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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA
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11 TACTION TECHNOLOGY, INC.,
12 Plaintiff,
13 v.
14 APPLE INC.,
15 Defendant.

Case No.: 21-CV-812 TWR (JLB)

**ORDER GRANTING PLAINTIFF'S
MOTION TO STRIKE
DEFENDANT'S AMENDED
INVALIDITY CONTENTIONS**

(ECF No. 205)

16
17 Presently before the Court is the Motion to Strike (“Mot.,” ECF No. 205) portions
18 of the amended invalidity contentions that Defendant Apple Inc. (“Apple”) served on
19 November 18, 2022, filed by Plaintiff Taction Technology, Inc. (“Taction”), as well as
20 Apple’s Response in Opposition to (“Opp’n,” ECF No. 230 (public), 235 (sealed)) and
21 Taction’s Reply in Support of (“Reply,” ECF No. 248) the Motion. The Court held a
22 hearing on April 13, 2023. (*See* ECF No. 261.) For the reasons discussed below, the Court
23 **GRANTS** Taction’s Motion.

24 **BACKGROUND**

25 **I. The Asserted Patents**

26 Taction is the owner and assignee of U.S. Patent No. 10,659,885 (“the ’885 Patent”)
27 and U.S. Patent No. 10,820,117 (“the ’117 Patent”) (collectively, “the asserted patents”).
28 (*See* ECF No. 1, (“Compl.”) ¶¶ 68, 72); *see also* U.S. Patent No. 10,659,885, at [73] (issued

1 May 19, 2020); U.S. Patent No. 10,820,117, at [73] (issued Oct. 27, 2020). The '885 Patent
2 is entitled “Systems and Methods for Generating Damped Electromagnetically Actuated
3 Planar Motion for Audio-Frequency Vibrations” and was issued on May 19, 2020. '885
4 Patent at [45], [54]. The '117 Patent is entitled the same and was issued on October 27,
5 2020. '117 Patent at [45], [54]. The '885 Patent and the '117 Patent share a common
6 specification, and both patents claim priority to provisional application No. 62/054,712
7 filed on September 24, 2014. '885 Patent at [60]; '117 Patent at [60].

8 The invention described in the '885 Patent and the '117 Patent “relates to tactile
9 transducers that produce bass frequency vibrations for perception by touch.” '885 Patent
10 col. 1 ll. 20–21.¹ The specification of the asserted patents explains:

11 Below about 200 Hz, the lower the frequency of sound, the more it is
12 perceived not only by vibration of the ear drum but also by touch receptors in
13 the skin. This sensation is familiar to anyone who has “felt the beat” of strong
14 dance music in the chest, or through the seat of a chair, or has simply rested a
15 hand on a piano. The natural stimulus is both auditory and tactile, and a true
reproduction of it is possible only when mechanical vibration of the skin
accompanies the acoustic waves transmitted through the air to the ear drum.

16 *Id.* at col. 1 ll. 25–33.

17 The specification then details the problems with the prior art audio-frequency tactile
18 transducers, which utilized “axial shakers,” “un-damped eccentric rotating motors
19 (‘ERMs’),” and “un-damped linear resonant actuators (‘LRAs’).” *See id.* at col. 1 l. 34–
20 col. 2 l. 46. With respect to the ERMs and LRAs, the specification explains that a lack
21 mechanical damping is “problematic.” *See id.* at col 2 ll. 1–2 (“The problem of uneven
22 frequency response is typically made worse by a lack of mechanical damping.”), col. 2 ll.
23 11–13 (“Another approach in the prior art, also problematic, is the use of un-damped
24 eccentric rotating motors (‘ERMs’) and un-damped linear resonant actuators (‘LRAs’).”).

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28 ¹ Because the '885 Patent and the '117 Patent share a common specification, the Court will cite to only
the '885 Patent’s specification for ease of reference.

1 The asserted patents aim to overcome the problems of the prior art by disclosing “a
2 thin, flat vibration module with a movable member that is electromagnetically actuated to
3 produce motion in-plane.” *See id.* at col. 3 ll. 51–53; *see also id.* at col. 2 ll. 47–49. “[T]he
4 module may consist of a mass and thin magnets, polarized through their thickness, where
5 the mass and magnets are movably suspended inside a housing.” *Id.* at col. 3 ll. 63–66.
6 Further, the suspension may include flexures or a ferrofluid layer. *Id.* at col. 3 ll. 66–67.
7 In addition, “the vibration of the moving portion may be damped” using the layer of
8 ferrofluid. *Id.* at col. 4 ll. 6–8.

9 Independent claim 1 of the ’885 Patent recites:

10 1. An apparatus for imparting motion to the skin of a user, the apparatus
11 comprising:

12 a housing;

13 a plurality of coils capable of carrying electrical current;

14 a plurality of magnets arranged in operative proximity to the plurality of coils;

15 a moving portion comprising an inertial mass and the plurality of magnets;

16 a suspension comprising a plurality of flexures that guides the moving portion
17 in a planar motion with respect to the housing and the plurality of conductive
18 coils;

19 wherein movement of the moving portion is damped by a ferrofluid in
20 physical contact with at least the moving portion; and

21 wherein the ferrofluid reduces at least a mechanical resonance within the
22 frequency range of 40-200 Hz in response to electrical signals applied to the
23 plurality of conductive coils.
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25 ’885 Patent col. 14 ll. 48–65.

