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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

VOLTSTAR TECHNOLOGIES, INC.,

Plaintiff,

v.

SUPERIOR COMMUNICATIONS,
INC. et al.,

Defendants.

Case No. 2:19-cv-07355-MCS-(Ex)

**ORDER GRANTING PLAINTIFF’S
MOTION TO AMEND
INFRINGEMENT CONTENTIONS [47]**

In this action, Voltstar Technologies, Inc. (“Plaintiff”) alleges that Superior Communications, Inc. and AT&T Mobility LLC (“Defendants”) have infringed U.S. Patent Nos. 7,910,834 (“the ’834 Patent”) and 7,960,648 (“the ’648 Patent”) (collectively, “the Patents-in-Suit”). (“Complaint,” ECF No. 1.)

Plaintiff has moved to amend its Infringement Contentions to add dependent Claims 32 and 40 of the ’648 Patent. (“Motion,” ECF No. 47-1.) The Motion has been fully briefed. (“Opposition,” ECF No. 48; “Reply,” ECF No. 53.)

Based on a review of the filings, it has been determined that the Motion is appropriate for decision without oral argument. *See* Fed. R. Civ. P. 78; Local Rule 7-15.

1 For the reasons stated in this Order, the Motion is **GRANTED**.

2 **I. BACKGROUND**

3 Plaintiff commenced this action on August 23, 2019. (*See* Complaint). The
4 Complaint alleges that “AT&T’s QI wireless charger in combination with an electrical
5 device” infringed the ’648 Patent. (*Id.* ¶ 42.) The Complaint did not identify which
6 claims Plaintiff asserted for the ’648 Patent. On October 22, 2019, the Court set a Rule
7 16(b)/26(f) scheduling conference. (ECF No. 28.) On November 19, 2019, Plaintiff
8 served Defendants with its initial infringement contentions. (“Initial Infringement
9 Contentions,” ECF No. 47-3.) They identify Claims 31 and 39 of the ’648 Patent.

10 In the parties’ joint Rule 16(b)/26(f) report, which was filed on January 24, 2020,
11 Defendants requested an additional two weeks to serve their invalidity contentions
12 “because Plaintiff served its infringement contentions two weeks late[.]” (ECF No. 36
13 at 9.) Plaintiff did not oppose this request, and the Court approved the parties’ proposed
14 deadlines. (“Initial Scheduling Order,” ECF No. 37.) Under the Initial Scheduling
15 Order, the deadline for Defendants to serve their invalidity contentions was March 2,
16 2020. (*Id.*) Defendants did so on March 9, 2020. (ECF No. 47-2 ¶ 8; *see also* ECF No.
17 48 at 5.) Due to the ongoing COVID-19 pandemic, the Court extended the Initial
18 Scheduling Order five times. (ECF Nos. 39, 41, 44, 46, 52.) On September 16, 2020,
19 Plaintiff served Defendants with its amended infringement contentions, which added
20 Claims 32 and 40 of the ’648 Patent. (“Amended Infringement Contentions,” ECF No.
21 47-4.) On February 18, 2021, pursuant to General Order 19-03, the case was reassigned
22 here from District Judge Kronstadt. (ECF No. 68.)

23 The ’648 Patent is titled “Energy Saving Cable Assemblies.” It was filed on
24 October 15, 2008 and issued on June 14, 2011. The ’648 Patent “relates to”:

25
26 power saving cable assemblies, in particular, cable assemblies for use with
27 electrical devices having on-board rechargeable batteries and, more
28 particularly, to cable assemblies for laptop computers or other electrical
devices capable of sending an electrical signal indicating the electrical

1 device has been turned on so the cable assembly connects power to the
2 electrical device and shifts from a disconnect state in which power drain
3 commonly known as “phantom” load is substantially reduced or
4 eliminated.

4 ('648 Patent at 1:17–26.)

5 Claim 32 of the '648 Patent depends on Claim 31, which depends on independent
6 Claim 26. Those claims are as follows:

7
8 26. In combination with an electrical device, a cable assembly for
9 connecting and disconnecting electrical power to the electrical device, the
10 system comprising:
11 an input portion for connection with a power source for receiving input
12 electrical power;
13 a converter portion including converter circuitry for converting electrical
14 power; and
15 switch circuitry for controlling an on and an off state for the system,
16 wherein the switch circuitry automatically disconnects the input electrical
17 power to switch the system to the off state in response to a reduced power
18 state of the electrical device,
19 wherein the cable assembly consumes substantially no power while in the
20 off state.

