

U.S. District Court
District of Delaware (Wilmington)
CIVIL DOCKET FOR CASE #: 1:24-cv-00811-JLH-SRF

Pierre Fabre Medicament SAS et al v. Rubicon Research Private Limited
Assigned to: Judge Jennifer L. Hall
Referred to: Judge Sherry R. Fallon
Related Case: [1:22-cv-01442-JLH](#)
Cause: 35:1 Patent Infringement

Date Filed: 07/12/2024
Jury Demand: Plaintiff
Nature of Suit: 835 Patent - Abbreviated New Drug Application(ANDA)
Jurisdiction: Federal Question

Date Filed	#	Docket Text
11/07/2025	116	ORAL ORDER re 103 Joint Motion for Teleconference to Resolve Discovery Dispute. Having reviewed the parties' discovery dispute letter submissions and associated filings, (D.I. 109; D.I. 110; D.I. 111), IT IS ORDERED that Defendant's motion to compel Plaintiffs to make available for deposition Dr. Christine Leaute-Labreze, Dr. Eric Dumas de la Roque, and Dr. Benoit Thambo (collectively, the "Co-Inventors") is GRANTED. In this case, Plaintiffs assert claims for infringement of two patents concerning methods for treating a hemangioma. (D.I. 1, Exs. A-B) Following the court's construction of the preamble in its <i>Markman</i> ruling, Defendant asserted that the patents-in-suit were invalid under 35 U.S.C. 101 for improper inventorship. (D.I. 88) The present dispute involves Defendant's efforts to obtain discovery on conception and reduction to practice in support of its improper inventorship theory. There is no dispute that the Co-Inventors are employed by Plaintiffs, or that Plaintiffs identified the Co-Inventors of the patents-in-suit in their initial disclosures under Rule 26(a) of the Federal Rules of Civil Procedure. (D.I. 109 at 2, Ex. 2 at 1; Ex. 3) Moreover, the Co-Inventors executed assignment agreements for the patents-in-suit in which they agreed as follows: "Assignor hereby covenants and agrees... as to letters patent..., and for litigation regarding... the United States application for patent, or Letters Patent therefor, and to testify in support thereof, for the benefit of Assignee[.]" (<i>Id.</i>, Exs. 9-10) Plaintiffs acknowledge that "the 3 Doctors... agreed... to testify in support of any issued patent for the benefit of Assignee[.]" (D.I. 111 at 3) Plaintiffs nonetheless attempt to distinguish the language of the assignment agreements from the assignments at issue in <i>Aerocrine AB v. Apieron Inc.</i>, in which the witnesses agreed "generally to do everything possible," including "testifying in the United States." 267 F.R.D. 105, 111 (D. Del. 2010). (<i>Id.</i>) But this is a distinction without a difference. Like the assignment agreement in <i>Aerocrine</i>, the assignment agreements in this case contain express language compelling the assignor to provide testimony in litigation in support of U.S. patents, and it is reasonable to infer that the location of litigation and testimony regarding U.S. patents would be in the United States. <i>See Aerocrine</i>, 267 F.R.D. at 112 (granting a motion to compel the U.S. depositions of foreign inventors who executed assignment agreements "that specifically contemplated the provision of testimony for purposes of enforcing the patent rights."). Accordingly, the Co-Inventors should be made available for depositions under Rule 30(b)(1), and Plaintiffs' position that Defendant was required to follow the procedures under the Hague Convention is unpersuasive. Plaintiffs also argue that the deposition testimony is not relevant or proportional to the case. (D.I. 111 at 2, 4) However, Plaintiffs cite no authority demonstrating how these considerations apply to a properly noticed deposition under Rule 30. <i>See, e.g.</i>, Fed. R. Civ. P. 30(a)(1) ("A party may, by oral questions, depose any person,

including a party, without leave of court except as provided in Rule 30(a)(2)."). Plaintiffs contend that their 30(b)(6) witnesses will furnish the information sought from the Co-Inventors, but this offer rings hollow in light of Plaintiffs' backpedaling on their offer to supply the information through written responses to requests for admission and interrogatories. (D.I. 109, Ex. 5 at 2; D.I. 110, Ex. 7 at 3-5; D.I. 111 at 2) Plaintiffs' failure to respond to those written discovery requests after offering them as a substitute for the testimony also undermines their position that Defendant unreasonably delayed in noticing the depositions (a position for which Plaintiffs cite no authority). (D.I. 111 at 1-2) As to the scope of the relief granted herein, Defendant's letter submission and proposed form of order do not specify whether the depositions should take place in the United States or remotely in France. (D.I. 109) The record demonstrates that Defendant offered to take remote depositions for witnesses residing outside of the United States. (D.I. 109, Ex. 2 at 1) Unless the parties reach agreement and stipulate to remote depositions, IT IS ORDERED that Plaintiffs shall make the Co-Inventors available for deposition in the United States no later than December 5, 2025. *See Aerocrine*, 267 F.R.D. at 112 (resolving doubts regarding assignment agreement language in favor of requiring the depositions to occur in the United States, considering the totality of the circumstances). IT IS FURTHER ORDERED that the discovery dispute teleconference set for November 12, 2025 at 2:00 p.m. is CANCELLED. Ordered by Judge Sherry R. Fallon on 11/7/2025. (lih) (Entered: 11/07/2025)

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