

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

INGURAN, LLC, d/b/a STGENETICS
and
CYTONOME/ST, LLC,

Plaintiffs,

v.

ABS GLOBAL, INC.
and
GENUS PLC

Defendants.

OPINION AND ORDER

20-cv-349-wmc

Plaintiffs Inguran, LLC d/b/a STGenetics and Cytonome/ST, LLC (“ST”) seek leave to supplement their infringement contentions. (Dkt. #168.) The proposed supplement does not add new patents, claims, or accused products, but adds four paragraphs of text and one diagram, pertaining to two patent claims, to its infringement contentions claim chart for U.S. Patent No. 10,583,439 (the ‘439 Patent).¹ Defendants ABS Global, Inc., and Genus, PLC, (“ABS”) oppose the motion as untimely and unduly prejudicial. ABS seeks to amend its invalidity contentions and claim construction disclosures, serve supplemental expert reports, and re-depose key witnesses if the motion for leave is granted. Because ST’s supplemental contentions are neither untimely nor unduly prejudicial, the court will grant ST’s motion for leave and partially grant ABS’s requested relief.

¹ ST also seeks to remove five asserted claims from its contentions pertaining to U.S. Patent No. 11,446,665. (Dkt. #168, at 3 n.1; dkt. #169-1 at 2.)

OPINION

As provided in the pretrial conference order, requests to amend core substantive contentions are evaluated by the court under Federal Rule of Civil Procedure 15. (Dkt. #86, at 2.) Under Rule 15(a), the court should freely give leave to amend “when justice so requires.” Fed. R. Civ. P. 15(a)(2). However, “district courts have broad discretion to deny leave to amend” such as where there is “undue delay,” or “undue prejudice to the defendants.” *Arreola v. Godinez*, 546 F.3d 788, 796 (7th Cir. 2008); *e.g.*, *Fin. Fiduciaries, LLC v. Gannett Co.*, 46 F.4th 654, 667–68 (7th Cir. 2022); *Oxbo Int’l Corp. v. H&S Mfg. Co.*, No. 15-cv-292-jdp, 2016 WL 1312181, at *1 (W.D. Wis. Apr. 2, 2016).

ST argues leave is proper because ABS’s engineer, David Appleyard, Ph.D., provided further support for ST’s existing infringement claims at his July 11, 2023, 30(b)(6) deposition. ST represents that Dr. Appleyard testified that the assembly drawing of the ABS SSC-BII-C3 microfluidic chip at Detail B depicts an additional taper feature in the chip, serving as a lateral fluid focusing feature. (Dkt. #169-1, at 16–17; David Appleyard 7/11/2023 Dep. (dkt. #166, at 85:20–86:10) (“Detail B depicts a horizontal narrowing, and I anticipate that the dimensions of the sample stream will be impacted and further constrained downstream of it.”).) ST contends this testimony is particularly relevant to the following in the ’439 patent: limitation E (“the fluid focusing region having a lateral fluid focusing feature”) and limitation H (“the lateral, the first vertical, and the second vertical fluid focusing features provided at different longitudinal locations along the flow channel”) of claim 1; and limitation E (“the lateral, the first vertical, and the second vertical fluid focusing features provided at different longitudinal locations along the flow channel”)

of claim 22. ST informed ABS of its intent to supplement its contentions as to those claim limitations on July 24, 2023.

ABS argues ST's requested amendment is untimely. Because ST told ABS of its intent to supplement these infringement contentions on July 24, 2023, that is the date from which the court will evaluate ST's delay and ABS's prejudice. *See Oxbø*, 2016 WL 1312181, at *1. July 24 was just 13 days after ST plausibly obtained new information during the July 11 Appleyard deposition and was just 11 days before ST's opening expert report on infringement became due. Although ABS points out the document containing the "Detail B" diagram was cited 31 times in ST's original infringement contentions, establishing ST's earlier knowledge of the diagram, ABS has not shown that ST must have known what ABS's 30(b)(6) witness purports to know: the taper constituted "a horizontal narrowing" that would focus the sample. Perhaps ST could be faulted for not pursuing this discovery sooner, but this is not enough to preclude the amendment.

