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United States District Court  
Northern District of California

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

HUAWEI TECHNOLOGIES, CO, LTD, et al.,

Plaintiffs,

v.

SAMSUNG ELECTRONICS CO, LTD., et al.,

Defendants.

Case No. [3:16-cv-02787-WHO](#)

**ORDER GRANTING SAMSUNG  
LEAVE TO AMEND INFRINGEMENT  
CONTENTIONS**

Re: Dkt. No. 116

**INTRODUCTION**

Counterclaim-plaintiffs Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) seek to amend their infringement contentions to (1) include additional infringing instrumentalities and (2) change the conception dates with respect to Samsung’s U.S. Patent Number 8,228,827 (“827 Patent”) and RE44,105 (“105 Patent”). Counterclaim-defendants Huawei Technologies Co., Ltd., Huawei Device USA, Inc., Huawei Technologies USA, Inc. and HiSilicon Technologies Co. Ltd. (collectively, “Huawei”) do not oppose the first request, but contend that Samsung’s second request should be denied because Samsung has not been diligent and Huawei will be prejudiced if Samsung is permitted to amend the conception dates at this time. Because Samsung has been at least marginally diligent and I do not see prejudice to Huawei, Samsung’s motion to amend the conception dates is GRANTED.

**BACKGROUND**

Huawei initiated this action on May 24, 2016; Samsung answered and filed counterclaims on August 22, 2016. *See* Compl. (Dkt. No. 1); Answer, Third Party Complaint, and Counterclaims (Dkt. No. 42[redacted], Dkt. No. 41-3[under seal]).

On October 25, 2016, Samsung served its infringement contentions and document

1 productions as dictated by Patent Local Rules 3-1 and 3-2. Lordgooei Decl. ¶ 2 (Dkt. No. 116-1);  
 2 *see* Samsung's Disclosure of Asserted Claims and Infringement Contentions (*Id.*, Ex. 1, Dkt. No.  
 3 116-2; Huawei's Partial Opp'n to Samsung's Mot. ("Opp'n"), Ex. A, Dkt. No. 120-3).<sup>1</sup> But it did  
 4 not identify specific conceptions dates for four of Samsung's nine asserted patents, including the  
 5 '827 and '105 patents. *See* Samsung's Disclosure at 8. Rather, it disclosed priority dates of "at  
 6 least" February 9, 2007 for the '827 patent and "at least" April 6, 2005 for the '105 patent. *Id.*

7 On November 7, 2016, Huawei wrote to Samsung to address deficiencies in its  
 8 contentions, including Samsung's failure to identify specific dates of conception for each asserted  
 9 patent. 11/7/16 Letter to Samsung (Opp'n, Ex. B, Dkt. No. 120-3). It specifically requested  
 10 confirmation that Samsung would not rely on any conception dates earlier than the priority dates  
 11 disclosed. *Id.* at 1. Samsung did not immediately respond and Huawei sent another letter on  
 12 November 30, 2016. 11/30/16 Letter to Samsung (Opp'n, Ex. C, Dkt. No. 120-3; Lordgooei  
 13 Decl., Ex. 2, Dkt. No. 116-3). Samsung responded on December 2, 2016, disputing that it was  
 14 required to identify specific conception dates (as opposed to priority dates), but providing  
 15 supplemental infringement contentions that identified additional conception dates "in an effort to  
 16 resolve potential disputes between the parties[.]" 12/2/16 Letter to Huawei (Opp'n, Ex. D, Dkt.  
 17 No. 120-3); *see* Samsung's First Supplemental Disclosure of Asserted Claims and Infringement  
 18 Contentions (Opp'n, Ex. E, Dkt. No. 120-3; Lordgooei Decl., Ex. 3, Dkt. No. 116-4). It also  
 19 stated its understanding that "neither party will be required to seek leave to amend their respective  
 20 infringement contentions" and "reserve[d] the right to update these dates as additional information  
 21

