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8 UNITED STATES DISTRICT COURT  
9 WESTERN DISTRICT OF WASHINGTON  
AT SEATTLE

10 PLAY VISIONS, INC.,

11 Plaintiff,

12 v.

13 DOLLAR TREE STORES, INC., and  
14 GREENBRIER INTERNATIONAL,  
INC.,

15 Defendants.

CASE NO. C09-1769 MJP

ORDER GRANTING MOTION TO  
AMEND PRELIMINARY  
INVALIDITY CONTENTIONS

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17 This matter comes before the Court on Defendants' motion to amend their preliminary  
18 invalidity contentions. (Dkt. No. 42.) Having reviewed the motion, the response (Dkt. No. 45),  
19 the reply (Dkt. No. 48), and all supporting papers, the Court GRANTS the motion. The Court  
20 also GRANTS Defendants' motion to STRIKE and does not consider the overlength portion of  
21 Plaintiff's response brief.

22 **Background**

23 Plaintiff Play Visions, Inc. has filed suit against Defendants for patent infringement. The  
24 scheduling order of this Court required Defendants to file preliminary non-infringement and

1 invalidity contentions by August 4, 2010. (Dkt. No. 10.) Defendants filed non-infringement  
2 contentions on that date, stating that they had no invalidity contentions, but reserved the right to  
3 present such contentions “as they are discovered or developed.” (Dkt. No. 43-2 at 3.) On  
4 October 1, 2010, Defendants served Play Visions with supplemental interrogatory responses in  
5 which they disclosed several prior art references. (Dkt. No. 43-3.) Five days later, Defendants  
6 served preliminary invalidity contentions to Plaintiff. (Dkt. No. 43-4.) On October 14, 2010,  
7 Defendants filed a motion to amend their non-infringement and invalidity contentions. Claims  
8 construction is scheduled for January 3, 2011. (Dkt. No. 10.) Discovery ends on March 21,  
9 2011. (Id.) Trial is set for July 18, 2011. (Id.)

## 10 Analysis

### 11 A. Amendment

12 Defendants seek leave to file amended preliminary invalidity contentions pursuant to  
13 Local Patent Rule 124. The Court agrees.

14 Local Patent Rule 124 permits amendment of invalidity contentions “only by order of the  
15 Court upon a timely showing of good cause.” Examples of good cause are stated in the rule as

16 (a) a claim construction by the Court different from that proposed by the party  
17 seeking amendment; (b) recent discovery of material prior art despite earlier  
18 diligent search; and (c) recent discovery of nonpublic information about the  
19 Accused Device which was not discovered, despite diligent efforts, before the  
service of the Infringement Contentions. The duty to supplement discovery  
responses does not excuse the need to obtain leave of court to amend contentions.

20 Local Patent Rule LR 124. Restrictions on amendment to invalidity contentions are aimed at  
21 avoiding the “shifting sands” approach to claim construction. See Halo Elecs., Inc. v. Bel Fuse  
22 Inc., 2010 WL 3489593, at \*1 (N.D. Cal. Sept. 3, 2010) (granting motion for leave to amend  
23 invalidity contentions where the defendants argued they searched diligently over a broad  
24 spectrum of prior art). The burden to show diligence is on Defendants in this case. Id.

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2 Defendants rely on Quantum Corp. v. Riverbed Tech., Inc., No. C07-04161 WHA, 2008  
3 U.S. Dist LEXIS 53632 (N.D. Cal. July 15, 2008). In Quantum, the defendant filed no invalidity  
4 contention, but sought leave to file such contentions after its expert witness advised it of  
5 particular prior art. Id. at \*4. The Court found that the posture of the case was early, given that  
6 only six months had passed since the defendant filed its counterclaim and that there had been no  
7 claim construction and no depositions had been taken. Id. at \*5.

8 Defendants have shown good cause. Similar to the facts in Quantum, claim construction  
9 will not occur until after January, discovery does not end until March 2011, and Defendants  
10 moved to amend the invalidity contentions roughly two months after the deadline to file them.  
11 Defendants explain the delay is a result of a broad investigation that yielded newly obtained  
12 evidence. (Dkt. No. 42 at 7.) They have shown reasonable diligence in providing these  
13 invalidity contentions, despite Plaintiff's argument to the contrary. For example, Plaintiff argues  
14 that Defendants had over seven months to conduct this search from the time the case was filed.  
15 This ignores that Plaintiff's Fifth Amended Complaint wasn't filed until June 2010, and that the  
16 motion to amend was filed roughly two months after the deadline passed. Good cause exists to  
17 permit amendment.

18 Plaintiff also argues that Defendants have engaged in gamesmanship and that they are  
19 "destroy[ing] the reason for having local patent rules." (Dkt. No. 45 at 11.) This hyperbole does  
20 not convince the Court of Plaintiff's position. Defendants attest in their motion that they were  
21 diligently pursuing their invalidity contentions and moved to amend at the earliest moment.  
22 There is no evidence of gamesmanship, particularly given the short time it took Defendants to  
23 amend their invalidity contentions and the early posture of the case.

1 Plaintiff also argues that it will suffer prejudice if Defendants are allowed amendment.  
2 There is no evidence of prejudice given that the parties have yet to engage in claims construction  
3 and discovery does not end for months. The Court does not consider Plaintiff's other arguments  
4 of prejudice, as they are contained in the overlength portions of the brief which the Court strikes.  
5 See infra.

6 The Court therefore GRANTS the motion and GRANTS Defendants leave to file their  
7 amended preliminary invalidity contentions.

8 B. Motion to Strike

9 Defendants ask the Court to strike the overlength portion of Plaintiff's response brief.  
10 The Court agrees. The response is 14 pages, when it should have been 12. Local Rule CR 7(e).  
11 The Court STRIKES and does not consider the final two pages of Plaintiff's opposition. The  
12 Court notes, too, that Plaintiff has used lengthy footnotes in what appears to be a further effort to  
13 skirt the page limitation. If matters are sufficiently important for the Court's attention, they  
14 should be placed in the body of the argument, not in footnotes.

15 The Court also advises Plaintiff that it failed to submit courtesy copies of its filings in this  
16 matter that were over 50 pages. (See Dkt. No. 46.) The Local Civil Rules require that any filing  
17 over 50 pages must be accompanied by courtesy copies delivered to the Clerk's Office for  
18 chambers. Local Rule CR 10(e)(8).

19 **Conclusion**

20 The Court GRANTS the motion to amend. Defendants have shown diligence in pursuing  
21 amendments to their preliminary invalidity contentions and there is no evidence of prejudice to  
22 Plaintiff in the face of amendment. The Court GRANTS Defendants' motion to strike and  
23 STRIKES the final two pages of Plaintiff's response brief.  
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1 The clerk is ordered to provide copies of this order to all counsel.

2 Dated this 30th day of November, 2010.

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5 Marsha J. Pechman  
6 United States District Judge  
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