
**IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF UTAH
CENTRAL DIVISION**

REALLY RIGHT STUFF,

Plaintiff,

v.

FIELD OPTICS RESEARCH,

Defendant.

RULING & ORDER

Case No: 2:20-cv-00345

District Court Judge David Barlow

Magistrate Judge Dustin B. Pead

INTRODUCTION

This case is currently before Magistrate Judge Dustin B. Pead pursuant to a 28 U.S.C. § 636(b)(1)(A) referral from District Court Judge David B. Barlow.¹ Currently pending is Plaintiff Really Right Stuff's ("Plaintiff") Motion for Leave to Amend Infringement Contentions, Defendant Field Optics Research Inc.'s ("Defendant") Motion for Leave to Amend Non-Infringement Contentions and Defendant's Motion for Leave to Amend Invalidity Contentions.² Plaintiff objects to both of Defendant's motions.³

¹ ECF No. 14, Order Referring Case.

² ECF No. 78, Plaintiff's Motion for Leave to Amend Infringement Contentions; ECF No. 97, Defendant's Motion for Leave to Amend Non-Infringement Contentions; ECF No. 98, Defendant's Motion for Leave to Amend Invalidity Contentions.

³ ECF No. 99, Plaintiff's Combined Response To Defendant's Motion To Amend Invalidity Contentions and Defendant's Motion To Amend Non-Infringement Contentions.

Oral argument on the pending motions was heard by the Court on October 3, 2022.⁴ For the reasons stated on the record and as set forth herein, the Court now rules as follows.

BACKGROUND

This is an action for patent infringement under 35 U.S.C. § 271.⁵ Plaintiff brings claims against Defendant for infringement of three assigned patents related to the following inventions: (1) Quick Release Clamp For Photographic Equipment, United States Patent 6,733,172 (the “172 Patent”); (2) Dual Clamping Device, United States Patent 10,612,718 (the “718 Patent”); and (3) Panoramic Camera Mount, United States Patent 10,585,337 (the “337 Patent”).⁶

Plaintiff served its Final Infringement Contentions on March 23, 2021, asserting infringement of:

- *Claim 29 of the ‘172 patent;
- *Claims 1, 3, 4, 10, 11, 12, 13, 14, 15 and 20 of the ‘718 patent; and
- *Claims 1, 7, 11, 18, 25, 26, 30, 33, 35 and 42 of the ‘337 patent.⁷

On April 5, 2021, Defendant served its Final Unenforceability and Invalidity Contentions.⁸ On April 20, 2022, Defendant provided its Final Non-Infringement Contentions claiming, “it does not infringe any of the 3 asserted patents with any of its products, either directly or indirectly, whether literally or through the doctrine of equivalents.”⁹

⁴ ECF No. 106, Minute Entry.

⁵ ECF No. 22, Plaintiff’s First Amended Complaint for Patent Infringement.

⁶ *Id.*

⁷ ECF No. 99-1, Exhibit 1, Plaintiff’s Disclosure of Final Infringement Contentions.

⁸ ECF No. 99-2, Exhibit 2, Defendant’s Disclosure of Final Unenforceability and Invalidity Contentions.

⁹ ECF No. 99-3 at 3, Exhibit 3, Defendant’s Disclosure of Final Non-Infringement Contentions.

On June 9, 2022, Defendant for the first time disclosed its media kit containing images of model code FPH-ULP, which Plaintiff identified as an additional infringing product. As a result, on June 17, 2022, Plaintiff filed its Motion For Leave to Amend Final Infringement Contentions to supplement its initial infringement contentions to include newly disclosed product FPH-ULP.¹⁰

On June 29, 2022, the parties filed a joint Motion to Stay the Court's consideration of Plaintiff's Motion to Amend.¹¹ Shortly thereafter, the Court granted the parties' stay, but denied Plaintiff's Motion to Amend Final Infringement Contentions without prejudice subject to refileing after claim construction.¹²

On July 27, 2022, attorney Howard H. Sheerin ("Sheerin") was admitted *pro hac vice* as new counsel for Defendant.¹³ The next day, pursuant to Local Patent Rule ("LPR") 3.4, Defendant filed its pending Motion for Leave to Amend Non-Infringement Contentions related to the '172 and '337 patents¹⁴ and its Motion for Leave to Amend its Invalidity Contentions related to the '337 and '718 patents.¹⁵

¹⁰ ECF No. 78, Plaintiff's Motion for Leave to Amend Infringement Contentions.

