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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

ENFISH, LLC,
Plaintiff,
v.
MICROSOFT CORPORATION;
FISERV, INC.; INTUIT, INC.; SAGE
SOFTWARE, INC.; and JACK
HENRY & ASSOCIATES, INC.,
Defendants.

Case No. 2:12-cv-7360-MRP-MRWx

**Order Denying Plaintiff’s Motion
for Leave to Supplement
Infringement Contentions**

I. INTRODUCTION

Plaintiff Enfish, LLC (“Enfish”) has sued Defendants Microsoft Corporation (“Microsoft”), Fiserv, Inc., Intuit, Inc., Sage Software, Inc., and Jack Henry & Associates, Inc. (collectively, “Defendants”) for infringement of U.S. Patent No. 6,151,604 (“the ’604 Patent”) and U.S. Patent No. 6,163,775 (“the ’775 Patent”). Enfish moves for leave to supplement its infringement contentions to allege willful infringement and to assert Claims 6, 7, 12, 24, 25, 36, 37, 42, 54, and 55 from the ’604 Patent.

1 **II. BACKGROUND**

2 The technical background of the invention of the '604 Patent is set forth in this
3 Court's Order Granting in Part and Denying in Part Defendants' Motion for
4 Summary Judgment of Anticipation.

5 On November 16, 2012, the Court ordered Enfish to serve on all parties a
6 disclosure of asserted claims and infringement contentions for those claims by
7 December 27, 2012. Dkt. No. 45 (scheduling the initial case management
8 conference for December 13, 2012 and ordering service of disclosure of asserted
9 claims and infringement contentions not later than 14 days following the
10 conference). On May 15, 2013, Enfish filed its infringement contentions,
11 identifying asserted claims 1, 2, 16, 17, 31, 32, 46, and 47 from the '604 Patent and
12 asserted claims 31, 32, 47 from the '775 Patent. The infringement contentions also
13 identified accused products and services sold and offered by Defendants. Enfish
14 did not assert allegations of willful infringement in its complaint, its first amended
15 complaint, or the infringement contentions.

16 On July 15, 2013, the Court issued its Claim Construction order, construing ten
17 claim terms selected by the parties. Dkt. No. 86. Following claim construction,
18 the Court ordered the parties to stipulate to a schedule to address discovery,
19 summary judgment, and other litigation deadlines. Dkt. No. 102. The Court
20 issued a scheduling order pursuant to the parties' stipulation, opening fact
21 discovery on September 5, 2013 and scheduling a hearing on motions for summary
22 judgment of invalidity on February 13, 2014. Dkt. No. 101. The parties did not
23 address amendments to the disclosure of asserted claims or the infringement
24 contentions.

25 On December 6, 2013, Defendants filed motions for summary judgment on
26 invalidity in conformity with the Court's deadline. Two weeks later, Enfish filed
27 the instant motion for leave to amend its infringement contentions.

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1 patents, it could not plead sufficient facts giving rise to a showing of objective
2 recklessness of the risk of infringement without discovery. The source code for
3 Microsoft's software product, ADO.net, has been publicly available since 2008.
4 Further, none of the evidence adduced by Enfish indicates that Microsoft
5 subjectively believe it was infringing or risking infringement. Enfish presents no
6 evidence that suggests it has learned something new since the opening of
7 discovery; instead, the evidence indicates that Enfish waited until after the opening
8 of summary judgment motions to bring facts it knew since 2002 to the Court's
9 attention.

10 **B. Additional asserted claims**

11 In the original infringement contentions, Enfish asserted eleven claims from the
12 '604 and '775 Patents. Now, after the exchange of invalidity contentions and
13 motions for summary judgment on invalidity, Enfish seeks to add ten more claims
14 from the '604, claiming that review of the ADO.net source code revealed new
15 information about Defendants' infringing activity. Enfish's arguments about
16 licensing limitations, including its argument that beginning patent litigation
17 terminates the user's right to license the ADO.net software, are without merit.
18 Enfish has pointed to nothing in the comments or historical version that supports
19 assertion of the new claims. Enfish's original infringement contentions adequately
20 alleged infringement of eleven claims, but Enfish does not, and cannot, explain
21 why it could not have adequately alleged infringement of the proposed claims.

22 **C. Prejudice to Defendants**

23 Finally, Enfish argues that Defendants would suffer no prejudice if the Court
24 granted Enfish leave to supplement its infringement contentions. The parties
25 selected ten claim terms for construction, the Court construed claim terms,
26 Defendants researched and selected relevant prior art, and Defendants moved for
27 summary judgment of invalidity for all asserted claims. To allow Enfish to add ten
28 claims would effectively reset the case, potentially requiring that the parties

1 negotiate and the Court construe new claim terms. In addition, the proposed
2 supplementation renders superfluous both Defendants' motion for summary
3 judgment of invalidity and this Court's attempt to effectively manage the case
4 docket by considering potentially dispositive motions early in the case.

5 Enfish's argument that no prejudice would occur because discovery is still open
6 ignores the extensive work already completed in this case. The purpose of staged
7 discovery is not to allow the plaintiff to entirely shift the focus of the case fifteen
8 months after filing the complaint.

9 As Defendants contend, the Court and the parties have indeed already invested
10 significant time and resources in a claim construction process and summary
11 judgment motions that focused exclusively on the original set of asserted claims.
12 Adding ten claims would prejudice Defendants and justifies denying leave to add
13 new claims to the case. *Berger v. Rossignol Ski Co., Inc.*, No. 05-cv-2523, 2006
14 WL 1095914, at *4 (N.D. Cal. Apr. 25, 2006) aff'd, 214 F. App'x 981 (Fed. Cir.
15 2007); *Atmel Corp. v. Info. Storage Devices Inc.*, No. 95-cv-1987, 1998 WL
16 775115, at *3 (N.D. Cal. Nov. 5, 1998).

17 V. CONCLUSION

18 Having read and considered all of the briefs and arguments of the parties, the
19 Court concludes that Enfish has not shown good cause for leave to supplement its
20 infringement contentions and that Defendants would be prejudiced if the Court
21 granted leave to amend. The Court therefore **DENIES** Enfish's Motion for Leave
22 to Supplement Infringement Contentions.

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24 IT IS SO ORDERED.

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26 DATED: March 31, 2014



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28 Hon. Mariana R. Pfaelzer
United States District Judge