

No. _____

**In the
Supreme Court of the United States**

MUSHKIN, INC.

Petitioner,

v.

ANZA TECHNOLOGY, INC.

Respondent.

*On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit*

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Fed. R. Civ. P. 15(c)(1)(B) states that an amended pleading will “relate back” to the date of an original pleading if the amended pleading “asserts a claim or defense that arose out of the conduct, transaction or occurrence set out – or attempted to be set out – in the original pleading.”

This Petition should be granted to address the following questions:

1. Whether the appropriate standard of review for a “relation back” determination under Fed. R. Civ. P. 15(c) is: (1) the *de novo* standard of review applied by the First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth and Tenth Circuit Courts of Appeal, (2) the abuse of discretion standard of review applied by the Eighth, Eleventh, and District of Columbia Circuit Court of Appeals, with Eighth and Eleventh Circuits applying a clear error standard of review for factual findings, (3) the *de novo* standard of review applied by the Federal Circuit Court of Appeals in the present case, with fact findings reviewed for clear error, or, (4) the clear error standard of review supported by this Court’s recent precedent, *U.S. Bank v. Village at Lakeridge*, for appellate review of case-specific factual determinations made by a district court?
2. What is the proper test for a “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B) in light of the 1991 and 1993 Amendment to Rule 15(c), which eliminated the notice requirements from the

“conduct, transaction, or occurrence” provision of Fed. R. Civ. P. 15(c)?

3. Whether the court of appeals in the present case erred in its “relation back” analysis under Fed. R. Civ. P. 15(c)(1)(B) by establishing, and relying on, a “liberal notice-based” interpretation of the “conduct, transaction, or occurrence” provision of Fed. R. Civ. P. 15(c)(1)(B)?

4. Whether claims withdrawn from the scope of the original proceedings can be re-asserted later in an amended pleading using the “relation back” doctrine under Fed. R. Civ. P. 15(c)(1)(B) in the absence of a retraction of that withdrawn position?

PARTIES TO THE PROCEEDINGS
(Rule 14(b)(i))

A list of all parties to the proceedings in the court whose judgment is the subject of this Petition is as follows:

Defendant-Petitioner: Mushkin, Inc. d/b/a Enhanced Network Systems, Inc. Mushkin, Inc.

Plaintiff-Respondent: Anza Technology, Inc. Anza Technology, Inc.

CORPORATE DISCLOSURE STATEMENT
(Rule 14(b)(ii))

Pursuant to this Court's Rule 29.6, Petitioner Mushkin Inc. states that it has no parent corporation and that no publicly held company owns 10% or more of its stock.

RELATED PROCEEDINGS
(Rule 14(b)(iii))

As set forth in this Court's Rule 14(b)(iii), there are no proceedings in state, federal trial or appellate courts, including proceedings in this Court, that are directly related to the case in this Court.

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PETITION FOR WRIT OF CERTIORARI

Mushkin, Inc. respectfully petitions for a writ of certiorari to review the Opinion and Judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The Opinion and Order of the Court of Appeals (App. 1a-27a) is reported as *Anza Technology, Inc. v. Mushkin dba Enhanced Network Systems, Inc.*, 934 F.3d 1359 (Fed. Cir. 2019).

The Opinion and Order of the District Court for the District of Colorado (Denver Div.) (App. 28a-42a) is reported as *Anza Technology, Inc. v. Mushkin dba Enhanced Network Systems, Inc.*, 2018 U.S. Dist. LEXIS 145761; 2018 WL 4095113 (D. Colo. Aug. 28, 2018).

JURISDICTION

The Opinion and Judgment of the Court of Appeals was entered on August 16, 2019. This Court has jurisdiction under 28 U.S.C. §1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS

Fed. R. Civ. P. 15(c)(1)(A)-(C) reads as follows:

(1) *When an Amendment Relates Back.* An amendment to a pleading relates back to the date of the original pleading when:

(A) the law that provides the applicable statute of limitations allows relation back;

(B) the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading; or

(C) the amendment changes the party or the naming of the party against whom a claim is asserted, if Rule 15(c)(1)(B) is satisfied and if, within the period provided by Rule 4(m) for serving the summons and complaint, the party to be brought in by amendment:

(i) received such notice of the action that it will not be prejudiced in defending on the merits; and

(ii) knew or should have known that the action would have been brought against it, but for a mistake concerning the proper party's identity.

35 U.S.C. §286 states:

Except as otherwise provided by law,
no recovery shall be had for any
infringement committed more than six
years prior to the filing of the complaint
or counterclaim for infringement in the
action.

◆

STATEMENT OF THE CASE

The trial court dismissed a Second Amended Complaint finding that it did not “relate back” to the original and First Amended Complaint under Fed. R. Civ. P. 15(c)(1)(B). The trial court found that the claims in the Second Amended Complaint were time-barred under the patent statute of limitations, 35 U.S.C. §286.

The trial court dismissed the Second Amended Complaint because: (1) the two patents asserted for the first time in the Second Amended Complaint expanded the scope of the claimed subject matter in the case, (2) the statutory basis for patent infringement asserted in the Second Amended Complaint had been previously withdrawn from the original proceedings by Plaintiff’s infringement contentions served on March 23, 2018, and (3) two new products were added to the new infringement claims, which were not the subject of the original proceedings.

Under Fed. R. Civ. P. 15(c)(1)(B), the district court determined that the filing date for the Second Amended Complaint did not “relate back” to the original filing date of the original complaint. The

district court dismissed the Second Amended Complaint because the statute of limitations provisions set forth in 35 U.S.C. §286 precluded all damages recovery for the patent infringement claims set forth therein.

Based on a *de novo* standard of review (with findings of fact reviewed for clear error), the Court of Appeals for the Federal Circuit adopted a “liberal notice-based” test for the relation back determination under Fed. R. Civ. P. 15(c)(1)(B). Based on that “notice-based” test, the Court of Appeals in the present case reversed the district court’s decision finding the Second Amended Complaint “related back” to the original complaint with respect to products that were previously identified in that pleading. With respect to the two new products added for the first time in the Second Amended Complaint, the Court of Appeals for the Federal Circuit vacated and remanded the proceedings to the district court to determine if there was “relation back” based on the “notice-based” “relation back” test set forth in the appellate opinion.



REASONS FOR GRANTING THE PETITION

I. Certiorari Should Be Granted to Resolve a Split Among the Circuits Regarding the Correct Standard of Review for “Relation Back” Determinations Under Fed. R. Civ. P. 15(c), Which Is an Important Federal Question Touching On Many Different Cases

Certiorari should be granted to resolve a split in the various circuits regarding the appropriate standard of review to apply to “relation back” determinations under Fed. R. Civ. P. 15(c)(1). This Court should grant certiorari in order to bring all the circuit courts of appeal into a uniform standard of review, either based on one of the circuit courts of appeal or, as discussed below, in line with this Court’s recent *U.S. Bank v. Village at Lakeridge* decision.¹ Because “relation back” determinations under Rule 15(c) impact a wide variety of cases adjudicated in the federal court system, this case presents an important federal question that needs to be resolved by this Court.

A. This Case Presents an Ideal Vehicle to Resolve the Various Circuit Splits For the Proper Standard of Review for “Relation Back” Determinations

The circuit courts of appeal are split on the proper standard of review for “relation back”

¹ *U.S. Bank v. Vill. at Lakeridge*, 138 S. Ct. 960, 200 L. Ed. 218 (2018).

determination under Fed. R. Civ. P. 15(c), with the circuit courts of appeal applying the following standards of review: (1) the First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth and Tenth Circuit Courts of Appeal apply the *de novo* standard of review, (2) the Federal Circuit Court of Appeals in the present case applies the *de novo* standard of review, and reviews factual findings reviewed for clear error; and (3) the Eighth, Eleventh and the District of Columbia Circuit Courts of Appeal apply the abuse of discretion standard with Eighth and Eleventh Circuits applying a clear error standard of review for factual findings. This splintered approach for reviewing “relation back” determinations among the various circuits should be reconciled, and resolved, by this Court so that one uniform standard of appellate review can be applied to “relation back” determinations by the circuit courts of appeal.

1. The First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth and Tenth Circuit Courts of Appeal apply a *de novo* standard of review to “relation back” determinations

The majority of circuits, including the First, Second, Third, Fourth, Fifth, Sixth, Seventh, Ninth and Tenth Circuit Courts of Appeal, apply the *de novo* standard of review for “relation back” determinations under Fed. R. Civ. P. 15(c).² As noted in the Federal

² *Young v. Lepone*, 305 F.3d 1, 14 (1st Cir. 2002); *Slayton v. Am. Express Co.*, 460 F.3d 215, 227–28 (2d Cir. 2006); *Glover v. FDIC*, 698 F.3d 139, 144 (3d Cir. 2012); *Robinson v. Clipse*, 602 F.3d 605, 607 (4th Cir.

Circuit’s opinion in the present case, the appellate decisions from these circuits provide little, or no, rationale for the application of the *de novo* standard of review in a “relation back” determination. *Anza v. Mushkin*, 934 F. 3d 1359, 1366-68 (Fed. Cir. 2019), App. 14a.

The rationale, when expressed, underlying application of the *de novo* standard of review for “relation back” determinations under Fed. R. Civ. P. 15(c) is that the reviewing court addresses a mixed question of the legal standard of Rule 15(c) as applied “to a given set of facts,” which is “a task we are no less suited to perform than the district court.” *See Anza v. Mushkin*, 934 F.3d 1359, 1367 (Fed. Cir. 2019), App. 14a (citing *Miller*, 231 F.3d at 247; *accord Percy*, 841 F.2d at 978; *Lundy v. Adamar of N.J., Inc.*, 34 F.3d 1173, 1177 (3d Cir. 1994)).

While the majority of circuit courts of appeal adopt a *de novo* standard of review to the Rule 15(c)(1) determination, the cited decisions for these circuits do not distinguish the standard of review applied to the district court’s factual findings from the standard of review applied to the ultimate “relation back” determination under Fed. R. Civ. P. 15. In the absence of any indication to the contrary, these circuit courts of appeal appear to review the underlying factual findings of the district court under the same *de novo*

2010); *Sanders-Burns v. City of Plano*, 594 F. 3d 366, 372 (5th Cir. 2010); *Miller v. Am. Heavy Lift Shipping*, 231 F.3d 242, 246–47 (6th Cir. 2000); *Delgado-Brunet v. Clark*, 93 F.3d 339, 342 (7th Cir. 1996); *Percy v. S.F. Gen. Hosp.*, 841 F.2d 975, 978 (9th Cir. 1988); *Slade v. U.S. Postal Serv.*, 875 F.2d 814, 815 (10th Cir. 1989).

standard applied to the review of the Rule 15 “relation back” determination.

2. The Second Circuit Court of Appeals previously applied the abuse of discretion standard of review to “relation back” determinations before overruling its own precedent in favor of a *de novo* standard of review

Prior to 2006, the Second Circuit Court of Appeals applied the abuse of discretion standard of review to district court Fed. R. Civ. P. 15 “relation back” determinations. *Slayton v. Am. Express Co.*, 460 F.3d 215, 227–28 (2d Cir. 2006). As noted by the *Slayton* court, the pre-2006 Second Circuit decisions rarely identified the standard of appellate review for “relation back” determinations. *Id.* at 226.

But, when the standard of review was identified in prior Second Circuit decisions, the abuse of discretion standard of review was applied to the “relation back” determination. *Id.* (citing *Tho Dinh Tran v. Alphonse Hotel Corp.*, 281 F.3d 23, 35–36 (2d Cir. 2002) (“We review a district court’s decision that an amendment ‘relates back’ for an abuse of discretion.”); *Nettis v. Levitt*, 241 F.3d 186, 193 (2d Cir. 2001) (“We review for abuse of discretion a district court’s decision as to whether [the Rule 15(c)(2)] standard has been met.”); *Wilson v. Fairchild Republic Co., Inc.*, 143 F.3d 733, 738 (2d Cir. 1998) (Whether a new claim in amended pleading relates back to an original complaint “lies in the district court’s discretion . . . and it is for abuse of that discretion that we review the district court’s decision.”)).

In *Slayton*, the Second Circuit overruled its precedent and held the *de novo* standard of review is more appropriate for “relation back” determinations stating that “the relation back issue is more analogous to a dismissal on the pleadings than a balancing of factors involving the conduct of a lawsuit.” *Slayton*, 460 F.3d at 227–28, n. 13. The Slayton court adopted the *de novo* standard of review because that is the same standard of review applied by appellate courts when reviewing dismissals on the pleadings. *Id.*

3. The Eighth, Eleventh and the District of Columbia Circuit Courts of Appeal apply the abuse of discretion standard with Eighth and Eleventh Circuits applying a clear error standard of review for factual findings

In *Powers v. Graff*, 148 F.3d 1223, 1226 (11th Cir. 1998), the Eleventh Circuit Court of Appeals held that the “relation back” determination under Rule 15(c) should be reviewed under an abuse of discretion standard. Likewise, the Eighth Circuit Court of Appeals and the District of Columbia Circuit Court of Appeals also apply the abuse of discretion standard of review for “relation back” determinations under Fed. R. Civ. P. 15(c). *KBHS Broad Co. v. Sanders (In re Bozeman)*, 226 B.R. 627, 630 (B.A.P. 8th Cir. 1998); *Ransom v. Shulkin*, 719 Fed. Appx. 8 (D.C. Cir. 2018).

