

Scope of Brain Imaging Patent Dispute Comes into Focus

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Judge Stearns recently clarified the scope of an almost five-year-old multi-district patent dispute in the District of Massachusetts. Since early 2013, Judge Stearns has presided over NeuroGrafix' allegations of patent infringement after ten actions encompassing dozens of defendants were consolidated in the District of Massachusetts. In the suit relevant to Judge Stearns' most recent order, NeuroGrafix alleged that defendant Brainlab infringed U.S. Pat. No. 5,560,360, entitled "Image Neurography and Diffusion Anisotropy Imaging."

The Court's recent order stemmed from a dispute over whether plaintiff NeuroGrafix disclaimed all but one asserted claim in the action. Following years of proceedings, NeuroGrafix served supplemental interrogatory responses after the close of fact discovery, identifying claim 47 of the asserted '360 patent as asserted against Brainlab. The problem, Brainlab contended in its emergency motion to exclude the supplemental interrogatory answers and for sanctions, was that NeuroGrafix had already disclaimed all but claim 36 of the asserted patent. In support of its motion, Brainlab contended that all of the expert reports and other discovery from both parties focused only on claim 36 and did not address infringement of any other claims. For example, in response to repeated requests from Brainlab during discovery, NeuroGrafix eventually identified five claims from its original list of claims in its complaint, but claim 47 was not one of those five claims. And, Brainlab alleged that NeuroGrafix had long engaged in similar bait-and-switch tactics, shifting its infringement theories throughout the case from first asserting Brainlab infringed through its sale of MRI machines early on in the case to claiming its sale of various software products used in the MRI process infringed later in the case.

NeuroGrafix responded that it never withdraw the other asserted claims identified in its complaint, pointing to filings and discovery responses that identified several different claims, including claim 47. NeuroGrafix also pointed out that during the *Markman* process, defendant Brainlab proposed constructions for terms in claims other than claim 36, including claim 47, and the Court provided constructions for claims other than claim 36, again including claim 47, in its resulting order.

The Court ultimately determined that NeuroGrafix' supplemental interrogatory responses would be struck as untimely, because they were served approximately fourth months after the close of fact discovery. Judge Stearns declined, however, to preclude plaintiffs from asserting claim 47, as it had been previously included in their infringement contentions and the court saw "no evidence of an unequivocal withdrawal." But, the Court cautioned that plaintiffs' experts would be limited to opinions timely disclosed in their expert reports in accordance with the Federal Rules of Civil

Procedure. In so doing, the Court left open NeuroGrafix' ability to pursue claims other than claim 36 at trial, but, if Brainlab's assertions regarding the content of the parties' expert reports are to be believed, potentially without opinion testimony from an expert regarding infringement. Parties should be careful to identify and provide evidence for any claims it could potentially assert before the close of fact discovery, to avoid similar disputes over disclaimer or untimely discovery responses.

The case is *In re: Neurografix ('360) Patent Litigation*, 1:13-md-02432-RGS, before Judge Stearns in the District of Massachusetts.

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National Law Review, Volumess VIII, Number 39

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