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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADEN SPORTS, INC.,

Plaintiff,

v.

WILSON SPORTING GOODS CO.,

Defendant.

CASE NO. C11-0603MJP

ORDER ON DEFENDANT’S
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.

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. No. 69 at 13-14.) The Court declined to adopt Wilson’s limited construction of the ball seam to

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.
3 (Dkt. No. 73 at 2.) On May 7, 2012, Wilson filed a motion for leave to amend its invalidity
4 contentions. (Dkt. No. 71.)

5 **Discussion**

6 A. Standard for Amendment of Invalidity Contentions

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

18 B. Markman Decision

19 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
21 adopted none of Wilson’s proposed claim constructions. Wilson argues that since the Court
22 adopted a broader understanding of the seam taught by the ‘835 Patent, it initiated a search for
23 prior art to broaden its previous invalidity contentions that had only contemplated a more
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1 specific “top hat” seam. (Dkt. No. 71 at 3.) While Wilson should have perhaps conducted that
2 broader search earlier, it is reasonable to grant leave given the completely adverse outcome of
3 the Markman hearing, which is the precise situation contemplated by LPR 124.

4 C. Diligence

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
10 comes to light in the course of discovery.” O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.,
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 D. Prejudice

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

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

Conclusion

The Court GRANTS Wilson's motion for leave to amend its invalidity contentions to include the '052 Patent and JP '253 Patent. If the parties determine that an extension of discovery is necessary, the Court will consider such a request after the parties have met and conferred.

The clerk is ordered to provide copies of this order to all counsel.

Dated this 28th day of June, 2012.



Marsha J. Pechman
United States District Judge