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**UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

BENCHMADE KNIFE CO., INC.,
Plaintiff,
v.
HOGUE, INC. and
HOGUE TOOL & MACHINE, INC.,
Defendants.

Case No. 2:20-cv-11177-JWH-GJSx

**MEMORANDUM OPINION AND
ORDER ON PLAINTIFF'S
MOTION TO STRIKE
AFFIRMATIVE DEFENSE OF
INEQUITABLE CONDUCT [ECF
No. 77]**

1 Before the Court is the motion of Plaintiff Benchmade Knife Co., Inc. to
2 strike the affirmative defense of inequitable conduct asserted by Defendants
3 Hogue, Inc. and Hogue Tool & Machine, Inc. (jointly, “Hogue”), pursuant to
4 Rule 12(f) of the Federal Rules of Civil Procedure.¹ The Court finds this matter
5 appropriate for resolution without a hearing. *See* Fed. R. Civ. P. 78; L.R. 7-15.
6 After considering the papers filed in support and in opposition,² the Court
7 **DENIES** the Motion for the reasons set forth below.

8 I. BACKGROUND

9 Benchmade Knife is the assignee of the U.S. Design Patent No. 686,900
10 (the “D’900 Patent”), entitled “Knife Blade.”³ Michael Ohlrich is the named
11 inventor on the D’900 Patent.⁴ The application for the D’900 Patent was filed
12 on May 21, 2012, and it issued July 30, 2013.⁵ The D’900 Patent claims priority
13 to Patent Application No. 29/394,650, which was filed on June 20, 2011, and is
14 now abandoned.⁶ The D’900 Patent includes a single claim for “the ornamental
15 design for a knife blade, as shown and described.”⁷ Figures 1 and 2 reproduced
16 below depict “upper perspective view of the right side [and left side of] a knife
17 blade illustrating [the claimed] design,” respectively:⁸

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20 ¹ Pl. Benchmade Knife Co., Inc.’s Mot. to Strike Affirmative Defense of
Inequitable Conduct (the “Motion”) [ECF No. 77].

21 ² The Court considered the following papers: (1) Answer to Am. Compl.
22 (the “Answer”) [ECF Nos. 72 & 73 (sealed version)]; (2) the Motion (including
its attachments); (3) Defs.’ Opp’n to the Motion (the “Opposition”) [ECF
23 No. 83]; (4) Pl.’s Reply in Supp. of the Motion (including its attachments) (the
“Reply”) [ECF No. 87].

24 ³ *See* D’900 Patent [ECF No. 60-1]; D’900 Patent Assignment [ECF
No. 75-3].

25 ⁴ *See* D’900 Patent.

26 ⁵ *Id.*

27 ⁶ *Id.*

28 ⁷ *Id.*

⁸ *Id.*

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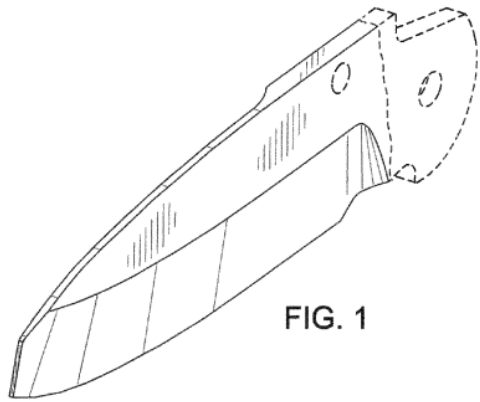


FIG. 1

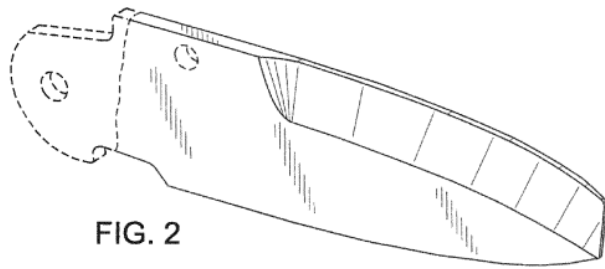


FIG. 2

II. LEGAL STANDARD

A. Rule 12(f)—Motion to Strike

Under Rule 12(f), the Court may strike “any insufficient defense or any redundant, immaterial, impertinent or scandalous matter.” Fed. R. Civ. P. 12(f). “The essential function of a Rule 12(f) motion is to ‘avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial.’” *Bureerong v. Uvawas*, 922 F. Supp. 1450, 1478 (C.D. Cal. 1996) (quoting *Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993), *overruled on other grounds*, 510 U.S. 517 (1994)).

