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17 **UNITED STATES DISTRICT COURT**
18 **NORTHERN DISTRICT OF CALIFORNIA**

19 UNIVERSITY OF BRITISH COLUMBIA,
20 Plaintiff,
21 v.
22 CAPTION HEALTH, INC.,
23 GE HEALTHCARE TECHNOLOGIES INC.,
24 Defendants.

Case No. 5:24-cv-3200-EKL
**JOINT STATEMENT REGARDING
DISCOVERY DISPUTE OVER
PLAINTIFF'S AMENDED
INFRINGEMENT CONTENTIONS**
Judge: Hon. Eumi K. Lee
Magistrate Judge: Hon. Susan van Keulen

26 **REDACTED VERSION OF DOCUMENT FILED UNDER SEAL**

1 Pursuant to section 7(b) of Magistrate Judge van Keulen’s Standing Order, Plaintiff
2 University of British Columbia (“UBC” or “Plaintiff”) and Defendants Caption Health, Inc. and
3 GE HealthCare Technologies, Inc. (collectively “Defendants”), submit this joint statement
4 regarding a discovery dispute in this patent infringement case. The Court has not set a date for the
5 close of fact discovery or trial. UBC recently served its second supplemental infringement
6 contentions to which it attached amended claim charts for its U.S. Patent No. 11,129,591 (“the ’591
7 patent”). The parties have attached as Exhibit 1 and Exhibit 2 redlined copies of these claim charts
8 comparing them to the prior versions. Defendants contend that UBC did not have leave of court or
9 good cause to serve these charts. UBC contends that it had both leave of court and good cause. As
10 a compromise, Defendants proposed that Plaintiff withdraw the portions of the claim charts relating
11 to the doctrine of equivalents. This compromise was rejected. Defendants now request a Court order
12 striking the entirety of the amended claim charts.

13 **I. Defendants’ Position**

14 UBC recently served amended claim charts for the ’591 patent without leave of court and
15 in violation of Patent Local Rule 3-6. But even if UBC had sought leave of court, it had no good
16 cause for many of its amendments, which are prejudicial to Defendants and are based on
17 information that is publicly-available or that UBC had already received before it filed its initial
18 infringement contentions. As a result, the Court should strike the amended claim charts.

19 **Background**

20 On May 28, 2024, UBC filed suit against Defendants asserting the ’591 patent. (Dkt. 1.)
21 The technology at issue relates to software to assist in obtaining medical images. On August 30,
22 2024, Defendants filed their Answer, Affirmative Defenses, and Counterclaims. The counterclaims
23 included a counterclaim of noninfringement of the ’591 patent, in which Defendants described the
24 accused products and many of Defendants’ noninfringement positions in detail. (Dkt. 33,
25 Counterclaims at ¶¶ 14–46.)

26 The Court subsequently set a deadline of October 23, 2024 for UBC to serve its Patent Local
27 Rule 3-1 infringement contentions. On October 23, 2024, UBC served infringement contentions
28 and attached two exhibits: (1) a 104-page claim chart for use of the accused Caption AI software

1 with Venue products; and (2) a 99-page claim chart for use of the accused Caption AI software
2 with Vscan products.

3 On October 29, 2024, Defendants sent correspondence to UBC, noting that the contentions
4 did not provide, *inter alia*, a disclosure of “[w]hether each limitation of each asserted claim is
5 alleged to be literally present or present under the doctrine of equivalents,” as required by Patent
6 Local Rule 3-1(e). Defendants asked UBC to supplement its contentions so that they included the
7 missing parts.

8 On November 22, 2024, UBC served its first supplemental infringement contentions and
9 attached two claim charts that were unchanged from the earlier versions except that UBC had added
10 the following language to address Patent Local Rule 3-1(e): “To the extent Defendants do not
11 literally infringe this claim element requiring [quote from patent claim], Defendants infringe this
12 claim element under the doctrine of equivalents because the accused structure performs
13 substantially the same function in substantially the same way to achieve substantially the same
14 result.”