The Eleventh and Eighth Circuits found that findings of fact made by the district court that were necessary for application of Rule 15 would be reviewed for clear error. *Powers, id.* at 1226, *KBHS Broad, id.* at 631. The abuse of discretion standard of review is consistent with pre-2006 Second Circuit precedent

before the *Slayton* decision, and a review of factual findings for clear error is consistent with the requirements of Fed. R. Civ. P. 52(a). *See, e.g., Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015) (“But, to overturn the judge’s resolution of an underlying factual dispute, the Court of Appeals must find that the judge, in respect to those factual findings, has made a clear error.”).

4. The Federal Circuit Court of Appeals, in the present case, applies a *de novo* standard of review, and reviews the district court’s factual findings for clear error.

In the present case, the Federal Circuit Court of Appeals applied a *de novo* standard of review for the “relation back” determinations under Fed. R. Civ. P. 15(c), and reviewed the district court’s findings of fact under a clear error standard of review. The Federal Circuit opinion in the present case notes that the other circuits provide little, or no, rationale for the application of a *de novo* standard of review in “relation back” determinations. *Anza v. Mushkin*, 934 F.3d 1359, 1366-1368 (Fed. Cir. 2019), App. 14a. The appeals court in the present case indicated that the rationale, when expressed by other courts, for adopting a *de novo* standard of review in “relation back” determinations was that it is “a task we are no less suited to perform than the district court.” *See Anza v. Mushkin*, 934 F.3d 1359, 1367 (Fed. Cir. 2019), App. 14a, *citing Miller*, 231 F.3d at 247; *accord Percy*, 841 F.2d at 978; *Lundy v. Adamar of N.J., Inc.*, 34 F.3d 1173, 1177 (3d Cir. 1994).

Based on that review, the appeals court in the present case applied the *de novo* standard of review because adopting “an abuse of discretion standard would be contrary to the law of most of the other circuits, which have adopted a *de novo* standard when reviewing decisions regarding whether an amended pleading relates back to the date of the original pleading.” *Anza v. Mushkin*, 934 F.3d 1359, 1367 (Fed. Cir. 2019), App. 13a-14a (citations omitted).

The Federal Circuit acknowledged that in “some instances, however, factual issues may need to be addressed as part of the district court’s analysis of the relation back issue,” and “[w]ith respect to any disputed facts that are material to the relation back issue, we are not as well situated as the district court to make the appropriate findings.” *Id.* The Federal Circuit in the present case held that such factual findings should be reviewed for clear error, which diverges from the *de novo* standard of review applied by a majority of other circuits.

B. This Court Recently Decided the Clear Error Standard of Review Is the Most Appropriate Standard of Review for Case-Specific Factual Determinations, as set forth in the *U.S. Bank v. Village at Lakeridge* Decision

Under Fed. R. Civ. P. 15(c)(1)(B), the “relation back” determination asks whether: “(B) the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading. . .” Fed. R. Civ. P. 15(c)(1)(B). While this analysis may be characterized as a mixed question of law and fact, the

“relation back” determination is primarily a factual analysis that compares conduct, transactions, and occurrences described in the pleadings, as well as a review of parties’ actions in the case. This type of determination would immerse the district court in “case-specific factual” analysis, which this Court has found to primarily involve factual work, as opposed to legal work. *See U.S. Bank v. Village at Lakeridge*, 138 S. Ct. 960, 200 L.Ed.2d 218, 222, 227 n. 4, 228 (2018).

This Court’s recent decision in *U.S. Bank v. Village at Lakeridge* established that the clear error standard of review applies to district court decisions that primarily involve factual work, as opposed to the other standards of review applied to legal work conducted by the district court. *Id.* In that case, the bankruptcy court concluded that a person, Mr. Rabkin, was not an “insider” to a particular transaction based on several findings of fact. *Id.* That designation supported the bankruptcy court’s determinations. The Ninth Circuit affirmed the bankruptcy court’s rulings finding that a district court’s findings on the “insider” determination were entitled to a clear error standard of appellate review. *Id.* On certiorari, the Supreme Court, in a unanimous opinion, affirmed the Ninth Circuit’s decision holding that clear error was the appropriate standard of review for the bankruptcy court’s “insider” determination. *Id.*

In *U.S. Bank*, this Court discussed the difference between findings of law—which are reviewed *de novo*—and findings of fact—which are reviewed for clear error. *Id.* at 222-23, 226-229. This Court found that courts often review mixed questions of law and fact under the *de novo* standard of review when the underlying determination “require[s] courts to expound on the law, particularly by amplifying or elaborating on a broad legal standard.” *Id.* This court then explained that the clearly erroneous

standard of appellate review applies to mixed questions that “immerse courts in case-specific factual issues.” *Id.*

The *U.S. Bank* Court concluded that “the standard of review for a mixed question all depends on whether answering it entails primarily legal or factual work.” *Id.* While this Court’s decision conceded that the determination of whether Rabkin met the legal test for an “insider” was a “mixed” question of law and fact, this Court held that the basic question to be determined was whether, “[g]iven all the basic facts found, Rabkin’s purchase of MBP’s claim [was] conducted as if the two were strangers to each other.” *Id.* Because “[t]hat is about as factual sounding as any mixed question gets,” this Court held that the clear error standard applied for appellate review of the bankruptcy court’s determination. *Id.*

Similar to the case-specific facts that would need to be reviewed in an “insider” bankruptcy determination in the *U.S. Bank* case, a Fed. R. Civ. P. 15(c) “relation back” determination also requires the district court to “immerse” itself in “case-specific factual issues.” The “relation back” analysis set forth in Fed. R. Civ. P. 15(c)(1)(B) compares conduct, transactions, and occurrences described in the pleadings, as well as a review of parties’ actions in the case, which appear to be purely factual matters.

Focusing on whether the original claim gave adequate “notice”³ to Mushkin of the nature of the allegations in the amended pleading, the Federal Circuit

³ The appropriateness of the Federal Circuit’s “liberal notice-based” test for “relation back” determinations under Fed. R. Civ. P. 15(c)(1)(B) is addressed more fully below. While the Petitioner questions the ultimate question posed by this “liberal notice-based” test, the factors considered in the Fed. R. Civ. P. 15(c)(1)(B) analysis appear to be purely factual in nature.

in the present case admitted that factual issues should be considered in the Fed. R. Civ. P. Rule 15(c)(1)(B) determination, as follows: “we will consider the overlap of parties, the overlap in the accused products, the underlying science and technology, time periods, and any additional factors that might suggest a commonality or lack of commonality between the two sets of claims.” *Anza v. Mushkin*, 934 F.3d 1359, 1369 (Fed. Cir. 2019), App. 18a-19a.

Moreover, the appeals court in the present case characterized the “relation back” analysis in factual terms as follows: “the question remains whether the general factual situation or the aggregate of operative facts underlying the original claim for relief” support the “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B). *Id.* at 1369, App. 19a. The Federal Circuit in the present case found that, based on a comparison of similar language in Fed. R. Civ. P. 13(a) and 20(a), factual matters need to be considered for “relation back” determinations, such as “the overlap of parties, products or processes, time periods, licensing and technology agreements, and product or process development and manufacture.” *Id.*

All the considerations underlying the “relation back” determination under Fed. R. Civ. P. 15(c), as found by the appeals court in the present case, are characterized in purely factual terms. *See Anza v. Mushkin*, 934 F.3d 1359, 1368-1373 (Fed. Cir. 2019), App. 19a (“general factual situation or the aggregate of operative facts underlying the original claim for relief”). As similarly found by this Court in the *U.S. Bank* decision, the “relation back” determination, based on the rule itself and characterizations of the analysis, “is about as factual sounding as any mixed question gets.”

This Court recently addressed the standard of review for another mixed question involving the legal interpretation given to a patent claim term in a patent claim construction context. *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 840-842 (2015). In *Teva*, this Court held that the patent claim construction is a legal conclusion to be reviewed under the *de novo* standard of review, with findings of fact reviewed for clear error. *Id.*

In contrast to the claim construction legal work addressed in the *Teva* decision, the “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B) is factual work that does not “require [the district] courts to expound on the law, particularly by amplifying or elaborating on a broad legal standard.” *U.S. Bank, id.* at 222-23, 226-229; see *Anza v. Mushkin*, 934 F.3d 1359, 1368-73 (Fed. Cir. 2019), App. 19a (“general factual situation or the aggregate of operative facts underlying the original claim for relief”).

For the above reasons, the standards of review applied by the circuit courts of appeals appear to be in conflict with this Court’s *U.S. Bank* decision. The touchstone for the adoption of a standard of review should not be whether an appeals court is “as well suited” as the district court to make a determination, but instead whether the kind of work being undertaken by the district court is legal work or factual work. This case is particularly well-suited for bringing all the circuit courts of appeal into a uniform standard of review, either based on one of the circuit courts of appeal or in line with the recent *U.S. Bank* decision.

C. This Case Presents an Important Federal Question that Needs To Be Resolved by this Court Because the “Relation Back” Determination Has A Significant Impact on Many Different Types of Cases

In 1986, this Court granted certiorari to consider the “relation back” determination under an earlier version of Fed. R. Civ. P. 15. *Schiavone v. Fortune*, 477 U.S. 21 (1986) (“Because of an apparent conflict among the Courts of Appeal, we grant certiorari.”). The *Schiavone* court reviewed, and interpreted the requirements, of the 1966 version of Fed. R. Civ. P. 15 in the context of a “relation back” determination. *Id.*; see also, discussion, *Jacobsen v. Osburne*, 133 F. 3d 315 (5th Cir. 1998).

As will be discussed in more detail below, this Court in *Schiavone* rejected a “liberal” interpretation of Fed. R. Civ. P. 15 by requiring a showing of all elements in the rule (e.g. common operative facts, notice, and lack of prejudice) to be present for “relation back” to be found under Fed. R. Civ. P. 15(c). *Id.*

After the *Schiavone* decision in 1986, the Federal Rules of Civil Procedure were amended in 1991 and 1993 to overrule the *Schiavone* decision. *1991 Advisory Committee Notes, Rule 15*. Since that time, Petitioner cannot find any decision from the Supreme Court that addresses the standard of review to be applied to cases applying amended Rule 15(c)(1)(B).

Issued over 30 years ago, the *Schiavone* decision appears to be the latest word from the Supreme Court on the standard of review to be applied to Rule 15 “relation back” determinations, and that decision was overruled by the 1991 and 1993 amendments to the

Federal Rules. This case, therefore, presents this Court with an ideal vehicle to address Fed. R. Civ. P. 15(c), its standards of review and the application of the rule as amended in 1991 and 1993.

“Relation back” determinations can arise in many different types of cases. That is, this case would not just have an impact on patent cases or appeals reviewed at the Federal Circuit Court of Appeals. On the contrary, this Court’s review of this case would have a broad impact on many different types of cases across the nation, such as libel, *Schiavone v. Fortune*, 477 U.S. 21 (1986) (on appeal from the Second Circuit); §1983 false arrest and excessive force claims, *Jacobsen v. Osborne*, 133 F. 3d 315 (5th Cir. 1998); patent infringement claims, *Anza v. Mushkin*, 934 F. 3d 1359 (Fed. Cir. Aug. 16, 2019); shareholder federal securities claims, *Young v. Lepone*, 305 F.3d 1, 14 (1st Cir. 2002); Fair Debt Collections Practices Act and Pennsylvania FCEUA, *Glover v. FDIC*, 698 F.3d 139, 144 (3d Cir. 2012); §1983 excessive force claims, *Robinson v. Clipse*, 602 F.3d 605, 607 (4th Cir. 2010); survival and wrongful death claims under Jones Act, *Miller v. Am. Heavy Lift Shipping*, 231 F.3d 242, 246–47 (6th Cir. 2000); Eighth Amendment violations alleged by inmate, *Delgado-Brunet v. Clark*, 93 F.3d 339, 342 (7th Cir. 1996); wrongful termination under 42 U.S.C. §§1983 and 2000, *Percy v. S.F. Gen. Hosp.*, 841 F.2d 975, 978 (9th Cir. 1988); employment claims against the U.S. Postal Services, *Slade v. U.S. Postal Serv.*, 875 F.2d 814, 815 (10th Cir. 1989); class action securities, *Slayton v. Am. Express Co.*, 460 F.3d 215, 227–28 (2d Cir. 2006); Fair Labor Standards and RICO violations, *Tho Dinh Tran v. Alphonse Hotel Corp.*, 281 F.3d 23, 35-36 (2d Cir.2002); diversity case alleging CEPA violation, *Nettis v. Levitt*, 241 F.3d 186,

193 (2d Cir. 2001); wrongful termination under 42 U.S.C. §2000, *Wilson v. Fairchild Republic Co., Inc.*, 143 F.3d 733, 738 (2d Cir. 1998); and class action securities, *Powers v. Graff*, 148 F.3d 1223, 1226 (11th Cir. 1998).

“Relation back” determinations are important issues that can arise in almost any case having amended pleadings and a statute of limitations. In those cases, if “relation back” is found, an amended pleading can avoid the applicable statute of limitations. The District Court for the District of New Jersey most succinctly stated the issue in *Collezione Europa U.S.A., Inc. v. Amini Innovation Corp.*, 2009 WL 2634648, at *4 (D. N.J. Aug. 26, 2009) as follows:

[I]f the Court were to allow amendments that are out of time to relate back that involve entirely different copyrights for entirely different products, a party could readily evade a statute of limitations by bootstrapping stale copyright claims onto ones that are fresh, thus allowing the exception to swallow the rule. Such a holding would render the statute of limitations a nullity in copyright cases.

Id. at p. 8.

Evasion of the statute of limitations through the “bootstrapping” of stale claims onto “ones that are fresh” is an important federal question that needs to be addressed by this Court. This issue is important because allowing an expansion of the “relation back” doctrine with a “liberal” test could result in “the exception” swallowing “the rule” governed by the statute of limitations, which could render “the statute

of limitations a nullity.” *See Collezione Europa U.S.A., Inc.*, 2009 U.S. Dist. LEXIS 76411, at p. 8.

