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

BRILLIANT INSTRUMENTS, INC.,
Plaintiff,
v.
GUIDETECH, INC.,
Defendant.
_____/

No. C 09-5517 CW
ORDER GRANTING
GUIDETECH, INC.'S
MOTION TO STRIKE
(Docket No. 77)

AND ALL RELATED COUNTERCLAIMS

Defendant and Counterclaimant GuideTech, LLC,¹ moves to strike references contained in the report of Plaintiff and Counterclaim- Defendant Brilliant Instruments, Inc.'s expert Martin E. Kaliski, Ph.D. Brilliant opposes the motion. The motion will be taken under submission on the papers. Having considered all the papers submitted by the parties, the Court GRANTS GuideTech's motion to strike.

BACKGROUND

Brilliant seeks a declaration that its products do not

¹ GuideTech, LLC, was apparently erroneously sued as GuideTech, Inc.

1 infringe GuideTech's United States Patent Nos. 6,091,671 ('671
2 patent); 6,181,649 ('649 patent); 6,226,231 ('231 patent);
3 6,456,959 ('959 patent); 6,621,767 ('767 patent); 6,999,382 ('382
4 patent); and 7,203,610 ('610 patent). GuideTech answered
5 Brilliant's complaint and counterclaimed for infringement of the
6 '671, '649 and '231 patents. GuideTech maintains that Brilliant's
7 infringement has been and continues to be willful. In response to
8 GuideTech's infringement claims, Brilliant counterclaimed for
9 invalidity of the '671, '649 and '231 patents.

10 GuideTech moves to strike the following prior art references
11 contained in Dr. Kaliski's report on invalidity:

12 U.S. Patent 4,792,932 ('932 patent)

13 U.S. Patent 4,362,955 ('955 patent)

14 DTS 2070/2075 Block Diagram

15 DTS-2070 User's Guide and Reference Manual, Rev B (1994-2000)

16 HP 5335A Universal Frequency Counter Temporary Operating &
17 Service Manual (October 1, 1980)

18 The Fundamentals of Time Interval Measurements, Application
19 Note 200-3 (1997)

20 The Fundamentals of Electronic Counters, Application Note 200
21 (1997)

22 HP 5372A Frequency and Time Interval Analyzer Operating Manual
23 (1995)

24 HP 5372A Service Manual (1990)

25 Chapter 19 of The Electronic Instrument Handbook, Second
26 Edition, Clyde F. Coombs, Jr. (1994)

27 A High-Precision Time-to-Digital Converter for Pulsed
28 Time-of-Flight Laser Radar Application, Kari Maatta and Juha
Kostamovaara (1998)

Brilliant does not dispute that it did not identify these
references in its Invalidity Contentions, which were served on June

1 17, 2010. It asserts, however, that it discovered the '932 patent
2 on December 23, 2010 and the '955 patent on January 27, 2011. Dr.
3 Kaliski referred to these patents and the other above-mentioned
4 materials in his expert report, which Brilliant served on January
5 28, 2011.

6 DISCUSSION

7 GuideTech asks that the above-mentioned references contained
8 in Dr. Kaliski's report be stricken because they were not
9 identified as relevant prior art in Brilliant's Invalidity
10 Contentions.

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

23 Despite GuideTech's objections to the above-mentioned
24 references, Brilliant has not moved to amend its Invalidity
25 Contentions.² Even if it had, it has not demonstrated good cause

26

27 ² In its opposition, filed February 24, 2011, Brilliant states
28 that it will seek leave to amend its Invalidity Contentions "to
(continued...)

1 to amend them. Brilliant indicates only when it discovered the
2 '932 and the '955 patents, both of which are expired patents that
3 were publicly available at the time Brilliant served its Invalidity
4 Contentions. Because Brilliant did not identify these patents as
5 relevant prior art in its Invalidity Contentions, Dr. Kaliski may
6 not use them as prior art to demonstrate invalidity. Accordingly,
7 Dr. Kaliski's report is stricken to the extent that he relies on
8 the '932 and '955 patents as prior art that allegedly anticipates
9 the claims asserted in this action or renders such claims obvious.

10 Brilliant maintains that the references other than the '932
11 and '955 patents are not items of prior art that allegedly
12 anticipate the asserted claims or render these claims obvious.
13 Instead, Brilliant asserts, these references "are relevant to the
14 general knowledge of the person of ordinary skill in the art . . .
15 and the prior art solutions to the types of problems encountered in
16 the art." Opp'n 5:4-7. Brilliant further argues that these other
17 references are relevant to claim construction. Because Brilliant
18 asserts that it is not using these other references as invalidating
19 prior art, they are stricken from Dr. Kaliski's report to the
20 extent that he relies on them as prior art that allegedly
21 anticipates the claims asserted in this action or renders such
22 claims obvious. However, Dr. Kaliski may rely on these other
23 references for other purposes.

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26 ²(...continued)
27 include the '955 patent, and will either seek leave to include the
28 '932 patent and add it to the appropriate claim chart(s), or will
stipulate to withdraw it from the Kaliski invalidity report as
cumulative." Opp'n 3:24-26. However, Brilliant has not so moved.

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CONCLUSION

For the foregoing reasons, the Court GRANTS GuideTech's motion to strike. (Docket No. 77.) The above-mentioned references are stricken from Dr. Kaliski's report to the extent that he relies on them as prior art that allegedly anticipates the claims asserted in this action or renders such claims obvious.

IT IS SO ORDERED.

Dated: 3/15/2011



CLAUDIA WILKEN
United States District Judge