United States District Court,
C.D. California.

Roland T. CLARK,
Plaintiff.
v.
EVERETT ASSOCIATES, INC,
et al. Defendants.

No. 8:97-CV-351 GLT EE

July 20, 1998.

ORDER GRANTING PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT

TAYLOR**, J.**

Calendar Item # 14A

Plaintiff's Motions for Partial Summary Judgment on the issues of Validity, Infringement, and Willful Infringement are GRANTED. Plaintiff's Motion for Partial Summary Judgment denying Defendants' Anticipation and Obviousness claims as a matter of law is GRANTED. Defendants' request for the Court to sua sponte grant summary judgment against Plaintiffs is DENIED.

Plaintiff has moved for partial summary judgment on the issues of validity, infringement, and willfulness. Plaintiff also seeks summary judgment denying Defendants' unenforceability claims as a matter of law. In response, Defendants have asked the Court, sua sponte, to grant summary judgment against Plaintiffs and in favor of Defendants.

Summary judgment is proper if "there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(e). The moving party bears the initial burden of proving the absence of a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). A dispute about a material fact is genuine "if the evidence is such that a reasonable jury could return a verdict for the non-moving party." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). If the moving party makes this showing, the burden then shifts to the non-moving party to "designate specific facts showing that there is a genuine issue for trial." *Id*. at 324. In making this determination, "the inferences to be drawn from the underlying facts contained in [evidentiary] materials must be viewed in the light most favorable to the party opposing the motion." United States v. Diebold, Inc., 369 U.S. 654, 655(1962). Only if the non-moving party fails, "the moving party is entitled to a judgment as a matter of law." Celotex, 477 U.S. at 323.

Initially, the Court must determine patent validity. To make this determination the Court must rule on construction of claim 1 of U.S. Patent No. 5,009,170 ("the '170 patent") and Defendants invalidity defenses.

After establishing the validity of the patent, the Court can then turn to the issues of infringement.

I. ***Patent Validity***

A patent, and each claim of a patent, is presumed valid. See 35 U .S.C. s. 282. Thus, the infringer challenging the validity has the burden of showing clear and convincing evidence of facts establishing invalidity. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1459 (Fed.Cir.1984).

A. ***Claim Construction***

At the outset, the Court must determine the meaning and scope of the patent claim asserted to be infringed. Claim construction is a question of law to be decided exclusively by the court. Markman v. Westview Instruments, 52 F.3d 967, 983-84 (Fed.Cir.1995). In this initial step, the court examines the language of the claim which defines the scope of protection. Bell Communications Research, Inc. v. Vitalink Communications Corporation, 55 F.3d 615, 619 (Fed.Cir.1995).

The claim at issue in this motion, Claim 1 of the '170 patent, contains twelve subparagraphs setting forth the patent's limitations . FN1 Plaintiff has provided an interpretation of each of these subparagraphs which attaches plain meaning of the words of the claim. *See* id. at 620 (directing courts to examine the words of a claim and ascribe to them ordinary meaning). Plaintiff has supported its interpretations by referring to the specification of the patent and its prosecution history. *See* Markman, 52 F.3d at 979 (directing courts to examine same).

FN1. These 12 subparagraphs are verbatim:
1. a pair of rectangular table top sections;

2. a peripheral border flange depending from each of said sections;

3. hinge members interconnecting said flange bottom edges of adjacent sides of said sections to enable folding of said table top sections from working configuration, wherein said table top sections are coplanar, to a portable configuration, wherein the bottom edges of said flanges are juxtaposed;

4. two pairs of support legs of rectangular cross section;

5. a first means hingably securing a first end of each said pair of legs to the underside of each said table top section to fold toward said hinge members within said border flange;

6. a first ridge cross brace secured between the legs of each pair thereof;

7. two pairs of support aims of rectangular cross section, each said arm comprising a first and second section pivotally interconnected by a second pivot means securing facing sides of each other;

8. a third pivot means hingably securing a first end of each said pair of arms to the underside of each said table top section to fold toward said table top section within said border flange;

9. a fourth pivot means securing a second end of each said pair of arms to said pair of legs to fold toward said table top section into the receptacle formed by said border flange;

10. a second rigid cross brace secured between the arms of each pair thereof;

11. a pair of first flexible, non-stretchable cables, one of said cables being pivotally secured between each opposing pair of said second pivot means, each said cable being of length to be in tension when said table top sections are coplanar and when said legs are fully unfolded; and,

12. two pairs of flexible, non-stretchable second cables, each individual said second cable being pivotally secured between said first and said second pivot means, each said second cable being of length to be in tension when said table top sections are coplanar and when said legs are fully unfolded.