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1 Independent claim 1 of the '117 Patent recites:

2 1. An apparatus comprising:

3 a housing;

4 a plurality of conductive coils capable of carrying electrical current;

5 a plurality of magnets arranged in operative proximity to the plurality of
6 conductive coils;

7 a moving portion comprising an inertial mass and the plurality of magnets;

8 a suspension comprising a plurality of flexures that guides the moving portion
9 in a planar motion with respect to the housing and the plurality of conductive
10 coils;

11 wherein vibration of the apparatus imparts vibrations to a user's skin;

12 wherein vibration of the apparatus is damped by a viscous ferrofluid in
13 physical contact with at least the moving portion;

14 wherein the viscous ferrofluid reduces at least a resonance within a frequency
15 range of 40-200 Hz in response to signals applied to the plurality of
16 conductive coils;

17 wherein said moving portion includes at least a pocket that provides space for
18 at least a magnet;

19 wherein each of said plurality of flexures is more resistant to motion
20 transverse to a plane of the moving portion than it is to linear motion in the
21 plane of the moving portion; and

22 wherein said housing is generally cuboid in shape.
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24 '117 Patent col. 14 l. 47–col. 15 l. 5.

25 **II. Procedural History**

26 On April 26, 2021, Taction filed a complaint against Apple, alleging infringement
27 of the asserted patents. (*See generally* ECF No. 1 (“Compl.”).) Specifically, Taction
28 alleges that Apple has directly infringed and induced or contributed to the infringement of

1 the asserted patents by making, using, selling, and offering for sale Apple products,
2 including the iPhone and Apple Watch, that implement haptics technology, (*see id.* ¶¶ 77,
3 80), which refers to the science of enabling interaction with technology through the sense
4 of touch, such as, for example, through the use of vibrations. (*See* ECF No. 73 at 1.)

5 On July 8, 2021, Apple answered the complaint and filed counterclaims against
6 Taction. (*See generally* ECF No. 17.) Magistrate Judge Jill L. Burkhardt issued a Case
7 Management Order on August 10, 2021, (*see generally* ECF No. 34), setting a Claims
8 Construction and Tutorial Hearing before the Honorable Gonzalo P. Curiel for
9 February 18, 2022. (*See id.* ¶ 12.)

10 On October 21, 2022, after this action was transferred to the undersigned, (*see* ECF
11 No. 48), Apple filed before the Patent Trial and Appeal Board (“PTAB”) four petitions for
12 *inter partes* review (“IPR”), challenging the validity of all of the asserted claims of the
13 asserted patents. (*See* ECF No. 53-1 (“Kete Decl.”) Exs. 1–4.) On January 26, 2022, the
14 Court stayed the action, including further claims construction briefing, pending the PTAB’s
15 decision on whether to institute the IPRs. (*See* ECF No. 76 at 6.) The PTAB issued
16 decisions denying institution of IPR for all four IPR proceedings related to the asserted
17 patents on April 18, 2022. (*See generally* ECF No. 97.)

18 On June 2, 2022, the Court lifted the stay and reset the Claim Construction and
19 Tutorial Hearing for August 18, 2022, (*see generally* ECF No. 98), which the Court
20 subsequently continued to September 15, 2022. (*See* ECF No. 119.) After issuing a
21 tentative ruling, (*see* ECF No. 122), the Court held the *Markman* hearing on September 15,
22 2022. (*See* ECF No. 126.) The Court’s Claim Construction Order followed on
23 September 28, 2022. (*See generally* ECF No. 141.)

24 On November 18, 2022, Apple served Taction with Apple’s “Post Claim
25 Construction Amended Invalidation Contentions” (the “Amended Invalidation Contentions”).
26 (*See* ECF No. 230-1 (“Sproul Decl.”) ¶ 14; ECF No. 235-4 (“Ex. 11”).) Taction first
27 challenged Apple’s Amended Invalidation Contentions on December 29, 2022, and the
28 Parties met and conferred on January 12, 2023. (*See* Sproul Decl. ¶ 14.) The Parties lodged

1 a Joint Discovery Statement with Judge Burkhardt on January 31, 2022. (*See id.*) On
2 February 7, 2023, Judge Burkhardt issued a Minute Order indicating that the Parties
3 “dispute is more properly raised as a noticed motion before the District Judge.” (*See* ECF
4 No. 176.) Taction filed the instant Motion on February 21, 2023. (*See generally* ECF No.
5 205.)

6 LEGAL STANDARDS

7 “The Court’s Patent Local Rules are designed to require parties to crystallize their
8 theories of the case early in the litigation and to adhere to those theories once they have
9 been disclosed.” *CliniComp Int’l, Inc. v. Cerner Corp.*, No. 17CV02479GPCDEB, 2022
10 WL 16985003, at *12 (S.D. Cal. Nov. 15, 2022) (quoting *Wi-LAN Inc. v. LG Elecs., Inc.*,
11 No. 18-CV-01577-H-BGS, 2019 WL 5790999, at *2 (S.D. Cal. Sept. 18, 2019)); *see also*
12 *AntiCancer, Inc. v. Pfizer, Inc.*, 769 F.3d 1323, 1331 (Fed. Cir. 2014); *O2 Micro Int’l Ltd.*
13 *v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366 n.12 (Fed. Cir. 2006). “The Local
14 Rules are also designed to provide structure to discovery and to enable the parties to move
15 efficiently toward claim construction and the eventual resolution of their dispute.” *Bell*
16 *Semiconductor, LLC v. NXP USA, Inc.*, No. 22-CV-00594-H-KSC, 2023 WL 2342037, at
17 *2 (S.D. Cal. Feb. 27, 2023) (quoting *Pelican Int’l, Inc. v. Hobie Cat Co.*, No. 3:20-CV-
18 02390-RSH-MSB, 2023 WL 2127995, at *2 (S.D. Cal. Feb. 10, 2023)).

