

ORAL ORDER: Having reviewed numerous recent filings, IT IS HEREBY ORDERED that: (1) Plaintiffs' motion to exclude evidence from Drs. Rotella and Scheidt (D.I. 162) is DENIED. The Court adopts and applies the undisputed legal standards as set out by Plaintiffs. (See D.I. 163 at 2) The Court is not persuaded by Plaintiffs' contentions that the challenged testimony impermissibly invades the province of the factfinder (which in this case is the Court) or expresses improper opinions about state of mind. Instead, it appears that the testimony will be helpful to the Court in understanding background facts (e.g., industry norms, reasonable expectations, etc.) it may need to consider in applying the agreed-upon test for determining whether a poster displayed at a chemistry society meeting is a printed publication. Plaintiffs' criticisms appear to go to the weight and not admissibility of the challenged evidence; (2) Plaintiffs' motion to strike certain opinions from Drs. Rotella and Scheidt (D.I. 168) is DENIED. Plaintiffs have failed to persuade the Court that Dr. Scheidt offers opinions inconsistent with Defendants' inequitable conduct pleading, which is primarily focused on ACS Poster 205 but also includes allegations about a larger pattern of deceptive conduct. (See, e.g., D.I. 175 at 1) (citing pleadings) Defendants will be held to their representation that they will not argue "the 10 secondary references... constitute wholly independent grounds of inequitable conduct." (D.I. 175 at 2) Plaintiffs have further failed to persuade the Court that the experts' redirect deposition testimony improperly disclosed new opinions, as opposed to properly addressed issues to which Plaintiffs had already opened the door and/or reasonably elaborated on opinions the experts had timely disclosed in their reports and/or provided permissible (possibly new) fact testimony. In any event, to cure any potential unfair prejudice to Plaintiffs, they will be permitted to file a brief supplemental report of their expert, Dr. MacMillan (see D.I. 169 at 2 n.2), provided that Dr. MacMillan will then be offered for a brief additional deposition. The Court will not require Drs. Rotella and Scheidt to be produced for additional depositions as Plaintiffs already had an opportunity to examine them, including on re-cross examination at depositions; (3) Defendants' motion to strike two supplemental expert reports (D.I. 170) is DENIED. While it would have been preferable had Plaintiffs disclosed their intent to rely on purported statements from an ACS representative by timely supplementing their interrogatory responses, and while the weight to be accorded to those statements (if any) is likely to be reduced given the manner in which Plaintiffs seek to admit them (i.e., the type of hearsay reasonably relied on by chemistry experts), the Court is not persuaded by Defendants' arguments for striking the supplemental reports. To the extent the Pennypack factors apply, the Court finds that the prejudice and surprise to Defendants can be cured by permitting Defendants' experts to serve short, supplemental expert reports directed solely to the new evidence challenged by Defendants' motion - and the Court hereby grants Defendants leave to do; and (4) with respect to the parties' disputes about the forthcoming trial, the parties shall meet and confer (it appears they have not yet done so) and, no later than Monday, November 23, SUBMIT a joint status report, providing their specific proposal(s) as to how the Court should proceed (including with respect to the additional discovery ordered today) and describing their positions on any disputes, taking account of the guidance provided below. The Court intends to proceed, as scheduled, in December, with as much of the remote bench trial as possible, possibly to include the entirety of that trial. On the submissions to date, the Court is not persuaded by Plaintiffs that its fact witnesses are unavailable to testify live (remotely) or that, if they are unavailable, that admission of

their deposition testimony is not a fair substitute. Both sides will have a full and fair opportunity to present their positions (before, during, and after trial) as to whether any non-appearance of any witnesses live at trial is due to issues relating to the merits of the inequitable conduct allegations, travel restrictions arising from the global pandemic, and/or other factors. IT IS FURTHER ORDERED that the Court will hold a teleconference with the parties on Wednesday, November 25 beginning at 11:00 a.m. to discuss their proposal(s) and any disputes in the joint status report and how this case should now proceed. The parties and any interested member of the public shall use the following call-in information: 877-336-1829 and using the access code 1408971. ORDERED by Judge Leonard P. Stark on 11/18/20. (ntl) (Entered: 11/18/2020) As of November 19, 2020, PACER did not contain a publicly available document associated with this docket entry. The text of the docket entry is shown above.

Adverio Pharma GmbH et al v. MSN Laboratories Private Limited et al
1-18-cv-00073 (DDE), 11/18/2020, docket entry 191