

United States District Court
For the Northern District of California

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

LIFE TECHNOLOGIES CORPORATION,)	Case No.: 11-CV-1582-PSG
)	
Plaintiff,)	ORDER RE EXCHANGE OF
v.)	OPENING EXPERT WITNESS
)	REPORTS ON WRITTEN
PACIFIC BIOSCIENCES OF CALIFORNIA,)	DESCRIPTION
INC.,)	
)	
Defendant.)	

In this patent interference suit pursuant to 35 U.S.C. 146, Plaintiff Life Technologies Corporation’s (“Life”) requests that both parties be required to serve opening, rather than rebuttal, expert witness reports regarding the inadequacy of the written description of the patent and patent application that each challenges. The parties’ stipulated scheduling order requires opening reports on all issues on which a party bears the burden of proof. Life argues that its proposal mirrors assignment of the burden in the interference proceeding giving rise to this suit, and that under the Federal Circuit’s recent decision in *Streck v. Research & Diagnostic Systems, Inc.*,¹ the *de novo* standard of review preserves the burden assignment here.

Defendant Pacific Biosciences of California, Inc. (“PacBio”) opposes the request. PacBio argues that regardless of the *de novo* review standard that may apply upon Life’s introduction of new evidence, only PacBio claims survived the written description challenges before the Patent

¹ 659 F.3d 1186 (Fed. Cir. 2011).

1 Office’s Board of Patent Appeals and Interferences. Thus, this suit is not a “do-over” but an
2 attempt to set aside a determination by the Board. According to PacBio, this puts the burden of
3 proof on all written description issues in this suit squarely on Life.

4 On January 20, 2012, the parties appeared telephonically for hearing on shortened time.
5 Having considered the arguments of counsel,

6 IT IS HEREBY ORDERED that Life’s request is GRANTED.

7 *Streck* distinguishes between an appeal from an adverse decision and a new civil
8 proceeding subject to *de novo* determination.² In the former, the burden is properly assigned to the
9 party pursuing the appeal. But in the latter, the burdens remain as they were in the administrative
10 body. In *Streck*, the lone issue was priority, and so just as the junior party before the Board
11 properly bore the burden so too did it in the district court action. Here, the parties have agreed to
12 bifurcate priority issues, and so the only issue in this phase is the adequacy of the written
13 description of the patent and patent application at issue. Because each party bore the burden before
14 the Board of demonstrating the inadequacy of the written description it was attacking,³ each will
15 do so here if live testimony is admitted at trial such that the *de novo* standard is triggered.⁴ PacBio
16 is correct that no such testimony has yet been admitted to trigger the *de novo* standard. But the
17 likelihood of admitting such testimony is such that, as a matter of case management, the better
18 course is to sequence the exchange of expert reports under the presumption that it will be. Perhaps
19 the court’s presumption will prove wrong, but the tight schedule of this case and the need to
20
21
22

23
24 ² *Id.* at 1191.

25 ³ *See McMullin v. Carroll*, 153 Fed. Appx. 738, 740 (Fed. Cir. 2005) (holding that “the Board
26 properly stated that Carroll bore the burden of proof to show that McMullin’s specification did not
27 reasonably convey to the artisan that McMullin had possession of the subject matter of the claims
28 at issue in the interference”).

⁴ *Cf. Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1347 (holding that “the admission of live
testimony on all matters before the Board in a section 146 action, as in this case, makes a factfinder
of the district court and requires a *de novo* trial”).

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

manage discovery in a practical way takes priority.

IT IS SO ORDERED.

Dated: 1/20/2012

_____

PAUL S. GREWAL
United States Magistrate Judge