When ruling on a Rule 12(f) motion to strike, the Court must view the pleading in the light most favorable to the nonmoving party. *See RDF Media Ltd. v. Fox Broad. Co.*, 372 F. Supp. 2d 556, 561 (C.D. Cal. 2005). “Motions to strike an affirmative defense are generally disfavored, but the court may properly grant them when the defense is insufficient as a matter of law.” *Multimedia Patent Tr.*

1 *v. Microsoft Corp.*, 525 F. Supp. 2d 1200, 1211 (S.D. Cal. 2007) (citations
2 omitted).

3 **B. Rule 9(f)—Pleading Inequitable Conduct**

4 “Inequitable conduct is an equitable defense to patent infringement that,
5 if proved, bars enforcement of a patent.” *Therasense, Inc. v. Becton, Dickinson &*
6 *Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011). Rule 9(b) governs inequitable
7 conduct claims. *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1326
8 (Fed. Cir. 2009). “Rule 9(b) requires that in all averments of fraud or mistake,
9 the circumstances constituting fraud or mistake shall be stated with
10 particularity.” *Id.* (internal quotation marks and bracket omitted). To meet that
11 standard, the Federal Circuit (like other circuits) requires the pleading party to
12 identify “the specific who, what, when, where, and how of the material
13 misrepresentation or omission committed before the PTO.” *Id.* at 1327.

14 Thus, a well-pleaded claim for inequitable conduct must allege facts
15 supporting that “(1) an individual associated with the filing and prosecution of a
16 patent application made an affirmative misrepresentation of a material fact,
17 failed to disclose material information, or submitted false information; and
18 (2) the individual did so with a specific intent to deceive the PTO.” *Id.* at 1327
19 n.3. “A pleading that simply avers the substantive elements of inequitable
20 conduct, without setting forth the particularized factual bases for the allegation,
21 does not satisfy Rule 9(b).” *Id.* at 1326-27.

22 With respect to materiality, “[w]here a patent applicant fails to disclose
23 prior art to the PTO, the prior art is but-for material if the PTO would not have
24 allowed a claim had it been aware of the undisclosed prior art.” *Therasense*, 649
25 F.3d at 1292.

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III. DISCUSSION

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A. Summary of Arguments

Benchmade Knife moves to strike Hogue’s affirmative defense of inequitable conduct. According to Benchmade Knife, “Hogue’s allegations of inequitable conduct, which meander for pages, obfuscate what is missing, and fail to satisfy virtually every requirement of Rule 9(b).”⁹ For the “who” requirement, Benchmade Knife asserts that “Hogue vaguely points to a panoply of actors,” including “Mentor, Benchmade, their employees [including Dave Maxey and Jason Boyd], their patent attorneys, and/or others associated with the filing and prosecution of the patent application for the D’900 Patent,” which Benchmade Knife argues is insufficient.¹⁰ Benchmade Knife also contends that Hogue fails to plead with sufficiency the “what” and “where” requirements—Benchmade Knife asserts that the allegedly withheld prior art information was disclosed to the PTO—and that “Hogue has failed to include a single image of *any* knife in its pleading.”¹¹ Additionally, Benchmade Knife argues that Hogue cannot satisfy the “why” and “how” requirements because the alleged withheld prior art is both immaterial and cumulative to the photos already produced to the PTO.¹² Finally, Benchmade Knife asserts that “Hogue has failed to plead sufficient facts from which an intent to device the Patent Office can be reasonably inferred.”¹³

Hogue responds that it “has pled the ‘who, what, when, where and how’ of Plaintiff’s material omission of the reverse side of the Beshara Orcinas

⁹ See Motion 15:12-14.

¹⁰ See *id.* at 15:16-17:23.

¹¹ See *id.* at 17:24-19:14.

¹² See *id.* at 19:15-21:11.

¹³ See *id.* at 21:12-22:25.

