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3 **UNITED STATES DISTRICT COURT**
4 **DISTRICT OF NEVADA**
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6 BRAVO COMPANY USA, INC.,)

7 Plaintiff,)

8 vs.)

9 BADGER ORDNANCE LLC and MARTIN J.)
10 BORDSON,)

11 Defendants.)

Case No. 2:14-cv-00387-RCJ-GWF

ORDER

12 This matter is before the Court on Plaintiff's Motion to Compel (ECF No. 107), filed on
13 September 23, 2016. Defendant Martin J. Bordson filed a Response (ECF No. 113) on October 11,
14 2016. Plaintiff filed its Reply (ECF No. 118) on October 21, 2016. The Court conducted a hearing
15 in this matter on October 27, 2016.

16 **BACKGROUND**

17 On March 14, 2014, Plaintiff filed its Complaint against Defendants Badger Ordnance LLC
18 and Martin J. Bordson seeking declaratory judgment that specific products produced by Plaintiff do
19 not infringe patent numbers 7,900,546 B2 (the "546 patent") and 7,240,600 B1 (the "600 patent")
20 and that such patents are invalid. *Complaint* (ECF No. 1), pg. 2. The 546 patent remains as the
21 only patent at issue. *Motion to Compel* (ECF No. 107), pg. 2. On August 17, 2015, Plaintiff served
22 its Preliminary Invalidation Contentions upon Defendant Bordson. *Defendant's Response* (ECF No.
23 113), pg. 5. On July 12, 2016, Plaintiff served its First Amended Invalidation Contentions ("Amended
24 Invalidation Contentions") and its third set of interrogatories upon Defendant Bordson, which
25 contained a single interrogatory, Interrogatory No. 16, which states:

26 State with particularity all of Bordson's detailed positions, including
27 all factual and legal bases therefore as to why each claim of the '546
28 Patent is valid in response to Bravo's First Amended Invalidation
contentions served July 12, 2016.

Motion to Compel (ECF No. 107), at pg. 3.

1 Defendant Bordson objected to Interrogatory No. 16 as follows:

2 Bordson objects to this Interrogatory as Bravo's First Amended
3 Invalidity Contentions (the "Amended Contentions") served July 12,
4 2016 are improper under Local Patent Rule 1-12, amended May 1,
5 2016 (formerly L.R. 16-1.12), including because (i) good cause does
6 not exist for Bravo Company to supplement its invalidity contentions
7 with cumulative prior art that was publicly available and readily
8 ascertained through a diligent search, (ii) good cause does not exist for
9 Bravo Company to supplement its invalidity contentions with two
entirely new grounds for invalidity under 35 U.S.C. § 103 and 35
U.S.C. § 112 ¶ 2 that were available to Bravo Company but not raised
previously, and (iii) Mr. Bordson will be unduly prejudiced by the
substantial expansion of Bravo Company's Amended Contentions,
which include more than ten times the number of prior-art references
cited in Bravo's initial Invalidity Contentions and entirely new
grounds for invalidity under 35 U.S.C. § 103 and 35 U.S.C. § 112 ¶ 2.

10 *Id.* at Exhibit D.

11 After meeting and conferring, the parties were unable to resolve the dispute concerning the
12 interrogatory. Plaintiff argues that Defendant's objection is invalid and it should be required to
13 provide a full and complete response to Interrogatory No. 16. Plaintiff also requests that Defendant
14 Bordson be ordered to pay its reasonable attorney's fees and expenses for preparing its motion to
15 compel. *Motion to Compel* (ECF No. 107), pg. 6. Defendant argues that Plaintiff's amendment of
16 its invalidity contention undermines the Local Rules of Practice for Patent Cases and that its
17 objection to Interrogatory No. 16 was proper because Plaintiff did not have good cause to amend its
18 invalidity contentions. *Defendant's Response* (ECF No. 113), pg. 12-13.

19 DISCUSSION

20 Local Patent Rule ("LPR") 1-11 requires a party who files a complaint seeking declaratory
21 judgment that a patent is not infringed, is invalid, or is unenforceable to serve on all other parties its
22 initial Non-Infringement, Invalidity, and Unenforceability Contentions within 14 days after the
23 Initial Scheduling Conference. LPR 1-12 further states as follows:

24 Amendment of initial disclosures required by these rules may be made
25 for good cause without leave of the court anytime before the discovery
26 cut-off date. Thereafter, the disclosures are final and amendment of
27 the disclosures may be made only by court order upon a timely
28 showing of good cause. Non-exhaustive examples of circumstances
that may, absent undue prejudice to the nonmoving party, support a
finding of good cause include: (a) a claim construction by the court
different from that proposed by the party seeking amendment; (b)

1 recent discovery of material prior art despite earlier diligent search;
2 and (c) recent discovery of nonpublic information about the Accused
3 Instrumentality despite earlier diligent search. The duty to supplement
4 discovery responses does not excuse the need to obtain leave of the
5 court to amend contentions.

