

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

PROMEGA CORPORATION,

Plaintiff,

v.

APPLERA CORPORATION and
LIFECODES CORPORATION, and its
SUBSIDIARIES CELLMARK
DIAGNOSTICS, INC. and GENOMICS
INTERNATIONAL CORPORATION,

Defendants.

OPINION and
ORDER

01-C-244-C

Plaintiff has filed a motion to strike the declaration of defendants' expert Richard Gibbs in support of defendants' opposition to plaintiff's motion for summary judgment of non-obviousness of the '598 and '660 patents and a motion to strike defendants' corrected proposed findings of fact. With respect to the first motion, Gibbs states that he submitted his "declaration in response to Promega's unfair characterization of statements [he] made in [his] expert report" submitted on June 26, 2002. Gibbs's declaration was submitted on September 13, 2002. The deadline for rebuttal expert reports was July 19, 2002. Plaintiff contends both that the declaration is a "sham affidavit" and that it contains new expert opinion submitted after the July 19, 2002 deadline. Specifically, plaintiff argues that in his declaration, Gibbs opines for the first time that:

1. [O]ne skilled in the art would be motivated to and have a reasonable expectation that the claimed multiplex combinations [of the '598 patent] would work when combining the other teachings in the prior art; and

2. [T]hese specific teachings documented in my expert report would motivate those skilled in the art to make the claimed methods of the '660 patent, and would give them a reasonable expectation of success in doing so.

Plaintiff maintains that these opinions conflict with Gibbs' June 26 expert report and his deposition testimony. I disagree. In his expert report, Gibbs describes the process of constructing multiplex PCR reactions involving STR loci as difficult and unpredictable, but qualifies these statements by noting that difficulties generally arise only in the absence of specific, pre-existing teachings. Gibbs's report goes on to describe specific, pre-existing teachings found in the prior art relative to the combinations of loci claimed in the '598 and '660 patent. Plaintiff asked Gibbs at his deposition "whether or not those preexisting teachings would, in fact . . . allow one skilled in the art to know whether the given multiplex would successfully coamplify." Gibbs testified that in light of the specific teachings in question, "you could say that some multiplex reactions would be pretty likely to work, and that would limit the uncertainty quite greatly in certain examples." In its motion to strike, plaintiff does little more than nitpick the explanations Gibbs provided in his deposition. For instance, despite Gibbs's explanation that in light of specific teachings some multiplex reactions "would be pretty likely to work" and the teachings "would limit . . . uncertainty quite greatly," plaintiff insists that "Dr. Gibbs [never] opine[d] or even hint[ed] that the suggested experiment would work or have any expectation of success." This assertion is simply not true. Plaintiff's other efforts to undermine Gibbs's declaration and testimony concerning both the '598 and the '660 patents are equally unpersuasive.

In essence, both plaintiff and defendants are engaged in the same endeavor. In its motion for summary judgment of non-obviousness, plaintiff selectively quotes Gibbs's expert report and seeks to spin it in a fashion that buttresses plaintiff's summary judgment arguments. There is nothing unusual or untoward about this. However, when Gibbs filed a declaration objecting to plaintiff's spin, plaintiff filed a voluminous motion to strike the declaration as both a sham affidavit and untimely new expert opinion. It is neither. In filing Gibbs's declaration, defendants have done little more than follow plaintiff's lead in attempting to cast Gibbs's report and deposition in the light most favorable to their summary judgment posture. At best, any discrepancies between Gibbs's report, deposition testimony and declaration involve the conviction with which he advances his opinions, rather than their content. See Bank of Illinois v. Allied Signal Safety Restraint Sys., 75 F.3d 1162, 1169-70 (7th Cir. 1996) (“A definite distinction must be made between discrepancies which create transparent shams and discrepancies which create an issue of credibility or go to the weight of the evidence”) (quoting Tippens v. Celotex Corp., 805 F.2d 949, 953 (11th Cir. 1986)). Accordingly, plaintiff's motion to strike the declaration of Richard Gibbs will be denied.

As to plaintiff's second motion to strike defendants' corrected proposed findings of fact, it will be granted in part and denied in part. Where defendants' corrections are clearly corrections of mistakes made in their initial filing, I will rely upon them. Where, however, they are new versions of earlier proposals, I will rely upon them only to the extent they do not prejudice plaintiff.

ORDER

IT IS ORDERED that

1. Plaintiff Promega Corporation's motion to strike the declaration of Richard Gibbs is DENIED; and

2. Plaintiff Promega Corporation's motion to strike defendant's corrected proposed findings of fact is GRANTED in part and DENIED in part, in accordance with this order.

Entered this 23rd day of October, 2002.

BY THE COURT:

BARBARA B. CRABB
District Judge