

1 Ramsey M. Al-Salam, CA Bar No. 109506
RAlsalam@perkinscoie.com
2 Dorianne Salmon, pro hac vice
DSalmon@perkinscoie.com
3 PERKINS COIE LLP
1201 Third Avenue, Suite 4900
4 Seattle, Washington 98101-3099
Telephone: +1.206.359.8000
5 Facsimile: +1.206.359.9000

6 Moeka Takagi, Bar No. CA 333226
MTakagi@perkinscoie.com
7 PERKINS COIE LLP
3150 Porter Drive
8 Palo Alto, California 94304-1212
Telephone: +1.650.838.4300
9 Facsimile: +1.650.838.4350

10 *Attorneys for Plaintiff/Counterclaim-Defendant*
11 *University of British Columbia*

12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN JOSE DIVISION

15 UNIVERSITY OF BRITISH COLUMBIA,

16 Plaintiff/Counterclaim-
17 Defendant,

18 v.

19 CAPTION HEALTH, INC.; GE
20 HEALTHCARE TECHNOLOGIES INC.,

21 Defendant/Counterclaim-
22 Plaintiff.

Case No. 5:24-cv-03200-EKL

**PLAINTIFF UBC'S MOTION FOR
LEAVE TO AMEND INFRINGEMENT
CONTENTIONS REGARDING U.S.
PATENT NOS. 11,129,591 AND 10,751,029**

Hearing Date: June 17 2025

Time: 10:00 a.m.

Judge: Hon. Susan van Keulen

Location: Courtroom 6, 4th Floor

22
23
24
25
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS

I. INTRODUCTION AND SUMMARY OF FACTS..... 1

 A. Relevant Facts 1

II. UBC SHOULD BE ALLOWED TO AMEND ITS CONTENTIONS 3

 A. Amendments are Allowed if There is Diligence and No Prejudice 3

 B. UBC Has Good Cause to Amend its Infringement Contentions..... 4

 C. Defendants Will Not Be Prejudiced by UBC’s Proposed Amendments..... 6

III. CONCLUSION 7

TABLE OF AUTHORITIES

Cases

Apple Inc. v. Samsung Elecs. Co., No. 12-cv-0630-LHK (PSG), 2013 WL 3246094, at *1 (N.D. Cal. June 26, 2013) 3, 5, 7

Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc., No. C 05-04158 MHP, 2008 WL 624771 7

Brandywine Commc’ns Techs., LLC v. AT&T Corp., No. 12-cv-2494 CW, 2014 WL 1569544, at *15 (N.D. Cal. Apr. 18, 2014) 3

DCG Sys. v. Checkpoint Techs., LLC, No. C-11-03792 PSG, 2012 WL 1309161, at *3 (N.D. Cal. Apr. 16, 2012) 1

Impinj, Inc. v. NXP USA, Inc., No. 19-CV-03161-YGR, 2022 WL 2125133, at *2 (N.D. Cal. Mar. 4, 2022) 4

Nuance Comm’ns, Inc. v. ABBYY Software House, No. C 08-02912 JSW MEJ, 2012 WL 2427160, at *2 (N.D. Cal. June 26, 2012) 6

O2 Micro Int’l, Ltd. v. Monolithic Power Sys., Inc., 467 F.3d 1355, 1363 (Fed. Cir. 2006)..... 3

R.N Nehushtan Tr. Ltd. v. Apple Inc., No. 22-CV-01832-WHO, 2023 WL 10364531, at *2 (N.D. Cal. May 19, 2023) 5

Synchornoss Tech., Inc. v. Dropbox Inc., No. , 2018 WL 2984850, at *2 (N.D. Cal. June 14, 2018) 1

Synchronoss Techs., Inc. v. Dropbox Inc., No. 416CV00119HSGKAW, 2018 WL 5619743, at *5 (N.D. Cal. Oct. 29, 2018)..... 3, 6

Vasudevan Software, Inc. v. Int’l Bus. Machines Corp., No. C09-05897 RS HRL, 2011 WL 940263, at *3-4 (N.D. Cal. Feb. 18, 2011)..... 6

Wisk Aero LLC v. Archer Aviation Inc., No. 21-CV-02450-WHO, 2022 WL 5007912, at *4 (N.D. Cal. Oct. 4, 2022)..... 5

XpertUniverse, Inc. v. Cisco Sys., Inc., No. 17-cv-03848, 2019 WL 3413287 (N.D. Cal. July 29, 2019) 3, 7