19 The Patent Local Rules accomplish this “by requiring both the plaintiff and
20 the defendant in patent cases to provide early notice of their infringement and
21 invalidity contentions, and to proceed with diligence in amending those
22 contentions when new information comes to light in the course of discovery.
23 The rules thus seek to balance the right to develop new information in
discovery with the need for certainty as to the legal theories.”

24 *Echologics, LLC v. Orbis Intelligent Sys., Inc.*, No. 21-CV-01147-RBM-AHG, 2022 WL
25 17724142, at *7 (S.D. Cal. Dec. 15, 2022) (quoting *O2 Micro*, 467 F.3d at 1365–66).

26 Under Patent Local Rule 3.3, an accused infringer must serve on all parties its
27 “Invalidity Contentions,” which must disclose specific information regarding the accused
28 infringer’s theories of invalidity in the case. *See id.* (citing S.D. Cal. Patent L.R. 3.3); *see*

1 *also Pelican*, 2023 WL 2127995, at *3. “In a lawsuit for patent infringement in the
2 Southern District of California, an accused infringer is limited to the invalidity theories and
3 prior art references it sets forth in its invalidity contentions.” *Echologics*, 2022 WL
4 17724142, at *7; *accord Pelican*, 2023 WL 2127995, at *3. Any invalidity theories not
5 properly disclosed pursuant to the Court’s Patent Local Rules “‘are barred from
6 presentation at trial (whether through expert opinion testimony or otherwise).” *See Bell*
7 *Semiconductor*, 2023 WL 2342037, at *3 (quoting *Pelican*, 2023 WL 2127995, at *3); *see*
8 *also In re PersonalWeb Techs., LLC Pat. Litig.*, No. 18-MD-02834-BLF-SVK, 2019 WL
9 11201545, at *3 (N.D. Cal. Aug. 7, 2019) (“The contentions are not a mere formality but
10 rather a requirement ‘to eliminate the gamesmanship of hints in favor of open disclosure.”
11 (quoting *Largan Precision Co. v. Genius Elec. Optical Co.*, No. 13-CV-02502-JD, 2014
12 WL 6882275, at *4 (N.D. Cal. Dec. 5, 2014))).

13 “The Court’s Patent Local Rules do not allow amendments to contentions as a matter
14 of course when new information is revealed in discovery.” *Echologics*, 2022 WL
15 17724142, at *7 (quoting *Zest IP Holdings, LLC v. Implant Direct MFG, LLC*, No. 10-CV-
16 0541-GPC-WVG, 2014 WL 358430, at *3 (S.D. Cal. Jan. 31, 2014)). “Rather, a party
17 seeking to amend its infringement or invalidity contentions must satisfy the relevant
18 provisions set forth in Patent Local Rule 3.6.” *Id.*; *accord Pelican*, 2023 WL 2127995, at
19 *3. “In contrast to the more liberal policy for amending pleadings, the philosophy behind
20 amending contentions under the Patent Local Rules is decidedly conservative, and
21 designed to prevent the shifting sands approach to claim construction.” *Echologics*, 2022
22 WL 17724142, at *7 (quoting *Regents of Univ. of Cal. v. Affymetrix, Inc.*, No. 17-CV-
23 01394-H-NLS, 2018 WL 4053318, at *2 (S.D. Cal. Aug. 24, 2018)); *accord Genentech,*
24 *Inc. v. Amgen, Inc.*, 289 F.3d 761, 774 (Fed. Cir. 2002).

25 Patent Local Rule 3.6(b) governs amendments to invalidity contentions:

26 As a matter of right, a party opposing a claim of patent infringement may
27 serve “Amended Invalidity Contentions” no later than the completion of claim
28 construction discovery. Thereafter, absent undue prejudice to the opposing
party, a party opposing infringement may only amend its validity contentions:

1 1. If a party claiming patent infringement has served “Amended
2 Infringement Contentions,” and the party opposing a claim of patent
3 infringement believes in good faith that the Amended Infringement
4 Contentions so require;

5 2. If, not later than fifty (50) days after service of the Court’s Claim
6 Construction Ruling, the party opposing infringement believes in good faith
7 that amendment is necessitated by a claim construction that differs from that
8 proposed by such party; or

9 3. Upon a timely motion showing good cause.

10 S.D. Cal. Patent L.R. 3.6(b). Additionally, Patent Local Rule 3.6 states: “This rule does
11 not relieve any party from its obligations under Fed. R. Civ. P 26 to timely supplement
12 disclosures and discovery responses.” S.D. Cal. Patent L.R. 3.6.