17 31. The cable assembly as recited in claim 26 further comprising:
18 pulse monitoring circuitry operable to monitor pulses and drive the switch
19 circuitry based thereon.

20 32. The cable assembly as recited in claim 31 further comprising a
21 transformer, wherein the pulse monitoring circuitry is operable to monitor
22 pulses from the transformer and drive the internal switching circuitry based
23 thereon.

23 (*Id.*, Claims 26, 31, 32.)

24 Similarly, Claim 40 of the '648 Patent depends on Claim 39, which depends on
25 independent Claim 34. Those claims are as follows:

26
27 34. In combination with an electrical device, a cable assembly for
28 connecting and disconnecting electrical power to the electrical device, the
system comprising:

1 an input portion for connection with power source for receiving input
2 electrical power;
3 a converter portion including converter circuitry for converting electrical
4 power; and
5 switch circuitry for controlling an on and an off state for the system,
6 wherein the switch circuitry automatically connects the input electrical
7 power to switch the system to the on state,
8 wherein the cable assembly consumes substantially no power while in the
9 off state.

10 39. The cable assembly as recited in claim 34 further comprising:
11 pulse monitoring circuitry operable to monitor pulses and drive the switch
12 circuitry based thereon.

13 40. The cable assembly as recited in claim 39 further comprising a
14 transformer, wherein the pulse monitoring circuitry is operable to monitor
15 pulses from the transformer and drive the internal switching circuitry based
16 thereon.

17 (*Id.*, Claims 34, 39, 40.)

18 **II. ANALYSIS**

19 **A. Legal Standards**

20 As a preliminary matter, the Court holds that the case is still governed by the
21 Standard Patent Rules (“S.P.R.s”). (*See* ECF No. 20.) The S.P.R.s “are essentially a
22 series of case management orders that fall within a district court’s broad power to
23 control its docket and enforce its order.” *Keranos, LLC v. Silicon Storage Tech., Inc.*,
24 797 F.3d 1025, 1035 (Fed. Cir. 2015). District Courts have the inherent power to
25 manage their dockets and “are authorized to ‘consider and take appropriate action’ to
26 facilitate the ‘just speedy, and inexpensive disposition’ of all matters before them.”
27 *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1321 (Fed. Cir.
28 2016).

In assessing proposed amended infringement contentions, a good cause standard
applies. S.P.R. 4.1.2. If a party receiving amendments to contentions “believes that
amendments were made without good cause, it may move the Court to strike them.”

1 See, e.g., S.P.R. 4.1. To show good cause, the party who has amended its contentions
2 must show that it “acted with diligence in promptly moving to amend when new
3 evidence is revealed.” See *O2 Micro Int’l, Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355,
4 1363 (Fed. Cir. 2006). “The burden is on the moving party to show diligence.” *Apple*
5 *Inc. v. Samsung Elecs. Co.*, No. 5:12-CV-00630-LHK, 2012 WL 5632618, at *2 (N.D.
6 Cal. Nov. 15, 2012).

7 If the court finds that the moving party acted diligently, “[t]he court then
8 considers whether there would be undue prejudice to the non-moving party.” *Id.*
9 Although there is “no need to consider the question of prejudice” without diligence, “a
10 court in its discretion may elect to do so.” *Id.* at *2, *4 (allowing a limited addition to
11 infringement contentions where plaintiff failed to demonstrate diligence, but where
12 there would be no prejudice to defendant); see also *Slot Speaker Techs., Inc. v. Apple,*
13 *Inc.*, No. 4:13-CV-01161-HSG-(DMRx), 2017 WL 235049, at *2 (N.D. Cal. Jan. 19,
14 2017) (“District courts have wide discretion in enforcing the patent local rules.”)
15 (quoting *Finjan, Inc. v. Proofpoint, Inc.*, Case No. 4:13-CV-05808-HSG, 2015 WL
16 9460295, at *1 (N.D. Cal. Dec. 23, 2015)).