The questions to be resolved by this Court in the present case are relevant to a wide spectrum of cases and would have a significant impact on the applicability of the statute of limitations in all the circuit courts of appeal. Because the present case presents important federal questions for this Court to resolve, this Court should grant this Petition for a Writ of Certiorari.

II. A “Liberal Notice-Based” Test Does Not Comport With The Elimination Of The Notice Requirements In The “Conduct, Transaction, Or Occurrence” Language In Fed. R. Civ. P. 15(C)(1)(B) Per The 1991 And 1993 Amendments To Rule 15(C)

In the present case, the appeals court reviewed a district court’s dismissal of a Second Amended Complaint under Fed. R. Civ. P. 15(c)(1)(B).⁴ Under that provision of Fed. R. Civ. P. 15(c), “relation back” is permitted if the claims in the amended pleading arise from the same “conduct, transaction or occurrence” set out in the original pleading. Fed. R.

⁴ The Second Amended Complaint filed by Plaintiff Anza Technology, Inc. did not change the name of the Defendant, Mushkin, Inc. from the original pleading, which means Fed. R. Civ. P. 15(c)(1)(C) does not apply to this case. The “relation back” determination under Fed. R. Civ. P. 15(c)(1) would be controlled, in the present case, exclusively by the analysis under Fed. R. Civ. P. 15(c)(1)(B).

Civ. P. 15(c)(1)(B); *see also*, *Anza v. Mushkin*, 934 F.3d 1359, 1365 (Fed. Cir. 2019), App. 8a.

In the absence of any Federal Circuit precedent dictating the test for the “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B), the appeals court in the present case adopted a “liberal notice-based” test for this determination. *See Anza v. Mushkin*, 934 F.3d 1359, 1368-73 (Fed. Cir. 2019), App. 15a-19a, 26a (“liberally” interpreted, “notified of litigation,” “liberal, notice-based interpretation,” “read liberally,” “gave notice,” “sufficient notice,” “gave adequate notice,” “notice-based interpretation of Rule 15(c),” background “technological overlap suggests” “original complaint gave notice,” whether new allegations “are too far afield from original complaint to put Mushkin on notice of the allegations against which it would be required to defend,” and “[t]here is no lack of notice and no substantial prejudice to Mushkin from having to defend against independent claims over a shorter period than the period set forth in the original complaint.”).

The Federal Circuit’s “liberal notice-based” test for the “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B) was summarized in *Anza v. Mushkin* as follows: “[a]t bottom, however, the question remains whether the general factual situation or the aggregate of operative facts underlying the original claim for relief gave notice to *Mushkin* of the nature of the allegations it was being called upon to answer.” *Id.* at 1369-70; App. 19a.

The adoption of a “liberal notice-based” test for “relation back” determinations under Fed. R. Civ. P. 15(c)(1)(B) is misplaced in view of the amendments to Fed. R. Civ. P. 15(c) in 1991 and 1993, which eliminated the “notice” and “prejudice” requirements

from the “conduct, transaction or occurrence” provision of Fed. R. Civ. P. 15(c)(1). By deleting the “notice” and “prejudice” requirements from the “conduct, transaction or occurrence” provision of Fed. R. Civ. P. 15(c)(1), the 1991 and 1993 amendments to Fed. R. Civ. P. 15(c) were meant to codify a more “liberal” interpretation of that rule and overrule the narrow interpretation of Rule 15(c) adopted by this Court’s *Schiavone* decision.

The appeals court in the present case did not consider the impact of the 1991 and 1993 amendments to Rule 15(c) in its analysis; and, the opinion rendered by the appeals court in the present case primarily relies on legal precedent that interpreted an older version of Rule 15(c) before the significant amendments to that rule in 1991 and 1993.

Because the “liberal notice-based” test adopted by the Federal Circuit in the present case for a “relation back” determination for Fed. R. Civ. P. 15(c)(1)(B) appears to be in error, this Court should grant Certiorari to establish the correct test for “relation back” determinations under the “conduct, transaction or occurrence” provisions of that rule. Establishing a uniform test for “relation back” determinations under Fed. R. Civ. P. 15(c)(1)(B) would greatly assist the courts in making future “relation back” determinations.

**A. This Court’s *Schiavone* Decision
Required Notice, and the Other
Factors of Rule 15(c), To Be Present
Simultaneously for “Relation Back” to
Be Found**

In 1986, this Court in *Schiavone* reviewed, and interpreted, the requirements of the 1966 version of Fed. R. Civ. P. 15(c) as it applied to “relation back” determinations. *Schiavone*, 477 U.S. 21, 32, n. 5 (1986); *see discussion, Jacobsen v. Osburne*, 133 F. 3d 315 (5th Cir. 1998). Fed. R. Civ. P. 15(c), at that time, read in in pertinent part:

Whenever the claim or defense asserted in the amended pleading arose out of the conduct, transaction, or occurrence set forth or attempted to be set forth in the original pleading, the amendment relates back to the date of the original pleading. An amendment changing the party against whom a claim is asserted relates back if the foregoing provision is satisfied and, within the period provided by law for commencing the action against him, the party to be brought in by amendment (1) has received such notice of the institution of the action that he will not be prejudiced in maintaining his defense on the merits, and (2) knew or should have known that, but for a mistake concerning the identity of the proper party, the action would have been brought against him.

Fed. R. Civ. P. 15(c).

Applying a “plain reading” of the rule at that time, the *Schiavone* Court held that Fed. R. Civ. P. 15(c) required that all elements in the rule must be met to support a relation back determination, including the same “conduct, transaction, or occurrence,” adequate “notice,” “lack of prejudice,” and “knew or should have known” that the amended action would be brought. *Schiavone*, 477 U.S. at 29 (relation back is dependent on four factors, “all of which must be satisfied”).

As discussed in *Jacobsen v. Osborne*, 133 F. 3d 315 (5th Cir. 1998), the *Schiavone* Court rejected a more “liberal” interpretation of Rule 15(c) under this 1966 version by requiring a showing of all factors, including “notice” and “lack of prejudice” together with the same “conduct, transaction or occurrence,” as follows:

(1) the basic claim must have risen out of the conduct set forth in the original proceeding; (2) the party to be brought in must have received such notice that it will not be prejudiced in maintaining its defense; (3) the party must or should have known that, but for a mistake concerning identity, the action would have been brought against it; and (4) the second and third requirements must have been fulfilled within the prescribed limitations period.

Jacobsen v. Osborne, 133 F. 3d 315 (5th Cir. 1998); *Moore v. Long*, 924 F.2d 586, 587 (5th Cir. 1991) (quoting *Schiavone*, 477 U.S. at 29).

As described in *Schiavone*, a narrow interpretation of Fed. R. Civ. P. 15(c) at that time required that “in order for an amendment adding a

party to relate back under Rule 15(c), the party to be added must have received notice of the action before the statute of limitations has run.” *Schiavone* at 32. Under the *Schiavone* court’s narrow interpretation of Rule 15(c), “[t]he linchpin is notice, and notice within the limitations period.” *Id.*

**B. The 1991 and 1993 Amendments
Removed the Notice Requirement
From the “Conduct, Transaction or
Occurrence” Language of Fed. R.
Civ. P. 15(c) To Change the
Result of *Schiavone***

As noted in the Advisory Committee Notes for the 1991 Amendments to Rule 15(c), “[o]n the basis of the text of the former rule, the Court reached a result in *Schiavone v. Fortune* that was inconsistent with the liberal pleading practices secured by Rule 8.” *Notes of Advisory Committee on Rules, Rule 15(c)–1991 Amendments*. The *Schiavone* court’s rejection of the liberal interpretation for Rule 15 was also the subject of several comments and law review articles, which were mentioned in the Advisory Committee Notes.⁵

⁵ *Id.* (citing Bauer, *Schiavone: An Un-Fortune-ate Illustration of the Supreme Court’s Role as Interpreter of the Federal Rules of Civil Procedure*, 63 Notre Dame L. Rev. 720 (1988); Brussack, *Outrageous Fortune: The Case for Amending Rule 15(c) Again*, 61 S. Cal. L. Rev. 671 (1988); Lewis, *The Excessive History of Federal Rule 15(c) and Its Lessons for Civil Rules Revision*, 86 Mich. L. Rev. 1507 (1987).

The 1991 and 1993 Amendments to Rule 15(c) were intended to change the scope and content of this rule, and these amendments were meant to overrule the *Schiavone* decision thereby codifying a more liberal interpretation of Fed. R. Civ. P. 15(c) for “relation back” determinations. See *Notes of Advisory Committee on Rules, Rule 15(c) – 1991 Amendments* (“Paragraph (c)(3). This paragraph has been revised to change the result in *Schiavone v. Fortune*, *supra*, with respect to the problem of a misnamed defendant,” and for “Paragraph (c)(1),” “If *Schiavone v. Fortune*, 106 S. Ct. 2379 (1986) implies the contrary, this paragraph is intended to make a material change in the rule.”). With the 1991 and 1993 amendments, all reference to “notice” in the common “transaction, occurrence, or conduct” provisions of Fed. R. Civ. P. 15(c)(1)(B) was eliminated, as shown below first in Rule 15(c)(2) before it was renumbered in 2007 for stylistic reasons as Rule 15(c)(1)(B).

Rule 15(c), as amended in 1991 and 1993, provides:

An amendment of a pleading relates back to the date of the original pleading when

- (1) relation back is permitted by the law that provides the statute of limitations applicable to the action, or
- (2) the claim or defense asserted in the amended pleading arose out of the conduct, transaction, or occurrence set forth or attempted to be set forth in the original pleading, or
- (3) the amendment changes the party or the naming of the party against whom a claim is asserted if the

foregoing provision (2) is satisfied and, within the period provided by Rule 4(m) for service of the summons and complaint, the party to be brought in by amendment (A) has received such notice of the institution of the action that the party will not be prejudiced in maintaining a defense on the merits, and (B) knew or should have known that, but for a mistake concerning the identity of the proper party, the action would have been brought against the party.

Fed. R. Civ. P. 15(c)(1)-(3) (“or” added between sub-sections). With the elimination of the “notice” and “prejudice” requirements from the “conduct, transaction or occurrence” provision in Fed. R. Civ. P. 15(c)(2), notice was no longer the “linchpin” for “relation back” determinations for that provision of Fed. R. Civ. P. 15(c).

In 2007, stylistic amendments to the Federal Rules re-designated sub-section designations of Rule 15(c)(1)-(3) into Fed. R. Civ. P. 15(c)(1)(A)-(C).⁶ Consistent with the “conduct, transaction, or occurrence” provisions of Rule 15(c)(2), Fed. R. Civ. P. 15(c)(1)(B) also does not possess “notice” and “prejudice” requirements.

⁶ Fed. R. Civ. P. 15(c)(1)-(3) was amended in 2007 “as part of the general restyling of the Civil Rules,” which re-numbered Rule 15(c) into its current Fed. R. Civ. P. 15(c)(1)(A)-(C) designations. *Adv. Comm. Notes*, 2007 Amendment (“These changes are intended to be stylistic only.”)

As shown above, the 1991 and 1993 amendments to Rule 15(c) added the disjunctive particle “or” between each sub-section (c)(1), (c)(2) and (c)(3), and the stylistic amendments in 2007 retained the disjunctive particle “or” between the re-designated sub-sections (c)(1)(B) and (c)(1)(C).

By including the disjunctive particle “or” between each of the sub-sections in Rule 15(c) and eliminating the “notice” and “prejudice” requirements from the “conduct, transaction or occurrence” language in Fed. R. Civ. P. 15(c) [now Fed. R. Civ. P. 15(c)(1)(B)], this Court’s *Schiavone* decision was overruled in favor of a codification of the liberal interpretation of Fed. R. Civ. P. 15(c) consistent with the goals and purpose set forth in Federal Rules of Civil Procedure.

**C. The Federal Circuit’s Decision in
the Present Case Attempts to
Add a Notice Requirement
Back Into the “Conduct, Transaction
or Occurrence” Language of
Fed. R. Civ. P. 15(c)(1)**

As characterized by the appeals court in the present case, the Federal Circuit established, and applied, a “liberal notice-based” test for “relation back” determinations under Fed. R. Civ. P. 15(c)(1)(B). *See Anza v. Mushkin*, 934 F.3d 1359, 1366-73 (Fed. Cir. 2019), App. 15a-19a, 26a (“liberally” interpreted, “notified of litigation,” “liberal, notice-based interpretation,” “read liberally,” “gave notice,” “sufficient notice,” “gave adequate notice,” “notice-based interpretation of Rule 15(c),” background

“technological overlap suggests” “original complaint gave notice”).

The Federal Circuit’s “liberal notice-based” test for the “relation back” determination under Fed. R. Civ. P. 15(c)(1)(B) was summarized by that court to be as follows: “[a]t bottom, however, the question remains whether the general factual situation or the aggregate of operative facts underlying the original claim for relief gave notice to *Mushkin* of the nature of the allegations it was being called upon to answer.” *Id.* at App. 19a, 26a (whether new allegations “are too far afield from original complaint to put Mushkin on notice of the allegations against which it would be required to defend,” and “[t]here is no lack of notice and no substantial prejudice to Mushkin from having to defend against independent claims over a shorter period than the period set forth in the original complaint.”).

