IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

VERVAIN, LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 1:24-cv-00259-ADA
	)	
PHISON ELECTRONICS CORPORATION,	)	
	)	Jury Trial Demanded
Defendant.	)	
	)	
	)	

DEFENDANT PHISON ELECTRONICS CORPORATION'S UNOPPOSED MOTION FOR LEAVE TO AMEND FINAL INVALIDITY CONTENTIONS

Defendant Phison Electronics Corporation ("Phison") respectfully moves the Court for leave to amend its Final Invalidity Contentions to include defenses under 35 U.S.C. §§ 102(a) and 102(b). Defendant seeks this amendment based on Plaintiff Vervain, LLC's ("Vervain") Final Infringement Contentions, served on February 28, 2025, which accused Phison products that were sold in the United States more than one year before the critical date of July 19, 2011, of infringement, and based on information revealed during discovery. Good cause supports this motion because fact discovery remains ongoing, and the proposed amendments relate directly to recently disclosed information bearing on the validity of Plaintiff's patents-in-suit. On March 26, 2025, Defendant notified Plaintiff regarding amendment of its Final Invalidity Contentions, and Plaintiff confirmed that it does not oppose the motion requested herein. Defendant provided Plaintiff with a draft version of the amended contentions on March 26, 2025. Attached as sealed Exhibits A1-A19 is a copy of Defendant's proposed Amended Final Invalidity Contentions and

accompanying attachments, which corresponds to the draft provided to Plaintiff.[1]

I. FACTUAL BACKGROUND

Fact discovery opened on December 9, 2024, and closes on July 7, 2025. ECF No. 16. The Scheduling Order initially set the deadline for Final Infringement and Invalidity Contentions as January 31, 2025. *Id*. The parties filed a joint notice extending the deadline by one month to February 28, 2025. ECF No. 53.

On December 9, 2024, Vervain served its First Set of Interrogatories on Phison, including Interrogatory No. 3, which requested: "[f]rom January 1, 2017, to the present, separately identify all of Your instrumentalities…that implement one or more Accused Features…in table format: (a) Product Name…and (i) Date Last Sold/Offered for Sale, to the extent applicable." Chin Decl. Ex. A at 9. Interrogatory No. 3 sought information regarding hundreds of Phison products spanning multiple years of sales data.

Phison diligently sought and collected information that was sufficient to answer Interrogatory No. 3 over the winter holidays, including conducting timeframe-based searches to identify its relevant products from January 1, 2017, to the present. On January 8, 2025, within the 30-day deadline required under the Federal Rules, Phison served its initial answers to Plaintiff's Interrogatories Nos. 1–19, including a response to Interrogatory No. 3, which identified [redacted]. Chin Decl. Ex. B at 19-25.

As fact discovery continued, Phison determined on or around February 12 that certain accused products may have actually been sold in the United States significantly earlier than previously understood, dating back prior to July 19, 2011.[2] The dates of first sale recited in

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[1] Only Exhibits A1 and A19 contain the new material that is the subject of this motion. Exhibits A2-A18 are included with the motion for completeness.

[2] In its infringement contentions, Plaintiff has asserted July 19, 2011 as the priority date for all asserted claims.

Phison's response to Interrogatory No. 3, however, reflected first sale dates within the period "[f]rom January 1, 2017, to the present," and not the first-ever sale dates.

As a result of this continued investigation, Phison timely served its First Amended and Supplemental Responses to Plaintiff's Interrogatories 1-19 on February 26, 2025, in which its response to Interrogatory No. 3 was amended and supplemented with a [redacted]. Chin Decl. Ex. C at 29-35. Phison's amended and supplemental response identified the PS2251-11, PS2251-60, PS2251-61, PS2251-75, PS3016 SSD-PATA, and PS3016 CTL as Phison products sold prior to July 19, 2011. *Id.* at 30-32.

Plaintiff served its Final Infringement Contentions on February 28, 2025, in which it added the PS2251-60, PS2251-61, PS2251-75, and "Phison SSD-PATA Drive products using Phison controllers, including: PS3016" to a list of Phison products, including the PS2251-11, as accused products. Chin Decl. Ex. D1 at 3-14.

On March 11, 2025, Phison supplemented its invalidity contentions in response to Interrogatory No. 9 by serving Defendant's Second Amended and Supplemental Responses to Plaintiff's Interrogatories Nos. 1–19. Chin Decl. Ex. E at 49-50. As part of its amended and supplemental response, Phison identified the PS2251-11, PS2251-60, PS2251-61, PS2251-75, PS3016 SSD-PATA, and PS3016 CTL as invalidating references under 35 U.S.C. §§ 102(a) and/or 102(b). *Id.*

On March 21, Phison also produced documents PHISON 0177891 – PHISON 0177896, [redacted]. Chin Decl. Ex. F. Subsequently, Defendant notified Plaintiff regarding amendment of its final invalidity contentions on March 26, 2025, and Vervain

confirmed that it does not oppose the motion requested herein.

II. LEGAL STANDARD

A party may amend its infringement or invalidity contentions if good cause exists and with leave of the Court. *See* Fed. R. Civ. P. 16(b)(4). To determine whether good cause exists, district courts in the Fifth Circuit apply a four-factor test: (1) the explanation for the failure to meet the deadline; (2) the importance of the amendment; (3) potential prejudice in allowing the amendment; and (4) the availability of a continuance to cure such prejudice. *See MV3 Partners LLC v. Roku, Inc., No. 6:18-CV-00308-ADA*, Dkt. No. 146 (W.D. Tex. Mar. 23, 2020) (citing *S & W Enters., L.L.C. v. Southtrust Bank of Ala., NA*, 315 F.3d 533, 536 (5th Cir. 2003)).

III. ARGUMENT

All four factors weigh in favor of granting Phison leave to amend its Final Invalidity Contentions.

A. Factor 1: Fact discovery remains ongoing, and Phison has acted diligently in conducting its investigation, having only recently learned the facts supporting its amendment.

Vervain initiated fact discovery on December 9, 2024, serving its First Set of Interrogatories, including Interrogatory No. 3, which required identification of all accused instrumentalities sold or offered for sale. Phison timely responded on January 8, 2025, [redacted]. On or around February 12, Phison discovered that several accused products had earlier U.S. sale dates than previously understood, with some dating back before July 19, 2011. After verifying these newly discovered facts and determining that its response to Interrogatory No. 3 potentially required amendment and supplementation, Phison investigated and promptly supplemented its interrogatory response on February 26, 2025. Based on Vervain's Final Infringement Contentions served on February 28,

2025, Phison supplemented its response to Interrogatory No. 9 regarding Invalidity on March 11, further investigating first sale dates on March 14, and produced additional documents on March 21, 2025. Courts routinely permit amendments where the moving party promptly acts on information "recently learned," as Phison has done here. *See Mears Techs., Inc. v. Finisar Corp.*, No. 2:13-cv-00376-JRG, Dkt. No. 121 (E.D. Tex. Oct. 6, 2014).

B. Factor 2: The amendment provides a dispositive invalidity defense under 35 U.S.C. §§ 102(a) and/or 102(b).

The amendment is critical to Phison's defense, as the recently discovered earlier sale dates provide potentially dispositive invalidity defenses under 35 U.S.C. §§ 102(a) and/or 102(b). Without the amendment, Phison would be unjustly prevented from asserting critical defenses that could materially affect the invalidity analysis, thereby impairing a fair and complete adjudication of the merits.

C. Factor 3: Phison's amendment will not prejudice Vervain.

Phison disclosed these updated sale dates on February 26, 2025, two days prior to Vervain serving its Final Infringement Contentions on February 28, 2025. Vervain was fully aware of the relevant facts prior to finalizing its infringement positions. Phison timely provided Vervain with updated invalidity arguments by supplementing its response to Interrogatory No. 9 through Defendant's Second Amended and Supplemental Responses to Plaintiff's Interrogatories Nos. 1–19, served on March 11, 2025. Phison also promptly provided a draft of its Amended Final Invalidity Contentions on March 26, 2025, as its investigation remained ongoing. Fact discovery

is ongoing and will continue for more than three months from the date of this motion, to July 7, 2025. Accordingly, Vervain has suffered no prejudice.

D. Factor 4: Continuance is available, even if prejudice were to exist.

As explained in factor 3 above, no prejudice exists because Vervain was timely provided with Phison's updated information and invalidity contentions. Fact discovery is still ongoing, with more than three months remaining, no depositions have yet been taken, and expert discovery has not commenced. Vervain has ample time to review Phison's proposed amendments. Furthermore, granting leave to serve Defendant's amended invalidity contentions would not disrupt or delay any deadlines in this case.

IV. CONCLUSION

For the foregoing reasons, Phison has shown good cause to amend its invalidity contentions and respectfully requests the Court grant its Motion for Leave to Amend its Final Invalidity Contentions.

Respectfully submitted,

Dated: March 27, 2025

By: */s/ Douglas E. Chin*

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CERTIFICATE OF CONFERENCE

I, Douglas E. Chin, counsel for Phison Electronics Corporation, hereby certify that on March 26, 2025, counsel for Plaintiff Vervain, LLC was notified regarding the foregoing Unopposed Motion for Leave to Amend Final Invalidity Contentions. Plaintiff's counsel confirmed on March 27, 2025, that Plaintiff was unopposed to Defendant's Motion for Leave to Amend.

/s/ Douglas E. Chin
Douglas E. Chin

CERTIFICATE OF SERVICE

I, Douglas E. Chin, counsel for Phison Electronics Corporation, hereby certify that on March 27, 2025, I electronically filed the foregoing DEFENDANT PHISON ELECTRONICS CORPORATION'S UNOPPOSED MOTION FOR LEAVE TO AMEND FINAL INVALIDITY CONTENTIONS with the Clerk of Court using the CM/ECF system which will send notification of such filing to all counsel of record. In addition, I emailed service copies of the sealed exhibit to counsel of record.

/s/ Douglas E. Chin
Douglas E. Chin