Rules

Patent Local Rule 3-6..... 1, 3

1 **NOTICE OF MOTION AND MOTION**

2 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that at 10:00 a.m. on June 17 2025, or as soon thereafter as the
4 matter may be heard in the courtroom of the Honorable Susan van Keulen, San Jose Courthouse,
5 Courtroom 6, 4th Floor, 280 South 1st Street, San Jose, CA 95113, Plaintiff and Counter-Claim
6 Defendant University of British Columbia (“UBC”) by and through its counsel of record, will and
7 hereby do move this Court, for an Order granting UBC leave to amend its infringement contentions
8 pursuant to Patent Local Rule 3-6 to assert that another GE product—the Voluson product—
9 infringes U.S. Patent No. 11,129,591 (“the ’591 patent”) and 10,751,029 (“the ’029 Patent”),
10 (collectively, the “Asserted Patents”).

11 This Motion is based on this Notice of Motion and Motion, the accompanying
12 Memorandum of Points and Authorities, the Declaration of Ramsey M. Al-Salam and exhibits in
13 support hereof, any reply papers which may be filed, the pleadings and papers on file in this action,
14 the arguments of counsel, and any other matter that the Court may properly consider.

15 **I. INTRODUCTION AND SUMMARY OF FACTS**

16 UBC seeks to amend its contentions to add a new product—the Voluson product—as
17 infringing the Asserted Patents. UBC’s motion should be granted because: (1) it has been
18 reasonably diligent in seeking to amend its contentions; (2) GE will suffer no undue prejudice; and
19 (3) it enhances judicial economy to have the entire dispute resolved in this lawsuit, as opposed to a
20 different lawsuit. Contentions may be amended by order of the Court upon a timely showing of
21 good cause. Patent L.R. 3-6. Good cause exists when the moving party is diligent in amending its
22 contentions and the non-moving party will not be unduly prejudiced by the amendment.
23 *Synchornoss Tech., Inc. v. Dropbox Inc.*, No. , 2018 WL 2984850, at *2 (N.D. Cal. June 14, 2018)
24 (quoting *DCG Sys. v. Checkpoint Techs., LLC*, No. C-11-03792 PSG, 2012 WL 1309161, at *3
25 (N.D. Cal. Apr. 16, 2012)).

26 **A. Relevant Facts**

27 This is a patent infringement case involving two patents—the ’029 Patent and the ’591
28 patent. Both patents relate to capturing better ultrasound images. The ’591 patent relates

1 specifically to optimizing the quality of echocardiographic images (images of the heart). The '029
2 patent applies similar techniques to other types of ultrasound images such as obstetrical, pulmonary,
3 ocular, and renal.

4 The Complaint was filed on May 28, 2024, alleging Defendants' infringement of the '591
5 Patent. On December 20, 2024, UBC amended its Complaint to add a claim of infringement of the
6 '029 patent. (Dkt. No. 46). The parties then jointly moved to modify the case schedule to align the
7 deadlines for both Asserted Patents. The Court granted the Proposed Scheduling Order, extending
8 the deadlines for infringement and invalidity contentions to February 7, 2025, and March 28, 2025,
9 respectively. (Dkt. No. 49). UBC first filed its infringement contentions for the '029 Patent on
10 February 7, 2025. Those contentions alleged that Defendants infringed the '029 Patent based on
11 their sale of ultrasound equipment with Caption Guidance software for optimizing
12 echocardiographic images (also accused of infringing the '591 Patent). Al-Salam Decl., ¶ 3. After
13 the service of those contentions, UBC became aware that Defendant GE Healthcare is selling
14 another product, called Voluson, that also uses neural networks to optimize the quality of fetal
15 ultrasound imaging. Id., ¶ 4. UBC promptly told Defendants that it considered the Voluson
16 products to infringe the '029 Patent. In particular, on February 20, 2025, UBC served discovery
17 requests seeking information on the Voluson product and referring to it as an "Accused Product."
18 Id. Further, in mediation briefing preceding the March 13, 2025 mediation between the parties,
19 UBC identified the Voluson product as an infringing product. Id. After the mediation was
20 unsuccessful, UBC began working on infringement contentions for the Voluson product, sent
21 Defendants a draft of those contentions on April 10, 2025, and asked if Defendants objected to the
22 amendment. Id., ¶ 5. On April 22, 2025, Defendants said they objected to the amendment, thereby
23 necessitating this motion.

24 In sum, UBC informed Defendants that it planned to accuse the Voluson product within two
25 weeks of when its infringement contentions were first due for the '029 patent, and provided a set
26 of amended contentions within nine weeks of the due date. Under these circumstances, the
27 amendment should be allowed.

