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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

PERSONALWEB TECHNOLOGIES, LLC
AND LEVEL 3 COMMUNICATIONS, LLC,

Plaintiffs,

v.

GITHUB, INC.,

Defendant.

Case No. 5:16-cv-01267-EJD (HRL)

**ORDER GRANTING IN PART
PLAINTIFF’S MOTION FOR LEAVE
TO AMEND INFRINGEMENT
CONTENTIONS**

Re: Dkt. No. 122

PersonalWeb Technologies, LLC (“PersonalWeb”) and Level 3 Communications, LLC (“Level 3”) (collectively “Plaintiffs”) sued GitHub, Inc. for patent infringement in the U.S. District Court for the Eastern District of Texas. Dkt. No. 24. Plaintiffs sued IBM in a separate action in the same district. *PersonalWeb Technologies, LLC v. IBM*, No. 6:12-CV-661-LED (E.D. Tex. 2012). Plaintiffs served infringement contentions in December 2013. Dkt. No. 85-9 at 7. The court stayed both cases for fourteen months pending completion of related inter partes proceedings before the USPTO. Dkt. Nos. 62, 72. Judge Rodney Gilstrap lifted the stay and consolidated the GitHub and IBM cases for pretrial purposes. Dkt. No. 80.

In February 2016, Judge Gilstrap issued an Order of Conditional Transfer to the Northern District for both GitHub and IBM effective “immediately upon entry of [his] *Markman* opinion.” Dkt. 89 at 6. Judge Gilstrap issued his claim construction order on March 11. Dkt. No. 93. The case appeared on the Northern District docket on March 15, Dkt. No. 97, and was eventually reassigned to Judge Davila on April 1, Dkt. No. 113. On May 31, PersonalWeb moved this court to amend its infringement contentions. Dkt. No. 122. The court vacates the hearing set for this motion and now grants the motion in part for the reasons discussed below.

1 **Legal Standard**

2 A party may amend its infringement contentions “only by order of the Court upon a timely
3 showing of good cause.” Patent L.R. 3-6. “Good cause for granting a motion to amend
4 infringement contentions exists when the moving party shows (1) that it was diligent in amending
5 its contentions; and (2) that the nonmoving party will not suffer undue prejudice if the motion is
6 granted.” *Angioscore, Inc. v. TriReme Med., Inc.*, No. 12-cv-03393-YGR, 2015 WL 75187, at *4
7 (N.D. Cal. Jan. 6, 2015) (citing *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355,
8 1366 (Fed. Cir. 2006)). One of the enumerated bases supporting a finding good cause is “[a]
9 claim construction by the Court different from that proposed by the party seeking amendment.”
10 Patent L.R. 3-6(a).

11 But a court’s differing claim construction “in and of itself does not constitute good cause,”
12 and the moving party must still establish its diligence. *Verinata Health, Inc. v. Sequenom, Inc.*,
13 No. 12-cv-00865-SI, 2014 WL 789197, at *2 (N.D. Cal. Feb. 26, 2014). The Local Rules
14 previously required parties to move to amend infringement contentions “not later than 30 days
15 after service by the Court of its Claim Construction Ruling.” *See LG Elecs. Inc. v. Q-Lity*
16 *Computer Inc.*, 211 F.R.D. 360, 367 (N.D. Cal. 2002). The rules now require only that the motion
17 be “timely,” Patent L.R. 3-6, but some Northern District courts continue to treat 30 days as a
18 noteworthy threshold, *see Tech. Properties Ltd. LLC v. Canon Inc.*, No. 14-3643-CW, 2016 WL
19 1360756, at *3 (N.D. Cal. Apr. 6, 2016). “However, even if the movant was arguably not diligent,
20 the court retains discretion to grant leave to amend.” *Linex Techs., Inc. v. Hewlett-Packard Co.*,
21 No. C13-159 CW, 2013 WL 5955548, at *1 (N.D. Cal. Nov. 6, 2013); *see also Apple Inc. v.*
22 *Samsung Electronics Co.*, No. CV 12-00630 LHK, 2012 WL 5632618 (N.D. Cal. Nov. 15, 2012).

23 **Discussion**

24 Judge Gilstrap’s claim construction was different from that proposed by Plaintiffs. Dkt.
25 No. 93. Plaintiffs argued that the court should give the disputed terms “licensed,” “unlicensed,”
26 “authorized,” “unauthorized,” and “authorization” their plain and ordinary meaning. Dkt. No. 85
27 at 7, 9. The court instead provided a specific construction for each term. Dkt. No. 93 at 25, 28.
28 This discrepancy supports a finding of good cause. Patent L.R. 3-6(a).

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with regard to the amendment both parties agreed to, Dkt. Nos. 123-2, 123-3, and grants their motion to make this specific amendment.

IT IS SO ORDERED.

Dated: 6/28/16



HOWARD R. LLOYD
United States Magistrate Judge