United States District Court,
W.D. Wisconsin.

PROMEGA CORPORATION,
Plaintiff.
v.
APPLERA CORPORATION and Lifecodes Corporation, and its Subsidiaries Cellmark Diagnostics, Inc. and Genomics International Corporation,
Defendants.

No. 01-C-244-C

June 7, 2002.

J. Donald Best, for Plaintiff.

James R. Cole, Quarles & Brady, Madison, WI, Edward R. Reines, Weil, Gotshal & Manges, LLP, Redwood Shores, CA, for Defendants.

OPINION and ORDER

CRABB**, J.**

In this civil action for patent infringement, two motions filed by plaintiff Promega Corporation are before the court. In the first, plaintiff asks the court to reconsider those portions of its January 2, 2002 claim construction opinion and order in which it construed claims 1 through 5 and 16 of plaintiff's United States Patent No. 5,843,660 (the '660 patent). In the second, plaintiff seeks an order blocking the disclosure of its trade secrets to one of defendants' experts. For the reasons discussed below, plaintiff's motion for reconsideration will be granted and its motion for an order blocking disclosure to defendants' expert will be denied.

I. MOTION FOR RECONSIDERATION

The '660 patent discloses a method for the simultaneous amplification of multiple, specific regions of human DNA, or "short tandem repeat loci," in order to facilitate the analysis of distinguishing genetic characteristics. More background on this technology can be found in the court's January 2, 2002 claim construction opinion and order. Claim I of the '660 patent reads as follows, with significant language emphasized:

1. A method of simultaneously determining the alleles present in at least four short tandem repeat loci from one or more DNA samples, comprising:

(a) obtaining at least one DNA sample to be analyzed,

(b) selecting a set of at least four short tandem repeat loci of the DNA sample to be analyzed which can be amplified together, wherein the at least four loci *in the set* are selected from the group of loci consisting of: D3S1539, D4S2369, D5S818, D7S820, D9S930, D10S1239, D13S317, D14S118, D14S548, D14S562, D16S490, D16S539, D16S753, D17S1298, D17S1299, D19S253, D20S481, D22S683, HUMCSF1PO, HUMTPOX, HUMTH01, HUMF13A01, HUMBFXIII, HUMLIPOL, HUMvWFA31;

(c) co-amplifying the loci in the set in a multiplex amplification reaction, wherein the product of the reaction is a mixture of amplified alleles from each of the co-amplified loci in the set; and

(d) evaluating the amplified alleles in the mixture to determine the alleles present at each of the loci analyzed in the set within the DNA sample.

In the January 2, 2002 claim construction opinion and order, I stated that claim 1 "covers only sets of short tandem repeat loci in which all the loci in the [multiplex amplification] reaction, whether four or more, are selected from the group of loci listed in step (b)." January 2, 2002 Op. and Order, dkt. # 40, at 15. According to this interpretation of the claim, a multiplex reaction that includes four or more loci chosen from the list (or "*Markush* group") in step (b) but that also includes at least one unlisted loci would not infringe the claim. In reaching this understanding of the claim's scope, I relied upon an amendment made to the claim in March 1998. Before the amendment, step (b) of claim 1 read as follows:

(b) selecting a set of at least four short tandem repeat loci of the DNA sample to be analyzed which can be amplified together, wherein at least four of the loci in the set are selected from the group of loci consisting of:

D3S1539, D4S2369, D5S818, D7S820, D9S930, D10S1239, D13S317, D14S118, D14S548, D14S562, D16S490, D16S539, D16S753, D17S1298, D17S1299, D19S253, D20S481, D22S683, HUMCSF1PO, HUMTPOX, HUMTH01, HUMF13A01, HUMBFXIII, HUMLIPOL, HUMvWFA31;

The amendment, which the examiner indicated was made "to place [the claim] in condition for allowance," required that "[i]n claim 1, (b), line 2, -thehas been inserted after 'wherein' and 'of the' after 'four' has been deleted." After the March 1998 amendment, claim 1 reads as follows, with the inserted language underlined and the deletion bracketed and stricken.