1 knife.”¹⁴ For the “who” requirement, Hogue argues that it specifically alleged
2 that Jason Boyd and Dave Maxey “knew the Beshara Orcinas knife was designed
3 with opposing bevels, and deliberately withheld that information from the PTO
4 with intent to deceive.”¹⁵ Hogue asserts that whether “Messrs. Boyd and
5 Maxey’s supervisory responsibilities and roles in selecting images for the
6 D’900 Patent application” established that they each owed a duty to the PTO is
7 “a question of fact that must be resolved in favor of the non-moving party at the
8 pleading stage.”¹⁶

9 With respect to the “what” and “where” requirements, Hogue cites its
10 allegations that Benchmade Knife’s “use of a cropped and blurry image of the
11 Beshara Orcinas knife design ‘would and did mislead the USPTO during its
12 examination of the patent claim to erroneously conclude that the D’900 Patent’s
13 sole claimed novel feature of opposing bevels on the blade was not anticipated
14 and made obvious by prior art.’”¹⁷ Hogue asserts that those same allegations
15 meet the “why” and “how” requirements as well and that an uncropped and
16 undistorted image of the Beshara Orcinas knife would have been both material
17 and non-cumulative of the prior art submitted to the PTO.¹⁸ Finally, Hogue
18 maintains that the allegations that Benchmade Knife intentionally submitted a
19 cropped and distorted image of the Beshara Orcinas knife creates a plausible
20 inference that Benchmade Knife did so with intent to deceive the PTO.¹⁹

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¹⁴ See Opposition 10:20-11:2.

24 ¹⁵ *Id.* at 11:10-12:2 (citing Answer 9:14-17).

25 ¹⁶ See *id.* at 12:12-13:4 (citing *CertusView Techs, LLC v. S&N Locating Servs.,*
26 *LLC*, 198 F. Supp. 568, 597 (E.D. Va. 2016); *Summit 6 LLC v. Research in Motion*
Corp., 2013 WL 12124321, at *1 (N.D. Tex. June 26, 2013)).

27 ¹⁷ *Id.* at 14:5-14 & 15:8-16:4 (citing Answer 8:17-20 & 9:14-19).

28 ¹⁸ See *id.* at 16:10-17:16.

¹⁹ See *id.* at 18:14-20:15.

1 Benchmade Knife replies that Hogue’s allegations fail to show that Hogue
2 never alleged that Boyd and Maxey “saw the back side of [the Beshara Orcinas]
3 knife, whether in person, as a prototype, or in a photograph.”²⁰ According to
4 Benchmade Knife, “Mr. Beshara’s website has a picture only of the front of that
5 knife” and includes several knives without opposing bevels.²¹

6 **B. Analysis**

7 The Court finds that Hogue sufficiently pleaded its affirmative defense of
8 inequitable conduct. In its Reply, Benchmade Knife no longer disputes that
9 Hogue’s allegations satisfy the “what,” “when,” “where,” “why,” “how,”
10 and intent to deceive requirements.²² Instead, Benchmade Knife focuses its
11 argument on Hogue’s failure to allege that Boyd and Maxey ever saw the back of
12 the Beshara Orcinas knife. Contrary to Benchmade Knife’s assertion, however,
13 Hogue expressly avers that “Mr. Boyd met Mr. Beshara while attending at least
14 one trade show and received from Mr. Beshara a set of wooden mock-ups or
15 prototypes of his” “Opposing Bevel” design.²³ Thus, Hogue has sufficiently
16 alleged the “who” requirement for its inequitable conduct defense.

20 ²⁰ Reply 1:5-6.

21 ²¹ *See id.* at 1:7-14.

22 ²² Regarding Benchmade Knife’s initial disputes, the Court notes that the
23 Federal Circuit has found that “[p]artial disclosure of material information
24 about the prior art to the PTO cannot absolve a patentee of intent if the
disclosure is intentionally selective.” *Am. Calcár, Inc. v. Am. Honda Motor Co.*,
768 F.3d 1185, 1190 (Fed. Cir. 2014).

25 ²³ Answer 7:10-16. Additionally, Beshara’s website—of which both parties
26 agree the Court may take judicial notice—includes a rotating knife with what
27 appears to be the opposing bevel design and a tab titled “BESH WEDGE,”
28 which defines “BESH Wedge” as “a revolutionary knife grind composed of
diagonally opposing bevels converging to create a third cutting edge.” *See*
Motion 5 n.2 (citing
http://www.beshknives.com/gallery_category.php?newCategoryId=68 (last
accessed February 19, 2022)); Opposition 3 n.2.

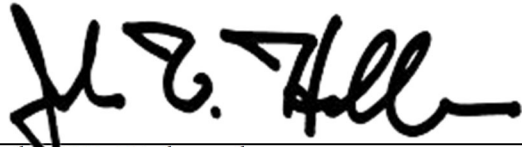
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IV. CONCLUSION

For the foregoing reasons, the Court hereby **DENIES** the Motion.

IT IS SO ORDERED.

Dated: February 22, 2022



John W. Holcomb
UNITED STATES DISTRICT JUDGE