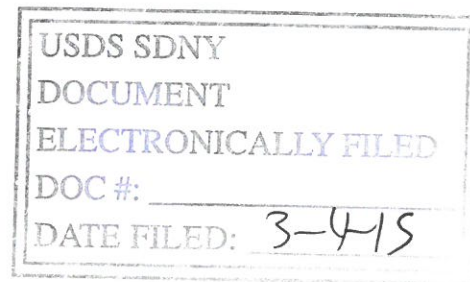


EXHIBIT G

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



ROCHE DIAGNOSTICS GMBH, *et al.*,
Plaintiffs,

-v-

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

No. 04-cv-4046 (RJS)
ORDER

RICHARD J. SULLIVAN, District Judge:

Now before the Court are three joint letters, dated December 8, 2014, December 17, 2014, and January 30, 2015, submitted by Enzo Biochem, Inc. and Enzo Life Sciences (collectively, “Enzo”) and Roche Diagnostics GmbH and Roche Molecular Systems, Inc. (collectively, “Roche”). (Doc. Nos. 222, 224, & 228.) Roche seeks leave to supplement its invalidity contentions in light of the Supreme Court’s decision in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) and moves for a protective order to limit discovery during the damages discovery period, while Enzo moves to compel Roche to produce contract damages discovery concerning Roche’s Elecsys products. Roche, in response to Enzo’s motion concerning Elecsys products, asks the Court to award Roche’s fees and costs “in connection with having to litigate these issues for yet a third time.” (Doc. No. 228 at 5.) For the reasons set forth below, Roche’s request to supplement its invalidity contentions is denied, Roche’s motion for a protective order is granted in part and denied in part, Enzo’s motion to compel is denied, and Roche’s motion for fees and costs is denied. The Court will address these requests in turn.

I. BACKGROUND

Roche commenced this action by filing the Complaint on May 28, 2004 (Doc. No. 1), and on January 21, 2005, it filed the Amended Complaint (Doc. No. 16). Enzo filed its First Amended Answer and Counterclaims (the “FAAC”) on February 22, 2005. (Doc. No. 18.) This case was originally assigned to the Honorable John E. Sprizzo, District Judge, but after Judge Sprizzo passed away in December 2008, the case was reassigned to my docket on January 8, 2009. (Doc. Nos. 5 & 39.) From March 13, 2009 until August 25, 2011, this action was stayed while a related case was appealed to the Federal Circuit. (Doc. Nos. 44, 65, & 67.) On September 24, 2012, following a renewed round of briefing by Roche and the defendants in related patent-infringement cases, the Court granted in part and denied in part Roche’s motion for summary judgment with respect to multiple patent claims asserted by Enzo. (Doc. No. 83.) Enzo filed a motion for reconsideration of a claim construction ruling issued in 2006 and vacatur of the September 24, 2012 summary judgment decision that relies on the 2006 ruling, which the Court denied on December 10, 2014. (Doc. No. 223.)

Roche filed a separate motion for summary judgment on April 11, 2013, focusing on Enzo’s non-patent claims and asserting a contractual basis for dismissing Enzo’s remaining patent claims. (Doc. No. 102.) In a Memorandum and Order dated December 6, 2013, the Court denied summary judgment with respect to Enzo’s claim that Roche violated the use restrictions in the April 1994 “Distribution and Supply Agreement” (the “Agreement”), but granted Roche’s motion in all other respects. (Doc. No. 132.) On September 16, 2014, after yet another round of briefing, the Court denied Enzo’s motion for reconsideration of the December 6, 2013 summary judgment ruling. (Doc. No. 217.)

On October 22, 2014, the Court entered a revised scheduling order that, among other things, mandated that “[a]ll damages fact discovery . . . which has not already been completed shall be completed by January 30, 2015.” (Doc. No. 219.) The three joint letters now before the Court were submitted during this “damages fact discovery” period. In the first joint letter, dated December 8, 2014, Roche seeks leave to supplement its invalidity contentions in light of the Supreme Court’s *Nautilus* decision. (Doc. No. 222.) In the second letter, dated December 17, 2014, Roche moves for a protective order to limit discovery during the damages discovery period. (Doc. No. 224.) In the third letter, dated January 30, 2015, Enzo moves to compel Roche to produce contract damages discovery concerning Roche’s Elecsys products. (Doc. No. 228.) In that same January 30, 2015 joint letter, Roche, in response to Enzo’s motion concerning Elecsys products, asks the Court to award Roche’s fees and costs “in connection with having to litigate these issues for yet a third time.” (*Id.* at 5.)

II. SUPPLEMENTAL INVALIDITY CONTENTIONS

In the first joint letter, dated December 8, 2014, Roche seeks leave to supplement its invalidity contentions in light of the Supreme Court’s *Nautilus* decision. (Doc. No. 222.) The Court denies Roche’s motion.

In a Case Management Plan and Scheduling Order, dated February 7, 2013, the Court ordered that “[a]ny party opposing a claim of patent infringement shall serve invalidity contentions on or before May 17, 2013.” (Doc. No. 99 at 2.) On November 12, 2013, the Court granted Enzo’s motion to strike Roche’s supplemental invalidity contentions dated September 17, 2013, September 30, 2013, and October 16, 2013 because those contentions were untimely. (Doc. No. 129 at 2-3.) In the November 12, 2013 Order, the Court noted, “[i]f

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.” (*Id.* at 3.)

Over one year later, Roche again seeks to supplement its invalidity contentions. Roche's latest attempt to supplement its invalidity contentions is based on the Supreme Court's June 2, 2014 *Nautilus* decision. 134 S. Ct. 2120 (2014). In *Nautilus*, the Court found that the Federal Circuit's previous standard for indefiniteness – that “a patent claim passes the [35 U.S.C.] § 112, ¶ 2 threshold so long as the claim is ‘amenable to construction,’ and the claim, as construed, is not ‘insolubly ambiguous’” – does not satisfy the definiteness requirement under 35 U.S.C. § 112, ¶ 2. *Id.* at 2124 (citing the Federal Circuit's *Nautilus* opinion). Instead, the Court held “that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.*

Roche argues that *Nautilus* “represents a significant change in the law of indefiniteness under 35 U.S.C. § 112” by making indefiniteness challenges easier. (Doc. No. 222 at 2.) Roche elaborates that “[t]here is a fundamental difference between proving an ‘insoluble ambiguity,’ *i.e.* an ambiguity that cannot be cured (the old standard), and proving a ‘zone of uncertainty’ as to the scope of the invention (the new standard).” *Id.* But it is not certain that *Nautilus* is such a “significant change.” The *Nautilus* Court itself noted that “[t]he standard we adopt accords with opinions of this Court” *Nautilus*, 134 S. Ct. at 2129-30 (citing three Supreme Court precedents); *see also Cognex Corp. v. Microscan Sys., Inc.*, No. 13-CV-2027 JSR, 2014 WL 2989975, at *7 n.2 (S.D.N.Y. June 30, 2014) (characterizing *Nautilus* as having

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