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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

ZEST IP HOLDINGS, LLC and ZEST
ANCHORS, LLC,

Plaintiffs,

vs.

IMPLANT DIRECT MFG, LLC et al.,

Defendants.

CASE NO. 10cv0541-GPC-WVG

ORDER:

**1. DENYING DEFENDANTS’
MOTION FOR PARTIAL
RECONSIDERATION AND
RENEWED MOTION TO AMEND
INVALIDITY CONTENTIONS**

[Dkt. No. 306]

**2. DENYING WITHOUT
PREJUDICE DEFENDANTS’
MOTION TO FURTHER AMEND
INVALIDITY CONTENTIONS**

[Dkt. No. 306]

**3. DENYING DEFENDANTS’
MOTION TO STRIKE
PLAINTIFFS’ OPPOSITION**

[Dkt. No. 347]

Pending before the Court is Defendants Implant Direct Mfg. LLC, Implant Direct LLC, and Implant Direct International’s (collectively, “Defendants”) Motion for Partial Reconsideration or Alternatively, Renewed Motion to Amend Invalidity Contentions; and Further Motion to Amend Invalidity Contentions. (Dkt. No. 306.) Defendants seek reconsideration of the Court’s October 16, 2013 Order granting in part and denying in part Defendants’ Motion to Amend Invalidity Contentions (Dkt. No. 301, “October 16, 2013 Order”). The motion for partial reconsideration or renewed motion has been fully briefed. (Dkt. Nos. 314, 316.)

1 Pursuant to Civil Local Rule 7.1(d)(1), the Court finds the matter suitable for
2 adjudication without oral argument. Having reviewed the parties' briefs and relevant
3 legal authority, the Court hereby **DENIES** Defendants' motion for reconsideration and
4 renewed motion to amend invalidity contentions and **DENIES WITHOUT**
5 **PREJUDICE** Defendants' motion to further amend invalidity contentions.

6 **I. BACKGROUND**

7 As set forth in this Court's October 16, 2013 Order, this is a patent and
8 trademark infringement action for dental attachment products. (See Dkt. No. 1.) In
9 the First Amended Complaint, Plaintiffs Zest IP Holdings, LLC and Zest Anchors,
10 LLC (collectively, "Plaintiffs") allege that the marketing and sale of the GoDirect
11 and GPS products (the "Accused Products") by Defendants infringes Plaintiffs'
12 patent and trademark rights. (Dkt. No. 13, "FAC," at 12-13.) The patents at issue are
13 U.S. Patent No. 6,030,219 ("the '219 Patent") and U.S. Patent No. 6,299,447 ("the
14 '447 Patent"). (Id.) Plaintiffs also allege Defendants infringed Plaintiffs' registered
15 marks "ZEST" and "LOCATOR" without Plaintiffs' authorization, resulting in
16 trademark infringement. (Id. at 13.) Plaintiffs allege several additional federal and
17 state law claims, including false designation of origin, false advertising, unfair
18 business practices, and unfair competition. (Id. at 13-17.)

19 On April 1, 2011, Plaintiffs served Preliminary Infringement Contentions
20 upon Defendants. (Dkt. No. 107-2.) On May 6, 2011, Defendants served Plaintiffs
21 with Preliminary Invalidity Contentions. (Dkt. No. 230-3¹; Dkt. No. 252-1 at 24.)
22 Defendants' Preliminary Invalidity Contentions identify three items of prior art
23 claimed to anticipate or render obvious the '447 Patent contested claims: U.S.

24
25 ¹The Court notes that although Defendants filed a copy of their Preliminary
26 Invalidity Contentions as "Exhibit A" to the "Declaration of Christopher Drugger" in
27 support of their initial motion to amend invalidity contentions, (Dkt. No. 230-3), the
28 Preliminary Invalidity Contentions are incomplete without the accompanying chart
"identifying where specifically in each alleged item of prior art each element of each
asserted claim is found," Patent L.R. 3.3(c). The Court hereinafter cites to the version
of Defendants' Preliminary Invalidity Contentions filed by Plaintiffs in their opposition
to Defendants' motion as the complete version of Defendants' Preliminary Invalidity
Contentions, (Dkt. No. 252-1 at 24-42.)