15 On December 16, 2024, Defendants sent a letter to UBC noting that the boilerplate language
16 quoted above is not sufficient to satisfy Patent Local Rule 3-1(e). *Geovector Corp. v. Samsung*
17 *Elects. Co. Ltd.*, No. 16-CV-02463-WHO, 2017 WL 76950, at *10 (N.D. Cal. Jan. 9, 2017). They
18 also noted that “[i]t is improper to assert the doctrine of equivalents with generic ‘placeholder’
19 language on the hope that future discovery might support such an assertion.” *InteraXon Inc. v.*
20 *NeuroTek, LLC*, No. 15-c-05290-KAW, 2016 WL 5118267, at *2 (N.D. Cal. Sept. 21, 2016).
21 Defendants made clear their position that UBC had waived its right to assert the doctrine of
22 equivalents and that Defendants would object to any attempt by UBC to make a doctrine of
23 equivalents argument later in the case. UBC never responded to this letter or requested leave of
24 court to amend or supplement its doctrine of equivalents positions.

25 On December 20, 2024, UBC filed its First Amended Complaint, adding a claim for
26 infringement of United States Patent No. 10,751,029 (“the ’029 patent”). In light of this
27 amendment, the parties agreed to move the Court to modify the scheduling order. The parties filed
28 a Joint Motion to Modify Case Schedule in which they represented to the Court in relevant part:

1 The parties have started to make various disclosures relating to the claims of the
2 '591 patent, but they will need to make the same disclosures for the claims of the
3 '029 patent. Rather than having two tracks of deadlines—one for the '591 patent
4 and one for the '029 patent—the parties seek to create a single track of deadlines
5 for both patents. ***Under the parties' proposed schedule, Plaintiff will serve its
6 infringement contentions for the claims of '029 patent by February 7;*** Defendants
7 will serve their invalidity contentions for the claims of the '029 patent by March
8 28; and by April 11, the parties will exchange claim terms from the '029 patent for
9 construction. ***From that point forward, the remaining dates and deadlines will
10 apply to both the '591 and '029 patent.***

11 (Dkt. 48 at 4 (emphasis added).) Thus, the parties agreed to a February 7 date for Plaintiff to serve
12 infringement contentions for its newly-asserted '029 patent, and did not agree that Plaintiff could
13 (again) amend its contentions for the '591 patent. Further, after the parties exchanged claim terms
14 for the '029 patent on April 11, both patents would then be on the same track from there on out.

15 On January 2, 2025, the Court granted the parties' Joint Motion and entered the parties'
16 Proposed Order with certain modifications unrelated to the present dispute. (Dkt. 49.)

17 On February 7, 2025, UBC served its second supplemental infringement contentions,
18 addressing not only the newly-added '029 patent but also the previously-asserted '591 patent. The
19 attached claim charts for the '591 patent had more than doubled to a length of 232 pages (for
20 Caption AI with Venue) and 237 pages (for Caption AI with Vscan). Among other things, UBC
21 had added substantive doctrine of equivalents positions, added material from publicly-available
22 documents, and even stated new infringement theories. As an example of this last point, see page
23 12 of Exhibit 1 and page 9 of Exhibit 2, where UBC essentially deleted two sentences explaining
24 its infringement position for claim 1[b] and replaced them with a new position. (See also Ex. 1 at
25 51 & Ex. 2 at 55–56 (adding the new theory that [REDACTED]
26 [REDACTED]
27 [REDACTED].)

28 On February 18, 2025, UBC provided to Defendants redlines showing the changes it had
made to the claim charts for the '591 patent. The very next day, Defendants sent correspondence to
UBC objecting that it had made massive amendments without leave of court. Following additional
back and forth via email, the parties met via video conference on February 26, 2025 but were unable
to resolve their dispute, leaving Defendants with no choice but to seek assistance from the Court.

Legal Standard

Patent Local Rule 3-6 provides that “[a]mendment of the Infringement Contentions . . . may be made only by order of the Court upon a timely showing of good cause.” Further, “[t]he duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.” This Court strikes infringement contentions that are filed without leave of court or good cause. *See, e.g., Informatica Corp. v. Bus. Objects Data Integration, Inc.*, No. C 02-3378 JSW, 2006 U.S. Dist. LEXIS 10106, at *4 (N.D. Cal. Feb. 23, 2006).