22 <sup>1</sup> Samsung filed an administrative motion to file under seal information that has been designated  
 23 by Huawei as confidential. Samsung's Administrative Mot. (Dkt. No. 115). Since Huawei does  
 24 not seek to seal that information (Dkt. No. 119), the motion is DENIED. Huawei filed an  
 25 administrative motion to file under seal information designated by Samsung as Highly  
 26 Confidential, including portions of its partial opposition and Exhibit M attached thereto. Huawei's  
 27 Administrative Mot. (Dkt. No. 120). Samsung filed a declaration in support of sealing, seeking to  
 28 maintain the confidentiality of Exhibit M (internal meeting minutes) and nine lines from Huawei's  
 29 Opposition referencing portions of Exhibit M. Lordgooei Decl. ISO Administrative Mot. to File  
 30 Under Seal ¶¶ 4–5 (Dkt. No. 122). Because Samsung's request is narrowly tailored to seal only  
 highly confidential business information, it meets the good cause standard for sealing non-  
 dispositive motions and related materials. *See Kamakana v. City & Cty. of Honolulu*, 447 F.3d  
 1172, 1179-80 (9th Cir. 2006) ("A 'good cause' showing under Rule 26(c) will suffice to keep  
 sealed records attached to non-dispositive motions"). Huawei's administrative motion to file

1 becomes available.” 12/2/16 Letter to Huawei. Samsung identified “April 6, 2005” as the  
2 conception date for the ’105 patent and “January 2007” as the conception date for the ’827 patent.  
3 Samsung’s First Supp. Infr. Contentions at 8. Huawei accepted the conception date for the ’105  
4 patent, but notified Samsung that it had to identify a specific date, not just a month and year, for  
5 the ’827 patent. 12/15/16 Letter to Samsung (Opp’n, Ex. F, Dkt. No. 120-3). It also disputed  
6 Samsung’s contention that it could amend without seeking leave because “Huawei is relying on  
7 these dates to develop invalidity contentions[.]” and “[a]ny changes could negatively impact  
8 Huawei’s ability to put forth an invalidity defense.” *Id.*

9 Although Samsung continued to disagree that the Patent Local Rules required disclosure of  
10 a specific date, it amended its conception date for the ’827 patent to “January 26, 2007.” 1/10/17  
11 Letter to Huawei (Opp’n, Ex. G, Dkt. No. 120-3; Lordgooei Decl., Ex. 4, Dkt. No. 116-5). Ten  
12 days later on January 20, 2017, the parties exchanged invalidity contentions and accompanying  
13 document productions. Huawei contended that Samsung was not entitled to a priority date of  
14 February 2007 for the ’827 asserted claims, nor a priority date of April 2005 for the ’105 asserted  
15 claims. Huawei’s Invalidity Contentions at 90 (Opp’n, Ex. H, Dkt. No. 120-3; Lodgooei Decl.,  
16 Ex. 6, Dkt. No. 116-7). For the ’827 patent, Huawei disclosed allegedly invalidating prior art that  
17 it claims was available as early as December 2005 and as late as January 5, 2010. *Id.* at 27; *see*  
18 Samsung’s Mot. to Amend Infr. Contentions at 3 (“Mot.”)(Dkt. No. 116).<sup>2</sup> And for the ’105  
19 patent, Huawei disclosed allegedly invalidating prior art that it claims was available as early as  
20 1999, and as late as June 8, 2009. Huawei’s Invalidity Contentions at 32–33; *see* Mot. at 3.  
21 According to Huawei, it relied upon the conception dates provided by Samsung to locate key prior  
22 art references. *See* Opp’n at 4 (citing to Huawei’s Invalidity Contentions).

23 Between January 12 and February 14, Samsung identified documents supporting a  
24 conception date of January 22, 2007 for the ’827 patent, and March 30, 2005 for the ’105 patent.<sup>3</sup>

26 \_\_\_\_\_  
27 <sup>2</sup> These dates are not included in the prior art references in Huawei’s infringement contentions.  
They are only mentioned in Samsung’s motion. *See* Mot. at 3.

