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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

ZEST IP HOLDINGS, LLC,)	Civil No.10-0541-GPC(WVG)
et al.,)	
)	ORDER DENYING DEFENDANTS'
Plaintiffs,)	APPLICATION TO CONDUCT
v.)	ADDITIONAL DISCOVERY
)	
IMPLANT DIRECT MFG., LLC,)	
et al.)	
Defendants.)	
)	
_____)	

On February 7, 2014, in response to the Court's suggestion of January 31, 2014, Defendants filed a Statement of Pending Discovery Issues. [Docket No. 366]. On February 21, 2014, Defendants submitted a letter application to the Court seeking to conduct additional discovery in this case. On February 26, 2014, Plaintiffs submitted a letter in opposition to Defendants' letter application.

I

INTRODUCTION

Defendants contend that they have pending discovery matters before the Court that have yet to be resolved. A

1 careful review of the docket indicates that there are no
2 pending discovery matters before this Court. However,
3 given the history of this litigation and the numerous
4 pleadings which have been filed, it is perhaps understand-
5 able why Defendants may think there are unresolved dis-
6 putes. But Defendants' mistaken belief does not justify
7 allowing the discovery they now seek.

8 Defendants raised the present discovery issues in a
9 Joint Statement Regarding Discovery, filed on May 17,
10 2013. [Docket No. 217]. A hearing was held regarding these
11 discovery issues on May 29, 2013. [Transcript of May 29,
12 2013 hearing, Docket No. 228]. During the hearing, Defen-
13 dants indicated that they intended to file several motions
14 (to amend invalidity contentions and for a new *Markman*
15 hearing) before Judge Curiel and were awaiting a ruling on
16 a pending Motion For Reconsideration pertaining to the
17 sufficiency of Plaintiffs' infringement contentions.
18 [Transcript of May 29, 2013 hearing at 53-56]^{1/}. The
19 resolution of those motions would impact the discovery
20 being sought by Defendants and accordingly, this Court
21 took the matters under advisement pending the outcome of
22 Judge Curiel's orders. [Transcript of May 29, 2013 hearing
23 at 45, ll. 12-17; at 55, ll. 9-13]. Although the discov-
24 ery matters were taken under advisement, it became evident
25 to the Court in papers filed subsequently by the parties,
26 or in orders issued by Judge Curiel, that the discovery in

27
28 ^{1/}All references to page numbers are to the Court's CM/ECF
pagination, unless otherwise noted.

1 question had either taken place or would be conducted. The
2 Court, having not heard from Defendants since May 2013
3 about the lack of ruling from this Court and having not
4 received any objection about the lack of discovery from
5 Plaintiffs, naturally assumed that the discovery had been
6 conducted.

7 Defendants had the opportunity to conduct the
8 discovery that is now being requested, when it was appro-
9 priate to do so. For whatever reason, they chose not to
10 conduct the discovery or file timely objections to the
11 discovery which was provided by Plaintiffs. The fact
12 remains that the discovery requested by Defendants, which
13 should have been, and could have been, accomplished much
14 earlier in this litigation, if allowed to be conducted
15 now, would seriously prejudice Plaintiffs, require enor-
16 mous amounts of additional discovery, and seriously
17 undermine the Court's calendaring of this already lengthy
18 litigation.

19 II

20 DEFENDANTS' DISCOVERY REQUESTS

21 Defendants have identified three topics about which
22 they now seek discovery:

23 1. Plaintiffs' infringement contentions relating to
24 the new internal connection GPS cap and liner and the
25 basis for any such contentions; 2. The invalidity of
26 Plaintiffs' patents; 3. Plaintiff's alleged damages
27 regarding the new internal connection GPS cap and liner,
28 including in the form of a Rule 30(b)(6) deposition.

1 [Defendants' Statement of Pending Discovery Issues, Docket
2 No. 366, at 3, 11. 8-9, 12, 15-16].

3 A. Defendants' Request To Conduct Additional Fact
4 Discovery Into Plaintiffs' Infringement Contentions
5 Is DENIED.

6 Patent infringement analysis involves essentially
7 two steps: 1) claim construction; and 2) comparison of the
8 properly construed claims with the accused product(s).
9 Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454 (Fed.
10 Cir. 1998). Judge Burns, who was assigned this case before
11 Judge Curiel, held a claim construction hearing on April
12 10, 2012 [Docket No. 88] and issued his Claim Construction
13 Order on May 16, 2012. [Docket No. 99]. Immediately
14 thereafter, Defendants filed a Motion For Reconsideration
15 [Docket No. 100] which was denied by Judge Burns. [Docket
16 No. 102]. Once Judge Burns construed the claim terms, the
17 first part of the analysis was completed. As Plaintiffs'
18 counsel has stated, the claim terms have not changed since
19 April 10, 2012.^{2/}

20 As to the second part of the analysis, Defendants'
21 entire argument to justify the request for additional
22 discovery in this area is that Plaintiff has added an
23 entirely "new" accused product in the litigation after the
24 discovery cutoff. Defendants continue to characterize the
25 "new" GPS internal male connection as an entirely new
26 accused product and contends that Plaintiffs have changed

27 ^{2/} Although Defendants stated at the May 29, 2013, hearing that
28 they intended to file a motion for a new *Markman* Hearing, no such
motion was ever filed. Accordingly, as Plaintiffs argue, the claim
construction ordered by Judge Burns on May 16, 2012, is and has been
the "law of the case" as to the construed terms.