ABS also argues that it is unduly prejudiced by ST's new theory, but ABS's non-infringement rebuttal report is not due until September 15, 2023. Moreover, there are no newly asserted claims, and ABS will still have two weeks from this order, and two months from ST's supplement, to address non-infringement with its expert. Thus, ABS is not unduly prejudiced in its non-infringement argument about the taper at Detail B. However, to avoid any risk of prejudice, ABS may have until September 29, 2023, to file its rebuttal report on this new theory.

Additionally, ABS argues ST's supplemental contentions "may have" changed its original claim construction disclosures. (Dkt. #173, at 11.) This argument on

construction has some merit, but is premature to establish undue prejudice. The deadline for the parties' requirement to submit a table of terms requiring construction jointly, with each side's proposed construction, has not yet occurred. (Dkt. #86, at 3–4.) Moreover, the proposed construction disclosures that *have* occurred to date “need not be filed with the court, and the parties *may supplement or amend these disclosures* by agreement.” (*Id.* at 3 (emphasis added).) Thus, the court will provide ABS one week to propose any amendments to its claim construction disclosures for the terms appearing in its brief, and ST one additional week to lodge any disagreement with those amendments.

ABS argues ST's supplemental contention would have altered ABS's prior art search and invalidity defenses. This court finds this implausible, and of limited prejudice to ABS, if at all. First, although ABS says it would have “broadened” its prior art search “to include chip designs that ‘re-order’ the features” and “chip designs with different distances between features,” ABS does not suggest any *specific* prior art as an example. Second, because Detail B is from ABS's product, and the Appleyard testimony came from ABS, ABS could have anticipated the Detail B taper might be accused and searched for prior art accordingly, as it no doubt did with respect to other possible claims and defenses.

ABS argues “ST's patents suffer from a lack of adequate written description support under 35 U.S.C. § 112 if they are understood to cover a device that re-orders the features,” and “if given more than 11 days to consider” the supplemental contentions, ABS's invalidity expert “might have refined his opinions” and incorporated other materials. (*Id.*, at 11–12.) But ABS does not dispute having an opportunity to address the Detail B taper in its opening report on invalidity, albeit truncated, and has still not posited how its

invalidity argument might have changed. In *Oxbo*, the court permitted supplementing infringement contentions to assert six additional patent claims with “just over a month for [defendant’s] experts to consider the new claim elements.” 2016 WL 1312181, at *2. Here, by contrast, ABS’s invalidity expert had no new asserted claims or patents to consider. Thus, ABS’s invalidity expert had sufficient time to consider the infringement contentions supplement, and any delay was not unduly prejudicial.

Finally, ABS says it needs to retake depositions, particularly of party inventor, Dr. Jonathan Sharpe, to ask “questions focused on the ordering of the features in the patent” and devices embodying the claims. Although again skeptical, to be able to question ST’s witnesses on these supplemental contentions, ABS is granted a deposition of Dr. Sharpe (or if it prefers, one of the other witnesses named in ST’s opposition brief), for no more than two hours on this narrow topic, without fee shifting, to be taken remotely via videoconference, on or before September 15, 2023.

For all these reasons, the court will grant ST’s motion for leave to amend its infringement contentions. The relief requested by ABS is granted in part and denied in part, as stated in this order.

ORDER

IT IS ORDERED that:

- 1) ST's Motion for Leave to File / Serve Supplemental Infringement Contentions (dkt. #168) is GRANTED.
- 2) ABS's request for permission to amend its claim construction disclosures is also GRANTED, and ABS may have until September 8, 2023, to amend its proposed constructions addressing the terms specified in its brief: "ordering" of features, "lateral fluid focusing feature," "adjacent to," and "different longitudinal locations;" ST may have until September 15, 2023, to lodge any disagreement with those amendments.
- 3) ABS's request to re-depose a technical witness is GRANTED and ABS may depose Jonathan Sharpe (or if it chooses, one of the witnesses named in ST's opposition brief, dkt. #173 at 11), for no more than two hours, solely to address the new contentions, without fee shifting, to be taken remotely, by September 15, 2023.
- 4) ABS may have until September 29, 2023, to file its rebuttal report on ST's new infringement theory.

Entered this 31st day of August, 2023.

BY THE COURT:

/s/

WILLIAM M. CONLEY
District Judge