Defendants do not offer their own interpretations or direct the Court to areas which are ambiguous. Instead, Defendants contend. Plaintiff's interpretation is "too broad." Defendants point to Plaintiff's prior conduct and prior art as evidence of this overbreadth. Defendants' evidence of overbreadth, however, is not relevant to interpretation of the '170 patent. The Federal Circuit has held when a claim is unambiguous, a court should only look to specific intrinsic evidence: "[t]he claims, the specification, and the prosecution history." Id. In cases, such as here, where intrinsic evidence "unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996). Accordingly, Defendants evidence of conduct and prior art is not useful to the Court in interpreting Claim 1 of the '170 patent.

Although Defendants have failed to dispute Plaintiff's interpretation with intrinsic evidence, "the trial judge has an independent obligation to determine the meaning of the claims, notwithstanding the views asserted

by the adversary parties." Exxon Chemical Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1555 (Fed.Cir.1995). After an independent review, the Court finds Plaintiff's construction of subparagraphs 1-4, 6, and 10-12 to be correct. As to subparagraphs 5, 7, 8, and 9, the evidence before the Court requires closer analysis.

Subparagraphs 5, 7, 8, and 9 each contain a "pivot means" clause. Plaintiff construes these clauses as 35 U.S.C. s. 112(6) "means plus function" clauses. In a means plus function clause, at least one element of the claim is expressed as a means for performing a specified function, rather than as a specific structure. *See* 35 U.S.C. s. 112(6). Courts should consider the specification when determining whether the recited "means" language is a proper means plus function clause. In re Donaldson Co., Inc., 16 F.3d 1189, 1194 (Fed.Cir.1994). However, simply because a claim employs "means for" language followed by recitation of a function is not determinative. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531 (Fed.Cir.1996). FN2

FN2. Plaintiff interprets Cole v. Kimberly-Clark Corp., 102 F.3d 524, 530 (Fed.Cir.1996), as holding that recital of structure before the word "means" withdraws a clause from the purview of s. 112(6). In *Kimberly-Clark,* the claim at issue employed the phrase "perforation means." When the court held the claim was not a means plus function claim, it explained the patentee had included too many structural details. "An element with such detailed recitation of its structure, as opposed to its function, cannot meet the requirements of the statute." *Id*. at 531. Placement of the word "means" is not dispositive. In fact, even if a particular element of a claim does not employ the word "means" it can still be a means plus function element within the meaning of s. 112(6). *Id*.

Here, four pivot means clauses are at issue. Below is each of the "pivot means" clauses, the corresponding specification, and drawing information:

-> Subparagraph 5 recites "a first pivot means hingably securing a first end of each said pair of legs". FN3 The specification recites "at the outer end of each section 20, a pair of support legs is attached by first pivot means 35." The drawings show a "pivot means" 35 attaching each leg on the respective corner of the table. The preferred embodiment of the '170 patent uses a bolt and anchoring nut for each of its pivot means.

FN3. The Patent Office originally made an error in printing the patent. It omitted the word "pivot" between the words "first" and "means" in subparagraph 5. A Certificate of Correction was later issued inserting the word "pivot" after the word "first". The certificate was properly issued under 35 U.S.C. s. 254 and 37 C.F .R. s. 1.322 to correct a Patent Office error. Subparagraph 5 of Claim 1, as amended, reads as quoted.

-> Subparagraph 7 recites "a first and second section pivotally interconnected by a second pivot means". The '170 patent specification recites "[e]ach section 20 has a pair of support arms, each arm comprising a first length 50 and a second length 60 interconnected by second pivot means 36". The drawings show the preferred embodiment support are connected by a second pivot means with of a bolt and an anchoring nut.
-> Subparagraph 8 recites "a third pivot means hingably securing a first end of each said pair of arms to the underside of each said table top". The specification recites "[t]he free end of each first length 50 is connected to border flange 80 by third pivot means 37". The specification describes the preferred embodiment of the third pivot means as a bolt and anchoring nut.

