

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

**General Mills Marketing, Inc., General
Mills Operations, LLC, and General
Mills, Inc.,**

Civil No. 11-2099 (PJS/JJG)

Plaintiffs,

v.

O R D E R

**Fritsch GmbH, Fritsch USA, Inc., Rich
Products Corporation, The New French
Bakery, Inc., Il Fornaio (America)
Corporation, Bridor USA, Inc., and
Aryzta LLC,**

Defendants.

JEANNE J. GRAHAM, United States Magistrate Judge

This is a patent infringement action involving blunt-edge dough-cutting technology. Plaintiffs General Mills Marketing, Inc., General Mills Operations, LLC, and General Mills, Inc. (collectively, “Plaintiffs”) allege that Defendants Fritsch GmbH, Fritsch USA, Inc., Rich Products Corporation, The New French Bakery, Inc., Il Fornaio (America) Corporation, Bridor USA, Inc., and Aryzta LLC (collectively, “Defendants”) infringe one or more claims of Plaintiffs’ U.S. Patent No. 6,902,754 (“the ’754 patent”). The case is presently before the Court on Defendants’ Motion for Leave to Amend Prior Art Statement (ECF No. 250) and Defendant Bridor USA, Inc.’s Motion for Protective Order (ECF No. 261). For the reasons set forth below, the Court grants the first motion and denies the second.

I. Defendants' Motion for Leave to Amend Prior Art Statement

Defendants timely produced a prior art statement to Plaintiffs on November 1, 2013. The prior art statement contained 154 references. On November 13, 2013, the parties exchanged lists of claim terms for construction, and on November 22, 2013, they exchanged preliminary proposed constructions and supporting evidence. A few days later, on November 26, 2013, Defendants notified Plaintiffs of nine additional prior art references. Plaintiffs objected to the late disclosure, and Defendants filed a motion to amend the prior art statement on December 4, 2013.

The Amended Pretrial Scheduling Order provides that a party may add prior art to its original prior art statement only with leave of the Court. (Order at 6, Aug. 30, 2013, ECF No. 200.) To obtain leave to amend, Defendants must show: (1) the additional references were not and could not reasonably have been identified earlier; (2) the additional references are not cumulative of other references in the existing prior art statement; and (3) the balance of prejudice favors Defendants. *Polaris Indus., Inc. v. CFMOTO Powersports, Inc.*, No. 10-4362 (JNE/JJG), slip op. at 4 (D. Minn. Feb. 27, 2012) (citing *FLOE Int'l Inc. v. Newmans' Mfg. Inc.*, Civ. No. 04-5120 (DWF/RLE), 2005 WL 6218040, at *2 (D. Minn. Nov. 9, 2005); *Multi-Tech Sys., Inc. v. Dialpad.com, Inc.*, Civ. No. 00-1540 (ADM/RLE), 2002 WL 27141, at *3 (D. Minn. Jan. 8, 2002)).

A. Earlier Discovery of the Prior Art

The first factor relates to a party's diligence, *id.*, and Defendants bear the burden to establish it, *O2 Micro International Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355, 1366 (Fed. Cir. 2006). Defendants assert they have been searching diligently for and reviewing prior art references since the litigation was commenced, but that the relevant technology is extensive and dates back more than 100 years. Defendants further assert they have acted diligently in

notifying Plaintiffs of the new references and filing the motion to amend. Once Defendants discovered the additional prior art, they notified Plaintiffs, prepared claim charts, produced the new references to Plaintiffs, and filed the instant motion, all in less than a month.

While the timing of the disclosure admittedly was not ideal, occurring after the parties had exchanged claim construction terms and during Thanksgiving week, it is highly significant that less than a month passed between the original deadline for the prior art statement and Defendants' identification of the nine additional references. Defendants filed their motion to amend only a few days later. The Court would be hard-pressed to justify denying a request to amend made so soon after the original deadline. *Cf. Multi-Tech*, 2002 WL 27141, at *3 (where new references were identified six months late, finding the potential breadth of possible references insufficient to explain the untimely disclosure). Given that Defendants identified the new references so close to the original deadline, the Court will accept their averment that the new references were not and could not reasonably have been identified earlier. Defendants are advised, however, they will face a higher mark in the future should they argue that additional references were not and could not reasonably have been identified earlier.