6 Because the Local Patent Rules do not require a party to obtain leave of court to file
7 amended Non-Infringement, Invalidity, and Unenforceability Contentions prior to the close of
8 discovery, the proper procedure to challenge such amended contentions is through a motion to
9 strike. In *JS Products, Inc. v. Kabo Tool Company*, 2014 WL 1093107, at *1 (D. Nev. Mar. 19,
10 2014), for example, the plaintiff served its “supplemental” or amended contentions prior to the close
11 of discovery. The defendant moved to strike the amended contentions on the grounds that they were
12 not supported by good cause. In partially granting the motion, the court analogized the filing of
13 amended invalidity contentions to adding new causes of action to the complaint. *Id.* at *5.
14 Similarly, in *Silver State Intellectual Techs., Inc. v. Garmin Int’l, Inc.*, 32 F. Supp. 3d 1155, 1160
15 (D. Nev. 2014), the defendant amended its invalidity contentions prior to the close of discovery. In
16 response, the plaintiff moved to strike portions of the amended contentions on the grounds that
17 defendant could not satisfy the good cause standard. Whether amended contentions satisfy the good
18 cause standard appears to be a dispositive-type determination, equivalent to ruling on a motion to
19 dismiss a complaint, rather than a discovery issue.

20 Rule 26(b)(1) of the Federal Rules of Civil Procedure provides that “[p]arties may obtain
21 discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and
22 proportional to the needs of the case, considering the importance of the issues at stake in the action,
23 the amount in controversy, the parties’ relative access to relevant information, the parties’ resources,
24 and the importance of the discovery in resolving the issues, and whether the burden and expense of
25 the proposed discovery outweighs its likely benefit. Information within the scope of discovery need
26 not be admissible in evidence to be discoverable.” Fed. R. Civ. P. 26(b)(1). It is the objecting
27 party’s burden to establish why a discovery request should be denied. *See Tedrow v. Boeing*
28 *Employees Credit Union*, 315 F.R.D. 358, 359 (W.D. Wash. 2016); *Painters Joint Comm. v.*
Employee Painters Trust Health & Welfare Fund, 2011 WL 4573349, at *5 (D. Nev. Sept. 29,
2011).

1 Applying the principles of Rule 26, the Court finds that Defendant has not met its burden of
2 showing why it should not respond to Interrogatory No. 16. Plaintiff was not required to obtain
3 leave of the court to serve its amended contentions because they were served before the discovery
4 cut-off date. Defendant has not moved to strike the amended contentions, but has, instead,
5 indirectly attacked them by objecting to Interrogatory No. 16 on the grounds that the amended
6 contentions are not supported by good cause. This is not a proper method for challenging amended
7 invalidity contentions because it, in effect, requires the disclosing party to first obtain court approval
8 for the amended contentions before it can conduct discovery relating to those contentions. This,
9 however, is contrary to LR 1-12. The Court will therefore grant Plaintiff's motion to compel
10 Defendant to answer Interrogatory No. 16. Because the Local Patent Rules are not explicitly clear
11 as how amended invalidity contentions filed before the discovery deadline should be challenged,
12 reasonable minds could differ as to the appropriateness of Defendant's objection. The Court
13 therefore will not award expenses to Plaintiff. *See Aevoe Corp. v. AE Tech Co., Ltd.*, 2013 WL
14 5324787, *1 (D.Nev. Sept. 20, 2013). This order does not preclude Defendant from filing a motion
15 to strike Plaintiff's Amended Invalidity Contentions. Accordingly,

16 **IT IS HEREBY ORDERED** that Plaintiff's Motion to Compel (ECF No. 107) is **granted**.
17 Defendant must serve its response to Plaintiff's Interrogatory No. 16 by **November 10, 2016**.

18 DATED this 2nd day of November, 2016.

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22 GEORGE FOLEY, JR.
23 United States Magistrate Judge
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