

No. 16-

IN THE
Supreme Court of the United States

JOHNSON & JOHNSON VISION CARE, INC.,
Petitioner,

v.

REMBRANDT VISION TECHNOLOGIES, L.P.,
Respondent.

On Petition For A Writ Of Certiorari To The
United States Court Of Appeals
For The Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

GREGORY L. DISKANT	PAUL M. SMITH
EUGENE M. GELERNTER	<i>Counsel of Record</i>
LAURA B. KAUFMAN	ISHAN K. BHABHA
PATTERSON BELKNAP WEBB & TYLER LLP	JENNER & BLOCK LLP
1133 Avenue of the Americas	1099 New York Ave., NW
New York, NY 10036	Suite 900
(212) 336-2000	Washington, DC 20001
	(202) 639-6000
	psmith@jenner.com

Counsel for Petitioner

QUESTIONS PRESENTED

Fed. R. Civ. P. 60(b)(3) authorizes a losing party to seek to reopen a final judgment based on a showing of “fraud . . . , misrepresentation, or misconduct by an opposing party” that has denied the movant a full and fair opportunity to present its case. The circuits are sharply split on the burden of proof required for such relief, the showing that is necessary to meet the burden, the identity of the party that must bear the burden under particular circumstances, the meaning of “an opposing party,” and what constitutes “misconduct”. The questions presented are:

1. Whether a movant must show that it has been denied a full and fair opportunity to present its case by “clear and convincing evidence,” as the Third, Fifth, Seventh, Eighth, and Eleventh Circuits have held; or must the movant instead show “substantial interference” in the presentation of its case, as the Ninth, Tenth, and D.C. Circuits have held; or does the burden on this issue shift under certain circumstances to the party opposing a Rule 60(b)(3) motion, as the First and Sixth Circuits have held; or is there no requirement to show any real effect on the proceeding at all, as the Federal Circuit has held here.

2. Whether “misrepresentations . . . of an opposing party” under Fed. R. Civ. P. 60(b)(3) include misrepresentations by an expert witness, unknown to the party or its counsel, as the Federal and Eleventh Circuits have held, or cannot be attributed to the party without the complicity of the party or its counsel, as the Seventh and D.C. Circuits have held.

3. Whether “misconduct” under Fed. R. Civ. P. 60(b)(3) includes purely accidental and unintentional omissions in the course of discovery, as the First, Fifth, Eleventh and Federal Circuits have held, or requires a showing of improper or wrongful behavior, as the Sixth Circuit has held.

RULE 29.6 STATEMENT

Johnson & Johnson Vision Care, Inc. is a subsidiary of Johnson & Johnson, which owns 10% or more of Johnson & Johnson Vision Care, Inc.'s stock. Johnson & Johnson is a publicly held company.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Johnson & Johnson Vision Care, Inc., respectfully petitions this Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINION AND ORDER BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is published at 818 F.3d 1320 (Fed. Cir. 2016). Pet. App. 1a-34a. The opinion of the United States District Court for the Middle District of Florida is published at 300 F.R.D. 694 (M.D. Fla. 2014). Pet. App. 35a-48a.

JURISDICTION

The judgment of the court of appeals was entered on April 7, 2016. A timely petition for rehearing and rehearing en banc was denied on July 11, 2016. Pet. App. 126a-127a. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

RELEVANT FEDERAL RULE

Federal Rule of Civil Procedure 60 provides, in relevant part:

(b) Grounds for Relief from a Final Judgment, Order, or Proceeding. On motion and just terms, the court may relieve a party or its legal representative from a final judgment, order, or proceeding for the following reasons:

- (1) mistake, inadvertence, surprise, or excusable neglect;
- (2) newly discovered evidence that, with reasonable diligence, could not have been

discovered in time to move for a new trial under Rule 59(b);

(3) fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;

(4) the judgment is void;

(5) the judgment has been satisfied, released or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or

(6) any other reason that justifies relief.

INTRODUCTION

Rule 60(b)(3) of the Federal Rules of Civil Procedure gives district courts the authority to relieve a party from an adverse judgment, even after it is final, based on a showing of “fraud . . . , misrepresentation, or misconduct by the opposing party.” Although this rule has been in effect since 1948, it has never been meaningfully addressed by this Court. As a result, the federal circuits have adopted a multiplicity of conflicting approaches – reflecting “major area[s] of controversy in Rule 60(b)(3) jurisprudence,” *Jordan v. Paccar, Inc.*, 97 F.3d 1452, 1996 WL 52890, at *7 (6th Cir. 1996) (unpublished table decision) – about how this rule should operate. These conflicts involve: (1) the burden of proof, the identity of the party that must bear the burden, and the quantum of evidence necessary for proving that alleged fraud or misconduct denied a party a full and fair opportunity to litigate; (2) whether “misconduct . . . by an opposing party” includes an expert’s misconduct, absent the complicity of the party who presented the expert or its counsel; and (3) whether “misconduct” includes inadvertent omissions.

This case provides the Court with an opportunity to resolve all of these circuit conflicts. The case also illustrates the need for greater clarity in this area of the law, because the reasoning adopted by the Federal Circuit, in a decision that watered down at every turn the showings demanded of the moving party, gives far too little weight to the important value of respecting the finality of judgments.

STATEMENT OF THE CASE

A. Factual Background and Trial Proceedings

In 2009, respondent Rembrandt Vision Technologies, L.P.'s ("Rembrandt") sued petitioner Johnson & Johnson Vision Care, Inc. ("JJVC") for patent infringement, alleging that JJVC's Acuvue Advance® and Acuvue Oasys® contact lenses infringed Rembrandt's U.S. Patent No. 5,712,327 ("327 patent"). During a 2012 trial, the parties disputed whether JJVC's lenses met two separate elements required to prove infringement – whether the lenses were "soft" and whether they had a "surface layer," both as claimed in the '327 patent. To prove its claim of patent infringement, Rembrandt was required to prove both elements.

As regards the "soft" limitation, the court found that, for purposes of the '327 patent, a "soft gas permeable contact lens" is "a contact lens having a Hardness (Shore D) less than five." Pet. App. 51a. In seeking to prove infringement of this claim element — namely that JJVC's lenses had a Shore D Hardness of less than five — Rembrandt relied solely on the expert testimony of Dr. Thomas Beebe, Jr. about testing that he had allegedly performed and that he described in his expert report. *Id.* Dr. Beebe's direct testimony was consistent with his expert report, but then, during cross-examination, he "suddenly changed course ... and testified that he did not follow the procedures listed in his expert report." *Id.* at 53a. Instead, Dr. Beebe testified that his experiments had consisted of entirely different procedures, none of which was described in his expert report. *Id.* JJVC moved to

exclude Dr. Beebe's testimony on the ground that the testing procedure described during cross-examination had never been disclosed in the expert report and also departed from accepted scientific protocols. The district court deferred ruling on the motion until after the jury returned its verdict.

The jury returned a verdict of non-infringement. The district court then granted JJVC's motion to exclude Dr. Beebe's testimony, agreeing that his methods had not been sufficiently disclosed and in any event lacked support in the relevant scientific literature. *Id.* Having excluded the only evidence Rembrandt advanced at trial to prove JJVC's accused lenses were "soft" within the meaning of the claims, the district court granted judgment as a matter of law in favor of JJVC. *Id.*

On the direct appeal from the judgment in 2013, the Federal Circuit affirmed the district court's decision excluding Dr. Beebe's testimony and its grant of judgment as a matter of law based on Rembrandt's failure to present any admissible evidence concerning the "soft" limitation. *Id.* at 49a. As a result, the court found it unnecessary to address the jury verdict. Pet. App. 54a n.1.

B. Post-trial Discovery and the Rule 60(b) Motion

After the trial, Rembrandt received information suggesting that one of JJVC's experts, Dr. Christopher Bielawski, had testified falsely during the trial and that the results of certain tests conducted by Dr. Bielawski had not been produced in discovery. Dr. Bielawski's

testimony related exclusively to the “surface layer” limitation and not to the “soft” limitation on which the district court granted judgment as a matter of law. Based on the new information regarding Dr. Bielawski, Rembrandt moved under Rule 60 to reopen the case. Pet. App. 36a.

During trial, Dr. Bielawski testified that he personally had conducted certain laboratory testing on JJVC’s accused lenses. Pet. App. 4a. Information received after trial, however, revealed that graduate students and lab supervisors had conducted these tests and that Dr. Bielawski was not in the country when some of the testing had occurred. *Id.* In addition, Rembrandt asserted that its new evidence undercut Dr. Bielawski’s testimony that he had appropriate expertise in the tests that were conducted. *Id.* Finally, the new information revealed that Dr. Bielawski had performed tests on third-party lenses, which had previously been found to infringe the ’327 patent. *Id.* at 5a. JJVC had been unaware of those tests and they were not disclosed to Rembrandt. Rembrandt claimed this information would have been significant to its efforts to prove infringement of the “surface layer” limitation.

The district court denied Rembrandt’s Rule 60 motion. *Id.* at 47a. Putting aside the impact of the JMOL based on the absence of evidence addressing the “soft” limitation, the opinion focused on the impact of Dr. Bielawski’s testimony on the trial of the separate “surface layer” limitation. The court first noted that “Dr. Bielawski’s testimony was not nearly as central or necessary to this case” as the false testimony of experts

in other cases where Rule 60(b)(3) relief had been granted. *Id.* at 43a. In addition, citing decisions from the Sixth, Seventh, and D.C. Circuits, the district court held that Rule 60(b)(3) relief was only appropriate when the misconduct “involve[d] the complicity of ‘the opposing party’ (JJVC) or its counsel.” *Id.* The district court found that Rembrandt had not shown that JJVC “should have known of Dr. Bielawski’s misconduct,” and likewise that Rembrandt was “unconvincing in demonstrating that JJVC’s lawyers knew or should have known about Dr. Bielawski’s false testimony.” *Id.* at 45a. Because “neither JJVC nor its counsel has been shown to be complicit in any fraud or misconduct,” the district court denied Rembrandt’s motion. *Id.*

The district court also held that relief under Rule 60(b)(3) was unwarranted for the further reason that Rembrandt “was not prevented from fully and fairly presenting its case.” *Id.* at 46a. What Rembrandt lost as a result of Dr. Bielawski’s misconduct was “an opportunity to discredit or eliminate an expert witness who . . . was not required for JJVC to win the case.” *Id.* The court held that Rule 60(b)(3) is properly used only “to redress ‘judgments which were unfairly obtained.’” *Id.* (quoting *Rozier v. Ford Motor Co.*, 573 F.2d 1132, 1339 (5th Cir. 1978)). Finally, the district court emphasized that it had concluded that Rembrandt had failed to demonstrate a basis for Rule 60(b)(3) relief without even considering the court’s earlier decision granting JJVC judgment as a matter of law — a ruling based solely on the deficiencies of Rembrandt’s case in chief on the “soft” limitation and thus not related to Dr.

Bielawski's testimony on an entirely different claim limitation. *Id.* at 46a n.9.

The district court also rejected Rembrandt's allegations with respect to the supposedly withheld test results. On its Rule 60(b)(3) motion, Rembrandt did not make any showing that those data were relevant, or that JJVC's expert, Dr. Bielawski, had considered the data in forming his opinions (as required to make the data discoverable under Rule 26(a)(2)(B)(ii)), or that JJVC even knew the data existed. In light of this failure of proof, the district court found Rembrandt's arguments "murky at best" and insufficient to constitute clear and convincing evidence that the omission had denied Rembrandt a full and fair opportunity to present its case. *Id.* at 36a n.1.

C. The Court of Appeals Decision

Purporting to apply the law of the Eleventh Circuit because the case arose in that circuit, a panel of the Federal Circuit reversed, over a dissent by Judge Dyk. Pet. App. 1a-2a.

Initially, the court of appeals rejected JJVC's argument that Rembrandt could not possibly have been denied a full and fair opportunity to litigate the "soft" limitation because Dr. Bielawski had not testified about the "soft" limitation and because the district court had granted judgment as a matter of law based solely on Rembrandt's failure to prove that necessary element of its case. *Id.* at 8a. Looking to ambiguous comments made by the district judge during the Rule 60 hearing — and disregarding the content of the district court's published decision — the Federal Circuit concluded

that the district judge “may well have responded differently [to the motion for judgment as a matter of law] had he been aware at the time of Dr. Bielawski’s false testimony.” *Id.* at 10a.

Rather than requiring a showing, by clear and convincing evidence or otherwise, that Dr. Bielawski’s misconduct had actually deprived Rembrandt of a full and fair opportunity to present its case on the “soft” limitation, the Federal Circuit refused to “speculate as to what impact the fraud and misconduct had on the ultimate judgment of noninfringement where the false testimony and withheld documents were material to the issue of patent infringement [on the ‘surface layer’ limitation] and could well have impacted . . . the district court’s decision to exclude Dr. Beebe’s testimony and consequently grant [the] JMOL on the ‘soft’ limitation.” *Id.* at 12a. Knowledge of the supposed weakness in JJVC’s defense on the “surface layer” limitation, the court said, “could well have changed the nature of the entire proceedings,” and thus “raise[d] a substantial question undermining the judgment of noninfringement.”¹ *Id.* at 13a. The court again refused

¹ The Federal Circuit also stated that while “Rembrandt identified only Dr. Beebe’s testimony” when responding to JJVC’s motion for judgment as a matter of law on the soft limitation, the court believed that there was “additional evidence at trial to show that JJVC’s . . . lenses had satisfied the ‘soft’ limitation.” Pet. App. 13a. That additional evidence, however, had been excluded by the district court at trial, or not even presented by Rembrandt, because it did not relate to whether JJVC’s product satisfied the Shore D Hardness test as required to prove infringement for the

to “speculate” about how this information would have made a difference on the district court’s grant of judgment as a matter of law based on an unrelated claim limitation. *Id.*

Turning to the jury verdict of noninfringement and JJVC’s defense on the “surface layer” limitation, the court said that Dr. Bielawski testified on a “central infringement issue at trial — whether JJVC’s accused lenses met the ‘surface layer’ claim limitation” — and that the verdict was “irretrievably tainted” by the false testimony and withheld test results. *Id.* at 8a-9a. Acknowledging that it did not know “the exact impact the false testimony would have had on the jury,” the court observed that the testimony “may well have been critical to the noninfringement verdict.” *Id.* at 9a.

On the question whether Dr. Bielawski’s false testimony was attributable to JJVC and thus was misconduct “by an opposing party” under Rule 60(b)(3), the Federal Circuit held that Rule 60(b)(3) relief could be granted even if the opposing party and its counsel were unaware — and had no reason to be aware — of the expert’s misconduct at trial. The Federal Circuit held that the Eleventh Circuit would not “require proof that JJVC or its counsel was complicit in Dr. Bielawski’s false testimony.” *Id.* at 18a. Rather, the court of appeals held that Dr. Bielawski’s false testimony, standing alone, was sufficient grounds to set aside a final judgment under Rule 60(b)(3). The court

“soft” limitation. The district court rulings were upheld by the Federal Circuit on the 2013 direct appeal. *See id.* at 49a.

did not explain why an independent expert was an “opposing party.”

Finally, with respect to JJVC’s failure to produce in discovery Dr. Bielawski’s tests on the third-party lenses, the Federal Circuit stated that it did not need to “determine whether JJVC’s failure to obtain and produce this data was intentional or merely accidental,” because, in its view, “even an accidental omission qualifies as misconduct under Rule 60(b)(3).” *Id.* at 15a.

D. The Dissent

Judge Dyk dissented. In his view, the majority decision presents “important questions about the interpretation of Rule 60(b)(3)” and conflicts with the law of other circuits. Pet. App. 19a.

First, Judge Dyk observed that various circuits — including the Eleventh Circuit — require that a movant show by clear and convincing evidence that fraud or misconduct prevented it “from fully and fairly presenting [its] case or defense.” *Id.* (Dyk, J., dissenting) (quoting *Cox Nuclear Pharm., Inc. v. CTI, Inc.*, 478 F.3d 1303, 1305 (11th Cir. 2007) (internal quotation marks omitted)). The majority’s decision “effectively eliminates” this requirement, Judge Dyk found. *Id.* at 20a.

Judge Dyk criticized the majority for focusing on the jury’s verdict of non-infringement when, he asserted, the applicable ruling was the district court’s grant of judgment as a matter of law on the “soft” limitation, a ruling that in no way relied on Dr. Bielawski’s testimony on the “surface layer” limitation and that the Federal Circuit had affirmed in a prior

appeal. *Id.* at 24a. Rembrandt’s only argument that the expert’s misconduct on the “surface layer” limitation might have impacted its failure of proof on the “soft” limitation was “speculat[ion] that it would have spent more time preparing its case for the ‘soft’ limitation and could have potentially prevented Dr. Beebe’s meltdown on the stand.” *Id.* at 24a. In Judge Dyk’s view, the majority’s acceptance of this speculation “renders the ‘full and fair’ requirement a nullity,” making it “hard to see any case where, after a party proves misconduct of any kind, that party would not be afforded relief.” *Id.*

Judge Dyk also noted that the majority’s position was in conflict with all other authority on the correct application of Rule 60(b)(3). As he explained, the rule does not provide a basis for setting aside a judgment where the alleged misconduct was “essentially irrelevant to the legal issues upon which the case turned.” *Id.* at 25a (citing cases from the First, Second, and Seventh Circuits). He contrasted cases from the Third, Fifth, and Sixth Circuits where Rule 60(b)(3) relief was properly granted because the movant’s “know[ledge of] . . . the misconduct actually could have made a difference.” *Id.* at 26a. In sum, because “Rembrandt failed to produce any credible evidence on one element of its case . . . [and] [t]hat failure had nothing to do with Dr. Bielawski’s false testimony,” Judge Dyk would not have granted Rembrandt relief from the judgment. *Id.* at 30a.

Second, even if there were any reason to consider the effect of Dr. Bielawski’s misconduct with respect to the “surface layer” limitation, Judge Dyk criticized the

majority for granting relief under Rule 60(b)(3) based only on an expert's misconduct, without requiring any showing that JJVC or its counsel knew, or had reason to know, of any falsity in Dr. Bielawski's testimony. He pointed out that at least two other courts of appeals confronting the same issue — the Seventh and D.C. Circuits — had “reached the opposite conclusion.” *See id.* at 31a (citing *Metlyn Realty Corp. v. Esmark Inc.*, 763 F.2d 826, 833 (7th Cir. 1985); *Richardson v. Nat'l R.R. Passenger Corp.*, 49 F.3d 760, 765 (D.C. Cir. 1995)). He added that the very text of the Rule itself requires party complicity — by referring to fraud “by an opposing party.” *Id.* at 30a (quoting Fed. R. Civ. P. 60(b)(3)).

Third, with respect to JJVC's failure to produce certain test data collected by Dr. Bielawski, Judge Dyk faulted the majority for making a decision on the issue in the absence of any fact finding by the district court. *Id.* at 34a.

REASONS FOR GRANTING THE PETITION

The Federal Circuit's decision not only departs from the approach followed by many circuits but also provides an excellent vehicle for resolving several longstanding conflicts among the regional circuits.

American common law has long balanced the desire to assure a fair truth-seeking process against the “important interest in the finality of judgments,” *Massaro v. United States*, 538 U.S. 500, 504 (2003). The balance generally favors finality. In the words of Justice Story, “it is for the public interest and policy to make an end to litigation . . . [so that] suits may not be

immortal, while men are mortal.” *Ocean Ins. Co. v. Fields*, 18 F. Cas. 532, 539 (C.C.D. Mass. 1841). See *McCleskey v. Zant*, 499 U.S. 467, 491 (1991) (“One of the law’s very objects is the finality of its judgments.”).

Rule 60(b) thus “strikes a balance between the need for finality of judgments and the importance of ensuring that litigants have a full and fair opportunity to litigate a dispute.” *United Student Aid Funds, Inc. v. Espinosa*, 559 U.S. 260, 276 (2010). In so doing, it “reflects and confirms the courts’ own inherent and discretionary power, ‘firmly established in English practice long before the foundation of our Republic,’ to set aside a judgment whose enforcement would work inequity.” *Plaut v. Spendthrift Farm, Inc.*, 514 U.S. 211, 233-234 (1995) (citations omitted). At the same time, as this Court has cautioned, the application of Rule 60(b) must be carefully circumscribed so that the “exception to finality” created by Rule 60(b) does not “swallow the rule.” *United Student Aid Funds*, 559 U.S. at 270.

Rule 60(b) sets forth a hierarchy of different grounds for granting relief from judgment if a motion is filed within a year of the judgment. Rule 60(b)(1) is addressed to mistake, typically a mistake of fact or law by the district court. See, e.g., *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380, 393 (1993). Rule 60(b)(2) allows a new trial based on newly discovered evidence. It has uniformly been interpreted to require a showing that the newly discovered evidence would probably have produced a different result at trial. E.g., *JPMorgan Chase Bank, N.A. v. First Am. Title Ins. Co.*, 750 F.3d 573, 584-585 (6th Cir.

2014); *Thermacor Process, L.P. v. BASF Corp.*, 567 F.3d 736, 744 (5th Cir. 2009); *Waddell v. Hendry Cty. Sheriff's Office*, 329 F.3d 1300, 1309 (11th Cir. 2003).

Rule 60(b)(3), by contrast, addresses more serious violations – “fraud . . ., misrepresentation or misconduct by an opposing party.” As befits the seriousness of such violations, the Courts of Appeals have uniformly required a less stringent showing as to the effect of the misconduct – not a probability of a different outcome at trial, but rather interference with the movant’s “full and fair opportunity to litigate” its case. At the same time, to obtain the benefit of this lesser showing, the Courts of Appeals have uniformly required clear and convincing evidence that misconduct actually occurred.

This case presents, *first*, the question of how strong a showing the movant must make that the claimed fraud, misrepresentation or misconduct actually impaired the movant’s ability to litigate the case. The circuits are in conflict over what proof is necessary, and who must present it, when determining the effect the misconduct had on the trial.

Five circuits focus on the burden of proof and require the movant to prove by “clear and convincing evidence” that it was denied a full and fair opportunity to litigate. Three other circuits focus instead on the amount of interference and require the movant to show “substantial interference” with the litigation without specifying the applicable burden of proof. Two other circuits employ complex burden-shifting frameworks. Where misconduct by an opposing party is shown to have been deliberate and intentional, substantial interference is presumed and the burden is shifted to

the opposing party to overcome that presumption with “clear and convincing evidence.”

The Federal Circuit, while claiming to follow Eleventh Circuit law, actually applied none of these standards. Rather than requiring some showing that the expert’s misconduct actually deprived respondent of an ability to fully and fairly present its case, the Federal Circuit repeatedly stated it would not “speculate” on whether Dr. Bielawski’s misconduct might or might not have impacted the trial or the district court’s grant of judgment as a matter of law. By refusing to “speculate” on this key issue, the court of appeals effectively created an irrebuttable presumption of interference, eliminating the need for any showing that the misconduct actually impeded the movant’s ability to litigate its case.

Second, and equally worthy of review, is the Federal Circuit’s holding that an expert’s misconduct, standing alone, is a sufficient basis for setting aside a judgment, without any need for a showing that the party that called the expert, or its counsel, knew or should have known, of the expert’s misconduct. The court of appeals held that it was enough that an expert witness testified falsely under oath. But false testimony by an expert is not misconduct “by an opposing party,” which Rule 60(b)(3) expressly requires. As Judge Dyk noted, treating an expert’s misconduct as misconduct “by an opposing party” squarely conflicts with decisions of the Seventh and D.C. Circuits, as well as with long-standing evidentiary and professional responsibility rules that reject the

notion that a party or its lawyer vouches for every statement made by a witness.

Third, and again worthy of review, is the Federal Circuit's conclusion that a party's innocent and accidental omission in the production of discovery materials can be "misconduct" that is sufficient to grant relief under Rule 60(b)(3), even without a showing that the party or its counsel did anything wrong. Here again, there is a circuit conflict. Unlike four other circuits, the Sixth Circuit has rejected that interpretation as inconsistent with the plain language of the Rule and has held that the Rule authorizes reopening a final judgment only based on a showing of a deliberate act by the adverse party that adversely impacted the fairness of the prior proceedings.

These circuit disagreements are far from a trivial matter. There have been more than 2000 reported decisions on Rule 60(b)(3) motions in the last ten years – more than 200 a year on average – and there are undoubtedly many more decisions that are not reported. When new evidence is found (such as Dr. Bielawski's false testimony and non-produced documents), a movant can always seek relief under Rule 60(b)(2), but only if it can show that the new evidence would likely have produced a different result at trial.² In such a situation, Rule 60(b)(3) is an inviting

² In its motion for a new trial, Rembrandt argued that the Bielawski evidence warranted a new trial under Rule 60(b)(2). The district court rejected that argument, finding that the evidence was not so important that it would probably have caused

alternative because it allows relief upon a lesser showing of impact. But under the express terms of the Rule, it is properly reserved for more serious violations – misconduct by an opposing party – not the garden variety discovery of new evidence.

The Federal Circuit’s approach – adopting the most lenient standard from among all the circuits on three separate prerequisites to Rule 60(b)(3) relief – minimizes the intended differences between (b)(2) and (b)(3) and encourages efforts to reopen fair judgments, even where there has been no misconduct “by an opposing party” and even where there is no showing that any alleged misconduct deprived the movant of the ability to fully and fairly present its case. Moreover, in the wake of this decision, the resolution of motions of this kind will continue to vary dramatically based solely on which circuit’s law is controlling. In fact, it is almost inconceivable that most other circuits would have reversed the denial of a Rule 60(b)(3) motion here (reviewable for an abuse of discretion), where the false testimony and non-production related to one element of the case — the “surface layer” limitation — and bore no relation to the moving party’s outcome-dispositive failure to offer any admissible evidence on another element, the “soft” limitation. But that is what the Federal Circuit, purporting to apply Eleventh Circuit law, did here.

a different result at trial. Pet. App. 39a-41a. The Federal Circuit did not disturb that finding.

I. The Decision Below Exacerbates A Three-Way Circuit Conflict Over The Showing A Party Must Make To Receive Rule 60(b)(3) Relief.

