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UNITED STATES DISTRICT COURT

DISTRICT OF ARIZONA

Champion Power Equipment, Inc., Plaintiff, v. Firman Power Equipment Inc., Defendant.	No. CV-23-02371-PHX-DWL **FIRMAN'S MOTION FOR LEAVE TO AMEND DATE IN INVALIDITY CONTENTIONS APPENDIX**

Defendant Firman Power Equipment Inc. ("Firman") submits this Motion requesting leave to amend a single date in Appendix C to Firman's Invalidity Contentions ("Appendix C").

I. INTRODUCTION

Firman seeks leave to amend one date in Appendix C based on newly discovered materials revealing a nonparty's offer to sell an already-disclosed prior art device that occurred two months before the priority date currently listed in Appendix C. Consistent

with Firman's disclosure obligations under Federal Rule of Procedure 26(e), the proposed amendment (as shown below) merely serves as an update to accurately reflect a newly discovered fact from the nonparty, despite a prior diligent search by Firman.

APPENDIX C

Short Name	Item Offered for Sale or Publicly Used/Known	Date of Offer, Sale, or Public Use/Knowledge	Identity of Relevant Entity/Person	Beginning BATES
ECO8990E with Kit	Firman ECO8990E Device with Kit	10/31/2013	Firman	N/A
Kubota Engine	Kubota DF972-E20KEA-1 Device	8/6/2009	Kubota	FIRMAN_00007495 SCAG_00000076 SCAG_00000075
RD9000E	Firman RD9000E Device	~~5/7/2015~~ 3/11/2015	Firman	FIRMAN_00007710 FIRMAN_00007713 FIRMAN_00007773 HARRIS_00000078
Winco HPS12000HE with Kit	Winco HPS12000HE Device with Kit	9/11/2013	Winco	N/A
Champion 100153	Champion 100153 Device	5/2/2015	Champion Global Power Equipment	N/A
Champion 71532	Champion 71532 Device	2/2/2014	Champion	N/A
Champion 71530	Champion 71530 Device	4/26/2014	Champion	N/A
Champion 71531	Champion 71531 Device	5/31/2014	Champion	N/A
Champion 76533	Champion 76533 Device	7/28/2014	Champion	N/A
Champion 76555	Champion 76555 Device	12/21/2014	Champion	N/A
Champion 100122	Champion 100122 Device	1/28/2015	Champion	N/A

Notwithstanding the discrete and narrow nature of the proposed amendment as well as the absence of any prejudice to Champion, Champion opposes this request.

II. STATEMENT OF FACTS

On November 10, 2023, Champion filed suit against Firman, alleging patent infringement. (Doc. 1.) To prove that Champion's patents are invalid, Firman made a diligent search for prior art—involving independent searching conducted separately by an industry expert, a leading intellectual property services firm, and in-house patent attorneys and patent agents—that culminated in Invalidity Contentions covering over 100 prior art references and over 5,000 pages of detailed claim charts. (Doc. 124 at 1-2, 8.) As the Court observed, if that level of effort "is insufficient to establish diligence, it is hard to understand what could possibly qualify." (*Id.* at 8.)

Firman's Invalidity Contentions explained why the RD9000E generator, among many other prior art references, invalidates many of Champion's patents. (*See, e.g.*, Doc.

116-1 at 7.) But the RD9000E generator is not new to Champion. Indeed, Champion has known about the RD9000E generator for a decade, since Champion's CTO Mark Sarder saw the RD9000E on display at the National Hardware Show in May 2015 ("NHS 2015"). (Doc. 109 at 2.) Since September 6, 2024, Firman has sought—through Interrogatory No. 12—written discovery on Champion's contention that the RD9000E generator is not prior art invalidating Champion's patents. (Docs. 81, 109, 139.) On January 14, 2025, the Court denied Firman's first request to compel Champion to substantively respond to this interrogatory because the Court found the production of a physical RD9000E dispositive. (Doc. 111 at 2-3.)