Most of the decisions relied upon by the appeals court in the present case pre-date the 1991 and 1993 amendments to Fed. R. Civ. P. 15(c), which means the supporting precedent cited by the appeals court in the present case is inapposite to the rule as currently codified. Namely, as support for its “liberal notice-based” test of Fed R. Civ. P. 15(c)(1)(B), the Federal Circuit relied on Supreme Court precedent [1945 and 1984 decisions (App. 15a)], predecessor Court of Claims decisions [1967, 1970, and 1968 decisions (App. 15a-16a)], and a few Federal Circuit cases [1987 and 1990 decisions (App. 16a)]. These pre-1991 cases were interpreting an older version of Rule 15(c) that was altered significantly by the 1991 and 1993 amendments.

The appeals court in the present case does not mention the *Schiavone* decision, and the appeals

court's opinion in the present case does not consider the impact of the 1991 and 1993 amendments on the application of Fed. R. Civ. P. 15(c)(1)(B) to the "relation back" determinations. In light of the 1991 and 1993 amendments to Fed. R. Civ. P. 15(c), the adoption of a "liberal notice-based" test for "relation back" determinations under Fed. R. Civ. P. 15(c)(1)(B) is misplaced.

The "liberal notice-based" test adopted by the Federal Circuit in the present case for a "relation back" determination for Fed. R. Civ. P. 15(c)(1)(B) is erroneous because it attempts to inject the "notice" requirements back into the "conduct, transaction, or occurrence" provisions of Fed. R. Civ. P. 15(c)(1)(B). The "conduct, transaction, or occurrence" provision of Fed. R. Civ. P. 15(c)(1), however, was amended almost 30 years ago to eliminate the need for a showing of "notice" in that provision.

There are fundamental errors in the "relation back" analysis under the Federal Circuit's "liberal notice-based" test. Based on the current text in the Fed. R. Civ. P. 15(c)(1)(B) and the history of this provision, the appeals court's "liberal notice-based" test for "relation back" determinations attempts to "unwind" the 1991 and 1993 amendments to Fed. R. Civ. P. 15(c), which is a fundamental error that should be reviewed, and corrected, by this Court's grant of Certiorari.

III. A “Relation Back” Test Based on the Plain Text of Fed. R. Civ. P. 15(c)(1)(B) Would Avoid Problems Inherent in the Federal Circuit’s “Liberal Notice-Based” Test

By ignoring the 1991 and 1993 amendments to Fed. R. Civ. P. 15(c), the appeals court in the present case “turns back the clock” by re-introducing the notice requirements into the common “transactions, conduct or occurrence” test of Fed. R. Civ. P. 15(c)(1)(B). By re-introducing “notice” requirements into the “relation back” test for Fed. R. Civ. P. 15(c)(1)(B), the Federal Circuit re-introduces the “elements of arbitrariness” previously criticized by the commentators of the *Schiavone* decision. The post-*Schiavone* amendments to Rule 15(c) in 1991 and 1993 were intended to eliminate these “elements of arbitrariness.”

A “relation back” test formulated on the plain text of the “conduct, transaction or occurrence” language of Fed. R. Civ. P. 15(c)(1)(B) would avoid the problems created the overly broad expansion of the scope of Fed. R. Civ. P. 15(c)(1)(B) under a “liberal notice-based” “relation back” test. The Federal Circuit’s expanded “liberal” test for “relation back” determinations interjects “elements of arbitrariness” in the following ways: (1) the court focused on a broad description of the general background technology involved in the case, as opposed to comparing the amended scope of the case based on a review of relevant “conduct, transactions or occurrences,” (2) the court ignored contentions duly served by the Plaintiff that waived infringement claims and statutory bases in the original proceedings, even though Plaintiff never retracted these waived provisions, and, (3) the court segregated the newly accused products identified

for the first time in the amended pleading from the other “conduct, transactions, or occurrences” involved in the entire case, considered as a whole, even after acknowledging that “it is improbable that allegations regarding different products, involving different patents, would have a common core of operative facts.”

**A. Appeals Court’s Improper Focus on a
Broad Description of Underlying
General Background Technology**

The district court found that the scope of the patent claims in the original proceeding (‘927 patent) would be directed to the use of “flip chip” “ball placement capillary” bonding tips, and the appeals court confirmed that the asserted claims in the two new patents asserted in the Second Amended Complaint “broadly recite methods of using bonding tips more generally.” *Id.* at App. 20a. Based on the narrow scope of asserted use of a particular “flip chip” “ball placement capillary” bonding tip covered by the ‘927 patent in the original proceedings, and the “broad” methods of using any “bonding tip” in the new patents asserted in the Second Amended Complaint, the district court found that there would be a different, broader scope to the amended pleading compared to the original proceeding.

The appeals court disagreed with the district court’s findings on the broader scope of the Second Amended Complaint because the two newly-asserted patents and the originally-asserted patent share the same “underlying” background technology of placing a dissipative material on a bonding tip. *Anza v. Mushkin*, 934 F.3d 1359, 1369-71 (Fed. Cir. 2019), App. 20a. Ignoring what was actually claimed in the patents, the

appeals court in the present case found that “[t]his technological overlap suggests that the aggregate of operative facts underlying infringement under the ‘927 patent in the original complaint gave notice of the substance of the claims of infringement under the ‘479 and ‘864 patents in the second amended complaint.” *Id.*

The appeals court in the present case primarily relied on this similarity in general background technology even though it conceded the following operative facts: (1) “the patents address different bonding techniques,” App. 20a, (2) “the original complaint differs from the second amended complaint in that the original complaint was limited to products manufactured using flip chip bonding,” App. 21a, and, (3) “the specifications of the ‘479 and ‘864 patents discuss only wire bonding,” App. 20a. All of these operative facts were disregarded by the appeals court in favor of the similarity of the general background technology, which “suggested” to the appeals court that there was “notice” provided to the defendant of the new infringement claims.

Instead of properly considering the actual operative facts present in the case (which support the district court’s conclusions), the appeals court in the present case focused upon the “overlap” of a technological background description to “suggest” notice. Broad technological background descriptions and “suggestions of notice” should not be the primary focus of the “relation back” determination, and those factors should not replace a comparison of the actual operative facts involved with claims set forth in the amended pleading. Instead of focusing on the underlying technological background of the case, the “relation back” determination should focus on whether

the scope of the case is expanded, the same, or contracted by the amended pleading based on a review of relevant “conduct, transactions or occurrences.”

Overall, the Federal Circuit’s “liberal notice-based” test diverts the proper focus away from a comparison of the operative facts shown in the actual “transactions, conduct or occurrences,” which a plain reading of Fed. R. Civ. P. 15(c)(1)(B) would require.

B. The Appeals Court Failed to Properly Weigh the Impact of the Infringement Contentions Signed and Served by Plaintiff in the Original Proceedings

The appeals court in the present case recognized the fact that Anza executed and served Infringement Contentions pursuant to the Local Rules of the District of Colorado in the original proceedings, and those Infringement Contentions withdrew claims of infringement under 35 U.S.C. §271(g) of the Patent Act and withdrew claims of infringement of Claim 16 of the ‘927 patent (method of use claims). *Id.* at App. 21a-22a.⁷

⁷ The District Court’s Order granting the Motion to Dismiss identifies these Infringement Contentions as “informal” because they were served before an Answer was filed by the Defendant. The Infringement Contentions, however, were formally signed by Anza’s counsel, and served on Mushkin on March 23, 2018, with hundreds of pages of documents and a proof of service was filed on the docket for the case noting the execution and service of same, as well as compliance with the District of Colorado’s Patent Rules.

Anza has never retracted or modified their Infringement Contentions as executed and served in the original proceedings on March 23, 2018, and those Infringement Contentions still stand as the “final” and “last word” from Anza as to the infringement claims Anza was asserting in the original proceedings. After the execution and service of their Infringement Contentions, Anza’s claims for infringement were limited to direct infringement under 35 U.S.C. §271(a) of system claims in the ‘927 patent (and all claims of infringement of methods of use claims under 35 U.S.C. §271(g) were withdrawn). In the Motion to Dismiss, the district court considered the subsequent re-introduction in the Second Amended Complaint of the withdrawn 35 U.S.C. §271(g) method of use claims to be an expansion of the case compared to the original proceedings.

The appeals court indicated that the Infringement Contentions executed and served by Anza could have been supplemented or amended at a later date. Mushkin agrees that Anza, with leave of the Court, could have amended those contentions. But, Anza never supplemented, modified or amended those Infringement Contentions in the present case, and their positions were never retracted by Anza at any time in the proceedings.

Because there was no retraction of Anza’s position withdrawing 35 U.S.C. §271(g) infringement claims from the original proceedings, the district court’s reliance on Anza’s un-retracted positions, was not error. The appeals court’s failure to properly consider the impact and weight of the un-retracted positions set forth in Anza’s Infringement Contentions adds another “element of arbitrariness” to the appeals

court's analysis, which should be reviewed by this Court.

C. As Discussed in the Federal Circuit's Opinion, It is Improbable That Newly Added Products Asserted Under Different Patents Would Have a Common Core of Operative Facts

The appeals court in the present case segregated their consideration of the “relation back” analysis for the newly accused products identified for the first time in the Second Amended Complaint, instead of considering, and comparing, the scope of the case presented in the Second Amended Complaint, as a whole, to the original proceedings. That is, the entire scope of the case defined by the Second Amended Complaint was not considered as a whole in the “relation back” determination, and the appeals court did not review the “conduct, transactions, or occurrences” of the entire case in a comparative analysis.

The Federal Circuit in the present case indicated that other courts have found “it is improbable that allegations regarding different products, involving different patents, would have a common core of operative facts.” *Id.* at App. 26a. In the present case, a comparative analysis of the operative facts, including the actual “transactions, conduct or occurrences,” for the case as a whole, found that the Plaintiff's amended allegations regarding different product, involving different patents, do not possess a common core of operative fact. The improbability discussed by the Federal Circuit describes the present case, as found by the district

court. If the comparative analysis was conducted based on a plain reading of Fed. R. Civ. P. 15(c)(1)(B) applied to the case as a whole, no relation back would have been found and the district court's analysis would likely have been affirmed.

Instead of considering the amended case as a whole, the appeal court bifurcated its analysis. But, there is no indication that this analysis should be bifurcated or conducted in a piecemeal fashion under Fed. R. Civ. P. 15(c)(1)(B), and a plain reading of that provision would appear to require just the opposite. Considering the case as a whole, the improbability noted above by the Federal Circuit would result in a finding that the case defined by the amended pleading would not "have a common core of operative facts." The appeals court's failure to properly consider the scope and impact of the Second Amended Complaint, as a whole, adds another "element of arbitrariness" to the appeals court's analysis, which should be reviewed by this Court.

**D. A Plain Reading of Fed. R. Civ. P.
15(c)(1)(B) Should Be Applied to
"Relation Back" Determinations**

A plain reading of the "conduct, transactions or occurrence" language in Fed. R. Civ. P. 15(c)(1)(B) indicates that "relation back" arises when an "amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading." Fed. R. Civ. P. 15(c)(1)(B). This Court in *Mayle v. Felix*, addressed "relation back" determinations in the habeas corpus context, stating that "[t]he very purpose of Rule 15(c)(2), as the dissent notes, is to "qualify a

statute of limitations,” “[b]ut ‘qualify’ does not mean repeal.” *Mayle v. Felix*, 545 U.S. 644, 662-63 (2005). Requiring that Rule 15(c)(1)(B) be interpreted in a “liberal” manner adds an element of “arbitrariness” to this analysis, which should be reviewed by this Court.

CONCLUSION

This Court should grant Certiorari to resolve the proper standard of appellate review, and the proper rule to be applied, for “relation back” determinations under Fed. R. Civ. P. 15(c)(1)(B). A plain reading of the “conduct, transaction, or occurrence” provisions of Rule 15(c)(1)(B) should be applied to “relation back” determinations in light of elimination of “notice” and “lack of prejudice” elements from that provision in the 1991 and 1993 Amendments to that rule.

Respectfully submitted,

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APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ANZA TECHNOLOGY, INC.,

Plaintiff-Appellant

v.

MUSHKIN, INC., DBA ENHANCED NETWORK
SYSTEMS, INC.,

Defendant-Appellee

2019-1045

Appeal from the United States District Court for the
District of Colorado in No. 1:17-cv-03135-MEH,
Magistrate Judge Michael E. Hegarty.

Decided: August 16, 2019

COLBY BRIAN SPRINGER, Polsinelli LLP,
San Francisco, CA, argued for plaintiff-appellant.
Also represented by MIYA YUSA; MICHAEL
DULIN, Denver, CO; HANNAH THERESA YANG,
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D. SCOTT HEMINGWAY, Hemingway &
Hansen, LLP, Dallas, TX, argued for defendant-
appellee. Also represented by THOMAS S. RICE,
Senter Goldfarb & Rice LLC, Denver, CO.

Before PROST, Chief Judge, NEWMAN and
BRYSON, Circuit Judges.

BRYSON, Circuit Judge.

Plaintiff Anza Technology, Inc., (“Anza”) appeals from a decision of the United States District Court for the District of Colorado granting a motion by defendant Mushkin, Inc., dba Enhanced Network Systems, Inc., (“Mushkin”) to dismiss Anza’s second amended complaint. The dismissal followed from the court’s finding that Anza’s claim of damages for patent infringement was barred by the six-year statute of limitations in the Patent Act, 35 U.S.C. §286. That ruling was based in turn on the court’s determination that the claims in Anza’s second amended complaint did not relate back to the date of Anza’s original complaint and were therefore time-barred. Because the district court’s application of the relation back doctrine was overly restrictive, we reverse in part, vacate in part, and remand for further proceedings.

