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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

IN RE: CHROMACODE LITIGATION	Case No. 5:23-CV-04823-EKL **JOINT CASE MANAGEMENT STATEMENT & [PROPOSED] ORDER** Judge: Honorable Eumi K. Lee

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Plaintiffs and Counter-Defendants ChromaCode, Inc. ("ChromaCode") and California Institute of Technology ("Caltech") (collectively, "Plaintiffs") and Defendant and Counter-Plaintiff Bio-Rad Laboratories, Inc. ("Bio-Rad") jointly submit this Joint Case Management Statement & [Proposed] Order ("Statement") pursuant to the Standing Order for All Judges of the Northern District of California, Civil Local Rule 16-9, Patent Local Rule 2-1(b), Federal Rule of Civil Procedure 26(f), and the Court's Order Reassigning this action to the Honorable Eumi K. Lee. *In re: ChromaCode Litig.*, Case No. 5:23-cv-04823, Dkt. 73 (N.D. Cal.) (the "4823 Case").

1. Jurisdiction and Service

This action arises under the patent laws of the United States, 35 U.S.C. §§ 1-390. The Court has subject matter jurisdiction. No issues exist regarding personal jurisdiction or venue, and no party remains to be served.

2. Facts

A. Brief Chronology

The present litigation is the result of two actions that have now been consolidated. A summary of the history of the cases individually and collectively is below.

On September 20, 2023, ChromaCode brought an action for declaratory judgment of non-infringement of U.S. Patent Nos. 9,222,128 (the "'128 Patent") and 9,921,154 (the "'154 Patent") (collectively, the "Bio-Rad Patents"). 4823 Case, Dkt. 1. Bio-Rad filed its answer and counter-claimed for infringement of the Bio-Rad Patents on November 8, 2023. 4823 Case, Dkt. 27.

On October 5, 2023, ChromaCode brought an action for infringement of U.S. Patent Nos. 10,068,051 (the "'051 Patent") and 10,770,170 (the "'170 Patent") in the U.S. District Court for the Central District of California. *ChromaCode, Inc. et al. v. Bio-Rad Laboratories, Inc.*, 5:23-cv-06360-EJD, Dkt. 1 (N.D. Cal.) (the "6360 Case"). On October 13, 2023, Plaintiffs filed an Amended Complaint. *See* 6360 Case, Dkt. 12. On November 8, 2023, Defendant filed its Answer and Counterclaims. 6360 Case, Dkt. 22. On November 29, 2023, Plaintiffs filed their Answer to Defendant's Counterclaims. 6360 Case, Dkt. 32. On December 7, 2023, this case was transferred to this District. 6360 Case at Dkt. Nos. 34, 35.

On January 17, 2024, this Court entered an Order Relating Case that related the two cases. 4823 Case, Dkt. 43. On March 27, 2024, Plaintiffs filed a Second Amended Complaint in the 6360 case, further alleging infringement of U.S. Patent No. 11,827,921 (the "'921 Patent"; collectively with the '051 and '170 Patents, the "Caltech Patents"). 6360 Case, Dkt. 54 ("SAC"). On April 10, 2024, Bio-Rad filed its Answer and Counterclaims. 6360 Case, Dkt. 57.

Since then, the parties have completed claim construction briefing regarding both the Bio-Rad Patents and the Caltech Patents and participated in a settlement conference with Magistrate Judge van Keulen on July 17, 2024. 4823 Case at Dkt. Nos. 67. The two cases were subsequently consolidated by then-assigned Judge Davila on August 16, 2024, 4823 Case, Dkt. 71, before subsequent reassignment to Your Honor on August 21, 2024.

B. Principal Factual Issues in Dispute

1. Plaintiffs' Statement

Plaintiffs' Infringement Claims:

Caltech and ChromaCode's patented technology in this case concerns the ability to detect, unambiguously, multiple targets in a single sample without having to label every target with a different color. 6360 Case, Dkt. 12 (First Amended Complaint, or "FAC"), ¶ 10. In 2011, a team of researchers from Caltech, comprised of Emil Kartalov, Aditya Rajagopal, and Axel Scherer, conceived of a solution that enabled high-definition multiplexing—specifically, the unambiguous identification of multiple targets for each color. *Id.*, ¶ 16. The Caltech researchers' innovative approach to high-definition multiplexing, referred to as both high-definition PCR ("HDPCR"), involves using multiple fluorescent probes in a single reaction, each probe corresponding to a different target but not necessarily a different color, and distinguishing targets unambiguously based on cumulative signal intensities from each fluorophore. *Id.*, ¶ 21. HDPCR is the subject of multiple U.S. patents assigned to Caltech, including the Caltech Patents. *Id.* In 2012, Aditya Rajagopal teamed up with Alex Dickinson to found ChromaCode, with patents licensed from Caltech, in order to bring the patented HDPCR technology to the market. *Id.*, ¶ 22. ChromaCode exclusively licensed the Caltech Patents from Caltech.

