

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

BRIGHT RESPONSE, LLC	§	
F/K/A POLARIS IP, LLC,	§	
	§	
Plaintiff,	§	
v.	§	
	§	No. 2:07-cv-00371-CE
GOOGLE INC., ET AL.,	§	
	§	
Defendants.	§	Jury Demanded

**DEFENDANTS’ UNOPPOSED MOTION FOR LEAVE  
TO AMEND THEIR INVALIDITY CONTENTIONS**

Defendants Yahoo! Inc., Google Inc., and AOL, LLC (collectively “Defendants”), respectfully request leave of the Court to supplement their Invalidity Contentions under P.R. 3-6(b) of the Rules of Practice for Patent Cases before the Eastern District of Texas. Plaintiff is not opposed to this request. Good cause for this Motion exists because Plaintiff amended its infringement contentions against the parties to assert additional claims, and Defendant’s continued diligent research has led to the discovery of new prior art references and corresponding invalidity arguments.

**I. APPLICABLE LAW FAVORS AMENDMENT**

Defendants move this Court to amend their Invalidity Contentions pursuant to P.R. 3-6(b), which provides: “Amendment or supplementation of any Infringement Contentions or Invalidity Contentions, other than as expressly permitted in P.R. 3-6(a), may be made only by order of the Court, which shall be entered only upon a showing of good cause.” To determine good cause, courts consider the following non-exclusive factors:

- i. The length of the delay and its potential impact on judicial proceedings;
- ii. The reason for the delay, including whether it was within the reasonable control of the movant;
- iii. Whether the offending party was diligent in seeking an extension of time, or in supplementing discovery, after an alleged need to disclose the new matter became apparent;
- iv. The importance of the particular matter, and if vital to the case, whether a lesser sanction would adequately address the other factors to be considered and also deter future violations of the court's scheduling orders, local rules, and the federal rules of civil procedure; and
- v. The danger of unfair prejudice to the non-movant.

*Computer Acceleration Corp. v. Microsoft Corp.*, 481 F. Supp. 2d 620, 625 (E.D. Tex. 2007).

The Court should grant Defendants' Motion for Leave to Amend Their Invalidity Contentions as good cause exists.

**A. Delay Will Not Occur if Leave to Amend is Granted**

Granting this Motion will not delay or impact the Court's schedule. Permitting the Defendants to amend will not adversely impact the scheduled proceedings or dates in the Court's Docket Control Order.<sup>1</sup> The close of discovery is over a month away, expert discovery has not begun, and the close of expert discovery is nearly two months away. Furthermore, trial is not scheduled for over two month. Because Plaintiff will have adequate time to address Defendants' additional arguments, within the timeframe allowed for discovery and well before trial, Defendants' amendment will not disrupt the Court's schedule.

**B. The Time Lapse is Due to Plaintiff's Recently Asserted Claims and Amended Infringement Contentions**

Plaintiff only recently asserted certain claims against all Defendants. Due to these amended claims and infringement contentions, Defendants began a more rigorous investigation

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<sup>1</sup> The parties have recently submitted a proposed amended docket control order to the Court, and permitting the amended invalidity contentions will not adversely impact such proposed schedule.

into prior art related to those previously unasserted claims. During Defendants' continued diligent research, they discovered art pertinent to the asserted invalidity arguments. Thus, Defendants' supplemental invalidity contentions provide additional contentions and charts, included to address the new claims which were asserted against Defendants in Plaintiff's Amended Infringement Contentions and included based on newly discovered prior art.

**C. Defendants Were Diligent in Seeking Amendment and Granting Leave to Amend**

Defendants have been diligent in seeking leave to amend their Invalidity Contentions. Specifically, Defendants contacted Plaintiff as early as the first part of March 2010 to meet-and-confer pursuant to Local Rule CV-7(h). At that time, Plaintiff asked for further clarification of the Defendants' basis to update their Invalidity Contentions. Defendants provided all prior art references, charts, and the Amended Invalidity Contentions to Plaintiff prior to filing this motion.

**D. Amendment is Vital to Defendants' Invalidity Defense**

The arguments and prior art that Defendants seek to add to their Invalidity Contentions are important to establishing the invalidity of the asserted patent. For example, some of this same prior art forms the basis of a reexam request, which is still pending before the United States Patent and Trademark Office. Further, other prior art references describe products and services that were developed and used publically before the critical date by the same company of some of the inventors-in-suit. Therefore, these references and arguments are critical to establishing the invalidity of the asserted patent.

**E. There Is No Danger of Prejudice to Plaintiff If the Court Grants the Requested Leave To Amend**

Finally, Plaintiff will not suffer unfair prejudice as a result of the Defendants' amendment because discovery is still ongoing, the Court has not rendered a claim construction ruling, expert discovery has yet to begin, expert reports have not been severed, and expert discovery will not

close for nearly two months. Further, the supplemental contentions and charts have already been provided to plaintiff Bright Response, LLC, and Bright Response does not oppose this supplementation.

## **II. CONCLUSION**

For all the foregoing reasons, Defendants respectfully request that this Unopposed Motion for Leave to Amend Their Invalidity Contentions pursuant to P.R. 3-6(b) be granted.

Dated: May 28, 2010

Respectfully Submitted,

/s/ Jennifer Doan

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**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on May 28, 2010.

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/s/ Jennifer H. Doan  
Jennifer H. Doan

**CERTIFICATE OF CONFERENCE**

Defendants' counsel conferred with Bright Response LLC's counsel, Andrew Spangler, in good faith, on May 26, 2010, and Bright Response LLC does not oppose this motion.

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/s/ Jennifer Doan  
Jennifer Doan