13 “A district court has wide discretion in enforcing the Patent Local Rules.” *Pelican*,
14 2023 WL 2127995, at *4 (quoting *CliniComp*, 2022 WL 16985003, at *12); *see*
15 *Howmedica Osteonics Corp. v. Zimmer, Inc.*, 822 F.3d 1312, 1320 (Fed. Cir. 2016)
16 (reviewing “a district court’s application of its local rules for abuse of discretion”). The
17 Federal Circuit will “affirm decisions in which [a] district court enforced its own local
18 rules, unless it is ‘clearly unreasonable, arbitrary, or fanciful; based on erroneous
19 conclusions of law; clearly erroneous; or unsupported by any evidence.’” *Howmedica*
20 *Osteonics*, 822 F.3d at 1324; *see also Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*,
21 811 F.3d 1314, 1321 (Fed. Cir. 2016) (“[T]his court defers to the district court when
22 interpreting and enforcing local rules so as not to frustrate local attempts to manage patent
23 cases according to prescribed guidelines.”).

24 ANALYSIS

25 Every asserted claim in this action contains a “ferrofluid” claim limitation. (*See* ECF
26 No. 234-9, Ex. I at p. 481 (listing the asserted claims).) Independent claim 1 of the ’885
27 Patent contains the following limitation: “wherein movement of the moving portion is
28 damped by a ferrofluid in physical contact with at least the moving portion.” ’885 Patent
col. 14 ll. 59–61. And independent claim 1 of the ’117 Patent similarly contains the

1 following limitation: “wherein vibration of the apparatus is damped by a viscous ferrofluid
2 in physical contact with at least the moving portion.” ’117 Patent col. 14 ll. 60–62.

3 In its initial invalidity contentions, Apple identified its iPhone 6 and iPhone 6 Plus
4 products as prior art references and asserted that each of those two references in
5 combination with other references render obvious claims 1 through 17 of the ’117 Patent
6 and claims 1 through 20 of the ’885 Patent.² (See ECF No. 234-1 (“Ex. A”) at p. 2; ECF
7 No. 234-2 (“Ex. B”) at p. 56; ECF No. 234-3 (“Ex. C”) at p. 105; ECF No. 234-4 (“Ex.
8 D”) at p. 174.) On November 18, 2022, Apple served Taction with its Amended Invalidity
9 Contentions, (see Sproul Decl. ¶ 14), in which Apple—for the first time—asserted that the
10 iPhone 6 and iPhone 6 Plus prior art references anticipate the asserted claims of the ’885
11 Patent and the ’117 Patent.³ (See ECF No. 234-5 (“Ex. E”) at p. 247; ECF No. 234-6 (“Ex.
12 F”) at p. 315; ECF No. 234-7 (“Ex. G”) at p. 377; ECF No. 234-8 (“Ex. H”) at p. 429.)
13 And Apple for the first time asserted that the iPhone 6 and iPhone 6 Plus prior art references
14 satisfy the ferrofluid claim limitations at issue. (Compare Ex. E at pp. 281–87; Ex. F at
15 pp. 344–51; Ex. G. at pp. 397–402; Ex. H at pp. 449–54, with Ex. A at pp. 15–16; Ex. B at
16 p. 66; Ex. C at pp. 125–26; Ex. D at pp. 193–94.)

17 Through its Motion, Taction argues that these amendments to Apple’s Amended
18 Invalidity Contentions violated Patent Local Rule 3.6 and therefore seeks to strike claim
19 charts regarding the iPhone 6 and iPhone 6 Plus references and to preclude Apple from
20

21 ² To prove that a patent claim is invalid as obvious under 35 U.S.C. § 103, an accused infringer must show
22 “the differences between the subject matter sought to be patented and the prior art are such that the subject
23 matter as a whole would have been obvious at the time the invention was made to a person having ordinary
24 skill in the art to which said subject matter pertains.” *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352,
25 1357 (Fed. Cir. 2019) (quoting 35 U.S.C. § 103(a)); accord *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398,
26 406 (2007). “Obviousness can be proven by combining existing prior art references, while anticipation
27 requires all elements of a claim to be disclosed within a single reference.” *Cohesive Techs., Inc. v. Waters*
28 *Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008).

³ To prove that a patent claim is invalid as anticipated under 35 U.S.C. § 102, an accused infringer must
show that “a single prior art reference disclose[s] each and every limitation of the claimed invention, either
explicitly or inherently.” See *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1306 (Fed. Cir. 2019); see
also *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1377 (Fed. Cir. 2012).

1 contending “that the iPhone 6 or iPhone 6 Plus anticipate the asserted claims or otherwise
2 meet the ferrofluid limitations.” (See ECF No. 205-1 (“Mem.”) at 1–2, 5–12.⁴) In
3 response, Apple argues that Taction’s challenge to its amended invalidity contentions
4 should be rejected for three reasons. (See Opp’n at 8.) First, Apple argues that Taction
5 waived its ability to challenge Apple’s November 18, 2023 Amended Invalidity
6 Contentions by failing to raise the issue in a timely manner. (See *id.* at 8–10.) Second,
7 Apple contends that it merely supplemented its invalidity contentions as permitted by
8 Patent Local Rule 3.6. (See *id.* at 10–11.) Third and finally, Apple argues that “good
9 cause” exists under Patent Local Rule 3.6(b)(3) for it to amend its invalidity contentions.
10 (See *id.* at 12–25.) The Court addresses each of Apple’s three arguments in turn below.

