

02/05/2025	93	ORAL ORDER re 69 Joint MOTION for Teleconference to Resolve Discovery Dispute. Having reviewed the parties' discovery dispute letter submissions (D.I. 89; D.I. 90; D.I. 91; D.I. 92), IT IS ORDERED that: (1) Defendant's motion to compel Plaintiffs to supplement their infringement contentions for the '741 patent is DENIED without prejudice. Defendant does not suggest it is not on notice of Plaintiffs' infringement theories. Instead, Defendant challenges the factual accuracy of Plaintiffs' infringement contentions. The disputed issues of fact and/or claim construction are not the proper subject of a discovery dispute. (2) Defendant's motion to compel Plaintiffs to supplement their response to Interrogatory No. 3 by providing element-by-element claim charts for each marked product is DENIED without prejudice. Interrogatory No. 3 seeks information on Plaintiffs' position under the patent marking statute at 35 U.S.C. 287, which governs a party's failure to mark patented articles. (D.I. 90, Ex. 3 at 9); 35 U.S.C. 287. Here, Defendant acknowledges that Plaintiffs' products are marked but contends that those products do not satisfy every element of the asserted claims of the patents with which they are marked. (D.I. 90 at 4) To the extent that Defendant alleges Plaintiffs failed to identify a sufficient association between their marked products and the patents with which those products were marked, this is governed by the separate false marking statute. 35 U.S.C. 292; <i>see Seoul Semiconductor Co., Ltd. v. Finelite, Inc.</i>, 2023 WL 7107259, at *3 (N.D. Cal. Aug. 16, 2023) ("If Plaintiffs have over-marked their products, that may relate to false marking, a different statute."). (3) Defendant's request that the court overrule Plaintiffs' compound objections and counting of Interrogatory Nos. 1 to 3 is DENIED without prejudice. Plaintiffs have substantively responded to Interrogatory Nos. 1 to 3 and Defendant raises no issues with the substance of Plaintiffs' responses. (D.I. 90, Ex. 4 at 3-6) Arguments based solely on the number of interrogatories are not properly raised with the court unless the number of interrogatories served will impact the substance and sufficiency of the discovery response itself. Otherwise, this dispute should be resolved between the parties without court intervention. (4) Defendant's motion to compel Plaintiffs to produce three samples of every "marked product" under any Asserted Patent that has been listed on Plaintiffs' virtual patent marking website is DENIED without prejudice based on Plaintiffs' representation that it produced the requested documents and samples, rendering the issue moot. (D.I. 92, Exs. 7-8) (5) Plaintiffs' motion to compel Defendant to supplement its invalidity contentions is DENIED without prejudice. Plaintiffs identify as deficient Defendant's charts for two elements out of nearly 900, arguing that Defendant should have used highlighting or arrows to identify the elements. (D.I. 89 at 2-3) But Plaintiffs do not expressly state this lack of indicators on two discrete claim elements renders them unable to understand the contentions, nor do they indicate that these specific issues were vetted through the meet and confer process. Plaintiffs' issue with Defendant's contentions is distinguishable from Plaintiffs' cited authority in <i>Integra LifeSciences Corp. v. HyperBranch Medical Technology, Inc.</i>, where the contentions did not "provide any hint as to which references may render the claims anticipated versus which references may render the claims obvious." 223 F. Supp. 3d 202, 205 (D. Del. 2016) (acknowledging that "Defendant need not provide a detailed description for each such limitation, given that these are initial contentions with a significant number of claims... at issue"). Defendant's initial invalidity contentions, which include more than 1,400 pages of claim charts, are sufficient to serve their purpose of providing Plaintiffs with reasonable notice of how the prior art references meet the claim limitations of the asserted patents. (D.I. 91, Exs. 11-12); <i>see Wi-Lan Inc. v. Vizio, Inc.</i>, C.A. No. 15-788-LPS, 2018 WL 669730, at *1 (D. Del. Jan. 26, 2018) (holding that contentions should provide notice of the proponent's theories and need not prove the case). Defendant's contentions will be further developed and refined as the case proceeds through discovery, claim construction, and expert reports, but at this stage, Defendant is not required to prove its invalidity theories. <i>Id.</i> (6) Plaintiffs' motion to compel Defendant to supplement its response to Interrogatory No. 20 to provide a narrative factual basis and evidence of non-infringement is DENIED without prejudice to renew following the issuance of a final decision on claim construction. Defendant responded to the contention interrogatory with a 10-page list of 198 claim terms that are allegedly not satisfied by the accused products, but it did not include a narrative response or citations to evidence in support. (D.I. 89 at 4) Plaintiffs do not dispute Defendant's position that a further response to Interrogatory No. 20 would turn on disputed issues of claim construction. Courts have held that a contention interrogatory may be premature if it implicates issues of claim construction before the terms have been construed. <i>See ROY-G-BIV Corp. v. Famuc Ltd.</i>, 2008 WL 11346476, at *6 (E.D. Tex. July 15, 2008) (citing <i>Jacobs Chuck Mfg. Co. v. Shandong Weida Mach.</i>, C.A. No. 2:05-185, D.I. 93 at 2 (E.D. Tex. Aug. 18, 2006)). IT IS FURTHER ORDERED that the discovery dispute teleconference set for February 6, 2025 at 2:00 p.m. is CANCELLED. Signed by Judge Sherry R. Fallon on 2/5/2025. (Polito, Rebecca) (Entered: 02/05/2025)
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