1 Patent No. 6,203,325 (“the Honkura ‘325 Patent”); U.S. Patent No. 3,656,236; and
2 European Patent Application No. EP 0 891 750 A1. (Dkt. No. 252-1 at 24-42.)
3 Defendants’ Preliminary Invalidity Contentions identified no items of prior art that
4 anticipated or rendered obvious the ‘219 Patent asserted claims. (Id.)

5 On July 25, 2012, Plaintiffs filed a motion to amend their infringement
6 contentions to add a revised version of the accused products, which included a new
7 GPS male. (Dkt. No. 107.) On April 4, 2013, the Court granted Plaintiffs’ motion to
8 file amended infringement contentions to add the revised version of the accused
9 products. (Dkt. No. 202.)

10 On May 17, 2013, Defendants notified the Court that it would seek leave to
11 amend Defendants’ invalidity contentions. (Dkt. No. 217, “Joint Status Report,” at
12 5.) On May 29, 2013, during a case management conference and hearing,
13 Defendants indicated to Magistrate Judge Gallo intention to file amended invalidity
14 contentions. (Dkt. No. 228.) During that hearing, Magistrate Judge Gallo agreed
15 that Defendants could file a motion to amend invalidity contentions by June 21,
16 2013. (Id. at 56:20.) On June 21, 2013, Defendants filed a motion to amend or
17 correct invalidity contentions pursuant to Patent Local Rule 3.6(b). (Dkt. No. 230.)
18 The motion was fully briefed. (Dkt. Nos. 252, 297.)

19 On October 16, 2013, the Court granted in part and denied in part
20 Defendants’ motion to amend or correct Defendants’ invalidity contentions. (Dkt.
21 No. 301, “October 16, 2013 Order.”) Specifically, the Court granted Defendants’
22 motion to add one prior art reference² to Defendants’ invalidity contentions and
23 denied Defendants’ motion as to the other twenty nine requested prior art
24 references. (Id. at 11-20.)

25 By the present motion, Defendants move this Court to partially reconsider the
26 October 16, 2013 Order, requesting leave to amend Defendants’ invalidity
27 contentions to add four of the twenty nine previously rejected art references. (Dkt.

28 ²U.S. Patent 4,431,416 (Niznick) (“the ‘416 Patent”).

1 No. 308 at 1.) Defendants further move for leave to add eight additional prior art
2 references that were not included in Defendants’ prior motion to amend invalidity
3 contentions. (Id.)

4 In support of the motion for reconsideration, Defendants have filed a
5 proposed amended chart as Exhibit A to Defendants’ Proposed Second Amended
6 Invalidity Contentions, (Dkt. No. 306-13), providing much more detail than the
7 proposed amended chart submitted as Exhibit A to Defendants’ Proposed [initial]
8 Amended Invalidity Contentions filed with their initial motion to amend invalidity
9 contentions, (Dkt. No. 230-5). In addition, Defendants separately filed, and the
10 Court has considered, the prosecution histories of the ‘219 and ‘447 patents. (Dkt.
11 No. 322.) On January 15, 2014, Defendants filed an ex parte motion to strike
12 Plaintiffs’ opposition brief to the present motion for reconsideration, on the ground
13 that Plaintiffs’ counsel used 13.5-point font instead of the required 14-point font in
14 violation of Civil Local Rule 5.1(a) and the Court’s October 11, 2013 Order
15 reminding the parties to heed Civil Local Rule 5.1(a), (Dkt. No. 294). Plaintiffs’
16 counsel has submitted a declaration attesting to his use of 14-point font to write the
17 brief in question. (Dkt. No. 347.) Defendants have responded, submitting six
18 exhibits. (Dkt. No. 355.) The Court DENIES the motion to strike and reminds
19 Defense counsel that signing and filing a motion with this Court certifies that the
20 motion is not presented for any improper purpose. Fed. R. Civ. P. 11(b).