11 **I. Timeliness of Taction’s Challenge**

12 Apple argues that Taction waived any challenge to the Amended Invalidity
13 Contentions by failing timely to raise its challenge to the Court. (See Opp’n at 8–10.) On
14 September 23, 2022, Judge Burkhardt issued an Amended Case Management Order that
15 provided:

16 Discovery disputes must be brought to the Court’s attention in the time and
17 manner required by § V of Judge Burkhardt’s Civil Chambers Rules. **All**
18 **discovery disputes must be raised within 30 calendar days of the service**
19 **of an objection, answer, or response** that becomes the subject of dispute, or
20 the passage of a discovery due date without response or production, and only
after counsel (and any unrepresented parties) have met and conferred to
resolve the dispute. See J. Burkhardt Civ. Chambers R. § V.

21 (See ECF No. 140 at 2 ¶ 2 (emphasis in original).) Judge Burkhardt’s Civil Chambers
22 Rules also require that “[c]ounsel shall commence the meet and confer process within **14**
23 **calendar days** of the event giving rise to the dispute.” J. Burkhardt Civ. Chambers R.
24 § V.A (emphasis in original). According to Apple, Taction failed to comply with Judge
25 Burkhardt’s timeline to raise its present challenge to the Amended Invalidity Contentions.

27
28 ⁴ A sealed version of Taction’s memorandum of points and authorities in support of its Motion also appears
at ECF No. 234.

1 (See Opp'n at 8–10.) Specifically, although the Amended Invalidity Contentions were
2 served on November 18, 2022, (1) Taction did not raise any issue with the contentions to
3 Apple until December 29, 2022; (2) the Parties did not meet and confer on the issue until
4 January 12, 2023; and (3) Taction did not raise its challenge to the Court until January 31,
5 2023, when the parties filed a joint discovery statement with the Judge Burkhardt. (*See id.*
6 at 9; *see also* Sproul Decl. ¶ 14; ECF No. 235-1 (“Ex. 5”).)

7 In response, Taction asserts that Apple’s argument fails because Judge Burkhardt
8 rejected it when she concluded that the present issue should be raised as a noticed motion
9 before the district judge. (*See* Reply at 1–2.) Although the Court disagrees with Taction
10 that Judge Burkhardt concluded its challenge was timely, the Court agrees that Apple’s
11 reliance on paragraph 2 of Judge Burkhardt’s September 23, 2022 Amended Case
12 Management Order is misplaced. By its plain terms, the provision applies only to
13 “[d]iscovery disputes.” (*See* ECF No. 140 at 2 ¶ 2.) A challenge to the disclosures in
14 another party’s infringement or invalidity contentions, however, is not a “discovery
15 dispute.” While discovery disputes in this District are generally referred to the magistrate
16 judges, motions to strike infringement and/or invalidity contentions are heard by the district
17 court judges. *See, e.g., Evolusion Concepts, Inc. v. Cross Eng’g, LLC*, No. 18-CV-0871
18 DMS (MSB), 2019 WL 13149923, at *1 (S.D. Cal. Apr. 8, 2019); *Apple Inc. v. Wi-LAN,*
19 *Inc.*, No. 14CV2235 DMS (BLM), 2018 WL 9538772, at *1 (S.D. Cal. Mar. 2, 2018); *In*
20 *re Qualcomm Litig.*, No. 17-CV-00108-GPC-MDD, 2018 WL 1406944, at *1 (S.D. Cal.
21 Mar. 21, 2018); *Multimedia Pat. Tr. v. Apple Inc.*, No. 10-CV-2618-H KSC, 2012 WL
22 4547449, at *1 (S.D. Cal. Sept. 28, 2012). Further, the deadline in paragraph 2 of the
23 Court’s scheduling order is only triggered by the service of “an objection, answer, or
24 response.” (*See* ECF No. 140 at 2 ¶ 2.) Amended invalidity contentions are not an
25 objection, answer, or response to a discovery request. The Court therefore rejects Apple’s
26 argument that Taction waived its ability to challenge the November 18, 2023 Amended

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1 Invalidity Contentions by failing to comply with the deadline in the Court’s scheduling
2 order.⁵

3 **II. Supplementation Under Patent Local Rule 3.6**

4 Apple next contends that Taction’s motion should be denied because Apple merely
5 “supplemented” its invalidity contentions as permitted by Patent Local Rule 3.6. (*See*
6 *Opp’n* at 10–11.) Specifically, Apple relies on the following sentence from Patent Local
7 Rule 3.6: “This rule does not relieve any party from its obligations under Fed. R. Civ. P
8 26 to timely supplement disclosures and discovery responses.” *See* S.D. Cal. Patent L.R.
9 3.6. Apple argues that this sentence “allow[s] for supplementation of invalidity
10 contentions, and indeed require[s] it, upon the discovery of new facts. (*See Opp’n* at 10.)
11 Taction responds that Apple’s supplementation argument relies on a strained reading of
12 Patent Local Rule 3.6 and should be rejected. (*See Reply* at 2–3.) The Court agrees with
13 Taction.

14 In the sentence on which Apple relies, Patent Local Rule 3.6 refers to Federal Rule
15 of Civil Procedure 26’s supplementation requirements, which provide:

16 A party who has made a disclosure under Rule 26(a)—or who has responded
17 to an interrogatory, request for production, or request for admission—must
18 supplement or correct its disclosure or response:

- 19 (A) in a timely manner if the party learns that in some material respect the
20 disclosure or response is incomplete or incorrect, and if the additional
21 or corrective information has not otherwise been made known to the
22 other parties during the discovery process or in writing; or
- 23 (B) as ordered by the court.