28

1 II. UBC SHOULD BE ALLOWED TO AMEND ITS CONTENTIONS

2 Defendants oppose UBC's amended contentions for the Asserted Patents because they cite
3 documents that have been publicly available. But UBC acted diligently to collect the information
4 needed for these amendments and sought leave promptly thereafter. The Court should grant UBC
5 leave to amend and reject Defendants' arguments for at least the reasons below.

6 A. Amendments are Allowed if There is Diligence and No Prejudice

7 Under Patent Local Rule 3-6, a party may amend its infringement contentions for good
8 cause absent undue prejudice to the non-moving party. This Rule "balance[s] the parties' rights to
9 develop new information in discovery along with the need for certainty in legal theories at the start
10 of the case." *Brandywine Commc'ns Techs., LLC v. AT&T Corp.*, No. 12-cv-2494 CW, 2014 WL
11 1569544, at *15 (N.D. Cal. Apr. 18, 2014) (citation omitted). Good cause requires the party to
12 show it "acted with diligence in promptly moving to amend when new evidence is revealed in
13 discovery." *O2 Micro Int'l, Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1363 (Fed. Cir.
14 2006). Diligence has two prongs: "(1) diligence in discovering the basis for amendment; and (2)
15 diligence in seeking amendment once the basis for amendment has been discovered."
16 *XpertUniverse, Inc. v. Cisco Sys., Inc.*, No. 17-cv-03848, 2019 WL 3413287, at *2 (N.D. Cal. July
17 29, 2019). Additionally, Patent Local Rule 3-6 provides examples of good cause, including "recent
18 discovery of nonpublic information about the accused product that, despite diligent efforts, was not
19 discovered before service of infringement contentions." "If the court finds that the moving party
20 has acted with diligence, it then must determine whether the non-moving party would suffer
21 prejudice if the motion to amend were granted." *Apple Inc. v. Samsung Elecs. Co.*, No. 12-cv-
22 0630-LHK (PSG), 2013 WL 3246094, at *1 (N.D. Cal. June 26, 2013) (internal quotation marks
23 and citation omitted). Prejudice can be shown when amending contentions will "disrupt the case
24 schedule or other court orders" and when a party changes its infringement theories or requires its
25 opposition to prepare additional defenses. *Synchronoss Techs., Inc. v. Dropbox Inc.*, No.
26 416CV00119HSGKAW, 2018 WL 5619743, at *5 (N.D. Cal. Oct. 29, 2018); *Apple Inc. v.*
27 *Samsung Elecs. Co.*, No. CV 12-00630 LHK, 2012 WL 5632618, at *3 (N.D. Cal. Nov. 15, 2012).
28 However, "extra work alone does not support a finding of prejudice." *Impinj, Inc. v. NXP USA,*

1 *Inc.*, No. 19-CV-03161-YGR, 2022 WL 2125133, at *2 (N.D. Cal. Mar. 4, 2022).

2 **B. UBC Has Good Cause to Amend its Infringement Contentions**

3 Good cause exists to grant UBC leave to amend its infringement contentions. Courts in the
4 Northern District of California consistently allow amendment where, as here, the amendments do
5 not include any new theories of infringement. UBC’s proposed amendments to its infringement
6 contentions merely add a single product line—the Voluson Expert, Signature, and SWIFT series—
7 to the list of accused products.

8 UBC initially accused the Venue and Vscan ultrasound systems of infringement in its May
9 28, 2024 Complaint as the ’591 patent pertains to echocardiographic imaging. On December 20,
10 2024, UBC filed its First Amended Complaint to add the ’029 Patent, which applies to a wide range
11 of ultrasound imaging such as obstetrical, pulmonary, ocular, and renal. (Dkt. No. 46). The parties
12 then jointly moved to modify the case schedule to align the deadlines for both Asserted Patents.
13 The Court granted the Proposed Scheduling Order, which extended the deadlines for the ’029
14 infringement contentions to February 7, 2025. (Dkt. No. 49). In its ’029 infringement contentions,
15 UBC accused the Venue and Vscan ultrasound systems of infringement due to their AI-enabled
16 Caption Guidance software which analyzes a variety of acquired ultrasound images including
17 echocardiographic images, which UBC earlier accused of infringing the ’591 Patent. Al-Salam
18 Decl., ¶ 3.

