

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

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|----------------------------|---|------------------------------|
| ABBVIE INC. and ABBVIE | : | |
| BIOTECHNOLOGY LTD | : | |
| | : | |
| v. | : | CIVIL NO. 17-cv-01065-MSG-RL |
| | : | |
| BOEHRINGER INGELHEIM | : | |
| INTERNATIONAL GMBH, | : | |
| BOEHRINGER INGELHEIM | : | |
| PHARMACEUTICALS, INC., and | : | |
| BOEHRINGER INGELHEIM | : | |
| FREMONT, INC. | : | |

ORDER

On April 25, 2019, I held a telephone conference call on the record in this matter concerning discover disputes between the parties, collectively referred to as “AbbVie” (plaintiffs) and “Boehringer” (defendants). As directed during the conference call, it is on this 26th day of April, 2019,

ORDERED

As follows:

1. AbbVie will file a motion to compel regarding Boehringer’s search terms related to Interrogatory No. 21. The motion will include the search terms at issue and AbbVie’s justifications for requesting broader terms.
2. AbbVie will file a motion to compel relating to the alleged non-responsiveness by Boehringer to AbbVie’s Interrogatories and Requests for Admissions.
3. Boehringer will provide AbbVie with all aBLA documents submitted to or received from the FDA from May 2018 until April 25, 2019. These documents shall be supplied to AbbVie by **May 2, 2019**. The parties should meet and confer on the issue of whether future correspondence with the FDA should be provided.

4. AbbVie will file a motion to compel concerning the allegedly improper redactions in Boehringer's document productions. AbbVie will also submit no more than fifteen (15) documents to support their argument.
5. Boehringer will file a motion regarding AbbVie's notices of deposition of Boehringer's apex witnesses and in-house litigation counsel.
6. Boehringer will file a motion concerning AbbVie's allegedly improper clawback of documents.
7. AbbVie will advise Boehringer of the status of the search of the storage facility referenced during the telephone conference held on April 25, 2019. This status update will include an estimate of the length of time to search the facility, the amount of documents that are located at the facility, and the categories of documents that AbbVie has learned are located at the facility.
8. AbbVie will also provide more complete answers to Boehringer's Interrogatory No. 42 and Interrogatory No. 43.
9. Boehringer is permitted to re-depose Yu-Hsiang Chang with the document containing the now-correct metadata. AbbVie will pay for the costs and attorneys' fees relating to the re-deposition.
10. Boehringer may re-raise the issues regarding prior art presentations if the directives in paragraphs seven (7), eight (8), and nine (9) prove inadequate to cure prejudice. However, I will defer any motions on this issue until the parties have completed the directives stated in paragraphs seven (7), eight (8), and nine (9) of this Order and have met and conferred to resolve any remaining issues. In the event that issues remain, the parties may schedule a telephone call with me.

11. Boehringer will file a motion to compel the production of documents relating to AbbVie's prior art sales.
12. AbbVie will submit a letter to my chambers detailing the background and history of the issue involving the production of AbbVie's internal prosecution files, specifically what was (and was not) agreed to in the April 2018 agreement and November 2018 letter. This letter must be submitted no later than **May 2, 2019**. Boehringer may submit a responsive letter due no later than **May 9, 2019**. After considering these letters, I will decide whether motions on the issue of the production of AbbVie's internal prosecution files are necessary.
13. The parties will meet and confer about the language relating to AbbVie's dates of conception and reduction to practice for the asserted claims. If the parties cannot agree, Boehringer will file an appropriate motion.
14. For the motions referenced in this Order, each party will submit one brief containing the party's respective motions. These briefs are due no later than **May 16, 2019**. Responsive memoranda are due **May 30, 2019**. Reply briefs will not be permitted except on request and for good cause.

BY THE COURT:

s/Richard A. Lloret
RICHARD A. LLORET
U.S. MAGISTRATE JUDGE