IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

IMPOSSIBLE FOODS INC., *Plaintiff*, v. MOTIF FOODWORKS, INC., *Defendant*.	§ § § § § § § § § §	Civil Action No. 22-311-WCB

ORDER

I. BACKGROUND

Impossible Foods Inc., filed this action on March 9, 2022, charging Motif Foodworks, Inc., with infringement of U.S. Patent No. 10,863,761. Dkt. No. 1. On July 25, 2022, Impossible amended its complaint for the first time, adding allegations of infringement of four new patents in addition to the '761 patent (the five patents asserted in the amended complaint are collectively referred to as the "Food Products Patents"). On September 7, 2022, Impossible filed a Second Amended Complaint, which added two new patents (the "Yeast Patents"). On July 3, 2023, Impossible filed a Third Amended Complaint, which added Ginkgo Bioworks, Inc., as a defendant with respect to the Yeast Patents. On July 25, 2023, the court modified the scheduling order, directing that the Food Products Patent case and the Yeast Patents case be tried separately and proceed on separate timelines. Dkt. No. 161. The deadline to amend pleadings and join parties in the Yeast Patents case was December 1, 2023. *Id.* at ¶ 7. The same deadline in the Food Products Patents case was June 20, 2023. Dkt. No. 37 at 3.

On December 1, 2023, the last day to amend pleadings in the Yeast Patents case, Impossible moved to amend its Yeast Patents complaint, adding a new claim against Motif under the Defend Trade Secrets Act. Dkt. No. 284. The new claim was based on actions by a third party, The [redacted] The asserted trade secrets relate generally to production of heme proteins, including logistical details such as cost structures and production output. Dkt. No. 284-1 at ¶¶ 94-95. The Yeast Patents, on the other hand, relate to the underlying nucleic acid sequences encoding those heme proteins. *See e.g.,* U.S. Patent No. 10,273,492 at 7748–57 (claim 1); *see also* U.S. Patent No. 10,689,656 at 87:31–41 (claim 1). Motif and Ginkgo both oppose Impossible's motion.

II. LEGAL STANDARD

Impossible's request for leave to amend is governed by Federal Rule of Civil Procedure 15(a)(2), which instructs the court to grant leave to amend "when justice so requires." Among other reasons, the court has discretion to deny leave if the amendment would be "prejudicial to the opposing party." *Bjorgung v. Whitetail Resort, LP*, 550 F.3d 263, 266 (3d Cir.2008); *see also Genentech, Inc. v. Amgen Inc.*, No. CV 17-1407-CFC, 2020 WL 708433, at *1 (D. Del. Feb. 12, 2020). In evaluating prejudice to the opposing party, courts consider "whether allowing an amendment would result in additional discovery, cost, and preparation to defend against new facts or new theories." *Cureton v. Nat'l Collegiate Athletic Ass'n*, 252 F.3d 267, 273 (3d Cir. 2001). "The decision to grant or deny leave to amend lies within the discretion of the court." *Sonos, Inc. v. D&M Holdings Inc.*, No. CV 14-1330-RGA, 2017 WL 476279, at *1 (D. Del. Feb. 3, 2017) (citing *Foman v. Davis*, 371 U.S. 178, 182 (1962)).

III. DISCUSSION

Granting Impossible leave to amend for a fourth time would unfairly prejudice Ginkgo and would render this case unwieldy for a jury.

The court has already recognized the prejudice to Ginkgo of trying the Food Products and Yeast Patents cases together. The same concerns underly Impossible's proposed amendment. The proposed amendment will create jury confusion about which claims apply to which defendant. *See Philips Elecs. N. Am. Corp. v. Contec Corp.*, 220 F.R.D. 415, 418 (D. Del. 2004) (noting "the real prospect that the jury will assume [one party] is liable for patent infringement by association with [the other]"). To the extent that the jury finds Motif acted wrongly in relation to Impossible's trade secrets, it may improperly impute that behavior to Ginkgo based on Ginkgo's business relationship with Motif.

The appropriate case in which Impossible should have amended its claims was the Food Products Patents case, to which Ginkgo is not a party and bears no risk of prejudice. That deadline passed on June 30, 2023. Dkt. No. 37 at 3. Although Impossible asserts that it did not discover the alleged trade secret misappropriation until after that deadline, the belated discovery does not justify amendment in a largely dissimilar case.

While the proposed trade secret claims and existing patent claims both depend on the same background information, they ultimately turn on entirely different facts. For example, the trade secret claims involve questions such as the degree to which Motif is responsible for [redacted] actions—questions far afield of patent infringement. This case already involves 17 asserted claims across two patents, against two defendants. The addition of trade secret claims against only Motif will further complicate an already complicated case. *See Genentech, Inc. v. Amgen Inc.*, No. CV 17-1407-CFC, 2020 WL 708433, at *2 (D. Del. Feb. 12, 2020) (denying leave to amend in part,

where proposed amendment added a claim of patent infringement concerning a different drug than the one already at issue in the case; reasoning that the expansion of an already "unwieldy" case would undermine the court's efforts to "drive the case to a reasonable and efficient conclusion."). The added efficiency of trying these claims together does not outweigh the prejudice, particularly to Ginkgo, of having to defend allegations of patent infringement in a case cluttered with other issues directed solely at another defendant.

Accordingly, Impossible's motion for leave to amend is DENIED. Impossible is free to pursue its trade secret claims in a separate action against Motif, but not in the unrelated action to which Ginkgo is a party.

This order has been filed under seal because the parties' briefs and exhibits pertaining to the present motions were filed under seal. Within three business days of the issuance of this order, the parties are directed to advise the court by letter whether they wish any portions of the order to remain under seal. Any request that portions of the order should remain under seal must be supported by a particularized showing of need to limit public access to those portions of the order.

IT IS SO ORDERED.

SIGNED this 19th day of January, 2024.

William C. Bryson

WILLIAM C. BRYSON
UNITED STATES CIRCUIT JUDGE