IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NEXTGEN INNOVATIONS, LLC, Plaintiff, v. FUJITSU NETWORK COMMUNICATIONS, INC., FUJITSU LIMITED, FUJITSU OPTICAL COMPONENTS LIMITED, AND FUJITSU OPTICAL COMPONENTS AMERICA, INC., Defendants.	Case No. 2:22-cv-00307-JRG-RSP **LEAD CASE**
NEXTGEN INNOVATIONS, LLC, Plaintiff, v. INFINERA CORPORATION, Defendant.	Case No. 2:22-cv-00306-JRG-RSP **MEMBER CASE**
NEXTGEN INNOVATIONS, LLC, Plaintiff, v. AT&T SERVICES, INC. AND AT&T CORP., Defendants.	Case No. 2:22-cv-00308-JRG-RSP **MEMBER CASE**
NEXTGEN INNOVATIONS, LLC, Plaintiff, v. NOKIA OF AMERICA CORPORATION, NOKIA NETWORKS, AND NOKIA SOLUTIONS AND NETWORKS OY, Defendants.	Case No. 2:22-cv-00309-JRG-RSP **MEMBER CASE**

DEFENDANTS' OPPOSED MOTION FOR LEAVE TO AMEND INVALIDITY CONTENTIONS

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TABLE OF EXHIBITS

Exhibit	Description
A	Fact Declaration of Monte Squire, October 12, 2023, including authentication of Exhibits 1-12.
1	Defendants' (M. Squire) Email to NextGen, Aug. 1, 2023, Providing Notice of Non-Party Prior Art Product, Enclosing Provisional Invalidity Claim Chart
2	AT&T Defendants' (A. Franklin) Email to All Parties, serving AT&T's Notice of Third-Party Deposition and *Subpoena Duces Tecum* to Ciena Corporation, Aug. 24, 2023
3	Non-Party Ciena's (R. Gabriel) Email to AT&T Defendants (D. Dyer), Producing Technical Documents as RESTRICTED – ATTORNEYS' EYES ONLY
4	AT&T Defendants' (V. Wendel) Email to All Parties, Enclosing Ciena's Production.
5	Defendants' Amended and Supplemental Invalidity Contentions, attached to Defendants (S. Saleem) Email to NextGen (Sept. 26, 2023)
6	Emails Between Defendants (S. Saleem) and NextGen (A. Weiss) from September 26 to October 1, 2023
7	Redline comparison of specifications of U.S. Patent 9,337,948 (filed July 30, 2009) and U.S. Patent 7,242,868 (filed June 10, 2004)
8	US Patent 9,887,795
9	US Patent 9,337,948
10	Excerpt of File History for U.S. Patent 10,263,723
11	U.S. Patent 7,242,868
12	Ciena article, Coherent Optical Turns 10 – Here's How It Was Made, March 9, 2018 (PA_0012842).

I. INTRODUCTION

Pursuant to Local Patent Rule 3-6(b), Defendants[1] respectfully move for leave to amend their invalidity contentions (the "Invalidity Contentions") to add a prior art product that required investigation and discovery from a third party. Defendants served their original Invalidity Contentions in February. Despite Defendants' significant efforts to search for, investigate, and identify prior art relevant to the asserted M-Ary Patents[2] before serving their Invalidity Contentions, Defendants only discovered the existence of the prior art product — the Nortel 40G/100G Adaptive Optical Engine (the "Adaptive Optical Engine") — in June. Defendants promptly gathered and presented all of the publicly known information about the Adaptive Optical Engine in a provisional claim chart to Plaintiff NextGen Innovations, LLC ("NextGen") on August 1, 2023. Through third-party discovery, Defendants secured additional critical confidential details regarding the Adaptive Optical Engine on September 21, 2023 and immediately served amended invalidity contentions on September 26, 2023, subject to the leave of Court sought here.

Good cause exists for granting Defendants leave to amend, and all four factors favor this request.

