

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

CHRIMAR SYSTEMS INC, et al.,
Plaintiffs,
v.
CISCO SYSTEMS INC, et al.,
Defendants.

Case No. [13-cv-01300-JSW](#)

**NOTICE OF TENTATIVE RULING
AND REQUIRING SUPPLEMENTAL
BRIEFING IN ADVANCE OF HEARING**

Re: Docket. Nos. 338-339,

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD, PLEASE TAKE NOTICE OF THE FOLLOWING TENTATIVE RULING on Defendants' motion for leave to amend, which is scheduled for a hearing on April 22, 2016. The Court issues this tentative ruling in the hopes that the parties might be able to meet and confer and resolve this issue without further Court involvement. If they are able to do so, they shall file a stipulation and order to that effect by April 20, 2016. If they cannot, the Court shall resolve the motion in advance of the deadline to file motions for summary judgment.

Federal Rule of Civil Procedure 15(a) permits a party to amend its pleading once as a matter of right any time before a responsive pleading has been served. Once a responsive pleading has been served, however, the amendment requires written consent of the adverse party or leave of the court, and leave "shall be freely given when justice requires." Fed. R. Civ. P. 15(a). The Court considers five factors to determine whether a motion for leave to file an amended complaint should be granted: "(1) bad faith, (2) undue delay, (3) prejudice to the opposing party, (4) futility of amendment[,]" and (5) whether the moving party previously amended a pleading. *In re Western States Wholesale Nat. Gas Antitrust Litig.*, 715 F.3d 716, 738 (9th Cir. 2013) (quoting *Allen v. City of Beverly Hills*, 911 F.2d 367, 373 (9th Cir. 1990)).

United States District Court
Northern District of California

1 Each factor is not given equal weight. *Eminence Capital, LLC v. Aspeon, Inc.*, 316 F.3d
2 1048, 1052 (9th Cir. 2003); *Bonin v. Calderon*, 59 F.3d 815, 845 (9th Cir. 1995). “Absent
3 prejudice, or a strong showing of any of the remaining ... factors, there exists a *presumption* under
4 Rule 15(a) in favor of granting leave to amend.” *Eminence Capital*, 316 F.3d at 1052 (emphasis
5 in original).

6 In brief, the Court tentatively finds that each of these factors would support granting leave
7 to amend. The Court tentatively concludes there has been no bad faith and, to the extent there has
8 been some delay, that, on its own would not justify denying the motion. With respect to futility,
9 the Court’s tentative view is that Defendants have *alleged* sufficient facts to show that amendment
10 would not be futile and that, on this record, the Court could not rule as a matter of law the
11 allegations fail to satisfy the standards required to show specific intent to deceive and materiality.
12 *See Therasense v. Becton , Dickinson & Co.*, 649 F.3d 1276, 1290-93 (Fed. Cir. 2011). Rather, it
13 appears to the Court that the arguments presented in opposition to the motion are better addressed
14 in the context of the impending motions for summary judgment.

15 Plaintiffs argue that if the Court grants the motion, it “may” warrant reopening discovery
16 and the exchange of additional expert reports “to the extent” an expert in patent office practice is
17 warranted. (*See Opp. Br.* at 4:16-19.) The Court tentatively finds that, on the current record,
18 Plaintiffs have not made a strong showing of prejudice. The Court also tentatively concludes that
19 Plaintiffs have not shown that any potential prejudice could not be cured by permitting some
20 limited and targeted discovery on an expedited basis. Because prejudice is the factor that, in
21 general, carries the greatest weight, the Court concludes supplemental briefing would be useful.

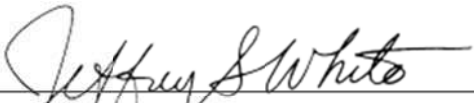
22 Accordingly, the Court **HEREBY ORDERS** Plaintiffs to file a supplemental brief, not to
23 exceed five (5) pages, that outlines in detail the discovery they would need to obtain to adequately
24 respond to a claim or defense of inequitable conduct by **12:00 p.m. on April 13, 2016**. By this
25 Order, the Court is not inviting Plaintiffs to submit a “wish list” of any and all possible discovery
26 they might need to respond to a claim for inequitable conduct. Rather, the Court expects Plaintiffs
27 to respond to this request in good faith and in compliance with Federal Rule of Civil Procedure
28 26(b)(1). Plaintiffs should also provide an estimate of how much time they expect would be

1 required to complete any additional discovery. Defendants may file a three (3) page response by
2 **3:00 p.m. on April 15, 2016.**

3 If, after considering the parties' supplemental briefs, the Court concludes that the motion
4 can be resolved without oral argument, it will notify the parties in advance of the hearing date.

5 **IT IS SO ORDERED.**

6 Dated: April 7, 2016

7 
8 _____
9 JEFFREY S. WHITE
10 United States District Judge
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28