

PUBLIC VERSION: FILED AUG. 6, 2010

FISH & RICHARDSON P.C.

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July 30, 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:

Plaintiff (“Allergan”) respectfully requests that the Court deny Defendants’ letter application (D.I. 107) to compel production of inadvertently produced privileged documents (most, if not all, of which are of marginal relevance in this case). For twenty of these documents (D.I. 107 Exhibits 2-21), Defendants do not substantively challenge that they are privileged. Defendants instead only contend that Allergan waived the privilege by producing them in an earlier litigation in this Court (the “*Pharmacia* litigation”), or by failing to take reasonable steps to prevent production in this litigation. Allergan details below and in a supporting declaration (“Campbell Dec.”) that it far exceeded the requirements of the law in trying to prevent the inadvertent disclosure of this privileged information. Next, with respect to eight documents (D.I. 107 Exhibits 27-34), Allergan demonstrates from the documents themselves and by an *in camera* declaration (“Baran Dec.”) that these documents are privileged. Finally, Allergan withdraws its claim of privilege with respect to the six remaining exhibits (D.I. 107 Exhibits 1, 22-26).

Documents produced in *Pharmacia* (Exhibits 2-21). Defendants claim that Allergan’s production of Exhibits 2-21 in the *Pharmacia* litigation amounts to a waiver (1) by the mere fact of their production in the *Pharmacia* case, and (2) because some of them were inadvertently produced twice (once in *Pharmacia*, and once in this this case), Allergan must not have taken reasonable steps to prevent disclosure.

On the first argument, Defendants offer no evidence that the *Pharmacia* disclosure was a knowing waiver. The evidence in the record is that it was not. (Campbell Dec., ¶ 12.) Defendants’ case law on this point is inapposite. Defendants cite *Shell Oil* for the proposition that voluntary, knowing disclosure constitutes a waiver. 772 F. Supp. 202, 207 (D. Del. 1991). But that case is irrelevant, as it was limited to the “narrow issue” of the government’s waiver of a privilege by *voluntary* oral disclosure. *Id.* at 204, 206, 211. In *Genentech*, the Federal Circuit affirmed an ALJ ruling that “Genentech’s waiver of privilege in the district court was a general waiver that could be asserted in the ITC proceeding.” 122 F.3d 1409, 1418 (Fed. Cir. 1997). The district court found Genentech waived because “Genentech did not use adequate procedures to prevent [inadvertent] disclosure” of 12,000 pages of privileged documents. *Id.* at 1413, 1415. Genentech only challenged the applicability of the district court waiver in the ITC forum, not the finding of waiver itself. *Id.* at 1416. In contrast to *Genentech*, the *Pharmacia* Court never found that Allergan waived privilege of Exhibits 2-22, either by inadvertent or intentional disclosure, and never found Allergan’s

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procedures to prevent inadvertent disclosure in *Pharmacia* inadequate. Thus, Defendant's case law provides no basis for finding waiver based on prior production in *Pharmacia*.

As to the second argument, Federal Rule of Evidence 502(b) provides that the disclosure of attorney-client privileged communications does not operate as a waiver if "(1) the disclosure was inadvertent; (2) the holder of the privilege or protection took reasonable steps to prevent disclosure; and (3) the holder promptly took reasonable steps to rectify the error." Fed. R. Evid. 502(b). Because each of these elements is satisfied, no waiver has occurred.

First, the evidence is clear that the disclosure was inadvertent. Allergan was unaware that these documents had been produced in either litigation until just weeks ago. (Campbell Dec. ¶¶ 11, 12) Allergan investigated to determine if, during the *Pharmacia* litigation nine years ago, these documents were (1) deliberately produced, or (2) alternatively, were inadvertently produced, but a decision was made not to claw them back. So far as Allergan has been able to determine, there is no evidence to support either proposition. (*Id.* at ¶ 12.) Thus, the production of Exhibits 2-21 in *Pharmacia* was inadvertent. (*Id.*) The production of the documents in this litigation was also inadvertent. (*Id.* at ¶ 11.) Moreover, in *Pharmacia*, Judge Robinson ordered that the inadvertent production of privileged information would not be deemed a waiver, provided that the producing party made prompt notice upon discovery. (*Id.* at Ex. A, ¶ 16.) Upon discovery, Allergan gave prompt notice to the Defendants in this case; there was no need to notify the *Pharmacia* parties, because the *Pharmacia* parties destroyed their copies when that case was dismissed years ago. (*Id.* at Ex. A, ¶ 22.)