First, Defendants were diligent. On August 1, Defendants notified NextGen of their intent to supplement their Invalidity Contentions subject to further investigation, and provided NextGen with documents and an invalidity claim chart with Defendants' exemplary mapping of the newly discovered prior art to a representative claim. Ex. 1. As most of the claim elements could only be

[1] Fujitsu Network Communications, Inc., Fujitsu Limited, Fujitsu Optical Components Limited, and Fujitsu Optical Components America, Inc. (collectively, "Fujitsu"); Defendant Infinera Corporation ("Infinera"); Defendants AT&T Services, Inc. and AT&T Corp. (collectively, "AT&T"); and Defendants Nokia of America Corporation, Nokia Corporation, and Nokia Solutions and Networks OY, (collectively, "Nokia") (all defendants collectively, "Defendants").

[2] U.S. Patent Nos. 9,887,795, 10,263,723, and 10,771,181 (collectively, the "M-Ary Patents").

mapped on "information and belief," Defendants also informed NextGen that their investigation of the Adaptive Optical Engine prior art was ongoing and that they were seeking additional information from Ciena Corporation ("Ciena"), who Defendants learned had acquired the relevant business line from Nortel. By September 21, the AT&T Defendants were able to secure Ciena's cooperation and obtain a production of technical documents containing confidential, Restricted – Attorney's Eyes Only information that provided the missing details concerning the subcomponents and functionality of the Adaptive Optical Engine product from the 2008-2009 timeframe. The next day, AT&T re-produced Ciena's technical production to NextGen and the remaining Defendants. Ex. 4. Defendants quickly completed their review and analysis of this critical information and, within three business days, on September 26, served NextGen with detailed supplemental invalidity contentions with explicit charting of the confidential details of the Adaptive Optical Engine against all of the asserted claims of the three M-Ary Patents. Ex. 5.

Second, the proposed amendment is important to Defendants' case. As detailed below, the Adaptive Optical Engine prior art is important because Defendants contend that it renders all of the asserted claims of the M-Ary Patents invalid. Further, unlike Defendants' other references, the Adaptive Optical Engine prior art is system prior art, that is often more probative and easier for juries to understand. The art is additionally important because Defendants now know that the system's internal subcomponents are the same or substantially similar to the products that Plaintiff is accusing of infringement, making it key to Defendants' defenses. Finally, the Adaptive Optical Engine is uniquely situated and important evidence to the case because it corroborates certain written description and enablement defenses, and a related priority date dispute.

Third, NextGen would not be prejudiced, for several reasons. Defendants have committed to offset the addition of the Adaptive Optical Engine prior art with a corresponding

reduction/removal of other prior art so that the net number of references will be unchanged. Additionally, NextGen received Defendants' supplemental invalidity contentions nine weeks before the close of fact discovery, six weeks before the *Markman* Hearing, and before Plaintiff has taken any fact depositions (third-party or otherwise). Importantly, NextGen has not suggested that the prior art raises a new, genuine issue of disputed claim construction. To the extent NextGen now raises the issue, Defendants do not oppose addressing any reasonable claim construction disputes. Lastly, separate and apart from the issue of prior art invalidity (and, therefore, regardless of the outcome of this motion), the Adaptive Optical Engine provides important evidence supporting Defendants' enablement and written description defenses (which do not require an amendment to invalidity contentions). Thus, the system is already at issue in the case. This means that any additional burden of analyzing the system as prior art is less significant.

Fourth, the amendment does not necessitate a continuance. This case is still in relatively early stages. As described above, Defendants served both its draft claim chart (public information) and amended invalidity contentions (private information) about the Adaptive Optical Engine before claim construction briefing began, and the *Markman* Hearing will not take place until November 8, 2023. Plaintiff has yet to take any fact depositions, fact discovery does not close until November 29, 2023, and expert discovery does not close until January 22, 2024. Jury selection is not set to begin until May 6, 2024.

II. FACTUAL BACKGROUND

Defendants served their original Invalidity Contentions on February 2, 2023. M. Squire Decl., Oct. 12, 2023 (attached as Ex. A), at ¶ 2. Defendants began investigating and searching for relevant prior art at the outset of this case, researching and conducting a sweep of searches, and engaging multiple search firms and consultants, to uncover prior art relevant to the asserted claims of the M-Ary Patents. *Id.* at ¶ 3. Defendants' efforts involved extensive searches of publicly

available information for relevant prior art patents and publications as well as systems and product prior art. *Id*. As a result, Defendants' original Invalidity Contentions identified numerous prior art patents and publications. *Id*. None of Defendants' extensive prior art search efforts, however, resulted in the discovery of the Adaptive Optical Engine prior art before the deadline for serving invalidity contentions. *Id*.