In late 2022, Bio-Rad announced its new QX600 Droplet Digital PCR System (the "QX600 System"). *Id.*, ¶ 36. Beginning at least as of December 14, 2022, Bio-Rad's website offered the QX600 System for sale. *Id.*, ¶ 38.

Bio-Rad's QX600 System and related assays directly infringe each of the Caltech Patents, either literally or under the doctrine of equivalents. 6360 Case, Dkt. 54. For example, as to the '051 Patent, one or more assays provided by Bio-Rad with at least the QX600 System perform amplitude based PCR multiplexing to unambiguously identify the presence or absence of at least seven polynucleotide analytes based on cumulative signal intensity of probes that comprise at least one fluorophore selected from four fluorophores, and perform each of the other elements of claim 1. *Id.*, ¶ 51. As another example, as to the '170 Patent, one or more assays provided by Bio-Rad with at least the QX600 System perform amplitude-based PCR multiplexing to unambiguously identify the presence or absence of at least five polynucleotide analytes based on cumulative signal intensity of probes that comprise between one and four fluorophores, and perform each of the other elements of claim 1 of the '170 Patent. *Id.*, ¶ 62. As another example, as to the '921 Patent, one or more assays provided by Bio-Rad with at least the QX600 System are capable of performing amplitude-based PCR multiplexing to unambiguously identify the presence or absence of each of at least M analytes each encoded as a value of one component of a fluorescent signal, thereby generating a coding scheme, based on detection of F wavelength components of the fluorescent signal, when M is greater than F, and perform each of the other elements of claim 1. *Id.*, ¶ 73.

Bio-Rad also indirectly infringes each of the Caltech Patents. *Id.*, ¶ 50. Bio-Rad has knowingly induced infringement of the Caltech Patents by encouraging others to infringe at least claim 1 of the '051 Patent, claim 1 of the '170 Patent, and claim 1 of the '921 Patent. *Id.* ¶¶ 52, 63, 74. For example, in Bio-Rad's QX600 System User Guide, Bio-Rad has induced, and will continue to induce, users to infringe the '051, '170 and '921 Patents by expressly and intentionally instructing and encouraging users to perform each limitation of at least claim 1 of the '051 Patent in violation of 35 U.S.C. § 271(b). *Id.*

Bio-Rad's sale of infringing products has contributed, and will continue to contribute, to

the infringement of each of the Caltech Patents in violation of 35 U.S.C. § 271(c). *Id.*, ¶ 53, 64, 75. For example, users of the QX600 System have infringed, and will continue to infringe, at least claim 1 of the '051 Patent, claim 1 of the '170 Patent, and claim 1 of the '921 Patent by performing assays in accordance with instructions set forth in the QX600 System User Guide. *Id.*

Upon information and belief, Bio-Rad had actual and constructive notice of each of the '051 and '170 Patents prior to launching the QX600 System and knowingly or intentionally infringed each of the '051 and '170 Patents after acquiring that knowledge. *Id.*, ¶¶ 55, 66, 77.

Bio-Rad had and continues to have knowledge that multiple assays it provides for the QX600 System are especially made or especially adapted for a use that infringes each of the Caltech Patents. Bio-Rad's infringement of each of the Caltech Patents has been, and continues to be, willful. *Id.*, ¶¶ 65, 67, 78.

Plaintiffs have been damaged by Bio-Rad's egregious and willful infringement of each of the Caltech Patents. *Id.*, ¶ 57, 68, 80.

None of the Caltech Patents is invalid or unenforceable. 6360 Case, Dkt. 57 (Plaintiffs' Answer to Counterclaims), Counterclaims ¶¶ 16-21.

<u>ChromaCode's Declaratory Judgment ("DJ") Claims:</u>

On September 6, 2023, Bio-Rad sent ChromaCode a letter accusing ChromaCode of infringing the Bio-Rad Patents and attaching "exemplary infringement claim charts." Dkt. 1, Ex. C. On September 20, 2023, in view of Bio-Rad's letter and the cloud that its claims have cast over ChromaCode's business, ChromaCode filed the 4823 Case seeking a declaratory judgment of non-infringement as to both Bio-Rad Patents. 4823 Case, Dkt. 1. Neither ChromaCode, nor any of its products, directly or indirectly infringe any claim of either of the Bio-Rad Patents literally or under the doctrine of equivalents. For example, ChromaCode's products do not "calculat[e] an average level of each target in the partitions based on the R signals, wherein the level calculated accounts for a coincidence of all possible combinations of the more than R targets in the same individual partitions," as required by claim 1 of the '128 Patent. Nor do ChromaCode's products "determin[e] a respective level of each of the R targets from the data" or require "a

partition count for a partition population positive for two of the R targets," as required by claim 1 of the '154 Patent.

2. Defendant's Statement

Bio-Rad is an industry leader in PCR multiplexing. It successfully markets products in this field developed through its investment into research and development that rely on its own intellectual property, including a sophisticated patent portfolio that protects this intellectual property. The Bio-Rad Patents are included in this patent portfolio in the field of PCR multiplexing.