(b) selecting a set of at least four short tandem repeat loci of the DNA sample to be analyzed which can be amplified together, wherein *the* at least four loci in the set are selected from the group of loci consisting of:

D3S1539, D4S2369, D5S818, D7S820, D9S930, D10S1239, D13S317, D14S118, D14S548, D14S562, D16S490, D16S539, D16S753, D17S1298, D17S1299, D19S253, D20S481, D22S683, HUMCSF1PO, HUMTPOX, HUMTH01, HUMF13A01, HUMBFXIII, HUMLIPOL, HUMvWFA31;

(Emphasis added). Thus, while the pre-amendment claim 1(b) required "at least four of the loci in the set" to be chosen from the listed group, after the March 1998 amendment the same section required "*the* at least four loci in the set" to be chosen from the listed group. Relying on this prosecution history, I reasoned that the pre-amendment language contemplated the inclusion of unidentified loci as long as a minimum of four loci were selected from the identified list, but that the post-amendment language required all the loci, whether four or more, to be selected from the list.

I am convinced that this reasoning is unsound for several reasons. First, I stated that "claim 1 covers only sets of short tandem repeat loci in which all the loci in the [multiplex] reaction, whether four or more, are selected from the group of loci listed in step (b)." Plaintiff argues that this statement incorrectly conflates the terms "set" and "multiplex reaction." According to plaintiff, the court "erroneously read the claim term 'set' to mean 'multiplex reaction" ' and "[t]his misunderstanding of the claim resulted in the Court limiting the *multiplex reaction* of limitation (c) to only the loci specified in limitation (b) rather than limiting the *'sets'* or combination of loci required by limitation (b)." (Emphasis added). In other words, the court effectively rewrote a critical portion of claim 1(b) to read "wherein the at least four loci in the *multiplex reaction* are selected from the group consisting of...."

Plaintiff is correct. I conflated the term "set" with "multiplex reaction" incorrectly in some passages of the January 2, 2002 claim construction opinion and order. Claim 1, step (b) involves selecting a set of at least four loci and requires that "the at least four loci *in the set*" be chosen from the group of loci listed in step (b). The examiner's amendment does not address the loci that are included in the *multiplex reaction* described in step (c). I agree with plaintiff that if anything must be chosen exclusively from the list of loci in step (b), it is the content of the set rather than the multiplex reaction. Defendants disagree, arguing that the claim limits the content of the multiplex reaction of step (c) to only the set selected in step (b). Defendants' most persuasive argument on this score is grounded in the language of step (c), which provides that "*the*" end product of the multiplexing reaction is "a mixture of amplified alleles from each of the co-amplified loci in the set." Defendants argue that this language suggests that the sole product of the reaction must be a mixture of *only* the loci in the set selected in step (b) and that unidentified loci are logically excluded from the reaction. Although this proposition has surface appeal, a second argument advanced by plaintiff refutes it.

Plaintiff maintains that the court's claim construction is untenable because under it, a competing product could infringe dependent claims 3 through 5 without infringing independent claim 1, from which claims 3 through 5 depend. This is because claims 3 through 5 each contain sets that incorporate a locus, HUMFESFPS, that is not listed in claim 1. For instance, claim 3 contains the following set of loci: "D16S539, D7S820, D13S317, D5S818, HUMF13A01, HUMFESFPS." Each of these loci is also listed in independent claim 1, *except* HUMFESFPS. Under the court's January 2, 2002 claim construction, selection and evaluation of this precise set without including other unidentified loci in the multiplex reaction would clearly infringe claim 3. Patent law provides that because claim 3 depends from claim 1, claim 1 must also be infringed. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. s. 112, para. 4. Therefore, "[o]ne who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim." Wahpeton Canvas Co., Inc. v. Frontier, Inc., 870 F.2d 1546, 1552 n. 9 (Fed.Cir.1989). However, the January 2, 2002 claim construction can be read in such a way that claim 1 would not be infringed. This is because (1) the January 2, 2002 opinion and order allows a competitor to avoid infringement by adding to the multiplex reaction an additional loci not identified in step (b) of a claim and (2) the HUMFESFPS locus is not identified in the list of loci identified in step (b) of claim 1. Because HUMFESFPS is not identified in step (b) of claim 1, its presence in the set "D16S539, D7S820, D13S317, D5S818, HUMF13A01, HUMFESFPS" serves to render the resulting reaction non-infringing with respect to independent claim 1, although the use of that set would infringe dependent claim 3. The same analysis applies to dependent claims 4 and 5, which include the HUMFESFPS locus in a listed set.