21 **II. LEGAL STANDARDS**

22 **A. Motions for Reconsideration**

23 A motion for reconsideration is “appropriate if the district court is provided
24 with (1) newly discovered evidence; (2) clear error or manifest injustice, or (3) if
25 there is an intervening change in controlling law.” School Dist. No. 1J, Multnomah
26 County, Or. v. AcandS, Inc., 5 F.3d 1255, 1263 (9th Cir. 1993). Whether to grant or
27 deny a motion for reconsideration is within the sound discretion of the district court.
28 Navajo Nation v. Norris, 331 F.3d 1041, 1046 (9th Cir. 2003) (citing Kona Enters.,

1 Inc. v. Estate of Bishop, 229 F.3d 887, 883 (9th Cir. 2000)). Although the court may
2 reconsider and amend a previous order under Federal Rules of Civil Procedure
3 59(e), “the rule offers an ‘extraordinary remedy, to be used sparingly in the interests
4 of finality and conservation of judicial resources.’” Kona Enters., Inc. v. Estate of
5 Bishop, 229 F.3d 877, 890 (9th Cir. 2000) (quoting 12 James Wm. Moore et al., §
6 59.30[4]). A party may not raise new arguments or present new evidence if it could
7 have reasonably raised them earlier. Kona Enters., 229 F.3d at 890 (citing 398
8 Orange St. Partners v. Arnold, 179 F.3d 656, 665 (9th Cir. 1999)).

9 **B. Amendments to Invalidity Contentions**

10 Particular to patent cases, infringement and invalidity contentions are
11 “designed specifically to require parties to crystalize their theories of the case early
12 in the litigation so as to prevent the shifting sands approach to claim construction.”
13 O2 Micro Intern. Ltd. v. Monolithic Power Sys., Inc., 467 F.3d 1355, 1364 (Fed.
14 Cir. 2006) (internal quotation marks and citations omitted). Among other
15 requirements, invalidity contentions must set forth:

- 16 a. The identity of each item of prior art that allegedly anticipates each
17 asserted claim or renders it obvious. This includes information about
18 any alleged knowledge or use of the invention in this country prior to
19 the date of the invention of the patent. Each prior art patent must be
20 identified by its number, country of origin, and date of issue. Each
21 prior art publication must be identified by its title, date of publication,
22 and where feasible, author and publisher. . . .
23 b. Whether each item of prior art anticipates each asserted claim or
24 renders it obvious. If obviousness is alleged, an explanation of why the
25 prior art renders the asserted claim obvious, including an identification
26 of any combinations of prior art showing obviousness;
27 c. A chart identifying where specifically in each alleged item of prior
28 art each element of each asserted claim is found

Patent L.R. 3.3 (emphasis added).

The U.S. District Court for the Southern District of California Patent Local
Rules³ (“the Patent Local Rules”) therefore do not allow amendments to contentions

³Provisions for amendment of Defendants’ Invalidity Contentions are set forth
in the U.S. District Court for the Southern District of California Local Patent Rules and
Federal Circuit Law. O2 Micro Intern. Ltd., 467 F.3d at 1364-65 (“Since the [] local
patent rules on amendment of infringement contentions are unique to patent cases and

1 “as a matter of course when new information is revealed in discovery,” but instead
2 require parties to file amendments to contentions with diligence. O2 Micro Intern.
3 Ltd., 467 F.3d at 1365-66. Under the Patent Local Rules,

4 As a matter of right, a party opposing a claim of patent infringement
5 may serve “Amended Invalidation Contentions” no later than the
6 completion of claim construction discovery. Thereafter, absent undue
7 prejudice to the opposing party, a party opposing infringement may
8 only amend its invalidity contentions:

- 9 1. if a party claiming patent infringement has served “Amended
10 Infringement Contentions,” and the party opposing a claim of patent
11 infringement believes in good faith that the Amended Infringement
12 Contentions so require;
- 13 2. if, not later than fifty (50) days after service of the court’s Claim
14 Construction Ruling, the party opposing infringement believes in good
15 faith that amendment is necessitated by a claim construction that differs
16 from that proposed by such party; or
- 17 3. upon a timely motion showing good cause.