Following its practice of applying regional circuit law when substantive issues of patent law are not involved, *see, e.g., In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008), the Federal Circuit purported to apply Eleventh Circuit precedent in finding that Rembrandt had been denied a full and fair opportunity to litigate the case. *See* Pet. App. 7a (citing *Harre v. A.H. Robins Co.*, 750 F.2d 1501, 1503 (11th Cir. 1987)). Regardless of whether the Federal Circuit accurately applied Eleventh Circuit law, there exists, as the Sixth Circuit noted twenty years ago, a “major area of controversy in Rule 60(b)(3) jurisprudence” among the circuits about “how significant the misbehavior on the part of the non-moving party needs to be before a new trial will be afforded to the moving party.” *Jordan*, 1996 WL 528950, at *7. In the twenty years since, the conflict has only become more pronounced, raising the question of what standard of proof is applicable in deciding whether a movant was denied a full and fair opportunity to litigate its case as a result of an opposing party’s fraud or misconduct.

A. The Third, Fifth, Seventh, Eighth and Eleventh Circuits require a movant to show by “clear and convincing evidence” that it was denied a full and fair opportunity to litigate its case.

The “clear and convincing” evidence standard is a “high” bar, *see e.g., Commil USA, LLC v. Cisco*

Systems Inc., 135 S. Ct. 1920, 1929 (2015), and in light of the costs to litigants and courts alike of disturbing a final judgment, five circuits have correctly required a movant to show by this elevated standard that the opposing party's misconduct denied it a full and fair opportunity to litigate its case. That standard derives from this Court's holding, prior to the enactment of Rule 60(b)(3), that "to justify setting aside a decree for fraud whether extrinsic or intrinsic, it must appear that the fraud charged *really* prevented the party complaining from making a full and fair defense." *Toledo Scale Co. v. Computing Scale Co.*, 261 U.S. 399, 421 (1923) (emphasis added).

Application of this familiar and well-understood standard properly limits relief to those cases where a compelling showing can be made. For example, in *Lonsdorf v. Seefeldt*, 47 F.3d 893 (7th Cir. 1995), the Seventh Circuit applied the clear and convincing standard to grant relief under Rule 60(b)(3). The plaintiff had moved to set the judgment aside in light of the discovery of defendant's fraudulent alteration of a training schedule, which the defendant had successfully used at trial to show his actions were not sexual harassment but in fact part of a pre-approved training program. The Seventh Circuit held that the "party seeking relief must prove that they are entitled to a new trial by clear and convincing evidence." *Id.* at 897. Applying this standard, the court found "ample prejudice in the use of the fraudulent evidence" at trial "to demonstrate that [the plaintiff] mistakenly viewed training exercises as sexual harassment." *Id.* at 896-97.

On the other hand, application of the clear and convincing standard preserves the finality of judgments where the proof of interference with the trial is less than compelling. For example, the Eighth Circuit in *Greiner v. City of Champlin*, 152 F.3d 787 (8th Cir. 1998), used the clear and convincing standard to deny relief under Rule 60(b)(3) to plaintiffs seeking to reopen a judgment in a civil rights suit brought against police officers. The plaintiffs sought relief based on the allegedly wrongful withholding of a psychological evaluation of one of the defendants. *Id.* at 788. The court noted that Rule 60(b)(3) requires a movant to “show by clear and convincing evidence that his opponent engaged in a fraud or misrepresentation that prevented the movant from fully and fairly presenting his case.” *Id.* at 789. Under this standard, the court held, the withheld psychological evaluation was insufficient to warrant setting aside a final judgment.

The Third, Fifth, and Eleventh Circuits also require movants under Rule 60(b)(3) to show by clear and convincing evidence that they were denied a full and fair opportunity to litigate their case. *See, e.g., Boldrini v. Wilson*, 609 F. App’x 721, 724 (3d Cir. 2015) (“A court may vacate a judgment under Rule 60(b)(3) only if a party establishes, by clear and convincing evidence that the judgment was obtained through such fraud that prevented [him] from fully and fairly presenting his case.” (internal citations and quotation marks omitted)); *Rozier v. Ford Motor Co.*, 573 F.2d 1332, 1339 (5th Cir. 1978) (“One who asserts that an adverse party has obtained a verdict through fraud,

misrepresentation or other misconduct has the burden of proving the assertion by clear and convincing evidence.”); *Matthews, Wilson & Matthews, Inc. v. Capital City Bank*, 614 F. App’x 969, 971 (11th Cir. 2015) (“Watkins has also failed to show, through clear and convincing evidence, that Capital City Bank’s alleged conduct prevented her from fully and fairly presenting her case or defense, as required by Rule 60(b)(3).”); *Kissinger-Campbell v. C. Randall Harrell, M.D., P.A.*, 418 F. App’x 797, 806 (11th Cir. 2011) (denying Rule 60(b)(3) relief where there “not clear and convincing evidence that the failure to produce such emails prevented the Defendants from fully and fairly presenting their case”).³

B. The Ninth, Tenth, and D.C. Circuits require a movant to show “substantial interference” with its ability to litigate its case.

Unlike the five circuits that focus the Rule 60(b)(3) inquiry on the clear and convincing burden of proof, three other circuits focus instead on the amount of interference that must be shown – whether the misconduct substantially interfered with the movant’s ability to fully and fairly present its case. The substantial interference standard derives from Rule 61, which requires courts to disregard, at all stages of the proceedings, “all errors and defects that do not affect

³ The Federal Circuit apparently did not feel bound to follow these unpublished decisions of the Eleventh Circuit. It cited no standard of proof in support of its analysis.

any party's substantial rights." The substantial interference cases require that the fraud or misconduct itself be shown by clear and convincing evidence, but most are silent on whether substantial interference must be shown by clear and convincing evidence or by a preponderance of evidence.

For example, in *Woodworker's Supply, Inc. v. Principal Mutual Life Insurance Co.*, 170 F.3d 985, 993 (10th Cir. 1999), the defendants moved for relief under Rule 60(b)(3) in light of the plaintiff's alleged failure to adequately disclose, pretrial, its theory of damages. In reviewing the denial of their post-trial Rule 60(b)(3) motion, the court of appeals held that before relief can be granted, "the challenged behavior must substantially have interfered with the aggrieved party's ability fully and fairly to prepare for and proceed at trial." *Id.* (quoting *Anderson v. Cryovac, Inc.*, 862 F.2d 910, 924 (1st Cir. 1998)). Under this standard, the Tenth Circuit found the defendants could not prevail because they had not availed themselves of multiple opportunities to cure any prejudice arising from plaintiff's non-disclosure. *Id.* at 993-94. *See also Zurich N. Am. v. Matrix Serv. Inc.*, 426 F.3d 1281, 1290 (10th Cir. 2005) ("[T]he challenged behavior must substantially have interfered with the aggrieved party's ability fully and fairly to prepare for and proceed at trial." (quotation marks omitted)).

In *Jones v. Aero/Chem Corp.*, 921 F.2d 875, 878 (9th Cir. 1990), the Ninth Circuit reviewed a motion for a new trial under Fed. R. Civ. P. 59, but, in assessing the part of that motion based on alleged misconduct at trial, it applied a test "borrowed from cases interpreting

Rule 60(b)(3).” *See also id.* at 878 n.3 (explaining why the tests for Rule 59 and Rule 60(b)(3) must be the same). Relief under Rule 60(b)(3), the court explained, is required when a movant showed that fraud, misrepresentation or misconduct “may have substantially interfered with [her] ability to fully and fairly present her case.” *Id.* at 879.⁴

The D.C. Circuit also has used variants of the “substantial interference” test under Rule 60(b)(3), requiring a movant to “demonstrate actual prejudice . . . [such that the misconduct] ‘affected the substantial rights of the movant.’” *Summer v. Howard Univ.*, 374 F.3d 1188, 1193 (D.C. Cir. 2004) (quoting *Anderson*, 862 F.2d at 924 (alteration omitted)); *see also Hope 7 Monroe St. L.P. v. Riaso, LLC*, 743 F.3d 867, 875 (D.C. Cir. 2014) (“In addition to demonstrating misconduct, the movant must show the misconduct was prejudicial, foreclosing the full and fair preparation or presentation of its case.”).

C. The First and Sixth Circuits employ a burden-shifting framework.

Unlike the eight circuits described above, the First and Sixth Circuits do not place the Rule 60(b)(3) burden

⁴ Other Ninth Circuit cases apply the clear and convincing burden of proof. *See, e.g., De Saracho v. Custom Food Mach., Inc.*, 206 F.3d 874, 880 (9th Cir. 2000) (“[T]he moving party must prove by clear and convincing evidence that the verdict was obtained through fraud, misrepresentation, or other misconduct and the conduct complained of prevented the losing party from fully and fairly presenting the defense.”).

solely on the movant. Rather, these courts employ a burden-shifting test. If the movant establishes that the misconduct was intentional, these circuits shift the burden to the opposing party to prove by clear and convincing evidence that the misconduct did not result in prejudice to the movant's ability to fully and fairly litigate its case.

In *Anderson v. Cryovac, Inc.*, 862 F.2d 910, 923 (1st Cir. 1998), plaintiffs brought a Rule 60(b)(3) motion based on the defendant's failure to disclose an environmental report containing information that the defendant's tannery had contaminated groundwater in the plaintiff's town. After discussing the approaches followed by other circuits, *Anderson* pronounced itself in "general concert with their approaches" and, consistent with other circuits, it explained the basis for the substantial interference test. "Verdicts ought not lightly to be disturbed, so it makes very good sense to require complainants to demonstrate convincingly that they have been victimized by an adversary's misconduct. . . . [T]he error, to warrant relief, must have been harmful – it must have 'affect[ed] the substantial rights' of the movant." *Id.* at 924 (citing Rule 61).

The First Circuit then placed its "own gloss upon the subject" by "refin[ing]" the conventional Rule 60(b)(3) standard. *Id.* If a movant shows an opponent's misconduct by clear and convincing evidence and also shows that the misconduct was "knowing and deliberate," *id.* at 930 n.15, the First Circuit applies a rebuttable presumption that the misconduct substantially interfered with the movant's ability to

litigate. The burden then shifts to the opposing party, which can overcome the presumption “by a clear and convincing demonstration that the consequences of the misconduct were nugacious.” *Id.* at 926.

Alternatively, “if unaided by a presumption—that is, if the movant is unable to prove that the misconduct was knowing or deliberate—it may still prevail as long as it proves by a preponderance of the evidence that the nondisclosure worked some substantial interference with the full and fair preparation or presentation of the case.” *Id.* Having propounded a new standard, the First Circuit remanded the case for the district court to apply it in the first instance.

The Sixth Circuit also applies a burden-shifting framework. In *Jordan*, 1996 WL 528950, at *1-*2, the Sixth Circuit recognized that there was a “major area of controversy in Rule 60(b)(3) jurisprudence” about “how significant the misbehavior on the part of the non-moving party needs to be before a new trial will be afforded to the moving party.” *Id.* at *7. Although criticizing “an elaborate system of burden-shifting that lacks any textual foundation in the rule,” the Sixth Circuit went on to require such a standard itself, holding that once the moving party had shown by clear and convincing evidence that misbehavior by an opposing party had occurred, prejudice to the moving party would be assumed unless the non-moving party shows by clear and convincing evidence that the misbehavior had no prejudicial effect on the litigation. *Id.* at *8-*9.

D. The Federal Circuit requires no showing of interference with the movant's ability to litigate its case.

The Federal Circuit, purporting to apply Eleventh Circuit law, took an approach that conflicts with the law in every other circuit. It simply asserted, without cogent explanation, that Dr. Bielawski's misconduct relating to the "surface layer" limitation somehow *might* have affected how Rembrandt tried its case on the "soft" limitation and/or the district court's decision to grant judgment as a matter of law based on Rembrandt's failure of proof on the "soft" limitation. Under the guise of refusing to "speculate" further, the Federal Circuit avoided explaining how this could possibly be true. In effect, the court erected an irrebuttable presumption of interference with Rembrandt's ability to litigate its case. As Judge Dyk stated in dissent, "[t]he authority is uniformly to the contrary." Pet. App. 24a.

In taking this approach, the Federal Circuit made no effort to demonstrate that the false testimony "*really* prevented the party complaining from making a full and fair defense." *Toledo Scale Co.*, 261 U.S. at 421 (emphasis added). As a result, it is very likely there would have been a different outcome had this case arisen in a different circuit. Moreover, this "major area of controversy" among the circuits, *Jordan*, 1996 WL 528950, at *7, concerns an important question of civil procedure that affects in a material way the balance between finality and fairness that courts are required to apply under Rule 60.

II. The Decision Below Conflicts With Other Circuit Decisions Holding That False Testimony By An Expert Is Not A Misrepresentation “By An Opposing Party” Under Rule 60(b)(3).

Courts have long recognized that misconduct by a party is more serious, and deserving of greater sanction, than misconduct by a witness. In its leading decision on fraud on the court, *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 245 (1944), this Court drew that distinction sharply: “This is not simply a case of a judgment obtained with the aid of a witness who, on the basis of after-discovered evidence, is believed possibly to have been guilty of perjury. Here . . . we find a deliberately planned and carefully executed scheme [by a party] to defraud not only the Patent Office but the Circuit Court of Appeals.”

When Congress adopted Rule 60(b)(3) two years after *Hazel-Atlas* it, too, recognized the distinction. While Rule 60(b)(2) addresses newly discovered evidence, no matter its source, Rule 60(b)(3) permits relief from a final judgment only upon the proof of “fraud . . ., misrepresentation, or misconduct *by an opposing party*.” (emphasis added). For all practical purposes, the Federal Circuit dispensed with this requirement. Notwithstanding the text of the Rule, the Federal Circuit concluded that it did not matter whether this was “simply” a case in which a witness testified falsely or one in which a party or its counsel was aware of the false testimony. *Hazel-Atlas*, 322 U.S. at 245.

Review of the Federal Circuit’s decision would allow the Court to resolve an additional longstanding and important circuit conflict. Applying Eleventh Circuit law, the Federal Circuit held that “the district court erred by concluding that the Eleventh Circuit would require proof that JJVC or its counsel was complicit in Dr. Bielawski’s false testimony.” Pet. App. 31a; *see also id.* (“[W]e cannot agree that the Eleventh Circuit would require complicity in Dr. Bielawski’s false testimony.”). In other words, the court of appeals held that false testimony by an expert witness may, without more, be imputed to the party that called the witness. The court offered no explanation why false testimony by an expert witness could be deemed a misrepresentation “by an opposing party.”

In so ruling, the Federal Circuit relied on *Harre v. A.H. Robins Co.*, 750 F.2d 1501 (11th Cir. 1985), *vacated in part on reconsideration*, 866 F.2d 1301 (11th Cir. 1989), in which an expert was shown to have testified falsely at trial. As the Federal Circuit acknowledged, the *Harre* court discussed the complicity of counsel in the expert’s false testimony, but the Federal Circuit concluded that *Harre*’s holding did not rely on complicity. Rather, the Federal Circuit noted that in *Bonar v. Dean Witter Reynolds, Inc.*, 835 F.2d 1378, 1380 n.7 (11th Cir. 1988), the Eleventh Circuit cited *Harre* as relying on false expert testimony, without more.

This analysis conflicts with the rulings of at least two other circuits, which have held that false testimony by an expert is not misconduct “by an opposing party” under Fed. R. Civ. P. 60(b)(3), absent evidence that the

party knew or had reason to know of the expert's misconduct.

In *Metlyn Realty Corp. v. Esmark, Inc.*, 763 F.2d 826, 829 (7th Cir. 1985), a party moved under Rule 60(b)(3) to set aside a judgment after learning that an expert witness had exaggerated his experience and the methods of profit calculation he used. The Seventh Circuit affirmed the district court's denial of the motion. In so doing, the court said that the claim "smacks of the proposition that every party 'vouches' for its witnesses, a view long departed and little missed in federal practice." *Id.* at 833 (citing Fed. R. Evid. 607). To the contrary, "expert witnesses . . . are free agents," and while "[p]arties and counsel have an obligation not to deceive the court about the witness[es] and to correct statements they know to be false . . . they are not responsible for the details of the witness's testimony." *Id.* at 832. Thus, to merit relief under Rule 60(b)(3), the false testimony must be "traced to the adverse party." *Id.* Because the movant could not make this showing the court denied relief.

The D.C. Circuit applied the same standard in *Richardson v. National Railroad Passenger Corp.*, 49 F.3d 760 (D.C. Cir. 1995). In *Richardson*, the district court found that the plaintiff's expert had misrepresented his education and hospital privileges, *id.* at 762, but that the movant "failed to show that [the plaintiff was] privy to any deception," or had been engaged in a concerted effort with the expert to misstate the extent of his injuries. *Id.* at 763. Because the plaintiff was not complicit in any wrongdoing, the D.C. Circuit saw no basis to set aside the settlement

under Rule 60(b)(3). The court of appeals held that Rule 60(b)(3) relief was not appropriate “once it was determined that [the plaintiff] bore no responsibility for the testimony of [the expert] . . . Rule 60(b)(3) requires a showing that the alleged ‘misconduct’ is attributable to ‘an adverse party.’” *Id.* at 765.

The Federal Circuit’s holding that a movant need not show adverse party complicity in an expert’s false testimony is at odds with the plain text of Rule 60(b)(3) and is in direct conflict with the holdings of two courts of appeals that have addressed this exact issue. Had this case been tried in at least two other circuits, Rembrandt’s Rule 60(b)(3) motion would have failed given JJVC’s lack of complicity in Dr. Bielawski’s misstatements.

III. The Circuits Are Also In Conflict Over Whether “Misconduct” Under Rule 60(b)(3) Can Include An Accidental Omission.

As the Sixth Circuit has noted, there is also a “major area of controversy in Rule 60(b)(3) jurisprudence” about whether an inadvertent error by a party can constitute “misconduct” under the Rule. *Jordan*, 1996 WL 528950, at *7. On this issue, the Sixth Circuit has rejected the “interpretations of Rule 60(b)(3) by the First, Fifth, and Eleventh Circuits . . . [as] not squar[ing] with the plain meaning of the rule.” *Id.* at *6.

In this case, the Federal Circuit held that relief was warranted under Rule 60(b)(3) because of the non-production of Dr. Bielawski’s test data on third-party lenses. The court of appeals stated that it “need not

determine whether JJVC's failure to obtain and produce this data was intentional or merely accidental," because in its view, "even an accidental omission qualifies as misconduct under Rule 60(b)(3)." Pet. App. 15a. In reaching this conclusion, the Federal Circuit relied on the First Circuit's holding in *Anderson*, 862 F.2d at 923, that the term "misconduct" in the rule "can cover even accidental omissions — otherwise it would be pleonastic, because 'fraud' and 'misrepresentation' would likely subsume it." Pet. App. 15a. *Anderson* has been followed on this point by the Fifth and Eleventh Circuits. See *Bros Inc. v. W.E. Grace Mfg. Co.*, 351 F.2d 208, 211 (5th Cir. 1965); *United States v. One (1) Douglas A-26B Aircraft*, 662 F.2d 1372, 1374-75 n.6 (11th Cir. 1981); see also *Catskill Dev., L.L.C. v. Park Place Entm't Corp.*, 286 F. Supp. 2d 309, 314 (S.D.N.Y. 2003) (recognizing the circuit conflict); 12 James Wm. Moore, *Moore's Federal Practice* § 60.43[1][a] (3d ed. 2016).

The Sixth Circuit has reached the opposite conclusion. In *Jordan*, 1996 WL 528950, at *6, the court analyzed the question at some length and concluded that the *Anderson* line of cases was mistaken. Considering both the plain meaning of the word "misconduct" and its placement in a rule addressed to fraud and misrepresentation, the court concluded "the primary connotation of each of the words in Rule 60(b)(3) suggests a requirement of some odious behavior on the part of the non-moving party. To interpret one of these words as permitting the moving party merely to demonstrate that the non-moving party made a non-reckless mistake is to ignore the text

and context of the rule as well as the *noscitur a sociis* canon of statutory interpretation.” *Id.* at *7. Thus, the court held “the moving party under the rule must show that the adverse party committed a deliberate act that adversely impacted the fairness of the relevant legal proceeding.” *Id.* at *6. This Sixth Circuit rule was reaffirmed and followed in *Info-Hold, Inc. v. Sound Merchandising, Inc.*, 538 F.3d 448, 455 (6th Cir. 2008) (citing *Jordan*).

The First Circuit’s analysis, followed by the Federal Circuit and other circuits, is in plain conflict with the words and purpose of Rule 60(b)(3). “Misconduct” should properly mean misconduct. This third major disagreement among the circuits is thus important to the proper application of Rule 60(b)(3). And it is clear that the mere failure to produce test results, absent some wrongful behavior by JJVC, would not in the Sixth Circuit have constituted a basis for setting aside a final judgment under Rule 60(b)(3).

IV. This Case Presents An Ideal Vehicle For Clarifying The Scope Of Rule 60(b)(3).

With no attention from this Court since it took effect in 1948, Rule 60(b)(3) jurisprudence has developed in divergent ways in the Courts of Appeals. This case presents the Court with an ideal opportunity to clarify three different and important aspects of Rule 60(b)(3). Few vehicles will allow the Court to address in a single case all three issues presented – the standard of proof and whether party complicity can be ignored, notwithstanding the text of Rule 60(b)(3), either because false statements by an expert are automatically imputed to an innocent party or because

inadvertent non-production of unknown documents can be treated as “accidental” misconduct of a party (or, as here, both). Resolving these circuit conflicts would put an end to diverging views that, as applied by the Federal Circuit, seriously undercut “the law’s important interest in the finality of judgments.” *Massaro*, 538 U.S. at 504.

Moreover, while these circuit conflicts have existed for decades, the outcome in this case illustrates why they should not persist any further. Respondent was able to overturn a final judgment even though it had presented no admissible evidence on an essential element of its affirmative case and even though this failure was entirely self-inflicted and completely unrelated to the grounds for the Rule 60(b)(3) motion. This occurred because the Federal Circuit relieved the respondent of any meaningful burden of proving that the expert’s misconduct in fact denied it a full and fair opportunity to litigate its case. And it occurred because the Federal Circuit bent over backwards to find a basis for concluding that JJVC should be held guilty of “fraud . . . misrepresentation or misconduct,” when in fact it did none of those things.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

GREGORY L. DISKANT	PAUL M. SMITH
EUGENE M. GELERNTER	<i>Counsel of Record</i>
LAURA B. KAUFMAN	ISHAN K. BHABHA
PATTERSON BELKNAP WEBB & TYLER LLP	JENNER & BLOCK LLP
1133 Avenue of the Americas	1099 New York Ave., NW
New York, NY 10036	Suite 900
(212) 336-2000	Washington, DC 20001
	(202) 639-6000
	psmith@jenner.com

October 7, 2016

APPENDIX

1a

Appendix A

United States Court of Appeals
For the Federal Circuit

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff-Appellant

v.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant-Appellee

2015-1079

Appeal from the United States District Court for the
Middle District of Florida in No. 3:11-cv-00819-TJC-JRK,
Judge Timothy J. Corrigan

Decided: April 7, 2016

JUDGES: Before DYK, MOORE, and STOLL, Circuit
Judges.

Rembrandt Vision Technologies, L.P.
("Rembrandt") appeals from the district court's denial of
Rembrandt's motion for a new trial under Federal Rules

of Civil Procedure 60(b)(2) and (3). Because the district court abused its discretion in denying Rembrandt's Rule 60(b)(3) motion, we reverse and remand for a new trial.

BACKGROUND

This case returns to us following an unusual set of circumstances. Rembrandt sued Johnson & Johnson Vision Care, Inc. ("JJVC"), alleging that its Acuvue Advance ® and Oasys ® contact lenses infringed the asserted claim of U.S. Patent No. 5,712,327. At trial, the parties disputed whether JJVC's accused lenses met the "surface layer" and "soft" limitations of the asserted claim. Following trial, the jury returned a verdict of noninfringement. The district court, in the alternative, granted judgment as a matter of law that Rembrandt failed to prove that the accused lenses were "soft." *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc. (JMOL Order)*, 282 F.R.D. 655, 668 (M.D. Fla. 2012). We affirmed the district court's grant of JMOL. *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc. (Rembrandt I)*, 725 F.3d 1377 (Fed. Cir. 2013).

At trial, Rembrandt relied on expert testimony from Dr. Thomas Beebe to prove that the accused lenses met both the "surface layer" and "soft" claim limitations. During his direct examination regarding the "soft" limitation, Dr. Beebe presented test results to show that the accused lenses met this limitation. During cross-examination, however, Dr. Beebe drastically changed his testimony regarding the testing methodology he used. Because his testimony on cross-examination significantly conflicted with both his testimony during his direct examination and the testing methodology

disclosed in his expert report, the district court ultimately struck Dr. Beebe's trial testimony regarding this testing. After noting that Dr. Beebe's stricken testimony was the only evidence that Rembrandt advanced to prove the accused lenses were "soft" in opposing JJVC's motion, the district court granted JMOL that JJVC did not infringe. *JMOL Order*, 282 F.R.D. at 668.

In turn, JJVC relied on expert testimony from Dr. Christopher Bielawski to support its position that its accused lenses did not meet the "surface layer" limitation, but did not present expert testimony with respect to the "soft" limitation. During the course of his trial testimony, Dr. Bielawski took advantage of several opportunities to impugn Dr. Beebe's credibility. For example, Dr. Bielawski described Dr. Beebe's failure to correct allegedly incorrect data as "misleading and tantamount to dishonesty." Joint Appendix ("J.A.") 4683. JJVC also capitalized on Dr. Beebe's changing testimony. During his closing argument, JJVC's counsel urged that "[y]ou should not trust Dr. Beebe, and you should throw out his testimony, not in part, but in whole. You should not trust Dr. Beebe." J.A. 5159.

