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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

CELLSPIN SOFT, INC.,

Plaintiff,

v.

FITBIT, INC.,

Defendant.

**ORDER DENYING DEFENDANTS' MOTION TO
STRIKE OR TO COMPEL AMENDMENT OF
CELLSPIN'S INVENTIVENESS CONTENTIONS**

Case No. 17-cv-05928-YGR

Dkt. No. 140

v.

MOOV, INC.,

Defendant.

Case No. 17-cv-05929-YGR

Dkt. No. 123

v.

ADIDAS AMERICA, INC.,

Defendant.

Case No. 17-cv-05930-YGR

Dkt. Nos. 97, 98

v.

NIKE, INC.,

Defendant.

Case No. 17-cv-05931-YGR

Dkt. No. 121

v.

UNDER ARMOUR, INC.,

Defendant.

Case No. 17-cv-05932-YGR

Dkt. No. 101

v.

FOSSIL GROUP, INC., ET AL.,

Defendants.

Case No. 17-cv-05933-YGR

Dkt. No. 43, 69

v.

GARMIN INTERNATIONAL, INC., ET AL.,

Defendants.

Case No. 17-cv-05934-YGR

Dkt. No. 117

1 v.

2 **NIKON AMERICAS, INC., ET AL.,**
3 Defendants.

Case No. 17-cv-05936-YGR
Dkt. No. 119

4
5 Defendants in the above-captioned patent infringement cases move to strike or, alternatively, to
6 compel plaintiff's inventiveness contentions.¹ Defendants object to five aspects of plaintiff's inventiveness
7 contentions served on June 19, 2020: plaintiff "buries" the contentions in 1,400 pages of charts; the
8 contentions cite inadmissible evidence as support; plaintiff reserves the right to rely on additional documents
9 in rebuttal; plaintiff reserves the right to rely on inventor and expert testimony; and the contentions fail to tie
10 the inventive concepts to the language of specific limitations.

11 Defendants largely misunderstand the nature of contentions. Contentions do not require a party to
12 prove its case with admissible evidence. *See AntiCancer, Inc. v. Pfizer, Inc.*, 769 F.3d 1323, 1331 (Fed. Cir.
13 2014) (analyzing this district's local rules). Nor do they require premature expert discovery. *See Amgen*
14 *Inc. v. Sandoz Inc.*, No. 14-cv-04741-RS (MEJ), 2017 WL 1352052, at *2 (N.D. Cal. Apr. 13, 2017).
15 Instead, the purpose of contentions is to "require parties to crystallize their theories of the case early in the
16 litigation and to adhere to those theories once they have been disclosed." *Shared Memory Graphics LLC v.*
17 *Apple, Inc.*, 812 F. Supp. 2d 1022, 1024 (N.D. Cal. 2010) (citation omitted). As such, contentions require
18 parties to disclose *theories* and *facts*—not all evidence to support those theories and facts. *See Asia Vital*
19 *Comopnents Co., Ltd. v. Asetek Danmark A/S*, 77 F. Supp. 3d 990, 1003-04 (N.D. Cal. 2019); *Finjan, Inc. v.*
20 *Symantec Corp.*, No. 14-cv-02998-HSG (JSC), 2018 WL 620169, at *2 (N.D. Cal. Jan. 30, 2018). The
21 Court's scheduling order recognizes this distinction by requiring plaintiff to serve its "full and final
22 contentions" (along with "factual and legal bas[e]s" that support those contentions), and to separately
23 produce all evidence upon which plaintiff may rely in support of its contention. (Dkt. No. 113.)
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27 ¹ The Court has previously found the asserted patents invalid under 35 U.S.C. § 101. Following
28 reversal by the Federal Circuit based on plaintiff's allegations of an "inventive concept" under the second
step of *Alice*, the Court required plaintiff to produce inventiveness contentions disclosing and supporting
such "inventive concepts."

1 Plaintiff, on the other hand, adopts the opposite extreme and argues that it is not bound by its
2 contentions at all because defendants have the burden to prove invalidity. That, too, misunderstands the
3 nature of contentions. “The ultimate burden of invalidity . . . does not dictate the scope of discovery.” *SPH*
4 *Am., LLC v. Res. in Mot., Ltd.*, 13cv2320 CAB (KSC), 2016 WL 6305414, at *2 (S.D. Cal. Aug. 16, 2016)
5 (citing Fed. R. Civ. P. 26(b)(1)). The Federal Rules of Civil Procedure do not require the party who carries
6 the burden on an issue to make a *prima facie* case before it is entitled to discover rebuttal information. *Id.*;
7 *see Amgen*, 2017 WL 1352052, at *2 (granting motion to compel validity contentions); *Finjan, Inc. v. ESET,*
8 *LLC*, 17CV183 CAB (BGS), 2018 WL 4772124, at *5 (S.D. Cal. Oct. 3, 2018) (same); *Implicit Networks,*
9 *Inc. v. Juniper Networks, Inc.*, 3:10-cv-4234, Dkt. No. 92 at 2 (N.D. Cal. June 6, 2012) (explaining that
10 validity contentions are based on information equally available to both parties).

11 Here, plaintiff has the better knowledge of the alleged inventive concept of the patents. Moreover,
12 the Court has already found—and has had its decision affirmed by the Federal Circuit—that the asserted
13 patents are directed to patent ineligible idea and that the specification provides scant support for an inventive
14 concept. The case therefore hinges on plaintiff’s allegations of an inventive concept beyond the already-
15 determined patent ineligible idea. *See Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1307, 1316-19 (Fed. Cir.
16 2019). Under these circumstances, it is entirely appropriate to require plaintiff to produce inventiveness
17 contentions to prevent a “shifting sands” approach to litigation where defendants prove that a certain
18 implementation was conventional only to have plaintiff assert a wholly new inventive concept. *See O2*
19 *Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1365 (Fed. Cir. 2006). Accordingly, plaintiff
20 will be restricted to arguing the alleged inventive concepts disclosed in its contentions and any new theories
21 will be struck pursuant to Federal Rule of Civil Procedure 26.

22 The Court has reviewed plaintiff’s cover pleading and chart attached to defendants’ motion and
23 cannot conclude that plaintiff violated the Court’s scheduling order. The cover pleading identifies fourteen
24 alleged inventive concepts and the chart states an inventive concept tied to the limitation at hand. (*See* Dkt.
25 No. 117-5 at 38.) To the extent that defendants contend that other inventive concepts are not tied to specific
26 limitations, the parties are **ORDERED** to meet and confer to discuss any alleged inventive concept for which
27 the underlying limitation or limitations are unclear. The Court **DENIES** defendants’ motion.
28

1 In light of the timing of this Order, the parties shall advise the Court whether any adjustment of the
2 scheduling order is necessary.

3
4 This Order terminates docket number 117 in case number 4:17-cv-5934.

5
6 **IT IS SO ORDERED.**

7 Dated: July 17, 2020

8 
9 **YVONNE GONZALEZ ROGERS**
10 **UNITED STATES DISTRICT COURT JUDGE**