I

A

Anza filed this action on March 28, 2017, in the United States District Court for the Eastern District of California, alleging that Mushkin had infringed claims 1, 14, and 16 of Anza’s U.S. Patent No. 7,124,927 (“the ’927 patent”), in violation of 35 U.S.C. § 271(a) and (g). The ’927 patent, entitled “Flip Chip Bonding Tool and Ball Placement Capillary,” relates to “dissipative and insulative ceramic flip chip bonding tools and capillaries for ball placement for bonding electrical connections.” ’927 patent, col. 1, ll. 39–41.

The specification of the '927 patent discusses two techniques for bonding electronic components, such as semiconductor integrated circuit ("IC") chips, to substrates, circuit boards, or carriers. The two techniques are referred to as "wire bonding" and "flip chip bonding." '927 patent, col. 1, ll. 60–65. In wire bonding, the chip is oriented face-up, so that there is no direct electrical connection between the leads of the chip and the bond pads on the substrate. A wire is then used to connect the chip to the substrate. *Id.* at col. 1, ll. 43–61. In flip chip bonding, the chip is oriented face-down, which allows for a direct electrical connection between the chip and the substrate. The direct electrical connection is facilitated by conductive solder balls that are deposited on the chip; the solder balls provide the conductive path from chip to substrate. *Id.* at col. 1, ll. 61–65; col. 2, ll. 9–10; Fig. 3.

Under either technique, the bonding process requires the use of bonding tools. The '927 patent explains that the problem with prior art bonding tools was that "an electro-static discharge (ESD) from the bonding tool or transient currents from the machine [that uses the tool] can damage the very circuit the tool is bonding." *Id.* at col. 2, ll. 47–49. According to the specification, "[c]ertain prior art devices have a one-or-more volt emission when the tip makes bonding contact. This could present a problem, as a one-volt static discharge can . . . cause the integrated circuit to fail." *Id.* at col. 2, ll. 53–59.

To avoid damage to the electronic devices from such an electrostatic discharge, the '927 patent recites a bonding tool tip for flip chip bonding that "conducts electricity at a rate sufficient to prevent charge buildup but not at so high a rate as to

overload the device being bonded.” Id. at col. 2, line 67, through col. 3, line 2.

Claims 1, 14, and 16 of the ’927 patent, all independent claims, recite a system, a component, and a method, respectively. Claim 1 provides as follows:

1. A flip chip bonding tool and ball placement capillary system for connecting leads on integrated circuit bonding pads, comprising a dissipative material having a resistance low enough to prevent a discharge of a charge to a device being bonded and high enough to stop current flow large enough to damage the device being bonded.

Claim 14 recites:

14. An ESD-preventive device comprising:
a flip chip bonding tool and ball placement capillary, comprising a dissipative material and configured to come in contact with a device being bonded, wherein a current produced by static charge generated during bonding is allowed to flow; wherein the dissipative material has a resistance low enough to prevent a discharge of charge to the device being bonded and high enough to stop all current flow to the device being bonded.

Claim 16 recites “[a] method of utilizing a flip chip bonding tool . . . in a microelectronic assembly.” The claimed method recites the use of a bonding machine capable of being equipped with a flip chip bonding tool, which has a tip comprising a dissipative material having the same properties as recited in claims 1 and 14.

B

On September 6, 2017, Anza filed its first amended complaint, which joined Avant Technology,

Inc., as a co-defendant.¹ Thereafter, Mushkin filed a motion to dismiss or to sever the claims against Mushkin from those against Avant, and either to stay the case against Mushkin or to transfer the case to the District of Colorado. The California district court severed Anza's claims against Mushkin and transferred the case against Mushkin to the District of Colorado.

Following the transfer, Anza served infringement contentions against Mushkin pursuant to the District of Colorado's Local Patent Rules 4 and 5. The infringement contentions accused Mushkin of directly infringing claims 1 and 14, but did not refer to claim 16. Noting in its infringement contentions that discovery had not commenced and a formal scheduling order had not been entered, Anza stated that it reserved "the right to supplement these contentions as appropriate based upon further discovery and the schedule of this case, including but not limited to assertions related to new claims and/or patents as may be allowed through amendment of the operative pleading."

The parties then engaged in mediation. In the course of the mediation, Mushkin provided Anza

fn 1 The first amended complaint alleged that Avant was "the sole aggregator of all Mushkin-based memory modules and board products . . . by virtue of Avant having acquired certain assets of Defendant Mushkin in accordance with an asset purchase agreement dated April 1, 2012." Because there is no material difference between the original complaint and the first amended complaint for purposes of the issues in this case, we focus on the differences between the original complaint and the second amended complaint.

with a declaration of George Stathakis, Mushkin's president, regarding the technology used by Mushkin. The Stathakis declaration stated, *inter alia*, that Mushkin "did not bond IC chips to boards or modules." Instead, according to the declaration, "[t]he memory products purchased by Mushkin, Inc. from suppliers were IC memory chips that were already . . . bonded on printed circuit boards or memory module boards." Additionally, the declaration stated that Mushkin's supplier "does not place or position solder ball connectors on the IC chip for use in bonding the IC chip to a printed circuit board or memory module board."

The district court held a hearing to address Mushkin's motion to dismiss. In light of information in the Stathakis declaration, Anza "agreed that its present claims [were] no longer viable." Based on that concession, the district court granted Mushkin's motion. However, the court ruled that Anza would be permitted to file an amended complaint and that Mushkin would be allowed to file a motion to dismiss that complaint.

C

Anza filed its second amended complaint on June 8, 2018. In the second amended complaint, Anza removed the infringement allegations regarding the '927 patent and alleged infringement of two new patents: U.S. Patent Nos. 6,354,479 ("the '479 patent") and 6,651,864 ("the '864 patent"). The new complaint alleged that Mushkin had infringed those patents under 35 U.S.C. § 271(g). Anza also omitted ten of the sixteen products that had been accused in the original complaint and added two new products that had not previously been accused.

The '479 and '864 patents, entitled "Dissipative Ceramic Bonding Tip" and "Dissipative Ceramic

Bonding Tool Tip,” respectively, claim priority to the same U.S. provisional application as the ’927 patent. Like the ’927 patent, the ’479 and ’864 patents recite the use of “dissipative ceramic bonding tips for bonding electrical connections.” ’479 patent, col. 1, ll. 12–13; ’864 patent, col. 1, ll. 20–21. The patents offer the same solution to the problem of electrostatic discharge damage during the bonding process—providing a bonding tool tip that conducts electricity “at a rate sufficient to prevent charge buildup, but not at so high a rate as to overload the device being bonded.” ’479 patent, col. 2, ll. 4–6; ’864 patent, col. 2, ll. 11–13. The ’479 and ’864 patents differ from the ’927 patent in that they are directed to bonding tool tips for wire bonding, rather than for flip chip bonding. In addition, in contrast to the system and component claims of the ’927 patent, the asserted claims of the ’479 and ’864 patents (claims 39 and 28, respectively), are method claims. Claim 37 of the ’479 patent, from which asserted claim 39 depends, recites as follows:

37. A method of using a bonding tip,
comprising:

bonding a device using a bonding tip
made with a dissipative material that has a
resistance low enough to prevent a discharge
of charge to said device and high enough to
avoid current flow large enough to damage
said device.

Similarly, independent claim 28 of the ’864 patent recites:

28. A method of using an electrically
dissipative bonding tool tip, having a

resistance in the range of 105 to 1012 ohms, comprising:

providing the electrically dissipative bonding tool tip;

bonding a material to a device;

allowing an essentially smooth current to dissipate to the device, the current being low enough so as not to damage said device being bonded and high enough to avoid a build up of charge that could discharge to the device being bonded and damage the device being bonded.

D

Mushkin filed a motion to dismiss the second amended complaint. It argued, *inter alia*, that the new patent claims against Mushkin do not relate back to the date of Anza's original complaint. In support of that argument, Mushkin relied on Rule 15(c)(1)(B) of the Federal Rules of Civil Procedure, which provides: "An amendment to a pleading relates back to the date of the original pleading when . . . the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading."

The district court granted Mushkin's motion, ruling that the new infringement claims did not relate back to the date of the original complaint. The court explained that new infringement claims relate back to the date of the original complaint when the claims involve the same parties, the same products, and similar technology—i.e., when the claims are "part and parcel" of the original complaint. The court ruled that newly asserted claims of infringement do not relate back if the new claims are not an integral part of the claims in the original complaint and if

proof of the new claims will not entail the same evidence as proof of the original claims.

With respect to the patent claims asserted in the original complaint as compared with those asserted in the second amended complaint, the district court found that “[a]lthough the claims involve the same parties, they do not relate to identical products and technology.” Comparing the ’864 and ’479 patents with the ’927 patent, the district court found that the asserted claims of the ’864 and ’479 patents “protect a method of using a wire bonding tool, while the ’927 claims involved a flip chip bonding and solder ball placement tool.” The district court acknowledged that the patent claims have the “same purpose—bonding integrated circuit chips to printed circuit boards while minimizing electrostatic discharge.” But because it found that “different processes and technologies are used to achieve this purpose,” the district court held that the patent claims are “not part and parcel of one another.” As for the accused products, the court noted that the second amended complaint added two new accused products and omitted a number of

accused products as compared with the original complaint.²

The district court added that “proving infringement of the initial and new claims would not involve substantially the same evidence.” The district court explained:

Proving the '927 patent claims would require evidence of the flip chip bonding method and how the flip chip bonding and ball placement tool was used in making the allegedly infringing products. Conversely, proving the newly asserted claims requires evidence of the wire bonding process and how a wire bonding tool tip was used to produce the allegedly infringing products.

In particular, the court noted, the new claims would entail different evidence because Anza's infringement contentions had dropped claim 16 of the '927 patent, which the district court considered to be the claim from the first amended complaint that

² The district court misspoke with regard to the number of accused products omitted from the second amended complaint. The court stated that the second amended complaint omitted eleven of the products that were accused in the original complaint, but in fact the number of omitted products was ten. Compare Second Amended Complaint at 13, *Anza Tech., Inc. v. Mushkin, Inc.*, No. 1:17-cv-03135-MEH (D. Colo. June 8, 2018), ECF No. 75, with Complaint at 6–7, *Anza Tech., Inc. v. Mushkin, Inc.*, No. 1:17-cv-03135-MEH (D. Colo. Mar. 28, 2017), ECF No. 1.

was most similar to the newly asserted claims.

The district court then addressed the effect of its rulings on the statute of limitations for patent claims, 35 U.S.C. § 286, which bars recovery for any infringement “committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.” Because Anza acknowledged that Mushkin’s allegedly infringing activity all took place more than six years before the filing date of the second amended complaint, the court held that the effect of ruling that the second amended complaint did not relate back to the filing date for the original complaint was that all the asserted claims in the second amended complaint were time-barred.

II

A

A preliminary question is whether Federal Circuit law, rather than regional circuit law, governs whether newly alleged claims in an amended complaint relate back to the date of the original complaint when the new claims are based on newly asserted patents.

We have previously held that “[a] procedural issue that is not itself a substantive patent law issue is nonetheless governed by Federal Circuit law if the issue pertains to patent law, if it bears an essential relationship to matters committed to our exclusive control by statute, or if it clearly implicates the jurisprudential responsibilities of this court in a field within its exclusive jurisdiction.” O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc., 467 F.3d 1355, 1364 (Fed. Cir. 2006) (quoting Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 (Fed. Cir. 1999)(en banc in relevant part)).

One example of such a procedural issue is a motion to sever in a patent case. We have held that “motions to sever are governed by Federal Circuit law because joinder in patent cases is based on an analysis of the accused acts of infringement, and this issue involves substantive issues unique to patent law.” In re EMC Corp., 677 F.3d 1351, 1354 (Fed. Cir. 2012). As in the case of motions to sever, the determination of whether newly alleged infringement claims relate back to the original complaint also turns on “an analysis of the accused acts of infringement.” Id. Therefore, we hold that this determination is also governed by Federal Circuit law.

B

The next question is what standard governs this court’s review of a district court’s application of the relation back doctrine.

Anza argues that this court should apply a *de novo* standard of review. Anza bases that argument on the fact that the district court dismissed the second amended complaint after holding the relation back doctrine inapplicable, and that dismissals of a complaint under Fed. R. Civ. P. 12(b)(6) are subject to de novo review.

The problem with Anza’s argument is that the dismissal in this case was the necessary consequence of the court’s determination that the relation back doctrine does not apply, since without the benefit of the relation back doctrine, it is clear that the statute of limitations would bar all of Anza’s claims against Mushkin. What Anza is challenging is not the dismissal itself, but whether the district court properly applied the relation back doctrine under Rule 15(c). The standard of review that applies to a dismissal under Rule 12(b)(6) therefore has nothing

to do with the critical issue in this case, which is whether the court properly determined not to apply the relation back doctrine to the second amended complaint. For that reason, Anza's argument sheds no light on what standard should be applied in reviewing that issue.

Mushkin argues that the district court's ruling on the relation back issue should be reviewed under the abuse of discretion standard. In arguing for that standard, Mushkin relies on two decisions of this court, but the cases Mushkin cites do not support its argument. In the first case, Fromson v. Citiplate, Inc., the court merely stated that it found "no reversible error" in the district court's conclusion that the amended complaint related back to the date of the original complaint. 886 F.2d 1300, 1304 (Fed. Cir. 1989). The court did not specify what standard of review it applied in reaching that conclusion. The second case, Datascope Corp. v. SMEC, Inc., 962 F.2d 1043 (Fed. Cir. 1992), did not deal with the relation back doctrine at all. The court in that case merely held that the district court's refusal to permit amendment of the complaint was not an abuse of discretion. Id. at 1047. While Datascope applied the abuse of discretion standard to the question whether the district court erred in denying a motion to amend a complaint under Fed. R. Civ. P. 15(a), nothing in Datascope speaks to the standard of review to be applied to the separate question of whether an amended pleading relates back to the date of the original pleading under Fed. R. Civ. P. 15(c).