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25
26 ⁵ To be clear, although the Court ultimately concludes that Apple’s timeliness argument is without merit,
27 the Court does not condone Taction’s delay in raising the issue. Even in the absence of a firm deadline to
28 file this Motion, an attorney should have taken the time to review the Amended Invalidity Contentions
soon after they were served on Taction. For the reasons discussed below, however, the Court concludes
that Taction’s delay was not unreasonable and that the procedural equities ultimately favor Taction.

1 Fed. R. Civ. P. 26(e)(1). By its plain terms, Rule 26(e)(1)'s supplementation requirements
2 only apply to Rule 26(a) disclosures,⁶ responses to interrogatories, responses to requests
3 for production, and responses to requests for admissions. An accused infringer's invalidity
4 contentions do not qualify as any of the documents specified by Rule 26(e)(1). As such,
5 Patent Local Rule 3.6 and Rule 26(e)(1) do not provide any basis for the "supplementation"
6 of infringement contentions.⁷ *Cf. Bell Semiconductor*, 2023 WL 2342037, at *6
7 (explaining to patentee that any "supplementation" of its infringement contentions
8 constitutes "amendments" to those contentions). Indeed, courts in this District have
9 expressly held that "[t]he Court's Patent Local Rules do not allow amendments to
10 contentions as a matter of course when new information is revealed in discovery." *See*
11 *Echologics*, 2022 WL 17724142, at *7 (internal quotation marks omitted) (quoting *Zest IP*
12 *Holdings*, 2014 WL 358430, at *3); *accord Pelican*, 2023 WL 2127995, at *3. "Rather, a
13 party seeking to amend its infringement or invalidity contentions must satisfy the relevant
14 provisions set forth in Patent Local Rule 3.6," which for infringement contentions are the
15 provisions in Rule 3.6(a) and for invalidity contentions are the provisions in Rule 3.6(b).
16 *See Echologics*, 2022 WL 17724142, at *7; *accord Pelican*, 2023 WL 2127995, at *3.

17 Moreover, the Court rejects Apple's assertion that its Amended Invalidity
18 Contentions have not "meaningfully changed." Contrary to Apple's assertions, it did not
19 merely amend its infringement contentions to disclose "a single fact." (*See Opp'n at*
20 *10–11, 20.*) Rather, Apple made substantive amendments to its invalidity contentions that
21 represent new invalidity theories. That the changes at issue are substantive amendments
22 and new invalidity theories can be seen from an examination of the provisions in Patent
23 Local Rules 3.3(b) and (c), which contain disclosure requirements for an accused
24

25 ⁶ Rule 26(a) disclosures are initial disclosures, expert disclosures, and pretrial disclosures. *See* Fed. R.
26 Civ. P. 26(a).

27 ⁷ Taction persuasively argues that the more sensible reading on the last sentence of Patent Local Rule 3.6
28 is that it merely reminds parties that the passing of the deadlines set forth in Rule 3.6 does not permit a
party to ignore its duties to supplement under Rule 26. (*See Reply at 3.*)

1 infringer’s invalidity contentions. Patent Local Rule 3.3(b), for example, requires the
2 disclosure of “[w]hether each item of prior art anticipates each asserted claim or renders it
3 obvious.” S.D. Cal. Patent L.R. 3.3(b). In the Amended Invalidity Contentions, Apple for
4 the first time asserted that the two prior art references at issue anticipate the asserted claims
5 of the asserted patents. (*See* Ex. E at p. 247; Ex. F at p. 315; Ex. G. at p. 377; Ex. H at
6 429.) As such, those changes are substantive amendments to Apple’s Rule 3.3(b)
7 disclosures and are new invalidity theories even if the prior art references had been
8 previously disclosed as obviousness references in earlier contentions. *See, e.g., Polaris*
9 *PowerLED Techs., LLC v. VIZIO, Inc.*, No. SACV181571JVSDFMX, 2020 WL 4258663,
10 at *4 (C.D. Cal. May 14, 2020) (striking expert opinion for disclosing new theory of
11 invalidity where expert attempted to use prior art as an anticipatory reference when the
12 prior art had only been previously disclosed as an obviousness reference in the invalidity
13 contentions).

14 Similarly, Patent Local Rule 3.3(c) requires: “A chart identifying where specifically
15 in each alleged item of prior art each element of each asserted claim is found.” *See* S.D.
16 Cal. Patent L.R. 3.3(c). In the Amended Invalidity Contentions, Apple for the first time
17 asserted that the two prior art references at issue satisfy the ferrofluid limitations in the
18 asserted claims. (*See* Ex. E at pp. 281–87; Ex. F at pp. 344–51; Ex. G. at pp. 397–402; Ex.
19 H at pp. 449–54.) As such, those changes are substantive amendments to Apple’s Rule
20 3.3(c) disclosures and are new invalidity theories even if the prior art references had been
21 previously disclosed as satisfying other limitations.⁸ *See, e.g., Asia Vital Components Co.*

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23
24 ⁸ The Court notes that district courts interpret changes to infringement contentions in a similar way. A
25 change to even just one claim limitation to identify a different element of an accused product is considered
26 a new theory of infringement. *See, e.g., Echologics, LLC v. Orbis Intelligent Sys., Inc.*, No. 21-CV-01147-
27 RBM-AHG, 2023 WL 2756492, at *9 (S.D. Cal. Mar. 27, 2023) (granting motion to strike expert report
28 that identified a different component in the accused product as satisfying the relevant claim limitation than
was disclosed in the infringement contentions); *Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 13-CV-03999-
BLF, 2015 WL 3640694, at *3–4 (N.D. Cal. June 11, 2015) (same); *MediaTek Inc. v. Freescale*
Semiconductor, Inc., No. 11-CV-5341 YGR, 2014 WL 2854773, at *2 (N.D. Cal. June 20, 2014) (same).