Argument

A. The Court Should Strike UBC’s Amended Claim Charts for the ’591 Patent Because They Were Served Without Leave of Court.

Under the express terms of Patent Local Rule 3-6, UBC needed leave of court to serve amended infringement contentions for the ’591 patent. UBC suggests that it had leave as a result of the Court’s order granting the parties’ Joint Motion to Modify Case Schedule. But in the parties’ joint motion, they made clear their shared understanding that the February 7, 2025 deadline for serving infringement contentions would apply only to contentions directed to the newly-asserted ’029 patent and not contentions directed to the previously-asserted ’591 patent. It does not make sense that the Court, in granting the parties’ motion, would *sub silentio* grant the parties different relief than what they had requested. In any event, UBC should be estopped from now taking a position that is contrary to what it agreed to in the parties’ joint motion. UBC failed to seek leave of court, and the Court should strike UBC’s amended claim charts for the ’591 patent on that basis alone.

B. The Court Should Strike UBC’s Amended Claim Charts for the ’591 Patent Because UBC Lacked Good Cause for its Amendments.

UBC also lacked good cause for many of the amendments to its claim charts, which are based on information that is publicly-available or that UBC had already received in this case.

In its amended claim charts, UBC fleshed out its doctrine of equivalents positions, even though it already had the information it needed for those positions prior to serving its initial infringement contentions. Its new positions rely on the [REDACTED] features in

1 Defendants' accused products. (*See* Ex. 1 at p. 31, 50, 65–66, 72–73, 80–81, 87, 107, 145, 171,
2 173–75, 188–93, 197; Ex. 2 at 27, 47, 68–69, 75–76, 83–84, 90, 110, 148, 174, 176–78, 191–96,
3 200.) But Defendants described these [REDACTED] features in their Counterclaim
4 for noninfringement of the '591 patent, which was filed on August 30, 2024, well before UBC
5 served its initial infringement contentions on October 23, 2024. (Dkt. 33, Counterclaims at ¶¶ 14–
6 46.) Tellingly, when the parties met and conferred on this matter, UBC's counsel acknowledged
7 that UBC's doctrine of equivalents positions were based upon information in Defendants' Answer,
8 Affirmative Defenses, and Counterclaims. Thus, UBC had the information that it needed to make
9 its doctrine of equivalents arguments when it served its initial infringement contentions. It simply
10 failed to do so, and now it wants a second bite at the apple.

11 UBC's amended claim charts also add material based on documents that were publicly-
12 available online before UBC served its initial infringement contentions. For example, UBC's claim
13 charts add citations to YouTube videos from 2021 and early 2024. (*See* Ex. 1 at 15; Ex. 2 at 12, 29,
14 42.) Indeed, UBC's claim chart for the Caption AI software used with Vscan includes a stretch of
15 four consecutive pages where UBC has added only publicly-available materials. (Ex. 2 at 48–51.)

16 UBC's amendments are also prejudicial to Defendants. Defendants have already prepared
17 and served their invalidity contentions based on the scope of the claims apparent from UBC's initial
18 infringement contentions. By amending their infringement contentions now to disclose new
19 positions on, for instance, the doctrine of equivalents, UBC is effectively asserting that its patent
20 claims are different and broader in scope than previously disclosed and relied upon by Defendants
21 in preparing their invalidity contentions.

22 Because UBC amended its infringement contentions for the '591 patent without leave of
23 court or good cause, the Court should strike the amended claim charts.

24 **II. Plaintiff UBC's Position**

25 Defendant's motion should be denied because Plaintiff University of British Columbia
26 ("UBC") served its infringement contentions consistent with the revised schedule the parties agreed
27 upon and the Court entered. Defendants drafted the motion and proposed order that sets forth a
28 single schedule for both patents. UBC complied with the schedule.

1 Further, Defendants are suffering no plausible prejudice. Other than their complaints about
 2 the supplementations to the Doctrine of Equivalents (DOE) assertions, Defendants do not contend
 3 that UBC added any new infringement theories—the revisions simply provide additional
 4 evidentiary support to the theories previously disclosed. Adding publicly-available information to
 5 a pre-existing infringement theory does not create prejudice. And after the latest extension they
 6 requested, Defendants will get more than twice the time provided by the local rules to prepare
 7 invalidity contentions and intend to do it for both patents (consistent with a unified schedule and
 8 inconsistent with their position on the infringement contention deadline).