18 Patent L.R. 3.6(b). Parties seeking to amend infringement or invalidity contentions
19 upon “a timely motion showing good cause” under Patent Local Rule 3.6(a)(2)
20 (infringement contentions) or 3.6(b)(3) (invalidity contentions) bear the burden of
21 establishing diligence in seeking to amend. O2 Micro Intern. Ltd., 467 F.3d at 1366.

22 III. DISCUSSION

23 Defendants move the Court for leave to further amend Defendants’ invalidity
24 contentions on three grounds: (1) the “highly unusual circumstances” of this case
25 warrant reconsideration of the Court’s previous denial of four prior art references, (Dkt.
26 No. 308 at 16); (2) the Court should allow Defendants’ “renewed motion” to add the
27 four previously rejected prior art references because Defendants have now cured the
28 deficiencies of the previous motion, (id. at 16-17); and (3) good cause exists for the
Court to allow Defendants to add eight new prior art references, (id. at 17-21).

29 A. Reconsideration of the Court’s October 13, 2013 Order and Defendants’ 30 Renewed Motion to Amend Invalidation Contentions

31 As an initial matter, whether Defendants style their motion as a motion for
32 reconsideration or a renewed motion, Defendants must meet the established

33 _____
34 have a close relationship to enforcement of substantive patent law, we proceed to
35 review their validity and interpretation under Federal Circuit law.”).

1 requirements for a motion for reconsideration. See Civ. L. R. 7.1(i)(1) (describing
2 applications for reconsideration as any subsequent motion made for the same relief in
3 whole or in part as a previous motion for an order that has been refused in whole or in
4 part). Accordingly, Defendants must show the October 16, 2013 Order was manifestly
5 unjust, showed clear error of law, or warrants reconsideration because of newly
6 discovered facts or law. School Dist. No. 1J, Multnomah County, Or. v. AcandS, Inc.,
7 5 F.3d 1255, 1263 (9th Cir. 1993).

8 In seeking reconsideration, Defendants make no showing of new facts or law,
9 clear error of law, or undue prejudice. See School Dist. No. 1J, Multnomah County,
10 Or., 5 F.3d at 1263. Instead, Defendants argue that this case presents “other, highly
11 unusual circumstances warranting reconsideration” because the GPS internal
12 connection product asserted by Plaintiffs in the amended infringement contentions
13 “raises a different set of issues than were at issue when only the GPS external
14 connection product was involved.” (Dkt. No. 308 at 15.) For the following reasons, the
15 Court disagrees, and DENIES Defendants’ motion for reconsideration and renewed
16 motion to amend their invalidity contentions to add four of the nine previously rejected
17 prior art references⁴ (“the Blümli, Lester, Niznick, and Tseng Patents”).

18 **1. Motion for Reconsideration**

19 In Defendants’ initial motion to amend their invalidity contentions, Defendants
20 sought to amend under both Patent Local Rule 3.6(b)(1), asserting a good faith belief
21 that Plaintiffs’ amended infringement contentions required amended invalidity
22 contentions, as well as Patent Local Rule 3.6(b)(3), asserting that good cause existed
23 to amend their invalidity contentions. (Dkt. No. 230-1 at 6-7.) Defendants further
24 argued that under either prong of the Patent Local Rule 3.6(b) amendment
25 requirements, Defendants’ proposed amendments would not unduly prejudice
26

27 ⁴These prior art references are: (1) European Patent EP 867,154(A1) (Blümli);
28 (2) U.S. Patent No. 2,854,746 (Lester, October 7, 1958); (3) U.S. Patent No. 5,071,350
(Niznick, December 10, 1991); and (4) U.S. Patent No. 5,997,300 (Tseng, December
7, 1999). (Dkt. No. 308 at 4.)