1 *v. Asetek Danmark A/S*, No. 16-CV-07160-JST, 2018 WL 4945316, at *5 (N.D. Cal.
2 Oct. 11, 2018) (striking expert opinions that the “prior art teaches additional limitations not
3 identified in the invalidity contentions” on the grounds that those opinions represent “new
4 invalidity theories that were not properly disclosed”); *Largan*, 2014 WL 6882275, at *5
5 (same); *Verinata Health, Inc. v. Sequenom, Inc.*, No. C 12-00865 SI, 2014 WL 4100638,
6 at *7–8 (N.D. Cal. Aug. 20, 2014) (same).⁹

7 Because the changes at issue are substantive amendments to Apple’s invalidity
8 disclosures under Patent Local Rule 3.3(b) and 3.3(c), for those amendments to have been
9 proper, Apple needed to satisfy one of the provisions set forth in Patent Local Rule 3.6(b).

11
12 ⁹ At the hearing, Apple argued that district courts allow modifications to previously charted prior art, citing
13 to *Kilopass Technology Inc. v. Sidense Corporation*, No. C 10-02066 SI, 2012 WL 1901198, at *2–3
14 (N.D. Cal. May 24, 2012); *Oracle America, Inc. v. Google Inc.*, No. C 10-03561 WHA, 2011 WL
15 3443835, at *5 (N.D. Cal. Aug. 8, 2011); and *Chemfree Corp. v. J. Walter, Inc.*, No. CIV. 1:04-CV-
16 3711JTC, 2008 WL 4845129, at *4 (N.D. Ga. Aug. 27, 2008). Not only is this argument untimely, *see*,
17 *e.g.*, *ABS Glob., Inc. v. Cytonome/ST, LLC*, 984 F.3d 1017, 1027 (Fed. Cir. 2021) (finding argument
18 waived because it was “raised for the first time during oral argument”); *CliniComp*, 2022 WL 16985003,
19 at *21 (same), but the Court does not find Apple’s reliance on these three cases persuasive as none of the
20 cases appear to deal with a situation—like here—where although the accused infringer previously charted
21 the reference, the accused infringer is now attempting to assert for the first time that the reference satisfies
22 a new limitation.

23 In *Oracle*, for example, the accused infringer previously disclosed the references at issue as anticipatory
24 references and was seeking to amend its charts to now disclose obviousness combinations based on those
25 references. *See* 2011 WL 3443835, at *5. Because the references at issue were previously disclosed and
26 charted as anticipatory references, the accused infringer had already asserted that the references met each
27 and every limitation at issue, meaning there were no new limitation disclosures at issue with respect to
28 those amendments. In *Chemfree*, the accused infringers sought to add more detail to previously charted
references. *See* 2008 WL 4845129, at *4 (“[T]he new claim charts appear to be more detailed than the
claim charts included in Defendants’ previous invalidity contentions.”). There is no indication that these
additional details included asserting that the references satisfied new limitations. Finally, in *Kilopass*, the
accused infringer sought to amend its contentions to assert new obviousness combinations. *See* 2012 WL
1901198, at *2–3. There is no indication that those new combinations included asserting that the
references at issue satisfied new limitations. As such, *Kilopass*, *Oracle*, and *Chemfree* are all
distinguishable from the present case.

By contrast, the Court found three cases in which an accused infringer attempted to assert that a previously
disclosed prior art reference satisfied a new claim limitation. In each case, the district court struck the
new invalidity theory. *See, e.g., Asia Vital*, 2018 WL 4945316, at *5; *Largan*, 2014 WL 6882275, at *5;
Verinata, 2014 WL 4100638, at *7–8.

1 *See Pelican*, 2023 WL 2127995, at *3; *Echologics*, 2022 WL 17724142, at *7; *Zest IP*
2 *Holdings*, 2014 WL 358430, at *3.

3 **III. Good Cause Under Patent Local Rule 3.6(b)(3)**

4 Finally, Apple argues that there exists good cause to amend its Amended Invalidity
5 Contentions under Patent Local Rule 3.6(b)(3). (*See Opp'n* at 12–25.) By its plain terms,
6 however, Patent Local Rule 3.6(b)(3) only permits amendment of an accused infringer's
7 invalidity contentions “upon a *timely motion* showing good cause.” *See* S.D. Cal. Patent
8 L.R. 3.6(b)(3) (emphasis added). A request for leave to amend in an opposition brief to a
9 motion to strike that is filed four months after the amended contentions at issue were
10 already served is neither “timely” nor a “motion.” *See* Fed. R. Civ. P. 7(b)(1) (“A request
11 for a court order must be made by motion.”). As such, Apple cannot rely on Patent Local
12 Rule 3.6(b)(3) to justify the amendments at issue.

