

ORAL ORDER: The Court, having reviewed Defendant's motion to strike ("Motion"), which seeks to strike portions of the rebuttal report of Plaintiff's expert Dr. A. Bruno Frazier that newly identify certain claim limitations in certain asserted patents that are purportedly not found in prior art publications Ehret 1997 and Keese, (D.I. 325), and the briefing related thereto, (D.I. 326; D.I. 332; D.I. 342), hereby ORDERS that the Motion is GRANTED and the portions of the report at issue are STRICKEN. The Court so concludes for the reasons that follow: (1) During the discovery period, in response to Defendant's Interrogatory No. 22, Plaintiff identified all of the claim limitations in the asserted patents that it believed were not found in the various prior art references relied on by Defendant; Plaintiff did this twice, on November 27, 2024 and February 12, 2025. (D.I. 326 at 1 (citing *id.*, exs. D-E)) But then in Dr. Frazier's rebuttal report, served on April 25, 2025, Plaintiff for the first time identified additional claim limitations ("the limitations at issue") that it was contending are not found in Ehret 1997 (i.e., element a(i) of the 080 patent's claim 1 and element a(i) of the 752 patent's claims 11 and 14) and Keese (i.e., element b, element c and the preamble of the 255 patent's claim 9). (*Id.*) Importantly, Dr. Frazier's rebuttal report came after Defendant had narrowed its prior art bases (as part of serving its final invalidity contentions on January 31, 2025). (*Id.*) There can be no real dispute that these new assertions in Dr. Frazier's rebuttal report about the limitations at issue were untimely. If Plaintiff's view about which claim limitations were not found in Ehret 1997 and Keese had changed after its November 27, 2024 and/or February 12, 2025 discovery responses, then Plaintiff had an obligation pursuant to Fed. R. Civ. P. 26 to timely amend those responses. See *Integra Lifescis. Corp. v. HyperBranch Med. Tech., Inc.*, Civil Action No. 15-819-LPS-CJB, 2017 WL 11558096, at *4 (D. Del. Dec. 11, 2017). And yet here, it did not.; (2) Pursuant to Fed. R. Civ. P. 37(c), then, the new disclosures should be stricken unless they are substantially justified or harmless. To assess that question, our Court utilizes the Pennypack factors. See *Astellas Pharma Inc. v. Actavis Elizabeth LLC*, Civil Action No. 16-905-JFB-CJB Consolidated, 2019 WL 2265570, at *1 (D. Del. May 13, 2019) (listing the factors). They all either support exclusion here, or, at best for Plaintiff, are neutral. With regard to the first factor ("prejudice or surprise" to the moving party), the disclosures in Dr. Frazier's rebuttal report surely would have surprised Defendant. That's because in its earlier discovery responses, Plaintiff listed out numerous claim limitations that were allegedly not found in Ehret 1997 and Keese—but specifically did not list any of the limitations at issue as being missing from those references. (D.I. 326, ex. D at 32-35, 40-44; *id.*, ex. E at 52-67) Any reasonable reader of those responses, then, would have been justified in concluding that Plaintiff was not going to argue that the limitations at issue were missing from Ehret 1997 and Keese. And the new disclosure prejudiced Defendant. While Defendant did have the ability to file a responsive expert report as to the new material and depose Dr. Frazier on it, (D.I. 332 at 4), it had already made strategic choices about which references it would select in its final invalidity contentions based on Plaintiff's prior discovery responses. Had Defendant known about Plaintiff's new positions on the limitations at issue when it did so, Defendant might have made different strategic choices as to its invalidity case. See *Equil IP Holdings LLC v. Akamai Techs., Inc.*, Civil Action No. 22-677-RGA, 2024 WL 3967388, at *2 (D. Del. Aug. 28, 2024); *Intell. Ventures I LLC v. AT&T Mobility LLC*, C.A. No. 12-193-LPS, 2017 WL 478565, at *6 (D. Del. Jan. 31, 2017). The second and third factors ("possibility of curing the prejudice" and "likelihood of disrupting the trial") also go Defendant's way. Trial is in January 2026,

and it is too late (and would have been too late for some time now) to go back and have Defendant re-do its final invalidity contentions based on Dr. Frazier's rebuttal report, and then re-do the rest of expert discovery that would be relevant to those new choices. The fourth and six factors ("the presence of bad faith or willfulness" and "the explanation for the failure to disclose") are at best neutral, and might tip Defendant's way. That's because Plaintiff never comes up with a good explanation for how things went down as they did. For example, nowhere in Plaintiff's briefing does it actually come out and say "Yes, it is true, we did not include the limitations at issue in our prior discovery responses." Plaintiff just kind of... ignores that part. And Plaintiff never explains why it was that it could not have identified the limitations at issue as being missing from the references earlier in the case—i.e., it never articulates why something in Defendant's expert's opening report would have served, for the first time, to suggest to it that the limitations at issue weren't found in Ehret 1997 and Keese. Instead, Plaintiff blames Defendant for where we are, by repeatedly asserting that Defendant's invalidity contentions were wanting. (D.I. 332) But if Defendant's invalidity contentions were problematically vague, then Plaintiff should have gone to the Court during fact discovery and gotten the Court to order Defendant to say more. What a party in Plaintiff's shoes can't do is fail to complain to the Court about such contentions, and then try to use those purportedly-wanting contentions as a "get out of jail free card" to allow it to spring clearly new positions on its adversary later in expert discovery. Lastly, the fifth factor ("importance of the information withheld") favors Defendant, as it is undisputed that Plaintiff has numerous additional arguments about how Ehret 1997 and Keese fail to disclose various other claim limitations (and numerous other reasons why the asserted claims would not have been obvious in view of prior art combinations). (D.I. 326 at 3; D.I. 342 at 2); and (3) As Judge Bryson and the Court have noted, "though the Pennypack factors may be very forgiving, they are not a sieve." *Wang v. Injective Labs Inc.*, No. 22-943, 2025 WL 775530, at *3 (D. Del. Mar. 11, 2025) (citation omitted). If a party like Plaintiff propounds discovery responses that don't include a position, then never amends those responses to later include the position, and finally springs the new position on its opponent in an expert report (without well explaining why it could not have set out the position any earlier), then the Pennypack factors won't be a savior. Ordered by Judge Christopher J. Burke on 11/25/2025. (mlc) (Entered: 11/25/2025) As of November 26, 2025, PACER did not contain a publicly available document associated with this docket entry. The text of the docket entry is shown above.

Agilent Technologies, Inc. v. Axion BioSystems, Inc.
1-23-cv-00198 (DDE), 11/25/2025, docket entry 456