EXHIBIT F

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ROCHE DIAGNOSTICS GMBH, *et al.*,

Plaintiffs,

-v-

ENZO BIOCHEM, INC., *et al.*,

Defendants.

No. 04 Civ. 4046 (RJS)
ORDER

RICHARD J. SULLIVAN, District Judge:

The Court is in receipt of the attached joint letter submitted by Enzo Biochem, Inc., Enzo Life Sciences (together with Enzo Biochem, Inc., "Enzo"), Roche Diagnostics GmbH, and Roche Molecular Systems, Inc. (together with Roche Diagnostics GmbH, "Roche"). Enzo seeks to strike supplemental invalidity contentions that Roche filed after the relevant deadline and to compel production of licenses, consumer agreements, and sales and financial information related to certain Roche products. The Court will address Enzo's requests in turn.

I. BACKGROUND

On February 7, 2013, the Court issued a Scheduling Order that called for infringement contentions by Enzo "on or before April 15, 2013" and invalidity contentions from Roche "on or before May 17, 2013." (Doc. No. 99.) Notably, Roche proposed the deadlines for infringement and invalidity contentions and reminded the Court that the "benefits of exchanging infringement contentions early in the discovery period cannot be seriously contested: Early contentions 'force parties to crystallize their theories early in the case,' 'to identify the matters that need to be resolved,' and to 'streamline discovery by mandating the disclosures that are core to patent cases,

thus reducing the need for interrogatories, document requests, and contention depositions.'" (Jt. Letter from Enzo and Roche, dated Feb. 5, 2013, at 5, 5 n.4 (quoting Federal Judicial Center, *Patent Case Management Guide* 2-9, 5-6, 5-7 (2009)).)

After those important early deadlines passed, on June 11, 2013, the Court ordered the parties to apprise the Court of the status of discovery, including the parties' progress toward interim deadlines. (Doc. No. 114.) The parties submitted a letter on June 18, 2013, explaining that they "believe[d] that discovery [was] proceeding on pace and expect[ed] to meet all of the deadlines set forth in the Court's Scheduling Order." (Jt. Letter from Enzo and Roche, dated June 18, 2013, at 1.) The parties have since requested and received short extensions of the discovery deadlines set by the Court (Doc. Nos. 115, 123), but at no time have they sought to extend the time for filing contentions or sought leave to make supplemental contentions submissions. Accordingly, the time for infringement and invalidity contentions concluded in spring 2013, fact discovery closed October 21, 2013, and briefing for claim construction will begin November 15, 2013.

II. SUPPLEMENTAL INVALIDITY CONTENTIONS

Although the time for infringement and invalidity contentions has long passed, the parties have both sought to supplement their contentions. On September 5, 2013, the parties submitted a joint letter in which they disputed whether Enzo could seek discovery for products that were not listed in its April 15, 2013 infringement contentions. In light of the age and history of this case, the Court ruled that Enzo "failed to accuse [those products] in the operative document that list[ed its] infringement contentions," and that Enzo could not "proceed with an infringement case against products [it] did not accuse." (Doc. No. 122 at 3; *see* Doc. No. 120 at 2.) Now Roche seeks to supplement its invalidity contentions, but the same rule applies: The Court will

not permit Roche to posit new invalidity contentions after the May 17, 2013 deadline. Enzo has not been permitted to add new infringement contentions, and Roche will not be permitted to supplement its invalidity contentions. If Roche needed more time to research or respond to Enzo's accusations, then it should have sought an extension before the May 17, 2013 deadline – an interim deadline Roche emphatically advocated – or at the very least before now, nearly half a year later. Accordingly, IT IS HEREBY ORDERED THAT Enzo's motion to strike Roche's supplemental contentions is GRANTED.[1]

III. Discovery Disputes

The parties also dispute whether Roche should be compelled to produce licenses and agreements related to the Elecsys/ECL products accused of infringing the '523 patent. The discovery standard is broad, and Enzo is entitled to "discovery regarding any nonprivileged matter that is relevant to" its claims or defenses even if the discovered material is "not . . . admissible at the trial [so long as it] appears reasonably calculated to lead to the discovery of admissible evidence." Fed. R. Civ. P. 26(b)(1). The Court concludes that licensing agreements for Elecsys/ECL-related products and reagent/instrument agreements for Elecsys-related products meet this broad standard. Accordingly, IT IS FURTHER ORDERED THAT Roche shall produce this discovery.

[1] The Court notes that Roche relies on *Alt v. Medtronic*, No. 2:04 Civ. 370 (LED), 2006 WL 278868, *5–6 (E.D. Tex. 2006), for the proposition that the Court would be justified in permitting supplemental invalidity contentions even though it previously denied supplemental infringement contentions. *Medtronic* is different than this case. There, the Court was dealing with requests for supplemental contentions *after* the claim construction hearing, and the court reasoned that the "addition of prior art references post *Markman* do not have the same implications upon *Markman* briefing and arguments as the addition of a patent claim," which would result in irremediable prejudice to the defending party. The posture of this case is different, and the Court's rationale is different. The Court has taken a firm position on the deadlines imposed by its Scheduling Order, and neither party sought to amend that Order with respect to contentions. Because more than five months has elapsed since the relevant deadlines, the Court rejects the argument that there is good cause for either party to raise additional contentions.

Enzo also mentions that "Roche has failed to produce financial/revenue information for the Elecsys e170 instruments and/or for the first few years of infringing sales after launch (i.e., pre-2000)." From this vague statement, the Court is clearly not in a position to determine whether Roche has withheld relevant discovery with regard to financial or revenue information. Accordingly, IT IS FURTHER ORDERED THAT Roche need not produce financial or revenue information unless Enzo demonstrates the relevance of such information to Enzo's claims or defenses or that the information is likely to lead to admissible evidence at trial.

IV. CONCLUSION

For the reasons set forth above, Enzo's motion to strike Roche's supplemental invalidity contentions is granted, as is its motion to compel production of licenses and agreements relating to the Elecsys/ECL products accused of infringing the '523 patent. Enzo's remaining discovery requests are denied.

SO ORDERED.

DATED: November 11, 2013
New York, New York

RICHARD J. SULLIVAN
UNITED STATES DISTRICT JUDGE

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