

NOTE: This order is nonprecedential.

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

**In re: AFFYMETRIX, INC., LIFE TECHNOLOGIES
CORPORATION,**
Petitioners

2019-104

On Petition for Writ of Mandamus to the United States District Court for the Southern District of California in No. 3:17-cv-01394-H-NLS, Judge Marilyn L. Huff.

ON PETITION AND ON MOTION

Before LOURIE, WALLACH, and CHEN, *Circuit Judges*.
WALLACH, *Circuit Judge*.

O R D E R

Affymetrix, Inc. and Life Technologies Corporation (collectively, “Affymetrix”) petition this court for a writ of mandamus to direct the United States District Court for the Southern District of California to vacate its October 9, 2018 order compelling the production of documents Affymetrix considers privileged. Becton, Dickinson and Company et al. (collectively, “BD”) oppose. We may consider the petition pursuant to 28 U.S.C. § 1295(a)(1)

and 28 U.S.C. § 1651(a). We deny the petition and therefore deny Affymetrix's motion to stay production.

BD sued Affymetrix in the Southern District of California, alleging that Affymetrix's "Super Bright" dyes product infringes BD's patents.* Affymetrix worked with third-party AAT Bioquest to design and manufacture the dyes pursuant to a supply and license agreement. As relevant here, BD sought discovery of various email communications between Affymetrix's employees, Affymetrix's in-house counsel, and AAT's leadership after the effective date of the agreement. The district court ordered production of those documents by October 23, 2018. In doing so, the district court rejected Affymetrix's assertion that the common interest privilege applied even though AAT was not represented by counsel at the time of the communications. Affymetrix then filed this petition and moved to stay production of the documents. On October 29, 2018, this court temporarily stayed the production order pending consideration of Affymetrix's mandamus petition and stay motion.

"The remedy of mandamus is available only in extraordinary situations to correct a clear abuse of discretion or usurpation of judicial power." *In re MSTG, Inc.*, 675 F.3d 1337, 1341 (Fed. Cir. 2012). A party seeking a writ bears the heavy burden of demonstrating to the court that it has no "adequate alternative means" to obtain the desired relief, *Mallard v. U.S. Dist. Court for the S. Dist. of Iowa*, 490 U.S. 296, 309 (1989), and that the right to issuance of the writ is "clear and indisputable," *Will v. Calvert Fire Ins. Co.*, 437 U.S. 655, 666 (1978) (internal quotation marks omitted). And even when those two requirements are met, the court must still be satisfied that the issuance of "the writ is appropriate under the circumstances." *Cheney v. U.S. Dist. Court for the Dist. of*

* The dyes are fluorescent dyes used in flow cytometry, a technique for analyzing biological cells.

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Columbia, 542 U.S. 367, 381 (2004). We cannot say that exacting standard has been met by Affymetrix.

Affymetrix has not made a sufficient showing that it lacks adequate alternative means to obtain the desired relief. The Supreme Court has explained that “postjudgment appeals generally suffice to protect the rights of litigants and ensure the vitality of the attorney-client privilege” because an appellate court can vacate and remand “for a new trial in which the protected material and its fruits are excluded from evidence.” *Mohawk Indus., Inc. v. Carpenter*, 558 U.S. 100, 109 (2009); see also *Waymo LLC v. Uber Techs., Inc.*, 870 F.3d 1350, 1358–59 (Fed. Cir. 2017) (denying mandamus review of order compelling production of allegedly privileged documents because petitioner could appeal after final judgment). Affymetrix fails to specify why such review would not suffice in this case or why applying the final judgment rule here would be particularly injurious.

Affymetrix has also failed to show a “clear and indisputable” right to relief. *Calvert Fire Ins. Co.*, 437 U.S. at 666 (internal quotation marks omitted). Ninth Circuit law applies when determining whether the district court erred in its privilege determination. See *Waymo*, 870 F.3d at 1359. Affymetrix, however, admits that no Ninth Circuit decision has held that the common interest doctrine is applicable when one of the parties is not represented by counsel. The district court meanwhile noted that the Ninth Circuit has said that the common interest rule “is an exception to ordinary waiver rules designed to allow attorneys for different clients pursuing a common legal strategy to communicate with each other,” *In re Pac. Pictures Corp.*, 679 F.3d 1121, 1129 (9th Cir. 2012), and identified a number of other district court cases from the Ninth Circuit that have held that all parties must be represented by counsel for the common interest doctrine to apply.

Accordingly,

IT IS ORDERED THAT:

(1) The petition for a writ of mandamus is denied.

(2) The stay motion is denied as moot. The temporary stay put in place by the court's October 29, 2018 order is lifted. Affymetrix shall produce the documents within three days of the date of filing of this order.

FOR THE COURT

Nov. 29, 2018

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court

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