-> Subparagraph 9 recites "a fourth pivot means securing a second end of each said pair of arms to said pair

of legs to fold toward said table top". The specification recites "the free end of each first length 50 is connected to support let 30 by fourth pivot means 38." The specification describes the preferred embodiment of the third pivot means as a bolt and anchoring nut.

The Court finds the "pivot means" clauses in these subparagraphs are proper "means plus function" language as permitted under 35 U.S.C. s. 112(6). A pivot is "a point, shaft, pin, etc. on which something turns." Webster's New World Dictionary of American English 1030 (3d college ed.1988). The elements of the claim are expressed as a means for performing the specified "pivot" function. The clauses are not so detailed in recitation of structure, as opposed to its function, so to pull them outside the contemplation of s. 112(6). In sum, the Court finds Plaintiff's interpretation of Claim 1 of the '170 patent as set forth in the motion papers at pages 12 through 19 is proper as a matter of law.

B. ***Invalidity Defenses***

Defendants contend Claim 1 of the '170 patent is invalid because it is both anticipated and obvious. The basis of Defendants claims is prior art. FN4 The evidence presented, however, raises no genuine issues of material fact. Defendants fail to overcome the presumption that the '170 patent is valid.

FN4. Defendants correctly note, if there is prior art which was not considered by the Patent Office, the presumption of validity which normally attaches to a patent is easier to overcome. *See* American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1360 (Fed.Cir.1984)(finding introduction of prior art not previously considered by the patent examiner may make the clear and convincing standard easier to meet when such art is more pertinent than the cited prior art). Although the Court applied this more lenient standard, Defendants nonetheless failed to overcome this lower presumption of validity.

1. ***Prior Art***

The primary evidence offered by Defendants of invalidity is Exhibit C to the declaration of Thomas Kevin Konicek. Exhibit C is U .S. Patent No. 4,833,998 (the " '998 patent") and is offered as evidence of prior art. This evidence, however, if offered in direct contradiction to Response to Request for Admission No. 63 where Defendants admit they "know[ ] of no prior art which, alone or in combination, invalidates Claim 1 of U.S. Patent No. 5,009,170 in suit."

The Ninth Circuit has held, and Fed.R.Civ.P. 36(b) provides, "any matter admitted in response to a request for an admission is conclusively established unless the court permits withdrawal or amendment of the admission." 999 v. C.I.T. Corp., 776 F.2d 866, 869 (9th Cir.1985). The Court has not granted permission here. Nor can Defendants argue this is recently discovered evidence which merits retroactive amendment since Defendant Payne testified about the '998 patent more than four months ago. Payne Dep. at 29. Defendants cannot now create a material issue of fact by raising evidence in Opposition which contradicts earlier admissions. *See* Radobenk v. Automated Equipment Corporation, 520 F.2d 540, 544 (9th Cir.1975).

For this reason alone, the Court could conclude Defendants anticipation and obviousness defenses are unsupported. Nonetheless, assuming arguendo the Court accepts the '998 patent as viable evidence, Defendants anticipation and obviousness defenses still fail.

2. ***Anticipation***

Defendants contend the '170 patent is invalid due to anticipation. Under 35 U.S.C. s. 102, "invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference." Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed.Cir.1991). Anticipation is a question of fact which may be decided on a motion for summary judgment only if no material facts are disputed. *Id*.

The Everett '998 patent does not expressly anticipate Claim 1 of the '170 patent. The '998 patent uses only two cables per table, the cables are not connected between the pivot points of the support arms, and the table legs are not connected by cables to the support arms. Claim 1 of the '170 patent describes a portable massage table which uses six cables, connects the cables between the pivot points and the support arms, and connects the table legs by cables to the support arms. These differences are sufficient to defeat Defendants anticipation defense.

Nonetheless, Defendants make an inherency argument. Disclosure need not be express, but may anticipate by "inherency" where it would be appreciated by one of ordinary skill in the art. *Continental Can Co. USA Inc. v. Moncanto Co.,* 940 F.2d 1264, 1268 (Fed.Cir.1991). Here, Defendants contend "the '998 patent inherently teaches the exact same design as the '170 patent." Opp. at 5 (emphasis in the original). The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Id. at 1268.