On June 9, Defendant Infinera learned of the existence of the Adaptive Optical Engine prior art product based on a discussion with an individual who had been active in the field and knew of Nortel's product launch some 15 years ago. *Id.* at ¶ 4. Following that discussion, and over the next six weeks, Defendants' litigation counsel conducted research and investigation of publicly available information relating to the Adaptive Optical Engine product, the relationship of the product to NextGen's infringement allegations, and charted the available information against a representative claim of the M-Ary Patents. *Id.* at ¶ 5. While Defendants could not find public information necessary to chart many of the claim elements against the product's internal workings, Defendants believed that — because of the Adaptive Optical Engine's general similarity with the accused products — the product could be invalidating art, at least under Plaintiff's infringement theories. *Id.*

Relying on "information and belief," Defendants provided an invalidity claim chart to NextGen on August 1, 2023 that provided NextGen with all of the information known to Defendants, and produced copies of all of the publicly available documents they had discovered. *Id.* at ¶ 6; Ex. 1. Defendants likewise notified NextGen that it would be seeking the confidential details of the Adaptive Optical Engine from a third party, Ciena. Squire Decl. ¶ 6. Defendants marshalled the critical details to assist Ciena in locating the records of an acquired company (Nortel) for sales and product details from nearly fifteen years earlier, necessarily tracing back

through Ciena's acquisition of the pertinent business line from Nortel. *Id.* at ¶ 7. AT&T served a formal subpoena on August 24, 2023, and provided notice to all parties. *Id.*; Ex.2.

By September 21, non-party Ciena found, collected, reviewed, and produced confidential technical documents under the Court's Protective Order that detailed the technical specifications, components, and operation of the Adaptive Optical Engine product. Squire Decl. ¶ 8; Ex. 3. The next day, AT&T reproduced Ciena's production to NextGen and the remaining Defendants. Squire Decl. ¶ 9; Ex. 4. On September 26, 2023, three business days after receiving Ciena's confidential documents, Defendants served NextGen with its Amended and Supplemental Invalidity Contentions, consisting of three sets of invalidity claim charts showing the invalidity of all of the asserted claims of the M-Ary Patents, at least under NextGen's apparent infringement theories. Squire Decl. ¶ 10; Ex. 5. On October 2, 2023 the parties met and conferred (Ex. 6) and Defendants now bring this motion. Squire Decl. ¶ 11.

III. LEGAL STANDARD

Under Local Patent Rule 3-6(b), amendment of invalidity contentions "may be made only by order of the Court, which shall be entered only upon a showing of good cause." When determining whether a party has shown good cause to amend its invalidity contentions under P.R. 3-6(b), the court must consider the following factors: (1) the explanation for the party's failure to meet the deadline, (2) the importance of what the Court is excluding, (3) the potential prejudice if the Court allows that thing that would be excluded, and (4) the availability of a continuance to cure such prejudice. *Team Worldwide Corp. v. Wal-Mart Stores, Inc.*, No. 2:17-cv-00235-JRG, 2018 U.S. Dist. LEXIS 122748, at *8 (E.D. Tex. July 23, 2018); *see also S&W Enters., LLC v. SouthTrust Bank of Ala., NA*, 315 F.3d 533, 536 (5th Cir. 2003). Courts exercise discretion in balancing these factors. *Team Worldwide*, 2018 U.S. Dist. LEXIS 122748, at *8-20 (balancing factors in granting leave to amend invalidity contentions).

IV. ARGUMENT

All four factors support Defendants' motion, as discussed below.

