

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

INVENSYS SYSTEMS, INC.,

Plaintiff,

vs.

EMERSON ELECTRIC CO. and
MICRO MOTION INC., USA,

Defendants.

and

MICRO MOTION INC., USA,

Counterclaim-Plaintiff,

vs.

INVENSYS SYSTEMS, INC.,

Counterclaim-Defendant.

Case No. 6:12-cv-00799-LED

**MICRO MOTION, INC.'S AND EMERSON ELECTRIC CO.'S
MOTION FOR LEAVE TO SUPPLEMENT INVALIDITY CONTENTIONS**

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I. INTRODUCTION

Pursuant to P.R. 3-6(b), Defendants Micro Motion, Inc. and Emerson Electric Co. request that the Court enter an order permitting Defendants to supplement their invalidity contentions to reflect new evidence of a digital prototype Coriolis flow meter developed by Howard Derby (“Digital Prototype”) that anticipates most of the asserted patent claims and renders the remainder of the asserted claims obvious.

II. BACKGROUND

Plaintiff Invensys Systems, Inc. initiated this lawsuit by filing an original complaint on October 22, 2012 asserting infringement of four patents. (Dkt. No. 1.) On January 31, 2013, Invensys filed its amended complaint alleging infringement of a total of seven patents. (Dkt. No. 25.) On July 17, 2013, Invensys served its P.R. 3-1 infringement contentions as to Defendants. On September 13, 2013, Defendants served their P.R. 3-3 invalidity contentions.

Since the inception of this case, Defendants’ counsel has diligently investigated the prior art that relates to the Invensys patents-in-suit, but did not uncover the evidence of Mr. Derby’s development of the Digital Prototype until May, 2014. As described below, Defendants’ counsel discovered evidence of conception and possibly of reduction to practice prior to November 1997 of a digital prototype controller that might have used digital signal processing to generate a drive signal on April 22, 2014, while preparing a Micro Motion employee for an upcoming 30(b)(6) deposition. (*See* Declaration of Jeffrey N. Costakos (“Costakos Decl.”) ¶ 4.) In the weeks following April 22, counsel interviewed another Micro Motion engineer and a former Micro Motion consultant, which led to the discovery of information relating to the conception, reduction to practice and features of the Digital Prototype, including approximately 500 pages of relevant documents. Defendants promptly advised plaintiff’s counsel of these new discoveries and produced the newly-discovered relevant documents on May 20 and May 23. On May 24,

Defendants provided plaintiff's counsel with a detailed supplement to their invalidity contentions addressing the Digital Prototype. (Declaration of Richard S. Florsheim ("Florsheim Decl.") ¶ 7, Ex. C (Defendants' proposed supplementation to invalidity contentions).) On May 28, 2014, counsel for Defendants met-and-conferred with plaintiff's counsel to discuss whether plaintiff would consent to the Court's granting of Defendants' motion for leave to supplement their invalidity contentions, to which Plaintiff did not consent. (*Id.* ¶ 8.) Defendants now seek leave pursuant to P.R. 3-6(b) to supplement their invalidity contentions to incorporate the important new evidence and basis of invalidity.

As further explained below, the Digital Prototype is highly important information because it anticipates most of the asserted claims and renders the remainder obvious. Invensys will not be prejudiced if Defendants are permitted to supplement their invalidity contentions to reflect the Digital Prototype prior art because there is ample time remaining before the close of fact discovery for plaintiff to depose the two witnesses with firsthand knowledge of the conception and reduction to practice of the Digital Prototype. Indeed, Invensys had not sought to take any individual depositions prior to the date of the meet-and-confer, and, as of the date of filing of this motion, had not taken a single substantive deposition. Invensys has, in fact, noticed the depositions of those two witnesses, setting one to take place on July 8 and asking Defendants to arrange a date for the other. (Florsheim Decl. ¶ 9.) Moreover, Defendants would be willing to grant Invensys a short extension of the discovery deadline, if necessary, to take those two depositions as to the Digital Prototype.

III. LEGAL STANDARD

A party must obtain "the Court's leave on a good cause showing to modify the Patent Rule's deadlines." *Alt v. Medtronic, Inc.*, No. 2:04-CV-370, 2006 U.S. Dist. LEXIS 4435, at *4-5 (E.D. Tex. Feb. 1, 2006) (citing *STMicroelectronics, Inc. v. Motorola, Inc.*, 307 F. Supp. 2d

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