According to plaintiff, this anomaly is a result of faulty claim construction. The presence of HUMFESFPS

in dependent claims 3 through 5 can be explained, consistently with well-established patent law, only by a construction of claims 1 through 5 (and the similarly structured claim 16) that recognizes that infringement cannot be avoided simply by including unlisted loci in the multiplex reaction described in step (c). For instance, according to plaintiff's proposed interpretation, a multiplex reaction containing the set "D16S539, D7S820, D13S317, D5S818, HUMF13A01, HUMFESFPS" will infringe claim 3 but will also infringe claim 1. Even though HUMFESFPS is not listed in step (b) of claim 1, all of the limitations of claim 1 are met because a set of at least four loci identified in claim 1 (D16S539, D7S820, D13S317, D5S818, HUMF13A01) is present in the multiplex reaction. The fact that a locus not identified in claim 1, HUMFESFPS, is also present in the multiplex reaction does not mean that claim 1 is not infringed. Thus, a competing product that infringes dependent claim 3 will also infringe independent claim 1. *See* Wahpeton, 870 F.2d at 1552 n. 9 ("One may infringe an independent claim and not infringe a claim dependent on that claim. The reverse is not true."). In response, defendants argue that "it is clear that the presence of HUMFESFPS in the dependent claims [3]-5 is an oversight" that "the examiner did not notice." It is possible that this is true, but the possibility of examiner oversight is too weak a reed upon which to rest the court's earlier claim construction in light of the indisputable presence of the HUMFESFPS locus in claims 3 through 5. *See* Semiconductor Energy Lab Co. v. Samsung Electronics Co., 204 F.3d 1368, 1377 (Fed.Cir.2000) (examiner is presumed to have done his job correctly). Accordingly, I conclude that in claims 1 through 5 and 16 of the '660 patent, the multiplex reaction of limitation (c) is open to additional unlisted loci or sets of loci, provided that at least one of the sets derived from limitation (b) of these claims is present in the reaction.

Plaintiff goes on to argue that not only is the multiplex reaction of step (c) open, the sets selected in step (b) are themselves open to additional unlisted loci. As discussed above, I concluded in the January 2 order that a March 1998 examiner's amendment undermined this argument. I reasoned that the amendment effectively closed the sets by rewriting pre-amendment claim 1(b)'s requirement that "at least four of the loci in the set" be chosen from the listed group to require that "*the* at least four loci in the set" be chosen from the listed group. I agreed with defendants that the significance of this change in wording was to require that all the loci in a set, whether four or more, be selected from the *Markush* group in step (b). Plaintiff argues that this was error because the amendment was not substantive, but was made instead to conform the claim to standard patent claim drafting procedure, which requires that an element of a claim be preceded by a definite article, such as "the," each time it is referred to after its initial appearance in a claim. According to plaintiff, the amendment merely moved the incorrectly positioned definite article "the" from the middle of an element ("at least four of *the* loci") into its proper position in front of that element (" *the* at least four loci.")

I cannot say that plaintiff's explanation is entirely implausible. Accordingly, both plaintiff and defendants have advanced reasonable explanations for the examiner's amendment, although predictably, the competing explanations have significantly divergent repercussions for the scope of the disputed claims. Although in the court's original claim construction order I accepted defendants' theory about the meaning and significance of the examiner's amendment, I agree with plaintiff that it was error to significantly narrow the scope of its claims on the basis of that amendment, unaccompanied as it was by any explanation by the examiner or clear statement from the applicants regarding the amendment's significance. Although "explicit statements made by a patent applicant during prosecution to distinguish a claimed invention over prior art may serve to narrow the scope of a claim," Spectrum Int'l, Inc. v. Sterilite Corp., 164 F.3d 1372, 1378 (Fed.Cir.1998), plaintiff made no explicit statement during prosecution that can be read to limit the scope of its claims in the manner I suggested in the original claim construction order.