In a conventional multiplexed assay, each individual type of DNA target is associated with its own unique signal. For example, in an assay where a first type of DNA target is associated with a red signal and a second type of DNA target is associated with a green signal—red indicates the presence of the first target, green indicates the presence of the second target, red and green indicates the presence of both targets, and no signal indicates the presence of no targets. But this approach in which there is one-to-one relationship between every target and a specific signal is limited because the number of different targets cannot exceed the number of different types of signals one can generate and detect.

To overcome this limitation and increase the number of targets that can be detected in a single experiment, Bio-Rad invented and commercialized multiplexed digital assays that detect a greater number of targets than optical channels (*i.e.*, signal colors). For example, in an assay where a first target is associated with a red signal, a second target is associated with a green signal, and a third target is associated with a red+green signal, red indicates the presence of the first target, green indicates the presence of second target, red and green indicates the presence of both targets ***or*** the presence of the third target, and no signal indicates the presence of no targets. By further using the intensity of the red and green signals, one can identify whether red and green indicates the presence of both first and second targets or merely the presence of a third target.

Bio-Rad has generalized the foregoing approach to a larger number of targets and commercialized multiple products lines that offer a high degree of multiplexing, such as Bio-Rad's

QX600 and QXONE droplet digital PCR systems that consist of integrated instrumentation, reagents, and analysis software. Through ChromaCode's infringement of the Bio-Rad Patents by its sole product line, the so-called "high-definition PCR kits" ("HDPCR kits"), ChromaCode has improperly benefitted from its use of Bio-Rad's proprietary methods, including by its infringement of the Bio-Rad Patents.

Bio-Rad uses its own developed and proprietary technology to perform its assays and multiplex detection of targets. Bio-Rad does not, nor do any of its products, directly, literally or under the doctrine of equivalents infringe any claim of the CalTech Patents. 6360 Case, Dkt. 22.

Bio-Rad further believes the CalTech Patents are invalid in view of patents owned by Bio-Rad owned technology. Accordingly, Bio-Rad has filed two petitions for *inter partes* review challenging the '051 and '170 Patents, IPR2024-01177 and IPR2024-01178, respectively, with a third petition challenging the '921 Patent to come.

3. Legal Issues

Plaintiffs and Defendant are aware of the following principal legal issues in dispute:

i. Whether ChromaCode is liable for infringement of the Bio-Rad Patents pursuant to 35 U.S.C. § 271 (a), (b), and/or (c);

ii. Whether the asserted claims of the Bio-Rad Patents are invalid and/or unenforceable including under one or more of 35 U.S.C. §§ 101, 102, 103, 111, 112, and/or 116;

iii. Whether any claim terms of the Bio-Rad Patents should be construed and the proper construction of any disputed claim terms in the Bio-Rad Patents, 4823 Case at Dkt. Nos. 51, 59, 64;

iv. The amount of damages for any infringement of the Bio-Rad Patents by ChromaCode or other monetary relief including prejudgment and post-judgment interest, costs, expenses, and any attorneys' fees and costs pursuant to at least 35 U.S.C. §§ 284 and 285;

v. If ChromaCode is found liable for infringement of the Bio-Rad Patents, whether

such infringement was willful;

vi. Whether Bio-Rad is entitled to injunctive relief, if liability for infringement of the Bio-Rad Patents is proven;

vii. Whether Bio-Rad is liable for infringement of the Caltech Patents pursuant to 35 U.S.C. § 271 (a), (b), and/or (c);

viii. Whether the asserted claims of the Caltech Patents are invalid and/or unenforceable including under one or more of 35 U.S.C. §§ 101, 102, 103, 111, 112, and/or 116;

ix. Whether any claim terms of the Caltech Patents should be construed and the proper construction of any disputed claim terms in the Caltech Patents, 6360 Case at Dkt. Nos. 65, 73-75;

x. The amount of damages for any infringement of the Caltech Patents by Bio-Rad or other monetary relief including prejudgment and post-judgment, interest, costs, expenses, and any attorneys' fees and costs pursuant to at least 35 U.S.C. §§ 284 and 285;

xi. If Bio-Rad is found liable for infringement of the Caltech Patents, whether such infringement was willful;

xii. Whether Caltech and ChromaCode are entitled to injunctive relief, if liability for infringement of the Caltech Patents is proven;

xiii. Whether this case is exceptional under 35 U.S.C. § 285;

xiv. Whether any party is entitled to its costs, disbursements and reasonable attorneys' fees incurred in this action, including under 35 U.S.C. § 285;

xv. Whether any party's damages are limited under 35 U.S.C. §§ 287 and/or 288; and

xvi. Whether any other forms of relief are due to any party.

4. Motions

There is one pending motion before Magistrate Judge DeMarchi, which is ChromaCode's motion to amend its invalidity contentions with respect to the Bio-Rad Patents. 4823 Case, Dkt. 68, The motion is fully briefed, and oral argument is presently scheduled for September 17, 2024.

