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July 16, 2021

Via ECF

Honorable Allison D. Burroughs
United States District Court Judge
John Joseph Moakley U.S. Courthouse
1 Courthouse Way
Boston, Massachusetts 02210

Re: *Teva Pharmaceuticals International GmbH et al v. Eli Lilly and Company*,
Civil Action No. 1:18-cv-12029-ADB

Dear Judge Burroughs:

We, along with Finnegan LLP, represent Eli Lilly and Company (“Lilly”) in the above-captioned matter. We write in response to the July 7, 2021 letter filed by Teva Pharmaceuticals International GmbH and Teva Pharmaceuticals USA, Inc. (collectively, “Teva”) (*Dkt* 130) seeking to compel corporate testimony regarding Lilly’s prior art searches relating to the Tan Thesis in response to Teva’s Rule 30(b)(6) Topic Nos. 1 and 2.

Teva’s letter, which it rushed to file just days after the parties agreed to extend the case schedule to continue their efforts, *inter alia*, to “resolve any outstanding discovery disputes” (*Dkt* 128, ¶6), and when it knew Lilly’s offices were closed company-wide for the week, incorrectly seeks broad discovery including a waiver of Lilly’s privilege for its prior art searches. Teva omits, however, that it has:

1. *Rejected* Lilly’s offer to present a witness on Teva’s 30(b)(6) Topic Nos. 1 and 2;
2. *Backtracked* on its previous agreement that Lilly need not provide corporate testimony on Topic No. 2 if Lilly responded to Teva’s corresponding interrogatory on the same subject matter, which Lilly did; and
3. *Refused* to provide any reciprocal discovery on Lilly’s Rule 30(b)(6) topic directed to the same subject matter, notwithstanding that Teva—not Lilly—bears the ultimate burden of proving IPR estoppel under 35 U.S.C. § 315(e).

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Lilly has thus already offered, and Teva has declined, the discovery it now seeks. Teva's privilege-waiver arguments are also foreclosed by this Court's decision in *Palomar Tech., Inc. v. MRSI Sys., LLC*, No. 18-10236, 2020 WL 2115625, at *4 (D. Mass. May 4, 2020). Lilly respectfully requests that the Court deny Teva's letter to compel.

I. Teva Is Not Entitled to Relief

Teva's request to compel corporate testimony about Lilly's prior art searches (Topic No. 1) and awareness of the Tan Thesis (Topic No. 2) is belied by Teva's rejection of Lilly's offer to provide a corporate witness on that same subject matter. Ex. 1 (Lilly emails dated July 7, 2021, 2:06 pm and 7:53 pm). Lilly conditioned its offer on Teva agreeing that the act of providing a corporate witness would not in itself amount to waiver of attorney-client privilege. *Id.* But rather than taking the offered discovery, Teva refused. *Id.* (Teva email dated July 7, 2021, 6:51 pm).

Teva also omits two critical facts. First, the parties already obviated the need to raise a dispute to this Court by reaching agreement that Lilly need not provide a corporate witness on Topic No. 2 if Lilly answered Teva's Interrogatory No. 17 concerning the same subject matter of the Tan Thesis. Ex. 2 (Lilly letter dated June 4, 2021) at 1 ("Teva represented that it would forego Rule 30(b)(6) testimony on this topic [No. 2]..."). In accordance with the parties' agreement, Lilly has provided both initial and supplemental responses to that interrogatory, and Teva has identified no deficiencies in Lilly's responses. It is inefficient for the parties to reach agreements during discovery, only for Teva to backtrack, break those agreements, and burden the Court with previously resolved issues. Second, Teva has refused to provide a corporate witness on this very *same* issue for this very *same* reason—i.e., that it has "already provided all non-privileged information under which it first became aware of the Tan Thesis in an interrogatory response." Ex. 3 (Teva letter dated May 17, 2021) at 3; Ex. 4 at 23-24. On these bases alone, Teva's request with respect to Topic No. 2 should be denied.

Teva's privilege-waiver arguments also lack merit. Regarding Lilly's prior art searching (Topic No. 1), Teva argues waiver based on Lilly's *contention* in response to a contention interrogatory that the Tan Thesis "could not have been found through a reasonably diligent search," which is one of the factors this Court considers for IPR estoppel. Teva Ltr at 1-2; Teva Ex. 2 at 17; *Palomar*, 2020 WL 2115625 at *3. This Court has held that merely opposing a plaintiff's IPR estoppel arguments does not trigger waiver, and that is all Teva substantively presents here. *Palomar*, 2020 WL 2115625 at *4 (rejecting the proposition that a plaintiff "could trigger a waiver simply by asserting a challenge" based on IPR estoppel).