A. Defendants Were Diligent in Searching for and Disclosing the Adaptive Optical Engine Prior Art

Defendants were diligent in searching for prior art, and after discovering the Adaptive Optical Engine prior art, immediately disclosing it to NextGen. Defendants' diligence supports a finding of good cause. *See Uniloc 2017, LLC v. Google LLC*, No. 2:18-cv-00497-JDG-RSP, Dkt. No. 98, at 3 (E.D. Tex. Oct. 9, 2019) (granting motion for leave to amend invalidity contentions where defendant showed that it "exercised diligence in discovering the prior art"); *Seven Networks, LLC v. Google LLC*, No. 2:17-cv-00442-JRG, 2018 U.S. Dist. LEXIS 112210, at *8 (E.D. Tex. July 6, 2018) (finding "relative speed with which [Defendant] passed along the [new prior art] to [Plaintiff] once it was received" demonstrated diligence).

Defendants were diligent is searching for prior art both before and after the February 2023 deadline to serve their original Invalidity Contentions. Since early in the case, Defendants conducted prior art searches of publicly available information and engaged several prior art search firms and consulting experts to search for prior art.

Defendants' discovery of the Adaptive Optical Engine prior art later in the case was excusable because of the lack of public technical detail concerning a prior art product sold nearly fifteen years ago. *Tech. Pharmacy Serv. v. Alixa Rx LLC*, No. 4:15-cv-00766-ALM, 2017 U.S. Dist. LEXIS 164789, at *13 (E.D. Tex. Jan. 18, 2017) ("The Court . . . appreciates the difficulty of discovering all relevant prior art and supplemental materials."). Adaptive Optical Engine was a product sold by Nortel in the late 2000s. Unlike patents and technical publications, information regarding prior art products can be difficult to find. Delay in identifying and recognizing relevant prior art products can be difficult even by a party conducting a proper investigation. *Hearing*

Components, Inc. v. Shure, Inc., No. 9:07-cv-00104-RC, 2008 WL 11348009, at *2 (E.D. Tex. June 5, 2008) (finding delayed discovery of prior art "can be expected when a party conducts a proper investigation into the merits of its potential defenses"). Although Defendants did not find the Adaptive Optical Engine prior art before the original Invalidity Contentions deadline, Defendants continued their diligent efforts working to discover that product as part of their ongoing investigation and search concerning the validity of the asserted patents under the breadth of NextGen's infringement allegations.

After discovering the Adaptive Optical Engine prior art in June and investigating and analyzing the product against the asserted claims of the M-Ary Patents through July, Defendants immediately notified NextGen, continued its investigation, and sought critical confidential details from third party, Ciena. *UltimatePointer, LLC v. Nintendo Co.*, No. 6:11-cv-00496-JRG, 2013 U.S. Dist. LEXIS 200122, at *18 (E.D. Tex. May 28, 2013) (finding diligence where "Defendants discovered the importance of the additional prior-art references after further investigation and cooperation by a third party."). To avoid any claim of prejudice and delay, Defendants served NextGen with the documents it had uncovered and an invalidity claim chart for the prior art, and informed NextGen that they were seeking additional information from non-party Ciena. After Defendants received Ciena's key confidential technical documents on September 21, 2023, Defendants quickly analyzed the operation and functionality of the Adaptive Optical Engine prior art and prepared claim charts. Within three business days, on September 26, Defendants served NextGen with detailed amended invalidity claim charts for the Adaptive Optical Engine prior art, subject to leave of Court, which Defendants submit show the invalidity of all of the asserted claims of the M-Ary Patents. Defendants met and conferred with Plaintiff on October 2, and now bring the instant motion for leave of Court to permit the amendment served on September 26.

Because Defendants were diligent in searching for and analyzing the confidential details of this prior art and in notifying NextGen of the discovery of the Adaptive Optical Engine prior art, this factor weighs in favor of granting Defendants leave to amend their Invalidity Contentions.

B. The Adaptive Optical Engine Prior Art Is Important to Defendants' Case

Defendants' proposed amendments are particularly important to this case for several reasons.

First, Defendants contend the Adaptive Optical Engine prior art invalidates all of the asserted claims of the asserted M-Ary Patents. Ex. 5. This factor strongly supports a finding that good cause exists to allow the amendments. *See Alcatel USA Sourcing, Inc. v. Microsoft Corp.*, No. 6:06-cv-00500-LED, 2008 U.S. Dist. LEXIS 125201, at *9 (E.D. Tex. Oct. 3, 2008) ("Prior art references potentially rendering a patent invalid are important.").

