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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

IN RE: AMERANTH PATENT
LITIGATION CASES,

CASE NO. 11cv1810 DMS (WVG)

**ORDER (1) RESOLVING PARTIES’ JOINT
MOTION FOR DISCOVERY DISPUTE, (2)
RESOLVING PARTIES’ JOINT MOTION
REGARDING SERVICE OF AMENDED
INFRINGEMENT CONTENTIONS AND (3) RE-
SETTING DATES**

[Docket Nos. 450, 455]

This case comes before the Court on the parties’ (1) Joint Motion for Determination of Discovery Dispute [Docket No. 450] and (2) Joint Motion Regarding Service of Amended Infringement Contentions [Docket No. 455].

The first motion concerns Defendant QuikOrder’s responses to Plaintiff’s interrogatories regarding source code organization. Plaintiff served similar interrogatories on other Defendants, and thus the Court gave those parties an opportunity to file briefs on the issue, which some Defendants have done. The Court also gave Plaintiff an opportunity to file a reply, which it has done.

The subject interrogatories ask Defendants to identify by name, purpose and location certain “projects” within Defendants’ source codes that correspond to the accused systems. Defendants objected to the interrogatories on several grounds, and rely on Federal Rule of Civil Procedure 33(d) in response. Specifically, they assert the answers to Plaintiff’s interrogatories may be found in their respective source codes. The primary issue before the Court is whether Defendants’ reliance on that Rule is sufficient or further responses are necessary.

1 Federal Rule of Civil Procedure 33(d) states:

2 If the answer to an interrogatory may be determined by examining, auditing,
3 compiling, abstracting, or summarizing a party's business records (including
4 electronically stored information), and if the burden of deriving or ascertaining the
5 answer will be substantially the same for either party, the responding party may answer
6 by:

7 (1) specifying the records that must be reviewed, in sufficient detail to enable the
8 interrogating party to locate and identify them as readily as the responding party could;
9 and

10 (2) giving the interrogating party a reasonable opportunity to examine and audit the
11 records and to make copies, compilations, abstracts, or summaries.

12 Fed. R. Civ. P. 33(d). "A requesting party claiming an inappropriate use of Rule 33(d) must 'make
13 a prima facie showing that the use of Rule 33(d) is somehow inadequate, whether because the
14 information is not fully contained in the documents or because it is too difficult to extract.'" *RSI*
15 *Corp. v. Int'l Business Machines Corp.*, No. 5:08-cv-3414 RMW, 2012 WL 3095396, at *1 (N.D. Cal.
16 July 30, 2012) (quoting 7 J. Moore, *Moore's Federal Practice* § 33.105 (3d ed. 2012)). If the
17 requesting party meets that showing, "[t]he burden then shifts to the producing party to show that: (1)
18 a review of the documents will actually reveal answers to the interrogatories; and (2) the burden of
19 deriving the answer is substantially the same for the party serving the interrogatory as for the party
20 served." *Id.* (citing 7 Moore's).

21 Here, Plaintiff does not argue the information it seeks is not contained in Defendant's source
22 codes. Rather, it argues it will incur a "substantial burden" if it is forced to review those source codes
23 to discover the requested information. However, "discovery by its very nature is burdensome, and that
24 especially holds true in patent cases." *Digital Reg of Texas, LLC v. Adobe Systems Inc.*, No. CV 12-
25 01971-CW (KAW), 2013 WL 3361241, at *6 (N.D. Cal. July 3, 2013). That the task of discovering
26 the requested information is burdensome does not mean it is too difficult for Plaintiff to perform.
27 Accordingly, the Court denies Plaintiff's motion to compel QuikOrder, and any other Defendants to
28 which similar interrogatories were sent, to provide further responses to its interrogatories.

