 2 3 4 5 6 7 8 8 9 9 8 9 9 10 11 12 v. 13 14 15 16 17 18 19 11 11 12 14 15 15 16 17 18 19 11 11 12 14 15 16 17 18 19 11 11 12 14 15 16 17 18 19 10 11 12 14 15 16 17 18 19 10 11 12 14 15 16 17 18 19 10 11 12 14 15 16 17 18 19 10 11 12 12 14 15 16 17 18 19 19 10 11 11 11 12 12 14 15 15 16 17 18 19 19 10 11 11 12 12 12 14 15 14 15 14 15 15 16 17 18 19 19 10 11 12 12 14 14 <l< th=""><th>1</th><th></th><th></th></l<>	1		
4 5 6 7 8 9 9 9 10 11 12 13 14 15 16 17 18 19 10 11 12 12 13 14 15 15 16 17 18 19 19 11 11 12 13 14 15 15 16 17 18 19 113 114 115 115 116 117 118 118 119 119 110 1111 1111	2		
5 6 6 UNITED STATES DISTRICT COURT 8 WESTERN DISTRICT OF WASHINGTON 9 AT SEATTLE 10 BADEN SPORTS, INC., CASE NO. C11-0603MJP 11 Plaintiff, ORDER ON DEFENDANT'S 12 v. ORDER ON DEFENDANT'S 13 WILSON SPORTING GOODS CO., MOTION FOR LEAVE TO AMEND 14 Defendant. Order on the second sec	3		
 6 7 7 8 1 1	4		
7 8 UNITED STATES DISTRICT COURT WESTERN DISTRICT OF WASHINGTON AT SEATTE 9 AT SEATTE 10 BADEN SPORTS, INC., CASE NO. C11-0603MJP 11 Plaintiff, ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND 12 v. ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND 14 Defendant. ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND 15 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 16 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 17 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the 18 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79.), and all related 19 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity 10 contentions. 12 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 12 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 13 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	5		
 8 BADEN SPORTS, INC., CASE NO. C11-0603MJP BADEN SPORTS, INC., CASE NO. C11-0603MJP Plaintiff, ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND v. WILSON SPORTING GOODS CO., Defendant. Defendant. This matter comes before the Court on a brought by Defendant Wilson Sporting Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's reply (Dkt. No. 79.) and all related contentions. The Court held on April 27, 2012, that it wuld adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	6		
 WESTERN DISTRICT OF WASHINGTON AT SEATTLE BADEN SPORTS, INC., CASE NO. C11-0603MJP Plaintiff, ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND v. WILSON SPORTING GOODS CO., Defendant. This matter comes before the Court on a motion brought by Defendant Wilson Sporting Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	7		
9 BADEN SPORTS, INC., CASE NO. C11-0603MJP 11 Plaintiff, ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND 12 v. MOTION FOR LEAVE TO AMEND 13 WILSON SPORTING GOODS CO., Defendant. 14 Defendant. This matter comes before the Court on a motion brought by Defendant Wilson Sporting 17 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the 18 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related 19 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity 20 contentions. 21 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	8		
11 Plaintiff, ORDER ON DEFENDANT'S MOTION FOR LEAVE TO AMEND 12 v. 13 WILSON SPORTING GOODS CO., 14 Defendant. 15 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 16 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 17 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the 18 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related 19 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity 20 contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	9	AT SEAT	ITLE
12 v. 13 WILSON SPORTING GOODS CO., 14 Defendant. 15 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 16 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 17 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the 18 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related 19 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity 20 contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	10	BADEN SPORTS, INC.,	CASE NO. C11-0603MJP
 12 v. 13 WILSON SPORTING GOODS CO., 14 Defendant. 15 16 This matter comes before the Court on a motion brought by Defendant Wilson Sporting 17 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the 18 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related 19 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity 20 contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	11	Plaintiff,	
14Defendant.15161718191919101011121314151516171718191910101112131414151516171819191010111213141415151617181919101011121314141515161718191919101010111213141415151617181919191010101112131414151516161718181919191910 <td>12</td> <td>v.</td> <td>MOTION FOR LEAVE TO AMEND</td>	12	v.	MOTION FOR LEAVE TO AMEND
 This matter comes before the Court on a motion brought by Defendant Wilson Sporting Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	13	WILSON SPORTING GOODS CO.,	
 This matter comes before the Court on a motion brought by Defendant Wilson Sporting Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. Background The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	14	Defendant.	
 Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. Background The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	15		
 motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	16	This matter comes before the Court on a motion brought by Defendant Wilson Sporting	
 filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity contentions. Background The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	17	Goods for leave to amend preliminary invalidity contentions. (Dkt. No. 71.) Having reviewed the	
 20 contentions. 21 Background 22 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim 23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	18	motion, Plaintiff's response (Dkt. No. 77), Defendant's reply (Dkt. No. 79), and all related	
21Background22The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim23constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	19	filings, the Court GRANTS Defendant Wilson's motion for leave to amend its invalidity	
 The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt. 	20	contentions.	
23 constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	21	Background	
	22	The Court held on April 27, 2012, that it would adopt Plaintiff Baden's claim	
24 No. 69 at 13-14.) The Court declined to adopt Wilson's limited construction of the ball seam to	23	constructions of the four disputed terms of U.S. Patent No. 5,636,835 (the '835 Patent). (Dkt.	
	24	No. 69 at 13-14.) The Court declined to adopt Wils	son's limited construction of the ball seam to