The parties anticipate dispositive motion briefing and the potential for additional non-dispositive motions, such as discovery motions, as the case progresses.

5. Amendment of Pleadings

The parties agree that the deadline for joinder of any additional parties or other amendments to the pleadings has passed, unless by specific agreement of the parties and by leave of the Court.

6. Evidence Preservation

The parties have reviewed the Guidelines Relating to the Discovery of Electronically Stored Information ("ESI Guidelines"), and have met and conferred under Fed. R. Civ. P. 26(f) regarding reasonable and proportionate steps taken to preserve evidence relevant to the issues reasonably evident in this action.

7. Disclosures

The parties served their respective initial disclosures under Fed. R. Civ. P. 26(a) in the previously separate cases on November 30, 2023 and December 6, 2023.

8. Discovery

A. Discovery Taken to Date:

1. Plaintiffs' Statement:

The parties have served written discovery requests and responses to those requests, and each made significant document productions. The parties have also completed the exchange of infringement, invalidity, and damages contentions under Patent Local Rules 3-1 through 3-4, 3-8, and 3-9. Plaintiffs have also served eight third-party subpoenas. Plaintiffs are also in the process of reviewing additional documents for responsiveness and privilege, and expect to make a further production in the next week.

Plaintiffs believe the parties are positioned to complete fact discovery within 90 days after the Claim Construction Hearing, as proposed below. This aligns with the approximately 60 days

contemplated in the schedule set by previously assigned Judge Davila, plus an additional 30 days to account for the requirement of this Court's Standing Order for Civil Cases that "all discovery must be completed" prior to the close of fact discovery, "including motions to compel, hearings on discovery motions, and any additional discovery resulting from orders on discovery motions." *See* 4823 Case, Dkt. 39, 49; 6360 Case, Dkt. 53; Civil Standing Order at 4.

Bio-Rad never raised any concerns about the parties' ability to complete fact discovery under the prior schedule. The first time this issue has been raised is in connection with the preparation of this Statement.

2. Bio-Rad's Statement:

Although the close of fact discovery was originally scheduled for November 1, 2024, almost no discovery has taken place so as to move the case forward. Plaintiffs, in particular, have done essentially nothing to advance this case.

The parties have served written discovery requests, but Plaintiffs have not produced any documents responsive to Bio-Rad's requests for production and have only produced a small volume of documents connected to interrogatory responses and documents produced pursuant to the mandatory disclosures under the Patent Local Rules. In fact, of the 12,198 pages Plaintiffs have produced, 10,705 of them are simply the file histories of the Caltech Patents. The vast majority of the remaining pages are also related to Plaintiffs' required disclosures under the Patent Local Rules, including some documents that are simply screen captures of ***Bio-Rad's own webpages***. Plaintiffs' have otherwise not produced any documents responsive to Bio-Rad's 149 requests for production served across the cases, including Bio-Rad's requests for email from Plaintiffs' custodians. In response to Bio-Rad's requests to meet and confer regarding Plaintiffs' deficiencies in discovery, Plaintiffs have been evasive and have failed to engage with Bio-Rad's good faith efforts to progress the case. Plaintiffs have only in the last few days served their own custodial ESI requests, with Bio-Rad's responses and objections to such requests not even being due until October 7.

Bio-Rad, by contrast, has produced, in total, 75,294 pages of documents. Of these, more than 64,660 pages are specifically responsive to Plaintiffs' requests for production. In addition, Bio-Rad has produced documents connected to interrogatory responses and met its obligations under its Patent Local Rules mandatory disclosures. Bio-Rad has engaged with Plaintiffs in good faith and amended its discovery responses when appropriate.

While document discovery from Plaintiffs remains stalled, so too do other forms of discovery. No depositions have been noticed or taken by either party and no requests for admission have been served. This includes Federal Rule of Civil Procedure 30(b)(6) depositions, for which neither party has even served a notice, let alone met and conferred regarding 30(b)(6) topics.

The parties expect substantial discovery to still be taken in this case, within the limits as described in Section 8.E. below.

B. Scope of Anticipated Discovery and Subjects on Which Discovery May Be Needed

The parties anticipate that the scope of discovery will address the disputed legal and factual issues set forth above.

C. Report on E-Discovery Order

The parties entered into agreements regarding e-mail discovery and discovery of electronically stored information modeled on this District's model order for Discovery of Electronically Stored Information for Patent Litigation in both cases prior to consolidation of the two cases. 4823 Case, Dkt. 62; 6360 Case, Dkt. 67.

D. Any Issues About Claims of Privilege or of Protection as Trial-Preparation Materials

The parties agree that inadvertent production by a party of material subject to the attorney-client privilege, common interest privilege, work product protection, or any other applicable privilege or protection, despite the producing party's reasonable efforts to prescreen such material prior to production, will not waive the applicable privilege and/or protection if a request for return of such inadvertently produced material is made promptly after the producing party learns of its inadvertent production.

The parties further agree that communications with litigation counsel in this action are presumed to be privileged and need not be logged in this matter.