After trial, Rembrandt received information suggesting that Dr. Bielawski testified falsely at trial. Although the district court denied Rembrandt's request for post-trial discovery, Rembrandt received much of the discovery it sought from Dr. Bielawski's employer, the University of Texas, through an open records request and state court litigation. In light of that

discovery, the parties do not dispute that Dr. Bielawski testified falsely during trial.¹

Specifically, Dr. Bielawski repeatedly testified that he personally conducted X-ray photoelectron spectroscopy (“XPS”) and time-of-flight secondary ion mass spectrometry (“TOF-SIMS”) laboratory testing on JJVC’s accused lenses when, in fact, the testing was conducted by Dr. Bielawski’s graduate students and various lab supervisors. The post-trial discovery suggests that Dr. Bielawski was not even in the country when some of the testing was done. Moreover, the post-trial discovery suggests that Dr. Bielawski overstated his qualifications and experience with these testing methodologies. Whereas Dr. Bielawski was presented to the jury as an expert in TOF-SIMS testing, he actually “had no TOF-SIMS experience whatsoever.” J.A. 5437. As such, for the purpose of considering the Rule 60(b) motions, the district court “assume[d] . . . that Dr. Bielawski testified falsely when he said that he personally performed . . . tests, and about his qualifications as an expert in performing those tests.” *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.* (Rule 60 Order), 300 F.R.D. 694, 698 (M.D. Fla. 2014).

¹ Because perjury is a crime and Dr. Bielawski is not a party to this litigation, we express no opinion as to whether Dr. Bielawski committed perjury. Instead, we accept, for the purpose of deciding this case, the parties’ and district court’s conclusion that Dr. Bielawski testified falsely at trial.

In addition to showing Dr. Bielawski's false testimony, the post-trial discovery revealed that Dr. Bielawski withheld test results and data analysis that would have undermined his opinions and trial testimony. In particular, Dr. Bielawski withheld data from tests conducted on third-party contact lenses previously found to infringe the asserted claim. JJVC provided the samples of these lenses to Dr. Bielawski and requested that he perform "any initial setup experiments" on the third-party lenses in order to "satisfy[] himself with respect to the proper investigational techniques to be used on contact lenses." J.A. 5576. The test results generated in response to JJVC's request were not produced before trial, and JJVC claims that it was unaware that any data had been generated. Had these test results been produced to Rembrandt, they would have shown that the infringing lenses do not have a surface coating of about 20 nanometers, undermining Dr. Bielawski's testimony at trial. Specifically, Dr. Bielawski testified at trial without contradiction about the differences between JJVC's accused lenses and the infringing third-party lenses, explaining that the infringing lenses "have a surface coating that [is] about 20 nanometers," J.A. 4697, whereas JJVC's accused lenses do not. JJVC's counsel emphasized Dr. Bielawski's testimony on this point as proof of noninfringement during closing argument:

And guess what, this point 20 is not picked out of thin air. It's exactly what happens when you look at the [infringing third-party] lens.

J.A. 5142.

In light of this post-trial discovery, Rembrandt moved for a new trial under Rules 60(b)(2) and (3), which state:

On motion and just terms, the court may relieve a party . . . from a final judgment . . . for the following reasons: . . . (2) newly discovered evidence, that with reasonable diligence, could not have been discovered in time to move to a new trial under Rule 59(b); [or] (3) fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing

Following a lengthy hearing on the issue, the district court denied Rembrandt's motion. With little discussion, the district court dismissed Rembrandt's argument that the withheld documents prevented it from fully and fairly presenting its case. The district court thus limited its analysis to Dr. Bielawski's false testimony. The district court concluded that Rembrandt was not entitled to a new trial under Rule 60(b)(2) because Rembrandt had not satisfied the requirement in the Eleventh Circuit that a new trial would probably produce a new result. And it concluded that Rembrandt was not entitled to a new trial under Rule 60(b)(3) because JJVC's counsel was not complicit in the false testimony and because Rembrandt was not prevented from fully and fairly presenting its case. Rembrandt then renewed its motion to reopen discovery into JJVC's awareness of Dr. Bielawski's misconduct, but the district court denied that motion too.

Rembrandt appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review procedural questions such as the district court's denial of a Rule 60(b) motion under the law of the regional circuit, here the Eleventh Circuit. *Amado v. Microsoft Corp.*, 517 F.3d 1353, 1357 (Fed. Cir. 2008). The Eleventh Circuit reviews district court decisions on *Rule 60(b)* motions for an abuse of discretion. *Griffin v. Swim-Tech Corp.*, 722 F.2d 677, 680 (11th Cir. 1984). Under Eleventh Circuit law, the district court abuses its discretion if it: (1) applies an incorrect legal standard; (2) follows improper procedures in making the determination; or (3) makes findings of fact that are clearly erroneous. *Morgan v. Family Dollar Stores, Inc.*, 551 F.3d 1233, 1260 (11th Cir. 2008).

We first consider Rembrandt's motion for a new trial under Rule 60(b)(3), which permits a district court to grant a new trial in cases involving "fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party." Fed. R. Civ. P. 60(b)(3). To prevail on a motion under Rule 60(b)(3) in the Eleventh Circuit, the movant must establish that: (1) the adverse party engaged in fraud or other misconduct; and (2) this conduct prevented the moving party from fully and fairly presenting its case. *Harre v. A.H. Robins Co.*, 750 F.2d 1501, 1503 (11th Cir. 1985), *vacated in part on other grounds*, 866 F.2d 1303 (11th Cir. 1989). Proof that the result of the case would have been different but for the fraud or misconduct is not required; instead, Rule 60(b)(3) "is aimed at judgments which were unfairly obtained, not at those which are factually incorrect." *Rozier v. Ford Motor Co.*,

573 F.2d 1332, 1339 (5th Cir. 1978)² (internal citations omitted); *see also Wilson v. Thompson*, 638 F.2d 801, 804 (5th Cir. 1981) (“We recognize that a party moving under Rule 60(b)(3) may prevail without showing that the alleged fraud affected the outcome of the prior trial.”).

I

We start with the easier question of whether Rembrandt had a full and fair opportunity to present its case given Dr. Bielawski’s false testimony and withholding of relevant documents. In denying Rembrandt’s motion under Rule 60(b)(3), the district court concluded that “even accounting for Dr. Bielawski’s misconduct, Rembrandt was not prevented from making its case,” and explained that this holds true “even without considering that JJVC was entitled to judgment as a matter of law because Rembrandt failed to present evidence on an essential element of its case.” Rule 60 Order, 300 F.R.D. at 701 & n.9. The district court also summarily dismissed Rembrandt’s argument that it was prevented from fully and fairly presenting its case due to the withheld documents as “murky at best.” *Id.* at 697 n.1. We conclude that the district court clearly erred in finding that Rembrandt had a full and fair opportunity to present its infringement case.

Dr. Bielawski testified on a central infringement issue at trial—whether JJVC’s accused lenses met the “surface layer” claim limitation. In doing so, he testified falsely about his personal involvement in the testing, as

² Fifth Circuit precedent prior to September 30, 1981 is binding on the Eleventh Circuit. *Bonner v. City of Prichard*, 661 F.2d 1206, 1209 (11th Cir. 1981).

well as his experience with the relevant testing methodologies. He also withheld contradictory test results on third-party lenses known to infringe and generated at the request of JJVC's counsel. Because these test results were not produced, Dr. Bielawski testified without contradiction about alleged differences between the accused lenses and the third-party lenses to show that the accused lenses did not have the claimed surface layer. JJVC's counsel emphasized these differences as proof of noninfringement in his closing argument. In addition, Dr. Bielawski and JJVC's counsel seized several opportunities to impugn the credibility of Dr. Beebe, but the jury never heard that Dr. Bielawski had presented false testimony. Under these circumstances, we cannot agree with the district court that this conduct did not prevent Rembrandt from fully and fairly presenting its infringement case. The verdict was irretrievably tainted by Dr. Bielawski's false testimony and Dr. Bielawski's and JJVC's withholding of relevant documents. While we do not know the exact impact the false testimony would have had on the jury, the false testimony may well have been critical to the noninfringement verdict and the jury may well have been impacted upon learning that Dr. Bielawski committed an act at least as egregious as Dr. Beebe's.

JJVC and the dissent nonetheless assert that the district court did not abuse its discretion, relying on a rationale different from that of the district court. Specifically, JJVC argues that Rembrandt had a full and fair trial because Dr. Bielawski did not testify regarding the "soft" limitation and Rembrandt cannot show that the false testimony and improperly withheld documents

resulted in substantial impairment of its ability to present its case on the “soft” limitation. We are not convinced by JJVC’s argument.

The district court granted JMOL, not because of the merits of JJVC’s noninfringement position, but because its exclusion of Dr. Beebe’s unreliable testimony compelled that result. The district court judge acknowledged that he may well have responded differently had he been aware at the time of Dr. Bielawski’s false testimony. During the hearing regarding the Rule 60 motions, he explained:

I guess my problem with it is—is that—or my query is that—I don’t think I—I’m not sure I would have gotten to that place [of granting judgment as a matter of law]—or I sure—I may have gotten to that place differently—or I may—something different may have happened if I had known at the time—Dr. Beebe’s shortcomings came out during the trial.

And they were obvious and—and I made my ruling based on what I saw, noting, also, that as I recall it you were able to, with the jury, take great advantage of his implosion.

And so you kind of got—you kind of got a double whammy. You got me ruling as a matter of law to strike his testimony. But you also got to argue to the jury that—that one of their experts had—was unworthy of any credence. And so you got to do all that because Dr. Beebe’s malfeasance came out during the trial.

August 2, 2013 Motion Hearing, J.A. 7440-41. In the order denying Rembrandt's Rule 60(b)(3) motion, the district court also acknowledged that Dr. Bielawski's misconduct was at least as egregious as Dr. Beebe's:

This was a serious and detrimental occurrence. It insulted the jury, violated the integrity of the judicial process, and interfered with the search for the truth that is the hallmark of our trial-by-jury system. Moreover, this false testimony was given in a highly contested patent case in which an expert for Rembrandt, Dr. Beebe, radically changed his expert testimony during the middle of his examination. As a result, the Court struck his testimony and entered an alternative Rule 50 judgment against Rembrandt because it was unable to prove a required element of its case without Dr. Beebe's testimony. . . . Now, having learned post-trial that JJVC's expert likely lied on the stand, arguably committing an act at least as egregious as Dr. Beebe's, it is a fair question to ask whether Rembrandt should be entitled to a new trial.

Rule 60 Order, 300 F.R.D. at 698.

On this record, we cannot agree that Rembrandt had a full and fair trial on the "soft" limitation. We rejected an argument similar to JJVC's in *Fraige v. American-Nat'l Watermattress Corp.*, 996 F.2d 295 (Fed. Cir. 1993). In *Fraige*, the defendant forged a prior art document. *Fraige*, 996 F.2d at 296. Although the forged document was not presented to the jury, several witnesses who testified at trial had reviewed the document. *Id.* at 296, 298. We explained that we could

not accurately determine the impact of the forged document on the jury, noting that “[w]hen it became known that the jury was presented testimony based on fraudulent documentation, where that testimony was relevant and material to the issue of patent validity, *all of the jury’s invalidity findings became suspect.*” *Id.* at 299 (emphasis added). Although an arguably “independent” ground of invalidity existed in *Fraige*—invalidity under 35 U.S.C. § 112—we nevertheless reversed the district court’s denial of a new trial under Rule 60(b)(3).³ We concluded that where the impact of the tainted evidence on the allegedly “independent” ground of invalidity could not be ascertained, the independent ground was not a basis for denying the request for a new trial. *Id.* at 299-300.

Similarly, here, we will not speculate as to what impact the fraud and misconduct had on the ultimate judgment of noninfringement where the false testimony and withheld documents were material to the issue of patent infringement and could well have impacted the jury’s verdict, as well as the district court’s decision to exclude Dr. Beebe’s testimony and consequently grant JMOL on the “soft” limitation. We agree with

³ The dissent asserts that *Fraige* is inapposite, contending that “our reasoning was that relief was available not under Rule 60(b)(3) but under the savings clause in Rule 60.” We disagree. The Court’s decision in *Fraige* rested on Rule 60(b)(3). Indeed, the Court specifically stated that “[t]he effect of the tainted evidence on the section 112 defense, while less certain, cannot be ascertained and therefore is similarly not a basis for denying the Rule 60(b)(3) motion for relief from the patent invalidity judgment.” 996 F.3d at 299-300 (footnote omitted).

Rembrandt that it was prejudiced by the withholding of third-party test results and by the false testimony. As the Fifth Circuit held in *Rozier*, Rembrandt is not required to prove that the withheld documents were of such nature as to alter the result in the case. 573 F.2d at 1339. Instead, Rembrandt need only show that timely production of the documents would have made a difference in the way Rembrandt's counsel approached the case or prepared for trial. *Id.* at 1342. Here, Rembrandt could have deposed the individuals who actually conducted the testing for JJVC. JJVC based its noninfringement argument at trial nearly exclusively on the surface layer limitation. Knowing the weaknesses in JJVC's evidence regarding the surface layer limitation could well have changed the nature of the entire proceedings. We cannot and will not speculate about the profound effects knowledge of the withheld documents and falsified testimony of JJVC's primary witness would have had on the proceedings and the district court's JMOL. Suffice it to say that this raises a substantial question undermining the judgment of noninfringement.

Finally, we note that Rembrandt presented additional evidence at trial to show that JJVC's accused lenses satisfied the "soft" limitation. For example, JJVC stipulated that the accused lenses are silicone hydrogel contact lenses, and the record contains evidence that suggests silicone hydrogel contact lenses yield a Shore D test result of zero. The dissent states that Rembrandt failed to raise this evidence in response to JJVC's JMOL motion. It is true, as we noted in our prior opinion, Rembrandt identified only Dr. Beebe's testimony when responding to JJVC's JMOL motion. *Rembrandt I*, 725

F.3d at 1383. Had Dr. Beebe's testimony not been stricken, it certainly would have prevented the court from entering JMOL in favor of JJVC. In addition, although not relied on by Rembrandt in responding to JJVC's JMOL motion, there was additional evidence in the trial record that the accused lenses met the "soft" limitation. In light of this record, we cannot conclude that Rembrandt had a full and fair trial on infringement.

II

We next look to whether Rembrandt established that "the adverse party engaged in fraud or other misconduct." *Harre*, 750 F.2d at 1503 (citation omitted). We conclude that the district court abused its discretion in concluding otherwise. Specifically, the district court erred by summarily dismissing Rembrandt's allegations of misconduct and by requiring proof that JJVC or its counsel was complicit in Dr. Bielawski's false testimony.

Rembrandt alleges fraud based on Dr. Bielawski's false testimony and misconduct based on Dr. Bielawski and JJVC's failure to produce the contradictory test results on third-party lenses. Each allegation forms an independent basis for a new trial under Rule 60(b)(3). JJVC does not dispute that Dr. Bielawski testified falsely and that it never produced the test results for the third-party lenses. Instead, JJVC argues that Rule 60(b)(3) cannot provide relief because JJVC was not complicit in the fraud or the misconduct. Considering only Dr. Bielawski's false testimony, the district court held that Rembrandt was not entitled to a new trial under Rule 60(b)(3) because it had not shown that either JJVC or its counsel was complicit in any fraud or misconduct.

Turning first to Rembrandt's allegations of misconduct, we agree with Rembrandt that the district court erred by failing to fully address Rembrandt's allegations of misconduct and requiring proof of complicity. As used in Rule 60(b)(3), "[m]isconduct' does not demand proof of nefarious intent or purpose as a prerequisite to redress. . . . The term can cover even *accidental* omissions—elsewise it would be pleonastic, because 'fraud' and 'misrepresentation' would likely subsume it." *Anderson v. Cryovac, Inc.*, 862 F.2d 910, 923 (1st Cir. 1988) (emphasis added); *see also Bros Inc. v. W.E. Grace Mfg. Co.*, 351 F.2d 208, 211 (5th Cir. 1965) ("The effect [of misconduct] was the same whether there was evil, innocent or careless, purpose.").

JJVC admits that it provided samples of third-party lenses to Dr. Bielawski to conduct "initial set up experiments" on the lenses. The relevance of these tests to JJVC's noninfringement defense cannot be disputed—Dr. Bielawski testified about differences between JJVC's accused lenses and the third-party lenses that were known to infringe and JJVC's counsel emphasized these differences during his closing argument.

JJVC argues that a new trial is not warranted because it "was unaware of any testing of these lenses." Appellee Br. 28. JJVC's argument strains credulity, given that it provided the lenses to Dr. Bielawski and talked about them during closing argument. But we need not determine whether JJVC's failure to obtain and produce this data was intentional or merely accidental; as explained above, even an accidental omission qualifies as misconduct under Rule 60(b)(3).

Turning next to Rembrandt's allegations of fraud, the district court concluded that Rule 60(b)(3) requires proof of JJVC's complicity in the false testimony, relying heavily on *Harre*, 750 F.2d 1501, as well as cases outside of the Eleventh Circuit. Rembrandt argues that the district court misinterpreted Eleventh Circuit precedent by requiring proof of complicity to satisfy Rule 60(b)(3). We agree.

Although evidence of complicity was considered by the Eleventh Circuit in *Harre*, the court did not announce a rule *requiring* such evidence to prevail on a Rule 60(b)(3) motion. The district court in this case acknowledged as much, stating that “the *Harre* court did not expressly limit its holding to circumstances in which counsel is complicit with witness misconduct” Rule 60 Order, 300 F.R.D. at 699. Instead, after concluding that the appellant had “presented sufficient evidence to support the allegation that [the expert] committed perjury,” the *Harre* court turned to the second inquiry under Rule 60(b)(3)—“whether the conduct complained of prevented Appellants from fully and fairly presenting their case.” *Harre*, 750 F.2d at 1504-05. Although the *Harre* court also determined that counsel “must have been aware” of the perjury and expressed deep concern in view of that determination, it did not suggest that relief under Rule 60(b)(3) would otherwise have been unavailable. *See id.* at 1505. Consistent with our understanding, a subsequent Eleventh Circuit case cited *Harre* for the proposition that mere “perjury constitutes fraud under [Rule] 60(b)(3).” *See Bonar v. Dean Witter Reynolds, Inc.*, 835 F.2d 1378, 1383 n.7 (11th Cir. 1988). The Fifth Circuit has also recognized that Rule 60(b)(3)

is remedial and should be liberally construed. *Rozier*, 573 F.2d at 1346.

Likewise, we have previously affirmed a grant of a new trial under Rule 60(b)(3) in view of an expert's perjured testimony, even when it was undisputed that the party was unaware of the perjury. *See Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1324 (Fed. Cir. 2001). In *Viskase*, an expert witness lied about his personal involvement in laboratory testing concerning alleged infringement. *Id.* Although there was no evidence that the sponsoring party or its counsel was aware of the expert's perjury, the district court had determined that the party's counsel "surely knew there must have been additional documents and that there were additional tests conducted" that had not been produced, and, as a result, "conclude[d] that [the party] cannot escape responsibility for [the expert's] testimony." *Viskase Corp. v. Am. Nat'l Can Co.*, 979 F. Supp. 697, 705 (N.D. Ill. 1997). In affirming the district court's grant of a new trial, we "agree[d] with the district court that the jury verdict was irretrievably tainted and was properly set aside." *Viskase*, 261 F.3d at 1324. We are presented with very similar facts here. Although JJVC may have been unaware of Dr. Bielawski's false testimony, JJVC should have known that additional tests were conducted and additional documents were generated. Indeed, it provided samples of the third-party lenses to Dr. Bielawski, requested that he conduct initial testing on those lenses, and questioned Dr. Bielawski on the same subject matter during trial.

At bottom, the district court erred by concluding that the Eleventh Circuit would require proof that JJVC or its counsel was complicit in Dr. Bielawski's false testimony. In this most unusual case involving false testimony by both parties' experts and misconduct, we cannot agree that the Eleventh Circuit would require complicity in Dr. Bielawski's false testimony. While the district court gave thoughtful consideration to Rembrandt's Rule 60(b)(3) motion and to the integrity of the judicial process, it erred in requiring complicity and summarily dismissing Rembrandt's separate allegation of misconduct. We thus conclude that the district court abused its discretion in denying Rembrandt's motion for a new trial under Rule 60(b)(3).

III

Because we reverse the district court's denial of Rembrandt's motion for a new trial under Rule 60(b)(3), we do not consider whether the district court abused its discretion in denying Rembrandt's Rule 60(b)(2) and discovery motions. We also reject JJVC's argument that the mandate rule precludes consideration of Rembrandt's Rule 60(b) motions. Our prior decision in this case did not address, explicitly or implicitly, Rembrandt's request for a new trial under Rule 60(b). *See Rembrandt I*, 725 F.3d 1377.

CONCLUSION

We hold that the district court abused its discretion in denying Rembrandt's motion for a new trial under Rule 60(b)(3). We therefore reverse and remand for a new trial.

REVERSED AND REMANDED

DISSENT BY: DYK**DISSENT**

Dyk, *Circuit Judge*, dissenting.

This case presents two important questions about the interpretation of Rule 60(b)(3) of the Federal Rules of Civil Procedure in the context of false testimony by an expert witness. The first is whether a showing by a movant that it lacked a “full and fair” opportunity to present its case requires some showing that the result could have been affected by the false testimony. The second is whether false testimony by an expert witness can be attributed “to the opposing party” (as required by the rule) without a showing of knowledge or reason to know that the testimony was false. I respectfully suggest that the majority is wrong on both counts.

I

Relying on Rule 60(b)(3), Rembrandt sought to set aside a summary judgment of non-infringement of the asserted claim of U.S. Patent No. 5,712,327 (“the ‘327 Patent”) based on false testimony of Johnson & Johnson Vision Care’s (JJVC’s) expert witness, Dr. Christopher Bielawski. The district court denied relief.

To succeed on a motion under Rule 60(b)(3), it is not necessary to establish that the fraud “alter[ed] the result in the case.” *Rozier v. Ford Motor Co.*, 573 F.2d 1332, 1339 (5th Cir. 1978). But, the movant must demonstrate by clear and convincing evidence that the alleged fraud or misconduct prevented it “from fully and fairly presenting his case or defense.” *Cox Nuclear Pharm., Inc. v. CTI, Inc.*, 478 F.3d 1303, 1305 (11th Cir.

2007); *Harre v. A.H. Robins Co.*, 750 F.2d 1501, 1503 (11th Cir. 1985); *see also* 11 Charles Alan Wright et al., *Federal Practice and Procedure* § 2860 & n.12 (3d ed. 2012) (noting that to qualify for relief under the rule, “the fraud must have prevented the moving party from fully and fairly presenting his case,” and citing cases). In other words, the moving party must demonstrate that the misconduct “substantially interfered with its ability fully and fairly to prepare for, and proceed at, trial.” *Anderson v. Cryovac, Inc.*, 862 F.2d 910, 926 (1st Cir. 1988). In my view, the majority’s decision effectively eliminates this requirement, and errs in reversing the district court’s determination that this standard was not met.

At the original trial, JJVC argued for a finding of non-infringement based on two limitations of asserted claim 1 of the ‘327 Patent. The claim requires contact lenses that are both (1) “soft” and (2) have a “tear-wettable surface layer.” ‘327 Patent, col. 8 ll. 2-16. These are separate and independent limitations. For example, both “hard” and “soft” contact lenses can be coated with a material to make the lenses more “tear-wettable.” Similarly, the patent itself describes prior art “soft” lenses that lack a surface layer. Thus, to prevail in its infringement case, Rembrandt had the burden of independently proving (1) that the accused contact lenses were “soft” and (2) that the accused lenses had a surface layer. In this case, two witnesses testified falsely, one for each side and one on each issue.

The district court construed “soft” to mean “having a Hardness (Shore D) of less than 5” on the Shore scale--an accepted standard for hardness. *Rembrandt Vision*

Techs., L.P. v. Johnson & Johnson Vision Care, Inc., 282 F.R.D. 655, 657 (M.D. Fla. 2012) (“*JMOL Order*”). In other words, to meet the claim limitation, the accused lenses had to have a value of less than five according to a commonly used testing and measurement method for hardness.

Rembrandt’s expert witness, Dr. Thomas Beebe, Jr., testified that the accused contact lenses met the “soft” limitation of the patent claim. During his testimony about the “soft” limitation, “Dr. Beebe’s trial testimony did not match the opinions disclosed in his expert report.” *Rembrandt Vision Techs. v. Johnson & Johnson Vision Care, Inc.*, 725 F.3d 1377, 1379 (Fed. Cir. 2013) (“*Rembrandt I*”). “In fact, the differences . . . [were] so substantial that Dr. Beebe essentially performed an entirely different test” than he had described in his expert report. *JMOL Order*, 282 F.R.D. at 663. During what the district court described as an “implosion” on the stand, Dr. Beebe “completely changed his testimony” during cross-examination. *Id.* at 668. Accordingly, after trial, the district court excluded Dr. Beebe’s testimony and, because “Dr. Beebe’s testimony was the only evidence presented at trial that showed that the accused lenses met the ‘soft’ limitation,” the district court granted JJVC’s motion for judgment as a matter of law (“*JMOL*”) that the accused lenses did not infringe because they did not meet the “soft” limitation. *Rembrandt I*, 725 F.3d at 1383. On appeal, we affirmed the district court’s exclusion of Dr. Beebe’s testimony and the subsequent grant of *JMOL*. *Id.* at 1378.

A different scenario played out with respect to the “surface layer” limitation. The district court construed the “surface layer” limitation to mean “a layer beginning from and including the outermost surface and moving inward to an arbitrary depth of the lens and having a different composition from the ‘body’ portion of the lens.” *Rembrandt Vision Techs. L.P. v. Johnson & Johnson Vision Care, Inc.*, No. 11-cv-0819, ECF No. 300 (Transcript of May 10, 2012), at 295. In other words, to infringe, contact lenses must contain an outer layer made up of a different material than the rest of the contact lens. JJVC’s expert witness, Dr. Bielawski, testified that the accused products did not meet the surface layer limitation.

After trial, Rembrandt discovered that Dr. Bielawski had falsely testified about his credentials and about who had performed the testing in his expert report. Rembrandt also discovered that data from Dr. Bielawski regarding surface-layer testing of third party lenses had been withheld. As the majority notes, Dr. Bielawski testified for JJVC “to support its position that its accused lenses did not meet the ‘surface layer’ limitation, but did not present expert testimony with respect to the ‘soft’ limitation.” Maj. Op. at 3.