9 Finally, even if there were merit to Defendants claim that UBC needed to move to amend,
 10 UBC had good cause for the amendment based on new evidence obtained in discovery, including
 11 the review of source code. Again, Defendants complain that UBC supplemented its DOE theory,
 12 but that was based, at least in part, on information received in discovery. Each of these issues is
 13 addressed further below.

14 **A. UBC Served Infringement Contentions Consistent with the Schedule.**

15 Defendants’ entire motion is premised on the argument that the February 7, 2025, deadline
 16 in the Court’s modified scheduling order (Dkt. No. 49) applies only to contentions for the ‘029
 17 patent. But there is nothing in the Court’s order that states such a thing.

18 The relevant portion of the order is excerpted below:

19

Event	Deadline
Infringement Contentions & Accompanying Production Pat. L.R. 3-1 & 3-2	February 7, 2025
Deadline to Complete Initial ADR Session	February 21, 2025
Deadline to Answer or Otherwise Respond to First Amended Complaint Fed. R. Civ. P. 15(a)(3)	February 28, 2025

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Event	Deadline
Invalidity Contentions & Accompanying Production Pat. L.R. 3-3 & 3-4.	March 28, 2025
Exchange of Terms for Construction Pat. L.R. 4-1	April 11, 2025
Exchange of Preliminary Constructions and Extrinsic Evidence Pat. L.R. 4-2	May 2, 2025
Plaintiff's Damages Contentions Pat. L.R. 3-8	May 9, 2025
Joint Claim Construction & Prehearing Statement Pat. L.R. 4-3	May 30, 2025
Defendants' Responsive Damages Contentions Pat. L.R. 3-9	June 13, 2025
Completion of Claim Construction Discovery Pat. L.R. 4-4	June 27, 2025
Plaintiff's Opening Claim Construction Brief Pat. L.R. 4-5(a)	July 11, 2025
Defendants' Responsive Claim Construction Brief Pat. L.R. 4-5(b)	July 25, 2025
Plaintiff's Reply Claim Construction Brief Pat. L.R. 4-5(c)	August 1, 2025

As can be seen above, the Order does not distinguish between the two patents for contentions or anything else. Both infringement contentions and invalidity contentions are single deadlines. There is no ambiguity in the Court's order. This is a sufficient basis to deny Defendants' motion.

1 Further, this schedule was drafted and proposed by Defendants. In the email exchange that
2 led to the filing of the stipulation that resulted in the schedule, Defendants' counsel stated that the
3 "schedule should be reset in such a way that the '591 patent and the '029 patent are not on separate
4 tracks."¹ That email never said or suggested that the new dates for infringement contentions would
5 be limited to the '029 patent. They subsequently proposed a schedule that did not show separate
6 tracks for either patent for any contentions. In response to the proposal, UBC "tightened" some of
7 the deadlines, but otherwise agreed to the format of the schedule.

8 After the email exchange above, Defendants drafted, and UBC approved, the motion
9 proposing that schedule. *See* Dkt. No. 48. Defendants now seize on two sentences in that motion
10 (as opposed to the terms of the proposed schedule) to argue that the deadline for infringement
11 contentions was limited to the '591 patent. But those sentences are, at best, ambiguous. The relevant
12 paragraph expressly states: "Rather than have two tracks of deadlines – one for the '591 patent and
13 one for the '029 patent – *the parties seek to create a single track of deadlines for both patents.*"
14 Dkt. No. 48 (emphasis added). That statement is consistent with the schedule Defendants originally
15 proposed and the schedule submitted to the Court. The next sentence states the dates on which the
16 parties will submit their contentions for the '029 patent but never indicates that the revised
17 deadlines did not apply to both patents. *Id.* If that had been the intent, Defendants should have made
18 that clear in the schedule originally proposed to UBC, and the schedule and proposed order to the
19 Court. UBC understood that the parties agreed to revise the schedule following the addition of the
20 '029 patent, and that the revised schedule was intended to create a "single track of deadlines for
21 both patents." This is a reasonable interpretation of Defendants' proposal and follows the literal
22 language of the Court's scheduling order.