E. Proposed Discovery Plan and Proposed Changes to the Limitations on Discovery

Subject to the Court's approval, the parties propose the following modifications to the presumptive limitations on discovery set forth in the Federal Rules of Civil Procedure:

i. Interrogatories: A maximum of 50 interrogatories, including contention interrogatories, are permitted for each side. This limit does not include the Patent Local Rule Disclosures, except to the extent that a party serves interrogatories that overlap with the subjects of those Disclosures. The parties will work in good faith to extend the foregoing limits if it is reasonably necessary.

ii. Requests for Admission: A maximum of 50 requests for admission are permitted for each side. The parties will work in good faith to extend the foregoing limits if it is reasonably necessary, as well as to develop a process for authenticating documents without the need for requests for admission.

iii. Document Production: The Court entered a protective order governing confidentiality in each case that will enable the use of all documents produced before consolidation in this consolidated case. 4823 Case, Dkt. 56; 6360 Case, Dkt. 60.

iv. Fact Depositions: Unless the parties agree otherwise or the Court so permits, each side is limited to 140 hours of taking testimony by deposition upon oral examination of fact witnesses deposed in their individual capacity (whether party or non-party witnesses). Each individual fact witness deposition is limited to 7 hours of testimony, unless the parties agree otherwise or the Court so permits. To the extent both sides seek to depose the same fact witness, the parties shall confer regarding the total time to be allotted for the deposition of that fact witness and shall promptly raise any unresolved disputes with the Court. For any deposition

conducted primarily through an interpreter, 1.5 hours of time on the record shall count as 1 hour of deposition time towards any deposition limits.

v. Expert Depositions: Along with the submission of an expert's report, the party shall advise of the dates and times of their expert's availability for deposition before the close of expert discovery. The parties will work in good faith to adjust the limits under Federal Rule of Civil Procedure 30(d) if reasonably necessary.

vi. Email Discovery: This Court has ordered email discovery based on this District's Model Stipulated Order Re: the Discovery of Electronically Stored Information for Patent Litigation. 4823 Case, Dkt. 62, 6360 Case, Dkt. 67.

9. Class Actions

This is not a class action.

10. Related Cases

There are no related cases pending in this district. There are two petitions for *inter partes* review filed July 15, 2024 challenging the '051 and '170 Patents at issue in this action pending before the United States Patent Trial and Appeal Board. IPR2024-01177; IPR2024-01178.

11. Relief

Plaintiffs seek:

i. A judgment that Bio-Rad directly infringed (literally and/or under the doctrine of equivalents), contributorily infringed, and induced infringement of the '051 Patent;

ii. A judgment that Bio-Rad directly infringed (literally and/or under the doctrine of equivalents), contributorily infringed, and induced infringement of the '170 Patent;

iii. A judgment that Bio-Rad directly infringed (literally and/or under the doctrine of equivalents), contributorily infringed, and induced infringement of the '921 Patent;

iv. An order, prior to the expiration of the Caltech Patents, enjoining Bio-Rad from: (1) making, offering for sale and selling its infringing products and related multiplexing assays, and (2) infringing the Caltech Patents;

v. An award of monetary damages suffered as a result of Bio-Rad's infringement of

the Caltech Patents;

vi. An accounting of the monetary damages to be awarded to Plaintiffs as a result of Bio-Rad's infringing activities, including an accounting for infringing conduct not presented at trial and an award of additional damages for any such infringing activities;

vii. A finding that Bio-Rad's infringement of the Caltech Patents was egregious and willful and an award to Plaintiffs of three times their actual damages;

viii. A declaratory judgment that ChromaCode does not infringe any claims of the Bio-Rad Patents literally or under the doctrine of equivalents;

ix. A declaratory judgment that the Bio-Rad Patents are invalid and/or unenforceable;

x. An order that Bio-Rad is restrained and enjoined from further prosecuting or instituting any action against ChromaCode claiming that the Bio-Rad Patents are infringed, or from representing that any of ChromaCode's products, directly or indirectly, infringe the Bio-Rad Patents;

xi. A declaration that this case is exceptional under 35 U.S.C. § 285 and an award to Plaintiffs of their attorneys' fees, costs, and expenses incurred in this action; and

xii. An award to Plaintiffs of any further and additional relief as the Court may deem just, equitable, and proper.