Second, the fact that this prior art is a system (unlike a prior art patent, for example), brings it to life for a fact finder. *ACQIS LLC v. Appro Int'l, Inc.*, No. 6:09-cv-00148-LED, 2011 U.S. Dist. LEXIS 163729, at *6 (E.D. Tex. Jan. 20, 2011) ("[T]he RLX System 324 itself is still important prior art. It is a tangible system for the jury to consider . . .").

Third, the Adaptive Optical Engine is important because it has the same or similar subcomponents to products accused of infringement in the instant case. More specifically, the Adaptive Optical Engine is a so-called "coherent" optical transceiver using "dual-polarized Quadrature Phase Shift Keying" (DP-QPSK). In this lawsuit, Plaintiff asserts that DP-QPSK coherent products infringe the M-Ary patents. Thus, the Adaptive Optical Engine poses an important limitation on NextGen's ability to unfairly assert the M-Ary patents. *01 Communique Lab., Inc. v. Citrix Sys.*, 889 F.3d 735, 742-43 (Fed. Cir. 2018) ("[W]hen an accused product and the prior art are closely aligned, it takes exceptional linguistic dexterity to simultaneously establish infringement and evade invalidity."). If NextGen broadly interprets its claim terms to read on the

subcomponents of Defendants' accused DP-QPSK coherent transceivers, then it is important, even critical, that Defendants be able to show how that same broad interpretation reads on the subcomponents of the 2008 Adaptive Optical Engine DP-QPSK coherent transceiver. *Id.* at 741-43.

Fourth, the Adaptive Optical Engine is important prior art evidence related to a priority dispute for Plaintiff's patents, amplified by NextGen's infringement allegations against coherent optical transceivers. NextGen asserts priority back to 2003, but there was a continuation-in-part application filed in 2009 that added important new matter. Ex. 9 (U.S. Patent 9,337,948, filed Jul. 30, 2009), at 9:61-67; Ex. 7 (Redline comparison of specifications filed in 2009 versus priority date), at 2-4, 11; Ex. 8 ('795 Patent) at 1. As explained above, the Adaptive Optical Engine is a coherent optical transceiver using DP-QPSK modulation. The year after the Adaptive Optical Engine launched, the applicants of the M-Ary patents filed their continuation-in-part application, amending the specification to newly reference "DP-QPSK" and newly asserting that the invention's "m-ary modulation communication methods" included "coherent modulation techniques." Ex. 9 at 9:61-67; Ex. 7 at 2-4, and 11. The word "coherent" did not appear in the 2004 application, but in this lawsuit, Plaintiff asserts that DP-QPSK coherent products infringe the "m-ary" modulation patents. As a DP-QPSK coherent product that launched prior to applicant's amendment to their specification, the Adaptive Optical Engine is uniquely important among Defendants' references.

Fifth, the Adaptive Optical Engine is already important to the case, because Defendants intend to use the facts of the product launch to support its enablement and written description defenses (an issue not subject to this motion). More specifically, the M-Ary patents have no disclosure to support Plaintiff's asserted claim scope that the claims capture "coherent modulation"

in a miniaturized "pluggable" form. The claim requirement of a "pluggable" form was key to the granting of the M-ary patents. Ex. 10 (Excerpt of File History of '723 Patent), at 2 ("[T]he prior art fails to teach each of the recited elements of claim 1 within a unitary pluggable optical transceiver with a priority date before 2003."). The fact that coherent systems small enough for a line card, much less miniaturized to a smaller "pluggable" form, did not appear until Nortel's launch in 2008 evidences that the specification (which offers no technical details about how a coherent system would work, much less how to miniaturize it to fit on a pluggable) lacks enablement and written description support. *See Intel Corp. v. Tela Innovations, Inc.*, No. 3:18-cv-02848-WHO, 2020 U.S. Dist. LEXIS 241022, at *30 (N.D. Cal. Dec. 22, 2020) (granting summary judgment of invalidity for lack of enablement and written description where miniature form claimed was not possible for years after the priority date); *see also Amgen Inc. v. Sanofi*, 143 S. Ct. 1243, 1255 (May 18, 2023) (holding claims not enabled where specification required unreasonable experimentation in view of the state of "the underlying art.").[3] In contrast to the challenges faced by the industry as evidenced by the Adaptive Optical Engine in 2008, the priority specification for the M-Ary patents filed years earlier simply states "circuitry of transceivers 100, 101, or portions thereof, . . . , can be combined within industry standard optical modules. Common optical module standards are [listing standards, including some pluggable]." Ex. 11, at 10:36-41.