Mushkin's suggestion that we review the district court's relation back ruling under an abuse of discretion standard would be contrary to the law of most of the other circuits, which have adopted a de novo standard when reviewing decisions regarding

whether an amended pleading relates back to the date of the original pleading. See Glover v. FDIC, 698 F.3d 139, 144 (3d Cir. 2012); Robinson v. Clipse, 602 F.3d 605, 607 (4th Cir. 2010); Slayton v. Am. Express Co., 460 F.3d 215, 227–28 (2d Cir. 2006); Young v. Lepone, 305 F.3d 1, 14 (1st Cir. 2002); Miller v. Am. Heavy Lift Shipping, 231 F.3d 242, 246–47 (6th Cir. 2000); Delgado-Brunet v. Clark, 93 F.3d 339, 342 (7th Cir. 1996); Slade v. U.S. Postal Serv., 875 F.2d 814, 815 (10th Cir. 1989); Percy v. S.F. Gen. Hosp., 841 F.2d 975, 978 (9th Cir. 1988). Contra Powers v. Graff, 148 F.3d 1223, 1226 (11th Cir. 1998) (application of Rule 15(c) is reviewed for abuse of discretion, while findings of fact necessary for application of the rule are reviewed for clear error).

We adopt the majority rule. The rationale underlying that rule, when it has been expressed, is that the de novo standard of review applies because determining whether the amended claim “arose out of the conduct, transaction, or occurrence” set forth in the original complaint requires the reviewing court to apply the legal standard of Rule 15(c) “to a given set of facts,” which is “a task we are no less suited to perform than the district court.” Miller, 231 F.3d at 247; accord Percy, 841 F.2d at 978; Lundy v. Adamar of N.J., Inc., 34 F.3d 1173, 1177 (3d Cir. 1994). In some instances, however, factual issues may need to be addressed as part of the district court’s analysis of the relation back issue. With respect to any disputed facts that are material to the relation back issue, we are not as well situated as the district court to make the appropriate findings. Therefore, in the event that such factual issues arise, we would review any findings by the district court on those issues for clear error, as we do in analogous circumstances. See, e.g., Presidio Components, Inc. v.

Am. Tech. Ceramics Corp., 875 F.3d 1369, 1375 (Fed. Cir. 2017) (indefiniteness); Par Pharm., Inc. v. TWI Pharm., Inc., 773 F.3d 1186, 1194 (Fed. Cir. 2014) (obviousness); Alcon Research Ltd. v. Barr Labs., Inc., 745 F.3d 1180, 1188 (Fed. Cir. 2014) (enablement); SanDisk Corp. v. STMicroelectronics, Inc., 480 F.3d 1372, 1377 (Fed. Cir. 2007) (presence of a case or controversy); Rambus Inc. v. Infineon Techs. AG, 318 F.3d 1081, 1087–88 (Fed. Cir. 2003) (attorney fee award); In re Emert, 124 F.3d 1458, 1460 (Fed. Cir. 1997) (double patenting).

C

The Supreme Court has interpreted the relation back doctrine liberally, to apply if an amended pleading “relate[s] to the same general conduct, transaction and occurrence” as the original pleading. Tiller v. Atl. Coast Line R.R. Co., 323 U.S. 574, 580–81 (1945) (holding, in a railroad negligence case that even though the amended complaint alleged a different theory of negligence, the new charge related back to the original complaint because “[t]he cause of action now, as it was in the beginning, is the same—it is a suit to recover damages for the alleged wrongful death of the deceased.”). That liberal interpretation of the relation back rule reflects the rationale of Rule 15(c), which is that “a party who has been notified of litigation concerning a particular occurrence has been given all the notice that statutes of limitations were intended to provide.” Baldwin Cty. Welcome Ctr. v. Brown, 466 U.S. 147, 149 n.3 (1984).

Our predecessor court, the Court of Claims, embraced that liberal, notice-based interpretation of Rule 15(c). See Snoqualmie Tribe of Indians v. United States, 372 F.2d 951, 961 (Ct. Cl. 1967) (“A restrictive view would limit application of the rule to

minor pleading mistakes. We think modern practice requires a more imaginative approach, and that [Rule 15(c)] should be read liberally to permit an amended pleading to relate back where there is sufficient notice.”); see also Vann v. United States, 420 F.2d 968, 974 (Ct. Cl. 1970) (“The test for determining whether the new matter in an amended petition arose from the ‘conduct, transaction, or occurrence’ first pleaded is whether the general fact situation or the aggregate of the operative facts underlying the claim for relief in the first petition gave notice to the [accused party] of the new matter.”); United States v. N. Paiute Nation, 393 F.2d 786, 790 (Ct. Cl. 1968) (“Sufficient notice to the Government is the test . . . with our inquiry focusing on the notice given by the general fact situation set forth in the original pleading.”)(citations and footnote omitted)).

Federal Circuit cases have applied a similar approach to Rule 15(c). See Korody-Colyer Corp. v. Gen. Motors Corp., 828 F.2d 1572, 1575 (Fed. Cir. 1987) (“Under Rule 15(c) . . . an amendment may relate back when the earlier complaint gave adequate notice of the new claim.”); see also Barron Bancshares, Inc. v. United States, 366 F.3d 1360, 1369–70 (Fed. Cir. 2004); Intrepid v. Pollock, 907 F.2d 1125, 1130 (Fed. Cir. 1990).

The notice-based interpretation of Rule 15(c) is consistent with the approach used under Rules 13(a) and 20(a) of the Federal Rules of Civil Procedure. Those rules, which share the “same transaction or occurrence” standard used in Rule 15(c), have been interpreted to require that counterclaims (in the case of Rule 13(a)) or the claims of the plaintiffs to be joined (in the case of Rule 20(a)) be logically related

to the claims in the original complaint. See In re EMC Corp., 677 F.3d at 1357–58.

The “logical relationship” standard contemplates a “liberal approach to the concept of same transaction or occurrence.” 7 Charles Alan Wright et al., *Federal Practice & Procedure* § 1653, at 410–11 (3d ed. 2001). It asks whether the facts underlying the alleged claims “share an aggregate of operative facts.” In re EMC Corp., 677 F.3d at 1359. For purposes of the logical relationship test, “all logically related events entitling a person to institute a legal action against another generally are regarded as comprising a transaction or occurrence.” 7 Charles Alan Wright et al., *Federal Practice & Procedure* § 1653, at 409.

In light of the similarity in the language used in Rule 15(c) and Rules 13(a) and 20(a), cases applying the logical relationship test in the patent context are particularly instructive in applying the relation back doctrine. Those cases suggest that pertinent considerations bearing on whether claims are logically related include the overlap of parties, products or processes, time periods, licensing and technology agreements, and product or process development and manufacture. See In re EMC Corp., 677 F.3d at 1359–60; Futurewei Techs., Inc. v. Acacia Research Corp., 737 F.3d 704, 710 (Fed. Cir. 2013) (“Here, the logical relationship is strong: the license agreement gives rise to Huawei’s alter-ego claim, to SmartPhone’s affirmative right to enforce the patents in the Texas case, and to Huawei’s defense in that case”); see also In re Rearden LLC, 841 F.3d 1327, 1332 (Fed. Cir. 2016) (noting that the logical relationship test is one of three tests used to determine whether the transaction-or-occurrence test is met under Rule 13(a), and finding the

counterclaim compulsory because, inter alia, “the claims and counterclaims share a close, logical relation: the ownership and rightful use of the technology claimed and disclosed in the MOVA patents”).

Several district courts have addressed the issue of whether newly alleged claims, based on separate patents, relate back to the date of the original complaint. Most of those courts have employed a similar analysis, asking whether the newly asserted patents are “part and parcel” of the original controversy. For example, in Halo Electronics, Inc. v. Bel Fuse Inc., No. C-07-06222 RMW, 2008 WL 1991094, at *3 (N.D. Cal. May 5, 2008), the court found that the six Halo patents that were the subjects of the new claims were not “part or parcel” of the original complaint, which involved another patent, because “the Halo patents involve[d] different technologies and products.” On the other hand, the court in PerfectVision Manufacturing, Inc. v. PPC Broadband, Inc., 951 F. Supp. 2d 1083, 1093, 1093–94 (E.D. Ark. 2013), found that the amended complaint related back to the date of the original complaint, after considering whether the patents cited in the two complaints involved “the same field of art, the same fundamental science and technology . . . [,] the same allegedly infringing devices, and, in any damages analysis, the same pricing, sales, and related market data.”

Accordingly, in determining whether newly alleged claims, based on separate patents, relate back to the date of the original complaint, we will consider the overlap of parties, the overlap in the accused products, the underlying science and technology, time periods, and any additional factors that might suggest a commonality or lack of

commonality between the two sets of claims. At bottom, however, the question remains whether the general factual situation or the aggregate of operative facts underlying the original claim for relief gave notice to Mushkin of the nature of the allegations it was being called upon to answer.

D

On appeal, Anza challenges the district court's conclusion that the second amended complaint did not relate back to the date of the original complaint. Anza argues that the '864, '479, and '927 patents all seek to solve the same problem—avoiding damage to delicate devices as a result of ESD—and that the three patents all employ the same solution to address that problem—using dissipative ceramic tips on the bonding tools.

Anza also argues that there is a significant overlap of properties between the two sets of accused Mushkin products. According to Anza, each accused product in both the original complaint and the second amended complaint requires the use of certain techniques and methods to guard against damaging ESD events, which include compliance with standards that “involve[] the use of manufacturing tools made of dissipative materials having resistance ranges low enough to prevent a discharge of a charge to an ESD sensitive device but high enough to avoid current flows that may damage the device.”

Mushkin disagrees. According to Mushkin, the allegations in the second amended complaint are significantly different from the initial “flip chip” infringement allegations, for several reasons.

Mushkin first argues that the fact that the second amended complaint withdrew all prior claims of infringement under the “flip chip” '927 patent and

substituted claims from the two “wire bonding” patents indicates that the two complaints address entirely different bonding techniques. We disagree.

While the patents address different bonding techniques, they all share the same underlying technology. All three patents are focused on solving the same problem by the same solution, using a bonding tool tip made of a dissipative material having a resistance low enough to prevent the discharge of a charge to a device being bonded and high enough to avoid current flow to that device. ’927 patent, col. 2, line 64, through col. 3, line 2; ’479 patent, col. 2, ll. 3–6; ’864 patent, col. 2, ll. 11–13. Moreover, while the specifications of the ’479 and ’864 patents discuss only wire bonding, the asserted claims of those patents are not limited to the wire bonding technique. Both claim 39 of the ’479 patent and claim 28 of the ’864 broadly recite methods of using bonding tips more generally.

The use of bonding tool tips made of a dissipative material is the basis for the charges of infringement alleged in each of the complaints. According to the complaints, industry-recognized standards-setting organizations have set standards for certain ESD-sensitive devices, including IC chips, that require the use of manufacturing tools made of dissipative materials. The complaints thus target products assembled or manufactured in ways that meet or exceed industry standards for reducing the risk of damage to ESD-sensitive devices. This technological overlap suggests that the aggregate of operative facts underlying infringement under the ’927 patent in the original complaint gave notice of the substance of the claims of infringement under the ’479 and ’864 patents in the second amended complaint.

To be sure, the original complaint differs from the second amended complaint in that the original complaint was limited to products manufactured using flip chip bonding. But the type of bonding technique is of secondary importance compared with the use of manufacturing tools made of dissipative material. Contrary to the district court's conclusion, proving infringement would only require evidence that certain bonding tools were used, not evidence as to how those tools were used. That determination would not be likely to result in a substantially different evidentiary showing to prove infringement of the claims asserted in the second amended complaint.

Mushkin next argues that, before the filing of the second amended complaint, Anza narrowed its infringement claims in a way that distinguished its claims from the claims set forth in its original complaint. In what the district court characterized as Anza's "informal infringement contentions," Anza did not assert the previously pleaded 35 U.S.C. § 271(g) statutory basis for infringement, and it did not assert its previously pleaded allegations regarding "method of use" claim 16 of the '927 patent. The infringement contentions thus asserted only system and component claims 1 and 14, and alleged a theory of direct infringement only under 35 U.S.C. § 271(a). Subsequently, however, in the second amended complaint, Anza asserted infringement of "method of use" claims from the two new patents and alleged infringement under 35 U.S.C. § 271(g).

In light of this sequence of events, Mushkin argues that the second amended complaint changed not only the type of claims asserted, but also the statutory basis for infringement and the party alleged to have conducted the accused bonding

activity (a shift from Mushkin to an upstream manufacturer). Those changes between the theory of infringement set forth in the infringement contentions and allegations in the second amended complaint, according to Mushkin, show that there were substantial differences between the new and old claims.

Mushkin treats the infringement contentions as irreversibly narrowing the scope of the original complaint. In fact, however, Anza asserted that the infringement contentions were “preliminary, and based solely on public information.” Moreover, in the infringement contentions, Anza reserved the right “to supplement the[] contentions as appropriate based upon further discovery and the schedule of th[e] case.”

Apart from Anza’s reservation of the right to supplement, the District of Colorado Local Patent Rules permit amendments to infringement contentions. According to Rule 16 of the Local Patent Rules, amendments to the infringement contentions, including the addition of accused products or processes, are permissible upon a showing of good cause, such as the discovery of previously undiscovered information. D. Colo. Local Patent Rule 16(a)(3); see O2 Micro, 467 F.3d at 1366 (“If a local patent rule required the final identification of infringement and invalidity contentions to occur at the outset of the case, shortly after the pleadings were filed and well before the end of discovery, it might well conflict with the spirit, if not the letter, of the notice pleading and broad discovery regime created by the Federal Rules.”). The discoveries made as a result of the Stathakis declaration, including that Mushkin does not bond IC chips to boards or modules, but instead purchases pre-bonded chips

from suppliers, would likely constitute good cause to supplement Anza's infringement contentions by adding claim 16 and the section 271(g) theory of infringement.