The question here is whether Dr. Bielawski’s later-discovered false testimony about the “surface layer” limitation should result in re-opening the district court’s JMOL of non-infringement based on the plaintiff’s failure to produce any evidence in response to the JMOL motion (absent Dr. Beebe’s stricken testimony) that the accused lenses met the “soft” limitation. The district court correctly concluded that the JMOL should not be

reopened because Rembrandt was not deprived of a full and fair opportunity to present its case on the “soft” limitation—an issue which was dispositive of non-infringement.

I note at the outset that the majority incorrectly focuses on the jury verdict of non-infringement. *See, e.g.*, Maj. Op. at 8 (“The verdict was irretrievably tainted by Dr. Bielawski’s false testimony and Dr. Bielawski’s and JJVC’s withholding of relevant documents. While we do not know the exact impact the false testimony would have had on the jury, the false testimony may well have been critical to the noninfringement verdict and the jury may well have been impacted upon learning that Dr. Bielawski committed an act at least as egregious as Dr. Beebe’s.”) Whether the jury verdict was tainted by Dr. Bielawski’s testimony about Dr. Beebe is not relevant. The jury verdict is not under review here; the district court’s grant of JMOL (on the “soft” limitation only) is, and the district court did not rely on Dr. Bielawski’s testimony in granting JMOL.

In this respect, to succeed on the Rule 60(b)(3) motion for a new trial, Rembrandt was required to show that the false testimony resulted in a substantial impairment of its ability to present its case on the “soft” issue. “Substantial impairment may exist, for example, if a party shows that the [misconduct] precluded inquiry into a plausible theory of liability, denied it access to evidence that could well have been probative on an important issue, or closed off a potentially fruitful avenue of direct or cross examination.” *Anderson*, 862 F.2d at 925. But if the misconduct is related to evidence that is “cumulative, insignificant, or of marginal

relevance,” “retrial would needlessly squander judicial resources.” *Id.* at 924.

Rembrandt’s only argument as to substantial impairment is that it “could have moved for summary judgment on the surface layer issue—or streamlined its trial evidence on the issue—and thus had more time to present additional evidence regarding the ‘soft’ nature of the accused lenses.” Reply Br. at 24. In other words, Rembrandt speculates that it would have spent more time preparing its case for the “soft” limitation and could have potentially prevented Dr. Beebe’s meltdown on the stand. And the majority asserts that the existence of such a possible reallocation of resources is sufficient, stating that “[k]nowing the weaknesses in JJVC’s evidence regarding the surface layer limitation could well have changed the nature of the entire proceedings. We cannot and will not speculate about the profound effects knowledge of the [alleged misconduct] would have had on the proceedings and the district court’s JMOL.” Maj. Op. at 12. Under this standard, it is hard to see any case where, after a party proves misconduct of any kind, that party would not be afforded relief. In effect, the majority’s holding renders the “full and fair” requirement a nullity. Neither Rembrandt nor the majority can point to any case where Rule 60(b)(3) relief has been granted based on such speculation.

The authority is uniformly to the contrary. The standard before Rule 60 was adopted was quite clear. “[T]o justify setting aside a decree for fraud whether extrinsic or intrinsic, it must appear that the fraud charged really prevented the party complaining from making a full and fair defense.” *Toledo Scale Co. v.*

Computing Scale Co., 261 U.S. 399, 421, 43 S. Ct. 458, 67 L. Ed. 719, 1924 Dec. Comm’r Pat. 486 (1923) (emphasis added). “If it does not so appear, then proof of the ultimate fact, to wit, that the decree was obtained by fraud fails.” *Id.* This requires a showing of how “the complaining party was, without his fault, deprived of his opportunity to present his defense on the merits. . . . Chancery will intervene, therefore, only when the complainant was prevented from presenting a meritorious defense by the inequitable conduct of his adversary unmixed with negligence or fault on his own part.” *In re Innis*, 140 F.2d 479, 481 (7th Cir. 1944). “[I]t [is] an imperative condition of such relief that the party seeking it shall make it clearly appear that he had a good defense to the action, which, by fraud or accident, he was prevented from making, and also that there was neither fault nor negligence on his part.” *Talbott v. Pickford*, 36 App. D.C. 289, 298 (D.C. Cir. 1911), *aff’d sub nom.*, 225 U.S. 651, 32 S. Ct. 687, 56 L. Ed. 1240 (1912). This common law equity standard was incorporated into the Rule 60(b)(3) standard. *Rozier*, 573 F.2d at 1339 (citing *Toledo Scale*, 261 U.S. at 421).

Under Rule 60(b)(3), when the alleged misconduct is related to issues that “are essentially irrelevant to the legal issues upon which the case turned,” relief from the judgment is not warranted. *Simons v. Gorsuch*, 715 F.2d 1248, 1253 (7th Cir. 1983); *see also PMC, Inc. v. Atomergic Chemetals Corp.*, No. 95-7509, 1995 WL 595557, at *1 (2d Cir. Sep. 25, 1995) (unpublished decision) (finding claim of lack of a full and fair opportunity “to be without merit” when an expert lied about his credentials because the misconduct “did not

have ‘such a close nexus to the issues’” relevant in the case); *Anderson*, 862 F.2d at 931 (relief under Rule 60(b)(3) should not be granted where the misconduct “would have had no effect on the result” of the case).

A review of cases where Rule 60(b)(3) motions have been granted shows that relief is only granted when the misconduct involves material, relevant evidence; in other words, when knowing about the misconduct actually could have made a difference. *See, e.g., Abrahamsen v. Trans-State Express, Inc.*, 92 F.3d 425, 430 (6th Cir. 1996) (plaintiff in a tort action resulting from a car accident entitled to a new trial because defendant’s attorney withheld evidence of a statement by defendant’s driver that he “dozed off” while driving, leading to the accident); *Rozier*, 573 F.2d at 1339, 1342-43 (defendant improperly withheld an internal cost/benefit report showing the defendant’s knowledge of the defect and rejecting a safer design; the report “would have” affected plaintiff’s approach to the design-defect tort case, and the plaintiff was “prejudiced”); *Seaboldt v. Pa. R.R. Co.*, 290 F.2d 296, 299 (3d Cir. 1961) (defendant entitled to a new trial in a personal injury case relating to a back injury because plaintiff’s counsel failed to supply information concerning a chiropractor who would have testified that he “had treated the plaintiff previously for a ‘chronic’ back ailment” before the alleged injury.).

Fraige v. American-Nat’l Watermattress Corp., 996 F.2d 295 (Fed. Cir. 1993), relied on by the majority, is not to the contrary. In that case, counsel for the accused infringer had submitted to the court “false and forged documentation” about a supposed prior art reference. *Id.*

at 296. The motion was made under Rule 60(b)(3), and we held that relief should have been granted under that rule. However, our reasoning was that relief was available not under Rule 60(b)(3) but under the savings clause in Rule 60, which allows a court to “entertain an independent action for fraud on the court.” Fed. R. Civ. P. 60(d)(1); *see also Fraige*, 996 F.2d at 297 (citing the savings clause). As the Advisory Committee Note to the rule explains, “the rule expressly does not limit the power of the court, when fraud has been perpetrated upon it, to give relief under the saving clause.” As an illustration of this situation, *see Hazel-Atlas Glass Co. v. Hartford Empire Co.*, 322 U.S. 238, 64 S. Ct. 997, 88 L. Ed. 1250, 1944 Dec. Comm’r Pat. 675 (1944).¹ Fed. R. Civ. P. 60(b) Advisory Committee Note to the 1946 Amendments. We found in *Fraige* that “[l]ike *Hazel-Atlas*, [the defendant’s] fraudulent conduct was a wrong against the judicial system as well as against [the plaintiff.]” 996 F.2d at 299. Appropriately, we found that a new trial was necessary because for more serious “fraud on the court” (unlike Rule 60(b)(3)), the moving party need not demonstrate prejudice to receive relief from a judgment because “a decision produced by fraud

¹ Fraud on the court, not even alleged in this case, constitutes “an unconscionable plan or scheme which is designed to improperly influence the court,” and, unlike fraud referenced in Rule 60(b)(3), involves the “integrity of the court itself.” Charles Alan Wright, et al., *Federal Practice and Procedure* § 2870 (2012). In *Hazel-Atlas*, for example, the Supreme Court found that the patent-holder’s “flagrant” and “deliberate” plan to deceive both the Patent Office and the district court “call[ed] for nothing less than a complete denial of relief [] for the claimed infringement of the patent thereby procured and enforced.” *Hazel-Atlas*, 322 U.S. at 250.

on the court is not in essence a decision at all, and never becomes final.” *Kenner v. Comm’r of Internal Revenue*, 387 F.2d 689, 691 (7th Cir. 1968). *Fraige* is not authority for the proposition that Rule 60(b)(3) does not require a showing of lack of full and fair opportunity.

Rembrandt has failed to show how knowledge of Dr. Bielawski’s misconduct would have changed its approach to the “soft” limitation. The JMOL was based entirely on the exclusion of Dr. Beebe’s testimony because of his “abrupt and still unexplained implosion” that “led to the derailment of the trial” on the softness issue. J.A. 7444.²

The majority suggests that there was other evidence in the trial record that the accused lenses met the “soft” limitation, but such evidence was not raised by Rembrandt in response to the JMOL motion. Maj. Op. at 12. In the first appeal, we held that Rembrandt had not preserved the right to argue this evidence in connection with the JMOL motion.³ I fail to see how the decision by Rembrandt not to raise this evidence could have even

² Although the district court deferred action on the JMOL until after the jury verdict, it could have granted the relief at the end of the presentation of Rembrandt’s case. If it had done so, Dr. Bielawski would never even have testified.

³ Specifically, we found that “[i]n opposing JJVC’s motion for judgment as a matter of law, Rembrandt only pointed to Dr. Beebe’s trial testimony. Moreover, Rembrandt conceded at the post-trial hearing that Dr. Beebe’s testimony was the only evidence presented at trial that showed that the accused lenses met the ‘soft’ limitation. . . . We decline to upend the district court’s decision on a basis that was not raised below.” *Rembrandt I*, 725 F.3d at 1383 (emphasis added).

arguably been affected by Dr. Bielawski's false testimony.

In any event, Rembrandt's decision not to raise this evidence represents a strategic litigation choice. Rule 60(b)(3) cannot be used to allow a party to escape its own negligence in developing its case. Courts routinely deny Rule 60(b)(3) motions when a party loses not because of the alleged fraud but because of its own failings. "When a party is capable of fully and fairly preparing and presenting his case notwithstanding the adverse party's arguable misconduct, the trial court is free to deny relief under Rule 60(b)(3)." *Karak v. Bursaw Oil Corp.*, 288 F.3d 15, 22 (1st Cir. 2002); *see also Diaz v. Methodist Hosp.*, 46 F.3d 492, 497 (5th Cir. 1995). Nothing about Dr. Bielawski's misconduct regarding the "surface layer" limitation prevented Rembrandt from raising other evidence on the softness issue in response to the JMOL motion.

Quintessentially, the resolution of a Rule 60(b)(3) motion is a matter of discretion for the district court judge, who sat during the entire trial and is most intimately familiar with the reasoning for his own statements and previous order. Here the district court concluded that no retrial was appropriate. In an effort to suggest that the district court would have reached a different result if it had applied a different standard, both Rembrandt and the majority point to ambiguous statements by the district court during the Rule 60 hearing when the trial judge, before reaching his final decision on the motion, speculated that the false testimony might have somehow affected the JMOL decision as to the soft limitation. But, as noted, Dr.

Bielawski offered no testimony on the “soft” limitation, and the district court made no finding of any such relationship in its final decision.⁴ At best, the district court’s statements suggest that a remand to the district court might be appropriate to reconcile the final order and the court’s earlier statements.

In short, the record here demonstrates that Rembrandt failed to produce any credible evidence on one element of its case. That failure had nothing to do with Dr. Bielawski’s false testimony. In the prior appeal, we affirmed that the district court acted properly in excluding Dr. Beebe’s testimony and in granting JMOL of non-infringement based on the lack of evidence. That previous determination should not be disturbed by a subsequent discovery of false testimony about an entirely different issue.

II

There is also, in my view, a second error in the majority opinion. Under Rule 60(b)(3), “the court may relieve a party or its legal representative from a final judgment, order, or proceeding” if there was “fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party.”

⁴ In the final order, the district court found that “[w]hat Rembrandt mainly lost here was an opportunity to discredit or eliminate an expert witness who . . . was not required for JJVC to win the case. When the trial is looked at in its totality, even accounting for Dr. Bielawski’s misconduct, Rembrandt was not prevented from making its case.” *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.*, 300 F.R.D. 694, 701 (M.D. Fla. 2014) (“Rule 60 Order”).

Fed. R. Civ. P. 60(b)(3). I also disagree with the majority's conclusion (contrary to that of the district court) that the rule does not require any evidence that the misconduct was attributable to "the opposing party" as required by the text of Rule 60(b)(3).

The majority finds that the district court erred in "requiring proof of [JJVC's] complicity" in Dr. Bielawski's false testimony. Maj. Op. at 13. According to the majority, "[i]n this most unusual case involving false testimony by both party experts, we cannot agree that the Eleventh Circuit would require complicity in Dr. Bielawski's false testimony." *Id.* at 15.

The two other circuits that have confronted the issue have reached the opposite conclusion. As the Seventh Circuit explained, "[e]xpert witnesses . . . are free agents. Parties and counsel have an obligation not to deceive the court about the witness and to correct statements they know to be false, but they are not responsible for the details of the witness's testimony." *Metlyn Realty Corp. v. Esmark, Inc.*, 763 F.2d 826, 833 (7th Cir. 1985). Thus, the Seventh Circuit held that, absent evidence that "the adverse party procured or knew of any false testimony," relief under Rule 60(b)(3) is not available. *Id.* at 832; *see also Richardson v. Nat'l R.R. Passenger Corp.*, 49 F.3d 760, 765, 311 U.S. App. D.C. 26 (D.C. Cir. 1995) (declining to "substitute a less restrictive limitation" under Rule 60(b)(3) for attribution to a party misconduct of another "for the one expressly adopted under the Rules"). The majority's conclusion also conflicts with long-settled evidence and professional responsibility rules. *See* Fed. R. Evid. 607, Advisory Committee Notes to 1972 Proposed Rules

(abandoning the “traditional rule against impeaching one’s own witness” because “[a] party does not hold out his witnesses as worthy of belief”); Model R. Prof. Resp. 3.3 and comments (a lawyer will only be responsible for false testimony if the lawyer knew or should have known the testimony was false).

While the Eleventh Circuit has not expressed itself clearly on the issue here, there is no reason to think that it would reach the opposite conclusion. In the Eleventh Circuit case granting Rule 60(b)(3) relief discussed by the majority, *Harre*, 750 F.2d at 1503, the court found “that the record support[ed] Appellants’ argument that a material expert witness testified falsely on the ultimate issue in the case, where the defense attorneys knew or should have known of the falsity of the testimony.” *Id.* at 1503 (emphasis added). Nothing in *Bonar v. Dean Witter Reynolds, Inc.*, 835 F.2d 1378 (11th Cir. 1988), is to the contrary. *Bonar*, a case involving vacation of an arbitrator’s punitive damages award, cites *Harre* for the proposition that “[t]here is no doubt that perjury constitutes fraud,” and that the perjury is material when it goes to a “central issue” in a case. *Id.* at 1383 n.7 & 1385. The Eleventh Circuit in *Bonar* did not discuss *Harre* in the context of party complicity under Rule 60(b)(3) because *Bonar* did not involve that issue (nor did it involve Rule 60(b)(3) at all).

The majority points to *Viskase Corporation v. American National Can Company*, 261 F.3d 1316 (Fed. Cir. 2001), as supporting its position. *See* Maj. Op. at 15. But *Viskase* arose in the Seventh Circuit, which explicitly requires evidence of complicity to attribute false testimony of an expert witness to a party under

Rule 60(b)(3). *Metlyn*, 763 F.2d at 833. The district court in *Viskase* specifically found that the plaintiff's counsel "surely knew there were additional documents [that had been withheld] and that there were additional tests conducted" relying on evidence such as "invoices directed to [plaintiff's] counsel and [the expert's] notes document[ing] counsel's knowledge." *Viskase Corp. v. Am. Nat. Can Co.*, 979 F. Supp. 697, 705 (N.D. Ill. 1997). There is no similar evidence or finding here.

The majority agrees that JJVC "may have been unaware of Dr. Bielawski's false testimony" but suggests that JJVC may have been complicit in withholding Dr. Bielawski's data from tests on third-party contact lenses. Maj. Op. at 15. According to the majority, "JJVC should have known that additional tests were conducted and additional documents were generated. Indeed, it provided samples of the third-party lenses to Dr. Bielawski, requested that he conduct initial testing on those lenses, and questioned Dr. Bielawski on the same subject matter during trial." *Id.*

While JJVC admitted that it did "suppl[y] [the third party lenses] to Dr. Bielawski," it did so "only for use in setting up his equipment." Appellee's Br. at 28. According to JJVC, it "did not ask Dr. Bielawski to generate data on those lenses, and did not know that one of his assistants had (apparently) done so." *Id.* In fact, JJVC asserts that "Dr. Bielawski repeatedly reassured JJVC's counsel that he had given them all of the data he generated and all of the documents he relied upon." *Id.* at 63. The district court did not resolve this factual dispute as to whether JJVC's counsel should have known that additional evidence existed, finding instead

that this “murky” assertion did not support a finding that Rembrandt was prevented from fully and fairly presenting its case. *Rembrandt*, 300 F.R.D. at 697 n.1.

The majority’s resolution of this factual dispute as to whether JJVC’s counsel should have known about the withheld documents is inconsistent with our role as a court of review and the deferential “abuse of discretion” standard of review. As we have found, when the lower tribunal has left a factual issue unresolved, “[w]e are unable to engage in such fact-finding in the first instance and must therefore remand for further proceedings.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 2016 WL 537609, at *14 (Fed. Cir. 2016). This is a matter for the trial court and, at best, a remand for further fact-finding would be appropriate as to whether JJVC’s counsel should have known about the documents.

I respectfully dissent.

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Appendix B

UNITED STATES DISTRICT COURT FOR THE
MIDDLE DISTRICT OF FLORIDA,
JACKSONVILLE DIVISION

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff,

vs.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant.

Case No. 3:11-cv-819-J-32-JRK

July 10, 2014, Decided
July 10, 2014, Filed

JUDGES: TIMOTHY J. CORRIGAN, United States
District Judge.

OPINION

ORDER

Following a more than two-week trial in this contentious and expensive patent case, the jury found for Defendant. During trial, one of Plaintiff's experts gave contradictory testimony, causing the Court to disallow it, a ruling which has now been affirmed on appeal. Post-trial it was found that one of Defendant's expert witnesses also likely gave false trial testimony. How should the Court decide Plaintiff's Rule 60 motion seeking a new trial?

Plaintiff, Rembrandt Vision Technologies, L.P. (“Rembrandt”), asks the Court to order a new trial under Federal Rules of Civil Procedure 60(b)(2) and 60(b)(3) because of the alleged perjury of one of the expert witnesses for Defendant, Johnson & Johnson Vision Care, Inc. (“JJVC”), Dr. Christopher Bielawski. (Doc. 345 at 5-6).¹ The Court has considered the voluminous filings, including Plaintiff’s Motion to Set Aside the Judgment (Doc. 345), Defendant’s Response (Doc. 346), Plaintiff’s Reply (Doc. 357), the various supplementary filings (Doc. 347, 348, 367, 377), Defendant’s Notice of New Authority (Doc. 370) and Plaintiff’s Response (Doc. 372), as well as the parties’ statements regarding the effect of the Federal Circuit’s mandate (Doc. 379, 380) and updates regarding Dr. Bielawski’s status (Doc. 389, 390, 391, 392). The Court also heard extensive oral argument on August 2, 2013

¹ Rembrandt alternatively argues that it was not provided with the data and graphs from JJVC’s testing on infringing Bausch & Lomb and CIBA lenses, and from undisclosed tests on the accused contact lenses, and therefore that it is entitled to relief under Rules 60(b)(3) and 60(b)(2). (Doc. 345 at 24). To receive relief under Rule 60(b)(3), Rembrandt must demonstrate that it was prevented from fully and fairly presenting its case. Rembrandt’s assertion, which is murky at best, does not present such a scenario. *See Hirsch v. Nova Se. Univ., Inc.*, 289 F. App’x 364, 368 (11th Cir. 2008). Nor can Rembrandt demonstrate, as it must to succeed under Rule 60(b)(2), that a new trial with this evidence would probably produce a different result.

(Doc. 373), the record of which is incorporated by reference.²

I. The Effect of the Federal Circuit’s Decision on the Rule 60 Motion

After the jury ruled in JJVC’s favor, Rembrandt filed a post-trial motion to reopen the case and compel discovery, questioning the veracity of the trial testimony of Dr. Bielawski. (Doc. 305). JJVC opposed the request (Doc. 308), and the Court denied the motion (Doc. 318). Thereafter, Rembrandt appealed the final judgment, which the Court entered in JJVC’s favor in accordance with the jury’s verdict and the Court’s alternative ruling granting JJVC’s Rule 50 motion based on the defective trial testimony of one of Rembrandt’s experts, Dr. Thomas Beebe. (Doc. 317). Although one of the grounds on appeal was this Court’s denial of Rembrandt’s motion to reopen discovery, the Federal Circuit did not reach that issue. *Rembrandt Vision Technologies, L.P. v. Johnson & Johnson Vision Care, Inc.*, 725 F.3d 1377, 1380 n.1 (Fed. Cir. 2013). Rather, in affirming, the Federal Circuit only addressed the Court’s Rule 50 Order granting judgment as a matter of law based on the defects in Dr. Beebe’s testimony. *Id.*

The Court delayed ruling on this Rule 60 motion while the case was in the Federal Circuit. After the Federal Circuit mandate issued, the Court asked the parties what effect, if any, that mandate had on this Court’s consideration of the Rule 60 motion. (Doc. 378).

² The reader is encouraged to consider the transcript of the three-hour August 2, 2013 hearing, in which counsel and the Court engaged in extensive discussions on this motion. (Doc. 373).

Rembrandt, in essence, says the Federal Circuit decision has no effect and the Court should proceed on the merits. (Doc. 379). For a variety of reasons, but primarily because JJVC views the Federal Circuit affirmance as being on an independent ground that renders the Rule 60 motion moot, JJVC says the Federal Circuit's mandate, in and of itself, requires denial of the Rule 60 motion. (Doc. 380).

While JJVC's arguments have force, the Court is not convinced the Federal Circuit's decision forecloses merits consideration of Rembrandt's Rule 60 motion. If JJVC's arguments on this score prove to be correct, the Court presumes that on appeal the Federal Circuit will so instruct and decline to reach the merits of the Rule 60 motion. In the meantime, this Court will address the merits.³

II. Dr. Bielawski's Testimony

For the purposes of this motion, the Court assumes without deciding that Dr. Bielawski testified falsely when he said that he personally performed XPS and TOF-SIMS tests, and about his qualifications as an expert in performing those tests. In fact, even JJVC now agrees that there is clear and convincing evidence that Dr. Bielawski gave false testimony. (Doc. 380 at 18).⁴

³ With 20-20 hindsight, this Court's denial of Rembrandt's post-verdict, but pre-appeal request for discovery to investigate this issue now seems ill-advised.

⁴ Because Dr. Bielawski has not been given an opportunity to tell his side of the story and because there are potential personal ramifications for him if he is found to have lied under oath, the Court does not make a judicial finding that he testified falsely. But, since

This was a serious and detrimental occurrence. It insulted the jury, violated the integrity of the judicial process, and interfered with the search for the truth that is the hallmark of our trial-by-jury system. Moreover, this false testimony was given in a highly contested patent case in which an expert for Rembrandt, Dr. Beebe, radically changed his expert testimony during the middle of his examination. As a result, the Court struck his testimony and entered an alternative Rule 50 judgment against Rembrandt because it was unable to prove a required element of its case without Dr. Beebe's testimony. (Doc. 317). Now, having learned post-trial that JJVC's expert likely lied on the stand, arguably committing an act at least as egregious as Dr. Beebe's, it is a fair question to ask whether Rembrandt should be entitled to a new trial.

However, that Dr. Bielawski testified falsely does not end the inquiry. In deciding what to do, the Court must be guided by the Federal Rules, which make it difficult to upset a jury's verdict even if misconduct is shown. Thus, the Court turns to Rule 60 and looks at each of the sections cited by Rembrandt to determine whether a new trial is required. (Doc. 345 at 10-11).

A. Rule 60(b)(2)

“For the court to grant relief based upon newly discovered evidence under Rule 60(b)(2), a movant must meet a five-part test: (1) the evidence must be newly discovered since the trial; (2) due diligence on the part of

both parties now agree that he did testify falsely, the Court will assume *arguendo* that he did for purposes of deciding the Rule 60 motion.

the movant to discover the new evidence must be shown; (3) the evidence must not be merely cumulative or impeaching; (4) the evidence must be material; and (5) the evidence must be such that a new trial would probably produce a new result.” *Waddell v. Hendry Cnty. Sheriff’s Office*, 329 F.3d 1300, 1309 (11th Cir. 2003); *see also Scutieri v. Paige*, 808 F.2d 785, 793 (11th Cir. 1987).⁵ Since Rule 60(b)(2) relief is an extraordinary remedy, these requirements must be strictly met. *Id.* Without the need for further discussion, Rembrandt meets grounds 1 and 2.

Rembrandt asks this Court to set aside the judgment based on the newly discovered evidence that Dr. Bielawski lied about his qualifications and about performing tests. It is a very serious thing for a witness to lie from the stand. It can, in some cases bring criminal penalties for perjury. There is heightened concern here because Dr. Bielawski was a retained expert, solicited and sponsored by JJVC in a patent case in which expert testimony was critical.

Further, the matter that he lied about was material to his testimony. As Dr. Bielawski was testifying about the results of the tests and how they were important to his opinions, whether he personally conducted them was an obviously relevant and material factor.

⁵ In reviewing decisions on Rule 60 motions, the Federal Circuit applies the law of the circuit in which the district court sits so long as the ruling does not turn on substantive issues unique to patent law. *Lazare Kaplan Int’l, Inc. v. Photocopy Technologies, Inc.*, 714 F.3d 1289, 1292-93 (Fed. Cir. 2013).

