



goes on to list what constitutes good cause, including, for example, learning of new information that could not have been previously known through reasonable diligence, (*id.* at § 2(c)(i)), and adoption of an adverse claim construction by the Court. (*Id.* at § 2(c)(ii).)

An excerpt of the Scheduling Order is shown below:

(ii) If Defendant’s claim construction proposal as to a particular term or phrase is not adopted by the Court, or the Court issues a claim construction different from either party’s proposal, Defendant may request permission to amend its contentions, only related to that particular term/phrase. Such requests must be made to the magistrate judge no later than **14 days** after the Court’s claim construction order.

(*Id.*)

Tennant understood this language as allowing the parties to amend their contentions following an adverse claim construction. (*E.g.*, Dkt. 265 at 1; Declaration of Cara S. Donels (“Donels Decl.”), Exhibit 1 at 86:17-21, 95:7-11.) Tennant acted according to this understanding. For example, Tennant’s November 27, 2020 initial invalidity contentions indicated that “Tennant reserves the right to supplement or amend these Prior Art Charts as . . . rulings are made by the Court, such as the Court’s Claim Construction Order.” (Dkt. 268-1, Exhibit A at 1-2.) Tennant’s February 11, 2021 supplement contained similar language. (Dkt. 268-1, Exhibit B at 1-2.)

II. CLAIM CONSTRUCTION

During claim construction briefing, OWT acknowledged that its proposed construction of the “flowing water” terms was intended to avoid the Wikey reference. (*See*

Dkt. 78 at 28-29.) Wikey is a prior art patent that was not considered during prosecution of the asserted patents and is one of the primary references in the instituted IPR. The Wikey reference discloses an emitter that is placed in an aquarium. The electrolysis process causes water to flow through the emitter. (*See* Donels Decl., Exhibit 1 at 91:12-22.)

In its claim construction brief, Tennant argued that OWT's construction of the "flowing water" terms would create invalidity issues because it excludes disclosed embodiments and contradicts the Examiner's reasons for allowing the patent claims. (*See* Dkt. 76 at 17-19, Dkt. 143 at 12-14.)

During the claim construction hearing, Tennant raised the need to supplement contentions in the event of an adverse ruling, which OWT acknowledged. (Dkt 159 at 115:3-11 ("If Mr. Steinert thinks that the patents are invalid under 112 under a construction, the Court can adopt those constructions and deal with the 112 issue then.")). OWT also admitted during the claim construction hearing that, "to the extent [OWT] lose[s] on [its construction of the flowing water term], that may change some analysis on some issues, *but that's the point.*" (Dkt. 159 at 58:7-9 (emphasis added).)

On August 18, 2021, the Court issued a Claim Construction Order adopting OWT's proposed construction of the "flowing water" terms. (*See* Dkt. 162 at 27-30.) Specifically, the Court held that the "flowing water" terms require movement of water through the electrolysis emitter by means other than electrolysis. (Dkt. 162 at 3.)

The Court held a hearing on Tennant’s Motion to Supplement on October 6, 2021. During the hearing, OWT noted that, while the section of the Scheduling Order that states a party may move to supplement contentions after an adverse claim construction is located under the Infringement Contentions heading, there is no reason to have different rules for infringement and invalidity contentions. (Donels Decl., Exhibit 1 at 101:7-102:8.) The Magistrate Judge noted that her Scheduling Order has since been updated to identify a *Markman* order as a “potential . . . trigger for modifying not only infringement contentions, but also invalidity contentions,” and that she “[did not] know of a good reason to distinguish between the two” in the form used by the parties in this litigation. (*Id.* at 34:20-35:8.)

During the hearing, The Magistrate Judge asked OWT to describe the prejudice it would suffer if Tennant’s motion was granted. (*Id.* at 100:4-101:6.) OWT was unable to offer a cognizable basis of prejudice other than delay. (*Id.*)

On October 25, 2021, the Court denied Tennant’s motion to supplement as to the Wikey reference in a brief oral ruling. The ruling appears below in its entirety.

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