Thus, standing apart from other prior art in Defendants' invalidity contentions, the Adaptive Optical Engine is system art that was one of the first commercially launched coherent

[3] Indeed, according to Ciena documents produced to NextGen on August 1, a key part of the coherent "puzzle" was miniaturizing the "analog-to-digital converter" or "ADC." Ex. 12, at 5. "[T]he team needed to shrink the analog-to-digital converter (ADC) so that it could be embedded into a custom chip (an ASIC) that could fit on an optical line card." *Id.* "Nobody knew if we could miniaturize the ADC that could provide that kind of performance and power efficiency." *Id.* "It required a completely new type of chip that had really never even been considered." *Id.*

products. This demonstrates that while the "goal" of miniaturization was known and obvious to a POSA, it is not at all surprising that the Patent Office would not find prior art in 2003 disclosing and claiming such devices for the type of coherent transceivers accused in this case. It will be important for Defendants to present that theory, while corroborating Defendants' enablement and written description defenses with the facts of the Adaptive Optical Engine. Although NextGen will no doubt have its own view on these events, the system raises important issues that Defendants cannot present in the same way using other references.

C. Defendants' Proposed Amendments Will Not Prejudice NextGen

NextGen will not suffer any prejudice from Defendants' proposed amendments because Defendants gave NextGen advance notice of the Adaptive Optical Engine prior art, and even now, this case is in the early stages.

First, Defendants informed NextGen of the newly discovered prior art by providing publicly available documents and an invalidity claim chart in their disclosure on August 1, 2023, within weeks after investigating the Adaptive Optical Engine prior art and its relevance to the M-Ary Patents and this case. *Gen. Access Sols. v. Sprint Spectrum L.P.*, No. 2:20-CV-00007-RWS, 2020 U.S. Dist. LEXIS 259998, at *16-17 (E.D. Tex. Dec. 1, 2020) ("[T]he Court is at pains to see what prejudice General Access might suffer. General Access has possessed the proposed amended contentions for more than a month and will have several additional weeks to examine them before submitting its rebuttal expert report.").

The August 1 notice also informed NextGen that Defendants believed the Adaptive Optical Engine, and the documents Defendants produced concurrently, would be important corroborating documents for their enablement and written description defenses (previously presented). Thus, the Adaptive Optical Engine would still be at issue in the case for that purpose, even absent the confidential details necessary to use the product as prior art. In other words, regardless of this

motion (directed to prior art invalidity), Plaintiff has been in possession of the documents and was on notice since August 1 of the Adaptive Optical Engine, providing factual support for its previously disclosed enablement and written description defenses at a minimum. As the product will be in the case for at least that purpose, any prejudice from including the same product for prior art purposes is marginal at best – particularly compared to the unique nature and importance of this art.

Within three business days after receiving Ciena's confidential documents describing the technical specifications, components, and operation of the Adaptive Optical Engine prior art, Defendants served NextGen detailed invalidity claim charts addressing all of the asserted claims of the M-Ary Patents. Defendants did so shortly before opening claim construction briefing, six weeks before the *Markman* Hearing, nine weeks before the close of fact discovery, four months before the close of expert discovery, and before NextGen deposed any defense or third-party witnesses.[4] Defendants are seeking supplemental claim construction briefing in connection with NextGen's Patent Owner's statements in corresponding IPRs (*see* Dkt. 180), and that same process is available to Plaintiff if there are claim construction issues Plaintiff believes this amendment raises. Moreover, Defendants provided *notice* of its intent to amend its contentions, with a provisional claim chart, two months before opening claim construction briefs were due, three months before the *Markman* Hearing, four months before the close of fact discovery, and before NextGen deposed any defense or third-party witnesses. This weighs in favor of Defendants. *See Computer Acceleration Corp. v. Microsoft Corp.*, 481 F. Supp. 2d 620, 626 (E.D. Tex. 2007) (finding potential prejudice "not great" where plaintiff was made aware of defendant's intent to