Regardless of the seriousness of Dr. Bielawski's offense, however, Rembrandt still must demonstrate that a new trial would probably produce a different result. Upon sober reflection, I conclude it cannot do so. First, Rembrandt's lost opportunity to impeach Dr. Bielawski with evidence of his false testimony does not lead to Rule 60(b)(2) relief. *See Waddell*, 329 F.3d at 1309 (noting that newly discovered evidence must be more than merely cumulative or impeaching to warrant 60(b)(2) relief). Second, while there is no way for the Court to recount the whole of the evidence adduced at trial, there was strong evidence to support JJVC's non-infringement case, independent of Dr. Bielawski's testimony.⁶ Having carefully followed the evidence at trial, the Court was unsurprised by the jury's verdict of non-infringement.

B. Rule 60(b)(3)

Rule 60(b)(3) provides that the court may relieve a party from a final judgment because of fraud, misrepresentation, or misconduct "by an opposing party". Fed. R. Civ. P. 60(b)(3). The movant must prove by clear and convincing evidence both that the adverse

⁶ For example, on the "surface layer" issue as to which Dr. Bielawski testified, the project lead for Acuvue Advance testified that Acuvue Advance and Oasys did not have a surface layer. (Doc. 299 at 39-40). The staff scientist who helped create the lens testified to its creation without a surface layer. (Doc. 298 at 245-46). Additionally, the vice president of contact lens research and development for Vistakon in Jacksonville testified to the development of the non-coated (no surface layer) contact lens. (Doc. 297 at 246). These are but a few pieces of JJVC's case, which also contained expert testimony from sources other than Dr. Bielawski.

party obtained the verdict through fraud, misrepresentation, or misconduct and that the fraud prevented the movant from fully and fairly presenting its case. *Cox Nuclear Pharmacy, Inc. v. CTI, Inc.*, 478 F.3d 1303, 1314 (11th Cir. 2007).

Rembrandt chiefly relies on a case in which 60(b)(3) relief was granted on the basis of an expert witness' perjury, *Harre v. A.H. Robins Co., Inc.*, 750 F.2d 1501 (11th Cir. 1985). In *Harre*, the primary issue at trial related to whether an IUD allowed wicking, which is a process leading to uterine infections. *Harre*, 750 F.2d at 1502. Defendant presented only one expert witness who claimed to have conducted or directed wicking studies, Dr. Keith. *Id.* at 1505. After trial, it became apparent that Dr. Keith had never done any wicking experiments. *Id.* at 1503. As Dr. Keith had been an expert for defendant for years, and defense counsel must have become aware of the perjurious testimony, the court found that the attorneys were complicit in the misconduct. *Id.* at 1505.

We find that the record supports Appellants' argument that a material expert witness testified falsely on the ultimate issue in the case, where the defense attorneys knew or should have known of the falsity of the testimony. . . . This court is deeply disturbed by the fact that a material expert witness, with complicity of counsel, would falsely testify on the ultimate issue of causation. Therefore, we hold that the district court abused its discretion in denying Appellants' Rule 60(b)(3) motion. Accordingly, we REVERSE and REMAND for a new trial.

Id. at 1503, 1505.

Though *Harre* bears similarities to this case, it is ultimately distinguishable. First, Dr. Bielawski's testimony was not nearly as central or necessary to this case as that of Dr. Keith in *Harre*. Second, this case does not involve the complicity of "the opposing party" (JJVC) or its counsel. While the *Harre* court did not expressly limit its holding to circumstances in which counsel is complicit with witness misconduct, it was obviously important to the court's decision. Indeed, at least one court has distinguished *Harre* on the grounds that it involved a scenario where counsel knew or should have known about the expert's perjury. See *Richardson v. Nat'l R.R. Passenger Corp.*, 49 F.3d 760, 765 n.3, 311 U.S. App. D.C. 26 (D.C. Cir. 1995). In *Richardson*, where there was no claim that counsel knew, the court affirmed denial of Rule 60(b)(3) relief even though an expert witness perjured himself because that expert's testimony was not equivalent to the party's own testimony. *Id.*

A number of other courts have likewise interpreted the plain language of Rule 60(b)(3) to require the opposing party or its counsel to have engaged in the fraud, misrepresentation, or misconduct. See, e.g., *Metlyn Realty Corp. v. Esmark, Inc.*, 763 F.2d 826, 832 (7th Cir. 1985) (affirming denial of Rule 60(b)(3) relief because neither the party nor its counsel knew of the falsity of their expert witness' statements); *Bethel v. McAllister Bros., Inc.*, CIV.A. 91-2032, 1994 U.S. Dist. LEXIS 9177, 1994 WL 328350, at *3 (E.D. Pa. July 11, 1994) (noting that, to obtain Rule 60(b)(3) relief, "the moving party must show that [the] fraud is attributable

to the party or, at least, to counsel”); *Harris v. Mapp*, 719 F. Supp. 1317, 1324 (E.D. Va. 1989) (holding that a 60(b)(3) “movant must [] prove that the misconduct complained of is traceable to an adverse party”); *see also Jordan v. Paccar, Inc.*, No. 95-3478, 1996 U.S. App. LEXIS 25358, 1996 WL 528950, at *7 (6th Cir. Sept. 17, 1996) (stating that the plain language of Rule 60(b)(3) requires “some odious behavior on the part of the non-moving party”). The Court has canvassed Eleventh Circuit authority on Rule 60 and found no decisions which indicate that the Eleventh Circuit would rule differently on this point.

Rembrandt contends that 60(b)(3) relief is available even if the misconduct is not attributable to the opposing party. (Doc. 345 at 21). The only case it cites which supports this assertion is *In re Vioxx Products*, 489 F. Supp. 2d 587 (E.D. La. 2007), in which the court granted Rule 60(b)(3) relief where, unbeknownst to counsel, a central expert witness lied about whether he was board-certified. *Vioxx*, 489 F. Supp. 2d at 594-95. *Vioxx*, however, contradicts the majority of the case law on the topic, as well as the plain language of the Rule, and this Court declines to follow it, at least on these facts.⁷

Rembrandt therefore must demonstrate that JJVC or its attorneys knew or should have known that Dr. Bielawski’s testimony was false. Rembrandt focuses on JJVC’s attorneys and argues that they at least should

⁷ As did the Court in *Richardson*, this Court leaves open the possibility that non-party witness misconduct alone could give rise to Rule 60(b)(3) relief in an appropriate case. *Richardson*, 49 F.3d at 765.

have known that Dr. Bielawski was lying. (Doc. 345 at 21-22). According to Rembrandt, JJVC should have discovered Dr. Bielawski's dishonesty because another researcher was listed as the machine operator for one of the TOF-SIMS tests. (Doc. 345 at 22). JJVC also allegedly placed great weight on whether experts personally performed their experiments. (Doc. 345 at 21). This evidence is not sufficient to establish that JJVC should have known of Dr. Bielawski's misconduct. Indeed, Rembrandt also knew that another researcher was listed as the machine operator for one of the tests, thought that fact was important enough to mention at closing, (Doc. 300 at 197), and also did not discover Dr. Bielawski's misstatements until after trial.

Rembrandt also argues that JJVC should have known of Dr. Bielawski's dishonesty because he never submitted an invoice to JJVC's lawyers for his services. (Doc. 345 at 21). With the benefit of this type of hindsight, it is tempting to fault JJVC's lawyers for not discovering Dr. Bielawski's misconduct. However, he was apparently successful in convincing JJVC's lawyers that he knew the subject matter and that he was going to give truthful testimony.⁸ Rembrandt's evidence is unconvincing in demonstrating that JJVC's lawyers knew or should have known about Dr. Bielawski's false testimony. As neither JJVC nor its counsel has been shown to be complicit in any fraud or misconduct, Rembrandt is not entitled to relief under Rule 60(b)(3).

⁸ Unlike in *Harre*, Rembrandt has presented no evidence that either JJVC or JJVC's attorneys had a preexisting relationship with Dr. Bielawski.

Were the Court to accept Rembrandt's interpretation that 60(b)(3) relief is available solely because of the expert's misconduct, even in the absence of complicity by JJVC or its counsel, Rembrandt would still not be entitled to a new trial because it was not prevented from fully and fairly presenting its case. What Rembrandt mainly lost here was an opportunity to discredit or eliminate an expert witness who, unlike in *Harre*, was not required for JJVC to win the case. When the trial is looked at in its totality, even accounting for Dr. Bielawski's misconduct, Rembrandt was not prevented from making its case. At bottom, Rule 60(b)(3) seeks to redress "judgments which were unfairly obtained" *Rozier v. Ford Motor Co.*, 573 F.2d 1332, 1339 (5th Cir. 1978). This was not such a case.⁹

III. CONCLUSION

The Seventh Circuit has put it aptly:

A motion under Rule 60(b) often puts to a court a question without a right answer. The district judge must weigh incommensurables—the value of finality, the probability that an error affected the outcome of the proceeding, the probability that a second go-round would produce a 'better' outcome, the costs of that second proceeding to the parties (and ultimately to society as the finality of judgments is undercut).

Metlyn, 763 F.2d at 831.

⁹ This is true even without considering that JJVC was entitled to judgment as a matter of law because Rembrandt failed to present evidence on an essential element of its case. *See supra* Part I.

This is a close and difficult call. The Court recognizes that this decision could be interpreted as not taking seriously enough the integrity of this Court's proceedings and the importance of truthful witnesses. The Court could also be accused of treating misconduct by Rembrandt's expert witness more seriously than that of JJVC's.¹⁰ While this criticism would be understandable, there are other important attributes to be considered and balanced—finality, respect for the jury's verdict, and whether the ultimate result is just. I sat through the trial, heard all of the evidence, and have now conducted a lengthy hearing on the Rule 60 motion. I believe, notwithstanding the serious misconduct by Dr. Bielawski, this was a fair, though imperfect, trial. The jury's verdict is supported by the untainted evidence and should be allowed to stand.

Though the judgment should not be set aside, it remains that an expert witness for JJVC likely lied on the stand. Even if unwittingly, JJVC sponsored this false testimony and resisted initially when Rembrandt tried to expose Dr. Bielawski's untruthfulness. While denying Rule 60 relief, the Court will separately consider whether other actions vis-a-vis both Dr. Bielawski and JJVC should be undertaken.

¹⁰ If the misconduct of Dr. Bielawski had come to light during trial, the Court surely would have taken remedial action.

Accordingly, it is hereby

ORDERED:

1. It is the Court's intention to deny Plaintiff's Motion to Set Aside the Judgment Pursuant to Federal Rule of Civil Procedure 60(b)(2) and 60(b)(3) once the matters addressed in Paragraph 3 are finalized.

2. This Court will consider other possible courses of action, including whether to refer Dr. Bielawski's conduct to the United States Attorney's Office for possible criminal investigation for perjury or related crimes.¹¹

3. JJVC has until **August 8, 2014** to show cause why it should not have to pay reasonable attorneys' fees and costs associated with Rembrandt's post-trial investigation of Dr. Bielawski and the motion practice occasioned thereby. Rembrandt will have until **August 25, 2014** to respond to JJVC's submission.

DONE AND ORDERED in Jacksonville, Florida
this 10th day of July, 2014.

¹¹ Papers filed in connection with this motion suggest that Dr. Bielawski has already suffered significant professional consequences because of his actions in this case. (Doc. 389 at 1).

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Appendix C

United States Court of Appeals
For the Federal Circuit

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff-Appellant,

v.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant-Appellee.

2012-1510

August 7, 2013, Decided

JUDGES: Before DYK, CLEVINGER, and MOORE,
Circuit Judges.

Rembrandt Vision Technologies, Inc. (Rembrandt) appeals from the district court's judgment that Johnson & Johnson Vision Care, Inc. (JJVC) does not infringe Rembrandt's U.S. Patent No. 5,712,327 ("327 Patent"). Rembrandt challenges the court's grant of judgment as a matter of law and its denial of Rembrandt's motion for a new trial. Because the district court correctly granted judgment as a matter of law that JJVC does not infringe, we *affirm*.

BACKGROUND

The technology at issue in this case relates to contact lenses. Two important characteristics of a contact lens are its permeability to oxygen and the wettability of its surface. '327 patent, col. 1 ll. 18-21. By the 1980s, those skilled in the art had developed both "hard" and "soft" contact lenses that were permeable to oxygen but lacked a highly wettable surface. *Id.* col. 1 l. 25-col. 2 l. 7.

The contact lens claimed in the '327 Patent has both a highly wettable surface and is permeable to oxygen. The patent discloses a soft gas permeable lens that contains an acrylic layer on the surface of the lens body. '327 Patent, col. 3 l. 65-col. 4 l. 45. The addition of the layer increases the wettability and comfort of the contact lens. *Id.* col. 4 ll. 38-45. Claim 1 of the '327 Patent is representative and is directed to a "soft gas permeable contact lens" with certain properties:

A hydrophilic *soft gas permeable contact lens* comprised of a polymerization product . . . said lens comprising a hydrophilic lens body and a tear-wettable surface layer integral therewith, said lens body being comprised of said polymerization product and said tear-wettable surface layer being comprised of polymeric material containing hydroxy acrylic monomer units

'327 Patent, claim 1 (emphasis added). Rembrandt sued JJVC, alleging that its Advance and Oasis® contact lenses infringed the '327 Patent claims. JJVC prevailed at trial, and the district court, in the alternative, granted judgment as a matter of law that Rembrandt failed to

prove that the accused lenses were “soft gas permeable” contact lenses. *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.*, 282 F.R.D. 655, 668 (M.D. Fla. 2012) (*JMOL Order*).

The central issue in this appeal is whether Rembrandt proffered sufficient evidence that the accused contact lenses were “soft.” The court adopted the parties’ agreed construction of “soft gas permeable contact lens” as “a contact lens having a Hardness (Shore D) less than five.” *JMOL Order*, 282 F.R.D. at 657. Due to that specific construction, the court excluded Rembrandt’s evidence that the accused contact lenses were generally known as “soft” lenses because that evidence was not probative on whether the accused lenses had a Shore D Hardness of less than five. *Id.* at 664; J.A. 41-42.

At trial, Rembrandt relied on expert testimony from Dr. Thomas Beebe, Jr. to prove that the accused lenses had a Shore D Hardness of less than five. But Dr. Beebe’s trial testimony did not match the opinions disclosed in his expert report, and the district court ultimately struck his testimony. Dr. Beebe testified in his expert report that he performed the Shore D Hardness test by stacking the accused lenses around a stainless steel ball and then probing them. *JMOL Order*, 282 F.R.D. at 657-58. He testified that he stacked 24 individual hydrated contact lenses to achieve a thick enough sample to allow full penetration by a probe that is 2.54 mm in length. *Id.*

JJVC moved to exclude that expert testimony on the basis that Dr. Beebe’s Shore D Harding testing did not comply with industry-standard testing protocols. *Id.* at

658. JJVC contended that the applicable standards required probing a thick button of dry lens material on a flat surface and do not allow for testing a stack of hydrated contact lenses around a steel ball. J.A. 1941-42. JJVC also moved for summary judgment on the grounds that no reasonable juror could conclude that the accused lenses were “soft” based on Dr. Beebe's testing. *JMOL Order*, 282 F.R.D. at 658. The court denied JJVC's motion for summary judgment and deferred ruling on JJVC's evidentiary motion until after Dr. Beebe testified at trial. *Id.*

Dr. Beebe testified on direct examination that he had performed the steel ball Shore D Hardness test described in his expert report. *JMOL Order*, 282 F.R.D. at 658. During cross examination, JJVC's counsel asked Dr. Beebe whether he had tested a sufficiently thick sample of stacked lenses to comply with the industry-standard Shore D Hardness testing protocols, which required a stack with a thickness of 6 mm or more. *Id.* at 658-59. Dr. Beebe responded that he had tested a stack of lenses that was 6 mm thick, not 2.54 mm as he had disclosed in his expert report. *Id.* at 658-59. He testified that the error in his report “might be a typo.” *Id.* at 659.

JJVC pressed Dr. Beebe on his testing methodology. Despite the “typo,” Dr. Beebe confirmed that he had tested a stack of 24 contact lenses. *JMOL Order*, 282 F.R.D. at 658-59. JJVC then asked Dr. Beebe how a stack of 24 contact lenses, each with a thickness of .07 mm, could add up to 6 mm. *Id.* at 659. Dr. Beebe agreed that one would expect such a stack to have a thickness around 1.68 mm. *Id.*

JJVC then asked Dr. Beebe to confirm that he did not test flat samples of the lens material. *JMOL Order*, 282 F.R.D. at 659. At that point, Dr. Beebe “suddenly changed course in the middle of cross-examination and testified that he did not follow the procedures listed in his expert report.” *Id.* He testified that he performed the Shore D Hardness testing by cutting the lenses into quarters, stacking the lens quarters on a flat surface, and then probing them. *Id.* at 659-60. This procedure explained how he was able to create a stack of lenses that was 6 mm thick. *Id.* at 660. None of this procedure was in his expert report. *Id.* Dr. Beebe claimed that his expert report’s disclosure of the wrong Shore D Hardness test procedure was a “typo.” *Id.*

JJVC renewed its motion to exclude Dr. Beebe’s testimony and moved for judgment as a matter of law, and the court granted the motions. *JMOL Order*, 282 F.R.D. at 657. The court struck Dr. Beebe’s testimony under Federal Rules of Civil Procedure 26 and 37 because his expert report was “woefully deficient” to support his trial testimony. *Id.* at 663-65. The court also excluded Dr. Beebe’s testimony under Federal Rule of Evidence 702 because nothing in the record established the reliability of the testing methodology that he testified to at trial. *Id.* at 665-67. Because Dr. Beebe’s struck testimony was the only evidence that Rembrandt advanced at trial to prove that the accused lenses were “soft,” the court granted judgment as a matter of law that JJVC did not infringe. *Id.* at 668.

Rembrandt appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).¹

DISCUSSION

I

We apply regional circuit law to review the district court's exclusion of evidence and its grant of judgment as a matter of law. *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340, 1343 (Fed. Cir. 2012); *Micro Chem., Inc. v. Lextron, Inc.*, 317 F.3d 1387, 1390-91 (Fed. Cir. 2003). The Eleventh Circuit reviews *de novo* the grant of a motion for judgment as a matter of law. *Christopher v. Florida*, 449 F.3d 1360, 1364 (11th Cir. 2006). Judgment as a matter of law is appropriate when, after a party has been fully heard on an issue, “a reasonable jury would not have a legally sufficient evidentiary basis to find for the party.” FED. R. CIV. P. 50(a). A district court’s evidentiary rulings are reviewed for an abuse of discretion. *Goodman-Gable-Gould Co. v. Tiara Condominium Ass’n, Inc.*, 595 F.3d 1203, 1210 (11th Cir. 2010).

II

Rembrandt argues that the court erred in granting judgment as a matter of law. It contends that the district

¹ Rembrandt also challenges the denial of its motion for a new trial based on the district court’s construction of the “surface layer” limitation, its exclusion of evidence related to that limitation, and its denial of Rembrandt’s attempt to reopen expert discovery regarding the surface layer issue. Because we affirm the district court’s grant of judgment as a matter of law, we do not address those other issues.

court improperly excluded Dr. Beebe's trial testimony. Rembrandt asserts that the mistakes in Dr. Beebe's report were unintended and did not harm JJVC. It further contends that Dr. Beebe's actual testing methodology was reliable because he followed industry standard testing protocols. Rembrandt argues that, because the court erroneously excluded Dr. Beebe's testimony, we should reverse the district court's grant of judgment as a matter of law.

Rembrandt also argues that its circumstantial evidence that the accused lenses are generally known as "soft" precludes entry of judgment as a matter of law. It contends that the district court erred by categorically excluding that circumstantial evidence. It further argues that the circumstantial evidence that was admitted in evidence shows that the accused lenses meet the "soft" limitation.

JJVC counters that the court properly granted judgment as a matter of law. It argues that, regardless of Dr. Beebe's intent, there was no justification for Dr. Beebe's late disclosure of his testing methods. JJVC argues that Dr. Beebe's change in testimony significantly impaired its ability to prepare a noninfringement defense and prepare the case for trial. It asserts that Rembrandt failed to show that Dr. Beebe's undocumented testing methodology was sufficiently reliable. Lastly, JJVC argues that the court did not err in declining to consider Rembrandt's circumstantial evidence because the "soft" limitation requires the lenses to meet a specific hardness measure. JJVC thus contends that, because Rembrandt did not present any admissible evidence that the accused lenses

were “soft,” the court properly granted judgment as a matter of law.

We agree with JJVC that the court correctly granted judgment as a matter of law. The district court did not abuse its discretion when it excluded Dr. Beebe's testimony under the Federal Rules of Civil Procedure. Rule 26 requires an expert witness to disclose an expert report that contains “a complete statement of all opinions the witness will express and the basis and reasons for them.” FED. R. CIV. P. 26(a)(2)(B)(i). The purpose of the expert disclosure rule is to “provide opposing parties reasonable opportunity to prepare for effective cross examination and perhaps arrange for expert testimony from other witnesses.” *Reese v. Herbert*, 527 F.3d 1253, 1265 (11th Cir. 2008) (quotations omitted).

Failure to comply with Rule 26(a) has significant consequences, including Rule 37's “self-executing sanction.” FED. R. CIV. P. 37(c), advisory committee notes. An expert witness may not testify to subject matter beyond the scope of the witness's expert report unless the failure to include that information in the report was “substantially justified or harmless.” FED. R. CIV. P. 37(c)(1). The burden is on the party facing sanctions to prove that its failure to comply with Rule 26(a) was “substantially justified or harmless.” *Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1107 (9th Cir. 2001).

Here, it is undisputed that Dr. Beebe failed to produce a report containing “a complete statement of all opinions the witness will express and the basis and reasons for them.” FED. R. CIV. P. 26(a)(2)(B)(i). The

issue is thus whether, under Rule 37(c)(1), it was “substantially justified or harmless” that Dr. Beebe waited until trial to disclose the testing methodology that he claims he actually employed.

The district court did not err in concluding that the late disclosure was not substantially justified. The court rightly found that “[t]here is simply no excuse for Dr. Beebe waiting until cross-examination to disclose his testing procedures.” *JMOL Order*, 282 F.R.D. at 664. Dr. Beebe submitted his expert report nearly six months prior to trial. *Id.* at 663-64; J.A. 96. Leading up to trial, the contents of his expert report were the subject of his deposition and were at issue in the pre-trial briefing, including dispositive motions. *JMOL Order*, 282 F.R.D. at 663-64. JJVC moved to exclude Dr. Beebe’s testimony on the basis that his Shore D testing did not comply with industry standards. *Id.* at 658. JJVC also moved for summary judgment on the ground that the testing was not sufficient to raise a genuine issue of material fact as to the Shore D Hardness values of the accused lenses. *Id.* Nevertheless, even though the adequacy of his Shore D Hardness testing methodology was in dispute prior to trial, Dr. Beebe never attempted to supplement his expert report. As the district court observed, “Dr. Beebe thus apparently either did not review his expert report or forgot how he had actually performed the test.” *Id.* at 664. Nothing in the record indicates that Dr. Beebe’s failure to disclose his testing methodology was substantially justified.

We also reject Rembrandt’s argument that Dr. Beebe’s tardy disclosure was harmless. JJVC prepared its noninfringement defense based on the methodology

disclosed in Dr. Beebe's expert report, and opted to challenge that methodology rather than introduce competing expert testimony. *JMOL Order*, 282 F.R.D. at 664. Nothing during the course of the proceedings alerted JJVC to the possibility that Dr. Beebe would change his testimony. To the contrary, Rembrandt stood behind Dr. Beebe's expert report at summary judgment and Dr. Beebe testified to the veracity of his report on direct examination. *Id.* at 657-58. Dr. Beebe even initially defended his testing methodology upon cross-examination. *Id.* at 658-59. Dr. Beebe only recanted his expert report when, after being "repeatedly challenged on cross-examination," he was "[u]nable to explain how his written procedures complied with the standards" that govern hardness testing. *Id.* at 659, 668. While Dr. Beebe characterized the errors in his report as "typo[s]," it is undisputed that the shift in his testimony was both substantive and substantial. Such a late change in course significantly hampered JJVC's ability to adequately cross-examine Dr. Beebe and denied it the opportunity to develop or introduce competing evidence. The court did not err in finding that Dr. Beebe's failure to disclose his testing methodology harmed JJVC.

We conclude that the district court did not abuse its discretion in excluding Dr. Beebe's trial testimony under Rule 37. We therefore decline to address whether the court erred in excluding Dr. Beebe's testimony under Federal Rule of Evidence 702.

We also agree with JJVC that Rembrandt's circumstantial evidence does not preclude the grant of judgment as a matter of law. Prior to trial, the only circumstantial evidence that Rembrandt sought to

admit was “JJVC’s characterization of its lenses as ‘soft.’” Rembrandt Visions Technologies, L.P.’s Resp. in Opp’n to Johnson & Johnson Vision Care, Inc.’s Mot. in Limine, at 7, *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.*, No. 3:11-cv-00819 (M.D. Fla. Feb. 7, 2012), ECF No. 201. The court was within its discretion to exclude that evidence. Rembrandt agreed to a construction of “soft gas permeable contact lens” that required the lens to have a Shore D Hardness less than five. Generic statements that the accused lenses are “soft” had the potential to confuse the jury and did not bear on whether the accused lenses had a Shore D Hardness of less than five. *See* FED. R. EVID. 403.

On appeal, Rembrandt argues that other circumstantial evidence shows that the accused lenses had a Shore D Hardness less than five. However, Rembrandt never argued that point to the district court. In opposing JJVC’s motion for judgment as a matter of law, Rembrandt only pointed to Dr. Beebe’s trial testimony. *See* Rembrandt Visions Technologies, L.P.’s Mem. Of Law in Opp’n to Johnson & Johnson Vision Care, Inc.’s Renewed Daubert Mot., *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.*, No. 3:11-cv-00819 (M.D. Fla. May 3, 2012), ECF No. 266. Moreover, Rembrandt conceded at the post-trial hearing that Dr. Beebe’s testimony was the only evidence presented at trial that showed that the accused lenses met the “soft” limitation. *JMOL Order*, 282 F.R.D. at 668 n.15; J.A. 8799-90. This other circumstantial evidence was also not raised in opposition to JJVC’s motion in limine. We decline to upend the district court’s decision on a basis that was not raised below. Because

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Rembrandt failed to offer any admissible evidence that the accused lenses met the “soft gas permeable contact lens” limitation, we affirm the district court’s judgment that JJVC does not infringe the asserted claims of the ‘327 patent.

