

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

AMS, LLC,

Plaintiff,

v.

MUZZY, LLC,

Defendant.

OPINION AND ORDER

18-cv-583-wmc

On July 25, 2018, AMS, LLC, filed suit, alleging that Muzzy, LLC, was infringing two of its patents: (1) U.S. Patent 6,517,453 (the “’453 patent”); and (2) U.S. Patent 9,146,085 (the “’085 patent”). (*See generally* Compl. (dkt. #1).) At the end of March 2019, the court granted defendant’s motion to dismiss because conspicuously absent from plaintiff’s complaint were allegations that: (1) Muzzy’s Bottle Slide contained “a pad” as required by the sole, allegedly infringed claim (Claim 14) of the ’453 patent; and (2) Muzzy’s Iron Barb had an eye portion extending at “an offset from a line of radius of a center of the hole” as required by the sole, allegedly infringed claim (Claim 1) of the ’085 patent. (Mot. to Dismiss Op. & Order (dkt. #15) 2-5.) However, the court also granted plaintiff leave to file an amended complaint, which it did on April 12, 2009. (*Id.* at 6; Am. Compl. (dkt. #16).)

In the interim, consistent with the original pretrial conference order, plaintiff also served infringement contentions, identifying eighteen, additional claims in the patents in dispute that have been infringed by defendant’s products. (*See* AMS’s Infringement Contentions (dkt. #24-1) 2-3 (identifying claims 2, 3, 7, 8, 9, 12, 13, and 14 of the ’085 patent and claims 3, 6, 7, 8, 9, 13, 16, 26, 27, and 28 of the ’453 patent).) Unsurprisingly,

defendant moved to strike the eighteen, previously undisclosed claims.¹ (Mot. to Strike (dkt. #25) 1.)

OPINION

In support of its motion to strike, defendant argues that “[i]f a conspicuous absence of an element is a deficiency, the conspicuous absence of eighteen (18) new patent claims is, a fortiori, a deficiency that warrants these claims be stricken from the Infringement Contentions and dismissed from the case,” because “[i]nfringement contentions cannot be used to avoid the pleading requirements under *Iqbal* and *Twombly*.” (Mot. to Strike Br.

¹ In the alternative, defendant asked that the court extend the dates in the preliminary conference order. (Mot. Strike (dkt. #25) 1.) Regardless, the court re-set the case’s schedule after defendant’s motion came under advisement as follows:

	Original Deadline	Revised Deadline
Preliminary Disclosure of Infringement Contentions	April 1, 2019	July 22, 2019
Preliminary Disclosure of Invalidity and Unenforceability Contentions	May 3, 2019	August 23, 2019
Claims Construction Motions	May 31, 2019	September 20, 2019
Claims Construction Response Brief	June 14, 2019	October 4, 2019
Dispositive Motions	September 13, 2019	January 17, 2020
Settlement Letters	December 20, 2019	May 1, 2020
Motions in Limine	January 31, 2020	May 15, 2020
Motions in Limine Response	February 28, 2020	June 12, 2020
Final Pretrial Conference	March 17, 2020	June 23, 2020
Jury Trial	March 30, 2020	July 13, 2020

(Compare Scheduling Order (dkt. #11) with Am. Scheduling Order (dkt. #32).) Arguably, defendant’s entire motion was mooted by the amended scheduling order, however the court recognizes that the parties would greatly benefit from its guidance with regard to the viability of the additional asserted patent claims.

(dkt. #23) 5, 10.) Defendant further argues that permitting plaintiff to add eighteen new claims some ten months into the litigation “does not, and cannot, constitute fair notice,” given that defendant is “left with only a month and two weeks to conduct a prior art search” and two months to prepare for its expert deadline. (*Id.* at 11, 16.) In response, plaintiff argues that parties are “not expected to provide final identification of infringement and invalidity contentions at the outset of the case”; otherwise, “what is the point of infringement contentions? They would be completely redundant of the complaint.”² (Opp’n (dkt. #26) 5.) Plaintiff adds that defendant Muzzy was not prejudiced because plaintiff disclosed its infringement contentions consistent with the deadline in the pretrial conference order, which was designed to permit Muzzy an opportunity to take discovery and craft its defense. (*Id.* at 8.) Alternatively, plaintiff seeks leave to file an amended complaint to assert infringement of the claims identified in its infringement contentions. (*Id.* at 11.)

The original pretrial conference order required plaintiff to “identify each claim in each patent being asserted against each accused device” by April 1, 2019; while defendant was required to “identify each piece of prior art on which it will rely to show the invalidity of each asserted patent, and the basis for any other allegation of invalidity or unenforceability” by May 3, 2019. (Scheduling Order (dkt. #11) 2-3.) The court explained that these “core substantive contentions . . . will be treated as elements of

² Plaintiff also argues that Rule 12(f) is only applicable to “pleadings” and that defendant’s motion is untimely under Rule 12(f). (Opp’n (dkt. #26) 2-3.) While plaintiff is technically correct, Rule 12(f) is not the only avenue through which a party may move to strike. *See* Fed. R. Civ. P. 7(b) (motions must “state the relief sought” and the grounds therefor); Fed. R. Civ. P. 37(b)(2)(A)(iii) (permitting a court to strike pleadings as a sanction).

pleading,” but warned that it “expect[ed] the parties to commit to their core substantive contentions early in the case.” (*Id.* at 2.) Likewise, the court added that it “will be increasingly reluctant to allow amendments as the deadline for expert disclosures approaches.” (*Id.*) Defendant was also “strongly cautioned to conduct its prior art search with special diligence and to . . . amend its invalidity contentions as promptly as possible.” (*Id.* at 3.)

While the pretrial conference order does not include a similar “strong[] caution[]” for plaintiff regarding its infringement contentions, plaintiff’s failure to identify eighteen claims in its complaint is especially troubling in light of this case’s procedural posture. Indeed, just two days before plaintiff served its expansive infringement contentions, the court had granted defendant’s motion to dismiss because of the conspicuous absence of certain claim elements from plaintiff’s infringement allegations in the original complaint, giving plaintiff two weeks to replead. Plaintiff has offered no excuse for its inexplicable failure to seek leave to expand its complaint at that point.

Of course, even that would not have addressed defendant’s concern about having insufficient time to conduct its prior art search. Fortunately, most, if not all of that prejudice has been removed by the court’s June 14, 2019, order resetting the pretrial schedule. (Am. Scheduling Order (dkt. #32).) Indeed, the amended scheduling order set July 22, 2019, as the new deadline for plaintiff’s infringement contentions, giving defendant three and a half months since the original April disclosure to conduct its prior art search. Obviously, plaintiff will *not* be permitted to expand its infringement contentions beyond the twenty, expressly identified claims disclosed on April 1, 2019, but may have

fourteen days to file a second amended complaint identifying the basis for each of these claims. Moreover, any further attempts by plaintiff to expand or complicate its claims will not be given the benefit of the doubt again.

ORDER

IT IS ORDERED that:

- 1) Defendant's motion to strike (dkt. #25) is DENIED.
- 2) Plaintiff may have fourteen days to file a second amended complaint to incorporate the infringement contentions identified but not already included in the operative complaint. No further amendments to the complaint will be permitted absent significant good cause shown.

Entered this 12th day of July, 2019.

BY THE COURT:

/s/

WILLIAM M. CONLEY
District Judge