In light of the Court's ruling, Firman attempted to locate an RD9000E unit with a production date predating Champion's patents to satisfy that condition precedent. Among other efforts, Firman contacted Brett Harris of Norlite Inc., a company that manages Firman generator sales and inventory in Canada, to expand the RD9000E search to Canadian warehouses. (Byer Decl. ¶ 9a.) Mr. Harris revealed his possession of relevant and responsive documents concerning the RD9000E. (*Id.* ¶ 9b.) Firman collected these documents from Mr. Harris and promptly produced them on February 28, 2025. (*Id.* & Ex. B.) The documents included an email Mr. Harris had sent on March 11, 2015, to Lowe's Canada offering to sell the RD9000E.[1] (*Id.*, Ex. E.)

Also on February 28, 2025, consistent with Firman's obligations under Rule 26(e), Firman supplemented its interrogatory responses to account for this new information and also served a proposed amended Appendix C to reflect the March 2015 date. (*Id.*, Exs. A & C.) Firman explained that the only proposed amendment to Appendix C "reflect[s] an updated priority date for the RD9000E, in line with the discovery responses we served."

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[1] At the time Mr. Harris made the offer to sell to Lowe's Canada in March 2015, Firman's predecessor, Sumecht NA Inc., oversaw the Firman-branded generator business in North America. (Byer Decl. Ex. G.) In or around July 2015, Sumecht NA transferred the Firman-branded generator business to Firman. (*Id.*)

(*Id.*, Ex. C.) The amendment changes "5/7/2015" to "3/11/2015" and identifies the newly discovered supporting document from Mr. Harris. (*Id.*)

Firman asked Champion to provide its position on Firman's request for leave to make this amendment. (*Id.*) Champion did not respond for almost a week. (*Id.*, Ex. D at 5.) Only after further follow-up from Firman did Champion respond asking for Firman to explain its good cause basis for the amendment. (*Id.* at 4.) On March 7, 2025, Firman responded explaining that, on February 7, 2025, Mr. Harris, a nonparty, located evidence establishing an offer to sell the RD9000E to Lowe's Canada in March 2015. (*Id.* at 2-3.) Champion went silent again. On March 18, 2025, Firman again raised the question of whether Champion would agree to the amendment. (*Id.* at 2.) Champion refused without any explanation. (*Id.* at 1.)

Firman met and conferred with Champion on March 21, 2025, hoping to moot the dispute over amending a single date by two months. (Byer Decl. ¶ 10.) Champion, however, indicated it would oppose the amendment. (*Id.*) Firman suggested filing a joint discovery statement to present the dispute efficiently and cost-effectively to the Court, but Champion indicated that a full motion is needed and that it would object to the use of a joint discovery statement. (*Id.*) Champion maintained its opposition even after Firman again raised the possibility of stipulation in light of the Court's denial of Champion's recent motion for reconsideration. (*Id.* ¶ 11; Doc. 141.) Champion's opposition to the amendment and use of the joint discovery statement mechanism necessitated this Motion.

III. ARGUMENT

Firman may amend its invalidity contentions upon a "timely showing of good cause." (Doc. 33 ¶ 5(C).) As the Court recently explained, "[t]he good cause inquiry is two-fold, asking: (1) whether the moving party was diligent in amending its contentions; and (2) whether the non-moving party would suffer prejudice if the motion to amend were granted." (Doc. 124 at 5.) "The diligence required for a showing of good cause has two subparts: (1) diligence in discovering the basis for amendment; and (2) diligence in seeking amendment once the basis for amendment has been discovered." (*Id.* at 7-8 n.2

(citation omitted).) "Prejudice is typically found when amending contentions stand to disrupt the case schedule or other court orders." (*Id.* at 5 (citation omitted).) Here, Firman satisfies both subparts of the diligence inquiry, and the amendment would not cause Champion any prejudice.

