

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

3M Company, et al.,

Civil No. 10-2095 (ADM/FLN)

Plaintiffs,

v.

ORDER

Sperian Protection Americas, Inc., et al.,

Defendants.

Bussel E. Blythe & Aaron A. Myers for Plaintiffs.
Kurt J. Niederluecke & Eric R. Hubbard for Defendants.

THIS MATTER came before the undersigned United States Magistrate Judge on April 25, 2011 on Defendants' Motion for Leave to Supplement Defendants' Prior Art Statement (ECF No. 30). The Pretrial Schedule states that "Defendant can add prior art to its original Statement only by leave of the Court" and that the schedule may only be modified on a showing of "good cause as required by Local Rule 16.3." (ECF No. 19 at 1, 5.) The Court finds the following three factors to be relevant to the determination of whether a party has shown good cause to amend its prior art statement: (1) that the references were not and could not reasonably have been identified earlier; (2) that the references are not merely cumulative; and (3) how the defendant will be prejudiced if leave is denied and how the plaintiff will not be prejudiced if leave is given. *See, e.g., Floe Int'l Inc. V. Newman's Mfg. Inc.,*

Based upon the foregoing, and all the files, records and proceedings herein, **IT IS HEREBY ORDERED** that Defendants' Motion for Leave to Supplement Defendants' Prior Art Statement (ECF No. 30) is **GRANTED, in part**, and **DENIED, in part**, as follows:

1. To the extent Defendants seek to add U.S. Patent No. 4,827,924 to Japuntich ("the

Japuntich patent”) as a new prior art reference, the motion is **DENIED**. Defendants do not allege that the Japuntich patent was not and could not reasonably have been identified before service of Defendants’ original Prior Art Statement. Rather, Defendants admit that the Japuntich patent is cited in the prosecution history of the Patents-in-Suit, but allege that Defendants “failed to appreciate the significance of this reference to the invalidity of the Patents-in-Suit” until after service of the original Prior Art Statement. (ECF No. 36, Deft.’s Mem. in Supp. at 5.) The Court finds that the “failure to appreciate the significance” of the Japuntich patent does not constitute good cause to amend the Prior Art Statement.

2. To the extent Defendants seek to add German patent DE 3 337 031 to Freudenberg (“the Freudenberg patent”) as a new prior art reference, the motion is **GRANTED**. Defendants hired a German search firm to perform a prior art search of German databases prior to service of Defendants’ original Prior Art Statement, but that search did not locate the Freudenberg patent. (Deft.’s Mem. at 5.) That search shows diligence on the part of Defendants prior to service of its original Prior Art Statement. This Court finds good cause to allow Defendants to amend their Prior Art Statement.
3. To the extent Defendants seek to modify their contentions to include an assertion that U.S. Patent No. 5,332,061 to Brunson (“the Brunson patent”) anticipates claims 18, 29, and 33 of U.S. Patent No. 6,536,434, the motion is **GRANTED**. Defendants included the Brunson patent in their original Prior Art Statement, but did not include the particular assertions Defendants are now seeking to add. The Court finds that because the Brunson patent was included in Defendants’ original Prior Art Statement, Plaintiffs will not be prejudiced by this amendment and Defendants have demonstrated good cause to amend their Prior Art Statement.
4. Defendants shall serve on Plaintiffs a Supplemental Prior Art Statement in conformity with this order withing seven (7) days of the date of entry of this order. Plaintiffs shall respond to Defendants’ Supplemental Prior Art Statement within twenty-one (21) days of its receipt.

DATED: April 29, 2011

s/ Franklin L. Noel
FRANKLIN L. NOEL
United States Magistrate Judge