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Southern District of California Strikes Defendant's Invalidity Theories and References for Failing to Comply With District's Patent Local Rules

In *Taction Technology, Inc. v. Apple Inc.*, the United States District Court for the Southern District of California recently granted plaintiff Taction Technology, Inc.'s ("Taction") motion to strike portions of defendant Apple Inc.'s ("Apple") amended invalidity contentions. The case is a patent infringement action that addresses the distinctions between discovery under the Federal Rules of Civil Procedure and contention disclosure requirements under a district's local patent rules. In *Taction*, following the district court's claim construction order, Apple served "Post Claim Construction Amended Invalidity Contentions" in which it alleged for the first time that two prior art references anticipate the asserted claims of two of the patents-in-suit and that the same prior art references satisfy a claim limitation at issue. Taction filed a motion to strike the two new prior art references.

Apple raised multiple issues in opposition. First, Apple argued that the motion was not timely because it was not brought within the period to raise *discovery disputes* in the court's case management order. The court rejected that argument because, in the Southern District of California, a challenge to a party's infringement or invalidity contentions is not a "discovery dispute."

Second, Apple argued that the motion should be denied because it merely "supplemented" its invalidity contentions, as is allowed by Patent Local Rule 3.6. The Southern District of California's Patent Local Rule 3.6, which is similar to the District of New Jersey's Local Patent Rule 3.7, includes the following statement: "This rule does not relieve any party from its obligations under Fed. R. Civ. P. 26 to timely supplement disclosures and discovery responses." However, the district court made clear that the supplementation requirements of Fed. R. Civ. P. 26(e)(1) do not apply to the "supplementation" of infringement or invalidity contentions, only to

Rule 26(a) disclosures, *i.e.*, responses to interrogatories, responses to requests for production, and responses to requests for admissions. In so ruling, the district court noted that “courts in this District have expressly held that ‘[t]he Court’s Patent Local Rules do not allow amendments to contentions as a matter of course when new information is revealed in discovery.’” *Id.* at *13 (citing cases). The same is true in the District of New Jersey. See *Merck Sharp & Dohme Corp. v. Sandoz, Inc.* No. 12–3289, 2014 WL 997532, at *3 (Jan. 6, 2014) (noting that the Local Patent Rules, *inter alia*, require that a party “promptly mov[e] to amend when new evidence is revealed in discovery”) (quoting *O2 Micro Int’l Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355, 1363 (Fed. Cir. 2006)).

Lastly, Apple argued that its amendments do not “meaningfully change[]” its contentions. However, the district court reasoned that Apple’s amendments constituted “substantive amendments” to its infringement and invalidity disclosures that required “a timely motion showing good cause” pursuant to Patent Local Rule 3.6(b). Amendments to infringement and invalidity contentions in the District of New Jersey similarly require “a timely application and showing of good cause.” See D.N.J. Local Patent Rule 3.7. Not all district courts expressly require a motion, however, and the district court noted that the Patent Local Rules for the Northern District of California and Western District of Washington required only an “order of the Court upon a timely showing of good cause” for an amendment.

Finally, in granting Taction’s motion, the court supported its decision by addressing the procedural of motions to amend contentions. It concluded that allowing parties to “amend first, ask permission later” . . . would contravene and undermine the policies underlying the Court’s Patent Local Rules,” which require the disclosure of theories early in the case. *Id.* at *17. At least one court in the District of New Jersey has made a similar ruling. See *Merck*, 2014 WL 997532, at *7 (“By choosing not to seek leave to amend but to instead insert . . . New Prior Art in its expert report, [the defendant] essentially put the burden on [the plaintiff] to show why it should not be allowed, rather than bearing the burden itself under Rule 3.7 to show why the amendment should be allowed. This the Court could not allow.”).

Thus, the district court concluded that the proper remedy was to strike the amended portions of Apple's contentions and preclude Apple from asserting those theories at trial. Patent litigants need to be vigilant about adhering to the specific local rules in each district court or, as shown in this case, they can lose the opportunity to present various theories at trial.

Gibbons will continue to monitor and report developments in patent litigation.

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