

United States District Court
Middle District of Florida
Jacksonville Division

**DEPUY SYNTHES PRODUCTS, INC.,
& DEPUY SYNTHES SALES, INC.,**

Plaintiffs,

v.

NO. 3:18-cv-1342-J-20PDB

**VETERINARY ORTHOPEDIC IMPLANTS, INC.,
& [REDACTED],**

Defendants.

Order

DePuy Synthes Products, Inc., and DePuy Synthes Sales, Inc. (collectively, “Synthes”), sues Veterinary Orthopedic Implants, Inc. (“VOI”), and a manufacturer for alleged infringement of a patent for a “Tibial Plateau Leveling Osteotomy Plate”—a surgical plate for a ruptured ligament in a dog or other animal.¹ Doc. 92-1 ¶¶ 12, 13. Synthes alleges VOI’s plates infringe “each limitation of at least claim 12” of the patent.² Doc. 92-1 ¶ 37.

¹The name of the manufacturer is in the amended complaint, Doc. 92-1, which is under seal pending an interlocutory appeal. *See* Docs. 156, 159. Allegations summarized here are also in the original complaint, which is on the public docket.

²Claim 12 is: “A bone plate for securing two tibial bone segments as part of a tibial leveling ostetomy procedure for an animal, the bone plate comprising: a distal portion comprising an elongated shaft having disposed therein a plurality of screw holes each designed to accept a screw; and a proximal portion comprising at least three screw holes[.]” Doc. 92-1 ¶ 43. Claim 12 also describes the screw holes. Doc. 92-1 ¶ 43.

In a related case, Synthes and VOI settled a claim for design patent infringement. *See DePuy Synthes Prods., Inc., and Depuy Synthes Sales, Inc. v. Veterinary Orthopedic Implants, Inc.*, No. 3:19-cv-801-J-20PDB.

Before the Court is VOI's motion to compel responses to its fourth set of requests for production. Doc. 173. Synthes opposes the motion. Doc. 185.

In an answer raising affirmative and other defenses, VOI raises an invalidity defense, claiming the patent is invalid for failure to comply with 35 U.S.C. §§ 102 and 103. Doc. 137 at 17. In a counterclaim seeking a declaration of invalidity, VOI alleges the patent is invalid because it was anticipated or made obvious by at least six prior art references.³ Doc. 136 at 20.

The parties agreed that, by May 15, 2019, VOI would produce known prior art. Doc. 59-1 at 2. The Court set September 12, 2019, as the deadline for VOI to respond “to interrogatories setting forth invalidity contentions on a claim by claim basis” and to “produce any additional prior art not previously identified or produced on the May 15, 2019, disclosure.” Doc. 87 at 3.

VOI served its fourth set of requests for production on June 20, 2019. Doc. 173-1 at 11. The motion to compel involves requests 77 through 128, which seek information about plates Synthes featured in a 2004 catalog. Doc. 173 at 14.⁴ Request 77 asks for “Engineering drawings and design files pertaining to the following Synthes products: Lateral Tibial Head Buttress Plate—DCP (item nos. beginning with 240.4 and 240.5).” Doc. 173 at 3. Request 78 asks for “Documents sufficient to

³A person is entitled to a patent unless “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,” or “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(a)–(b) (2002). A “patent may not be obtained though the invention is not identically disclosed or described ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) (2004).

⁴Citations to page numbers in the motion to compel are to the numbers “stamped” through CM/ECF.

indicate the date of first sale in the United States of the following Synthes products: Lateral Tibial Head Buttress Plate—DCP[.]” Doc. 173 at 3. The other requests are the same, except they concern different plates or plate groupings. Doc. 173 at 5–13.

Synthes responded on July 22, 2019. Doc. 173-3 at 24. For each request at issue, Synthes provided the same response: “In addition to and in express reliance on its General Objections, ... Synthes objects to this Request as not relevant to any party’s claim or defense and not proportional to the needs of the case.” Doc. 173 at 4–13. Synthes’s general objections—more than 20 of them—were in its responses to VOI’s first set of requests for production. Doc. 173-3 at 3. In one, Synthes contended the requests are “vague, ambiguous, overly broad, unduly burdensome, unreasonably cumulative, overlapping, or duplicative.” Doc. 173-2 at 4.

Counsel tried to resolve the dispute without court intervention. *See* Doc. 173-4 (July 25, 2019, letter to Synthes’s counsel); Doc. 173-5 (August 13, 2019, letter to VOI’s counsel); Doc. 173-6 (August 13, 2019, letter to Synthes’s counsel); Doc. 173-7 (transcript of August 26, 2019, “meet and confer”); Doc. 173-8 (email exchanges between counsel from July 25, 2019, to January 28, 2020); Doc. 173-9 (email exchanges between counsel from November 28, 2019, to January 3, 2020); Doc. 173-10 (email exchanges between counsel from February 5, 2020, to February 28, 2020); Doc. 173 (motion filed on April 9, 2020).

For the requests at issue, Synthes has produced price lists from 2003 to 2005 but nothing more, even after VOI agreed to accept representative documents from before April 2005. Doc. 173 at 16; *see* Doc. 173-8 at 4 (“[VOI] would be willing to accept your production of representative engineering drawings from prior to April 2005. [VOI is] also willing to accept your production of representative documents relating to sales prior to April 2005 if Depuy is unable to identify first sales.”). Unlike Synthes, non-parties—including Acumed, AmerisourceBergen, New Generation Devices, Smith & Nephew, Stryker, and Zimmer—promptly provided documents relating to prior art during the same timeframe. Doc. 173 at 25.