Defendant seeks:

i. A judgment that Plaintiffs are not entitled to any relief whatsoever, including the relief requested by Plaintiffs from either Bio-Rad or the Court;

ii. A judgment that ChromaCode has directly infringed, induced infringement of, and contributorily infringed one or more claims of the '128 and '154 Patents and that this infringement has been willful and deliberate;

iii. An order preliminarily and permanently enjoining ChromaCode and its officers, directors, agents, servants, affiliates, employees, divisions, branches, subsidiaries, parents, and all others acting in active concert therewith from further infringement

of the ’128 and ’154 Patents;

iv. An award of damages pursuant to 35 U.S.C. § 284;

v. A declaration that ChromaCode’s infringement of the Bio-Rad Patents has been willful and deliberate, and an increase to the award of damages of three times the amount found or assessed by the Court, in accordance with 35 U.S.C. § 284;

vi. An order accounting of damages from ChromaCode’s infringement of the Bio-Rad Patents;

vii. A judgment that Bio-Rad does not infringe the ’051 Patent, directly (literally and/or under the doctrine of equivalents), contributorily, or by inducement;

viii. A judgment that the ’051 Patent is invalid;

ix. A judgement that the ’051 Patent is unenforceable;

x. A judgment that Bio-Rad does not infringe the ’170 Patent, directly (literally and/or under the doctrine of equivalents), contributorily, or by inducement.

xi. A judgment that the ’170 Patent is invalid;

xii. A judgement that the ’170 Patent is unenforceable;

xiii. A judgment that Bio-Rad does not infringe the ’921 Patent, directly (literally and/or under the doctrine of equivalents), contributorily, or by inducement.

xiv. A judgment that the ’921 Patent is invalid;

xv. A judgment that the ’921 Patent is unenforceable;

xvi. A judgment declaring this case exceptional under 35 U.S.C. § 285 awarding Bio-Rad its attorneys’ fees and prejudgment and post-judgment interest;

xvii. An award of all Bio-Rad’s costs in this action; and

xviii. An award to Bio-Rad such other and further relief as the Court may deem just and proper.

12. Settlement and ADR

The parties have engaged in the process of good faith participation in ADR Procedure No. 3 (“Early Settlement Conference with a Magistrate Judge”) and held a settlement conference with

Magistrate Judge van Keulen on July 17, 2024, 4823 Case, Dkt. 67. Bio-Rad also had a conference call regarding settlement negotiations on August 8, 2024. 4823 Case, Dkt. 78. The parties expect settlement discussions to continue and request an additional settlement conference with Magistrate Judge van Keulen following issuance of the Court's Claim Construction Order.

13. Other References

This action is not suitable for reference to binding arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

14. Narrowing of Issues

The parties are currently unable to narrow any issues by agreement or otherwise, but may be able to do so after fact discovery and claim construction.

15. Expedited Schedule

The procedure in General Order No. 64 Attachment A is not appropriate in this action.

16. Scheduling

1. Plaintiffs' Statement:

As noted above, Bio-Rad never raised any concerns about the parties' ability to complete fact discovery under the prior schedule until now.

Plaintiffs believe the parties are positioned to complete fact discovery within 90 days after the Claim Construction Hearing, consistent with both the schedule set by Judge Davila and this Court's Civil Standing Order. Plaintiffs also recognize that the Court may wish to hold a Claim Construction Hearing relatively soon—perhaps as early as October 2024—given that these cases have each been pending for a year and, further, that the Court's Civil Standing Order contemplates cases going to trial within 12-20 months of an initial case management conference. Civil Standing Order at 4 ("Counsel requesting longer pretrial periods must be prepared to justify that request"). Given these considerations, Plaintiffs have proposed a schedule that defers to the Court's selection of a date for the Claim Construction Hearing and sets later events relative to that hearing date, consistent with the time periods set forth in the Court's Civil Standing Order.

2. Bio-Rad's Statement:

This case is in its earliest stages, most notably with regard to discovery, as documented above in § 8.A. No depositions have been noticed, let alone taken. Plaintiffs have failed to produce documents responsive to Bio-Rad's requests for production and have merely made their mandatory disclosures under the Patent Local Rules and have otherwise failed to engage in amending deficient interrogatory responses.

Bio-Rad's proposed schedule appropriately takes into consideration the status and complexity of this case. This is a five-patent case involving patent assertions on both sides and multiple accused products and was consolidated and reassigned to Your Honor less than one month ago. A claim construction hearing has not been scheduled, and, as documented above, a full slate of discovery remains ahead. Bio-Rad's proposal set forth below takes into account the required effort and expenditures for the Court to familiarize itself with the case in advance of the claim construction hearing and leaves sufficient time for the parties to then complete discovery. Plaintiffs, on other hand, propose a schedule with no fixed dates and would, for instance, call for fact discovery to complete 90 days after the claim construction hearing, without regard to when the claim construction hearing actually takes place. In this regard, Plaintiffs' proposal fails to consider the actual facts and circumstances of this case and should be rejected.[1]

3. The Parties' Proposed Schedules

The parties propose the following schedules:

Event	**Caltech and ChromaCode's Proposed Schedule**	**Bio-Rad's Proposed Schedule**
Meet and Disclose Good Faith Damages Estimates; Submit Damages Meeting Certification (see Patent L.R. 3-10, Dkt. 49)	9/30/24	

[1] Moreover, as noted above, there are currently pending petitions for *inter partes* review of the Caltech Patents. Bio-Rad's proposed schedule better allows for the *inter partes* reviews to progress, which may ultimately allow for substantial simplification of the case.