17 **B. Application**

18 1. Diligence

19 Plaintiff was not diligent in seeking to amend its Initial Infringement Contentions.
20 “[T]he diligence required for a showing of good cause has two phases: (1) diligence in
21 discovering the basis for amendment; and (2) diligence in seeking amendment once the
22 basis for amendment has been discovered.” *Positive Techs., Inc. v. Sony Elecs., Inc.*,
23 No. 3:11-CV-2226-SI, 2013 WL 322556, at *2 (N.D. Cal. Jan. 28, 2013). In considering
24 the first phase, the primary issue “is not when [the moving party] discovered this
25 information, but rather, whether they could have discovered it earlier had it acted with
26 the requisite diligence.” *Google, Inc. v. Netlist, Inc.*, No. 4:8-CV-4144 SBA, 2010 WL
27 1838693, at *2 (N.D. Cal. May 5, 2010).

28 Plaintiff argues that it inadvertently omitted dependent Claims 32 and 40 in its

1 Initial Infringement Contentions. (Motion at 4.) It contends that “Plaintiff’s counsel’s
2 review of the Invalidity Contentions [in early September], and in particular the Jung
3 prior art, brought to light the omitted dependent claims.” (Reply at 5.) Further, Plaintiff
4 argues that its delay in reviewing Defendants’ invalidity contentions and the “Jung”
5 reference was due to COVID-19 related issues, which are briefly mentioned in the
6 parties’ joint stipulations to continue deadlines in this action. (Motion at 9.)

7 Plaintiff’s argument that it could not have reviewed Defendants’ invalidity
8 contentions sooner is not persuasive. Defendants served Plaintiff with their invalidity
9 contentions on March 9, yet Plaintiff did not serve its amended infringement
10 contentions until September 16, over six months later. Independent of when Plaintiff’s
11 counsel conducted the review of Defendants’ invalidity contentions, the concession that
12 Plaintiff inadvertently omitted the claims reflects a lack of diligence in discovering that
13 it omitted them. *See, e.g., Apple*, 2012 WL 5632618, at *5 (“Courts have declined to
14 find good cause where plaintiffs sought to add ‘mistakenly omitted’ infringements [sic]
15 where plaintiffs could not adequately explain the cause for the errors or the
16 amendment’s delay.”); *see also Johnson v. Mammoth Recreations, Inc.*, 975 F.2d 604,
17 609 (9th Cir. 1992) (“[C]arelessness is not compatible with a finding of diligence and
18 offers no reason for a grant of relief.”). Plaintiff does not dispute that the evidence it
19 relies on was available to Plaintiff at the time it filed its Complaint.

20 For these reasons, Plaintiff has not shown that it was diligent in seeking to amend
21 its infringement contentions.

22 2. Prejudice

23 Defendants would not be prejudiced by allowing Plaintiff to amend its
24 infringement contentions.¹

25
26 ¹ Defendants also assert that prejudice cannot be considered if a party is not found to
27 be diligent, (Opposition at 7–10), but this position is not consistent with prior
28 decisions. *See, e.g., Apple*, 2012 WL 5632618, at *2. Further, the Federal Circuit
stated that a court “need not reach the question of prejudice unless it is satisfied that

1
2 Defendants argue that allowing the amendment would cause prejudice because it
3 would require them to shift their defense strategy from one “based primarily on
4 invalidity” to one based primarily on non-infringement. (Opposition at 11.) Defendants
5 contend that this would also affect their claim construction positions, which the parties
6 were required to exchange before the present motion was scheduled. (*Id.*) Further,
7 Defendants argue that they would be forced “to start all over with a new prior art search
8 focused upon new claim 32 [and claim 40].” (*Id.* at 12.)

9 Plaintiff responds that Defendants would not be prejudiced by the proposed
10 amendment because “this matter is still in an early stage with over two months renaming
11 in Claim Construction discovery from the time the Amended Infringement Contentions
12 were served, and three months remaining until claim construction briefing is to begin.”
13 (Motion at 9.) Plaintiff adds that the new claims “add only one new claim term, ‘a
14 transformer.’” (*Id.* at 6.) Further, Plaintiff states that its “infringement theory explicitly
15 identified the transformer in Plaintiff’s original infringement contentions with respect
16 to the ‘pulse monitoring circuitry’ element.” (Reply at 8.) Plaintiff also claims that
17 Defendants intend to assert that the term “pulse monitoring circuitry” is a
18 means-plus-function term governed by 35 U.S.C. § 112 ¶ 6, and “[t]he transformer is
19 among the ‘corresponding structures’ disclosed in the ’648 patent and its parent
20 applications.” (*Id.* at 9.)