B. Cumulativeness

Plaintiffs have identified one duplicate proposed prior art reference, Leiby (U.S. Patent No. 3,234,895). Defendants concede the reference itself is cumulative, but they propose to add a detailed explanation of what the prior art shows and how it purportedly invalidates Plaintiffs' claims. In this respect, the Court finds the reference is not cumulative.

As to the other proposed new references, Plaintiffs contend they are excessive. As Plaintiffs concede, however, "[t]here is no bright-line or unequivocal rule as to how many prior art references are allowed in a prior art statement." *Polaris Indus.*, No. 10-4362 (JNE/JJG), slip

op. at 6-7. Where a new reference provides something different from the old references, it is neither cumulative nor excessive. *Id.* at 7. The Court is persuaded that the new references are related to different products and technologies and that each one adds something unique to the prior art statement. The Court thus finds the additional references are not excessive.

C. Prejudice

Plaintiffs argue they will be prejudiced if Defendants are allowed to amend their prior art statement because the parties have already exchanged claim terms and proposed constructions. Defendants counter that any prejudice can be cured by giving Plaintiffs an opportunity to amend their prior art statement and claim construction positions.

No party wants to be the first to reveal its cards, but this does not necessarily result in prejudice. There is ample time remaining under the pretrial schedule to allow Plaintiffs to amend their prior art statement and their claim construction positions. The trial-ready date is more than a year away, and expert reports are not due for months. No claim construction hearing or briefing has been scheduled. Thus, any prejudice to Plaintiffs is minimal. Defendants, on the other hand, risk significant prejudice if they are precluded from using relevant prior art to prove invalidity. On balance, this factor weighs in Defendants' favor.

D. Conclusion

Defendants have met their burden to obtain leave to amend their prior art statement. Defendants must serve their amended prior art statement by Monday, February 3, 2014. Plaintiffs may serve an amended prior art statement by Monday, March 17, 2014. Plaintiffs may amend the positions set forth in the joint claim construction statement by Monday, March 10, 2014.

II. Defendant Bridor USA, Inc.’s Motion for Protective Order

Defendant Bridor USA, Inc. (“Bridor”) moves for a protective order limiting the scope of discovery to Bridor’s use of the accused Fritsch equipment. Bridor contends it was named as a defendant only after Plaintiffs learned it had purchased the Fritsch technology, which is a dough-cutting knife with white plastic disks attached to the side of each cutting wheel. But, according to Bridor, Plaintiffs have known for months that Bridor never actually used the Fritsch equipment to make bread products offered for sale. When Bridor first tested the Fritsch equipment, it was not satisfied with the appearance of the bread and so removed the disks from the cutting mechanism before producing any products for sale. Bridor avers it continues to make its bread products with the modified Fritsch equipment, and it does not use any other bakery equipment resembling the accused technology. Bridor produced a sworn declaration and videorecording confirming these averments. According to Bridor, Plaintiffs have long refused to disclose whether they are asserting infringement based on Bridor’s use of the modified Fritsch equipment or any other non-Fritsch technology, but it is now clear from Plaintiffs’ recent discovery requests that they wish to expand the scope of their claims to any potentially infringing technology.

In response, Plaintiffs confirm that their infringement claims are not limited to the unmodified Fritsch equipment. Plaintiffs also want to discover whether Bridor is infringing the ’754 patent with the modified Fritsch equipment or with non-Fritsch equipment. According to Plaintiffs, the accused technology in this case includes all bakery equipment with blunt-edge dough cutters.

Federal Rule of Civil Procedure 26(c)(1) provides that a court “may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense.” A court has “broad discretion . . . to decide when a protective order is

appropriate and what degree of protection is required.” *Misc. Dkt. Matter #1 v. Misc. Dkt. Matter #2*, 197 F.3d 922, 925 (8th Cir. 1999) (quoting *Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 36 (1984)). For example, the court may forbid discovery, limit the scope of discovery, specify the terms of discovery, or prescribe a discovery method other than that sought by the movant. Fed. R. Civ. P. 26(c)(1)(A)-(D).