23 Further, Defendants are taking inconsistent positions because they have made clear that they
24 intend to treat the revised deadline for invalidity contentions as the deadline for *both patents*. More
25 specifically, the Defendants served their original invalidity contentions on the '591 patent on
26

27 ¹ UBC intended to attach the relevant email thread as an exhibit but Defendants indicated
28 the Court's Standing Order does not allow such exhibits. If the Court would like to see the thread
that led to the agreement on the schedule, UBC will provide it.

1 December 6, 2024. The revised schedule provides a new date for invalidity contentions as of March
2 28, 2025. Nevertheless, Defendants asked for an extension of that date, indicating that they intend
3 to provide invalidity contentions for **both** patents (and allegedly needed the extension because of
4 the revised '591 infringement contentions). It makes no sense to treat the new schedule as having
5 different dates for infringement contentions for each patent, but the same deadline for invalidity
6 contentions.

7 **B. Defendants are Suffering No Legitimate Prejudice.**

8 Because UBC complied with the Court's schedule, Defendants' motion should be denied.
9 In addition, however, Defendants are suffering no legitimate prejudice from UBC's amendment to
10 the original '591 contentions. This case is still in its earliest stages, and almost no discovery has
11 been pursued (e.g., no depositions). Although invalidity contentions are not a "response" to
12 infringement contentions, Defendants will also have more than twice the time provided in the Local
13 Patent Rules to serve such contentions. In particular, in response to Defendants' request, the parties
14 filed a Joint Stipulation extending Defendants' deadline to serve invalidity contentions from March
15 28, 2025, to April 18, 2025 (Dkt. No. 55). This results in Defendants having 70 days to serve
16 invalidity contentions as opposed to the 34 days under Local Patent Rules 3-3.

17 Further, other than the complaints about the additions to the DOE contentions, Defendants
18 do not contend that the amended contentions raise any new theories of infringement.² At most, the
19 revised contentions simply add more evidence to support the existing theories. For example, UBC's
20 revisions following its contentions served on November 22, 2024, were based on technical
21 documents that Defendants produced on November 22, 2024, and December 6, 2024
22 (CAPTION00000001-CAPTION00000078 and CAPTION00000452, hereinafter "new technical
23 documents"), and those additions merely explained the existing theories in more detail in light of
24 the newly produced information. And although Defendants contend that "many" of the
25 supplementations are based on public information, they do not deny the supplementations included
26 references to information that Defendants produced in discovery, including source code that was

27
28 ² As Defendants mention, they were willing to drop this motion if UBC agreed to remove its supplements to its DOE arguments.

1 produced on January 27 and 28, just one week before the infringement contentions were due.
 2 Further, some of that source code review was focused on Defendants' contention that its
 3 [REDACTED] values do not literally satisfy the claim limitation of a quality assessment
 4 value. UBC added citations to source code and the new technical documents in support of its
 5 contention that [REDACTED]
 6 [REDACTED], or, at the least, is equivalent under the DOE. This
 7 was in direct response to Defendants' non-infringement position in its Answer, and to the discovery
 8 that UBC took between the time of the Answer and February 7, 2025. While Defendants may not
 9 like that UBC more specifically articulated its infringement theory under the DOE, that articulation
 10 does not result in legitimate prejudice.

11 **C. Defendants Request to Strike all Amendments as Overly Broad.**

12 As discussed above, many of the changes to the infringement contentions were based on
 13 evidence that UBC received in discovery, including based on a review of relevant source code.
 14 Nevertheless, Defendants claim that *all* revisions should be stricken. The request is obviously
 15 overly broad. There are no new infringement theories – Defendant simply supplemented the
 16 evidence to support existing theories. At most, this included providing additional explanation for
 17 its claims under DOE. There is no justification for striking any of the revisions.

18
 19 Dated: March 19, 2025

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23 **ATTESTATION**

24 Pursuant to Civil Local Rule 5-1(i)(3), I hereby attest that all signatories to this document
25 concur in its filing.

26 Dated: March 19, 2025

/s/ Marla R. Butler
Marla R. Butler