A. Newly Discovered Materials from a Non-Party Supports Good Cause for the Proposed Amendment.

If "recent discovery of material, prior art despite earlier diligent search" supports good cause to add new prior art references, (Doc. 33 ¶ 5(C)), Firman's recent discovery of nonparty documents supporting an earlier priority date for an ***already-disclosed prior art reference*** more than clears the good cause requirement.

Champion's sole basis for opposing the amendment rests on the unsupported assertion that Firman should have disclosed the March 2015 date earlier. But there is no dispute that Firman was not on the emails with Lowe's Canada. (Byer Decl., Ex. E.) Indeed, Champion offers no explanation for how Firman could know about an offer to sell that predates even Firman's corporate existence. (*See supra* at 3 n.1; Byer Decl., Ex. F.) Firman's predecessor handling the Firman-branded generator business in March 2015 confirmed recently in response to Champion's subpoena that it does not possess any documents concerning any Firman-branded generators. (Byer Decl., Ex. G.) Given the absence of any documents in Firman's or even Firman's predecessor's possession, it is unclear how Firman could have known that, more than a decade ago, a nonparty made an offer to sell that preceded Firman's own offers to sell. Discovery of the March 2015 offer to sell after expanding Firman's search for an RD9000E to Canadian warehouses supports a showing of diligence.

B. Firman Brings a Timely Request.

The second prong of the diligence test looks for any undue delay "in seeking amendment once the basis for [the] amendment has been discovered." *Positive Techs., Inc. v. Sony Elecs., Inc.*, 2013 WL 322556, at *2 (N.D. Cal. Jan. 28, 2013). Champion did not contest this prong in the parties' discussions. In any event, the Motion is timely.

Within two weeks of locating the documents supporting the March 2015 date, Firman produced the documents, supplemented its written discovery, and notified Champion of its intent to amend Appendix C. (*See supra* § II.) Within two weeks of Champion confirming it would oppose amendment and the parties' unsuccessful mediation, Firman filed this Motion. (Byer Decl. ¶ 10; Doc. 147.) Firman's immediate action each step of the way demonstrates its timeliness. *See Illumina Inc. v. BGI Genomics Co.*, 2021 WL 1022865, at *4 (N.D. Cal. Mar. 17, 2021) (two-month delay in filing motion was timely when defendant notified plaintiff of its intent to amend its invalidity contentions "a few weeks after discovering the reference. . . . [and] much of the delay in moving for leave was due to the parties' good faith effort to meet and confer on the issue"); *Karl Storz Endoscopy-Am., Inc. v. Stryker Corp.*, 2016 WL 2855260, at **6-7 (N.D. Cal. May 13, 2016) (two-month delay in notifying opposing counsel and "four-plus months" delay in filing motion was timely); *Positive Techs.*, 2013 WL 322556, at *3 (two-month delay in notifying opposing counsel of intent to seek leave and four-month delay in filing motion was timely).

C. Champion Will Not Suffer Any Prejudice.

The proposed amendment merely updates—by two months—the priority date of the RD9000E, a prior art reference that Champion has known since before this lawsuit. The amendment neither introduces new prior art nor new theories of invalidity. Nor does the amendment disrupt the governing case schedule or any other court orders. (*See* Doc. 124 at 5 ("Prejudice is typically found when amending contentions stand to disrupt the case schedule or other court orders.") (citation omitted).) Indeed, Champion has not even explained how this two-month change affects its arguments on the merits. Considering the broader goal of patent litigation to reach the right outcome on the merits, the two-month change appears to be inconsequential to Champion, given Champion's failure to identify any prejudice it would suffer if Firman were granted leave to amend. *See, e.g.*, *Halo Elecs., Inc. v. Bel Fuse Inc.*, 2010 WL 3489593, at *2 (N.D. Cal. Sept. 3, 2010)

(granting leave to amend when "amendment will advance fair resolution of the issues on the merits without serious prejudice to [opposing party]").

IV. CONCLUSION

For the reasons stated above, Firman respectfully requests the Court grant it leave to amend Appendix C to its Invalidity Contentions.

DATED this 4th day of April, 2025.

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