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FISH & RICHARDSON P.C.

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August 13, 2010

The Honorable Leonard P. Stark
J. Caleb Boggs Federal Building
844 North King Street
Unit 26, Room 6100
Wilmington, DE 19801-3556

Re: *Allergan, Inc. v. Barr Laboratories, Inc. et al.*
USDC-D. Del. - C.A. No. 09-333-SLR/LPS (Consolidated Action)

Dear Magistrate Judge Stark:

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Plaintiff (“Allergan”) respectfully submits this letter pursuant to the Court’s August 4, 2010 direction that the parties meet and confer to further narrow their dispute concerning Allergan’s inadvertent production of privileged documents. Allergan and Barr met and conferred on August 11, 2010. Sandoz did not participate. Allergan believes it has resolved the dispute with Barr except for Barr Exhibit Nos. 4-8 and 19. (*See* D.I. 107, Exs. 4-8.)

Records of invention (Exhibits 4, 5, 6 and 8): Barr continues to pursue the reproduction of Barr Exhibits 4, 5, 6, and 8, all of which are records of invention (“ROIs”). Barr claims that Allergan waived privileged by virtue of their inadvertent production in the *Pharmacia* case, or alternatively, that these Exhibits are not protected by the attorney-client privilege in the first instance. Allergan originally understood Barr solely to advance a waiver argument on these Exhibits. Indeed, Allergan inadvertently produced and clawed back 11 other ROIs, and Barr chose not to pursue reproduction of those documents. (*Compare* D.I. 108, Ex. D (Allergan Privileged Document Log (July 14, 2010) at Doc. Nos. 38-45 & 47-49), *with* D.I. 107.) However, during the August 4, 2010 call with the Court, Barr stated that it also disputed whether Exs. 4, 5, 6, & 8 are privileged.

Allergan and Barr discussed Exhibits 4, 5, 6, and 8 during their August 10 meet and confer. Allergan rearticulated its position that these ROIs are protected by the attorney-client privilege under Federal Circuit precedent and that the privileged nature of the documents is evident from the documents themselves. Specifically, they are titled “Record of Invention,” they describe what was believed to be invented, the apparent inventors, and the apparent date of conception. Allergan also informed Barr that it was exploring obtaining a declaration from a company employee to support its arguments that the documents were privileged. Barr did not further inquire about Allergan’s proposed declaration after the August 10 meet and confer.

The Federal Circuit has held that “an invention record constitutes a privileged communication, so long as it is provided to an attorney ‘for purposes of securing primarily legal opinion, or legal services, or assistance in a legal proceeding.’” *In re Spalding*, 203 F.3d 800, 805 (Fed. Cir. 2000) (quoting *Knogo Corp. v. United States*, 213 USPQ 936, 940 (Ct. Cl. 1980)). As demonstrated below, and in Michael E. Garst’s declaration, each of Exhibits 4, 5, 6 and 8 is protected by the attorney-client privilege under *Spalding*.

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Each of Exhibits 4, 5, 6, and 8 is an ROI that is consistent with an ROI that would have been prepared by an Allergan employee and submitted to the Allergan Legal Department in accordance with the standard process at Allergan for pursuing patent protection. (*Id.* ¶¶ 6-9.) Thus, they are protected by the attorney-client privilege. *In re Spalding*, 203 F.3d at 806 (“Accordingly, since Spalding’s invention record was prepared and submitted primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application, we conclude that it is privileged in its entirety.”).

Based on the foregoing, Allergan has met its burden to establish the privileged nature of Exhibits 4, 5, 6 and 8. There is no reasonable dispute that these documents are ROIs protected under *Spalding*. However, Allergan is prepared to provide additional information or conduct further investigations should the Court require it.

