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October 18, 2022

**VIA ECF**

Hon. Lee G. Dunst  
United States Magistrate Judge  
Eastern District of New York  
100 Federal Plaza, Room 830  
Central Islip, New York 11722

**Re: *Slingshot Printing LLC v. Canon U.S.A., Inc., et ano.*,  
Case No. 22-cv-00123 (HG) (LGD) (“*Slingshot I*”)**

***Slingshot Printing LLC v. Canon U.S.A., Inc., et ano.*,  
Case No. 22-cv-01852 (HG) (LGD) (“*Slingshot II*”)**

Dear Judge Dunst:

My firm is co-counsel for defendants Canon U.S.A., Inc. and Canon Solutions America, Inc. (together, “Canon”) in the above-referenced actions, *Slingshot I* and *Slingshot II*. Pursuant to the Court’s Scheduling Orders dated July 5, 2022 and September 19, 2022, we write on behalf of both parties to submit the following joint status update in advance of the conference scheduled for October 21, 2022.

**1. Brief Summary of the Nature of the Claims and Defenses Alleged:**

**Slingshot’s Claims:**

Slingshot Printing LLC filed this action for patent infringement against Canon U.S.A., Inc. and Canon Solutions America, Inc. Canon U.S.A. and Canon Solutions both offer for sale a variety of inkjet printers.

The Patents in Suit relate to inkjet printer technology. Inkjet printers accomplish printing by ejecting ink from small nozzles on a printhead. The printhead generally includes a semiconductor substrate (or “chip”) having, among other features, ink ejection actuators that heat and eject ink through corresponding nozzles, temperature sensing elements, and means of supplying power. As alleged in *Slingshot I* and *Slingshot II*, U.S. Patent No. 7,152,951, U.S. Patent No. 7,195,341, U.S. Patent No. 7,559,629, U.S. Patent No. 7,484,823, U.S. Patent No. 7,594,708 and U.S. Patent No. 7,290,864 relate to printheads for inkjet printers or components thereof and U.S. Patent No. 7,938,523 relates to ink cartridges designed with venting elements.

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The Patents in Suit were originally assigned to Lexmark International, Inc. and then later assigned to Funai Electric Co., Ltd. when Funai acquired Lexmark's inkjet printing intellectual property. Funai subsequently assigned the Patents in Suit to Slingshot.

Slingshot has accused a variety of inkjet printers and ink cartridges of infringement, as explained in the Complaints and attached claim charts. Slingshot seeks damages for patent infringement; a judgment that the Patents in Suit are valid, enforceable, and infringed; a permanent injunction against infringement without additional compensation; and fees, costs, and expenses.

### **Canon's Defenses and Counterclaims:**

Canon has asserted counterclaims for non-infringement and invalidity with respect to each patent asserted by Slingshot. Canon's counterclaims for patent invalidity and non-infringement mirror non-infringement and invalidity defenses to Slingshot's infringement claims.

#### **2. Current Status of Discovery**

On June 30, 2022, the parties submitted the same proposed case management plan and discovery schedule in both *Slingshot I* and *Slingshot II*. (See *Slingshot I*, Dkt. 30; *Slingshot II*, Dkt. 24.) Following an initial pretrial conference with the parties, the Court issued a scheduling order on July 5, 2022 that "So Ordered" the parties' proposed case management plan and discovery schedule and essentially consolidated *Slingshot I* and *Slingshot II* for discovery purposes.

Pursuant to the "So Ordered" discovery schedule, the parties exchanged their Rule 26(a) initial disclosures on August 5, 2022. Slingshot then served its Disclosure of Asserted Claims and Infringement Contentions on August 18, 2022 pursuant to Local Patent Rule 6, and Canon served its Invalidity Contentions on October 17, 2022 pursuant to Local Patent Rule 7.

The "So Ordered" discovery schedule also provided for the completion of "Phase I Discovery" by October 7, 2022. However, before Phase I Discovery could be completed, the parties first attempted to negotiate the terms of a proposed Stipulation and Order Regarding Confidential Information ("Protective Order"). A dispute arose regarding two terms in the proposed Protective Order, and in a joint submission dated September 14, 2022, the parties requested the Court's assistance in resolving that dispute. (See *Slingshot I*, Dkt. 38; *Slingshot II*, Dkt. 32.) This Court then issued an order on September 19, 2022 staying the Phase I Discovery deadline pending resolution of the dispute.