Second, Allergan took reasonable steps—both here and during the *Pharmacia* litigation—to prevent inadvertent disclosure. In the *Pharmacia* case, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] Despite these reasonable measures, Allergan inadvertently produced 49 documents it considered privileged, amounting to just 145 pages (the dispute has now narrowed to 28 documents). (*Id.* at ¶ 11.) Compared to the [REDACTED] [REDACTED] pages produced (*id.*), this can hardly be viewed as careless enough to amount to a waiver, particularly in consideration of Allergan's exhaustive privilege screen procedures.

Third, consistent with the Protective Order, Allergan notified the Defendants and requested that Defendants destroy all unintentionally produced documents. (D.I. 65, ¶ 8; Exhibits A-D attached hereto.) Defendants do not dispute that Allergan took prompt action to rectify its error of having produced these privileged documents, consistent with the Protective Order and Rule 502(b).

Because Allergan's production of these documents was inadvertent, reasonably guarded against and promptly rectified, Rule 502(b) operates to maintain the privilege.

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Communications between counsel and employees (Exhibits 27-31, 34). The attorney-client privilege protects from compelled disclosure “any communication that satisfies the following elements: it must be ‘(1) a communication (2) made between privileged persons (3) in confidence (4) for the purpose of obtaining or providing legal assistance for the client.’” *In re Teleglobe*, 493 F.3d 345, 359 (3d Cir. 1997). Defendants’ claim that Exhibits 27-31 & 34 are not privileged because they are only memoranda to counsel attaching scientific data ignores the substance and purpose of the documents, as well as applicable law. As demonstrated below, and in Robert Baran, Esq.’s declaration submitted *in camera*, each of these documents is privileged.

Each of Exhibits 27-31 & 34 is a confidential communication between an Allergan attorney and employee for purposes of seeking legal advice concerning [REDACTED] (Baran Dec. ¶¶ 8-14.) These documents contain technical data and/or commentary that would assist Allergan’s counsel for the reasons described in Mr. Baran’s declaration, and counsel would have no need for that data and/or commentary except for these purposes. (*Id.*)

Defendants concede that the communications themselves are privileged, but seek the data. (D.I. 107 at 3.) This is a distinction without a difference. *In re Spalding*, 203 F.3d 800, 806 & n.3 (Fed. Cir. 2000) (finding that the inclusion of technical data in an invention record does not render the document discoverable, “because request for legal advice on patentability or legal services in preparing a patent application necessarily require the evaluation of technical information”). Where, as here, communications between privileged persons including technical data and/or commentary were made for purposes of obtaining legal advice or assistance or enabling counsel to provide legal advice, the attorney-client privilege applies. *Smithkline Beecham Corp. v. Apotex, Inc.*, 232 F.R.D. 467, 480 (E. D. Pa. 2005) (“Where client and counsel share technical information, that communication is privileged as long as it was made for the purpose of securing legal advice or legal services, or conveying legal advice.”); *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 538 (N.D. Ill. 2000) (protecting under *In re Spalding* documents “involving reports of technical information or results of tests requested by attorneys” that were “prepared in order to allow attorneys to assess patentability and sift information to prepare applications”); *Rohm & Haas Co. v. Brotech Corp.*, 815 F. Supp. 793, 797 (D. Del. 1993) (protecting as privileged a memorandum to counsel including scientific data provided for assisting counsel with an interference).

Lastly, Defendants’ challenge to Exhibits 32 & 33 mischaracterizes the substance of the communication. These confidential e-mails were sent by an Allergan employee, David Woodward, to other Allergan employees including attorney Martin Voet. These e-mails seek legal advice concerning [REDACTED] and concern matters within the scope of Allergan attorneys’ normal duties as explained by Mr. Baran. (Baran Dec. ¶ 13.)

Respectfully submitted,

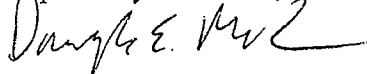

Douglas E. McCann

EXHIBIT A

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA E-MAIL

June 17, 2010

Ryanne Easley, Esq.
Winston & Strawn LLP
35 W. Wacker Drive
Chicago, IL 60601-9703

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

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Dear Ryanne:

We write to advise you regarding the following inadvertently produced documents, AGN-BAR-01195929, AGN-BAR-01195934 and AGN-BAR-01195935, that should have been withheld subject to a claim of attorney-client privilege and/or work product immunity.