[4] The parties received the same confidential documents from Ciena at the same time. NextGen has had and will have the same opportunity as Defendants to evaluate those documents and to conduct further discovery of the Adaptive Optical Engine prior art at any upcoming depositions.

amend invalidity contentions two and a half months before the claim construction hearing, four months before the close of discovery, and before plaintiff deposed any defense witnesses); *E-Watch Inc. v. Apple Inc.*, No. 2:13-cv-01061-JRG-RSP, Dkt. No. 230, at 3 (E.D. Tex. Dec. 5, 2014) (finding "no substantial prejudice" in granting pre-Markman amendment of invalidity contentions); *Tyco Healthcare Grp. LP v. E-Z-EM, Inc.*, No. 2:07-cv-00262-TJW, 2010 U.S. Dist. LEXIS 143971, at *6 (E.D. Tex. Apr. 1, 2010) (granting leave to amend invalidity contentions sought six months before trial).

Second, there is no undue prejudice to NextGen because Defendants seek to amend their Invalidity Contentions to add only one piece of system prior art. Given the broad array of products that Plaintiff accuses of infringement, the prejudice of the extra reference is minimal. *UltimatePointer, LLC v. Nintendo Co.*, No. 6:11-cv-00496-JRG, 2013 U.S. Dist. LEXIS 200122, at *18 (E.D. Tex. May 28, 2013) ("Although Plaintiff complains of being prejudiced by the number of prior art references, given the breadth of products accused by Plaintiff of infringement, the prejudice to plaintiff is minimal.").

Third, as explained above, separate from the issue of prior art invalidity at issue in this motion, the Adaptive Optical Engine provides important evidence supporting Defendants' enablement and written description defenses. Thus, the Adaptive Optical Engine is at issue in the case at least for that purpose. This means that the additional burden of including the system as prior art is less significant.

D. NextGen Does Not Need a Continuance

Because this case is in its early stages and Defendants disclosed the Adaptive Optical Engine prior art on August 1, months before opening claim construction briefing, no prejudice exists and no continuance is necessary. Plaintiff has never changed its claim construction positions in view of this prior art, nor come forward with a specific term or construction to that effect. Jury

selection is set for May 2024, and the Court has not yet held its *Markman* Hearing. Fact discovery does not close until the end of November 2023. There is no need for a continuance.

Moreover, even if there were some prejudice to NextGen as result of Defendants' proposed amendment (there is not), any prejudice could be cured by a modest accommodation in the discovery schedule, if needed. *See Sybase, Inc. v. Vertica Sys., Inc.*, No. 6:08-cv-00024-LED, 2009 U.S. Dist. LEXIS 110775, at *7 (E.D. Tex. Nov. 30, 2009) (stating "potential prejudice can easily be cured with an appropriate continuance of the discovery deadline if needed").

This factor therefore weighs in favor of granting Defendants leave to amend.

V. CONCLUSION

For the foregoing reasons, Defendants submit that good cause exists and respectfully request that the Court grant Defendants leave to amend their Invalidity Contentions to include the Adaptive Optical Engine prior art.

Dated: October 12, 2023

Respectfully submitted,

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CERTIFICATE OF CONFERENCE

I hereby certify that counsel for Defendants have met and conferred with counsel for Plaintiff regarding the relief sought in this Motion on October 2, 2023. Counsel for Plaintiff indicated that Plaintiff is opposed to the relief sought in this Motion.

By: */s/ Melissa R. Smith*
Melissa R. Smith

CERTIFICATE OF SERVICE

I hereby certify that on October 12, 2023, a true and correct copy of the above and foregoing document has been served on counsel of record *via* the Court's CM/ECF system pursuant to Local Rule CV-5(a)(3).

By: */s/ Melissa R. Smith*
Melissa R. Smith