13 At the hearing, Apple argued that it should be permitted to amend its invalidity
14 contentions through its Opposition, citing—concededly for the first time—to *Slot Speaker*
15 *Technologies, Inc. v. Apple, Inc.*, No. 13-CV-01161-HSG(DMR), 2017 WL 235049, at *8
16 (N.D. Cal. Jan. 19, 2017), and *0912139 B.C. Ltd. v. Rampion USA Inc.*, No. C18-1464JLR,
17 2019 WL 3082290, at *8 (W.D. Wash. July 15, 2019). The Court agrees with Taction that
18 it was improper for Apple to raise this argument for the first time at the hearing, and,
19 therefore, the argument is untimely and waived. *See, e.g., ABS Glob., Inc.*, 984 F.3d at
20 1027; *CliniComp*, 2022 WL 16985003, at *21. In any event, those two cases are of no help
21 to Apple here. *Slot Speaker* is a decision from the Northern District of California, and
22 *0912139 B.C.* is a decision from the Western District of Washington. The Patent Local
23 Rules for the Northern District of California and the Western District of Washington only
24 require an “order of the Court upon a timely showing of good cause” for a party to be able
25 to amend its invalidity contentions. *See* N.D. Cal. Patent L.R. 3-6; W.D. Wash. Patent L.R.
26 124. By contrast, Southern District of California Patent Local Rule 3.6(b)(3) specifically
27 and expressly requires “a *timely motion* showing good cause.” *See* S.D. Cal. Pat. L.R.

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1 3.6(b)(3) (emphasis added). Because Apple never filed a “timely motion,” Patent Local
2 Rule 3.6(b)(3) is inapplicable.

3 The Court also finds persuasive Taction’s argument that it would be unwise to permit
4 parties to violate the Patent Local Rules and then later seek retroactive permission to amend
5 because such a procedure would make civil litigation entirely unwieldy for both parties
6 and the judiciary and incentivize untimely disclosures. (*See Reply at 5.*) The Court agrees
7 that an “amend first, ask for permission later” policy would contravene and undermine the
8 policies underlying the Court’s Patent Local Rules, which “are designed to require parties
9 to crystallize their theories of the case early in the litigation and to adhere to those theories
10 once they have been disclosed.” *See CliniComp*, 2022 WL 16985003, at *12 (S.D. Cal.
11 Nov. 15, 2022). In any event, allowing a party to request amendment retroactively is
12 clearly not permitted under the plain language of Patent Local Rule 3.6(b)(3), which
13 requires the filing of “a timely motion.”

14 In sum, the amendments at issue in Apple’s Amended Invalidity Contentions violate
15 the Court’s Patent Local Rules, specifically Patent Local Rule 3.6(b). As such, the proper
16 remedy is to strike those portions of the contentions and preclude Apple from asserting at
17 trial that the iPhone 6 or the iPhone 6s satisfies the ferrofluid limitations in the asserted
18 claims and preclude Apple from asserting that the iPhone 6 or the iPhone 6s anticipates the
19 asserted claims. Although Apple argued at the hearing that it would be an “extraordinary
20 remedy” for the Court to strike the fact that the iPhone 6 has ferrofluid from the case, (*see*
21 *also, e.g.*, ECF No. 235 at 1, 11), the Court is not striking a “fact.” Rather, the Court is
22 striking untimely invalidity theories that were improperly disclosed in violation of the
23 Court’s Patent Local Rules. Consistent with the holdings of many district courts, any
24 invalidity theories that are not properly disclosed pursuant to the Court’s Patent Local
25 Rules “are barred from presentation at trial (whether through expert opinion testimony or
26 otherwise).” *See Bell Semiconductor*, 2023 WL 2342037, at *3; *accord Pelican*, 2023 WL
27 2127995, at *3; *Simpson Strong-Tie Co., Inc. v. Oz-Post Int’l, LLC*, 411 F. Supp. 3d 975,
28 981 (N.D. Cal. 2019); *Huawei Techs., Co, Ltd v. Samsung Elecs. Co.*, 340 F. Supp. 3d 934,

1 946 (N.D. Cal. 2018); *Verinata*, 2014 WL 4100638, at *3. Indeed, the Federal Circuit has
2 explained: “Because patent local rules are essentially a series of case management orders,
3 a district court may impose any just sanction for the failure to obey them, including refusing
4 to allow the disobedient party to support or oppose designated claims or defenses, or
5 prohibiting that party from introducing designated matters in evidence.” *Phigenix, Inc. v.*
6 *Genentech, Inc.*, 783 F. App’x 1014, 1016 (Fed. Cir. 2019) (internal quotation marks
7 omitted) (affirming district court’s striking of infringement theory from expert report for
8 failure to comply with the patent local rules (quoting *O2 Micro*, 467 F.3d at 1363)). As
9 such, preclusion of these improperly disclosed invalidity theories from presentation at trial
10 is the proper remedy here.

11 CONCLUSION

12 For the reasons above, the Court **GRANTS** Taction’s Motion to Strike Apple’s
13 Amended Invalidity Contentions (ECF No. 205) and **PRECLUDES** Apple from asserting
14 at trial that the iPhone 6 or the iPhone 6 Plus (1) satisfies the ferrofluid limitations in the
15 asserted claims, and (2) anticipates the asserted claims.

16 **IT IS SO ORDERED.**

17 Dated: April 17, 2023



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19 Honorable Todd W. Robinson
20 United States District Judge
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