Bridor bases its motion for a protective order on relevance. Generally, the scope of relevance for discovery is very broad. A party “may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.” Fed. R. Civ. P. 26(b)(1). This standard is widely recognized as “necessarily broad in scope, in order to allow the parties essentially equal access to the operative facts.” *Archer Daniels Midland Co. v. Aon Risk Servs., Inc.*, 187 F.R.D. 578, 589 (D. Minn. 1999) (citations omitted). The scope of relevance is not without bounds, however. *Id.* As the Eighth Circuit has observed, Rule 26(b)(1)’s standard “should not be misapplied so as to allow fishing expeditions in discovery. Some threshold showing of relevance must be made before parties are required to open wide the doors of discovery and to produce a variety of information which does not reasonably bear upon the issues in the case.” *Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir. 1992).

In the discovery dispute at hand, Bridor asks the Court to limit the scope of discovery to Fritsch’s unmodified technology, while General Mills would expand the scope to any equipment that potentially infringes the ’754 patent. Because the scope of discovery is defined by the claims and defenses asserted in this case, *see* Fed. R. Civ. P. 26(b)(1), the Court begins with the language of the claims asserted in the Amended Complaint.

The Amended Complaint alleges that Bridor “has used or uses bakery equipment and machines purchased from or provided by Fritsch to make bread products that, when used, practice one or more claims of the ’754 patent.” (Am. Compl. ¶ 67, Apr. 5, 2012, ECF No. 43.) This language would seem to limit the accused technology to the equipment that Bridor obtained from Fritsch. However, Plaintiffs further allege that Bridor makes its bread products with “a process that infringes—directly, contributorily, and/or by inducement—one or more claims of the ’754 patent.” (*Id.* ¶ 68.) This description of Bridor’s process does not refer to Fritsch’s technology. Likewise, Plaintiffs later aver that Bridor “us[es] or has used dough cutting and processing technology that infringes one or more of the claims in the ’754 patent.” (*Id.* ¶ 111.) Based on the expansive language used in paragraphs 68 and 111 of the Amended Complaint, the Court finds that Plaintiffs’ infringement claim is not limited to Bridor’s use of the Fritsch equipment. This finding is in accord with authority from this District recognizing that discovery on a product not named explicitly in a complaint should be allowed if the product falls within the confines of a broadly asserted claim. *See AGA Med. Corp. v. W.L. Gore & Assocs., Inc.*, Civ. No. 10-3734 (JNE/JSM), 2011 WL 11023511, at *7 (D. Minn. Oct. 19, 2011).

At the hearing on the motion, Bridor argued vehemently that Plaintiffs had no basis under Federal Rule of Civil Procedure 11 to sue Bridor for infringement based on technology other than the Fritsch equipment. If Bridor believed the claim against it, as alleged in the Amended Complaint, was too broadly stated or lacked a Rule 11 basis, Bridor should have moved for appropriate relief in lieu of answering or pursuant to Rule 11. As the claim stands now, however, it is worded broadly to include not just Fritsch equipment, but any dough-cutting equipment that infringes the ’754 patent.

The Court next considers the language of Plaintiffs' infringement contentions, because the scope of relevance can also extend to "products that are 'reasonably similar' to those accused in a party's preliminary infringement chart." *Id.* Allowing discovery on reasonably similar products "comports with the notice pleading and broad discovery created by the federal rules and the right to develop new information in discovery." *Epicrealm Licensing, LLC v. Autoflex Leasing, Inc.*, No. 2:05-cv-163, 2007 WL 2580969, at *3 (E.D. Tex. Aug. 27, 2007) (*cited in AGA Med. Corp.*, 2011 WL 11023511, at *7).