21 Plaintiff’s arguments are persuasive. Defendants do not dispute that the
22 amendment only adds a single, new claim term. Nine days after the parties exchanged
23 claim constructions and while this motion was pending, the parties stipulated to
24 continue the remaining claim construction deadlines by two weeks. (ECF No. 52.)

25 _____
26 [Plaintiff] has been diligent in seeking amendment[,]” not that it could not. *O2 Micro*,
27 467 F.3d at 1368. Given the wide discretion district courts have to enforce patent local
28 rules, the Court will consider prejudice in connection with the present motion to
amend.

1 Defendants have already agreed to five prior continuances to the Court’s schedule.
2 Defendants could have also sought to continue the date to exchange proposed
3 constructions. That they did not do so undermines their argument that they were “forced
4 to commit to their claim construction contentions in writing on November 10.”
5 (Opposition at 13.) Further, “a diligent search by [Defendants] for prior art that would
6 invalidate” the limitation “pulse monitoring circuitry” “would have turned up any art
7 that would invalidate the dependent claim[s] [Plaintiff] is now moving to add to its
8 contentions.” *See WhatsApp Inc. v. Intercarrier Commc’ns, LLC*, No. 3:13-CV-04272-
9 JST, 2014 WL 12703766, at *4 (N.D. Cal. Sept. 3, 2014).

10 Although the Court’s Claim Construction Hearing is currently set for March 1,
11 2021, the Court finds that it would be prudent to allow the parties additional time to
12 supplement their invalidity and claim construction positions, and file supplemental
13 briefing. “[A]ny potential prejudice regarding the timing of [Plaintiff’s] proposed
14 amendments would be cured by granting [Defendants] leave to supplement its invalidity
15 contentions and to propose additional terms for construction by the Court in an
16 additional round of claim construction.” *Facebook, Inc. v. BlackBerry Ltd.*, No. 4:18-
17 CV-05434-JSW-(JSCx), 2019 WL 8013872, at *9 (N.D. Cal. Sept. 17, 2019) (internal
18 quotation marks omitted) (granting amendment despite argument that the amendment
19 ““would require [accused infringer] to investigate additional prior art to supplement its
20 own contentions in this case, as well as to potentially seek the construction of additional
21 claim terms whose meaning may be called into question by new theories,’ and are thus
22 prejudicial ‘with respect to claim construction proceedings’”); *see also DCG Sys. v.*
23 *Checkpoint Techs., LLC*, Case No. 11-CV-03792-PSG, 2012 WL 1309161, at *3 (N.D.
24 Cal. Apr. 16, 2012) (granting amendment where doing so “may force [defendant] to
25 research further prior art, amend its invalidity contentions, and perhaps supplement its
26 claim construction briefing”). Given that Defendants have already agreed to five prior
27 continuances of deadlines, there is no harm in allowing the parties additional time to
28 revise their positions.

1
2
3 **III. CONCLUSION**

4 Although Plaintiff has not demonstrated reasonable diligence, Defendants would
5 not be prejudiced if Plaintiff is permitted to amend its Initial Infringement Contentions.
6 Therefore, the Motion is **GRANTED**.

7 The Court continues the date of the Claim Construction Hearing to March 22,
8 2021 at 9:00 a.m. The Court also sets the Final Pretrial Conference date for November
9 1, 2021 at 2:00 p.m. and the Trial date for November 16, 2021 at 8:30 a.m. The Court
10 is unlikely to entertain any request to extend these dates. Should either party determine
11 that additional terms need to be construed from the newly added claims, the parties are
12 instructed to file simultaneous supplemental claim construction briefs by March 8,
13 2021, and simultaneous responsive briefs by March 15, 2021. Defendants may also seek
14 leave to file supplemental contentions addressing the new claims. Defendants shall meet
15 and confer with Plaintiff and make such an application within 14 days of this Order if
16 they elect to pursue such relief. Any application shall include a proposed deadline by
17 which such supplemental material will be served. Any objections must be submitted by
18 Plaintiff within seven days after Defendants file their application.

19
20 **IT IS SO ORDERED.**

21
22 Dated: February 23, 2021



23 MARK C. SCARSI
24 UNITED STATES DISTRICT JUDGE
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