Indeed, the only explicit statement in the prosecution history on this topic favors plaintiff's proposed construction. On May 13, 1997, during the prosecution of claim 1, plaintiff agreed to an amendment deleting the HUMFESFPS locus from that claim's *Markush* group. However, in remarks accompanying that amendment, plaintiff noted that "the amendments to claim 1 do not change the fact that the claimed method encompasses the co-amplification and evaluation of sets of short tandem repeat loci which include the deleted locus, provided at least four of the loci in the set ... are selected from the remaining group of loci listed in claim 1." There is no clear evidence in the subsequent prosecution history suggesting that the examiner objected to this assertion or that the applicants disavowed explicitly the broad claim scope that it suggests. Therefore, I conclude now that the subsequent March 1998 examiner's amendment is too ambiguous to support an inference that the sets referred to in the disputed claims were limited in the fashion suggested by the court's original claim construction. Accordingly, I will adopt plaintiff's proposed claim construction that

Claims 1 through 5 and 16 of the '660 Patent require the presence of at least one of the sets identified in the *Markush* groups stated in limitation (b) of those claims but do not exclude the presence of other STR loci in the multiplex reaction required by limitation (c) of those claims.

II. MOTION TO PREVENT DISCLOSURE OF PLAINTIFF'S TRADE SECRETS

Plaintiff seeks an order blocking disclosure of its trade secrets to Dr. Richard Gibbs, one of defendants' experts. On September 24, 2001, the parties agreed to a protective order governing the disclosure of confidential information, including trade secrets, during the course of this litigation. The protective order allows the parties to designate as confidential proprietary information entitled to protection under Fed.R.Civ.P. 26(c)(7). Particularly sensitive confidential information can be further designated "attorneys' eyes only." Before information so designated can be disclosed to an expert such as Dr. Gibbs, the party wishing to make the disclosure must obtain a signed "undertaking" in which the expert acknowledges having read the protective order and promises to be bound by it. In addition to the signed undertaking, the party wishing to disclose information to an expert must disclose to opposing counsel the expert's name, address, employer, job description, information regarding the expert's relationship to the parties and consulting activities over the past three years. Provision is also made for obtaining additional information about the expert if necessary. If, despite the signed undertaking, a party still objects to disclosing its confidential information to a particular expert, it may move for a court order blocking disclosure to that expert or allowing disclosure only under certain conditions. Plaintiff has moved for such an order regarding Dr. Gibbs.

Plaintiff objects to disclosing protected information to Dr. Gibbs because he is the president of one company and sits on the scientific advisory boards or consults informally with six other companies that compete or may compete with plaintiff in the future in markets for various technologies. In addition, plaintiff argues that the parties' resolution of an earlier disclosure dispute under the protective order in this case set the standard for resolving such skirmishes. In the earlier dispute, defendants objected to the disclosure of certain protected information to Dr. Randall L. Dimond, plaintiff's vice president and chief technical officer. Although the parties filed briefs with the court on that issue, they resolved the dispute without court intervention when plaintiff agreed to a series of restrictions in addition to those imposed by the protective order. These included a time-limited restriction on Dr. Dimond's participation in plaintiff's new product development and patent prosecution involving STR multiplexes and a requirement that, for a period of years following the end of this litigation, plaintiff provide defendants' counsel with certain scientific information and specifications concerning any new or modified STR multiplex products that plaintiff planned to release.

Plaintiff argues that this court should either force defendants to hire another expert or impose upon Dr. Gibbs conditions identical to those that plaintiff agreed to apply to its vice president and chief technical officer, Dr. Dimond.