Pursuant to the Protective Order (D.I. 65, ¶ 8), we request that you destroy these unintentionally disclosed documents and all copies and derivations. Please confirm you have taken these steps. Please also find enclosed a privilege log for these documents.

Very truly yours,

/s/ Douglas E. McCann

Douglas E. McCann

DEM/clh

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EXHIBIT B

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA E-MAIL

June 24, 2010

Ryanne Easley, Esq.
Winston & Strawn LLP
35 W. Wacker Drive
Chicago, IL 60601-9703

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

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Dear Ryanne:

We write to advise you regarding the following inadvertently produced documents, AGN-BAR-00418984-985; AGN-BAR-01050195-200; AGN-BAR-01050321-325; AGN-BAR-02047546-553; AGN-BAR-00888553; AGN-BAR-01050195-200, AGN-BAR-02086771-773, and AGN-BAR-02086748-750 that should have been withheld subject to a claim of attorney-client privilege and/or work product immunity.

Pursuant to the Protective Order (D.I. 65, ¶ 8), we request that you destroy these unintentionally disclosed documents and all copies and derivations. Please confirm you have taken these steps. Please also find enclosed a privilege log for these documents. At a later time, and to the extent we deem necessary, we will provide redacted versions of the foregoing documents along with a redaction privilege log.

Very truly yours,

/s/ Douglas E. McCann

Douglas E. McCann

DEM/clh

Enclosure

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EXHIBIT C

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA E-MAIL

July 6, 2010

Ryanne Easley, Esq.
Winston & Strawn LLP
35 W. Wacker Drive
Chicago, IL 60601-9703

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

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Dear Ryanne:

We write to advise you regarding the following inadvertently produced documents AGN-BAR-00347165; AGN-BAR-00367961; AGN-BAR-00368832; AGN-BAR-00381588; AGN-BAR-00475454; AGN-BAR-00501399; AGN-BAR-00501401; AGN-BAR-01047196; AGN-BAR-01047295; AGN-BAR-01065348; AGN-BAR-01092386; AGN-BAR-01092387; AGN-BAR-01133502; AGN-BAR-01136364; AGN-BAR-01136453; AGN-BAR-01142539; AGN-BAR-01142540; AGN-BAR-01142698; AGN-BAR-01161294; AGN-BAR-01195624; AGN-BAR-01204276; AGN-BAR-01307191; AGN-BAR-01321847; AGN-BAR-02086921; AGN-BAR-01145761; AGN-BAR-01321549-551 that should have been withheld subject to a claim of attorney-client privilege and/or work product immunity.

Pursuant to the Protective Order (D.I. 65, ¶ 8), we request that you destroy these unintentionally disclosed documents and all copies and derivations. Please confirm you have taken these steps. Please also find enclosed a privilege log for these documents. At a later time, and to the extent we deem necessary, we will provide redacted versions of the foregoing documents along with a redaction privilege log.

Very truly yours,

/s/ Douglas E. McCann

Douglas E. McCann

DEM/clh

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EXHIBIT D

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA E-MAIL

July 14, 2010

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

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Dear Ryanne:

We write to advise you regarding the following inadvertently produced documents AGN-BAR-00476561-577; AGN-BAR-00894759-774; AGN-BAR-00919245-247; AGN-BAR-01047112-113; AGN-BAR-01047115-118; AGN-BAR-01047119-122; AGN-BAR-01047168-171; AGN-BAR-01047306-307; AGN-BAR-01047365-366; AGN-BAR-01047430-431; AGN-BAR-01140775; AGN-BAR-01548320-322; AGN-BAR-02076375-376; AGN-BAR-02076389-390 that should have been withheld subject to a claim of attorney-client privilege and/or work product immunity.

Pursuant to the Protective Order (D.I. 65, ¶ 8), we request that you destroy these unintentionally disclosed documents and all copies and derivations. Please confirm you have taken these steps. Please also find enclosed a privilege log for these documents (Doc. Nos. 36-49).

Very truly yours,

/s/ Douglas E. McCann

Douglas E. McCann

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