CONCLUSION

We have considered the parties’ remaining arguments and conclude that they are without merit. For the foregoing reasons, the judgment of the district court is

AFFIRMED

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Appendix D

UNITED STATES DISTRICT COURT FOR THE
MIDDLE DISTRICT OF FLORIDA,
JACKSONVILLE DIVISION

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff,

vs.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant.

Case No. 3:11-cv-819-J-32JRK

June 4, 2012, Decided
June 4, 2012, Filed

JUDGES: TIMOTHY J. CORRIGAN, United States
District Judge.

OPINION

ORDER

During the trial of this patent case, plaintiff's expert, Dr. Thomas Beebe, testified for the first time on cross-examination that he had followed an undocumented protocol for his Shore D testing that is entirely inconsistent with the procedures disclosed in his expert report. This caused defendant Johnson & Johnson Vision Care, Inc. ("JJVC") to make an *ore tenus* motion to exclude Dr. Beebe's testimony regarding his Shore D

testing and for judgment as a matter of law under Rule 50(a). The parties submitted briefing on this issue (Docs. 265, 266, 274), and oral argument was held on May 4, 2012, May 11, 2012, and May 14, 2012, the transcripts of which are incorporated by reference (Tr. Trans. Vol. VI at 39-93; Tr. Trans. Vol. X at 5-108; Tr. Trans. Vol. XI at 16-56). On May 14, 2012, the Court ruled on the record that it would grant JJVC's motion to strike Dr. Beebe's Shore D testimony and for judgment as a matter of law under Rule 50(a). (Tr. Trans. Vol. XI at 51.) This Order constitutes the Court's reasoning for that ruling, as well as its ruling on the issue of willful infringement.¹

I. BACKGROUND

Rembrandt alleges that JJVC's Acuvue Advance and Acuvue Oasys contact lenses infringe United States Patent Number 5,712,327 (the "327 patent"). The '327 Patent claims a "soft gas permeable contact lens" containing certain properties. At the joint request of the parties, the Court construed the term "soft gas permeable contact lens" to mean "a contact lens having a Hardness (Shore D) of less than five." (Doc. 69 at 2.)

Rembrandt retained Dr. Thomas Beebe to determine the Shore D hardness of the accused products. In his expert report, Dr. Beebe stated that he used the following standard operating procedures:

¹ At the conclusion of the evidence, the Court granted JJVC's *ore tenus* Rule 50(a) motion for judgment as a matter of law with respect to Rembrandt's claim of willful infringement. (Tr. Trans. Vol. VI at 92.)

1. A Shore-D durometer . . . was used for all hardness testing. . . .

2. The sample must be thick enough to allow full penetration of the probe through the material to be tested. The probe is 0.100 inch (2.54 mm) in length.

3. When the sample is thinner than this (as is the case with contact lenses), individual pieces of the sample must be stacked on top of each other in order to provide the required sample thickness.

4. The lenses were removed from their packaging and carefully stacked on a stainless steel ball having a curvature that matched the curvature of the lenses. . . . Stack 24 individual lens samples on each other, keeping the material hydrated in its original packaging fluid.

5. Locate the durometer probe at the location on the sample to be tested and slowly press the probe into the sample stack. Stop advancing when the durometer bottoms out.

6. The durometer was pressed into the test stack of lenses in sets of 10 replicates, each at a different location. . . .

7. Lenses were discarded after testing. All lens boxes with lot information were retained in a lab notebook.

(Doc. 265, ex. 2 at 46-47.)

Pretrial, JJVC moved to exclude Dr. Beebe's testimony under *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 592-93, 113 S. Ct. 2786, 125 L. Ed. 2d 469

(1993), and for summary judgment on the grounds that no reasonable juror could conclude that the accused products are “soft” based on Dr. Beebe’s testing. (Docs. 148, 152 at 27-34.) JJVC primarily argued that Dr. Beebe should have tested a dehydrated button of material rather than hydrated contact lenses. JJVC also argued that Dr. Beebe’s testing procedures did not conform to the governing scientific standards. The Court denied the motion for summary judgment; at the joint request of the parties, the Court deferred ruling on the Daubert motion until after Dr. Beebe testified at trial. (Docs. 237, 255.)

At trial, Dr. Beebe testified on direct examination that he performed his Shore D testing consistent with the procedures listed in his expert report. Specifically, Dr. Beebe stated that, when he conducted his testing, “other than the fact that [the lenses] were stacked up, they were as they come out of the case.” (Tr. Trans. Vol. III at 56.) He also testified that his testing was consistent with the testing he performed during the reexamination of the ‘327 Patent and in prior litigation, (*Id.*) and such testing was similar to that disclosed in his expert report.

On cross-examination, Dr. Beebe had difficulty articulating how he designed his Shore D test. He conceded that he had only performed Shore D testing in the context of litigation for Rembrandt and that he was not an expert on Shore D testing. (Tr. Trans. Vol. III at 231- 32.)² Dr. Beebe also stated that he “didn’t really

² The following exchange took place:

Q. And I think it’s fair to say that Shore D testing is not

refer to the patent in deciding how to do [his] testing” and that he had not attempted to determine how the inventor had conducted Shore D testing. (*Id.* at 232-33.) He further stated that, when he designed his test, he had not reviewed the patent office file history. (*Id.* at 236.) While Dr. Beebe asserted that he had looked at scientific standards for measurements, he stated: “I can’t recall whether I looked at the ASTM or the ANSI [standards]. The acronyms are similar. I looked at one of the standards.” (Tr. Trans. Vol. III at 237) (emphasis added).

JJVC then asked a series of questions designed to show that Dr. Beebe’s procedures, as disclosed in his expert report, did not conform to the governing scientific standards. At first, Dr. Beebe attempted to defend his written procedures; however, he had difficulty explaining how they met the standards. For example, when asked why he chose to test a stack of

something you do in your work as a research scientist; is that right?

A. Correct

Q. It’s something you’ve basically only done for Rembrandt, right?

A. Yes.

Q. So you wouldn’t call yourself an expert in Shore D testing?

A. Yes.

Q. That’s correct? You’re not an expert on Shore D testing?

A. Okay. Yes.

(Tr. Trans. Vol. III at 231-32.)

contact lenses rather than a button or blank of contact lens material, Dr. Beebe gave an implausible reading of the standards, opining that perhaps a “comma” was missing from the standards, which would alter their meaning. (*Id.* at 240.) JJVC next inquired into whether Dr. Beebe tested a sample of the appropriate thickness:

Q. You testified something was 6 millimeters thick?

A. Yes.

Q. What was that?

A. That was the stacked-up lenses that were stacked up in order to achieve a minimum thickness of 6 millimeters.

Q. Whoa. I thought you said in your report that you stacked 24 lenses.

A. Okay.

Q. Is that true? Here’s your expert report. . . . The sample must be thick enough to allow full penetration of the probe, and that’s 2.54 millimeters, right?

A. Yes. And I believe that’s a mistake, actually. I think that—I think the actual—*that might be a typo*. The correct value is one—one-quarter of an inch. . .

. . .

Q. How on earth do 24 lenses add up to 6 millimeters? . . . Oasys [has a] center thickness [of] .07.

...

Q. And my math tells me that 24 times .07 is 1.68 millimeters. Does that sound about right?

A. That math sounds right, yes.

Q. Okay. So you had 24 lenses, and they didn't come close to 6 millimeters, did they?

A. Yes, they did. I actually measured that with a micrometer.

Q. Your report, of course, says it came up to 2.54 [millimeters]. And that's just wrong?

...

A. . . . I'm saying that I think the correct numbers are 6 millimeters and one-quarter of an inch.

Q. Okay.

A. And I tested that with a micrometer caliber as I was stacking them up to make sure that was the case. *I think this might be a typo.*

(*Id.* at 240-43.) After unsuccessfully trying to explain how his sample had the appropriate thickness, Dr. Beebe began to change his account of his testing protocol:

Q. But you stacked 24 lenses, right? That's—that's not a typo, is it?

A. That's not a typo.

Q. And you stacked—

A. Well, I don't know if it's a typo. I stacked the number of lenses required to get a 24—rather, the required 6 millimeter sample height—

(*Id.* at 243.)³

JJVC next asked Dr. Beebe how he complied with the requirement in the standards that samples be flat:

Q. And, of course, the contact lenses aren't flat, right?

A. That's correct.

Q. So setting aside whether you did 6 millimeters or didn't do 6 millimeters, you certainly didn't have flat samples, correct?

A. That's not correct. I disagree.

(*Id.* at 245.)

Unable to explain how his written procedures complied with the standards, Dr. Beebe suddenly changed course in the middle of cross-examination and testified that he did not follow the procedures listed in his expert report. Instead, he claimed that he forgot to mention that the testing procedures he actually used were markedly different from those disclosed in his expert report:

A. I—I—now I think I know what—what I'm not remembering.

³ Dr. Beebe also acknowledged that, to be compliant with the standards, it was important that his sample be at least 6 millimeters thick. (*Id.* at 246.)

Q. Okay.

A. So the lens—I cut the lens into quarters and stacked those quarters up, and I cut 24 lenses into quarters, and that’s what I tested. And I made sure that it was more than 6 millimeters.

Q. Let’s take a look—that doesn’t appear anywhere in your standard operating procedures, does it?

...

Q. Is something missing here? You didn’t tell us what you did?

A. There was a step where I—*in order to make them flat*—you can’t make a curve—an accurate measurement on the curved lenses, as you pointed out a minute ago. So the lenses were quartered and stacked so I could make them flat.

Q. You didn’t think you should tell us that?

A. It’s not that I’m hiding it, but I just told you I—that . . .

...

Q. Right. Because how can you—how could you—sir, your report says you stacked them on a stainless steel ball having the curvature that matched the curvature of the lenses. Is this some other experiment you’re telling us about?

A. That’s—*that’s a typo, yes*. That’s not what I—that’s not how I made the measurements.

Q. Okay. So you didn't carefully stack them on a stainless steel ball having a curvature that matched the curvature of the lenses; you cut them into quarters and stacked them up?

A. On an aluminum plate, that's right.

...

Q. Okay. So is it fair to say that more or less this is a standard that you made up of cutting the lenses and stacking them up?

A. The part about cutting in order to stack them up is something that I did *in order to achieve what the standard says you need for the minimum thickness*.

(*Id.* at 247-50) (emphasis added). Therefore, while Dr. Beebe's expert report stated that he tested 24 whole contact lenses with a thickness of not less than 2.54 millimeters on a curved steel ball, he now testified that he had cut the 24 lenses into quarters and stacked as many as needed on an aluminum plate to reach a height of six millimeters. Dr. Beebe gave two explanations for his new procedures: cutting the lenses into quarters produced a flat surface; and, cutting the lenses allowed him to achieve a minimum thickness of 6 millimeters (though he later testified that he had an unlimited number of lenses).

Dr. Beebe also testified that he had no documentation to support the new procedures he claimed to have employed:

Q. Okay. And so far at least, we're just trusting you on the 6 millimeters. It's not—so far we haven't seen it in your records?

A. As you are trusting me as I testify here, yes.

Q. Okay. And, lastly, you took a video, as I recall, of your microtoming procedure, right?

A. Yes.

Q. But you didn't provide even a photograph of your stack of lenses, did you?

A. No.

Q. So we don't really know what it is you tested or what they looked like, do we?

A. Well, I'm testifying here, telling you that I tested a stack of quartered contact lenses out of the case, so that's what I tested.

(Tr. Trans. Vol. III at 250-51.)

On re-direct, Dr. Beebe provided no further explanation for his departure from the procedures listed in his expert report. Instead, when asked why he had not disclosed that he cut the lenses, Dr. Beebe stated: “[if] I had it to do over again I would have included that detail. I just forgot to put it in.” (Tr. Trans. Vol. IV at 13.)

During re-cross examination, Dr. Beebe acknowledged that his lab notebook also did not mention cutting the lenses, having a sample of 6 millimeters in thickness, stacking the lens pieces on an aluminum plate, or any of the other procedures that Dr. Beebe had mentioned for the first time on cross-examination. (Tr.

Trans. Vol. IV at 46.) Dr. Beebe thus testified that a scientist reviewing his work would not be able to reproduce his testing methodology:

Q. Okay. So any scientist trying to understand what you did based on the written record rather than your oral testimony—your written record says you took 24 lenses and stacked them up on a curved ball, right?

A. Yes, if you put it all together.

(*Id.* at 46.) However, Dr. Beebe agreed that it is important to “good science to accurately record what it is you’re doing.” (*Id.* at 44-45.) Dr. Beebe also acknowledged that a scientist who read the standard operating procedures from his expert report would realize that they are not consistent with the applicable scientific standards. (*Id.* at 41.)

After the completion of Dr. Beebe’s testimony, JJVC moved to exclude his testimony regarding Shore D testing under Daubert. (*Id.* at 77-81.) Rather than hear a response from Rembrandt, the Court scheduled argument on this issue, which occurred at the conclusion of Rembrandt’s case-in-chief. (*Id.* at 81-82.) Both parties filed briefing on the Shore D issue prior to the argument. (Docs. 265, 266.) At the argument, JJVC moved to strike Dr. Beebe’s testimony under both Daubert and Federal Rules of Civil Procedure 26 and 37. JJVC further moved for judgment as a matter of law under Federal Rule of Civil Procedure 50(a) because, if Dr. Beebe’s testimony was excluded, Rembrandt would have no evidence to meet its burden of proof on the “soft” claim limitation. (Doc. 265.) JJVC also moved for judgment as a matter of

law under Rule 50(a) on the issue of willful infringement. (Tr. Trans. Vol VI at 5-93.)

At argument, when the Court asked Rembrandt what it would tell the jury regarding Dr. Beebe's Shore D testing, Rembrandt's counsel stated:

I can only live with the testimony he gave, Your Honor. His testimony is that he did it the way he said he did it. I—I have no basis to say that that's not true. . . . I'm going to say that Dr. Beebe got extremely flustered on cross under a very vigorous cross. . . . His testimony was not clean by any way, shape, or form, but his test results are reliable.

(*Id.* at 74-75.) The Court deferred ruling on JJVC's motion to exclude Dr. Beebe's testimony until the conclusion of the liability phase of trial. (Tr. Trans. VI at 91-92.) However, the Court granted JJVC's Rule 50(a) motion with respect to willfulness, and thus did not permit Rembrandt to argue willful infringement to the jury. (*Id.*)

At the close of the evidence, JJVC renewed its motion to exclude Dr. Beebe's Shore D testimony. The Court continued to defer ruling. (Tr. Trans. Vol. IX at 134.)

During closing, Rembrandt told the jury that the differences between Dr. Beebe's expert report and his testimony at trial did not affect the reliability of his results. Rembrandt stated:

So you have to ask yourself this question as you sit there and listen to some of the criticisms

[of Dr. Beebe] and ask yourself: Does this one— does this one really matter on this one? And only you can answer that question, but the expected value of any kind of testing on the Shore D is zero.

(Tr. Trans. Vol. IX at 187.) Rembrandt then referred the jury to Shore D testing that Dr. Beebe had conducted on other contact lenses during a reexamination of the ‘327 patent and asserted: “as you can see, it doesn’t matter how you stack them, where you test them, the result is zero. It’s what you expect and that’s the results you get.” (*Id.*) Rembrandt thus essentially told the jury that it could disregard any flaws in Dr. Beebe’s methodology or the change in his testimony because “the expected result” was a Shore D value of less than 5.

The Court conducted another lengthy hearing after the case was submitted to the jury, (Tr. Trans. Vol. X at 1-108) and Rembrandt filed a supplemental memorandum (Doc. 274). After the jury returned a verdict of non-infringement, the Court announced that it would alternatively grant JJVC’s motion to strike Dr. Beebe’s Shore D testimony and for judgment as a matter of law under Rule 50(a). (Tr. Trans. Vol. XI at 51-52.)⁴

II. STANDARD OF REVIEW

In this patent case, this Court applies the law of the Eleventh Circuit with respect to evidentiary issues and the standard applicable to a motion for judgment as a

⁴ Rembrandt contended that the Shore D issue was moot in light of the jury’s verdict. However, after fully discussing the mootness issue with the parties, the Court decided to proceed with an alternative ruling for the reasons stated on the record. (Tr. Trans. Vol. XI at 12-52.)

matter of law. See *Retractable Techs., Inc. v. Becton, Dickinson and Co.*, 653 F.3d 1296, 1302 (Fed. Cir. 2011) (“In reviewing evidentiary rulings and denials of motions for JMOL, we apply the law of the regional circuit”); *Liquid Dynamics Corp. v. Vaughan Co.*, 449 F.3d 1209, 1218 (Fed. Cir. 2006) (applying regional circuit law when reviewing a Daubert ruling).

Under Rule 50(a), “[i]f a party has been fully heard on an issue during a jury trial and the court finds that a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue, the court may resolve the issue against the party.” The Eleventh Circuit has instructed that Rule 50 motions “should be granted . . . when the plaintiff presents no legally sufficient evidentiary basis for a reasonable jury to find for him on a material element of his cause of action.” *Howard v. Walgreen Co.*, 605 F.3d 1239, 1242 (11th Cir. 2010). The Court “look[s] at the record evidence, drawing all inferences in favor of the nonmoving party.” *Collado v. United Parcel Service, Co.*, 419 F.3d 1143, 1149 (11th Cir. 2005).

III. DISCUSSION

A. JJVC’s Motion to Exclude Dr. Beebe’s Shore D Testimony

While Dr. Beebe’s shifting testimony casts doubt on his credibility, for purposes of this Order, the Court will assume that Dr. Beebe testified truthfully on cross-

examination.⁵ The Court will thus assume that, in his expert report and during his own direct examination, Dr. Beebe disclosed a different testing methodology than he actually performed. The Court will also accept that Dr. Beebe tested a stack of an unknown number of “cut-up” quarter-contact lenses which measured 6 millimeters. Finally, the Court will accept Dr. Beebe’s testimony that, although it is important to good science to keep accurate records, Dr. Beebe has absolutely no record of his procedures.⁶

1. Rules 26 and 37

Federal Rule of Civil Procedure 26(a) requires an expert witness to produce a report which contains, among other things, “a complete statement of all opinions the witness will express and the basis and reasons for them” and “the facts or data considered by the witness in forming them.” Fed. R. Civ. P. 26(a)(2). Moreover, Rule 26(e) states a party must supplement its expert report “if the party learns that in some material respect the disclosure or response is incomplete or incorrect.” Fed. R. Civ. P. 26(e). The Eleventh Circuit has explained that “the expert disclosure rule is intended to provide opposing parties reasonable opportunity to prepare for effective cross examination and perhaps arrange for expert testimony from other

⁵ Rembrandt has likewise stated that it relies on Dr. Beebe’s “new” testimony rather than his expert report or his testimony on direct examination.

⁶ In fact, the documentary record of Dr. Beebe’s testing flatly contradicts the methodology he now says he actually used.

witnesses.” *Reese v. Herbert*, 527 F.3d 1253, 1265 (11th Cir. 2008) (quotation omitted).

Under Rule 37, “[i]f a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use that information or witness to supply evidence . . . at a trial, unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1). “The burden of establishing that a failure to disclose was substantially justified or harmless rests on the nondisclosing party.” *Mitchell v. Ford Motor Co.*, 318 F. App’x 821, 824 (11th Cir. 2009).

As the First Circuit has explained:

The Advisory Committee notes to the 1993 amendments to [Rule 37] state that the harmless provision is intended “to avoid unduly harsh penalties in a variety of situations.” Illustrative examples are late disclosures of a potential witness known to all parties, a trial witness already listed by the adverse party, or a witness on behalf of a pro se litigant ignorant of the requirement. These suggest a fairly limited concept of “harmless.”

Gagnon v. Teledyne Princeton, Inc., 437 F.3d 188, 197 (1st Cir. 2006); see also *Burney v. Rheem Mfg. Co.*, 196 F.R.D. 659, 692 (M.D. Ala. 2000) (“This commentary strongly suggests that ‘harmless involves an honest mistake on the part of a party coupled with sufficient

knowledge on the part of the other party.”) (quoting *Vance v. United States*, 182 F.3d 920 (6th Cir. 1999)).⁷

⁷ When determining if a failure to disclose was substantially justified or harmless, courts consider, among other things: “(1) the surprise to the party against whom the evidence would be offered; (2) the ability of that party to cure the surprise; (3) the extent to which allowing the evidence would disrupt the trial; (4) the importance of the evidence; and (5) the nondisclosing party’s explanation for its failure to disclose the evidence.” *Mobile Shelter Sys. USA, Inc. v. Grate Pallet Solutions, LLC*, 845F. Supp. 2d1241, 2012 U.S. Dist. LEXIS 4535, 2012 WL 115601, at *7 (M.D. Fla. Jan. 14, 2012). Rembrandt asserts that the Court should also consider whether there has been “bad faith or willfulness in failing to comply with the district court’s order.” (Doc. 274 at 6.) The cases

Rembrandt relies on, however, are in the context of a party that violates a court order prior to trial. (See Doc. 274.) The courts in those cases thus had the ability to ameliorate prejudice by extending deadlines, reopening discovery, or granting other relief (or, in some cases, there simply was no prejudice). Unlike in those cases, however, because JJVC learned for the first time in the middle of trial that Dr. Beebe had not disclosed his testing procedures, the Court was left with few remedial options. In this situation, sanctions may be appropriate even absent a showing of willfulness because the prejudice to JJVC was largely unavoidable.

Moreover, the Eleventh Circuit has affirmed the exclusion of expert witness testimony under Rules 26 and 37 without requiring a showing of bad faith. See *Mitchell*, 318 F. App’x at 824 (affirming the exclusion of an expert who “did not fully disclose the bases of his expert opinions or supplement the disclosures when it became clear that his Rule 26 disclosures and deposition had not been sufficient”); *Romero v. Drummond Co.*, 552 F.3d 1303, 1323 (11th Cir. 2008) (affirming exclusion where the expert’s report did not state the “anticipated opinion with sufficient specificity to allow [the opposing party] to prepare for rebuttal or cross-examination”); see also *Nelson v. City & County of San Francisco*, 123 F. App’x 817,

Dr. Beebe's expert report is woefully deficient under Rule 26. Rather than disclosing the basis for his opinions, Dr. Beebe's report describes a Shore D test that is completely different from the test he now states he actually performed. In his expert report, Dr. Beebe stated that 24 "lenses were removed from their packaging and carefully stacked on a stainless steel ball." (Doc. 265, ex. 2 at 46.) The report further states that the stack of lenses was at least 2.54 millimeters thick. (*Id.* at 47.) Dr. Beebe confirmed these procedures during direct examination. During cross-examination, however, Dr. Beebe stated that he had cut the 24 lenses into quarters and stacked an unknown number of these quarter lenses to a height of 6 millimeters. (Tr. Trans. Vol. III at 247.) He also explained that, rather than placing them on a stainless steel ball, he stacked the lenses on an aluminum plate. (*Id.* at 249.) Dr. Beebe thus employed drastically different testing procedures than those disclosed in his expert report.

Rembrandt asserts that Dr. Beebe merely made "minor mistakes" when reporting his testing procedures. (Doc. 266 at 9.) This assertion is no more tenable than Dr. Beebe's claim that the problems in his expert report were due to a series of "typos." In fact, the differences between the procedures listed in Dr. Beebe's reporting and those he testified to at trial are so substantial that Dr. Beebe essentially performed an entirely different test. Rembrandt's failure to alert

819-20 (9th Cir. 2005) (showing that a district court may exclude evidence under Rule 37 without finding willful deception).

JJVC to the true nature of Dr. Beebe's testing was thus a blatant violation of Rule 26.

The Court recognizes that Rule 26 "does not limit an expert's testimony simply to reading his report. The Rule contemplates that the expert will supplement, elaborate upon, and explain his report in his oral testimony." *Muldrow ex rel. Estate of Muldrow v. Re-Direct, Inc.*, 493 F.3d 160, 167, 377 U.S. App. D.C. 187 (D.C. Cir. 2007)(quotation omitted). This case, however, is easily distinguishable from those where courts have allowed an expert to vary from his expert report. In *McPherson v. Rowe*, 366 F. App'x 43 (11th Cir. 2010), for example, the Eleventh Circuit held that the district court did not abuse its discretion by failing to exclude expert testimony regarding certain new information that had not been disclosed in an expert report because "neither of the [expert] witnesses testified to opinions based on the 'new information.'" *Id.* at 45. Here, rather than permissibly elaborating on or supplementing his analysis, Dr. Beebe disclosed an entirely new testing protocol that formed the basis for his expert opinion. This Rule 26 does not allow.

Rembrandt's failure to disclose cannot be "substantially justified." Fed. R. Civ. P. 37(c)(1). Rembrandt produced Dr. Beebe's expert report to JJVC on October 3, 2011. Since that time, Dr. Beebe has been deposed (on other aspects of his Shore D testing) and JJVC has moved for summary judgment based on Dr. Beebe's Shore D testing methodology. (Doc. 152.) Throughout the pretrial proceedings, Dr. Beebe thus apparently either did not review his expert report or forgot how he had actually performed the test. There is

simply no excuse for Dr. Beebe waiting until cross-examination to disclose his testing procedures, and Rembrandt has not attempted to offer any explanation or justification.

However, Rembrandt contends that sanctions should not be imposed because its failure to disclose was harmless. Rembrandt asserts that JJVC suffered no prejudice for three reasons: (1) “JJVC paid no attention to Dr. Beebe’s Shore D testing procedures until its cross-examination of Dr. Beebe;” (2) “not a single one of JJVC’s experts reported making any effort whatsoever to duplicate Dr. Beebe’s tests;” and (3) “Dr. Beebe’s consistent results of zero are expected.” (Doc. 266 at 8-12.)