As an initial matter, it is difficult to regard the latter of these alternatives as a sincere effort by plaintiff to break the current impasse. This alternative would require seven companies that are not connected to this lawsuit in any way (but for whom Dr. Gibbs consults to varying degrees) to provide plaintiff with detailed information on various of their new or modified products before their release for a period of years, regardless whether or to what extent Dr. Gibbs consulted on those products. When plaintiff made such a sweeping request, it must have realized that it would be rejected. Understandably, defendants assert that a requirement that Dr. Gibbs comply with the same restrictions embodied in the earlier disclosure agreement involving Dr. Dimond is an unjustifiable "one-size-fits-all" solution. I agree. Plaintiff's arguments notwithstanding, the issue of disclosing protected information to Dr. Gibbs is not on all fours with the earlier dispute regarding disclosure of such information to Dr. Dimond. This is because unlike Dr. Gibbs, Dr. Dimond is an employee of plaintiff, a company that competes directly with defendant Applera in the market for STR multiplex products. And Dr. Dimond is not just any employee - he is plaintiff's vice president and chief technical officer and presumably involved in a host of plaintiff's competitive decision making processes regarding its products. On the other hand, Dr. Gibbs is an independent expert who is not employed by defendants and does not consult for them.

The protective order itself recognizes the difference between an employee of a party, such as Dr. Dimond, and an independent expert, such as Dr. Gibbs. Under the protective order, disclosure of "attorneys' eyes only" information to an employee of a party is subject to more stringent standards than disclosure of such material to an independent expert who is not an employee or officer of any party. *Compare* Protective Order para. 9 *and* para. 11. Nevertheless, plaintiff contends that "its risk of trade secret misappropriation by Dr. Gibbs is exponentially greater than Applera's claimed risk with Dr. Dimond, given Dr. Gibbs's involvement with" the seven companies identified by plaintiff. Br. in Supp. of Promega's Mot. for an Order that Disclosure Not Be Made to Dr. Richard Gibbs, dkt. # 48, at 15. This argument is unpersuasive because it is founded upon the false premise that Dr. Gibbs performs the same functions for those seven companies that Dr. Dimond performs for plaintiff. Dr. Gibbs does not act as vice president and chief technical officer for each of the seven companies about which plaintiff is concerned. Indeed, for six of the seven he either provides informal advice or attends periodic meetings in his capacity as a member of the companies' scientific advisory boards. The suggestion that these services are analogous to those provided to plaintiff by Dr. Dimond is disingenuous. Accordingly, I am not convinced that the restrictions applied to Dr. Dimond set a standard that must also apply to Dr. Gibbs.

The question remains whether some lesser set of restrictions can be crafted that will allow disclosure of relevant information to Dr. Gibbs while taking into account plaintiff's understandable concern for the continued confidentiality of its trade secrets. The parties propose differing standards for making this determination. According to plaintiff, the party seeking to block disclosure "must show that (1) the interest for which protection is sought is an actual trade secret or other confidential business information protected under [Fed.R.Civ.P. 26(c)(7)], and that (2) there is good cause for the protective order." Andrew Corporation v. Rossi, 180 F.R.D. 338, 340 (N.D.Ill.1998). "To establish good cause ... the courts have generally required 'specific examples of articulated reasoning' as opposed to 'stereotyped and conclusory statements." ' Id. at 341 (party seeking to block disclosure must "prove that disclosure will result in a 'clearly defined and very serious injury' to its business") (citations omitted). In response, defendants argue that the court must weigh their interest in selecting the expert most beneficial to their case with plaintiff's interest in

protecting its information from disclosure to competitors. Advanced Semiconductor Materials America, Inc. v. Applied Materials, Inc., 1996 U.S. Dist. LEXIS 21459 at *8, 43 U.S.P.Q.2d (BNA) 1381, 1384 (N.D.Cal.1996); *Telular Corp. v. Vox2, Inc.,* 2001 U.S. Dist. LEXIS 7472 at (N .D. Ill.2001). Under either standard, I conclude that it is appropriate to deny plaintiff's motion.

Defendants have demonstrated that they have a significant interest in employing Dr. Gibbs as an expert in this case. Dr. Gibbs is a professor of molecular and human genetics at Baylor College of Medicine in Houston, Texas, and the director of the Baylor College of Medicine Human Genome Sequencing Center. He has served as the chairman of the Joint Genome Institute Advisory Committee and on the National Institutes of Health Genome Study Section for the Center for Scientific Review. He has extensive experience developing multiplex PCR technologies and, as defendants note, is the co-author of at least eight articles that are cited prior art to plaintiff's patents-in-suit.

