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5 UNITED STATES DISTRICT COURT
6 WESTERN DISTRICT OF WASHINGTON
7 AT TACOMA

8 SYNTRIX BIOSYSTEMS, INC.,

9 Plaintiff,

10 v.

11 ILLUMINA, INC.,

12 Defendant.

CASE NO. C10-5870 BHS

ORDER DENYING PLAINTIFF'S
MOTION FOR PARTIAL
SUMMARY JUDGMENT

13 This matter comes before the Court on Plaintiff Syntrix Biosystems, Inc.'s
14 ("Syntrix") motion for partial summary judgment (Dkt. 106). The Court has considered
15 the pleadings filed in support of and in opposition to the motion and the remainder of the
16 file and hereby denies the motion for the reasons stated herein.

17 **I. PROCEDURAL HISTORY**

18 On November 24, 2010, Syntrix filed a complaint against Defendant Illumina, Inc.
19 ("Illumina") alleging infringement of United States Patent No. 6,951,682 ("682 patent");
20 trade secret misappropriation under the Uniform Trade Secrets Act, RCW Chapter 19.108
21 ("UTSA"); breach of contract; and unjust enrichment. Dkt. 1. On January 31, 2011,
22 Illumina answered and asserted the affirmative defense that the '682 Patent is "invalid for

1 failure to satisfy one or more conditions of patentability set forth in Title 35 of the United
2 States Code, including but not limited to 35 22 U.S.C. §§ 101, 102, 103, and/or 112.”
3 Dkt. 39.

4 On December 19, 2012, Syntrix filed a motion for partial summary judgment.
5 Dkt. 106. On January 7, 2013, Illumina responded. Dkt. 117. On January 11, 2013,
6 Syntrix replied. Dkt. 130.

7 **II. FACTUAL BACKGROUND**

8 On September 17, 1999, Dr. John A. Zebala, filed U.S. utility patent application
9 09/332,815 (“‘815 application”), which claimed priority to U.S. provisional patent
10 application number 60/110,529 filed on December 1, 1998. On October 4, 2005 the ‘815
11 application issued as the ‘682 Patent, which is titled “Porous Coatings Bearing Ligand
12 Arrays and Use Thereof.”

13 On June 11, 2008, Illumina filed a re-examination petition requesting that the ‘682
14 Patent be re-examined in light of prior art references. Dkt. 107, Declaration of
15 Christopher Schenck, Exh. F. During the re-examination, the examiner considered two of
16 the currently cited references, U.S. Patent No. 6,023,540 (“Walt ’540”) and U.S. Patent
17 No. 5,900,481 (“Lough”). *Id.*, Exh. D. On June 29, 2010, the USPTO issued a re-
18 examination certificate confirming the patentability of the claims, with only two minor
19 amendments to those claims. *Id.*, Exh. H.

20 Illumina’s expert, Dr. Milan Mrksich, Ph.D., asserts that the ‘682 Patent is
21 anticipated and/or obvious in light of seven references. *Id.*, Exh. B. Syntrix categorizes
22 the references into three families based on similarities in the disclosed technologies: (1)

1 the Walt Family that includes Walt '540, U.S. Patent No. 6,327,410 (“Walt ’410”), and
2 U.S. Patent No. 7,060,431 (“Chee”); (2) the Lough Family that includes Lough and U.S.
3 Patent No. 6,133,436 (“Köster”); and (3) the Brenner Family that includes Patent
4 Application No. PCT/US95/12791 published as WO96/12014 (“Brenner”) and U.S.
5 Patent No. 6,406,848 (“Bridgham”). Dkt. 106 at 8.

6 **III. DISCUSSION**

7 Syntrix moves for summary judgment on Illumina’s affirmative defenses that the
8 ‘682 Patent is invalid “due to lack of utility, anticipation, or obviousness.” Dkt. 106 at 1.

