

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION

GOOGLE, INC.,

Civil No. 09-642-HU

Plaintiff,

v.

ORDER

TRAFFIC INFORMATION LLC,

Defendant.

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HUBEL, Magistrate Judge

This matter came before the court on February 13, 2012, for a hearing on Plaintiff's Motion for Leave to Amend Invalidity Contentions [#116]. After hearing oral argument from the parties, the motion to amend invalidity contentions is granted.

The court, at the request of the parties, set a deadline for the filing of any motions to amend infringement and invalidity contentions in the scheduling order entered on April 21, 2010 [#41]. That order established that defendant's infringement contentions were to be submitted by April 27, 2010. Plaintiff's invalidity contentions were to be submitted by May 21, 2010. Remaining deadlines set by that order included, among other things, the claim construction proposals, Markman briefs, a Markman hearing, a claim construction decision by the Magistrate Judge as a Finding & Recommendation, followed by a period for objections to that claim construction decision and review of it by a District Judge. The order went on to establish, at the request of the parties, a date for motions to amend the parties' initial infringement and invalidity contentions 30 days after the Magistrate Judge's ruling on claims construction.

Following the entry of the Finding & Recommendation on claims construction, the court clarified the remaining deadlines in an

order entered May 6, 2011 [#64]. This order contained a deadline for any motions to amend infringement and invalidity contentions of June 6, 2011. On June 6, 2011, Google filed its motion to amend its invalidity contentions [#72]. On that same date, Traffic filed its motion to amend its infringement contentions [#75]. The parties began briefing these motions. They were simultaneously briefing their objections and responses to objections to the Magistrate Judge's claims constructions, and seeking more time to complete that process.

On July 5, 2011, the court held a telephone hearing to discuss the status of all pending motions, including these motions to amend the various contentions. The court suggested that it would be inefficient and premature to deal with the amended contentions issues until after final claim construction by Judge Mosman. The parties agreed, but Traffic noted it did not want to be deemed to be waiving its objections to Google's proposed amendments based on a lack of diligence. An order was entered from that conference which stated:

The deadline by which either party may seek to amend any contentions relating to infringement and validity is reset to thirty days after Judge Mosman's final ruling on the objections to the claims constructions entered on May 4, 2011 [#62]. Any new motion to amend contentions filed after Judge Mosman's ruling shall include all proposed amendments, whether previously made or new, which a party intends to pursue. A party may cite to the record with respect to arguments in support of, or in opposition to, such contentions, rather than restate them separately.

To the extent that a party files a new, comprehensive

motion to amend its contentions, the currently pending motion by that party will be deemed moot. In the event a party elects not to file a new motion to amend its contentions, any further briefing in support or opposition will not be due until a further briefing schedule is set following Judge Mosman's order. Deferring these motions to amend contentions shall not constitute a waiver of any motion to amend, nor any opposition to such motion.

The parties' Joint Motion for Leave to File Briefing Regarding Google's Motion for Leave to Serve Amended Invalidity Contentions [84] is granted, in part. The request for extension of time for defendant to file its opposition to plaintiff's motion for leave to amend contentions is deemed moot. The request for leave to file reply briefs regarding such motions to amend is granted.

[#89]

Judge Mosman's final claim construction ruling was filed on October 7, 2011 [#106]. This made the deadline to file motions to amend contentions November 7, 2011. On November 3, 2011, a joint motion was filed to extend the case schedule [#107]. That motion proposed a new date for the motions to amend contentions of December 19, 2011. This new deadline was adopted by the court in the minute order of November 22, 2011 [# 114].

In light of this case history, and given the public's interest in determining the validity of the '862 patent, I grant the motion by Google to amend its invalidity contentions. There is litigation pending in the Eastern District of Texas on this patent. There are also re-examination proceedings in the Patent Office pending. Procedurally barring these invalidity contentions when some of them were raised last June, and when there is no suggestion of any

prejudice to Traffic, would only encourage more litigation over the validity of the patent in question.

Given the fact the parties agreed to a deadline for amended contentions of December 19, albeit without Traffic waiving its opposition to these amendments based on lack of diligence, and given the fact that by that December deadline, fact discovery was not yet closed, and expert discovery had not yet begun, forcing a party to file to amend its contentions each time it learns of a basis for an amendment, encourages very inefficient use of the lawyers' time and resources as well as the court's. Were Traffic able to suggest prejudice of some sort, the court would be inclined to look more closely at the issue of diligence.

As I noted in oral argument, I have been encouraging the parties to be efficient in their presentation of issues to the court from the beginning of this case. As a result we have but one motion from each side to amend their contentions, each of which is now granted without any suggestion of prejudice to the other side. Not so much as one deposition has been identified that would have to be reopened or taken as a result of these amendments to the invalidity contentions. Each deadline the court set for these motions has been met. While diligence is an issue, how it weighs in the court's exercise of discretion changes the later in the case that the decision is made. There simply was no unreasonable delay in this motion to amend filed by Google within the deadline set at

the request of the parties and not long after Judge Mosman's claim construction decision. Fact discovery continues on some limited issues identified on the record today, and it will be completed one month before expert disclosures begin the expert discovery phase on May 4, 2012.

DATED this 13th day of February, 2012.

/s/ Dennis J. Hubel

Dennis James Hubel
United States Magistrate Judge