With respect to the second motion, pursuant to a July 26, 2013 Order issued by Magistrate
Judge Stormes, Plaintiff was to amend its preliminary infringement contentions in four respects: (1)
to provide more specifics with respect to the doctrine of equivalents, (2) to provide facts supporting
its theory of contributory infringement, (3) to state how the previous versions of Defendants' accused

1 systems are the same or reasonably similar to the charted version or provide a separate chart for each
2 accused version and (4) to identify with specificity where in the accused system the alleged
3 infringement occurs and how the claim elements are met. In that Order, Magistrate Judge Stormes
4 also ordered the parties to meet and confer regarding (1) a schedule for the service of the amended
5 infringement contentions and (2) whether Plaintiff should amend its infringement contentions as to
6 Defendants other than OpenTable, Wanderspot and Best Western.

7 In response to that Order, the parties filed the Joint Motion Regarding Service of Amended
8 Infringement Contentions. In the Joint Motion, Plaintiff stated it could not meet the requirement set
9 out in number (4) above without first reviewing Defendants' source codes. It also argued that it
10 should only have to amend its infringement contentions as to OpenTable, Wanderspot and Best
11 Western. Defendants disputed their source codes were necessary for Plaintiff to comply with
12 requirement number (4). They also asserted Plaintiff should amend its infringement contentions as
13 to all Defendants, not just the three identified above.

14 After the parties filed the Joint Motion, the case was reassigned to the undersigned Judge.
15 Pursuant to a September 13, 2013 Order, the Court gave Defendants who had not yet had an
16 opportunity to be heard on the Joint Motion an opportunity to file a brief on the issues, and gave
17 Plaintiff an opportunity to file a response. Defendants Starbucks, Apple, Eventbrite, Ticketfly and
18 Ticketbiscuit each filed a separate brief in which they argue they should not have to produce their
19 source codes for Plaintiff to amend its infringement contentions. Plaintiff filed a consolidated
20 response.

21 After reviewing Magistrate Judge Stormes's order, the parties' briefs, the record in this case
22 and the relevant authority, the Court agrees with Plaintiff that Defendants should provide their source
23 codes prior to Plaintiff amending its infringement contentions. Some Defendants (OpenTable, Papa
24 John's, GrubHub, Domino's, O-Web, Seamless, Pizza Hut and QuikOrder) have already done so.
25 Thus, Plaintiff can amend its infringement contentions as to these Defendants right away. As to the
26 other Defendants, the Court orders as follows:

27 1. The other Defendants shall produce their respective source codes to Plaintiff as follows:

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- 1 a. Wanderspot and the Hotel Companies shall provide their source codes on or before
2 **October 25, 2013.**
- 3 b. The Travel Aggregators shall provide their source codes on or before **November 8,**
4 **2013.**
- 5 c. The Ticketing Companies shall provide their source codes on or before **November 22,**
6 **2013.**
- 7 d. The POS Companies shall provide their source codes on or before **December 6, 2013.**
- 8 e. All other Defendants, including Starbucks, Eventbrite, Ticketfly, Ticketbiscuit and
9 Apple, shall provide their source codes on or before **December 20, 2013.**
- 10 2. Plaintiff shall provide its amended, or initial, infringement contentions as follows:¹
- 11 a. For the Pizza Companies and Providers, on or before **October 25, 2013.**
- 12 b. For the Food Ordering Companies, on or before **November 8, 2013.**
- 13 c. For the Reservations Companies, on or before **November 22, 2013.**
- 14 d. For the Hotel Companies, on or before **December 6, 2013.**
- 15 e. For the Travel Aggregators, on or before on or before **December 20, 2013.**
- 16 f. For the Ticketing Companies, on or before **January 3, 2014.**
- 17 g. For the POS Companies, on or before **January 17, 2014.**
- 18 h. For all other Defendants listed in 1.e. above, on or before **January 31, 2014.**

19 Plaintiff is directed to select no more than five (5) claims from each patent to assert against all
20 Defendants for a maximum of twenty (20) claims. Plaintiff may assert additional claims at this time
21 only with leave of Court. Plaintiff's amended infringement contentions shall consist of one
22 representative version of each Defendant's accused system for the five selected claims of each patent
23 asserted against that Defendant.² If Plaintiff asserts indirect infringement (contributory or inducement)
24 by a Defendant, Plaintiff shall provide as part of its infringement contentions an example of how the
25 ///

26 ¹ The following list includes all Defendants, to the extent they believe Plaintiff's infringement
27 contentions are inadequate. If any Defendant is satisfied with Plaintiff's infringement contentions,
28 Plaintiff need not amend its contentions as to those Defendants.