Rembrandt’s first contention is simply incorrect. JJVC moved for summary judgment and to exclude Dr. Beebe’s testimony on the grounds that, “by failing to comply with the appropriate testing standards of ANSI and ASTM, Rembrandt generated results wholly unreliable under the standards of Daubert.” (Doc. 152 at 38.) Although JJVC did not discuss Shore D testing procedures with Dr. Beebe during his deposition, JJVC was entitled to assume that Dr. Beebe had actually followed the procedures listed in his expert report.

Rembrandt’s second contention is irrelevant. Although JJVC may not have attempted to duplicate the testing procedures listed in Dr. Beebe’s expert report, JJVC was not given the opportunity to duplicate the testing procedures actually used by Dr. Beebe. JJVC now asserts that, had it known of the procedures actually used by Dr. Beebe, it would have put on evidence showing that his new procedures were

impractical and not in accordance with standards. (Tr. Trans. Vol. VI at 47.) Moreover, regardless of whether JJVC would have duplicated Dr. Beebe's testing, Rembrandt's failure to disclose Dr. Beebe's testing procedures until well into cross-examination obviously denied JJVC the ability to prepare for cross-examination. *See, e.g., Thibeault v. Square D Co.*, 960 F.2d 239, 246-47 (1st Cir. 1992) ("Many courts . . . have recognized that the introduction of new expert testimony on the eve of trial can be seriously prejudicial to the opposing party."). This prejudice is demonstrated by the fact that, after Dr. Beebe concluded his testimony, JJVC informed the Court in its Daubert motion that Dr. Beebe's new procedures violated scientific standards in ways it had neglected to raise before the jury.⁸

Rembrandt next argues that JJVC suffered no prejudice because the accused lenses are "soft" under ordinary usage; however, this argument belies the nature of patent litigation. The plaintiff in an infringement case has the burden to prove that the defendant's product meets each and every claim limitation, *as defined by the Court*. At the joint request of the parties, the Court construed the "soft" limitation to mean "a contact lens having a Hardness (Shore D) of

⁸ As more fully explained below in the Daubert discussion, the standards require that testing be performed at least three millimeters from any edge of the sample. By cutting the lenses in quarters, JJVC now argues that Dr. Beebe's samples were too small to comply with this requirement. Although JJVC raised this issue in its Daubert motion, it failed to do so before the jury. (Tr. Trans. Vol. IV at 80-81.)

less than five.” (Doc. 69 at 2.) As the Court ruled when Rembrandt raised this issue in its motion in limine, common usage of the term “soft” is simply not relevant. (See Doc. 255 at 95-96.)

Finally, Rembrandt contends that JJVC suffered no prejudice because, based on testing from other cases, Rembrandt believes the accused lenses have a Shore D value of less than five regardless of how they are tested. (Doc. 266 at 8.) However, to credit Rembrandt’s argument, the Court would need to accept testing that was performed on different lenses in litigation to which JJVC was not a party. This the Court cannot do. Aside from Dr. Beebe’s testimony in this case, neither the Court nor the jury had any way of knowing the Shore D value of JJVC’s lenses. Moreover, JJVC is entitled to put Rembrandt to its proof with respect to each claim limitation, and Rembrandt’s failure to disclose Dr. Beebe’s testing procedures seriously impaired JJVC’s ability to do so.

JJVC also suffered prejudice during closing arguments. Rather than attempt to defend Dr. Beebe’s science, Rembrandt told the jury to ignore the problems with his testimony and methodology because “the expected value of any kind of testing on the Shore D is zero.” (Tr. Trans. Vol. IX at 187.) Rembrandt told the jury: “it doesn’t matter how you stack them, where you test them, the result is zero.” (*Id.*) Rembrandt thus intimated that the jury could disregard Dr. Beebe’s testing and still find that the accused products met the “soft” claim limitation. But, of course, Dr. Beebe’s testing was the only evidence that Rembrandt offered on this issue.

While Rembrandt has cited a number of cases in which courts have decided not to exclude expert testimony when faced with a violation of Rule 26, each of those cases is easily distinguishable because none involved a disclosure of new testing procedures in the middle of trial. *See, e.g., McClain v. Metabolife Int'l, Inc.*, 193 F. Supp.2d 1252 (N.D. Ala. 2002); *Graphic Packaging Int'l, Inc. v. C.W. Zumbiel Co.*, No. 3:10-cv-891-J-37JBT, 2011 U.S. Dist. LEXIS 127320, 2011 WL 5357833 (M.D. Fla. Nov. 3, 2011). While a failure to comply with disclosure deadlines may be harmless in certain situations when the disclosure is ultimately made well before trial, the situation here is markedly different. Unlike in those cases, the Court could not simply extend a deadline or amend the case schedule to cure the prejudice to JJVC.⁹

The Court “acknowledge[s] that preclusion of expert testimony is a grave step, not to be undertaken lightly.” *Thibeault*, 960 F.2d at 247. However, Dr. Beebe performed an entirely different test than that disclosed in his expert report, and Rembrandt’s failure to disclose this fact was a clear and unjustified violation of Rule 26. Because this failure seriously prejudiced JJVC’s defense, Dr. Beebe’s Shore D testimony is due to be excluded under Rule 37.

⁹ Rembrandt contends that “[t]he prejudice to JJVC was resoundingly cured by Mr. Diskant’s [JJVC’s counsel] withering cross-examination.” (Doc. 274 at 8). However, Rembrandt has cited no authority for this argument, and the Court finds that it is not well taken. As explained above, Dr. Beebe’s failure to properly disclose his procedures impaired JJVC’s ability to adequately prepare for cross-examination.

2. *Daubert*

JJVC also contends that Dr. Beebe's testimony regarding Shore D should be excluded under Daubert. JJVC asserts that Dr. Beebe is not qualified to testify with respect to Shore D testing and his testing methodology is unreliable. According to JJVC, Dr. Beebe's methodology is unreliable both because it does not comply with scientific standards and because it is not recorded and thus his tests are not reproducible. (Doc. 265 at 17-24.)

Federal Rule of Evidence 702 governs the admissibility of expert testimony. In *Daubert*, the Supreme Court instructed that, under Rule 702, district courts must perform a "gatekeeping" role with respect to expert scientific testimony and must consider whether:

(1) the expert is qualified to testify competently regarding the matters he intends to address; (2) the methodology by which the expert reaches his conclusions is sufficiently reliable as determined by the sort of inquiry mandated in *Daubert*; and (3) the testimony assists the trier of fact, through the application of scientific, technical, or specialized expertise, to understand the evidence or to determine a fact in issue.

United States v. Frazier, 387 F.3d 1244, 1260 (11th Cir. 2004) (en banc), *cert. denied*, 544 U.S. 1063, 125 S. Ct. 2516, 161 L. Ed. 2d 1114 (2005). When evaluating whether an expert's methodology is reliable, the Court considers, among other things:

(1) whether the expert's theory can be and has been tested; (2) whether the theory has been subjected to peer review and publication; (3) the known or potential rate of error of the particular scientific technique; and (4) whether the technique is generally accepted in the scientific community.

Frazier, 387 F.3d at 1262.

“The burden of laying a proper foundation for the admissibility of an expert's testimony is on the party offering the expert, and the admissibility must be shown by a preponderance of the evidence.” *Hall v. United Ins. Co. of America*, 367 F.3d 1255, 1261 (11th Cir. 2004)(citation omitted). The admission of expert testimony is a matter within the discretion of the district court, which is accorded “considerable leeway” in making its determination. *Cook ex rel. Estate of Tessier v. Sheriff of Monroe Cnty, Fla.*, 402 F.3d 1092, 1103 (11th Cir. 2005); *Frazier*, 387 F.3d at 1258-59.

Rembrandt first argues that Dr. Beebe's testimony should not be excluded because “the weight and credibility of an expert's testimony are questions to be resolved by the jury.” (Doc. 266 at 10.) Rembrandt thus accepts the new methodology Dr. Beebe described during his cross-examination and disclaims the methodology listed in Dr. Beebe's expert report. (*Id.*) As explained above, for purposes of this Order, the Court likewise assumes that Dr. Beebe testified truthfully at trial during cross-examination.

The Court will also assume, without deciding, that Dr. Beebe is sufficiently qualified to testify regarding

Shore D testing and that his opinions, if reliable, would assist the jury. However, even accepting Dr. Beebe's testimony as true, Rembrandt has not met its burden of proving that Dr. Beebe's methodology is sufficiently reliable.

During oral argument, Rembrandt repeatedly asserted that Dr. Beebe's testing was reliable because "his test *results* are reliable." (Tr. Trans. Vol. VI. at 64, 75, 79, 85.)¹⁰ Rembrandt thus essentially argues that Dr. Beebe's testimony should be allowed so long as the Court concludes that his results are correct. Daubert, however, does not ask courts to evaluate whether an expert's opinion is correct; instead, it requires courts to determine whether the expert has used a reliable *methodology*. See, e.g., *Smelser v. Norfolk Southern Railway Co.*, 105 F.3d 299, 303 (6th Cir. 1997) ("When considering reliability, the trial court must focus on the soundness of the expert's methodology and not the correctness of his conclusions."). That Dr. Beebe's ultimate opinion may be consistent with the expected result is not relevant to the issue of whether he employed a scientifically reliable methodology to reach his opinion. Just as a court need not accept opinions that are "connected to existing data only by the ipse dixit of the expert," *General Electric v. Joiner*, 522 U.S. 136, 146, 118 S. Ct. 512, 139 L. Ed. 2d 508 (1997), this Court cannot simply accept the bald assertion that JJVC's lenses have a Shore D value of less than five. As the Eleventh Circuit

¹⁰ To support this assertion, Rembrandt again refers to the common usage of the term "soft" and testing Dr. Beebe performed on *other* contact lenses in litigation against *other* companies.

has explained, district courts must conduct “an exacting analysis of the foundations of expert opinions.” Frazier, 387 F.3d at 1260 (emphasis in original).

Rembrandt also asserts that Dr. Beebe’s methodology is reliable because it complies with the ASTM standards for Shore D testing. (Doc. 266 at 6.) Dr. Beebe’s procedures, however, significantly depart from those standards. For example, the ASTM standards state that “[t]he lateral dimensions of the specimen shall be sufficient to permit measurements at least 12.0 mm (0.48 inch.) from any edge, unless it is known that identical results are obtained when measurements are made at a lesser distance from an edge.” (Doc. 265, ex. 8 at 5.) Moreover, the ANSI standards, which Dr. Beebe stated he did not read,¹¹ provide that measurements must be made at least 3 mm from any edge. Because Dr. Beebe cut his sample lenses into quarters, however, it is mathematically impossible that he complied with either standard. His samples were simply too small. Moreover, the ASTM standards provide that “[t]he specimen shall be suitably supported to provide for positioning and stability.” (Doc. 265, ex. 8 at 5.) However, Dr. Beebe’s protocol, as he explained it at trial, nowhere mentions how the quarter-lenses were stacked or supported.¹²

¹¹ Dr. Beebe stated: “I can’t recall whether I looked at the ASTM or the ANSI. The acronyms are similar. I looked at *one* of the standards.” (Tr. Trans. Vol. III at 237.) He later stated that he had consulted the ASTM standards.

¹² The standard operating procedures provided in Dr. Beebe’s expert report also fail to indicate how the samples were supported. (See Doc. 266, ex. 2 at 46.)

Finally, while the ASTM standards state that “a specimen may be composed of plied pieces to obtain the necessary thickness,” it warns that “determinations made on such specimens may not agree with those made on solid specimens.” (Doc. 265 at ex. 8.)¹³ In sum, even accepting Dr. Beebe’s testimony as true, his testing contained serious deviations from the applicable scientific standards.

Not only did Dr. Beebe depart from generally accepted scientific standards, his methodology is also unreliable because he failed to keep proper records and documentation of his procedures. Under Daubert, courts must ensure that an expert “employs in the courtroom the same level of intellectual rigor that characterizes the practice of an expert in the relevant field.” *Frazier*, 387 F.3d at 1260. As Dr. Beebe stated at trial, experts in his field record their methodology so that other scientists can reproduce and test their experiments. (Tr. Trans. Vol. IV at 37, 44-45.) In fact, reproducible testing is a hallmark of reliable science. *See, e.g., Daubert*, 509 U.S. at 593 (“Scientific methodology today is based on generating hypotheses and testing them to see if they

¹³ The ANSI standards state that “a test specimen consists of a contact lens button or blank that has the dimension of a disc of at least 6 mm thick and a diameter of at least 12.7mm.” When asked about this provision on cross-examination, Dr. Beebe implausibly suggested that there may be a comma missing from the standard, such that it permitted the testing of a “contact lens [,] button or blank.” Dr. Beebe’s inability to provide any justification for his clear departure from the ANSI standards cuts against the reliability of his work. While the ASTM standards are more supportive of his methodology, Dr. Beebe seemed totally unaware of this fact throughout cross-examination.

can be falsified; indeed, this methodology is what distinguishes science from other fields of human inquiry.”) (quotation omitted); *Zenith Electronics Corp. v. WH-TV Broadcasting Corp.*, 395 F.3d 416, 419 (7th Cir. 2005)(“Someone else using the same data and methods must be able to replicate the result.”). Dr. Beebe’s testing, however, was not reproducible because he failed to document and disclose the procedures he used to conduct his tests.¹⁴ This lack of documentation strongly weighs against the reliability of Dr. Beebe’s methodology. *See Smelser*, 105 F.3d at 303 (testimony improperly admitted where expert had “failed to adequately document testing conditions and the rate of error so the test could be repeated and its results verified and critiqued”); *United States v. Hebshie*, 754 F. Supp.2d 89, 125 (D. Mass. 2010)(“Documentation is necessary to test a hypothesis; in fact, reproducibility is the sine qua non of science.”); *Morehouse v. Louisville Ladder Group LLC*, No. Civ.A 3:03-887-22, 2004 U.S. Dist. LEXIS 21766, 2004 WL 2431796, at *7 (D. S.C. 2004)(excluding expert testimony in part because the expert “failed to record his hypothesis testing or include relevant details in his report”); *Black v. Rhone-Poulenc, Inc.*, 19 F. Supp.2d 592, 598 (S.D.W. Va. 1998)(finding that an expert’s failure to document his study weighed against admissibility because “independent reconstruction would be exceedingly difficult if not impossible.”).

¹⁴ This is because, as previously discussed, Dr. Beebe’s laboratory records and expert report describe an entirely different testing regimen.

The Court thus concludes that Dr. Beebe's methodology is not scientifically reliable. His testing procedures are undocumented and do not conform to the governing scientific standards. The Court would be abdicating its gatekeeping role if it allowed the jury to rely on Dr. Beebe's opinion. Dr. Beebe's Shore D testimony is thus due to be excluded under Daubert as well as Rule 37.

3. *Summation*

While the Court has analyzed the Shore D issue as Rules 26 and 37 and Daubert require, this recitation may not capture the full import of what happened. Dr. Bebee provided the only evidence of an essential element of Rembrandt's infringement case. In the discipline of testing contact lenses, where measurements are often made in millimeters and the slightest variation in methodology can make a significant difference, Dr. Bebee tendered his Rule 26 report stating his method for conducting the Shore D test. He then testified consistent with his report on direct examination and even for part of cross-examination. It was only when he was repeatedly challenged on cross-examination concerning flaws in his method that he, on the fly, completely changed his testimony as to how he conducted the Shore D test. In doing so, he gave explanations that bordered on the fanciful, such as that virtually the entire testing method he disclosed in his expert report was a "typo".

JJVC was left without the ability to effectively cross-examine Dr. Bebee on this "new" testing methodology he had just announced. The jury, tasked with the Herculean challenge of deciphering the highly technical evidence in this patent case, was entirely disserved by

the expert's sudden change in course. Instead of the orderly and fair trial process contemplated by Rule 26 and Daubert, Dr. Beebe's abrupt and still unexplained implosion led to derailment of the trial as to this issue. Rule 26, Rule 37 and Daubert, as applied to these egregious facts, compel the striking of Dr. Beebe's Shore D testimony.

B. JJVC's Rule 50(a) Motions

1. Dr. Beebe's Shore D Testimony

Dr. Beebe's Shore D testimony constitutes the only evidence advanced by Rembrandt to prove that the accused JJVC products meet the "soft" claim limitation. Once Dr. Beebe's testimony is excluded, no reasonable jury could find infringement.¹⁵ Pursuant to Rule 50(a), JJVC is therefore entitled to judgment as a matter of law.¹⁶

2. Willfulness

The Court has also granted JJVC's Rule 50(a) motion with respect to the issue of willful infringement. The Federal Circuit has explained that,

to establish willful infringement, a patentee must show by clear and convincing evidence that the infringer acted despite an objectively high

¹⁵ Rembrandt conceded this point at the May 11, 2012 hearing. (See Tr. Trans. Vol. X at 19-20.)

¹⁶ As stated on the record, the Court believes the motion is properly analyzed under Rule 50(a). (Tr. Trans. Vol. XI at 15-52.) However, if the motion is more properly brought under Rule 50(b), the Court's ruling would be the same.

likelihood that its actions constituted infringement of a valid patent. The state of mind of the accused infringer is not relevant to this objective inquiry. If this threshold objective standard is satisfied, the patentee must also demonstrate that this objectively-defined risk (determined by the record developed in the infringement proceeding) was either known or so obvious that it should have been known to the accused infringer.

In re Seagate Technology, LLC, 497 F.3d 1360, 1371 (Fed. Cir. 2007). “[B]oth legitimate defenses to infringement claims and credible invalidity arguments demonstrate the lack of an objectively high likelihood that a party took actions constituting infringement of a valid patent.” *Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 F. App’x 284, 291 (Fed. Cir. 2008). Moreover, willfulness is not present where a claim term is susceptible to “a reasonable construction” under which the defendant’s products did not infringe. *Cohesive Technologies, Inc. v. Waters Corp.*, 543 F.3d 1351, 1374 (Fed. Cir. 2008). “The answer to whether an accused infringer’s reliance on a particular issue or defense is reasonable is a question for the court when the resolution of that particular issue or defense is a matter of law. Should the court determine that the infringer’s reliance on a defense was not objectively reckless, it cannot send the question of willfulness to the jury” *Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1236 (Fed. Cir. 2011).

Rembrandt has not presented a legally sufficient evidentiary basis for a reasonable jury to find by clear

and convincing evidence that JJVC acted despite an objectively high likelihood that its actions constituted infringement of a valid patent. JJVC presented cogent and reasonable arguments that its products did not meet several limitations, including the “soft” and “surface layer” limitations. Moreover, the Court finds that JJVC’s reliance on its claim construction arguments and indefiniteness defenses was not objectively reckless.

Accordingly, it is hereby

ORDERED:

1. Johnson & Johnson Vision Care, Inc.’s *ore tenus* motion to exclude evidence of Shore D testing and for judgment as a matter of law is **GRANTED**.

2. Johnson & Johnson Vision Care, Inc.’s *ore tenus* motion for judgment as a matter of law on the issue of willful infringement is **GRANTED**.

3. Pursuant to the jury’s verdict (Doc. 277) and this Order, each of which shall constitute alternative bases, judgment will be entered in favor of defendant Johnson & Johnson Vision Care, Inc. and against plaintiff Rembrandt Vision Technologies, L.P.

DONE AND ORDERED at Jacksonville, Florida
this 4th day of June, 2012.

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Appendix E

UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF TEXAS,
MARSHALL DIVISION

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff,

v.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant.

CIVIL ACTION NO. 2:09-cv-200-TJW

April 28, 2011, Decided

April 28, 2011, Filed

JUDGES: T. JOHN WARD, UNITED STATES DIS-
TRICT JUDGE.

MEMORANDUM OPINION AND ORDER

Plaintiff Rembrandt Vision Technologies, L.P. (“Rembrandt”) filed suit against Defendant Johnson & Johnson Vision Care, Inc. (“JJVC”) for patent infringement of U.S. Patent No. 5,712,327 (“the ‘327 Patent”). This Memorandum Opinion and Order outlines the Court’s claim construction for the four disputed terms in the ‘327 Patent.

I. BACKGROUND OF THE TECHNOLOGY

The '327 Patent is entitled "Soft Gas Permeable Contact Lens Having Improved Clinical Performance." The invention generally relates to a hydrophilic soft contact lens that has a novel surface that increases clinical performance. The abstract of the '327 Patent reads:

A hydrophilic soft gas permeable contact lens having substantially improved clinical performance by the provision of a sufficient higher proportion of hydroxy acrylic units to silicon units in the lens surface layer, as compared to that existing in the lens core, by the surface treatment of the lens, such as by reacting of the lens surface with polyols and base or acid or by radiation treatment of the base lens to graft, deposit or coat thereon hydroxy acrylic units.

Claim 1, which is asserted in this case and contains the disputed claim construction terms, reads as follows:

1. A hydrophilic soft gas permeable contact lens comprised of a polymerization product of a composition comprising a polymerizable vinylic siloxane monomer and a hydrophilic vinylic monomer, and having at least 25% water by weight and characterized by high oxygen permeability, softness, rebound elasticity and a high degree of clinical performance, said lens comprising a hydrophilic lens body and a tear-wettable surface layer integral therewith, said lens body being comprised of said polymerization product and said tear-wettable surface layer

being comprised of polymeric material containing hydroxy acrylic monomer units, and wherein the proportion of hydroxy acrylic monomer units to silicon units in said tear-wettable surface layer is greater than that of said lens body.

II. GENERAL PRINCIPLES GOVERNING CLAIM CONSTRUCTION

“A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using or selling the protected invention.” *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340 (Fed. Cir. 1999). Claim construction is an issue of law for the court to decide. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996).

To ascertain the meaning of claims, the court looks to three primary sources: the claims, the specification, and the prosecution history. *Markman*, 52 F.3d at 979. The specification must contain a written description of the invention that enables one of ordinary skill in the art to make and use the invention. *Id.* A patent’s claims must be read in view of the specification, of which they are a part. *Id.* For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Id.* “One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.” *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882 (Fed. Cir. 2000).

Nonetheless, it is the function of the claims, not the specification, to set forth the limits of the patentee's invention. Otherwise, there would be no need for claims. *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). The patentee is free to be his own lexicographer, but any special definition given to a word must be clearly set forth in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992). Although the specification may indicate that certain embodiments are preferred, particular embodiments appearing in the specification will not be read into the claims when the claim language is broader than the embodiments. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994).

This Court's claim construction decision must be informed by the Federal Circuit's decision in *Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). In *Phillips*, the court set forth several guideposts that courts should follow when construing claims. In particular, the court reiterated that "the *claims* of a patent define the invention to which the patentee is entitled the right to exclude." 415 F.3d at 1312 (emphasis added) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). To that end, the words used in a claim are generally given their ordinary and customary meaning. *Id.* The ordinary and customary meaning of a claim term "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Id.* at 1313. This principle of

patent law flows naturally from the recognition that inventors are usually persons who are skilled in the field of the invention and that patents are addressed to and intended to be read by others skilled in the particular art. *Id.*

The primacy of claim terms notwithstanding, *Phillips* made clear that “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.* Although the claims themselves may provide guidance as to the meaning of particular terms, those terms are part of “a fully integrated written instrument.” *Id.* at 1315 (quoting *Markman*, 52 F.3d at 978). Thus, the *Phillips* court emphasized the specification as being the primary basis for construing the claims. *Id.* at 1314-17. As the Supreme Court stated long ago, “in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims.” *Bates v. Coe*, 98 U.S. 31, 38, 25 L. Ed. 68, 1879 Dec. Comm’r Pat. 365 (1878). In addressing the role of the specification, the *Phillips* court quoted with approval its earlier observations from *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998):

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the

claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.

Phillips, 415 F.3d at 1316. Consequently, *Phillips* emphasized the important role the specification plays in the claim construction process.

The prosecution history also continues to play an important role in claim interpretation. Like the specification, the prosecution history helps to demonstrate how the inventor and the PTO understood the patent. *Id.* at 1317. Because the file history, however, “represents an ongoing negotiation between the PTO and the applicant,” it may lack the clarity of the specification and thus be less useful in claim construction proceedings. *Id.* Nevertheless, the prosecution history is intrinsic evidence that is relevant to the determination of how the inventor understood the invention and whether the inventor limited the invention during prosecution by narrowing the scope of the claims. *Id.*

Phillips rejected any claim construction approach that sacrificed the intrinsic record in favor of extrinsic evidence, such as dictionary definitions or expert testimony. The *en banc* court condemned the suggestion made by *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), that a court should discern the ordinary meaning of the claim terms (through dictionaries or otherwise) before resorting to the specification for certain limited purposes. *Phillips*, 415 F.3d at 1319-24. The approach suggested by *Texas Digital*—the assignment of a limited role to the specification—was rejected as inconsistent with decisions holding the specification to be the best guide to

the meaning of a disputed term. *Id.* at 1320-21. According to *Phillips*, reliance on dictionary definitions at the expense of the specification had the effect of “focus[ing] the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.” *Id.* at 1321. *Phillips* emphasized that the patent system is based on the proposition that the claims cover only the invented subject matter. *Id.* What is described in the claims flows from the statutory requirement imposed on the patentee to describe and particularly claim what he or she has invented. *Id.* The definitions found in dictionaries, however, often flow from the editors’ objective of assembling all of the possible definitions for a word. *Id.* at 1321-22.

Phillips does not preclude all uses of dictionaries in claim construction proceedings. Instead, the court assigned dictionaries a role subordinate to the intrinsic record. In doing so, the court emphasized that claim construction issues are not resolved by any magic formula. The court did not impose any particular sequence of steps for a court to follow when it considers disputed claim language. *Id.* at 1323-25. Rather, *Phillips* held that a court must attach the appropriate weight to the intrinsic sources offered in support of a proposed claim construction, bearing in mind the general rule that the claims measure the scope of the patent grant.

III. TERMS IN DISPUTE FROM THE '327 PATENT

A. The Three Surface-Related Terms

Claim Language	Rembrandt's Proposed Construction	JVVC's Proposed Construction ¹
1. A hydrophilic soft gas permeable contact lens comprised of a polymerization product of a composition comprising a polymerizable vinylic siloxane monomer and a hydrophilic vinylic monomer, and having at least 25% water by weight and characterized by high oxygen permeability, softness, rebound elasticity and a high degree of clinical performance, said lens comprising a hydrophilic lens body and a tear-wettable	<u>hydrophilic lens body means:</u>	<u>hydrophilic lens body means:</u>

¹ JVVC'S constructions are underlined to show the extent that they differ from Rembrandt's proposed constructions and this Court's previous constructions.

