

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

RESEARCH IN MOTION, LTD. and	§	
RESEARCH IN MOTION CORP.,	§	
	§	
Plaintiffs,	§	
	§	
v.	§	Civil Action No. 3:08-CV-2075-K
	§	
EASTMAN KODAK CO.,	§	
	§	
Defendant.	§	

ORDER

Before the Court is Plaintiffs' Motion for Leave to Supplement Invalidation Contentions (Doc. No. 123). The Court **GRANTS** the motion and informs the parties the trial date of December 6, 2010, still remains in effect.

Federal Rule of Civil Procedure 16(b) permits a party to modify the court's scheduling order upon a showing of good cause. FED. R. CIV. P. 16(b). The party seeking the modification must show that in spite of its diligence, it cannot meet the scheduling order deadline. *S & W Enters., L.L.C. v. SouthTrust Bank of Alabama*, 315 F.3d 533, 535 (5th Cir. 2003). The court has broad discretion in permitting these modifications, and considers four factors in making the determination: (1) the explanation for the failure to meet the deadline; (2) the importance of the amendment; (3) any potential prejudice in allowing the amendment; and (4) the availability of a continuance to remedy any such prejudice. *Id.* at 536. Adding prior art references post

Markman briefing and hearing do not have the same implications as adding a new patent claim. *Sybase, Inc. v. Vertica Sys., Inc.*, No. 6:08-CV-24, 2009 WL 4574690, *3 (E.D. Tex. Nov. 30 ,2009); *Alt v. Medtronic, Inc.*, No. 2:04-CV-370, 2006 WL 278868, *5 (E.D. Tex. Feb. 1, 2006).

Plaintiffs wish to supplement their invalidity contentions with prior art which was in Defendant's possession, requested by Plaintiffs in March 2009, and finally disclosed by Defendant in September 2009. The Court concludes: (1) Plaintiffs have shown good faith in attempting to supplement their invalidity contentions with these prior art references as soon as practicable, had sought the information months before the deadline, and have sufficiently explained why they missed this deadline, when Defendant provided these references in voluminous document productions, which included a million plus page production; (2) these prior art references are important to Plaintiffs claims in that they go directly to the validity of Defendant's patents; (3) there is no prejudice to Defendant since these prior art references were in Defendant's possession all this time, and some have already been reviewed by Defendant's experts in other litigation; and (4) the discovery deadline does not conclude until July 2010, and the expert discovery was extended to August 2010, giving Defendant ample time to address these references, which the Court again notes Defendant had in its possession and, some of which, its experts have previously reviewed in other litigation. Furthermore, the Court notes that Plaintiffs' request seeks to add prior art references, which do not have the same implications as adding a new patent claim. *See Sybase*, 2009

WL 4574690, at *3; *Alt*, 2006 WL 278868, at *5. Accordingly, the Court **grants** the motion for leave to supplement Plaintiffs' invalidity contentions.

Also before the Court is Plaintiffs' Motion to Compel [Defendant's] Production of Engineering Notebook (Doc. No. 126). The Court **DENIES** this motion. The Court recognizes that Defendant steadfastly maintains the redacted and remaining information in the notebook is irrelevant to the case at hand and/or protected by attorney-client privilege. However, the Court **orders** Defendant to re-review the notebook to determine whether there is any relevant and/or non-privileged information which may have been excluded from disclosure but should be turned over to Plaintiffs. The Court notes that it may review the notebook at a later time to determine relevance and privilege. At that time, should the Court find any information it deems relevant and/or non-privileged, which should have been disclosed to Plaintiffs, Defendant Eastman Kodak will face possible sanctions.

SO ORDERED.

Signed May 28th, 2010.



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UNITED STATES DISTRICT JUDGE