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8 UNITED STATES DISTRICT COURT
9 CENTRAL DISTRICT OF CALIFORNIA

10 FACET TECHNOLOGIES, LLC,

11 Plaintiff,

12 v.

13 LIFESCAN, INC.,

14 Defendant.
15
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Case No. 2:22-cv-01717-MCS (MARx)

**ORDER REGARDING MOTION TO
STRIKE LIFESCAN, INC.'S
SUPPLEMENTAL INVALIDITY
CONTENTIONS [ECF NO. 172]**

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18 Plaintiff Facet Technologies, LLC (“Plaintiff” or “Facet”) filed a motion to strike
19 Defendant LifeScan, Inc.’s (“Defendant” or “LifeScan”) supplemental invalidity
20 contentions. (“Mot.,” ECF No. 172). LifeScan opposed (“Opp.,” ECF No. 180), and
21 Facet replied (“Reply,” ECF No. 185). The Court finds the Motion appropriate for
22 resolution without oral argument. *See* Fed. R. Civ. P. 78(b); C.D. Cal. R. 7-15. The
23 Motion is **GRANTED**.

24 **I. BACKGROUND**

25 Facet brought this action on March 15, 2022. (“Compl.,” ECF No. 1.) Facet
26 alleges that LifeScan infringes at least claims 1, 6, 8, 14, and 18 of the ’635 Patent.
27 (“FAC,” ECF No. 93.) The ’635 Patent is directed to “improved lancet and lancet
28 endcap configurations” to facilitate safer blood testing necessary to treat certain medical

1 conditions, such as diabetes. (FAC ¶¶ 21, 26.)

2 The parties filed their Joint Rule 26(f) Report on June 29, 2022. (ECF No. 55).
 3 They proposed August 22, 2022 as LifeScan's deadline to serve its preliminary
 4 invalidity contentions and prior art. (*Id.*) They further proposed that Facet would serve
 5 its final infringement contentions 14 days after the Court's claim construction ruling
 6 and that LifeScan would serve its final invalidity contentions 14 days after receipt of
 7 Facet's final infringement contentions. (*Id.*) The Court issued a scheduling order in this
 8 case setting an August 22, 2022 deadline for preliminary invalidity contentions. (ECF
 9 No. 59). The Court did not set any patent-specific dates after the Claim Construction
 10 Hearing, including deadlines for final infringement and invalidity contentions. (*Id.*) The
 11 Court held the Claim Construction hearing on January 9, 2023 and issued its ruling on
 12 January 20, 2023. (ECF Nos. 119 and 122).

13 Facet served supplemental infringement contentions on January 6, 2022. (ECF
 14 No. 172-6). Facet contends its supplement merely conforms to its amended complaint
 15 and does not raise new issues relevant to invalidity. ("Memo," ECF No. 172-1 at 7).
 16 LifeScan served its first set of supplemental invalidity contentions on February 17,
 17 2023. (ECF No. 172-8). LifeScan served a second supplement on April 1, 2023. (ECF
 18 No. 172-9). Facet contends both sets of supplemental invalidity contentions are
 19 untimely and that LifeScan cannot establish good cause for the supplements. (*See*
 20 *generally*, Memo). Facet first raised this issue with Magistrate Judge Rocconi. (ECF
 21 No. 131). Judge Rocconi declined to rule on the issue and denied Facet's motion without
 22 prejudice to bring the issue before the district judge. (ECF No. 160).

23 II. LEGAL STANDARDS

24 Facet cites *Voltstar Techs., Inc. v. Superior Commc'ns, Inc.*, No.2:19-CV-07355-
 25 MCS-(Ex), 2021 WL 5605279 (C.D. Cal. Feb. 23, 2021) for the relevant legal standard.
 26 However, the Court in *Voltstar* adopted a standing order setting forth special patent
 27 rules. *Id.* at *2. Here, the Court has not adopted special patent rules. Life Scan cites
 28 authority applying the Northern District of California Local Patent Rules ("N.D. Cal.

1 L.P.R.”) and other special patent rules. The N.D. Cal. L.P.R. do not control in this this
2 district. Further, the parties have not agreed to be bound by the N.D. Cal. L.P.R. or any
3 other set of special patent rules. Still, the good cause standard applied in the cases the
4 parties cite is instructive and consistent with Rules 15 and 16.

5 Parties must demonstrate good cause to supplement their contentions. *Voltstar*
6 *Techs.*, 2021 WL 5605279, at *3. The Court may strike supplemental contentions
7 containing amendments made without good cause. *See, id.* To show good cause, the
8 party who has amended its contentions must show that it “acted with diligence in
9 promptly moving to amend when new evidence is revealed.” *See O2 Micro Int’l, Ltd. v.*
10 *Monolithic Power Sys.*, 467 F.3d 1355, 1363 (Fed. Cir. 2006). “The burden is on the
11 moving party to show diligence.” *Apple Inc. v. Samsung Elecs. Co.*, No. 5:12-CV-
12 00630-LHK, 2012 WL 5632618, at *2 (N.D. Cal. Nov. 15, 2012). “Good cause” also
13 exists where a supplement of contentions is based on the parties’ agreement. *See O2*
14 *Micro Intl’l, Ltd.*, 467 F.3d at 1366-1367. If the court finds that the moving party acted
15 diligently, the Court considers whether allowing supplemental contentions would
16 unduly prejudice the non-moving party. *Voltstar*, 2021 WL 5605279 at *2. The Court
17 need not consider the prejudice question absent a showing of diligence, though the
18 Court may exercise its discretion to do so. *Id.*

19 **III. DISCUSSION**

20 **A. The Parties’ Positions**

21 Facet argues the Court should strike both sets of LifeScan’s supplemental
22 invalidity contentions because the amendments are not tied to the Court’s claim
23 construction ruling and because LifeScan has not otherwise shown good cause. (Memo
24 at 12.) Specifically, Facet argues the claim constructions cannot establish good cause
25 because they were foreseeable. (*Id.*) Facet also argues LifeScan has not shown diligence
26 because LifeScan does not explain why or how it identified the new references included
27 in its supplemental contentions and why it could not have identified those references
28

1 earlier. (*Id.* at 13.) Facet further argues the supplemental contentions are prejudicial
2 given their untimeliness and the volume of new references they identify. (*Id.* at 13–14.)
3 Facet argues it did not have enough time to take discovery on the new references and
4 that the volume of references asserted leaves Facet uncertain as to which invalidity
5 positions LifeScan will present at trial. (*Id.* at 14–15.)

