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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

LARGAN PRECISION CO, LTD,
Plaintiff,
v.
GENIUS ELECTRONIC OPTICAL CO.,
LTD.,
Defendant.

Case No. 13-cv-02502-JD
**ORDER ON SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEFING**
Re: Dkt. Nos. 64, 65

On June 4, 2014, Defendant Genius Electronic Optical Co., Ltd. (“Genius”) filed a Statement of Recent Decision Regarding Indefiniteness Under 35 U.S.C. § 112, ¶ 2, attaching the Supreme Court’s June 2, 2014 decision in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014). Dkt. No. 64. At the telephonic status conference that was held on June 6, 2014, Genius requested that it be permitted to submit an expert declaration on claim construction in light of the *Nautilus* decision. Dkt. No. 65. The Court took Genius’s request under submission, and now denies it.

Several factors weigh against Genius’s request. As an initial matter, our district has strict rules that require all discovery relating to claim construction, including any depositions of experts, to be completed within 30 days after service and filing of the Joint Claim Construction and Prehearing Statement. *See* Patent L.R. 4-4. The parties followed this rule and expressly agreed in the Joint Claim Construction and Prehearing Statement that “no expert witnesses will be used for claim construction.” Dkt. No. 35 at 8.

The *Nautilus* decision does not justify allowing Genius to renege on this agreement or depart from the local rules. Genius itself characterized the “change in law” in *Nautilus* as follows: “In *Nautilus*, . . . [t]he Court held that definiteness under Section 112, Paragraph 2 requires ‘that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled

1 in the art about the scope of the invention with reasonable certainty.” Dkt. No. 64 at 1 (citing
2 *Nautilus*, No. 13-369, slip op. at 11). But Genius already briefed this same standard in the
3 responsive claim construction brief it filed on April 4, 2014. See Dkt. No. 40 at 6 (arguing that a
4 claim is “invalid for indefiniteness if ‘a person of ordinary skill in the art [can]not determine the
5 bounds of the claims’”) (citing *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249
6 (Fed. Cir. 2008)). And Genius had already concluded that reliance on *Halliburton* did not require
7 expert witness testimony. The fact that *Nautilus* adopted the *Halliburton* standard does not
8 suddenly re-arrange the landscape to permit opening expert discovery and testimony. In addition,
9 the parties are well down the road in this case and the extra time required to allow for experts
10 would unnecessarily delay progress toward resolution.

11 As stated at the June 6, 2014 status conference, the Court will permit both sides to submit
12 supplemental claim construction briefs of 10 pages or less (per side), applying *Nautilus* to the facts
13 of this case. Both parties are directed to file their supplemental briefs on or before June 19, 2014.
14 No expert testimony is permitted.

15 **IT IS SO ORDERED.**

16 Dated: June 12, 2014

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19 JAMES DONATO
20 United States District Judge

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