Defendants have agreed to apply a set of restrictions to Dr. Gibbs in order to insure the integrity of plaintiff's trade secrets. First and foremost, Dr. Gibbs has agreed to be bound by the standing protective order in this case and, thus, not to "directly or indirectly utilize or disclose" plaintiff's confidential information "except for the purpose of this action only and in accordance with any further order issued by the Court." Protective Order, dkt. # 14, at para. 14. Violation of the order risks contempt sanctions. Second, although plaintiff expresses concern regarding the entire batch of some 360,000 documents it has produced to defendants in this case, defendants seek to disclose to Dr. Gibbs only "information solely relating to the research and development of Promega's STR multiplex products, which primarily consist of laboratory notebooks and related scientific documents dating from the mid-1990s and earlier." Deft. Applera's Opp'n to Promega's Mot. Regarding Disclosure to Professor Richard Gibbs, dkt. # 51, at 4. As plaintiff itself pointed out when seeking the disclosure to Dr. Dimond of defendants' confidential information, "laboratory notebooks dated more than three years ago are less likely to contain highly confidential, trade secret or proprietary information." Decl. of Joelle C. Luedtke in Supp. of Applera's Opp'n to Promega's Mot. Regarding Disclosure to Professor Richard Gibbs, dkt. # 53, at Ex. D. To insure that his access to confidential information is limited accordingly, defendants' trial counsel has agreed to keep a record of the information disclosed to Dr. Gibbs. Third, Dr. Gibbs has agreed to "refrain from consulting or having any other involvement concerning the development or modification of genetic identity products involving PCR-based STR multiplexing designed for use in forensic, paternity or bone marrow transplant monitoring applications, until two years after the termination of this litigation." *Id.* at 6. Finally, Dr. Gibbs will "inform in writing each of the companies for which he consults about the restrictions on his consulting activities." *Id.*

Plaintiff deems these safeguards unsatisfactory. Plaintiff asserts that it is not practical to limit Dr. Gibbs's review to information related to the research and development of its STR multiplex products because of the "intertwined nature of scientific information" in plaintiff's document production. According to plaintiff, at least the following seven technologies "are used in conjunction with STRs and are included in the Promega confidential documents" produced to defendants: DNA purification; DNA quantitation; DNA sequencing; human DNA quantitation; DNA fragment analysis; single nucleotide polymorphism ("SNP") analysis; and application process integration and automation. Dimond Decl., dkt. # 50, at para.para. 7-8. Plaintiff argues that the intertwined nature of this information, along with Dr. Gibbs's relationship with seven companies that have some connection to one or more of these technologies, should serve to disqualify him as an expert in this case because he will be unable to "compartmentalize knowledge gained from reviewing Promega's confidential documents and [therefore the] companies for which he consults will inevitably benefit from the confidential knowledge gained by [him]."

The sweeping nature of plaintiff's argument serves to undermine it. Were the court to adopt plaintiff's approach, defendants would face a monumental task in locating a well-qualified expert. Although defendants seek to disclose to Dr. Gibbs only "information solely relating to the research and development of Promega's STR multiplex products," plaintiff's approach assumes that such disclosure also implicates seven other distinct technologies. Further, plaintiff maintains that scientific advisory board members have a "profound influence on the strategic decisions of [a] company" and that the role of informal adviser is "not ... necessarily of less significance" than that of a scientific advisory board member. *Id* . at para.para. 14-15. Thus, the logic of plaintiff's argument dictates that any potential expert who sits on a scientific advisory board or informally advises any company involved in STR multiplexing, DNA purification, DNA quantitation, DNA sequencing, human DNA quantitation, DNA fragment analysis, SNP analysis or application process integration or automation that may compete with plaintiff would be unacceptable because Dr. Gibbs cannot compartmentalize the knowledge he will gain as defendants' expert.