Setting aside Mushkin's assertion that Anza's infringement contentions waived claim 16 and the section 271(g) theory of infringement, Mushkin's arguments largely fall away. The original complaint alleged infringement of "each of the limitations of independent claims 1, 14, and 16 of the '927 patent in violation of 35 U.S.C. § 271(a) and (g)." Complaint at 8, Anza Tech., Inc. v. Mushkin, Inc., No. 1:17-cv-03135-MEH (D. Colo. Mar. 28, 2017), ECF No. 75. Similarly, the second amended complaint asserted infringement of "method of use" claims of the '479 and '864 patents under 35 U.S.C. § 271(g). Second Amended Complaint at 17, 20, Anza Tech., Inc. v. Mushkin, Inc., No. 1:17-cv-03135-MEH (D. Colo. June 8, 2018), ECF No. 75. Both complaints therefore alleged infringement of "method of use" claims under 35 U.S.C. § 271(g), such that the allegations of infringement in both the old and new claims would entail activities conducted by upstream manufacturers. Accordingly, there is a substantial overlap in the underlying facts alleged in each of the complaints.

Mushkin's next argument is that the time frame when infringement liability was allegedly incurred is significantly different in the second amended complaint compared to the original complaint. According to Mushkin, the second amended complaint changed the relevant time period from infringement that occurred within the six-year period preceding March 2017 to infringement that occurred between March 2011 and April 1, 2012. See Appellee Br. 38. But Mushkin fails to explain how

the second time period, which is wholly encompassed within the first, can be regarded as distinctly different from the first. There is no lack of notice and no substantial prejudice to Mushkin from having to defend against independent claims over a shorter period than the period set forth in the original complaint.

At several points, Mushkin argues that Anza's admission that the infringement allegations in the original complaint were non-viable dooms its relation back argument. Mushkin reasons that if the infringement claims in the second amended complaint are similar enough to the infringement claims in the original complaint to relate back to the date of the original complaint, the infringement claims in the second amended complaint must also be non-viable. Alternatively, Mushkin argues that if the current claims are viable because they are not the same as the original ones, the current claims should not relate back to the date of the original complaint.

That argument falls with its premise. Amended claims do not have to be the same as the original claims to relate back. Rather, the claims must arise out of the same conduct, transaction, or occurrence. In any event, the record contains no explanation for the non-viability of the original claims, so there is no basis for concluding that Anza's concession that the original claims were non-viable means that the claims in the second amended complaint must be so different from the original claims that they cannot relate back to the date of the original complaint.

Mushkin further contends that applying the relation back doctrine in this case would allow litigants to evade the statute of limitations by

bootstrapping old claims onto new ones, thus rendering the statute of limitations a nullity. To the contrary, while the relation back doctrine alters the starting point for the statute of limitations, that starting point can never be earlier than the filing date of the original complaint. And in order for the relation back doctrine to apply at all, the allegations of the amended complaint must be tethered to the conduct, transactions, or occurrences underlying the original claims.

Finally, Mushkin argues that “[w]ith the filing of the Second Amended Complaint, two-thirds of the accused products changed, including the addition of two new accused products.” That characterization of the change in the set of accused products is misleading. In fact, the second amended complaint omits ten of the original sixteen products from the list of accused products. The omission of those products has no prejudicial effect on Mushkin and does not deprive Mushkin of notice of any new allegations. The other six products—Redline, Blackline, Radioactive, Silverline, Proline, and Essentials—have been accused in all three complaints. With regard to those six products, the second amended complaint and the original complaint would likely present closely related issues.

The same, however, is not true for the two remaining products, the Ridgeback and Apple products, which were added for the first time in the second amendment complaint. Courts that have addressed the issue of whether newly alleged claims, based on separate patents, relate back to the date of the original complaint, have regarded the presence of newly accused products as a substantial factor weighing against the application of the relation back doctrine. See PerfectVision, 951 F. Supp. 2d at 1093–

94; Halo Elecs., 2008 WL 1991094, at *3; see also Mann Design Ltd. v. Bounce, Inc., 138 F. Supp. 2d 1174, 1179 (D. Minn. 2001) (finding no relation back, in part because “[t]here are no allegations in the Complaint or the Amended Complaint indicating that the products accused of infringing the ’061 patent are the same as those which allegedly infringe either the ’559 and ’053 patent.”). The rationale for that rule is that it is improbable that allegations regarding different products, involving different patents, would have a common core of operative facts. It is therefore an open question whether the allegations regarding the two newly accused products, which are alleged to have infringed the latter two patents, are too far afield from the original complaint to put Mushkin on notice of the allegations against which it would be required to defend.

Resolution of that issue requires an analysis of facts that are not before us and as to which the district court is uniquely situated to rule. A remand for further proceedings is therefore necessary so that the district court can determine whether the infringement claims as to those two products are sufficiently similar to the infringement claims in the original complaint to justify application of the relation back doctrine to those products.

III

We hold that the claims in the second amended complaint that relate to the six originally accused products—the Redline, Blackline, Radioactive, Silverline, Proline, and Essentials products—relate back to the date of the original complaint under Rule 15(c). For those products, section 286 does not wholly bar an award of damages. The grant of the motion to dismiss as to those products must therefore be reversed. For the

products that were added for the first time in the second amended complaint—the Ridgeback and Apple products—we vacate the order of dismissal and remand for the district court to determine, based on a factual analysis in light of the legal standard set forth above, whether the allegations regarding those products should relate back to the filing date of the original complaint.

REVERSED IN PART, VACATED IN PART, AND
REMANDED

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. 17-cv-03135-MEH

ANZA TECHNOLOGIES, INC.,

Plaintiff,

v.

MUSHKIN, INC.,

Defendant.

ORDER

Michael E. Hegarty, United States Magistrate Judge.

Defendant Mushkin, Inc. seeks to dismiss Plaintiff Anza Technologies, Inc.'s Second Amended Complaint. I find that 35 U.S.C. § 286 bars Anza's damages for patent infringement, because the newly asserted claims do not relate back to those in its First Amended Complaint. Accordingly, I grant Mushkin's motion.

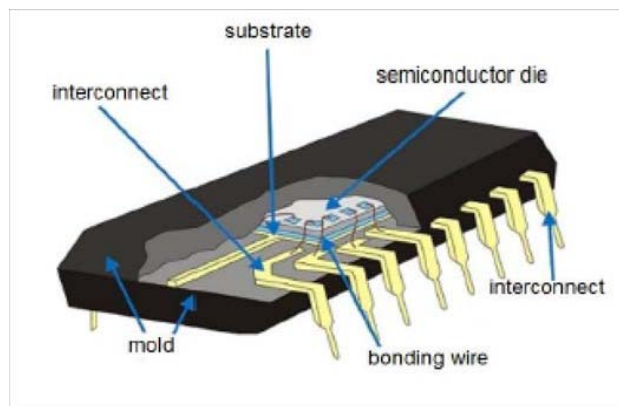
BACKGROUND

I. Facts

Anza makes the following relevant factual allegations (as opposed to legal conclusions, bare assertions, or merely conclusory allegations) in its Second Amended Complaint, which I take as true for my analysis under Fed. R. Civ. P. 12(b)(6). See Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009).

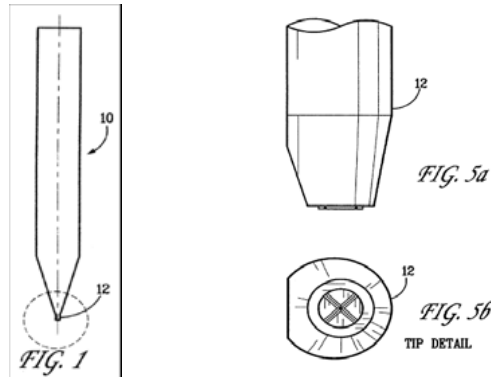
Anza produces and sells products that are used in assembling electronics. Second Am. Compl. ¶ 6, ECF No. 75. Relevant here, Anza manufactures products that minimize electrostatic discharge when connecting integrated circuit chips to other electrical components, such as semiconductor dies and circuit boards. See *id.* Mushkin was involved in the acquisition and sale of computer memory products until 2012, when it sold this portion of its business to Avant Technologies, Inc. *Id.* ¶¶ 8–9, 12.

Integrated circuit chips are connected to electrical components through various bonding techniques. *Id.* ¶¶ 14–19. “Wire bonding is the method of making interconnections with the integrated circuit and other components using, for example, gold or copper wire and the application of ultra-sonics or heat.” *Id.* ¶ 17. The following is an example of a wire bonded semi-conductor die:



Id. ¶ 13. To achieve a connection with minimal electrostatic discharge, the wire is placed on the circuit and bonded using a tool tip. *Id.* ¶ 18; U.S. Patent No. 6,354,479, at 8 (issued Mar. 12, 2002) (“479 patent”), ECF No. 75-3. In 2000, Anza obtained two patents over its wire bonding tool tip. ’479 Patent; U.S. Patent No. 6,651,864 (issued Nov. 25,

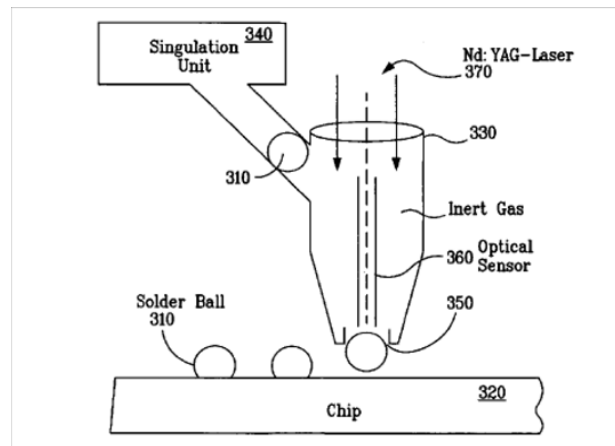
2003) (“864 patent”), ECF No. 75-4. The patents include diagrams illustrating the wire bonding tool and tip:



'479 patent, at 4, 5; '864 patent, at.4.

“Flip chip bonding” is a different method for connecting integrated circuit chips to electrical components. Second Am. Compl. ¶ 19. This technique deposits solder bumps on a substrate and then places a “flipped” or “face-down” integrated circuit chip onto the substrate so that the bumps directly connect the circuit and substrate. Id. Thus, “[w]ire bonding techniques use ‘face-up’ chips with a wire connection to each pad. Bump or ‘flip chip’ microelectronic assembly, on the other hand, is a direct electrical connection of face-down—‘flipped’—electronic components onto substrates” U.S. Patent No. 7,124,927, at 10 (issued Oct. 24, 2006) (“927 patent”), ECF No. 20-1.

When flip chip bonding, a tool must be used to deposit solder balls and minimize electrostatic discharge. Second Am. Compl. ¶ 20. In 2005, Anza obtained a patent on its flip chip and solder ball placement tool. '927 patent. The following diagram, which is included in Anza’s patent, represents the flip chip process using its tool:



Id. at 6.

Anza alleges that Mushkin acquired, assembled, imported, or sold products with integrated circuit chips that were manufactured with wire and/or flip chip bonding tools. Second Am. Compl. ¶ 10. Specifically, Anza contends the following Mushkin products must have used its patented bonding tools to comply with industry standards for electrostatic discharge: “REDLINE, BLACKLINE, RIDGEBACK, RADIOACTIVE, SILVERLINE, PROLINE, ESSENTIALS, and APPLE.” Id. ¶¶ 11, 37. Mushkin stopped manufacturing and selling these products in 2012 when it sold its electronic memory component business to Avant. *Id.* ¶¶ 8–9.

II. Procedural History

On March 28, 2018, Anza initiated this case against Mushkin in the United States District Court for the Eastern District of California. Compl., ECF No. 1. In an Amended Complaint filed on September 6, 2017, Anza asserted patent infringement claims against Mushkin and Avant. First Am. Compl. ¶¶ 33–37, ECF No. 20. According to Anza, Mushkin and Avant infringed claims one, fourteen, and sixteen of the ’927 patent when they manufactured or sold products with integrated circuit chips that had been flip chip bonded to circuit boards with tips that

reduce electrostatic discharge. Id. ¶ 37. Claims one and fourteen protect Anza’s “flip chip bonding tool and ball placement capillary system.” ’927 patent, at 12–13. Claim sixteen protects “[a] method of utilizing a flip chip bonding tool and ball placement capillary in a microelectric assembly” Id.

On December 20, 2017, the Honorable William B. Shubb severed the claims against Mushkin and Avant and transferred the Mushkin case to this District. ECF No. 40. While pursuing informal resolution of this case, Anza learned that its claims based on the ’927 patent were no longer viable. See Tr. of Mot. Hearing 12:22–13:3, ECF No. 74. Thus, it dismissed those claims and filed a Second Amended Complaint, which asserts new claims based on different patents. Id.; Second Am. Compl. ¶¶ 45–62, ECF No. 75. Specifically, Anza alleges Mushkin infringed claim thirty-nine of the ’479 patent and claim twenty-eight of the ’864 patent by manufacturing, importing, or selling products that had been wire or flip chip bonded. Id. Both of these claims protect methods of using the patented wire bonding tool tip. ’479 patent, at 11; ’864 patent, at 25.

