

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

INNOGENETICS, N.V.,

Plaintiff,

v.

ABBOTT LABORATORIES,

Defendant.

ORDER

05-C-0575-C

On August 15, 2006, defendant Abbott Laboratories advised plaintiff Innogenetics, N.V., that it would be waiving its attorney-client privilege and producing an opinion of counsel as a defense to plaintiff's charge of willful infringement of plaintiff's '704 patent. At the same time, it gave plaintiff an amended witness list and identified five persons who would be made available for depositions regarding the communications from counsel. The next day, plaintiff advised defendant that it would call Michael Sofocleous as an expert witness to rebut defendant's advice-of-attorney defense, whereupon defendant moved to prohibit Sofocleous's testimony as untimely. The parties agree that although plaintiff gave timely notice that it would be calling Sofocleous as an expert, it had never told defendant that he would be called as an expert on willfulness.

Defendant's objection is meritless. Until it disclosed its intention to rely on the advice of its patent counsel as a defense to willful infringement, plaintiff had no reason to disclose Sofocleous as an expert on that subject. The August 16 notice that Sofocleous would be testifying is not the "sandbagging" that defendant calls it; it is a predictable response to an eve of trial disclosure of a new defense and an amended witness list.

Defendant argues also that any testimony Sofocleous could give would be irrelevant because it would be after-the-fact second guessing that would give the jury no sense of defendant's state of mind at the relevant time. Moreover, defendant asserts, the value of any such testimony would be greatly outweighed by the unfair prejudice to defendant and the likelihood of jury confusion.

It is true that the importance of an opinion letter from outside counsel does not depend upon its legal correctness. Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 944 (Fed. Cir. 1992). The question is whether the infringer had a reasonable basis for believing it had the right to do what it did. In answering that question, the jury is entitled to examine the thoroughness of counsel's analysis of the infringement question, the case law that counsel discussed and the overall tone of the opinion letter. Id. at 945. Moreover, a patentee may be able to show that an outside opinion is so blatantly incorrect or without foundation as to call into question the infringer's assertion of reasonable reliance. On this topics, an expert witness can provide assistance to the jury, without confusing them about the nature of the

question they must answer.

ORDER

IT IS ORDERED that defendant Abbott Laboratories' motion to prohibit the expert testimony of Michael Sofocleous on issues of willfulness is DENIED.

Entered this 24th day of August, 2006.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge