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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

BRILLIANT INSTRUMENTS, INC.,  
Plaintiff,  
v.  
GUIDETECH, INC., and RONEN SIGURA,  
Defendants.  
\_\_\_\_\_  
AND ALL RELATED COUNTERCLAIMS  
\_\_\_\_\_

No. C 09-5517 CW  
ORDER DENYING  
BRILILANT  
INSTRUMENTS, INC.'S  
MOTION TO AMEND  
PRELIMINARY  
INVALIDITY  
CONTENTIONS AND  
ADMINISTRATIVE  
REQUEST FOR LEAVE TO  
FILE DAUBERT MOTION  
BEYOND THE APRIL 1  
DEADLINE  
(Docket Nos. 86 and  
113)

Plaintiff and Counterclaim-Defendant Brilliant Instruments, Inc., moves for leave to amend its invalidity contentions and for leave to file a Daubert motion after the April 1, 2011 deadline. Defendant and Counterclaimant GuideTech, LLC,<sup>1</sup> opposes the motions. The motions were taken under submission on the papers. Having considered the papers submitted by the parties, the Court DENIES Brilliant's motion for leave to amend its invalidity contentions and administrative motion to file its Daubert motion after the April 1 deadline.

BACKGROUND

Brilliant seeks a declaration that its products do not infringe GuideTech's United States Patent Nos. 6,091,671 ('671 patent); 6,181,649 ('649 patent); 6,226,231 ('231 patent); 6,456,959 ('959 patent); 6,621,767 ('767 patent); 6,999,382 ('382

<sup>1</sup> GuideTech, LLC, was apparently erroneously sued as GuideTech, Inc.

1 patent); and 7,203,610 ('610 patent). GuideTech answered  
2 Brilliant's complaint and counterclaimed for infringement of the  
3 '671, '649 and '231 patents. GuideTech maintains that Brilliant's  
4 infringement has been and continues to be willful. In response to  
5 GuideTech's infringement claims, Brilliant counterclaimed for  
6 invalidity of the '671, '649 and '231 patents.

7 At his March 3, 2011 deposition, GuideTech's infringement  
8 expert Dr. Burnell G. West discussed a product called the "ITS9000"  
9 and U.S. Patent No. 6,081,484 ('484 patent), for which he was named  
10 the inventor. The '484 patent is for an invention that "relates to  
11 measuring signals in a tester system." '484 patent, 1:5-6. The  
12 patent refers to the ITS 9000, stating that "a prior art timing  
13 measurement unit (TMU) is used in a tester system, such as the ITS  
14 90000GX system made by Schlumberger Technologies, Inc."<sup>2</sup> Id. at  
15 1:10-12.

16 At the deposition, Brilliant's counsel asked West whether  
17 Figure 4B in the '484 patent, which was labeled "PRIOR ART," showed  
18 elements contained in Claim 1 of the '671 patent. West responded  
19 that it did. Behiel Decl., Ex. 1, at 259:11-262:7.

20 In its proposed amended invalidity contentions, Brilliant  
21 includes charts that compare elements of claims in the '671 and  
22 '231 patents with information it purportedly gleaned from West's  
23 deposition. See generally Behiel Decl., Ex. 10, at 40-41 and 50.  
24 With respect to the '671 patent, Brilliant cites West's testimony  
25 regarding Figure 4B of the '484 patent. Id. at 40-41. As for its  
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27 <sup>2</sup> GuideTech maintains that the reference to the Schlumberger  
28 "ITS 90000GX" in fact relates to the ITS9000. Brilliant does not  
dispute this. Reply 7:13-15.

1 proposed contentions regarding the '231 patent, Brilliant states  
2 that "Dr. West testified that all claims in the '231 patent are  
3 anticipated by U.S. Patent No. 6,081,484." Id. at 50.

4 The parties' April 27, 2010 Joint Case Management Statement  
5 listed April 1, 2011 as the deadline for filing Daubert motions.  
6 The Court adopted this deadline in its May 4, 2010 Case Management  
7 Order.

8 DISCUSSION

9 I. Brilliant's Motion to Amend

10 Under Patent L.R. 3-3(a), a party's invalidity contentions  
11 must contain information on the "identity of each item of prior art  
12 that allegedly anticipates each asserted claim or renders it  
13 obvious." Amendments to infringement contentions may "be made only  
14 by order of the Court upon a timely showing of good cause," which  
15 may include "recent discovery of material, prior art despite  
16 earlier diligent search." Patent L.R. 3-6. Good cause under the  
17 Patent Local Rules "requires a showing of diligence." O2 Micro  
18 Int'l v. Monolithic Power Sys., Inc., 467 F.3d 1355, 1366 (Fed.  
19 Cir. 2006). The burden is on the party amending its contentions  
20 "to establish diligence rather than on the opposing party to  
21 establish a lack of diligence." Id.

22 Brilliant seeks leave to amend its invalidity contentions to  
23 refer to the "ITS9000," which Brilliant maintains is prior art that  
24 anticipates the patents it claims are invalid. Brilliant maintains  
25 that it did not learn about the relevance of this product until  
26 West discussed at his March 3, 2011 deposition. Brilliant points  
27 to West's testimony that, at one time, the ITS9000 was a trade  
28 secret. Brilliant maintains that, upon discovering information

1 about the ITS9000, it diligently sought leave to amend its  
2 contentions, filing the current motion on March 16, 2011.

3 Brilliant's argument, however, is vitiated by the publicly  
4 available '484 patent, which Brilliant knew of and believed to be  
5 "relevant prior art" in June 2010. See Reply at 8 n.3. As noted  
6 above, the '484 patent refers to the ITS9000 as underlying prior  
7 art, putting Brilliant on notice of that product. Indeed, the  
8 portion of West's testimony on which Brilliant relies for its  
9 current motion pertains to what is shown in Figure 4B of the '484  
10 patent. See Behiel Decl., Ex. 1, at 259:2-4. That Figure 4B may  
11 represent the ITS9000 without saying so does not support  
12 Brilliant's position. Figure 4B is labeled "PRIOR ART." See also  
13 '484 patent, 4:26. To be diligent, Brilliant should have  
14 investigated this prior art. It did not do so.

15 Brilliant's proposed amended contentions concerning the '231  
16 patent further demonstrate its lack of diligence. Those proposed  
17 contentions state, "Dr. West testified that all claims in the '231  
18 patent are anticipated by U.S. Patent No. 6,081,484." See Behiel  
19 Decl., Ex. 10, at 50. Brilliant maintains that West relied on  
20 "secret aspects of the ITS9000" for this purported testimony. Mot.  
21 at 7. However, Brilliant does not identify any material  
22 characteristics of the ITS9000 not disclosed in the '484 patent.<sup>3</sup>  
23 Further, Brilliant did not need West's testimony to know that the  
24 '484 patent was relevant. As noted above, it knew in June 2010

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26 <sup>3</sup> Indeed, Brilliant acknowledges that many elements of the  
27 ITS9000 were at issue "in a patent application filed 10/14/1997"  
28 and that this application ripened into the '484 patent. Mot. at 6  
n.3. However, Brilliant does not identify elements not disclosed  
in that application or the '484 patent that are relevant to its  
claims of invalidity.

1 that the patent constituted relevant prior art.

2 Accordingly, the Court denies Brilliant's motion for leave to  
3 amend its contentions based on the ITS9000.

4 II. Administrative Motion for Leave to File Brilliant's Daubert  
5 Motion Beyond the April 1 Deadline

6 Brilliant seeks leave to file a Daubert motion challenging  
7 West's expert report and testimony. As noted above, the deadline  
8 to file Daubert motions was April 1, 2011.

9 Pursuant to Federal Rule of Civil Procedure 16(b)(4), a  
10 scheduling order "may be modified only for good cause and with the  
11 judge's consent." In order to determine whether good cause exists,  
12 courts primarily consider the diligence of the party seeking the  
13 modification. Johnson v. Mammoth Recreations, Inc., 975 F.2d 604,  
14 609 (9th Cir. 1992); see also Coleman v. Quaker Oats Co., 232 F.3d  
15 1271, 1294 (9th Cir. 2000).

16 Brilliant asserts that it was not "reasonably feasible" to  
17 complete the Daubert motion by the deadline because West's  
18 deposition was March 3 and it was busy preparing its opening claim  
19 construction brief, motion for summary judgment and motion to amend  
20 its infringement contentions. Administrative Mot. at 2. This  
21 argument does not establish good cause. Brilliant knew of the  
22 Daubert motion deadline for almost a year. And after that deadline  
23 passed, Brilliant waited two weeks before seeking leave to file a  
24 belated motion. Finally, although it points to West's testimony on  
25 March 3, Brilliant was served with West's expert report on January  
26 28, 2011. See Case Management Order (Docket No. 29). Under these  
27 circumstances, Brilliant has not demonstrated its diligence.

28 Accordingly, Brilliant's administrative motion is denied.

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CONCLUSION

For the foregoing reasons, the Court DENIES Brilliant's motion for leave to amend (Docket No. 86) and administrative motion for leave to file its Daubert motion after the deadline (Docket No. 113).

IT IS SO ORDERED.

Dated: 4/29/2011

  
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CLAUDIA WILKEN  
United States District Judge