28 <sup>3</sup> Samsung contends that the archived documents were associated with prior litigation involving

1 Lordgooei Decl. ¶ 3. Samsung produced the responsive, non-privileged information on February  
2 14, 2017. *Id.*

3 The next day, Samsung sent Huawei an email with proposed second supplemental  
4 infringement contentions attached. 2/15/17 Email to Huawei with Supplemental Infringement  
5 Contentions Attachment (Opp'n, Ex. I, Dkt. No. 120-3). The supplemental contentions identified  
6 additional infringing products based on Huawei's supplemental interrogatory responses, and  
7 proposed changes to two conception dates: from January 26 to January 22, 2007 for the '827  
8 patent, and from April 6 to March 30, 2005 for the '105 patent. *Id.* Huawei responded that it did  
9 not oppose Samsung's revisions to the list of accused products but did oppose the revisions to its  
10 claimed conception dates. 2/22/17 Email to Samsung (Opp'n, Ex. J, Dkt. No. 120-3; Lordgooei  
11 Decl., Ex. 9, Dkt. No. 116-10). Samsung then requested a meet and confer and, as a compromise,  
12 proposed a stipulation to grant Samsung leave to serve disclosures with the revised conception  
13 dates and allow Huawei 30 days to respond to identify any additional prior art pre-dating the new  
14 conception dates. 2/27/17 Email to Huawei (Lordgooei Decl., Ex. 10, Dkt. No. 116-11).

15 After the meet and confer, Huawei requested that Samsung identify the documents  
16 supporting its revised conception dates. 3/8/17 Email to Samsung (Opp'n, Ex. K, Dkt. No. 120-3;  
17 Lordgooei Decl., Ex. 11, Dkt. No. 116-12). For the '827 patent, Samsung identified a document it  
18 had produced on February 14, 2017, and for the '105 patent, Samsung cited a draft privilege log  
19 entry. *See* Opp'n, Ex. L, Dkt. No. 120-3. After reviewing the documents, Huawei maintained its  
20 objection to Samsung's motion for leave to amend its conception dates. On March 13, 2017,  
21 Samsung filed its motion. Dkt. No. 116.

## 22 LEGAL STANDARD

23 Pursuant to the Patent Local Rules for the Northern District of California, a party claiming  
24 infringement must submit infringement contentions within fourteen days of the parties' initial  
25 Case Management Conference. Patent L.R. 3-1. These must include, among other things, "each  
26 accused apparatus, product, device, process, method, act, or other instrumentality ('Accused  
27 Instrumentality') of each opposing party of which the party is aware," and must "be as specific as

1 priority to an earlier application, the priority date to which each asserted claim allegedly is  
2 entitled.”

3 Patent Local Rule 3-2 governs “Document Production Accompanying Disclosure,” which  
4 must accompany the Rule 3-1 disclosures. This must contain documents that relate to the sale or  
5 other use of the claimed invention, as well as “[a]ll documents evidencing the conception,  
6 reduction to practice, design, and development of each claimed invention, which were created on  
7 or before the date of application for the patent in suit or the priority date identified pursuant to  
8 Patent L.R. 3-1(f), whichever is earlier.” Patent L.R. 3-2(a)-(b). A defendant must serve  
9 invalidity contentions and document production no later than 45 days after it is served with the  
10 infringement contentions. Patent L.R. 3-3, 3-4.

11 The court may allow a party to amend its infringement contentions only “upon a timely  
12 showing of good cause.” Patent L.R. 3-6. The Patent Local Rules supply several circumstances  
13 that support a finding of good cause, provided there is no prejudice to the non-moving party. *Id.*  
14 These include “[a] claim construction by the Court different from that proposed by the party  
15 seeking amendment,” and “[r]ecent discovery of nonpublic information about the Accused  
16 Instrumentality which was not discovered, despite diligent efforts, before the service of the  
17 Infringement Contentions.” *Id.*

18 The patent local rules were designed to require parties to crystallize their theories of  
19 infringement early in litigation, and to adhere to such theories. *Apple Inc. v. Samsung Elecs. Co.*,  
20 No. 12-CV-0630-LHK PSG, 2013 WL 3246094, at \*1 (N.D. Cal. June 26, 2013). In determining  
21 whether a party has good cause to amend, courts will first look to see whether the moving party  
22 has good cause, which requires that it act with diligence, and then to whether the non-moving  
23 party will suffer prejudice. *Id.* The focus of this inquiry is on the moving party’s reasons for  
24 seeking amendment. *Id.* The moving party bears the burden of establishing diligence. *Id.* “Only  
25 if the moving party is able to show diligence may the court consider the prejudice to the non-  
26 moving party.” *Id.*

27 “[T]he philosophy behind amending claim charts is decidedly conservative, and designed

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