Regarding the circumstances by which Lilly became aware of the Tan Thesis (Topic No. 2), Teva fails to identify any waiver of privilege in Lilly's response to Interrogatory Nos. 16 and 17. Indeed, there is none. Lilly properly responded to Teva's interrogatories by providing (1) *factual* information that Lilly undertook a prior art search, (2) *factual* information about Lilly's knowledge of the Tan Thesis, and (3) *factual* information about nonprivileged communications with third parties regarding how Lilly obtained the Tan Thesis. Teva Ex. 3 at 2-5; Teva Ex. 4 at 4-6. Nowhere in these responses did Lilly selectively disclose privileged communications or work product. *See Upjohn Co. v. United States*, 449 U.S. 383, 395 (1981) ("The privilege only protects disclosure of communications; it does not protect disclosure of the underlying facts....").

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Accordingly, the Court should reject Teva's incorrect assertions of privilege waiver and deny its request to compel corporate testimony.

II. Corporate Testimony from an Attorney Is Not Appropriate Relief

To the extent the Court grants Teva any relief, Lilly respectfully submits that a deposition of an in-house or outside attorney for Lilly would not be appropriate. As this Court has recognized, taking the deposition of an opposing party's attorney presents troubling concerns about "back-door method[s] for gleaning privileged information about an opponent's litigation strategy." *RP Mach. Enter., Inc. v. UPS Capital Bus. Credit*, 2006 WL 8458644, at *4 (D. Mass. Nov. 1, 2006) ("[C]ourts do not look favorably on such attempts" to depose counsel of an opposing party) (citing *Shelton v. Am. Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1986)).

Instead, any relief should be in the form of written discovery. *See Bank of Am., N. A. v. Barnes Hill, LLC*, No. 16-11583, 2018 WL 10247150 at *1-2 (D. Mass. July 26, 2018) (granting protective order against deposition of opposing party's in-house counsel in favor of written discovery, i.e., interrogatories). Affording only written discovery would be fully consistent with how Teva itself has conducted discovery in this case, denying Rule 30(b)(6) witnesses when it has provided an interrogatory response concerning the same issues. Ex. 3 (Teva letter dated May 17, 2021) at 3 ("Teva explained on the meet and confer that it would not provide a witness on [Lilly's] Topic 18 because Teva had already provided all non-privileged information under which it first became aware of the Tan Thesis in an interrogatory response."). Accordingly, to the extent Teva is entitled to any relief, it should be in the form of written discovery, i.e., supplementation and/or verification of Lilly's responses to Teva's corresponding Interrogatory Nos. 16 and 17 under oath, as appropriate.

III. Any Relief Granted Should be Reciprocal and Apply to Both Parties

Teva's request to compel corporate testimony is also undermined by its refusal to provide any reciprocal discovery on Lilly's discovery requests directed to the same subject matter. It is Teva, not Lilly, who bears the burden of establishing that IPR estoppel applies under 35 U.S.C. § 315(e). *Palomar*, 2020 WL 2115625 at *4 (IPR estoppel is an "affirmative defense" for which the plaintiff must make a "*prima facie* showing" before any burden of production shifts to the defendant). Teva's failure to designate a corporate witness regarding its own prior art searching and awareness of the Tan Thesis places Teva in poor standing to demand such a witness from Lilly.

To the extent the Court grants Teva any relief, Lilly requests that the Court make that relief reciprocal and—if corporate testimony is considered appropriate—require Teva to produce a corporate witness for Lilly's 30(b)(6) Topic Nos. 18 and 19 so that the parties are on equal footing as to discovery regarding the IPR estoppel issues in this case. Ex. 4 at 23-24. Such reciprocal relief would be warranted because, if anything, the prior art searching of Teva and any of its predecessors-in-interest is potentially more relevant than Lilly's. For example, if Teva's own searches did not locate the Tan Thesis, that evidence would substantially undermine Teva's IPR estoppel position that a reasonably skilled searcher would have found the Tan Thesis. If Teva did

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find the Tan Thesis, Teva would appear to face significant inequitable conduct concerns by failing to disclose it to the U.S. Patent and Trademark Office during prosecution.

Furthermore, if merely raising an objection to IPR estoppel were sufficient to waive privilege (i.e., contrary to this Court's guidance in *Palomar*), Teva's affirmative assertion of IPR estoppel should unquestionably waive any privilege Teva may have concerning its own prior art searching. There is no basis to treat the parties differently. Lilly thus requests reciprocity in any relief that the Court may be inclined to grant.

IV. Conclusion

For the foregoing reasons, Lilly respectfully requests that the Court deny Teva's letter to compel or, if relief is warranted, order reciprocal relief so that the parties are on equal footing as to discovery regarding the IPR estoppel issues in this case. Thank you for your kind attention to this matter. Lilly is available for a status call at the Court's convenience.

Respectfully submitted,

/s/Andrea L. Martin

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cc: All Counsel of Record (by ECF)

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