19 Intelligent Ultrasound Limited (IUL) is an ultrasound AI software and simulation company
20 based in Cardiff, Wales. At the time UBC served its ’029 infringement contentions, it remained
21 unclear to UBC whether GE Healthcare had independent commercial sales of Voluson in the United
22 States. First, though the parties discussed a proposed sale in July 2024, GE Healthcare did not
23 complete its acquisition of IUL’s clinical AI business until October 01, 2024. *See*
24 [https://radiologybusiness.com/topics/artificial-intelligence/ge-healthcare-completes-53m-](https://radiologybusiness.com/topics/artificial-intelligence/ge-healthcare-completes-53m-acquisition-ai-ultrasound-business)
25 [acquisition-ai-ultrasound-business](https://radiologybusiness.com/topics/artificial-intelligence/ge-healthcare-completes-53m-acquisition-ai-ultrasound-business). Second, GE’s own website suggested that Voluson products
26 were not for sale to US customers. *See* <https://gehealthcare-ultrasound.com/en/voluson-family/>
27 (English language website showing notice “It looks like you are located in United States. You are
28 trying to view a page from a different country or region. Please visit the website in your country.

1 *Not all products and services may be available in your country or region.”). UBC promptly
2 investigated IUL’s corporate status and whether the Voluson products, which include guidance
3 technology known as SonoLyst AI, infringe the Asserted Patents. UBC then became aware that
4 GE Healthcare’s nearly six-year relationship with IUL resulted in sales of infringing products in
5 the United States.

6 Having now determined that the Voluson products do infringe—in roughly the same manner
7 as the already accused Venue and Vscan ultrasound systems—UBC promptly told Defendants that
8 it considered the Voluson products to infringe the Asserted Patents. In particular, on February 20,
9 2025—two weeks after serving its infringement contentions—UBC served discovery requests
10 adding Voluson to the list of “Accused Products” and seeking marketing, financial, and acquisition-
11 related information. *Id.*, ¶ 4. UBC then included Voluson in the list of “Accused Products” in its
12 March 3, 2025 mediation brief to notify Defendants of its intention to include it in the scope of the
13 dispute. *Id.* After the parties’ unsuccessful mediation on March 13, 2025, UBC began drafting
14 amended infringement contentions for the Voluson products. UBC sent Defendants a draft of its
15 infringement contentions on April 10, 2025 and asked Defendants if they would object to UBC’s
16 efforts to amend. *Id.*, ¶ 5. On April 22, 2025, Defendants replied that they object to UBC’s
17 amendment. *Id.*, ¶ 6.

18 UBC has shown good cause because it only seeks to amend its contentions to map the
19 Voluson product line to the asserted claims. UBC’s third amended contentions do not involve any
20 re-reading of the claims and instead rely on the same underlying theories of infringement, including
21 the DOE theories for both patents. Thus, “[UBC]’s amendment does not seek to add new claims
22 or theories of infringement, but merely adds another device that has the same accused functionality”
23 as the previously accused devices. *Apple Inc. v. Samsung Elecs. Co.*, No. CV 12-00630 LHK, 2012
24 WL 5632618, at *3 (N.D. Cal. Nov. 15, 2012); *see also Wisk Aero LLC v. Archer Aviation Inc.*,
25 No. 21-CV-02450-WHO, 2022 WL 5007912, at *4 (N.D. Cal. Oct. 4, 2022); *R.N Nehushtan Tr.*
26 *Ltd. v. Apple Inc.*, No. 22-CV-01832-WHO, 2023 WL 10364531, at *2 (N.D. Cal. May 19, 2023).

27 Further, this court has granted a motion for leave to amend in a similar case. *See Nuance*
28 *Comm’ns, Inc. v. ABBYY Software House*, No. C 08-02912 JSW MEJ, 2012 WL 2427160, at *2

1 (N.D. Cal. June 26, 2012). There, Nuance sought to amend its infringement contentions to include
2 three products that were acquired by Lexmark “within the past few months.” *Id.* Like *Lexmark*,
3 Defendants in this case suggest that UBC must have been aware of the Voluson products for some
4 time simply because the proposed amendment cite to documents that have been publicly available
5 for years. However, even if UBC did know about these products, it did not know if they could be
6 included in its infringement contentions if they were not owned by GE Healthcare. *Nuance*
7 *Comm ’ns*, 2012 WL 2427160, at *2. Once UBC learned that GE Healthcare had acquired IUL and
8 was selling infringing products within the United States, it moved to amend its contentions so that
9 the Voluson series would be included as accused products. *See Synchronoss Techs.*, 2018 WL
10 5619743, at *5 (finding diligence where “[t]he trigger for amending [the plaintiff’s] [c]ontentions”
11 was “undoubtedly” the later-received information).