Here, Defendants have failed to present extrinsic evidence which clearly fills any alleged gaps in the '998 patent. No evidence has been presented to showing a person of ordinary skill in the art of portable massage table construction would find the '170 cabling system inherent in the '998 patent. Instead, the evidence shows the cabling of the '170 patent, as part of the "cradlelock design" was considered a "revolutionary" change. Nani Dep. 30-31. "Inherency, [ ] may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id.

No genuine issues of material fact are in dispute. Defendants' as a matter of law cannot maintain a claim for anticipation.

3. *Obviousness*

Defendants also contend the '170 patent is invalid for obviousness. The defense of obviousness stems from the principle that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. s. 103. Obviousness is a question of law based upon underlying factual determinations. Electro Medical Systems v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1052 (Fed.Cir.1994). According to the Supreme Court, the factual determinations a court must make are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, and (3) the level of ordinary skill in the pertinent art. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). A court also may take into account

"secondary considerations" which include (1) commercial success, (2) long felt but unsolved needs, and (3) the failure of others to solve the problem. *Id*.

At best, Defendants have stated a possibility that prior art references could have been combined to create the '170 patent. Defendants, however, have failed to support this argument with pertinent *Graham* evidence. *See* Gentry Gallery Inc. v. Berkline Corp., 134 F.3d 1473, 1478 (Fed.Cir.1998) (finding the mere possibility that prior art was used is insufficient). The evidence shows the '170 design is different from the '998 design. In fact, Defendant Payne has testified the '998 patent with the "Auto-Lock" system was allowed to lapse after the '170 patent entered the market with the "cradlelook design" because the '998 patent had become insignificant. Payne Dep. at 30-31. Moreover, Plaintiff has presented evidence that the '170 "cradlelock design" went beyond ordinary skill in the pertinent art and solved long-standing problems in the portable massage table industry. Nani Dep. at 30-31. Id. (calling the '170 patent "revolutionary").

Instead of presenting *Graham* evidence, Defendants once again point to prior art as evidence of obviousness. *Graham* evidence is required to support obviousness claims because "[v]irtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1575 (Fed.Cir.1987).

As a matter of law, Defendants' obviousness claims and defenses are untenable. In sum, Defendants have failed to overcome the presumption of validity of the '170 patent. Partial summary judgment in favor of Plaintiff's as to validity of the patent is GRANTED.

II. ***Patent Intringement***

Since the Court has determined the '170 patent is valid, it can now turn to the question of infringement. Determining whether a particular device infringes on a properly construed claim, is a question of fact. *See* Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1569 (Fed.Cir.1983). As such, it is amenable to summary judgment only where, as here, no reasonable fact finder could disagree with a finding of infringement. *See* Warner-Jenkinson Co. v. Hilton Davis Chem, Co., 117 S.Ct. 1040, 1053 n.8 (1997).

A claim is infringed only if each limitation in the claim is found in the accused device, either literally or by a substantial equivalent. Id. at 1049. Here, Plaintiff claims each limitation in the '170 patent is found in the accused devices either literally or by a substantial equivalent. Defendants admit "the majority of the features" of the Living Earth tables at issue share "common principals" with the features of the '170 table. Opp. at 14. Defendants contend, however, it is "in the execution of those common principles, the '170 table and the Living Earth tables differ significantly." FN5 Id. Specifically, Defendants contend the accused devises have pivot elements which are not equivalent to the pivot means limitations set forth in subparagraphs 5, 7, 8, and 9 of the claimed device.FN6

FN5. Defendants assertion that the accused tables do not have "facing sides of support arms fastened to each other" is incorrect. The accused table's support arms do have facing sides fastened to each other, with a pulley in between. The addition of a pulley does not detract from the fact that the accused structure has the structure recited by Claim 1 of the '170 patent. "Modification by mere addition of elements or functions, whenever made, cannot negate infringement". Amstar Corp. v. Envirotech Corp., 730 F.2d 1476, 1481-82 (Fed.Cir.1982).