9 **A. Summary Judgment Standard**

10 Summary judgment is proper only if the pleadings, the discovery and disclosure
11 materials on file, and any affidavits show that there is no genuine issue as to any material
12 fact and that the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c).
13 The moving party is entitled to judgment as a matter of law when the nonmoving party
14 fails to make a sufficient showing on an essential element of a claim in the case on which
15 the nonmoving party has the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317,
16 323 (1986). There is no genuine issue of fact for trial where the record, taken as a whole,
17 could not lead a rational trier of fact to find for the nonmoving party. *Matsushita Elec.*
18 *Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986) (nonmoving party must
19 present specific, significant probative evidence, not simply “some metaphysical doubt”).
20 *See also* Fed. R. Civ. P. 56(e). Conversely, a genuine dispute over a material fact exists
21 if there is sufficient evidence supporting the claimed factual dispute, requiring a judge or
22 jury to resolve the differing versions of the truth. *Anderson v. Liberty Lobby, Inc.*, 477

1 U.S. 242, 253 (1986); *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass’n*, 809 F.2d
2 626, 630 (9th Cir. 1987).

3 The determination of the existence of a material fact is often a close question. The
4 Court must consider the substantive evidentiary burden that the nonmoving party must
5 meet at trial – e.g., a preponderance of the evidence in most civil cases. *Anderson*, 477
6 U.S. at 254; *T.W. Elec. Serv., Inc.*, 809 F.2d at 630. The Court must resolve any factual
7 issues of controversy in favor of the nonmoving party only when the facts specifically
8 attested by that party contradict facts specifically attested by the moving party. The
9 nonmoving party may not merely state that it will discredit the moving party’s evidence
10 at trial, in the hopes that evidence can be developed at trial to support the claim. *T.W.*
11 *Elec. Serv., Inc.*, 809 F.2d at 630 (relying on *Anderson*, 477 U.S. at 255). Conclusory,
12 nonspecific statements in affidavits are not sufficient, and missing facts will not be
13 presumed. *Lujan v. Nat’l Wildlife Fed’n*, 497 U.S. 871, 888-89 (1990).

14 **B. Standard of Proof**

15 “[I]n ruling on a motion for summary judgment, the judge must view the evidence
16 presented through the prism of the substantive evidentiary burden.” *Anderson*, 477 U.S.
17 at 254. “A patent shall be presumed valid.” 35 U.S.C. § 282 (2006). The party asserting
18 invalidity carries “[t]he burden of establishing invalidity of a patent or any claim
19 thereof.” *Id.* Invalidity, as a defense to infringement, must be proved by clear and
20 convincing evidence. *Microsoft Corp. v. i4i Ltd.*, 564 U.S. _____, 131 S. Ct. 2238, 2242
21 (2011). When an issue requires clear and convincing evidence, “the appropriate
22 summary judgment question will be whether the evidence in the record could support a

1 reasonable jury finding either that the [party] has shown [invalidity] by clear and
2 convincing evidence or that the [party] has not.” *Anderson*, 477 U.S. at 255.

3 **C. Lack of Utility**

4 In its response, Illumina withdrew the affirmative defense of lack of utility. Dkt.
5 117 at 2. Therefore, the Court denies Syntrix’s motion on this issue as moot.

6 **D. Anticipation**

7 Invalidation based on anticipation requires the party challenging validity to show,
8 by clear and convincing evidence, that “every element and limitation of the claim was
9 previously described in a single prior art reference.” 35 U.S.C. § 102 (2006); *Sanofi-*
10 *Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1082 (Fed. Cir. 2008). A defendant’s burden
11 is reflected in the clear and convincing standard and a reexamination does not increase or
12 enhance it. *Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1259–61 (Fed. Cir. 2012)
13 (citing *Microsoft v. i4i Ltd. Partnership*, 131 S. Ct. 2238, 2250 (2011)). On the other
14 hand, prior art that differs from the prior art considered by the Patent Office may carry
15 more weight than the prior art that was considered. *Microsoft*, 131 S. Ct. at 2251. In
16 addition to the references themselves, “testimony concerning anticipation must be
17 testimony from one skilled in the art and must identify each claim element, state the
18 witnesses’ interpretation of the claim element, and explain in detail how each claim
19 element is disclosed in the prior art reference.” *Schumer v. Laboratory Computer*
20 *Systems, Inc.*, 308 F.3d 1304, 1315 (Fed. Cir. 2002).

21 In this case, Syntrix argues that Illumina has failed to provide clear and convincing
22 evidence of anticipation for every element of Claim 1 in the ‘682 Patent. Dkt. 106 at 14–

1 18. Specifically, Syntrix contends that “Dr. Mrksich did not articulate anywhere in his
2 report what specific aspect of each cited reference discloses the required ‘continuous’
3 element of Claim 1.” *Id.* at 14. The Court construed the term “continuous” as follows:
4 “A ‘porous coating’ is said to be ‘continuous’ when the coating covers the surface of the
5 substrate with virtually no discontinuities or gaps.” Dkt. 75 at 6.