In Plaintiffs' preliminary infringement claim chart for Bridor, they "accuse Bridor of having used or using dough cutting and processing technology purchased from or provided by Fritsch" (Pls.' Infringement Claim Chart for Bridor at 1, Sept. 30, 2013, ECF No. 264-1.) But Plaintiffs later expand their definition of infringing technology to include

bakery equipment with blunt edge dough cutters *including but not limited to* the type of bakery equipment depicted in Exhibit B of the First Amended Complaint (Dkt. No. 43), any bakery equipment with blunt edge dough cutters manufactured or provided by Fritsch, bakery equipment shown in brochures for Fritsch's LAMINATOR 300, LAMINATOR 3000, and IMPRESSA bread line of machines, and *any other devices that are the same or substantially similar to the above products.*

(*Id.*) (emphasis added). The inclusive language emphasized above brings Bridor's blunt-edge dough-cutting technology within the scope of relevance.

In arguing against an expanded scope of discovery, Bridor relies primarily on authority from the Northern District of California. In *Meidatek, Inc. v. Freescale Semiconductor, Inc.*, the court denied a motion to compel discovery on products not specifically identified as accused products in the party's preliminary infringement contentions ("PICs"), despite the PICs reference to "substantially similar" products. No. 11-5341 YGR (JSC), 2013 WL 588760, at *1 (N.D. Cal. Feb. 13, 2013). The court distinguished between a situation in which the party seeking discovery

does not know about the allegedly infringing products and one in which the party could have identified the products beforehand by examining publicly available documents. *Id.* at *2. In the first instance, “where publicly available information does not disclose a potentially infringing product[,] . . . some directed, proportional discovery may be appropriate, but only upon a showing of a reasonable belief that such additional products actually exist and that they cannot be discovered with publicly available information. *Id.* at *4. Because the situation before the *Meidatek* court fell into the second category, however, discovery was not allowed. *Id.*; see also *Kelora Sys., LLC v. Target Corp.*, No. C 11-01548 CW (LB), 2011 WL 5444419, at *2 (N.D. Cal. Nov. 9, 2011) (denying discovery in part because the party requesting discovery could have ascertained information from public websites).

The facts of the present case fall under the first circumstance described in *Meidatek*. Bridor concedes it uses dough-cutting technology and has produced a sworn declaration and videorecording to that effect, but Bridor refuses to answer Plaintiffs’ discovery requests or informal questions about the technology and the bread products it produces. Information on Bridor’s dough-cutting technology is not publicly available, and Plaintiffs cannot obtain information about Bridor’s process by purchasing and examining Bridor’s bread products. Consequently, *Meidatek* supports Plaintiffs’ position, not Bridor’s.

In conclusion, the Court finds that Bridor has not shown good cause for a protective order. Information concerning Bridor’s use of blunt-edge dough-cutting technology is relevant to Plaintiffs’ existing infringement claim against Bridor in this litigation, as framed by the Amended Complaint and the preliminary infringement claim chart. Thus, and as suggested by *Meidatek*, the Court will allow for “some directed, proportional discovery,” see *Meidatek*, 2013 WL 588760, at *4. Specifically, Bridor must answer the seven questions posed in Plaintiffs’

letter of September 9, 2013, and attend a half-day Rule 30(b)(6) deposition limited to those topics.

As a final note, the Court reminds the parties that the protective order in place prohibits Plaintiffs from using confidential information to sue any non-party identified in discovery. This provision should prevent a perpetual cycle of identifying manufacturers through bakeries and bakeries through manufacturers. In addition, the deadline to add parties to this case has expired, and given the age of this litigation, the Court will not prolong it.

Accordingly, **IT IS HEREBY ORDERED** that:

1. Defendants' Motion for Leave to Amend Prior Art Statement (ECF No. 250) is **GRANTED**, and the pretrial schedule is amended as follows:
 - a. Defendants must serve their amended prior art statement by **Monday, February 3, 2014**;
 - b. Plaintiffs may serve an amended prior art statement by **Monday, March 17, 2014**;
 - c. Plaintiffs may amend their positions set forth in the joint claim construction statement by **Monday, March 10, 2014**; and
2. Defendant Bridor USA, Inc.'s Motion for Protective Order (ECF No. 261) is **DENIED**.

Dated: January 27, 2014

s/ Jeanne J. Graham
JEANNE J. GRAHAM
United States Magistrate Judge