issues have arisen another deposition is required to adequately prepare for Dr. Schroeder's live testimony. However, the Court recognizes the burden of producing Dr. Schroeder for another deposition as well as at trial. Therefore, the Court will grant this request only if Bayer intends to call Dr. Schroeder as a live witness.

II. Infringement of Claims 3 and 5

In the Proposed Pretrial Order Bayer asserts infringement of Claims 3 and 5 of the '799 Patent. (D.I. 412 at Ex. 15). Defendants object to the assertion of infringement of Claims 3 and 5 after this extended litigation, particularly on the eve of trial. (D.I. 418 at 4). In reply, Bayer contends that because discovery with regard to Claims 3 and 5 was not forthcoming from Defendants there was a corresponding delay in the assertion of infringement of Claims 3 and 5. (D.I. 419 at 2). The Court is

persuaded that Bayer did not have sufficient discovery to assert infringement of Claims 3 and 5 until recently, particularly in light of the Court's recent ruling on discovery. Therefore, the Court will not preclude Bayer from asserting the infringement of Claims 3 and 5 of the '799 Patent, literally or by the doctrine of equivalents, at trial.

III. Doctrine of Equivalents For Claims 1 and 2

In the Proposed Pretrial Order Bayer asserts the right to rely on the doctrine of equivalents with respect to Claims 1 and 2. (D.I. 412). Defendants object because Bayer has not previously asserted the doctrine of equivalents with respect to Claims 1 and 2. (D.I. 412 at Ex. 15). In reply, Bayer contends that they never limited themselves to literal infringement by always asserting "at least claims 1 and 2 of the patent in suit are literally infringed." (D.I. 415 at 4). However, in its letter dated December 10, 2001, Bayer asserts that it does not "believe it needs to rely on the doctrine of equivalents." (D.I. 415 at 5). With the understanding that Bayer does not intend to assert the doctrine of equivalents with respect to Claims 1 and 2 at trial, the Court will grant Defendant's application to preclude these claims.

IV. Preliminary Work Documents Underlying Experimental Work Relied On By Professor O'Grady and Dr. Buxbaum

The parties have agreed to exchange all preliminary work documents underlying the experimental work relied on by their experts. (D.I. 416 at 6; D.I. 420). Accordingly, the Court will enter an order reflecting the agreement.

V. Bayer's October 23, 2001 Letter

Bayer requests the production of (1) Dowa records showing chemical analysis and structure determinations of Dowa metal powder, (2) Sony's chemical analysis and structure determinations of Dowa metal powders, (3) Sales and profit records of Sony, and (4) Dowa's process specifications for each of the metal powders sold to Sony and used in metal particle tapes sold in the United States. (D.I. 409 at 3-4). In reviewing this request, the Court finds that the documents are relevant to the subject matter of this litigation and therefore should be produced.

Additionally, Bayer requests that Sony Japan's Investments be produced. (D.I. 409 at 4). Bayer contends that the information is relevant to a laches defense. (D.I. 409 at 4). Defendants failed to respond to this request. (D.I. 410; D.I. 411). Accordingly, the Court presumes that laches will not be a principal defense presented by Sony at trial, and therefore will deny the request.

An appropriate Order will be entered.

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O R D E R

At Wilmington this 20 day of December 2001, for the reasons set forth in the Memorandum Opinion issued this date, IT IS HEREBY ORDERED that:

- A. If Bayer intends to call Dr. Schroeder live at trial, Bayer must produce Dr. Schroeder for deposition. The deposition shall be limited to three (3) hours of direct testimony, with the total time testifying not to exceed six (6) hours. The deposition must take place no later than ninety-six (96) hours before trial. If Bayer does not intend to call Dr. Schroeder live at trial, the request is denied.
- B. Bayer may not assert infringement of Claims 1 and 2 of the '799 Patent by the doctrine of equivalents at trial.

- C. Bayer may assert infringement of Claims 3 and 5 of the '799 Patent, literally or by the doctrine of equivalents, at trial.
- D. Dowo shall produce all its preliminary work documents concerning its underlying efforts to reproduce Bayer's patent examples and the prior art.
- E. Bayer shall produce all its preliminary work documents concerning the relevant experimental work performed by Dr. Buxbaum.
- F. Bayer's request to compel production of (1) Dowo Records Showing Chemical Analysis And Structure Determinations Of Dowo Metal Powder, (2) Sony's Chemical Analysis and Structure Determinations Of Dowo Metal Powders, (3) Sales And Profit Records Of Sony, and (4) Dowo's Process Specifications For Each Of The Metal Powders Sold To Sony And Used In Metal Particle Tapes Sold In The United States is **GRANTED**.
- G. Bayer's request to compel production of Sony Japan's Investments is **DENIED**.

JOSEPH J. FARNAN, JR.
UNITED STATES DISTRICT JUDGE