6 With regard to the Walt Family of references, the anticipation argument is
7 intertwined with an infringement argument. Syntrix alleges that Illumina’s product
8 infringes the ‘682 Patent, and Illumina contends that its product is “effectively
9 indistinguishable” from the beads-in-wells structure disclosed by the Walt references.
10 Dkt. 117 at 7. Thus, the argument goes that the two Walt references, which were issued
11 before the ‘682 Patent, anticipate the ‘682 Patent because a product “which would
12 literally infringe if later in time anticipates if earlier.” *Upsher-Smith Laboratories, Inc. v.*
13 *Pamlab, L.L.C.*, 412 F.3d 1319, 1322 (Fed. Cir. 2005) (citations omitted). Taking the
14 inferences in the light most favorable to Illumina – (1) Illumina’s product is similar to the
15 technology disclosed by Walt and (2) Illumina infringes – the Court finds that Illumina
16 has produced evidence that a juror could find clear and convincing evidence of
17 anticipation of the term “continuous.” Therefore, the Court denies Syntrix’s motion as to
18 the Walt Family of references.

19 With regard to the Lough Family of references, Dr. Mrksich specifically addresses
20 the continuous term. For example, he states that “Lough describes a ‘high-density
21 binding of beads to the solid support,’ consistent with the [sic] a coating that covers the
22 surface of the substrate with virtually no discontinuities or gaps.” Mrksich Report, ¶ 253.

1 The Court finds that Illumina has produced evidence that a juror could find clear and
2 convincing evidence of anticipation of the term “continuous.” Therefore, the Court
3 denies Syntrix’s motion as to the Lough Family of references.

4 With regard to the Brenner Family of references, Dr. Mrksich’s report sufficiently
5 addresses the term “continuous.” Dr. Mrksich initially addresses the ‘682 Patent claim
6 limitation and then proceeds to describe monolayers and arrays of beads attached to a
7 substrate. *See, e.g.*, Mrksich Report, ¶¶ 188–193. The Court finds that this is evidence
8 that a juror could find clear and convincing evidence on the issue of anticipation of the
9 term “continuous.” Therefore, the Court denies Syntrix’s motion as to the Brenner
10 Family of references and the motion as to the affirmative defense of anticipation.

11 **E. Obviousness**

12 If “the differences between the subject matter [patented] and the prior art are such
13 that the subject matter as a whole would have been obvious” then the patent is rendered
14 obvious. 35 U.S.C. § 103 (2006). Obviousness is a question of law based on underlying
15 facts, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *Graham* factors
16 are (1) the scope and content of the prior art, (2) the difference between the prior art and
17 the claimed invention, (3) the level of ordinary skill in the field of the invention, and (4)
18 any relevant objective considerations.

19 In this case, the parties dispute the elements of obviousness as well as Illumina’s
20 evidence as to obviousness. First, the Court agrees with Syntrix that “[t]he tests for
21 anticipation and obviousness are different.” *Cohesive Technologies, Inc. v. Waters*
22 *Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (“it does not follow that every technically

1 anticipated invention would also have been obvious.” (citation omitted)). Therefore,
2 Illumina may not rely on the affirmative defense that the ‘682 Patent is obvious based on
3 inherent anticipation.

4 Second, Syntrix argues that “Dr. Mrksich’s analysis fails on its face to provide
5 clear and convincing evidence of obviousness.” Dkt. 106 at 18. While Dr. Mrksich fails
6 to provide a detailed, step-by-step determination of obviousness, the report cites evidence
7 that a juror could find clear and convincing evidence that creates a genuine issue of
8 material fact as to obviousness. The obviousness inquiry is “expansive and flexible” and
9 is “not subject to a rigid formula.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415, 419
10 (2007). The Court finds that Illumina has submitted sufficient information to raise
11 questions of fact on the *Graham* factors. Therefore, the Court denies Syntrix’s motion
12 for summary judgment on Illumina’s affirmative defense of obviousness.

13 IV. ORDER

14 Therefore, it is hereby **ORDERED** that Syntrix’s motion for partial summary
15 judgment (Dkt. 106) is **DENIED**.

16 Dated this 30th day of January, 2013.

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BENJAMIN H. SETTLE
20 United States District Judge
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