12 UBC informed Defendants of its intention to accuse the Voluson products on February 20,
13 2025, two weeks after serving its ’029 infringement contentions on February 7, 2025, then provided
14 a set of amended contentions seven weeks later on April 10, 2025. UBC’s interval between the
15 deadline for infringement contentions and seeking leave to amend is reasonable, especially given
16 that UBC notified Defendants before filing this motion. Courts in this District have found time
17 periods of this length (or longer) to be reasonable for leave to add additional products to
18 infringement contentions. *See Nuance Comm ’ns*, 2012 WL 2427160, at *2 (N.D. Cal. June 26,
19 2012) (finding sufficient diligence where plaintiff waited a “few months” after learning that
20 defendant acquired accused products and thus plaintiff “could not include them in its infringement
21 contentions”); *Vasudevan Software, Inc. v. Int’l Bus. Machines Corp.*, No. C09-05897 RS HRL,
22 2011 WL 940263, at *3-4 (N.D. Cal. Feb. 18, 2011) (finding four months to be diligent).

23 C. Defendants Will Not Be Prejudiced by UBC’s Proposed Amendments

24 UBC’s amended infringement contentions will not cause any undue prejudice to
25 Defendants. While UBC’s amendment adds the Voluson series as an accused product, UBC’s
26 infringement theories concerning the neural network algorithms to determine a quality assessment
27 value are essentially the same as for the previously-accused Venue and Vscan products. *Al-Salam*
28 *Decl.*, Ex. 1, 2. In this circumstance, Defendants will suffer no prejudice because any defenses will

1 be the same. *See Apple Inc. v. Samsung Elecs. Co., Ltd.*, No. CV 12-00630 LHK, 2012 WL
2 5632618, at *3 (N.D. Cal., Nov. 15, 2012) (finding that six months of fact discovery did not
3 prejudice the opposing party because it had ample time to investigate and prepare defenses);
4 *XpertUniverse v. Cisco Sys., Inc.*, No. 17-cv-03848-RS (JSC), 2019 WL 3413287, at *5 (finding
5 no prejudice when plaintiff’s amended infringement contentions add a product and plaintiff intends
6 to rely on substantially the same theories set forth in its original contentions). Further, judicial
7 resources will be preserved if UBC’s amendment is granted because UBC’s infringement theories
8 concerning Voluson mirror its theories for Venue and Vscan. *See Potter Voice Techs., LLC v.*
9 *Apple Inc.*, No. C 13-1710 CW, 2015 WL 13404106, at *2 (N.D. Cal. Mar. 20, 2015) (finding that
10 including additional products would not prejudice Apple because “the infringement theories for
11 these new products are the same” and the amendment would “promote judicial efficiency” by
12 avoiding “piecemeal litigation”); *Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular*
13 *Sys., Inc.*, No. C 05-04158 MHP, 2008 WL 624771, at *4 (N.D. Cal. Mar. 4, 2008) (finding that
14 allowing plaintiff to amend its infringement contentions to add defendant’s newly released product
15 would preserve judicial resources given that the product’s technology had already been addressed
16 and that, in the event the amendment wasn’t allowed, plaintiff was likely to bring a new suit with
17 respect to the newly released product). Moreover, ample time remains in the case as the Court has
18 not yet set a trial date, fact discovery is ongoing, and expert discovery has not yet begun.

19 **III. CONCLUSION**

20 For the foregoing reasons, UBC respectfully requests that the Court grant its motion to
21 amend its infringement contentions to include the Voluson products with respect to the Asserted
22 Patents.

23
24
25
26
27
28

1 Dated: May 9, 2025

PERKINS COIE LLP

2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

By: */s/ Ramsey M. Al-Salam*
Ramsey M. Al-Salam, CA Bar No. 109506
RAlsalam@perkinscoie.com
Dorianne Salmon, pro hac vice
DSalmon@perkinscoie.com
PERKINS COIE LLP
1201 Third Avenue, Suite 4900
Seattle, Washington 98101-3099
Telephone: +1.206.359.8000
Facsimile: +1.206.359.9000

Moeka Takagi, Bar No. CA 333226
MTakagi@perkinscoie.com
PERKINS COIE LLP
3150 Porter Drive
Palo Alto, California 94304-1212
Telephone: +1.650.838.4300
Facsimile: +1.650.838.4350

*Attorneys for Plaintiff/Counterclaim-
Defendant University of British Columbia*