Event	**Caltech and ChromaCode's Proposed Schedule**	**Bio-Rad's Proposed Schedule**
Case Tutorial	**To be set by the Court**	December 5, 2024 or as soon as the Court is available thereafter
Claim Construction Hearing	**To be set by the Court**	December 12, 2024 or as soon as the Court is available thereafter
Advice of Counsel (see Patent L.R. 3-7)	30 days after Claim Construction order	30 days after Claim Construction order
Final Case Management Conference	28 days before Close of Fact Discovery	**To be set by the Court**
Close of Fact Discovery	90 days after Claim Construction Hearing	August 29, 2025
Opening Expert Report Deadline (for the party who has the initial burden of proof on the subject matter)	30 days after Close of Fact Discovery	October 24, 2025
Rebuttal Expert Report Deadline	60 days after Close of Fact Discovery	December 19, 2025
Close of Expert Discovery	90 days after Close of Fact Discovery	January 16, 2026
Deadline for Filing Summary Judgment Motion Opening Brief by Plaintiff Side and Opening Briefs for *Daubert* Motions[2]	14 days after Close of Expert Discovery	February 27, 2026
Deadline for Filing Summary Judgment Motion Opening/Opposition Brief by Defense Side and Opposition Briefs for *Daubert* Motions	14 days after Summary Judgment Motion Opening Brief by Plaintiff Side and Opening Briefs for Daubert Motions	March 27, 2026
Deadline for Filing Summary Judgment Motion Opposition/Reply Brief by Plaintiff Side and Reply Briefs for *Daubert* Motions	14 days after Summary Judgment Motion Opposition/Reply Brief by Plaintiff Side and Reply Briefs for *Daubert* Motions	April 17, 2026
Deadline for Filing Summary Judgment Motion Reply	14 days after Summary Judgment Motion	April 17, 2026

[2] *See* Standing Order for Civil Cases Before Judge Eumi K. Lee ("EKL CSO") at 9.

Event	**Caltech and ChromaCode's Proposed Schedule**	**Bio-Rad's Proposed Schedule**
Brief by Defense Side	Opposition/Reply Brief by Plaintiff Side	
Hearing on Summary Judgment and *Daubert* Motions	4 weeks after Close of Briefing on Summary Judgment and *Daubert* Motions	**To be set by the Court**
Pretrial Conference	**To be set by the Court** Plaintiffs propose 12 weeks after the Hearing on Summary Judgment and *Daubert* Motions	**To be set by the Court**
Trial	**To be set by the Court** Plaintiffs propose 4 weeks after the Pretrial Conference	**To be set by the Court**

17. Trial

This case will be tried to a jury. Plaintiffs anticipate a trial of approximately 10 days while Bio-Rad anticipates a trial of approximately 5 days.

18. Disclosure of Non-Party Interested Entities or Persons

The parties filed individual statements pursuant to Fed. R. Civ. P. 7.1 and Civ. L.R. 3-15. ChromaCode filed its Disclosure Statement and Certification of Interested Entities or Persons on September 20, 2023. 4823 Case, Dkt. 8. CalTech filed its Disclosure Statement and Certification of Interested Entities or Persons on October 13, 2023. 6360 Case, Dkt. 13. Bio-Rad filed its Disclosure of Non-Party Interested Entities or Persons on October 12, 2023. 4823 Case, Dkt. 16. The parties have no additional disclosures.

19. Professional Conduct

All attorneys of record for the parties have reviewed the Guidelines for Professional Conduct for the Northern District of California.

20. Other Matters that Facilitate Just, Speedy, Inexpensive Disposition

In accordance with this Court's order reassigning case to Judge Lee, 4823 Case, Dkt. 73,

the parties submit the following:

A. List or Description of Each Party

- ChromaCode and Caltech – Plaintiffs and Counter-Defendants
- Bio-Rad – Defendant and Counter-Plaintiff

B. Summary of All Claims, Counter-Claims, Cross Claims Or Third Party Claims

ChromaCode's and Caltech's Claims:

- DJs of Non-Infringement of U.S. Patent Nos. 9,222,128 and 9,921,154, filed in ChromaCode's 9/20/23 Complaint. 4823 Case, Dkt. 1.
- Infringement by Bio-Rad of U.S. Patent Nos. 10,068,051 and 10,770,170, filed in ChromaCode's 10/6/23 Complaint and Plaintiffs' 10/13/23 FAC, and 11,827,921, filed in Plaintiffs' 3/27/24 SAC. 6360 Case at Dkt. Nos. 1, 12, 54.

Bio-Rad's Claims and Counter-Claims:

- Counter-claims for Infringement by ChromaCode of U.S. Patent Nos. 9,222,128 and 9,921,154, filed 11/8/23. 4823 Case, Dkt. 27.
- Counter-claims for DJ of Non-Infringement of U.S. Patent Nos. 10,068,051, 10,770,170, and 11,827,921, filed in its 11/8/23 Answer to Plaintiffs' FAC and 4/10/24 Answer to Plaintiffs' SAC. 6360 Case at Dkt. Nos. 22, 57.
- Counter-claims for DJ of Invalidity of U.S. Patent Nos. 10,068,051, 10,770,170, and 11,827,921, filed in its 11/8/23 Answer to Plaintiffs' FAC and 4/10/24 Answer to Plaintiffs' SAC. *Id.*

C. Brief Procedural History of Case

The parties incorporate by reference herein Section 2.A and submit the below chart.