Claim Language	Rembrandt's Proposed Construction	JVVC's Proposed Construction ¹
<p>surface layer integral therewith, said lens body being comprised of said polymerization product and said tear-wettable surface layer being comprised of polymeric material containing hydroxy acrylic monomer units, and wherein the proportion of hydroxy acrylic monomer units to silicon units in said tear-wettable surface layer is greater than that of said lens body.</p>	<p>A lens body, which is the interior core portion of a contact lens, having an affinity for and capable of absorbing water.</p>	<p>A lens body, which is the interior core portion of a contact lens formed prior to treating the surface, having an affinity for and capable of absorbing water.</p>

Claim Language	Rembrandt's Proposed	JVVC's Proposed
	Construction	Construction¹
	surface layer means:	surface layer means:
	A layer beginning from, and including, the outermost surface and moving inward to an arbitrary depth of the lens, and having a different composition from the "body" portion of the lens.	A layer formed after, and as a result of treating the surface of the "body" portion of the lens, beginning from and including the outermost surface of the lens and having a different composition from the "body" portion of the lens.
	The phrase "wherein the proportion of hydroxyl acrylic monomer units to silicon units in said tear-wettable surface layer is greater than	The phrase "wherein the proportion of hydroxyl acrylic monomer units to silicon units in said tear-wettable surface layer is greater than

Claim Language	Rembrandt's Proposed Construction	JVVC's Proposed Construction¹
	that of said lens body” means:	that of said lens body” means:
	The proportion of hydroxyl acrylic monomer units to silicon units is higher in the tear-wettable surface layer than in the lens body.	The proportion of hydroxyl acrylic monomer units to silicon units is, after treating the surface of the lens body, higher in the tear-wettable surface layer than in the lens body.

The only material dispute² between the parties regarding the three surface-related terms shown in the

² The only other minor dispute is that for the “surface layer” term, JVVC uses the language “beginning from and including the outermost surface of the lens” instead of the language used in Rembrandt’s proposed construction and this Court’s previous construction, which reads “beginning from, and including, the outermost surface and moving inward to an arbitrary depth of the lens.” The Court rejects the language proposed by JVVC. The language proposed by Rembrandt, which is the language used by this Court in its previous construction, has support in the intrinsic record.

table above is whether the Court's claim construction of these terms should include the limitation that there must be surface treatment after the lens body formation. To understand the dispute, it is important to generally understand the subject of the '327 Patent. At a high level, the '327 Patent discloses an invention of an allegedly novel soft gas permeable contact lens. The claims of the '327 Patent include claims 1-6, which claim an actual "contact lens" and are therefore product claims. '327 Patent, 8:2-33. Claims 7-14, on the other hand, claim a method for creating a contact lens and are method claims. *Id.* at 8:34-10-4. The terms in dispute in this claim construction relate to terms in the product claims.

With respect to the product claims, for example claim 1, it is undisputed between the parties that the contact lens has two important and distinct structures: (1) a contact lens body and (2) a surface layer of the contact lens. Still speaking broadly and at a high level, it is also undisputed that the surface layer of the contact lens has different properties than the body of the contact lens. Indeed, the unique surface on the lens was touted in the specification as part of the reason for achieving the principal object of the invention. *See id.* at 2:1-21. The parties' dispute begins, however, when JJVC seeks to require the limitation that the contact lens in claim 1 (*i.e.*, the product claim) be created according to the method disclosed in the specification. That is, JJVC seeks to require the contact lens surface be formed by a surface treatment method after the contact lens body is formed. Furthermore, although JJVC describes the additional limitation as a single limitation, in reality it is two

limitations: (1) the surface layer must be formed by *surface treatment* and (2) the surface treatment must be performed *after* the contact lens body is formed. Although generally a claimed product is not limited by the process it was made, exceptions may arise, for example, when the product's distinction from the prior art depends on how it was produced. *Vanguard Prod. Corp. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372-73 (Fed. Cir. 2000); *AFG Indus., Inc. v. Cardinal IG Co., Inc.*, 224 Fed. Appx. 956, 958-59 (Fed. Cir. 2007).

The three surface-related terms in dispute are: (1) “hydrophilic lens body”; (2) “surface layer”; and (3) “wherein the proportion of hydroxyl acrylic monomer units to silicon units in said tear-wettable surface layer is greater than that of said lens body.” This Court has construed these three terms in a claim construction in a previous case. *See Rembrandt Vision Tech., L.P. v. Bausch & Lomb, Inc.*, Civ. No. 2:05-cv-491-TJW, 2007 U.S. Dist. LEXIS 36919, 2007 WL 1481811 (E.D. Tex. May 21, 2007) (Ward, J.). Rembrandt's proposed construction of the three terms is identical to this Court's previous construction of the terms. JJVC's proposed constructions, on the other hand, seek to add language to the Court's prior constructions that is premised on the Court accepting JJVC's argument that the surface layer is limited to a surface layer formed by surface treatment after the contact lens body is formed. If the Court accepts JJVC's argument, then it should adopt all three of JJVC's proposed constructions because all three are essentially premised on the same issue. Because the issue raised by JJVC in this case was not presented to the Court in the previous case, the

Court addresses it now. *See Burns, Morriss & Stewart Ltd. P'ship v. Masonite Int'l Corp.*, 401 F. Supp. 2d 692, 697 (E.D. Tex. 2005) (describing that although a previous construction may be instructive and provide the basis of the analysis, particularly when there are new parties and those parties have presented new arguments, the previous construction is not binding on the Court).

1. *The Parties' Construction Arguments*

JJVC spends over half of its claim construction brief arguing why the product claims require the limitation that the lens be surface treated after the lens body is formed. JJVC argues that the patentee disclaimed all lenses created by any other method. (Dkt. No. 55, at 10.) First, JJVC argues that the specification is clear that surface treatment is required after the lens body is formed. The specification states that “the SGP [soft gas permeable] lens of the invention is made from the known SGP lens compositions and, after lens formation, the lens is then treated to provide its surface a proportion of HAM [hydroxyl acrylic monomer] units to silicon units. . . .” ‘327 Patent, 4:38-42. The specification makes similar statements in other places. In addition, JJVC points out that the specification describes no other method to create the contact lens, and the five embodiments of the invention all use the same method.

Second, JJVC argues that the original prosecution history confirms that the patentee disclaimed all other methods of creating the product except for surface treatment after the lens body formation. For example, the patentee stated in prosecution history that “[a]pplicants’ invention effects a treatment of such

lenses so that they present a surface layer . . .” (Apr. 24, 1992 Response to Mar. 26, 1992 Office Action, at 7, attached as Ex. 2 to Dkt. No. 55, at REMJJ073687.) There are other similar statements in prosecution history. Furthermore, at one point in prosecution, the patent examiner imposed a restriction requirement because “[i]n the instant case the product can be prepared by another and materially different process” and the examiner required the patentee to make an election. (Mar. 8, 1993 Office Action, at 2, attached as Ex. 3A of Dkt. No. 55.) The patentee responded and elected the process claims but traversed the restriction requirement because “no basis exists for the Examiner’s assertion that the claimed contact lens product . . . can be made from any other materially different process than that set forth in the process claims.” (Apr. 15, 1993 Response to Mar. 8, 1993 Office Action, at 2, attached as Ex. 3B, Dkt. No. 55.)

Finally, JJVC argues that in Reexamination Rembrandt reiterated that the product claims “require” surface treatment. For example, in Reexamination, Rembrandt stated:

Thus, based on the state of the art in 1979, neither using a hydrophilic silicone hydrogel lens body nor treating the surface of such a lens body with a HAM would have been suggested to the skilled artisan. Both of these characteristics are required by Changs’ claims (*see, e.g.*, claim 1).

(Mar. 2, 2009 Reexamination Response to Office Action, at 14, attached as Ex. 4B to Dkt. No. 55.)

Rembrandt's response can be briefly described as arguing that the neither the specification nor prosecution history show a clear disclaimer as required by Federal Circuit law.

2. *Analysis*

The Court does not find a disclaimer and agrees with Rembrandt to adopt the same constructions that this Court adopted in its prior construction. The Federal Circuit has cautioned that "limitations appearing in the specification will not be read into claims, and . . . interpreting what is meant by a word in a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989)) (internal quotes omitted). "Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated clear intention to limit the claim scope using 'words or expressions of manifest exclusion or restriction.'" *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (quoting *Teleflex* at 1327). Regarding prosecution history, to be a disclaimer, the statement in prosecution history must be clear and unambiguous and constitute a clear disavowal of the scope. *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306 (Fed. Cir. 2007). In addition, the prosecution history is often less informative than the specification. *Phillips*, 415 F.3d at 1315. Finally, "[a] novel product that meets the criteria of patentability is

not limited to the process by which it was made.”
Vanguard, 234 F.3d at 1372.

First, the specification contains no clear intention to limit the product claim scope to lenses created with a surface treatment process after the lens body formation. While the specification describes no other method or embodiment, Federal Circuit law is clear that this is not enough to find a disclaimer. Furthermore, JJVC’s argument on page 14 of its brief that “the specification repeatedly disparages prior art SGP lenses whose surfaces have not been treated” is a misleading attempt to find a disclaimer by mixing attorney argument with pieces of quotes. (Dkt. No. 55, at 14.) Nowhere in the specification does the patentee criticize prior art lenses for the lack of the surface treatment step. The most that can be said is that the patentee criticized prior art lenses for lacking the *surface layer* of the ‘327 Patent lens, but that is much different than criticizing other prior art lenses for lacking *the step of surface treatment after lens body formation*—the latter being the limitation JJVC seeks to impose. In addition, the “summary of the invention” section of the ‘327 Patent describes that the “principal object of the invention” is achieved by the lens itself, which contains a unique surface layer, but not *the method* of creating that surface layer. See ‘27 Patent, 2:7-20. Then, after describing the novel lens that constitutes the invention, the ‘327 Patent states that the surface layer “*can be attained by surface treatment.*” *Id.* at 22-23 (emphasis added).

Second, there is no clear and unambiguous disavowal of the claim scope in the prosecution history. The hand-picked quotes that JJVC argues are disclaimers in the

prosecution history are ambiguous at best. Insofar as JJVC's argument regarding the Examiner's restriction requirement is concerned, the patentee's statements relating to the restriction are also ambiguous at most. M.P.E.P. 806.05(f) describes that the Examiner may enter a restriction requirement when "the process as claimed can be used to make another materially different product." After the Examiner entered the restriction requirement, the patentee only noted, when traversing the restriction requirements, that the Examiner has presented no reason (*i.e.*, no basis) for the product vs. process restriction requirement. (*See* Apr. 15, 1993 Response to Mar. 8, 1993 Office Action, at 2, attached as Ex. 3B, Dkt. No. 55 ("*N*]o basis exists for the Examiner's assertion that the claimed contact lens product . . . can be made from any other materially different process than that set forth in the process claims.") (emphasis added).) In addition, the patentee never technically agreed that the product and process claims were the same in order to withdraw the restriction requirement; instead, the patentee only agreed "that if the Examiner finds one of the inventions unpatentable over the prior art, such finding or evidence may be used in a rejection under 35 U.S.C. § 103 of the other invention." (Nov. 30, 1994 Response to Aug. 18, 1994 Office Action, at 1, attached as Ex. 3C to Dkt. No. 55.) In other words, the patentee agreed that the Examiner would not have to expend twice as much work for the issuance one patent, that is, if the product claim is found to be obvious then the Examiner could therefore find the process claim to be obvious. *See* M.P.E.P. 803 Restriction—When Proper ("If the search and examination of all the claims in an application can be

made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”).

Rather than supporting an intentional disclaimer, the prosecution history has support that the patentee believed his “invention” was the contact lens itself (*i.e.*, the product), and not only the method to create the contact lens. At one point in the original prosecution history, the patentee states:

In claiming the **novel lens** (*see, e.g.*, Claim 20 [which was issued as current Claim 1]), it is to be recognized that the entire lens per se is a hydrophilic SGP-type lens, *i.e.*, being comprised of a polymerization product of a composition comprising polymerizable vinylic siloxane monomer and hydrophilic vinylic monomer, and have a water content of 25% by weight or greater. The overall lens can be considered as comprised of a “body” portion and a “surface layer” which surrounds and is integral with the body portion. The body portion is comprised of the earlier-mentioned polymerization product when is characteristic of a hydrophilic SGP lens, such that the overall lens is seen to be a hydrophilic SGP lens. **In distinction from the prior art, the composition of the surface layer differs from that of the lens body portion** in that it contains a higher hydroxyl acrylic monomer unit to silicon unit ratio or proportion than exists in the body portion. For reasons noted above, **this renders the surface layer more tear-wettable and**

brings about the improvement in clinical performance.

(Apr. 24, 1992 Response to Mar. 26, 1992 Office Action, at 7-8, attached as Ex. 2 to Dkt. No. 55 (bold emphasis added, underline in original).) In the above quote, the patentee makes clear that it is the lens itself, not the method of creating the lens, that is novel. Furthermore, the patentee distinguishes the prior art on the basis that the '327 Patent lens has a unique surface layer—not that the surface layer is created from a surface treatment after the lens body is created. Therefore, it would be improper to add limitations from the method into the product claim because it was the product itself that was novel—not just the method. Of course, later in that same piece of prosecution history, the patentee states that “applicants’ treatment of the basic hydrophilic SGP lens has the result that the composition of the surface of the lens is altered relative to the rest of the lens.” (*Id.*) JJVC’s reliance on statements such as this, taken out of context, is insufficient to show a clear and unambiguous disclaimer. This statement can easily be read as the patentee only stating that the patentee’s surface treatment method can result in the novel contact lens that it claims in its product claim. In any event, even if surface treatment of the lens after the lens body is created is the only method the patentee knew that would create the product the patentee claimed, the patentee’s product claim can still cover products created by later discovered methods so long as those products fall within the scope of the patentee’s product claims. See *Innogenetics, N.W. v. Abbott Labs.*, 512 F.3d 1363, 1370-71 (Fed. Cir. 2008) (“Our case law allows for after-arising

technology to be captured within the literal scope of valid claims that are drafted broadly enough.”).

Additionally, there is no clear and unambiguous disclaimer in the prosecution history created in Reexamination. As JJVC notes, the patentee did state:

Thus, based on the state of the art in 1979, neither using a hydrophilic silicone hydrogel lens body nor treating the surface of such a lens body with a HAM would have been suggested to the skilled artisan. Both of these characteristics are required by Changs’ claims (*see, e.g.*, claim 1).

(Mar. 2, 2009 Reexamination Response to Office Action, at 14, attached as Ex. 4B to Dkt. No. 55.) This statement is also not an unambiguous disclaimer. This statement is partially taken out of context. The previous sentence discusses how Peyman (prior art) discouraged the use of “hydrogel lens bodies” and “HAM units to coat the surface.” *Id.* Given this context, the quote pointed out above by JJVC could be read as stating that these “characteristics” (*i.e.*, the “hydrogel lens bodies” and “HAM units to coat the surface” discouraged by Peyman) are required by Changs’ claims, including claim 1. But it is undisputed by Rembrandt that the claims may require a surface layer of HAM units. This is different, however, than requiring that surface layer to be formed by surface treatment after the contact lens body is formed.

Finally, although JJVC describes its proposed additional limitation as a single limitation, in reality it is two limitations: (1) the surface layer must be formed by *surface treatment* and (2) the surface treatment must be

performed *after* the contact lens body is formed. Most of JJVC's argument and support is based on statements merely stating that "surface treatment" may be a required step. There is even less support, however, for the limitation that this surface treatment must be performed *after* the contact lens body is formed. Therefore, even if the Court found that the patentee disclaimed all other methods besides a lens created by surface treatment, which it does not, the Court still would not necessarily find that this step must be performed *after* the contact lens body was formed.

In conclusion, the Court agrees with Rembrandt and adopts the following constructions:

- o "hydrophilic lens body" is construed as "a lens body, which is the interior core portion of a contact lens, having an affinity for and capable of absorbing water."

- o "surface layer" is construed as "a layer beginning from, and including, the outermost surface and moving inward to an arbitrary depth of the lens, and having a different composition from the 'body' portion of the lens."

- o The phrase "wherein the proportion of hydroxyl acrylic monomer units to silicon units in said tear-wettable surface layer is greater than that of said lens body" is construed as "*the proportion of hydroxyl acrylic monomer units to silicon units is higher in the tear-wettable surface layer than in the lens body.*"

B. “High Oxygen Permeability”

Claim Language	Rembrandt’s Proposed Construction	JVVC’s Proposed Construction
<p>1. A hydrophilic soft gas permeable contact lens comprised of a polymerization product of a composition comprising a polymerizable vinylic siloxane monomer and a hydrophilic vinylic monomer, and having at least 25% water by weight and characterized by <i>high oxygen permeability</i>, softness, rebound elasticity and a high degree of clinical performance, said lens comprising a hydrophilic lens body and a tear-wettable surface layer integral therewith, said lens body being comprised of said polymerization product and said tear-wettable surface layer</p>	<p>high oxygen permeability means:</p>	<p>high oxygen permeability means:</p>

Claim Language	Rembrandt's Proposed	JVVC's Proposed
	Construction	Construction
<p>being comprised of polymeric material containing hydroxy acrylic monomer units, and wherein the proportion of hydroxy acrylic monomer units to silicon units in said tear-wettable surface layer is greater than that of said lens body.</p>	<p>Having an oxygen permeability of about 25 barriers and higher and in no event does</p>	<p>Having an oxygen permeability of about 4 to 5 times higher than that of the conventional</p>

Claim Language	Rembrandt's Proposed	JVVC's Proposed
	Construction	Construction
	this term require a Dk measurement of more than about 32 barriers.	poly HEMA soft lens.

This Court did not construe the term “high oxygen permeability” in the previous claim construction. Rembrandt seeks a construction that reads “having an oxygen permeability of about 25 barriers and higher and in no event does this term require a Dk measurement of more than about 32 barriers.” JJVC seeks a construction that reads “having an oxygen permeability of about 4 to 5 times higher than that of the conventional poly HEMA soft lens.” The Court construes the phrase similar to Rembrandt’s construction but excludes the latter half of Rembrandt’s construction because it is unnecessary. The term “high oxygen permeability” is construed to be “having an oxygen permeability of 25 barriers or higher.”

1. *The Parties’ Construction Arguments*

JJVC argues that the ‘327 Patent defined “high oxygen permeability” when it stated that “[t]he lens thus made has high DK, about 4 to 5 times higher than that of the conventional poly HEMA soft lens.” ‘327 Patent, 6:21-22. The term DK is used synonymously with permeability to oxygen in the art. *See id.* at 1:19-21

(stating one property of contact lenses is their “permeability to oxygen (commonly referred to as DK”). Therefore, JJVC argues that its proposed construction is correct because it tracks the definition in the specification.

Rembrandt disagrees that the ‘327 Patent was defining “high oxygen permeability” when it stated that “[t]he lens thus made has high DK, about 4 to 5 times higher than that of the conventional poly HEMA soft lens.” *Id.* at 6:21-22. Instead, Rembrandt argues that “high oxygen permeability” should be defined by considering the types of lenses the ‘327 Patent considered to have high oxygen permeability. In the background of the ‘327 Patent, the patent mentioned several prior art lenses that contained “excellent oxygen permeability.” *Id.* at 1:62-63. One of these was U.S. Patent No. 7,711,943 (‘943 Patent). The ‘943 Patent described a contact lens material having “high oxygen permeability” with a DK of at least 25 barriers. ‘943 Patent, 3:53-57; 41:2-3. Therefore, Rembrandt argues this should be low end of the “high oxygen permeability” range.

2. *Analysis*

The ‘327 Patent was not defining the term “high oxygen permeability” when it stated “[t]he lens thus made has high DK, about 4 to 5 times higher than that of the conventional poly HEMA soft lens.” ‘327 Patent, 6:21-22. At most, the patent was only stating that the example it was discussing had a high oxygen permeability because it had a DK 4 to 5 times higher than a conventional HEMA soft lens. This only means a lens having a DK of 4 to 5 times higher than a

conventional poly HEMA soft lens is definitely considered to have “high oxygen permeability,” according to the ‘327 Patent. This does not mean, however, that the term “high oxygen permeability” is limited to those lenses with a DK range of 4 to 5 times higher than a conventional HEMA soft lens. Therefore, the Court rejects JJVC’s proposed construction as it potentially adds a limitation that is not required by the ‘327 Patent. In addition, JJVC’s proposed construction is problematic because it invites additional argument at trial regarding the DK value of a conventional poly HEMA soft lens because JJVC’s proposed construction is dependent on that value. It appears from the briefing the parties disagree on the DK value of a conventional poly HEMA soft lens, so JJVC’s construction would not provide a clear meaning of “high oxygen permeability” and the jury would have to decide who to believe regarding the proper DK value of a conventional poly HEMA soft lens (*i.e.*, the jury would essentially be partaking a task similar to claim construction). Determining the meaning of the claim terms, however, is the duty of the Court, not the jury.

Rembrandt’s construction, on the other hand, provides a clearer construction, and the construction is supported by the specification of the ‘327 Patent. The term “high oxygen permeability” is obviously a relative term and indicates a likely range of values that would be considered “high.” Rembrandt’s construction provides a clear floor to that range—25 barriers. Above the Court criticized JJVC’s construction for providing an unnecessary limitation to the term “high oxygen permeability.” Although Rembrandt’s proposed

construction also adds a strict limitation to the phrase, this limitation has support in the specification and the parties at least agree³ that the lower limit of the range should not be lower than 25 barriers. As Rembrandt points out, the ‘327 Patent lists several prior art SGP lenses that had high oxygen permeability.⁴ As discussed above, the ‘943 Patent is one of the prior art lenses listed, and the ‘943 Patent described a lens with “high oxygen permeability” with a DK of 25 barriers. ‘943 Patent, 3:53-57; 41:2-3. The ‘327 Patent specification agreed that this prior art lens had a high oxygen permeability. Therefore, the term “high oxygen permeability” should have a lower limit of no higher than 25 barriers because if not, such a definition would exclude an exemplar lens that the ‘327 Patent described as having high oxygen permeability. Because the parties do not argue the range

³ JJVC does not agree to Rembrandt’s construction; however, JJVC argues the lower end of the “high oxygen permeability” range should be higher than 25 barriers, so JJVC would undoubtedly agree that the lower end of the range should *not be lower than 25* barriers.

⁴ Although the ‘327 Patent explicitly states that those lenses had “excellent oxygen permeability,” it is clear that the patentee used the words “high oxygen permeability” to include those lenses with “excellent oxygen permeability.” ‘327 Patent, 1:55-2:7. This is clear because the paragraph where the ‘327 Patent discusses the prior art SGP lenses with “excellent oxygen permeability” is followed by the next paragraph that discusses how the ‘327 Patent lens is an improvement over the prior art SGP lenses because it “not only possess[es] a high degree of oxygen permeability” but also includes other advantageous features. *Id.* Thus, the ‘327 Patent is implying in this second paragraph that the SGP lenses in the previous paragraph had “a high degree of oxygen permeability.” *Id.*

should be any lower, the Court will allow the lower limit of the range to be 25 barriers. On the other hand, there is no clear limitation in the specification of an upper limit to the term “high oxygen permeability,” so the Court leaves the upper limit open-ended.

The latter portion of Rembrandt’s proposed construction that reads “in no event does this term require a Dk measurement of more than about 32 barriers” is unnecessary. Because the first part of the construction identifies a lower limit but has no upper limit for the range of “high oxygen permeability,” there is no need to point out that the term does not require a measurement of more than 32 barriers. Therefore, the term “high oxygen permeability” is construed as “*having an oxygen permeability of 25 barriers or higher.*”

C. “Hydrophilic”

There is some dispute regarding whether the term “hydrophilic” should be construed. Rembrandt argues the term should mean “having an affinity for and capable of absorbing water.” JJVC argues that construction is not necessary because the term “hydrophilic” is subsumed in the term “hydrophilic lens body,” and the Court’s construction of “hydrophilic lens body” should provide sufficient context for the term “hydrophilic.” JJVC does not dispute the accuracy of Rembrandt’s proposed construction of “hydrophilic”—JJVC only argues that it is unnecessary. In this Court’s previous construction, it did not construe “hydrophilic” independently. *Rembrandt*, 2007 U.S. Dist. LEXIS 36919, 2007 WL 1481811, at *4-5. But it is undisputed that Rembrandt’s proposed construction is at least

accurate, therefore, the Court adopts Rembrandt's construction of "hydrophilic" to be "*having an affinity for and capable of absorbing water.*"

D. Claim 7 Terms

Rembrandt asks the Court to construe terms appearing in claim 7. As JJVC correctly points out, Rembrandt has never asserted that claim against JJVC and so the Court should not construe them because the claim is not in controversy. The Federal Circuit has held that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy." *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). The Court refuses to construe the disputed terms of claim 7 because claim 7 is not asserted at this time.

IV. CONCLUSION

The Court adopts the constructions set forth in this opinion for the disputed terms of the '327 Patent. The parties are ordered that they may not refer, directly or indirectly, to each other's claim construction positions in the presence of the jury. Likewise, the parties are ordered to refrain from mentioning any portion of this opinion, other than the actual definitions adopted by the Court, in the presence of the jury. Any reference to claim construction proceedings is limited to informing the jury of the definitions adopted by the Court.

It is so ORDERED.

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SIGNED this 28th day of April, 2011.

/s/ T. John Ward

T. JOHN WARD

UNITED STATES DISTRICT COURT

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Appendix F

**United States Court of Appeals
For the Federal Circuit**

REMBRANDT VISION TECHNOLOGIES, L.P.,
Plaintiff-Appellant

v.

JOHNSON & JOHNSON VISION CARE, INC.,
Defendant-Appellee

2015-1079

Appeal from the United States District Court for the
Middle District of Florida in No. 3:11-cv-00819-TJC-JRK,
Judge Timothy J. Corrigan.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO,
CHEN, HUGHES and, STOLL, *Circuit Judges*.

PER CURIAM

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ORDER

Appellee Johnson & Johnson Vision Care, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on July 18, 2016.

FOR THE COURT

July 11, 2016

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court