² This limitation moots requirement (3) of Judge Stormes's order.

1 Defendant indirectly infringes, including the identity of the direct infringer and factual basis for the
2 Defendant's intent.

3 3. Plaintiff may provide infringement contentions for additional accused systems or versions
4 following the issuance of the claim construction order as provided in Patent L.R. 3.6(a).

5 4. No later than **March 31, 2014**, Defendants shall serve invalidity contentions pursuant to Patent
6 L.R. 3.3 and produce documents as required by Patent L.R. 3.4. Defendants shall jointly provide a
7 list of prior art they contend individually or in combination invalidates the patents at issue.
8 Defendants shall jointly serve one set of initial invalidity contentions on Plaintiff in accordance with
9 the format set forth in the local rules. The contentions shall be directed at the claims Plaintiff selects
10 for its infringement contentions. Defendants' production of information pursuant to Local Rule
11 3.4(a), setting forth the technical specifications and other information for their accused system is
12 limited to the system identified in Plaintiff's initial infringement contentions. Defendants' contentions
13 shall include all, if any, prior art they contend invalidates a claim based on anticipation. Defendants
14 shall include no more than five separate prior art combinations they contend invalidate based on
15 obviousness. For the latter purpose, Defendants may assert additional prior art references or
16 combinations at this time only with leave of Court.

17 5. Defendants may assert additional invalidity contentions following issuance of the claim
18 construction order as provided in Patent L.R. 3.6(b).

19 6. Counsel for all parties shall meet and confer and select no more than ten (10) claim terms or
20 phrases from each patent for construction.

21 7. On or before **April 21, 2014**, the parties shall exchange preliminary claim constructions
22 pursuant to Patent L.R. 4.1(a) and identify extrinsic evidence as required by Patent L.R. 4.1(b). On
23 or before **May 12, 2014**, the parties shall exchange responsive claim constructions pursuant to Patent
24 L.R. 4.1(c) and identify extrinsic evidence as required by Patent L.R. 4.1(d). In the interests of
25 efficiency and reducing the cost of litigation, Defendants are encouraged to provide an omnibus
26 preliminary claim construction and an omnibus response to Plaintiff.

27 8. On or before **July 7, 2014**, the parties shall complete and file a joint claim construction chart,
28 joint claim construction worksheet, and joint hearing statement pursuant to Patent L.R. 4.2.

1 9. All discovery intended for use in the claim construction hearing must be completed no later
2 than **August 18, 2014**. *See* Patent L.R. 4.3.

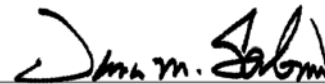
3 10. Defendants shall file one omnibus claim construction brief and response. To the extent any
4 Defendant wishes to present an argument specific to its position, it may do so in a supplemental brief
5 or response not to exceed five (5) pages. No later than **September 22, 2014**, the parties shall
6 simultaneously file their opening claim construction briefs. *See* Patent L.R. 4.4(a). No later than
7 **October 6, 2014**, the parties shall simultaneously file their responsive claim construction briefs. *See*
8 Patent L.R. 4.4(b). Each side's opening and responsive brief shall cover all the claim terms sought
9 to be construed and shall not exceed 35 pages in length.

10 11. On **October 9, 2014**, at **1:30 p.m.** the Court will hold a joint telephonic conference to discuss
11 the parties' intended presentations at the claim construction hearing, including any tutorial and
12 testimony.

13 12. The claim construction hearing will be held on **November 3, 2014**, at **9:00 a.m.** *See* Patent
14 L.R. 4.5. The Court shall hold a joint case management conference at the end of the claim
15 construction hearing. Counsel shall come prepared to discuss trial dates and case management dates
16 leading up to trial.

17 **IT IS SO ORDERED.**

18 DATED: October 10, 2013

19 

20 HON. DANA M. SABRAW
21 United States District Judge