Event	Date	Case Before Consolidation
ChromaCode files for DJ of Non-Infringement of Bio-Rad Patents	September 20, 2023	-04823
ChromaCode files complaint alleging infringement of '051 and '170 Patents by Bio-Rad in C.D. Cal.	October 5, 2023	-06360
Plaintiffs file amended complaint alleging infringement of '051 and '170 Patents by Bio-	October 13, 2023	-06360

Event	Date	Case Before Consolidation
Rad in C.D. Cal.		
Bio-Rad counter-claims for infringement of Bio-Rad Patents	November 8, 2023	-04823
Bio-Rad counter-claims for DJ of non-infringement and invalidity of ’051 and ’170 Patents in C.D. Cal.	November 8, 2023	-06360
Bio-Rad files motion to transfer case pending in C.D. Cal. to N.D. Cal.	November 13, 2023	-06360
Case Transferred from C.D. Cal. to N.D. Cal.	December 7, 2023	-06360
Two cases are related, and the -06360 case is reassigned to Judge Davila from Judge Tigar	January 17, 2024	Both
Plaintiffs file second amended complaint alleging infringement of the CalTech Patents	March 27, 2024	-06360
Bio-Rad counter-claims for DJ of non-infringement and invalidity of CalTech Patents	April 10, 2024	-06360
Settlement conference with Magistrate Judge van Keulen	July 17, 2024	Both
Consolidation of two cases	August 16, 2024	Both
Reassignment to Your Honor	August 20, 2024	Both

D. Request for Immediate Case Management Conference

The parties believe an immediate case management conference is needed to gain clarity on the timing of the Claim Construction Hearing and the Close of Fact Discovery, and respectfully request that a case management conference be set at the Court’s earliest availability.

21. Local Patent Rule 2-1(b)(3) – Proposed Format of Claim Construction Hearing

The parties request a hearing before the Court on claim terms in dispute for both the Bio-Rad Patents and the CalTech Patents and estimate the hearing will require three (3) hours.

22. Local Patent Rule 2-1(b)(4) – How Parties Intend to Educate the Court on Technology

Consistent with Your Honor’s Standing Order for Patent Cases Section V(A), the parties request 30 minutes per side to present a tutorial to educate the Court about the technology involved in this case. This technology tutorial would take place before the Claim Construction Hearing.

23. Local Patent Rule 2-1(b)(5) – Non-Binding, Good-Faith Estimate of Damages Range

Plaintiffs: Plaintiffs are unable to provide any good-faith estimate of its damages for Bio-Rad's infringement of the Caltech Patents without further discovery. ChromaCode estimates Bio-

Rad's damages for ChromaCode's alleged infringement of the Bio-Rad Patents to have no value as ChromaCode does not infringe the Bio-Rad Patents and the Bio-Rad Patents are further invalid.

Defendant: Bio-Rad estimates its damages to be in excess of $12 million as a result of ChromaCode's infringement of the Bio-Rad Patents. Bio-Rad estimates Plaintiffs' damages for the alleged infringement of the Caltech Patents to have no value as Bio-Rad does not infringe the Caltech Patents and the Caltech Patents are further invalid.

24. Opportunities for Junior Lawyers

Plaintiffs: ChromaCode's case team includes junior attorneys Sachli Balazadeh-Nayeri and Jeffrey Nall, each law school class of 2021. ChromaCode anticipates that under the supervision of more senior attorneys, Ms. Balazadeh-Nayeri and Mr. Nall will each be given opportunities to argue in court, take depositions, and otherwise participate in the case.

Defendant: Bio-Rad's case team includes junior attorney Cole Uzat, law school class of 2023. Defendant anticipates that under the supervision of more senior attorneys, Mr. Uzat will be given opportunities to argue in court, take depositions and otherwise participate in the case.

Dated: September 16, 2024

By : */s/ Derek C. Walter*

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CIVIL L.R. 5-1(i)(3) ATTESTATION

I, Amy H. Candido, am the ECF user whose ID and password are being used to file this JOINT CASE MANAGEMENT STATEMENT & [PROPOSED] ORDER. In compliance with Civil Local Rule 5-1(i)(3), I hereby attest that Jesse A. Salen and Derek C. Walter have concurred in this filing.

Dated: September 16, 2024

By : *<u>/s/ Amy H. Candido</u>*
Amy H. Candido

<u>ORDER</u>

The above JOINT CASE MANAGEMENT STATEMENT & PROPOSED ORDER is approved as the Scheduling Order for this case and all parties shall comply with its provisions. [In addition, the Court makes the further orders stated below:]

IT IS SO ORDERED.

Dated: _____ , 2024

_____
HON. EUMI K. LEE
UNITED STATES DISTRICT JUDGE