1 their infringement theory. [Defendants' February 21, 2014
2 letter]. This is simply not the case and Defendants'
3 persistent mischaracterization of the "new" GPS connection
4 will not change its true nature. Judge Curiel, using
5 language such as "the Court disagrees" and "the Court
6 rejects," has stated quite clearly that Plaintiffs'
7 inclusion of a "new" GPS male internal connection is not
8 an entirely new accused product. [Order, Docket No. 301 at
9 14, ll. 11-12, 24; at 15. ll. 1, 11]. Moreover, as Judge
10 Curiel stated in ruling on Defendants' Motion to Further
11 Amend Invalidity Contentions, "the Court is not convinced
12 that Plaintiffs are yet pursuing a new infringement
13 theory." [Order, Docket No. 362 at 13, ll. 13-14].

14 Defendants already have conducted discovery about
15 Plaintiffs' infringement and amended infringement conten-
16 tions. Plaintiffs have indicated that they will "update
17 their interrogatory responses" in light of the amended
18 infringement contentions [Transcript of May 29, 2013
19 hearing at 20, ll. 15-16; at 23, ll. 23-24] and apparently
20 did so without any insufficiency objection by Defendants.
21 [Plaintiffs' Opposition to Defendants' Motion for Recon-
22 sideration, Docket No. 234 at 10, ll. 1-9; Order Denying
23 Defendants' Motion for Reconsideration, Docket No. 248 at
24 4, ll. 22-24; *see also* Transcript of January 4, 2013
25 hearing before Judge Curiel, Docket No. 184 at 24, ll. 17-
26 23]. The Court also notes that since the May 29, 2013
27 discovery hearing, Defendants have not raised with the
28 Court any objections to Plaintiffs supplemental responses.

1 Accordingly, other than expert discovery as ad-
2 dressed in the Seventh Amended Case Management Conference
3 Order, [Docket No. 361, no additional discovery in this
4 area is justified.

5 B. Defendants' Request To Conduct Additional Fact
6 Discovery Regarding The Invalidity Of Plaintiffs'
7 Patents is DENIED.

8 Plaintiffs cite the seminal case of Graham v. John
9 Deere Co., 383 U.S. 1, 17 (1966), to argue correctly that
10 invalidity of a patent is separate and distinct from, and
11 has nothing to do with, the accused products. [Joint
12 Statement Regarding Discovery, Docket No. 217 at 8, ll.
13 19-22; Plaintiffs' Feb. 26, 2014 letter]. Invalidity of a
14 patent may be raised when the patentee fails to comply
15 with any of the statutory requirements set forth in
16 Sections 101-103, and 112. That invalidity of a patent
17 does not depend on the nature of the accused product is
18 basic patent law. It is so basic, that it needs no further
19 explanation here. Counsel for Plaintiffs repeatedly have
20 made this point. [Transcript of January 4, 2013 hearing
21 before Judge Curiel, Docket No. 184 at 18, ll. 12-13, at
22 20, ll. 17-23; Transcript of May 29, 2013 hearing at 21,
23 ll. 3-25; Plaintiffs' Feb. 26, 2014 letter]. For all of
24 the reasons set forth in Plaintiffs' Feb. 26, 2014 letter,
25 the time has come and gone for Defendants to conduct their
26 invalidity discovery.

27 Accordingly, other than expert discovery as ad-
28 dressed in the Seventh Amended Case Management Conference

1 Order, [Docket No. 361], no additional discovery in this
2 area is justified.

3 C. Defendants' Request To Conduct Additional Fact
4 Discovery Regarding Plaintiffs' Damages Evidence As
5 It Relates To The "New" GPS Internal Male Connection
6 Is DENIED.

7 In the Joint Statement Regarding Discovery, filed on
8 May 17, 2013, Plaintiffs made clear that they "are amena-
9 ble to responding to a contention interrogatory regarding
10 damages relating to the new GPS internal male." [Docket
11 No. 217 at 9, ll. 26-27, at 10, ll. 1-2]. The Court is
12 unaware if Defendants propounded a contention interroga-
13 tory, as offered by Plaintiffs. Whether Defendants did or
14 not, it is now too late to take additional fact discovery
15 on damages regarding the "new" GPS internal male connec-
16 tion. Moreover, Defendants' argument to justify additional
17 damages discovery is based on the false premise that there
18 is an entirely new accused product in the case which was
19 introduced after fact discovery closed. [Transcript of May
20 29, 2013 hearing at 41, ll. 22-25, at 42, at 43, ll. 1-6].
21 As indicated above, this simply is not the case.

22 D. Defendants' Request To Designate An Expert To
23 Testify About The Invalidity Of Plaintiffs' Patents
24 Is DENIED.

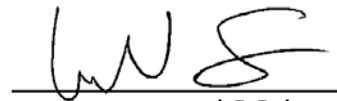
25 Defendants' February 21, 2014 letter requests that
26 Defendants be allowed to designate an expert to testify
27 about the invalidity of Plaintiffs' patents. Plaintiffs'
28 February 26, 2014 letter opposes the request.

As Defendants acknowledge in their letter, the time
to designate experts expired on December 15, 2011, over
two years ago. [Case Management Conference Order, Docket

1 No. 27 at para. 13]. Defendants did not designate any such
2 experts. As discussed above, invalidity of a patent is not
3 a moving target and does not rely at all upon the nature
4 of the accused products. Plaintiffs' patents have not
5 changed one iota throughout the course of this litigation.
6 Defendants' argument that Plaintiffs have added new
7 products and shifted their infringement contentions, even
8 if true, is weak support for the request they now make.
9 See Wong v. University of California, 410 F.3d 1052, 1060
10 (9th Cir. 2005); 02 Micro Intern Ltd. V. Monolithic Power
11 Systems, Inc., 467 F.3d 1355, 1368-1369 (9th Cir. 2006).

12 IT IS SO ORDERED.

13 DATED: March 3, 2014

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16 Hon. William V. Gallo
17 U.S. Magistrate Judge
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