

ORAL ORDER: The Court, having reviewed Plaintiffs' discovery dispute motion, in which they seek to strike certain prior art references from Defendants' invalidity contentions ("Motion"), (D.I. 154), the briefing related thereto, (D.I. 155; D.I. 157), and having heard oral argument, (D.I. 162 (hereinafter "Tr.")), HEREBY ORDERS that Plaintiffs' Motion is DENIED. Although originally at issue was Plaintiffs' request to strike 18 prior art references and certain Section 112 defenses from Defendants' March 27, 2020 supplemental invalidity contentions, (D.I. 155 at 1-2), the parties were later able to narrow the dispute to just two prior art references (Temgesic 2008 Label and Myers III), (D.I. 157 at 1-2; Tr. at 5-6). As to the inclusion of those two references, the Court does not agree with Plaintiffs that Defendants must demonstrate "good cause" for the amendment, (D.I. 155 at 2), because there is not a "good cause" requirement in the Scheduling Order regarding the amendment of contentions and there is not otherwise a deadline in the Scheduling Order clearly stating that Defendants' contentions were required to be finally amended by a date earlier than March 27, 2020. See *ICU Med., Inc. v. RyMed Techs., Inc.*, 674 F. Supp. 2d 574, 577 (D. Del. 2009); see also D.I. 156 at 1-2. Of course, the amendment was still required to be timely pursuant to Fed. R. Civ. P. 26. But even assuming that Defendants' attempt to introduce these references in their March 27 supplemental invalidity contentions was untimely, in the Court's view, the Pennypack factors would not require striking the references. Key here are the "possibility of curing the prejudice" and "likelihood of the disruption of trial" factors, which militate strongly enough in Defendants' favor that they win the day for Defendants. With regard to curing the prejudice, it does not appear that Plaintiffs need any further discovery on the references, and it seems that Plaintiffs could address the references with their experts without much additional cost or time lost. And as to disruption of trial, this cure would, as Plaintiffs acknowledged, be able to be accomplished without any impact on the trial date. (Tr. at 14) Although the two references do not strike the Court as particularly crucial to Defendants' case, it seems wrong to strike them under these circumstances. Ordered by Judge Christopher J. Burke on 6/17/2020. (dlb) (Entered: 06/17/2020)

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