¹¹ ECF No. 84, Joint Motion to Stay Consideration Of Plaintiff's Motion to Amend Final Infringement Contentions;

¹² ECF No. 90, Docket Text Order; *see also*, ECF No. 88, Amended Notice of Hearing; ECF No. 101, Notice Vacating Markman Hearing.

¹³ ECF No. 96, Order Granting Motion for Admission Pro Hac Vice of Attorney Howard H. Sheerin.

¹⁴ ECF No. 97, Defendant's Motion for Leave to Amend Non-Infringement Contentions.

¹⁵ ECF No. 98, Defendant's Motion for Leave to Amend Invalidity Contentions.

Plaintiff opposes both motions except to the extent that Defendant seeks to amend its non-infringement contentions related to the recently disclosed FPH-ULP product.¹⁶

LOCAL PATENT RULES

This court has adopted a set of Local Patent Rules (“LPR”) to “provide a standard structure for patent cases that will permit greater predictability and planning for the court and litigants.”¹⁷

In relevant part, Section 3.4 of the LPR, entitled Amendment of Final Contentions, states:

A party may amend its Final Infringement Contentions or Final Non-infringement, or Unenforceability and Invalidity Contentions only by Order of the court upon a showing of good cause and absence of unfair Prejudice to opposing parties, made no later than 14 days of the discovery of the basis for the amendment.¹⁸

DISCUSSION

Plaintiff’s Motion for Leave to Amend Final Infringement Contentions¹⁹

Plaintiff’s timely filed²⁰ and unopposed Motion for Leave to Amend Final Infringement Contentions to assert claim 29 of patent ‘172 against Defendant’s product code FPH-ULP is granted.

¹⁶ ECF No. 99.

¹⁷ Local Patent Rules, Preamble.

¹⁸ Local Patent Rules 3.4, Amendment of Final Contentions.

¹⁹ On September 23, 2022, this Court granted Plaintiff’s Motion for Leave to Refile its Motion for Leave to Amend Infringement Contentions which had been previously denied without prejudice subject to re-filing after the Markman hearing. ECF No. 104; ECF No. 90. In doing so, the Court concluded that because Defendant’s Motion sought to amend its non-infringement contentions related to claim 29 of the ‘172 patent (product FPH-ULP), Plaintiff’s motion to amend its final infringement contentions related to the same claim, patent and product should also be addressed by the Court.

Defendant’s Motion to Amend Final Non-Infringement Contentions

Pursuant to Local Patent Rule 3.4, Defendant seeks leave to amend its final non-infringement contentions as to the ‘172 and ‘337 patents.

‘172 Patent

Defendant argues its non-infringement contentions related to product FPH-ULP depend on an interpretation of the terms “first position” and “second position” and as a result should be amended prior to the Markman hearing.²¹ Plaintiff has no objection,²² and Defendant’s Motion to Amend its Non-Infringement Contentions regarding claim 29 of the ‘172 patent is granted.

‘337 Patent

As to the ‘337 patent, amendment is sought based on discussions with newly retained attorney Sheerin who “counseled” Defendant on new arguments to be raised.²³ Plaintiff opposes amendment, arguing an absence of good cause.

In addressing amendment under LPR 3.4, the questions before the Court are whether: (1) the request is made within 14 days of the discovery for the basis of the amendment; (2)

²⁰ Plaintiff filed its Motion to Amend Final Infringement Contentions on July 17, 2022, within fourteen days of Defendant’s the June 9, 2022, disclosure of new evidence.