FN6. Defendants' Opposition also argues since a number of the features of the '170 table were included in prior art, there cannot be infringement. This argument ignores the holding of *Baxter Healthcare Corp. v. Spectramed, Inc.,* 49 P.3d 1575 (Fed.Cir.1995). The *Baxter* court declared an accused infringer's assertion that it is only doing "what was already disclosed in the prior art is not a correct statement of the law governing patent infringement." *Id.* at 1583. The court explained infringement turns on whether each of the limitations of the patent claim are found in the accused device, not on whether the accused device combines teachings of the prior art. *Id.* Evidence of "prior art go[es] to validity of claims, not to whether an accused device infringes." *Id.*

Under the doctrine of equivalents, "a product or process that does not liberally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson, 117 S.Ct. at 1045. Infringement may be found under the doctrine of equivalents only if every limitation of the asserted claim, or its "equivalent," is found in the accused subject matter and the "equivalent" elements differ from the claimed limitation insubstantially. *Id.*

For each of the four pivot means in the '170 patent, the specification describes the preferred embodiment as an "anchor bolt and a nut." Defendants note the accused table's pivots are "machine screws set into a threaded wood block," "a bolt with a propeller nut secured by a locking nut," a "clevis pin secured by a cotter pin," and a bolt which is threaded into the table legs instead of being threaded so as to receive a nut. Based on these differences, Defendants contend there is no infringement.

These differences, however, are insubstantial. Each of the devices in the accused table provide a shaft about with a related part swings or rotates-in essence a "pivot means." The components used in the accused table perform substantially the same function as the claimed limitation, in substantially the same way, to achieve substantially the same result. *See* id. at 1054 (stating such similarity is relevant to a determination of equivalence). The Court finds the only conclusion a reasonable trier of fact could reach is that where the accused table differs from the '170 patent, it is nonetheless equivalent. Defendants' table structures as shown in Exhibits A-D to the Spehar Declaration, Exhibit C to the Clark Declaration, and Exhibit 5 to the Gray Declaration infringe on Claim 1 of the '170 patent. Partial summary judgment in favor of Plaintiff's as to infringement is GRANTED.

III. *Willful Infringement*

Plaintiff contends Defendants infringement has been willful. "Willful infringement" means the infringer has no reasonable basis for believing it has a right to do the allegedly infringing acts. Stickle v. Heublein, Inc., 716 F.2d 1550, 1565 (Fed.Cir.1983). "The test [for establishing willful infringement] is whether, under all the circumstances, a reasonable person would prudently conduct himself with any confidence that a court might hold the patent invalid or not infringed." Ryco, Inc. v. Ag-Bag Corp., 857 F.2d 1418 (Fed.Cir.1988). The court must examine the totality of the circumstances, including legal opinions sought and the substance of the opinions rendered. Radio Steel & Mfg. Co. v. MTD Prod. Inc., 788 F.2d 1554, 1559 (Fed.Cir.1986). Although willfulness is an issue of fact, a motion for summary judgment is appropriate where there are no genuine issues of material fact for trial. Avia Group Intern., Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 1566 (Fed.Cir.1988).

Here, Defendants have admitted, both in deposition and in response to interrogatories, that they received notice of infringement and a copy of the '170 patent by August 1996. Defendants also admit they did not seek advice of legal counsel regarding potential infringement, but rather continued to infringe. The Federal Circuit has held a potential infringer with actual notice of another's patent rights has an affirmative duty to exercise due care to determine whether or not he is infringing. Id . at 1566. This affirmative duty includes, among other things, the duty to seek and obtain competent legal advice from counsel before the initiation of any possible infringing activity. Id. It is uncontroverted that Defendants have failed to carry out this duty.

Instead, Defendants argue there was no "actual notice" since Plaintiff did not properly mark the '170 tables. This argument is not well-taken. If a patentee fails to mark his patented article, no damages may be recovered in an action for infringement, "except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice." 35 U.S.C. s. 287(a). Such proof of actual notice and continued infringement has been presented here.

The Court finds the evidence of willful infringement undisputed. Partial summary judgment in favor of Plaintiff's as to willfulness is GRANTED. Defendants request for the Court to sua sponte grant summary judgment against Plaintiff and in favor of Defendants is DENIED.

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