1 Plaintiffs. (Dkt. No. 230-1 at 12-13.)

2 In regard to Defendants' Rule 3.6(b)(1) claim, the Court disagreed with
3 Defendants' assertion that Plaintiffs' amended infringement contentions accuse an
4 "entirely new accused product," (Dkt. No. 301, "October 16, 2013 Order" at 14), but
5 found that Defendants met their burden of showing a good faith belief that Plaintiffs'
6 amended infringement contentions "may have created a need to add one prior art
7 reference," the '416 Patent, (id. at 15). In regard to Defendants' Rule 3.6(b)(3) claim,
8 the Court found that although Defendants "showed diligence in seeking leave to file
9 the motion to amend invalidity contentions," (id. at 17), Defendants had only shown
10 the need to add the '416 Patent and failed to offer "any explanation as to the relevance
11 of the additional twenty nine prior art references," (id. at 18). The Court therefore
12 granted Defendants leave to file amended invalidity contentions including only the
13 three previously identified prior art references and the additional '416 Patent prior art
14 reference. (Id. at 20.)

15 In support of reconsideration, Defendants assert that the Court's October 16,
16 2013 Order required a showing of materiality not facially required by the local rules
17 governing amendment of invalidity contentions. (Dkt. No. 308 at 14) (citing Patent
18 Local Rule 3.6(b)(1)-(3)). Defendants claim they were "unaware that the Court would
19 desire such a showing in connection with the original motion" and request that the
20 Court now consider the relevance and materiality of the Blümli, Lester, Niznick, and
21 Tseng Patents previously considered and rejected by the Court. (Dkt. No. 316 at 2.)

22 The Court finds no reason to revise the Court's October 16, 2013 Order.
23 Although Defendants correctly state that "materiality" does not appear as a requirement
24 of Patent Local Rule 3.6(b) (rules for "Amended and Final Contentions"), Defendants
25 neglect Patent Local Rule 3.3(a)-(e) (rules for "Invalidity Contentions"). As set forth
26 above, invalidity contentions must, at a minimum: (a) identify each item of prior art,
27 including information about prior use of the invention in the U.S.; (b) state whether
28 Defendants claim the prior art references anticipate or render obvious the claims of the

1 patents at issue; (c) if obviousness is alleged, an explanation of why the prior art
2 renders the asserted claims obvious; and (d) include a chart identifying where
3 specifically in each alleged item of prior art each element of each asserted claim is
4 found. Patent L.R. 3.3(a)-(c).

5 Defendants wholly failed to meet these requirements in their initial motion to
6 amend their invalidity contentions, (Dkt. No. 230-1), and concurrently filed proposed
7 amended invalidity contentions, (Dkt. No. 230-4, 230-5). Instead of providing “an
8 explanation of why the prior art renders the asserted claim obvious, including
9 identification of prior art showing obviousness,” Patent L.R. 3.3(b), Defendants
10 provided a blanket statement that “each item of the prior art renders the asserted claims
11 obvious in combination with each other, or any of them, and/or in combination with
12 features well known to people with skill in the art at the time of the respective
13 applications.” (Dkt. No. 230-4 at 3.) In addition, the chart provided by Defendants
14 failed to identify “where specifically in each alleged item of prior art each element of
15 each asserted claim is found” Patent L.R. 3.6(c). Instead, Defendants’ chart
16 reproduced every claim at issue in the ‘219 and ‘447 Patents in column one of the claim
17 chart, and listed, in every cell of the second column of the claim chart, thirty-two (32)
18 separate patents as “prior art” that allegedly reads on each contested claim in its
19 entirety.⁵ (Dkt. No. 230-5.) A list of thirty-two patents does not itself give notice to