Case 2:11-cv-00603-MJP Document 80 Filed 06/28/12 Page 2 of 4

1 only include a "top hat" seam formation with "flanges." (Id. at 12.) On May 2, 2012, Wilson 2 located U.S. Patent No. 2,182,052 (the '052 Patent) after initiating a new search for prior art. (Dkt. No. 73 at 2.) On May 7, 2012, Wilson filed a motion for leave to amend its invalidity 3 4 contentions. (Dkt. No. 71.)

5

6

Discussion

A. Standard for Amendment of Invalidity Contentions

7 "Amendment of the Infringement Contentions or the Invalidity Contentions may be made only by order of the Court upon a timely showing of good cause ... absent undue 8 9 prejudice to the non-moving party." Local Patent Rule W.D. Wash. 124. An example of a circumstance justifying a motion to amend includes: "a claim construction by the Court different 10 from that proposed by the party seeking amendment." Id. Courts have evaluated good cause in 11 12 the context of local patent rules by considering factors such as: "(1) the reasons proffered for the need to amend after the deadline for submitting contentions had passed, (2) the diligence of the 13 14 moving party, (3) the importance of the proposed amendments, together with any prejudice to the 15 moving party if amendment is denied, (4) potential prejudice to the non-moving party, and (5) the availability of a continuance to cure any prejudice." Convolve, Inc. v. Compaq Computer 16 17 Corp., 2007 WL 700904 at *2 (S.D.N.Y. Mar. 7, 2007).

18

19

21

22

23

B. Markman Decision

The Court's rejection of Wilson's proposed claim constructions provided Wilson good 20 cause to search for additional prior art to supplement its invalidity contentions. The Court adopted none of Wilson's proposed claim constructions. Wilson argues that since the Court adopted a broader understanding of the seam taught by the '835 Patent, it initiated a search for prior art to broaden its previous invalidity contentions that had only contemplated a more 24

Case 2:11-cv-00603-MJP Document 80 Filed 06/28/12 Page 3 of 4

specific "top hat" seam. (Dkt. No. 71 at 3.) While Wilson should have perhaps conducted that
 broader search earlier, it is reasonable to grant leave given the completely adverse outcome of
 the <u>Markman</u> hearing, which is the precise situation contemplated by LPR 124.

C. Diligence

4

5 Wilson searched for new prior art and requested leave to amend soon after receiving the 6 Court's Markman order. Wilson located the '052 Patent on May 2, 2012, just six days after the 7 Court's Markman order. (Dkt. No. 73 at 2.) On May 7, 2012, Wilson filed its motion to amend 8 preliminary invalidity contentions. (Id.) Wilson provided its original contentions in a timely 9 manner and proceeded "with diligence in amending those contentions when new information comes to light in the course of discovery." O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc., 10 11 467 F.3d 1355, 1366 (Fed. Cir. 2006). Wilson's quick action to amend after the Markman 12 hearing and the absence of any previous delaying weighs in favor of granting leave to amend.

13 <u>D. Prejudice</u>

Wilson's amendments do not significantly prejudice Baden because the amendments are
relatively minor and there is still time to allow Baden to conduct discovery and expert analysis
relating to the amended material.

Adding claim charts for the JP '253 Patent is not prejudicial because Baden had prior
notice of Wilson's use of the patent and is familiar with the patent from the <u>Molten</u> litigation.
(Case No. 2:06-cv-00210-MJP (W.D. Wash. 2006) (cited in Dkt. No. 78 in the present case)).
Regardless of the ultimate admissibility of the patent at trial, it is reasonable to allow Wilson to
include their amendments regarding the JP '253 Patent at this stage.

- 22 23
- 24

Case 2:11-cv-00603-MJP Document 80 Filed 06/28/12 Page 4 of 4

1	Conclusion
2	The Court GRANTS Wilson's motion for leave to amend its invalidity contentions to
3	include the '052 Patent and JP '253 Patent. If the parties determine that an extension of
4	discovery is necessary, the Court will consider such a request after the parties have met and
5	conferred.
6	The clerk is ordered to provide copies of this order to all counsel.
7	Dated this 28th day of June, 2012.
8	
9	The Man
10	Malshuf. Helens Marsha J. Pechman
11	United States District Judge
12	
13	
14	
15	
16	
17	
18	
19	
20	
21	
22	
23	
24	