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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

GENENTECH, INC., et al.,)	
)	
Plaintiff(s),)	No. C08-4909 SI (BZ)
)	
v.)	
)	SIXTH DISCOVERY ORDER
SANOFI-AVENTIS DEUTSCHLAND)	
GMBH, et al.,)	
)	
Defendant(s).)	
_____)	

Following a telephone hearing at which all parties were represented by counsel, **IT IS HEREBY ORDERED** as follows:

1. Sanofi-Aventis Deutschland GmbH ("Sanofi") requests detailed discovery of Rituxan® sales in order to prove the commercial success of its patented process. Ordinarily, a "patentee asserts that commercial success supports its contention of nonobviousness" Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1392 (Fed. Cir. 1988). The patentee must prove a legally and factually sufficient connection, or nexus, "between the proven success and the patented invention" Id. The purpose of introducing evidence of commercial success is to prove that

1 "the commercial success was of the patented invention itself."
2 Id. at 1394. (emphasis added).

3 In this case, Sanofi seeks detailed sales information of
4 the infringing product in order to prove non-obviousness of
5 the patented process. Sanofi has not persuaded me that
6 discovery of sales information of an infringing product is
7 relevant to prove the non-obviousness and commercial success
8 of the patented process. Commercial success of the allegedly
9 infringing product could be based on any number of factors,
10 other than infringement. In any event, defendant apparently
11 has information that Genentech has \$2 billion annual sales of
12 Rituxan® in the United States, evidence of the product's
13 commercial success. Defendant has not articulated how the
14 other information it seeks, such as profit margins, is
15 relevant to obviousness.

16 Tech Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353
17 (Fed. Cir. 1999) on which defendant relies, is
18 distinguishable. First, that case did not address discovery.
19 Second, the plaintiff in that case had already established
20 infringement. Contrary to Sanofi's assertion, Tech Air does
21 not stand for the general proposition that in a bifurcated
22 trial, sales information of an infringing product is
23 discoverable prior to the damages phase. Defendant's motion
24 to compel discovery of further sales information is **DENIED**.

25 2. Sanofi further requests discovery of all products
26 that employ the HCMV enhancer to prove the unexpected results
27 of their patented process. As an initial matter, this request
28 suffers from the same defect as Sanofi's request for detailed

1 sales information of the infringing product. In the ordinary
2 case, a "patent challenger makes a prima facie showing of
3 obviousness" and "the owner may rebut [this] based on
4 unexpected results by demonstrating that the claimed invention
5 exhibits some superior property or advantage that a person of
6 ordinary skill in the relevant art would have found surprising
7 or unexpected." Proctor & Gambel Co. v. Teva Pharmaceuticals
8 USA, Inc., 566 F.3d 989 (Fed. Cir. 2009) (emphasis added)
9 (internal citations omitted).

10 Sanofi has not persuaded me that any unexpected results
11 plaintiffs experienced with any of their products is relevant
12 to the issue of obviousness. In any event, to resolve this
13 dispute, Genentech has agreed to produce the requested
14 discovery for Rituxan®, the accused product. If Sanofi cannot
15 show that Genentech experienced unexpected results with
16 Rituxan®, it is hard to see how it can succeed by showing
17 unexpected results with products not accused of infringement.
18 If Sanofi finds evidence of unexpected results in the Rituxan®
19 discovery and believes it still needs evidence of other
20 products, it may renew its motion at that time. Given the
21 cost of producing the requested information, calculated at
22 almost a million dollars, and its questionable relevancy, this
23 request is **DENIED** as premature. See FRCP 26(b)(2)(c)(iii).

24 Genentech shall produce all documents concerning its use
25 of an HCMV enhancer in its production of Rituxan® by

26 ///


27 ///

28 ///

1 5:00 p.m. on December 1, 2009.

2 Dated: November 19, 2009

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Bernard Zimmerman
United States Magistrate Judge

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