²¹ ECF No. 103 at 9-18, Plaintiff’s Supplemental Final Infringement Contentions. Claim elements for claim 29 of patent ‘172 (as included in Plaintiff’s supplemental infringement contentions) include: (b) a lever capable of causing said lateral movement and movable between a first position and a second position, said lever engaged on a side of said member.

²² ECF No. 99, Plaintiff’s Combined Response to Defendant’s Motions.

²³ ECF No. 97 at 7-8, Defendant’s Proposed Amended Final Non-Infringement Contentions. *See also*, 35 U.S.C. 112(f).

Defendant can show good cause for the amendment; and (3) Plaintiff is prejudiced by amendment. The Court addresses each of these factors.

a. Timeliness

Defendant contends it discovered the basis for amendment during a “conference with Mr. Sheerin on 07/15/2022 (and in the days following)[,]” and on July 28, 2022, Defendant filed its Motion to Amend Non-Infringement Final Contentions.²⁴

After discovery, Defendant filed its motion within LPR 3.4’s fourteen (14) day window and the request for amendment is timely.

b. Good Cause & Undue Prejudice

The LPR provide little guidance on what constitutes good cause for purposes of amendment. The clearest illustration is provided in the Rule itself identifying one example “of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, . . . [as] a claim construction by the court different from that proposed by the party seeking amendment.”²⁵ This example, however, provides little clarity here since a Markman hearing has not been held and the Court has not had an opportunity to construe any of the claims.

As support for good cause, Defendant references the hiring of new counsel Sheerin, health concerns, the limitations of solo practitioners and Covid-19. Yet given the inquiry’s focus on diligence,²⁶ it is difficult to understand how Defendant’s claims can establish good cause for

²⁴ ECF No. 97 at 2.

²⁵ LPR 3.4.

²⁶ See *O2 Micro Int’l. Ltd. v. Monolithic Power Sys.*, 467 F.3d 1364, 1366 (Fed. Cir. Nov. 15, 2006) (“good cause requires a showing of diligence”) (internal citation omitted). Although the arguments do not speak to diligence, Defendant also asserts that amendment of its non-infringement contentions is

amendment. Indeed, neither the addition of new counsel, nor a failure to act are “compatible with a finding of diligence.”²⁷ As a result, the Court turns to prejudice. While amendment admittedly creates a degree of prejudice for the non-moving party, “the inconvenience and expense required by additional discovery and briefing of the new issues does not generally rise to the level” of prejudice that is undue.²⁸ Such is the case here. While amendment will place an additional burden on Plaintiff, given the procedural posture of the case, any prejudice will not be undue.

Under these circumstances and based on the information provided by Defendant, the court struggles to find good cause. On balance, the Court offers greater weight to the absence of undue prejudice and concludes that, at this juncture and in advance of claim construction, principles of judicial efficiency support amendment of Plaintiff’s Non-Infringement Contentions. Indeed, given the absence of undue prejudice, it would be “incongruous to deny amendment now, at the final contentions stage of the litigation, only to grant amendment later based upon a development in the claim construction stage of the litigation.”²⁹

Accordingly, Defendant’s Motion for Leave to Amend Non-Infringement Contentions as to the ‘172 and the ‘337 patents is granted.

appropriate because the case is early in the process and Plaintiff has only had to contend with a limited number of non-infringement issues.

²⁷ See *West v. Jewelry Innovations*, 2008 U.S. Dist. LEXIS 84928 at *11 (N.D. Cali. Oct. 8, 2008) (citing *MEMC Electronic Materials v. Mitsubishi Material silicon Corp.*, 2004 WL 5363616 at *5) (N.D. Cali. March 2, 2004).

²⁸ *Corel Software LLC v. Microsoft Corporation*, 2018 U.S. Dist. LEXIS 189832 at *9-10 (D. Utah Nov. 5, 2018).

²⁹ *Id.* at *8.