Document protected as attorney-work product (Exhibit 7): Barr Exhibit No. 7 (AGN-BAR-01161298-305) is protected by the work-product doctrine. “Under the attorney work-product doctrine, documents prepared by counsel or at counsel’s direction in preparation for trial or in anticipation of litigation are not discoverable absent a showing of substantial need, undue hardship, or inability to obtain their equivalent by other means.” *WebXchange Inc. v. Dell Inc.*, 264 F.R.D. 123, 128 (D. Del. 2010); Fed. R. Civ. P. 26(b)(3). Because all the elements of the work-product doctrine are satisfied, it operates to protect AGNBAR-01161298-305 from reproduction.

The first four pages of Exhibit 7, AGN-BAR-01161294-197, comprise a list of “Lumigan Media Coverage.” Allergan does not claim that these four pages are protected by the work-product doctrine or the attorney-client privilege. However, Allergan maintains its claim that the remaining pages of Exhibit 7, AGN-BAR-01161298-305, are protected by the work-product doctrine. Allergan proposed redacting pages AGN-BAR-01161298-305 from Exhibit 7 on two separate occasions, but Barr will not agree to the proposed redaction.

Pages AGN-BAR-01161298-305 of Exhibit 7 comprise a chart captioned “*Allergan v. Pharmacia*, U.S. District Court for the District of Delaware, Civil Action No. CV 01-141.” The chart provides a summary of documents relevant to the litigation broken down by category, Allergan contact, inquiry, and source. The chart is dated March 14, 2001, which is two weeks after the Pharmacia litigation was filed. (*See* D.I. 109, ¶3 (Campbell Dec.)) These pages constitute attorney-work product because (1) the chart indicates on its face that it was prepared pursuant to the ongoing *Pharmacia*

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litigation; (2) the document's content is unquestionably related the *Pharmacia* litigation, including at least the discovery phase; and (3) although Allergan has not yet been able to identify the author of this document, which was prepared 9 years ago, it contains the type of information that would be prepared by an attorney or at an attorney's direction in anticipation of litigation or for trial. Furthermore, these pages appear to have been inadvertently and inappropriately attached to an otherwise non-privileged document.

Because AGN-BAR-01161295-305 satisfies the elements required to establish protection under the work-product doctrine, they are protected as such. Barr has not, and cannot make any showing why Allergan should be compelled to produce these protected documents. *Dell*, 264 F.R.D. at 128.

Exhibit 19: Exhibit 19, on its face, is a cover page for a literature search seeking articles on amidases in the human eye requested by attorney(s) for Allergan for the purposes of the *Pharmacia* litigation. Barr does not apparently seek the inadvertently produced Exhibit 19 anymore, but rather the results of the search that was never produced in this case. Allergan learned that Barr intended to today seek the literature search itself on the afternoon of August 13 when Barr filed its letter to the Court. First, Barr has changed the dispute to a new issue that was not before the Court during the conference and thus should not be considered. Second, a literature search done by an attorney in anticipation of litigation is plainly work product and not subject to disclosure. If the Court is prepared to take up this issue, Allergan asks for an opportunity to provide the Court with the challenged document *in camera*, along with any supporting evidence it can gather through investigation. For the record, Allergan notes that Barr is using the information learned from the document that it no longer challenges as privileged (the cover page) in order to argue the lack of privilege over the attachment. This is improper argument under the Federal Rules of Civil Procedure.

Waiver: On the issue of waiver, Allergan relies on the arguments it made in its July 29 filing and in the Campbell Declaration. In summary, Allergan's investigation revealed no evidence that Exhibits 4-8 were deliberately produced in *Pharmacia*. That conclusion is particularly supported with respect to these documents (four records of invention and a document clearly prepared by attorneys gathering documents for the *Pharmacia* litigation). The fact that they were produced a second time in this case, despite extensive precautions, should not compel granting Barr's application. In document productions involving the gathering and production of millions of pages, such mistakes are unfortunate, but not unheard of. Allergan's efforts should more than satisfy the requirement that it take reasonable precautions to prevent inadvertent production.

Respectfully submitted,

/s/ Douglas E. McCann

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