21 ⁵For example, the second subpart of Claim 1 of the ‘219 Patent is “an abutment
22 member for attachment to a tooth root, implant, or adjacent tooth, the abutment member
23 having an upper end, and an outer locating surface portion projecting downwardly from
24 the upper end, the outer locating surface portion being positioned to project above a
25 tissue level when the abutment member is secured in a tooth root or implant;” (Dkt. No.
26 230-5 at 1.) Defendants’ proposed amended invalidity contentions chart states that the
27 following prior art reads on this first subpart of Claim 1 of the ‘219 Patent: “This
28 element is found in United States Patent Nos. 6,203,325; 3,656,236; 4,431,416;
4,544,358; 5,211,561; 1,101,819; 2,112,007; 2,854,746; 3,328,879; 3,656,236;
3,797,114; 4,518,357; 4,575,340; 4,731,020; 4,738,662; 4,854,874; 4,997,372;
5,030,094; 5,071,350; 5,133,662; 5,549,677; 5,597,306; 5,842,864; 5,871,357;
5,882,200; 5,997,300; 6,142,782; 6,203,325; 6,227,859; and/or European Patent Nos.
WO9717907; EP867154(A1); and EP867154(B1).” (Dkt. No. 230-5 at 1.) No other
information is provided as to which elements in these patents purportedly anticipates
or renders obvious the corresponding claims of the ‘219 Patent. The chart duplicates
this list in full for every contested claim in Plaintiffs’ ‘219 and ‘447 Patents. (Dkt. No.

1 Plaintiffs nor identify to the Court the invalidity claims made by Defendants.

2 Furthermore, the Court does not find compelling Defendants' claim that they
3 were unaware of the Court's expectations regarding the showing required to amend
4 invalidity contentions. In particular, the Court notes that Defendants' Preliminary
5 Invalidity Contentions⁶, (Dkt. No. 252-1 at 24-42), detailed Defendants' invalidity
6 contentions with much greater specificity than Defendants' Proposed Amended
7 Invalidity Contentions, (see Dkt. No. 230-4, 230-5). While Defendants' Preliminary
8 Invalidity Contentions comported with Patent Local Rule 3.3's requirements of
9 indicating specific claims in the prior art references that purport to read on Plaintiffs'
10 patents, (Dkt. No. 252-1 at 24) (citing specific column, line, and figure numbers in
11 which the Honkura '325 Patent reads on the contested claims of the '447 Patent and
12 detailing invalidity claims based on obviousness), Defendants replaced this specificity
13 with a repetitive list of thirty-two patents in their Proposed Amended Invalidity
14 Contentions (Dkt. No. 230-5); see supra, fn 5.

15 Given the defects in Defendants' previously filed proposed amended invalidity
16 contentions, the Court concludes that the October 16, 2013 Order did not commit clear
17 error and was not manifestly unjust, and Defendants have presented no newly
18 discovered evidence or intervening change in controlling law to warrant
19 reconsideration. Sch. Dist. No. 1J, Multnomah County, Or., 5 F.3d at 1263.

20 **2. Renewed Motion**

21 In addition, the Court finds no reason to allow Defendants to now cure the
22 defects of their previous motion on a "renewed motion." Defendants cite to four cases
23 where courts allowed renewed motions; in the cited cases, courts allowed renewed
24 motions due to newly discovered facts or evidence or where the court conditionally
25 granted permission to renew a motion to amend a complaint. (Dkt. No. 308 at 16-17)

26 _____
27 230-5.)

28 ⁶Defendants' "Preliminary Invalidity Contentions" became final invalidity
contentions after the close of claim construction discovery. See Patent L.R. 3.6(b).

1 (quoting Advanced Semiconductor Materials Am. v. Applied Materials, Inc., 922 F.
2 Supp. 1439, 1442 (N.D. Cal. 1996) (renewed motion for summary judgment allowed
3 due to new evidence obtained in depositions); Carnegie Mellon Univ. v. Hoffman La
4 Roche Inc., 148 F. Supp. 2d 1004, 1007-08, 1010, n.4 (N.D. Cal. 2001) (renewed
5 motion for summary judgment allowed due to new expert); MCGIP, LLC v. Does 1-
6 149, No. C 11-02331LB, 2011 WL 4352110, at *4 (N.D. Cal. Sept. 16, 2011)
7 (conditionally granting leave to renew motion to amend); Andrews Farms v. Calcot,
8 Ltd., 258 F.R.D. 640 (E.D. Cal. 2009) (previous motion to certify class was denied
9 without prejudice)). In their reply, Defendants further cite to three district court cases
10 in which the courts, exercising discretion, allowed renewed motions to correct previous
11 insufficient filings. (Dkt. No. 316 at 3-4) (citing Campbell-El v. District of Columbia,
12 881 F. Supp. 42, 43 (D.D.C. 1995) (allowing renewed motion to dismiss to correct
13 previous insufficiently addressed issues); Renasant Bank v. Park Nat’l Corp., 12-0689-
14 WS-C, 2013 U.S. Dist. LEXIS 88847 (S.D. Ala. 2013) (allowing *joint* renewed motion
15 to stay); Kovacevich v. Kent State Univ., 224 F.3d 806, 835 (6th Cir. 2000) (“District
16 courts may in their discretion permit renewed or successive motions for summary
17 judgment, particularly when the moving party has expanded the factual record on
18 which summary judgment is sought.”)).

