

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES—GENERAL

Case No. CV-11-10122 MWF (PLAx)

Date: January 4, 2013

Title: Uniloc Luxembourg S.A. v. Compulink Business Systems, Inc. et al.

Present: The Honorable MICHAEL W. FITZGERALD , U.S. DISTRICT JUDGE

<u>Rita Sanchez</u>	<u>Not Reported</u>	<u>N/A</u>
Deputy Clerk	Court Reporter/Recorder	Tape No.

Attorneys Present for Plaintiff:
Not Present

Attorneys Present for Defendants:
Not Present

Proceedings (In Chambers): ORDER DENYING MOTION TO COMPEL DEFENDANTS TO COMPLY WITH PRETRIAL ORDER REGARDING INVALIDITY CONTENTIONS [70]

This matter is before the Court on Plaintiff’s Motion to Compel Defendants to Comply with Pretrial Order Regarding Invalidation Contentions. (Docket No. 70). The Court has read and considered the parties’ submissions and deems the matter appropriate for decision without oral argument. *See* Fed. R. Civ. P. 78(b); Local Rule 7-15. Accordingly, the hearing scheduled for January 7, 2013, is removed from the Court’s calendar. For the reasons that follow, the Motion is DENIED.

Plaintiff Uniloc Luxembourg S.A. (“Uniloc”) seeks an order compelling Defendants to comply with the Court’s June 25, 2012 Order requiring that Defendants serve invalidity contentions on October 22, 2012. (Docket No. 24). It is undisputed that Defendants served invalidity contentions. (Mot. at 1). Uniloc argues, however, that Defendants’ invalidity contentions do not comply with the Court’s Order and fail to provide Uniloc with sufficient notice as to Defendants’ contentions.

The Court’s June 25, 2012 Order does not require Defendants to create the specific charts that Uniloc seeks. Although Uniloc describes invalidity contention charts as “customary” and cites local rules of other districts, no order, local rule of this district, or stipulation applicable to this matter compels that format. Indeed, Uniloc concedes that the Court did not prescribe any particular format for

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Defendants' contentions. (Mot. at 4). In light of this, the Court finds that the 65-page document Defendants served sufficiently complies with the Court's Order and substantively lists prior art and the asserted claims the prior art allegedly invalidates. (Ex. A to Huang Decl., Docket No. 70-3). The Court notes that cases concerning the requirements for proving invalidity do not govern the standard for initially contending invalidity in the absence of an order to the contrary.

However, whether Defendants' choice of format sufficiently puts Uniloc on notice as to the individual elements of each claim invalidated by the prior art such that Defendants can rely on a specific combination of references at trial is a matter yet to be decided and Defendants are advised to amend and supplement their contentions as discovery advances. *See, e.g., Avocent Redmond Corp. v. Rose Electronics*, 2012 WL 2921851, at *1 (W.D. Wash. July 6, 2012) ("The fact that defendants identified all four references somewhere in their invalidity contentions (or in the voluminous appendices to the invalidity contentions) is not sufficient to put plaintiff on notice that these combinations, as opposed to any or all other potential combinations, would be pursued at trial to invalidate a particular claim.").

In the Court's prior experience with patent cases (admittedly limited), the parties either stipulated to the follow the Patent Local Rules of the Northern District of California or simply chose to do so. Therefore, the Court is familiar with contentions being presented in the form of a chart. Perhaps the Court should issue a special patent standing order to require a chart, but has not done so yet.

Accordingly, the Motion is DENIED.

IT IS SO ORDERED.