Mushkin filed the present Motion to Dismiss on July 6, 2018. ECF No. 78. Mushkin first argues that Anza fails to state a violation of 35 U.S.C. § 271(g), because a “method of use” claim is not viable under that statute. Id. at 13–15. Next, Mushkin contends 35 U.S.C. § 286’s six-year limitation on patent infringement damages bars Anza’s claims. Id. at 15–21. Further, Mushkin argues the newly asserted claims do not relate back to those in Anza’s original or amended complaints. Id. Alternatively, Mushkin asks me to convert its motion to one for summary judgment and find that it did not infringe

the '479 or '864 patents. *Id.* at 22–23. Anza filed its response brief on July 27, 2018. Resp. to Mot. to Dismiss, ECF No. 79. Mushkin subsequently submitted its reply. Reply in Supp. of Mot. to Dismiss, ECF No. 80.

LEGAL STANDARDS

“To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007)). Plausibility, in the context of a motion to dismiss, means that the plaintiff pleaded facts which allow “the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* Twombly requires a two prong analysis. First, a court must identify “the allegations in the complaint that are not entitled to the assumption of truth,” that is, those allegations which are legal conclusions, bare assertions, or merely conclusory. *Id.* at 679–80. Second, the Court must consider the factual allegations “to determine if they plausibly suggest an entitlement to relief.” *Id.* at 681. If the allegations state a plausible claim for relief, such claim survives the motion to dismiss. *Id.* at 680.

Plausibility refers “to the scope of the allegations in a complaint: if they are so general that they encompass a wide swath of conduct, much of it innocent, then the plaintiffs ‘have not nudged their claims across the line from conceivable to plausible.’” Khalik v. United Air Lines, 671 F.3d 1188, 1191 (10th Cir. 2012) (quoting Robbins v. Oklahoma, 519 F.3d 1242, 1247 (10th Cir. 2008)). “The nature and specificity of the allegations required to state a plausible claim will vary based on context.” Kan. Penn Gaming, LLC v. Collins, 656 F.3d 1210, 1215

(10th Cir. 2011). Thus, while the Rule 12(b)(6) standard does not require that a plaintiff establish a prima facie case in a complaint, the elements of each alleged cause of action may help to determine whether the plaintiff has set forth a plausible claim. Khalik, 671 F.3d at 1191.

ANALYSIS

Mushkin argues that 35 U.S.C. § 286 bars Anza's newly asserted claims, because Anza's damages predate the Second Amended Complaint by more than six years. Mot. to Dismiss 9–17, ECF No. 78. Furthermore, Mushkin contends the new claims are not sufficiently similar to those based on the '927 patent to relate back. *Id.* In response, Anza does not dispute that its damages accrued more than six years ago. Resp. to Mot. to Dismiss 13, ECF No. 79. However, Anza contends the new claims relate back, because they involve the same end products and electrical components. *Id.* at 8–13. Additionally, Anza believes proving infringement will require similar evidence. *Id.*

Pursuant to § 286, “no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.” 35 U.S.C. § 286. Although the Federal Circuit has not addressed Federal Rule of Civil Procedure 15(c)'s application to patent cases, district courts generally allow damages on claims filed outside of the six year period if they relate back to timely asserted causes of action. See, e.g., Barnes & Noble, Inc. v. LSI Corp., 823 F. Supp. 2d 980, 988–89 (N.D. Cal. 2011). Pursuant to Rule 15(c)(1)(B), new claims relate back when “the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading.”

District courts have taken various approaches when applying Rule 15(c) to claims based on separate patents. Some courts and commentators have stated that an infringement claim involving a different patent does not relate back as a matter of law. See Illinois Tool Works, Inc. v. Foster Grant Co., Inc., 395 F. Supp. 234, 250–51 (N.D. Ill. 1974) (“An alleged infringement of one patent is not the ‘same conduct, transaction or occurrence’ as the alleged infringement of another patent.”); 6A Charles Alan Wright & Arthur R. Miller, Fed. Prac. & Proc. § 1497 (3d ed. 2018) (“[A]mendments alleging . . . the infringement of a different patent . . . may be subject to the defense of statute of limitations because of a failure to meet the transaction standard.”). However, the majority of courts analyze whether the newly asserted patent is “part and parcel” of the original controversy. See Mann Design, Ltd. v. Bounce, Inc., 138 F. Supp. 2d 1174, 1178–79 (D. Minn. 2001); PerfectVision Mfg., Inc. v. PPC Broadband, Inc., 951 F. Supp. 2d 1083, 1093 (W.D. Ark. 2013). Courts have found claims part and parcel when the original action involves the same parties, same products, and similar technology. See, e.g., Ramsey Grp., Inc. v. EGS Int’l, Inc., 208 F.R.D. 559, 563 (W.D.N.C. 2002) (quoting In re Medrad, Inc., 215 F.3d 1341 (Fed. Cir. 1999) (unpublished table disposition)). However, when the newly asserted claims are not an integral part of those in the original complaint and will not involve the same evidence, § 286 bars damages for the new cause of action. See Metrologic Instruments, Inc. v. PSC, Inc., No. 99-4876 (JBS), 2004 WL 2851955, at *19 (D.N.J. Dec. 13, 2004); see also Mann Design, Ltd., 138 F. Supp. 2d at 1179.

Although a close call, I find that the claims based on the ’479 and ’864 patents are not part and

parcel of those asserted under the '927 patent. I first provide detailed background on the three patents. Then, I discuss why the claims are not sufficiently similar to relate back.

Anza applied for the '479 patent on February 25, 2000. '479 patent, at 2, ECF No. 75-3. The abstract describes the invention as, “[d]issipative ceramic bonding tips for wire bonding electrical connections to bonding pads on integrated circuit chips and packages.” *Id.* In discussing the purpose of the bonding tips, the abstract states, “to avoid damaging delicate electronic devices by any electrostatic discharge, an ultrasonic bonding wedge tool tip must conduct electricity at a rate sufficient to prevent charge buildup, but not at so high a rate as to overload the device being bonded.” *Id.* The claim giving rise to the present lawsuit—claim thirty-nine—protects “[a] method of using a bonding tip, comprising: bonding a device using a bonding tip made with a dissipative material that has a resistance low enough to prevent a discharge of charge to said device and high enough to avoid current flow large enough to damage said device.” *Id.* at 11 (the language of claim thirty-seven to which claim thirty-nine refers).

In December 2001, Anza applied for the '864 patent, ECF No. 75-4. The abstract for this patent states, “Methods for making and using dissipative ceramic bonding tool tips for wire bonding electrical connections to bonding pads on integrated circuit chips and packages.” '864 patent, at 2. Claim twenty-eight protects, “[a] method of using an electrically dissipative bonding tool tip, having a resistance in the range of 10⁵ to 10¹² ohms, comprising: providing the electrically dissipative bonding tool tip; bonding a material to a device;

allowing an essentially smooth current to dissipate to the device” Id. at 25.

On April 15, 2005, Anza applied for the ’927 patent, ECF No. 20-1. Unlike the ’479 and ’864 patents, this patent does not involve a wire bonding device. Instead, it protects a tool used while flip chip bonding. Id. at 2. The abstract states, “[a] flip chip bonding tool and ball placement capillary system comprising a dissipative material with a resistance low enough to prevent a discharge of a charge to a device being bonded and high enough to avoid current flow to the device being bonded” Id. Claims one and fourteen protect the flip chip bonding and ball placement tool, while claim sixteen protects,

A method of utilizing a flip chip bonding tool and ball placement capillary in a microelectronic assembly, comprising: providing a bonding machine capable of being equipped with a flip chip bonding tool and ball placement capillary having a tip comprised of a dissipative material, the dissipative material having a resistance low enough to prevent a discharge of a charge to a device being bonded and high enough to stop all current flow to the device being bonded.

Id. at 12–13.

Analyzing the factors courts consider when determining whether patent claims relate back, I conclude the newly asserted claims are not part and parcel of the original cause of action. Although the claims involve the same parties, they do not relate to identical products and technology. Regarding the products underlying the patents, the ’864 and ’479 claims protect a method of using a wire bonding tool, while the ’927 claim involved a flip chip bonding and solder ball placement tool. When the ’864 and ’479

patents were issued, the flip chip bonding tool was not even invented. Additionally, the products produced with the patented processes are not identical. Although Anza's Second Amended Complaint includes six of the infringing products listed in the First Amended Complaint, the Second Amended Complaint adds two new products and omits eleven. Compare First Am. Compl. ¶ 32, ECF No. 20, with Second Am. Compl. ¶ 37, ECF No. 75. Thus, this case is different from PerfectVision Manufacturing, Inc., in which the plaintiff alleged that a single device for connecting coaxial cables infringed two separate patents. 951 F. Supp. 2d at 1093–94; see also Intel Corp. v. Amberwave Sys. Corp., 233 F.R.D. 416, 418 (D. Del. 2005) (finding that two patent claims were part and parcel, in part because the claims involved “the same allegedly infringing devices”).

The two patents also involve different technologies and processes for bonding integrated circuit chips to electrical components. The '927 patent explains this distinction when it states, “[w]ire bonding techniques use ‘face-up’ chips with a wire connection to each pad. Bump or ‘flip chip’ microelectronic assembly, on the other hand, is a direct electrical connection of face-down—‘flipped’—electronic components onto substrates, circuit boards, or carriers by means of conductive bumps on a chip bond pad.” '927 patent, at 10. In Hooker Chemicals & Plastics Corp. v. Diamond Shamrock Corp., the court found two patents to be part and parcel, because both arose from a common application and “[b]oth concern the same [membrane cell] technology.” 87 F.R.D. 398, 403 (W.D.N.Y. 1980). Here, the '927 patent involves flip-chip bonding technology, while the '864 and '479 patents

involve wire bonding. To be sure, the two devices have the same purpose—bonding integrated circuit chips to printed circuit boards while minimizing electrostatic discharge. However, because different processes and technologies are used to achieve this purpose, I find they are not part and parcel of one another.

Furthermore, contrary to Anza's contention, proving infringement of the initial and new claims would not involve substantially the same evidence. Because the patents involve different processes, different evidence is required. Proving the '927 patent claims would require evidence of the flip chip bonding method and how the flip chip bonding and ball placement tool was used in making the allegedly infringing products. Conversely, proving the newly asserted claims requires evidence of the wire bonding process and how a wire bonding tool tip was used to produce the allegedly infringing products.

My finding is supported by the court's decision in Metrologic Instruments, Inc., 2004 WL 2851955. In that case, the court considered whether a parent patent (i.e., a patent that was issued prior to related patents) could be added to a suit in which the plaintiff already alleged infringement of the continuation patents. Id. at *19–20. In finding that the newly asserted parent patent did not relate back, the court stated:

[T]his is not a situation in which the amendment concerned the inclusion of a newly issued continuation patent of the patent-in-suit. Instead, the '342 patent is the parent application to the three later continuations—the '027 patent, the '717 patent, and the '049 patent—all three of which were included in the original Complaint. While it may be said

that a Complaint including allegations of infringement of the parent patent (the '342) would provide sufficient notice of infringement of the continuations (the '027, '717, and '049 patents) as well, the reverse does not necessarily hold true.

Id. at *20. Similarly, although the '947 patent is a partial continuance of the '864 and '479 patents, it does not follow that the '947 claims gave Mushkin notice of potential claims arising under the older '864 and '479 patents. If Anza had first asserted claims based on the older wire bonding technology and then attempted to add a cause of action for infringement of the flip chip bonding tool, the claim may have related back. However, the reverse “does not necessarily hold true.” Id.

Anza contends the patents are part and parcel, because the claims in the '864 and '479 patents could incorporate flip chip bonding. Resp. to Mot. to dismiss 10. At first glance this appears to be a viable argument, since claim thirty-nine of the '479 patent and claim twenty-eight of the '864 patent do not specifically mention wire bonding. However, further review of these patents reveals they concern only wire bonding. Indeed, the abstracts specifically state that the patents protect tips used while “wire bonding electrical connections.” '479 patent, at 2; '864 patent, at 2. Furthermore, as Mushkin states (and Anza does not rebut) the flip chip tool had not been invented when these patents were issued. See Mot. to Dismiss 11. Thus, it is clear that the claims at issue protect only the use of “an electrically dissipative [wire] bonding tool tip.” '479 patent, at 11; '864 patent, at 25.

The upshot is that Anza's First Amended Complaint would not have put Mushkin on notice

that Anza would bring claims based on different patents involving an older process and technology. In other words, informing Mushkin that products it manufactured or sold impermissibly used a flip chip bonding tool would not give it notice that some of those same products (and some new products) impermissibly used a wire bonding tool tip. This is especially true, given that Anza's informal infringement contentions dropped claim sixteen of the '947 Patent, which was the most similar claim to those presently asserted. Tr. of Mot. Hearing 12:10–:12, ECF No. 74. Accordingly, the claims do not share sufficient similarities to relate back. Because the latest infringement Anza alleges occurred more than six years before it filed the Second Amended Complaint, § 286 bars all damages for the newly asserted patent infringement claims.¹

CONCLUSION

In sum, the claims Anza asserts in its Second Amended Complaint are not sufficiently similar to its prior claims to relate back. Because Anza acknowledges that Mushkin's allegedly infringing conduct took place more than six years ago, § 286 precludes damages for Anza's claims. Accordingly, Mushkin's Motion to Dismiss Anza's Second Amended Complaint [filed July 6, 2018; ECF No. 78] is **granted**. The Clerk of the Court is directed to close this case.

Entered and dated at Denver, Colorado, this 28th day of August, 2018.

BY THE COURT:

Michael E. Hegarty

United States Magistrate Judge

fn. 1 Because I find this statute precludes Anza's new patent claims, I need not analyze Mushkin's other arguments for dismissal.