The parties believe that Phase I Discovery can be completed promptly upon the Court resolving the issues relating to the proposed Protective Order. Following the completion of Phase I Discovery, the parties will proceed with Phase II Discovery pursuant to the deadlines set forth in the current "So Ordered" discovery schedule, subject to the Court's ruling on Canon's motion for a stay, discussed in Section 4, below.

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### **3. Dispute Concerning Final Contentions**

The parties previously advised the Court that they had a dispute regarding the need for “final contentions.” The Court instructed the parties to continue their discussions regarding the need for final contentions, and in its July 5, 2022 Scheduling Order, the Court directed that “[i]f an issue regarding a final [contentions] date remains outstanding, the joint letter should include each party’s position.” Because the parties have been unable to resolve this dispute, they are providing their positions below, as directed.

#### **Slingshot’s Position:**

Slingshot proposes following the Court’s Local Patent Rules, which do not require “final” contentions at a specified date. The parties can, and surely will, seek discovery relating to particular aspects of infringement, non-infringement, validity, and invalidity contentions, and responses should be supplemented in a timely manner pursuant to Fed.R.Civ.P. 26(e). Further, these matters will be the subject of expert reports and related depositions, and requiring “final” disclosure of contentions prior to expert report deadlines would be largely duplicative of expert discovery and also may lead to unnecessary arguments regarding whether one side has forfeited positions that its experts later wish to address. On the other hand, setting a “final” contention deadline after expert discovery provides incentives to wait until late in the case to disclose important theories. Given the nature of fact and expert discovery, there is no need to separately set a deadline for final infringement/invalidity contentions.

#### **Canon’s Position:**

Canon requests that this Court order the parties to serve Final Infringement and Validity Contentions (Slingshot) and Final Invalidity and Non-Infringement Contentions (Canon) (collectively, “Final Contentions”) after claim construction and before the close of fact discovery. *See* D.I. 30 and 31. This Court’s Local Patent rules require that the parties serve preliminary contentions but are silent as to when those contentions are considered final, *i.e.*, closed to new theories. Many judges in districts with high concentrations of patent cases, including those in the District of Delaware, Western District of Texas, and Northern District of Illinois, require that the parties serve Final Contentions articulating their claims and defenses, as well as the facts that support them, before moving into expert discovery and trial.<sup>1</sup> This ensures that each side has notice of the other’s positions, an adequate opportunity to take fact discovery and formulate responses, and prevents sandbagging through late disclosure during expert discovery after the factual record is closed. Final Contentions are not, as Slingshot suggests, duplicative of expert discovery, but rather shapes the bounds of permissible expert discovery.

### **4. Canon’s Request to File a Motion to Stay**

On September 9, 2022, Canon filed a letter requesting a pre-motion conference and/or leave to file a motion for a stay of *Slingshot I*. (*See Slingshot I*, Dkt. 37.) Canon respectfully requests that this Court

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<sup>1</sup> *See e.g.*, <https://www.ded.uscourts.gov/sites/ded/files/chambers/April%202021%20-%20MN%20Scheduling%20Order%20-%20Patent%20NON-ANDA.pdf>; <https://www.txwd.uscourts.gov/wp-content/uploads/Standing%20Orders/Waco/Albright/Standing%20Order%20Governing%20Proceedings%20Patent%20Cases%20041422.pdf>; [https://www.ilnd.uscourts.gov/\\_assets/\\_documents/\\_rules/localpatentrules-preamble.pdf](https://www.ilnd.uscourts.gov/_assets/_documents/_rules/localpatentrules-preamble.pdf)

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grant Canon leave to file its motion and set a briefing schedule. Slingshot filed a response to Canon's letter on September 16, 2022 opposing the request for leave as premature. (*See Slingshot I*, Dkt. 40.)

To the extent the Court believes that a pre-motion conference would be helpful, counsel for the parties will be prepared to address the matter during the conference scheduled for October 21, 2022, if the Court desires.

**5. History of Settlement Discussions**

The parties have not yet engaged in any settlement discussions. No demands or offers have been made.

**6. Submission of Joint Status Letter and Proposed Status Conference**

The parties propose that another joint status letter be submitted by January 18, 2023, and that a telephonic status conference with the Court be scheduled on or after January 20, 2023, if necessary.

Respectfully,  
*/s/ Grant A. Shehigian*  
Grant A. Shehigian

cc: Counsel of Record (via ECF)