Defendant’s Motion For Leave to Amend Invalidity Contentions

Next, Defendant moves to amend its invalidity contentions related to the ‘337 and the ‘718 patents. Similar to amendment of its non-infringement contentions, Defendant offers the retention of attorney Sheerin as grounds for amendment.³⁰ Additionally, Defendant suggests that amendment is appropriate due to the discovery of new prior art. Plaintiff objects, asserting Defendant cannot establish good cause and any new theories or prior art references have been “available to Defendant for the life of this case.”³¹

When addressing amendment under LPR 3.4 the questions before the Court are whether: (1) the request is made within 14 days of the discovery for the basis of the amendment; (2) Defendant can show good cause for the amendment; and (3) Plaintiff is prejudiced by amendment.³²

‘718 and ‘337 patents

a. Timeliness

The relevant dates for purposes of timeliness include: the July 15, 2022 conference with attorney Sheerin where new arguments and theories were raised, the July 15, 2022,³³ disclosure

³⁰ See 35 U.S.C. § 112.

³¹ ECF No. 99 at 4, Plaintiff’s Combined Response to Defendant’s Motions to Amend.

³² LPR 3.4, Amendment of Final Contentions.

³³ ECF No. 100 at 4, Defendant’s Reply to Plaintiff’s Response to Defendant’s Motions to Amend (amendment appropriate due to the “discovery of a new prior art, disclosed to Plaintiff on July 15, 2022 in response to Plaintiff’s subpoena duces tecum during Plaintiff’s Rule 30(b)(6) deposition of Mr. Vincent Warner. . .”).

of new prior art in response to Plaintiff's subpoena duces tecum and the July 27, 2022,³⁴ discovery of new prior art.

Defendant filed its Motion to Amend Non-Invalidity contentions on July 28, 2022— within the fourteen day (14) window of discovery required under the LPR. As a result, Defendant's request for amendment is timely.

b. Good Cause and Prejudice

As discussed above, the LPR provide little guidance on good cause. Yet unlike the decision to hire new counsel, the “recent discovery of material, prior art despite an earlier diligent search” has been identified as a circumstance supportive of good cause for amendment.³⁵ Here it is unclear exactly how the new prior art was discovered or if there was diligence in doing so. Defendant, however, argues that the prior art was difficult to find because the “key reference in question dates from 1948, well before the USPTO's full text database begins[.]”³⁶

Upon review and as discussed further with respect to amendment of non-infringement contentions, the court finds good cause to amend the invalidity contentions. While there undoubtedly will be some prejudice in allowing amendment, it is not undue and because

³⁴ ECF No. 98 at 2, Plaintiff's Motion for Leave to Amend Invalidity Contentions (amendment appropriate based on “a new prior art reference, discovered by the Defendant on 07/27/2022, which was not considered by the examiner during prosecution of the ‘718 patent application, and which is not cumulative to any prior art reference of record in the prosecution history.”).

³⁵ *Angioscore, Inc. v. Trireme Med., Inc.*, 2015 U.S. Dist. LEXIS 1118 at *15 (N.D. Cali Jan. 6, 2015); *see also Synchronoss Techs., Inc. v. Dropbox Inc.*, 2018 U.S. Dist. LEXIS 185105 at *9 (N.D. Cali Oct. 29, 2018) (“recent discovery of material prior art despite an earlier diligent search” may support good cause for amendment).

³⁶ ECF No. 100 at 5.

Defendant seeks amendment pre-claim construction, judicial efficiencies support allowing amendment at this juncture.

CONCLUSION

Accordingly, for the reasons stated on the record at the October 3, 2022, hearing and as set forth in this written ruling,

Plaintiff's Motion to Amend Infringement Contentions is GRANTED;

Defendant's Motion to Amend Non-Infringement Contentions is GRANTED; and

Defendant's Motion to Amend Invalidity Contentions is GRANTED.³⁷

IT IS SO ORDERED.

DATED this 11th day of October, 2022.



Dustin B. Pead, U.S. Magistrate Judge

³⁷ ECF No. 78, Plaintiff's Motion to Amend Infringement Contentions; ECF No. 97, Defendant's Motion to Amend Non-Infringement Contentions; ECF No. 98, Defendant's Motion to Amend Invalidity Contentions.