A party “may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense.” Fed. R. Civ. P. 26(b)(1). Relevance is “construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case.” *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 430, 351 (1978). “Information within this scope of discovery need not be admissible in evidence to be discoverable.” Fed. R. Civ. P. 26(b)(1).

Besides relevancy, discovery must be “proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties’ relative access to relevant information, the parties’ resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.” *Id.* Importantly here, the proportionality requirement is not “intended to permit the opposing party to refuse discovery simply by making a boilerplate objection that it is not proportional,” and a party seeking discovery does not have a burden of addressing all the factors. Fed. R. Civ. P. 26, Advisory Comm. Notes (2015 Amend.).

For each item or category in a request for production, “the response must ... state with specificity the grounds for objecting to the request, including the reasons.” Fed. R. Civ. P. 34(b)(2)(B). An objection also “must state whether any responsive materials are being withheld,” and an “objection to part of a request must specify the part and permit inspection of the rest.” Fed. R. Civ. P. 34(b)(2)(C). An “evasive or incomplete disclosure, answer, or response must be treated as a failure to disclose, answer, or respond.” Fed. R. Civ. P. 34(a)(4). If a party fails to respond or provides evasive or incomplete responses to requests for production, the opposing party may move for an order compelling disclosure or discovery. Fed. R. Civ. P. 37(a).

The Middle District of Florida Discovery Handbook—non-binding but persuasive—explains,

Objections. Attorneys should not make objections solely to avoid producing documents that are relevant to the case or that are otherwise necessary to discover or understand ... the issues. Absent compelling circumstances, failure to assert an objection to a request for production within the time allowed for responding constitutes a waiver and will preclude a party from asserting the objection in response to a motion to compel. Objections to requests for production should be specific, not generalized, and should be in compliance with the provisions of Rule 34(b), Federal Rules of Civil Procedure. Objections to portions of a document request do not excuse the responding party from producing those documents to which there is no objection. Specific objections should be matched to specific requests. General or blanket objections should be used only when they apply to every request. Boilerplate objections such as “the request is overly broad, unduly burdensome, and outside the scope of permissible discovery” are insufficient without a full, fair explanation particular to the facts of the case.

Handbook § III.A.3, 6.

Here, in responding to the requests for production, Synthes improperly asserted boilerplate objections, failed to explain its reasons for objecting to the requests beyond the boilerplate objections, and failed to state whether it was withholding responsive documents. In responding to the motion to compel, Synthes ignores this fundamental problem, choosing instead to zero in on two of the objections tucked in the many general objections: “unreasonably cumulative” and “unduly burdensome.” *See generally* Doc. 173-2 at 4; Doc. 185 at 4. Synthes’s responses to the requests equate to evasive or incomplete responses that “must” be treated as a failure to respond. *See* Fed. R. Civ. P. 37(a)(4) (quoted). The motion to compel—as reasonably limited by VOI’s compromise—is granted on that basis alone.

Alternatively, the motion to compel—again, as reasonably limited by VOI’s compromise—is granted considering Synthes’s belated rationales for limiting its disclosures. Under the broad construction of relevance, *see Oppenheimer*, 437 U.S. at 351, the documents relate to the anticipation and obviousness defenses and to the counterclaim; the design files and drawings bear on prior art and the first-sale documents bear on the on-sale bar. The drawing and design files, as VOI contends,

“presumably include details regarding the curvature of the proximal portion of the plates, which is directly relevant to the issue of whether orthopedic plates sold, offered for sale, or featured in printed publications by Synthes in the 2003–2005 timeframe anticipate and/or render obvious at least independent claims 1, 19, and 20.” Doc. 173 at 18.

Synthes’s argument that the discovery is cumulative fails. That Synthes may argue immateriality based on cumulativeness does not mean VOI cannot discover information to attempt to argue otherwise.

Synthes’s argument that VOI waited too long to move to compel—well after the deadline to file the invalidity contentions—fails. Counsel’s persistent attempts to compromise to avoid court intervention in the face of an unyielding insistence that VOI lay a foundation satisfactory to Synthes will not be held against VOI.

Synthes’s argument that the burden of “tracking down” the information is undue fails, particularly considering that VOI has agreed to accept representative documents only. Like the objections Synthes made in response to the requests, the affidavit Synthes provides in response to the motion to compel is too general to be meaningful. What the words, “large universe,” “extremely burdensome,” “time consuming,” and “considerable effort” mean to either the affiant or to Synthes—an apparent “multi-billion-dollar subsidiary of Johnson & Johnson”—is unexplained and not evident. *See* Doc. 185-4. Moreover, the affiant appears to attest to the burden of producing all responsive documents, not just representative documents VOI has agreed to accept as a compromise.⁵ *See* Doc. 173 at 22 n.2; Doc. 185-4.

⁵The affiant states, “Moreover, to the extent that certain of the requested documents are only maintained in paper form at Depuy Synthes’s premises, such materials are currently inaccessible because of stay-at-home orders in place as a result of the COVID-19 pandemic.” Doc. 185-4 ¶ 4. From this statement, whether any responsive document actually is in paper form and inaccessible is unclear. In any event,

The motion to compel—as reasonably limited by VOI’s compromise—is **granted**. Synthes must produce responsive representative documents by **July 31, 2020**.

Ordered in Jacksonville, Florida, on June 30, 2020.



PATRICIA D. BARKSDALE
United States Magistrate Judge

c: Counsel of Record

that counsel will work cooperatively and creatively in addressing barriers caused by the global pandemic is presumed.