

When Disclosure Isn't Disclosure

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By: Ted Mathias

A patent challenger identified a witness as a person with relevant knowledge in Rule 26(a) disclosures and interrogatory responses, and the patentee deposed the witness. Surely the witness can testify at trial, right? The answer: not as to the challenger's prior use anticipation defense.

Judge Wolson's recent decision in *Med-El Elektromedizinische Gerate Ges.M.B.H. v. Advanced Bionics, LLC*, No. 1:18-cv-1530-JDW (D. Del. Oct. 30, 2023), is a good reminder that adequate disclosure requires specificity. The patent challenger sought to have two witnesses testify at trial in support of its prior use defense. One witness was deposed after having been listed in initial disclosures as having information about the operation of and supporting materials for the accused products. Both witnesses were identified in an interrogatory response as knowledgeable about the functionality of the challenger's software that has been available since 2012. But as the court observed, the alleged priority date in the case is ten years earlier, in 2002. The "use" in the prior use defense, naturally, would have to be prior to the asserted patent's priority date.

The court cited case law for the proposition that discovery disclosures are insufficient under Rule 26 if they "are not facially apparent and require the drawing of further inferences." It held that the initial disclosures and interrogatory response did not meet that standard. Nor did invalidity contentions citing documents referencing the two witnesses.

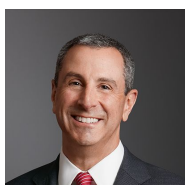
Finally, the court reviewed the *Pennypack* factors and determined that exclusion was warranted even in the absence of bad faith or willfulness given the surprise and prejudice to the patentee, trial scheduled in a month, and the case's tight time limits. This “extreme sanction” is a good reminder to revisit discovery disclosures well before the close of fact discovery with an eye toward the evidence needed for trial.

Without knowing that MED-EL might rely on Ms. Franz’s knowledge of prior use of the ’308 Patent’s technology, AB would have no reason to probe that knowledge during her deposition. Therefore, the mere fact that AB deposed Ms. Franz as to other topics did not cure MED-EL’s omission.

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