19 Here, Defendants present no new evidence or facts to support their renewed
20 motion, and the Court did not conditionally grant Defendants leave to revise their
21 motion to amend the invalidity contentions. Furthermore, while Defendants’ proffered
22 authorities support the contention that courts have discretion to permit renewed
23 motions for summary judgment or class certification, see Kovacevich, 224 F.3d at 835,
24 Defendants offer no legal authority to support a renewed motion to amend invalidity
25 contentions.

26 The Court also finds that, even if Defendants’ renewed motion is properly before
27 the Court, Defendants fail to cure the defect of their previous motion on the present
28 “renewed motion.” As an initial matter, Defendants fail to concurrently file proposed

1 second amended invalidity contentions, submitting only a proposed second amended
2 invalidity contentions *chart* that would presumably serve as “Exhibit A” to the second
3 amended invalidity contentions. (See Dkt. No. 306-13, Exhibit 12 to the Declaration
4 of Christopher Dugger.) Furthermore, although the Proposed Second Amended
5 Invalidity Contentions Chart provides much more detail than the first Proposed
6 Amended Invalidity Contentions Chart submitted with Defendants’ prior motion⁷, only
7 parts of the Second Amended Invalidity Contentions Chart comport with the Patent
8 Local Rule 3.3 requirements for invalidity contentions. (Compare Dkt. No. 306-13
9 at 1 (“In addition, this element is anticipated or obvious in light of United States Patent
10 Nos. 5,071,350 (‘Niznick ‘350’), 5,211,261[sic] (‘Graub’), 5,997,300 (‘Tseng’) . . .)
11 with id. at 2 (“United States Patent No. 2,854,746 (‘Lester’) shows an abutment
12 member (element 19) attached to a dental prosthesis and otherwise meeting all the
13 requirements of this element. It would have been obvious to incorporate these features
14 onto an abutment member for attachment to a tooth root, implant, or adjacent tooth.”)).

15 Given Defendants’ failure to meet the Patent Local Rule 3.3 requirements in their
16 initial motion to amend invalidity contentions; Defendants’ failure to explain their
17 previous deficient showing; and Defendants’ failure to cure the defect of their previous
18 motion; the Court declines to exercise discretion to allow Defendants to cure these
19 defects on a renewed motion. Accordingly, the Court DENIES Defendants’ motion for
20 reconsideration and renewed motion to amend invalidity contentions.

21 **B. Motion to Further Amend Invalidity Contentions**

22 Defendants further move to amend their invalidity contentions to add eight
23 additional prior art references⁸ that were not included in their prior motion to amend
24

25 ⁷This is plainly obvious from the respective lengths of the documents, alone.
26 (Compare Dkt. No. 230-5 (21 pages) with Dkt. No. 306-13 (39 pages)).

27 ⁸The references are: (1) U.S. Patent No. 4,540,367 (Sulc, September 10, 1985);
28 (2) U.S. Patent No. 5,120,222 (Sulc, June 9, 1992); (3) U.S. Patent No. 5,195,891
(Sulc, March 23, 1993); (4) Keith M. Griffin, DDS, Solving the Distal Extension
Removable Partial Denture Base Movement Dilemma: A Clinical Report, *The Journal*
of Prosthetic Dentistry, 347, 348 (1996); (5) U.S. Patent No. 5,211,561 (Graub, May

1 the invalidity contentions. (Dkt. No. 308 at 1.) Defendants claim good cause exists to
2 add the additional prior art references under Patent Local Rule 3.6(b)(3) because the
3 references relate to the issue of a “friction fit” theory of infringement only disclosed
4 by Plaintiffs after the Court’s October 16, 2013 Order. (Dkt. No. 308 at 1-2.)