6 LifeScan argues its supplemental contentions were timely in light of the parties’
7 proposed deadlines included in their Joint Rule 26(f) report. (Opp. at 10.) LifeScan also
8 argues that N.D. Cal. L.P.R. 3-3 authorizes supplemental contentions. (*Id.* at 10–11.)
9 Further, to the extent the contentions are untimely, LifeScan argues the Court’s claim
10 construction ruling provides good cause for the amendments. (*Id.* at 11.) Finally,
11 LifeScan argues that the supplemental contentions do not prejudice Facet because Facet
12 had ample time to conduct discovery. (*Id.* at 13–14.) Per LifeScan, any failure to
13 conduct discovery is due to Facet’s lack of diligence. (*Id.*)

14 Facet replies that the Joint Rule 26(f) report only presents proposed dates for the
15 Court to consider and does not constitute a stipulation, as LifeScan contends. (Reply at
16 4.) Facet further argues that the N.D. Cal. L.P.R. do not apply. (*Id.* at 4–5.)

17 **B. Analysis**

18 First, the Court finds Life Scan’s supplemental contentions untimely. The Court
19 did not set a deadline for supplemental contentions or any other patent-specific
20 deadlines following the claim construction hearing. (*See* ECF No. 59). In its scheduling
21 order, the Court indicated it would schedule other patent-specific dates after the claim
22 construction hearing only as needed (*Id.*) The parties did not stipulate to additional dates
23 and neither party individually requested that the Court set additional dates. The Court
24 did not adopt the proposed final contention dates set forth in the parties’ Joint Rule 26(f)
25 Report. Additionally, the N.D. Cal. L.P.R. do not govern here. On occasion, the Court
26 or parties may agree that special patent rules apply in a specific case. For instance,
27 parties may agree to adopt the N.D. Cal. L.P.R. or another district’s patent rules. Here,
28 the parties have not made any such agreement.

1 Because the supplemental invalidity contentions are untimely under the
2 scheduling order, the Court next determines whether good cause exists. The Court finds
3 it does not. First, other than this Court’s claim construction ruling, Life Scan offers no
4 reason it could not have searched for and identified the references included in both sets
5 of supplemental contentions earlier. The claim construction ruling does not provide a
6 good cause basis to supplement invalidity contentions. Generally, claim construction
7 rulings provide good cause for supplementation where the Court adopts constructions
8 that significantly diverge from one or both parties’ positions. *See Verinata Health, Inc.*
9 *v. Sequenom, Inc.*, No. C 12-00865 SI, 2014 WL 789197, at *2 (N.D. Cal. Feb. 26,
10 2014). A party seeking leave to supplement may fail to establish diligence where the
11 Court adopts foreseeable constructions. *Id.* Here, the Court found plain and ordinary
12 meaning applied to nearly all of the terms. (*See* ECF No. 122 at 28-29.) As to the term
13 “a secondary sheath for receiving the sharp lancing tip of a used lancet,” the Court
14 adopted the broad and entirely foreseeable construction, “a secondary sheath for
15 covering the sharp lancing tip of a used lancet by embedding or enclosing the lancet
16 tip.” (*Id.* (emphasis added).) There is no reason to think that a broad prior art search
17 would not have captured references consistent with the Court’s constructions.

18 Because LifeScan’s contentions are untimely and LifeScan has not established
19 good cause to supplement, the Court need not consider prejudice. *Voltstar*, 2021 WL
20 5605279 at *2. Still, even if LifeScan had established good cause, the timing and scope
21 of LifeScan’s supplemental contentions likely prejudices Facet. First, LifeScan’s
22 supplemental contentions, together, assert 26 previously undisclosed references. (*See*
23 Memo at 14.) To compare, LifeScan’s initial invalidity contentions identify only 28
24 references. (*Id.*) Thus, the supplements nearly double the scope of LifeScan’s invalidity
25 contentions. Additionally, 18 of the new references comprise system art. (*Id.*) Invalidity
26 positions based on system art can raise significant factual issues and often involve third
27 party discovery. Second, because of the number of asserted references and the type of
28 references asserted, the untimeliness poses prejudice. Fact discovery closed on May 29,

1 2023. (*See* Opp. at 13.) The case schedule and timing of LifeScan's supplemental
2 contentions left Facet with a mere two to three months to undertake fact discovery as to
3 the 18 new system references. The limited time to take extensive discovery under the
4 schedule likely poses prejudice, even if LifeScan had established diligence.

5 For the foregoing reasons, both sets of LifeScan's supplemental invalidity
6 contentions are untimely and good cause does not support the supplementation.
7 Moreover, even if LifeScan had shown diligence, the risk of prejudice here might still
8 warrant exclusion.

9 **IV. CONCLUSION**

10 The Court **GRANTS** Facet's Motion to Strike LifeScan's Supplemental
11 Invalidity Contentions.

12
13 **IT IS SO ORDERED.**

14
15 Dated: June 7, 2023



MARK C. SCARSI
UNITED STATES DISTRICT JUDGE