In *Advanced Semiconductor,* 1196 U.S. LEXIS 21459, at *8, the defendant objected to the disclosure of confidential information to the plaintiff's expert under the terms of a protective order because the expert would "inevitably misuse [the] information if he consults for [the defendant's] competitors in the future because the information will be in his head." *Id*. The court rejected this argument, noting that "this cannot be the standard to be applied. If it was, then a litigant could successfully object to any active industry consultant in any high technology litigation, thereby giving it power of veto over its adversary's choice of experts." *Id*. Plaintiff's expansive theory regarding the disqualification of experts would give it a similar veto power. Although plaintiff maintains that "[s]urely Applera can hire another expert," I do not share this optimism given plaintiff's intransigent position regarding Dr. Gibbs.

I have examined plaintiff's specific objections regarding the seven companies with which Dr. Gibbs has some affiliation. Plaintiff does not raise any substantial concerns regarding the two companies that Dr. Gibbs advises informally (Picoscript and Genpharmix). Plaintiff's arguments regarding two other companies (Exelixis and Genemachines) deal exclusively with technologies other than the development of STR multiplex products. Plaintiff's bare assertion that these various other technologies are hopelessly intertwined with the technology underlying its STR multiplexing products is insufficient to demonstrate good cause for its proposed order blocking disclosure to Dr. Gibbs. Plaintiff's arguments regarding two different companies (Pyrosequencing and Stratgene) are either speculative ("Stratagene appears to be pursuing" the use of STRs; certain Pyrosequencing technologies "are likely to compete" with plaintiff's) or involve technologies or markets other than those associated with STR multiplexing products.

The seventh company, SeqWright, merits more attention because Dr. Gibbs is its president and founder. Plaintiff objects because "SeqWright performs STR and SNP analysis" and, in particular, it "promotes its ability to perform multiplex STR analysis and devise custom multiplex STR analysis and SNP analysis." However, SeqWright does not sell STR multiplexing products. Decl. of Dr. Richard Gibbs, dkt. # 52, at para. 6. (It is significant that none of the seven companies identified by plaintiff sell STR multiplexing products. *Id*. at para.para. 6-12.) As defendants point out, plaintiff has not explained how this fact squares with its argument that SeqWright competes with it in the market for the sale of STR multiplexing products, as opposed to the market for STR analysis services. Moreover, SeqWright has not performed STR analysis for any customer for over two years. *Id*. at para. 6. Dr. Gibbs will not have access to plaintiff's non-public information relating to the synthesis of fluorescently labeled dye primers, which is an area of potential competition between SeqWright and plaintiff. When I add to this Dr. Gibbs's willingness to abide by the protective order and forgo any participation in the development or modification of genetic identity products

involving PCR-based STR multiplexing designed for use in forensic, paternity or bone marrow transplant monitoring applications, until two years after the termination of this litigation, I am convinced that plaintiff has failed to demonstrate that its motion to block disclosure to Dr. Gibbs is supported by good cause.

Accordingly, I conclude that defendants' interest in selecting Dr. Gibbs as their expert, in conjunction with the safeguards defendants have proposed, outweighs plaintiff's speculative fear that it will suffer competitive injury as a result of disclosing to Dr. Gibbs limited information related to the research and development of its STR multiplex products.

ORDER

IT IS ORDERED that

1. Claims 1 through 5 and 16 of U.S. Patent No. 5,843,660 are construed to require the presence of at least one of the sets identified in the *Markush* groups stated in limitation (b) of those claims but do not exclude the presence of other STR loci in the multiplex reaction required by limitation (c) of those claims; and

2. Plaintiff's motion for an order that disclosure of its trade secrets not be made to Dr. Richard Gibbs is DENIED. Dr. Gibbs is allowed access to "confidential" and "attorneys' eyes only" information relating solely to the research and development of plaintiff's STR multiplex products. Defendants' trial counsel are directed to keep a record of the information disclosed to Dr. Gibbs. Access to this information is contingent upon the understanding that Dr. Gibbs (1) is bound by the protective order in this case; (2) will refrain from consulting or having any other involvement concerning the development or modification of genetic identity products involving PCR-based STR multiplexing designed for use in forensic, paternity or bone marrow transplant monitoring applications until two years after the termination of this litigation; and (3) will inform in writing each of the companies for which he consults about these restrictions on his consulting activities.

W.D.Wis.,2002.
Promega Corp. v. Applera Corp.