5 Plaintiffs oppose, arguing that the alleged statements regarding “friction fit”
6 occurred during settlement discussions, and that Defendants should not be permitted
7 to rely upon confidential statements made during settlement discussions to provide
8 grounds for amending their invalidity contentions. (Dkt. No. 314 at 10-13) (citing Fed.
9 R. Evid. 408; Civ. L.R. 16.1.c.1.b; Rule 600-8 to General Order No. 387-A; Civ. L.R.
10 16.3.h). The Court agrees, for two primary reasons: first, as Plaintiffs argue, the Civil
11 Local Rules, Federal Rules of Civil Procedure, and common law evince a policy in
12 favor of confidentiality of settlement discussions. Second, upon review of the parties’
13 submissions, the Court is not convinced that Plaintiffs are yet pursuing a new
14 infringement theory. Plaintiffs have not amended their infringement contentions to
15 include a “friction fit” theory, and as Defendants recognize, the parties have not yet
16 taken any expert discovery, (Dkt. No. 230-1 at 12). See also O2 Micro Intern. Ltd., 467
17 F.3d at 1366 (recognizing that the Federal Rules contemplate a system whereby
18 discovery and pretrial hearings should assist in identifying precise issues in dispute as
19 more information becomes available).

20 Accordingly, the Court DENIES WITHOUT PREJUDICE Defendants’ motion
21 to further amend the invalidity contentions to include prior art references that respond
22 to Plaintiffs’ purported “friction fit” theory of infringement. The parties are reminded
23 that, as the parties take expert discovery, any future motion to amend contentions must
24 comport with Patent Local Rule 3.1 or 3.3. In addition, the party seeking amendment
25 must meet the Patent Local Rules’ burden of showing good cause to amend and no

26
27 18, 1993); (6) S. Robert Davidoff, DMD, FACP & Ronald P. Davis, DDS, The ERA
28 Implant-Supported Overdenture (1995); (7) Advertisement, “Stern ERA Attachments,
A ‘Snap’ to Use and Maintain,” copyright 1996, Sterngold/ImplaMed A Cookson
Company; (8) Dalbo Clyindrical Anchor by Dr. Dalla Bona and its commercial
embodiments.

1 undue burden on the opposing party. Patent L.R. 3.6.

2 **CONCLUSION**

3 For the above stated reasons, the Court hereby:

4 1) **DENIES** Defendants' motion for partial reconsideration of the Court's
5 October 16, 2013 Order and renewed motion to amend their invalidity
6 contentions to add four previously rejected prior art references (Dkt. No.
7 306);

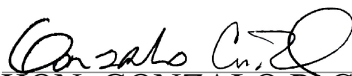
8 2) **DENIES WITHOUT PREJUDICE** Defendants' motion to amend their
9 invalidity contentions to add eight additional prior art references (Dkt. No.
10 306); and

11 3) **DENIES** Defendants' motion to strike Plaintiffs' Opposition Brief (Dkt.
12 No. 347).

13 Accordingly, Implant Direct **MAY FILE** revised proposed amended
14 invalidity contentions consistent with the Court's October 16, 2013 Order on or by
15 February 7, 2014. If the revised proposed amended invalidity contentions do not
16 comport with Patent Local Rule 3.3 or contain references to prior art references
17 other than United States Patent Nos. 6,203,325; 3,656,236; 4,431,416; and
18 European Patent Application No. EP 0 891 750 A1, the Court may reject the
19 proposed amended invalidity contentions.

20 **IT IS SO ORDERED.**

21 DATED: January 31, 2014

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23 HON. GONZALO P. CURIEL
24 United States District Judge
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