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IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF CALIFORNIA

DUHN OIL TOOL, INC.,)	No. CV-F-05-1411 OWW/GSA
)	
)	MEMORANDUM DECISION GRANTING
Plaintiff,)	IN PART AND DENYING IN PART
)	CAMERON'S MOTION FOR PARTIAL
vs.)	SUMMARY JUDGMENT OF NO
)	INFRINGEMENT (Docs. 445 &
)	446)
COOPER CAMERON CORPORATION,)	
)	
Defendant.)	
)	
)	

Cooper Cameron Corporation ("Cameron") moves for partial summary judgment on the ground that Duhn Oil Tool, Inc. ("Duhn") cannot carry its burden of proof as to the following subset of Duhn's allegations:¹

1. No direct infringement based on use or sales of an allegedly infringing wellhead assembly, for instances that Cameron has proof of noninfringement;
2. No direct infringement based on contributing to or, after April 2, 2009,

¹In seeking partial summary judgment, Cameron does not concede that it has infringed the '925 Patent.

1 inducing infringement; and

2 3. No infringement under the doctrine of
3 equivalents.

4 I. GOVERNING STANDARDS.

5 Summary judgment is proper when it is shown that there
6 exists "no genuine issue as to any material fact and that the
7 moving party is entitled to judgment as a matter of law."
8 Fed.R.Civ.P. 56. A fact is "material" if it is relevant to an
9 element of a claim or a defense, the existence of which may
10 affect the outcome of the suit. *T.W. Elec. Serv., Inc. v.*
11 *Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th
12 Cir.1987). Materiality is determined by the substantive law
13 governing a claim or a defense. *Id.* The evidence and all
14 inferences drawn from it must be construed in the light most
15 favorable to the nonmoving party. *Id.*

16 The initial burden in a motion for summary judgment is on
17 the moving party. The moving party satisfies this initial burden
18 by identifying the parts of the materials on file it believes
19 demonstrate an "absence of evidence to support the non-moving
20 party's case." *Celotex Corp. v. Catrett*, 477 U.S. 317, 325
21 (1986). The burden then shifts to the nonmoving party to defeat
22 summary judgment. *T.W. Elec.*, 809 F.2d at 630. The nonmoving
23 party "may not rely on the mere allegations in the pleadings in
24 order to preclude summary judgment," but must set forth by
25 affidavit or other appropriate evidence "specific facts showing
26 there is a genuine issue for trial." *Id.* The nonmoving party

1 may not simply state that it will discredit the moving party's
2 evidence at trial; it must produce at least some "significant
3 probative evidence tending to support the complaint." *Id.* The
4 question to be resolved is not whether the "evidence unmistakably
5 favors one side or the other, but whether a fair-minded jury
6 could return a verdict for the plaintiff on the evidence
7 presented." *United States ex rel. Anderson v. N. Telecom, Inc.*,
8 52 F.3d 810, 815 (9th Cir.1995). This requires more than the
9 "mere existence of a scintilla of evidence in support of the
10 plaintiff's position"; there must be "evidence on which the jury
11 could reasonably find for the plaintiff." *Id.* The more
12 implausible the claim or defense asserted by the nonmoving party,
13 the more persuasive its evidence must be to avoid summary
14 judgment." *Id.* In *Scott v. Harris*, ___ U.S. ___, 127 S.Ct.
15 1769, 1776 (2007), the Supreme Court held:

16 When opposing parties tell different stories,
17 one of which is blatantly contradicted by the
18 record, so that no reasonable jury could
19 believe it, a court should not adopt that
20 version of the facts for purposes of ruling
21 on a motion for summary judgment.

22 As explained in *Nissan Fire & Marine Ins. Co. v. Fritz Companies*,
23 210 F.3d 1099 (9th Cir.2000):

24 The vocabulary used for discussing summary
25 judgments is somewhat abstract. Because
26 either a plaintiff or a defendant can move
27 for summary judgment, we customarily refer to
28 the moving and nonmoving party rather than to
29 plaintiff and defendant. Further, because
30 either plaintiff or defendant can have the
31 ultimate burden of persuasion at trial, we
32 refer to the party with and without the
33 ultimate burden of persuasion at trial rather

1 than to plaintiff and defendant. Finally, we
2 distinguish among the initial burden of
3 production and two kinds of ultimate burdens
4 of persuasion: The initial burden of
5 production refers to the burden of producing
6 evidence, or showing the absence of evidence,
7 on the motion for summary judgment; the
8 ultimate burden of persuasion can refer
9 either to the burden of persuasion on the
10 motion or to the burden of persuasion at
11 trial.

12 A moving party without the ultimate burden of
13 persuasion at trial - usually, but not
14 always, a defendant - has both the initial
15 burden of production and the ultimate burden
16 of persuasion on a motion for summary
17 judgment ... In order to carry its burden of
18 production, the moving party must either
19 produce evidence negating an essential
20 element of the nonmoving party's claim or
21 defense or show that the nonmoving party does
22 not have enough evidence of an essential
23 element to carry its ultimate burden of
24 persuasion at trial ... In order to carry its
25 ultimate burden of persuasion on the motion,
26 the moving party must persuade the court that
there is no genuine issue of material fact
....

16 If a moving party fails to carry its initial
17 burden of production, the nonmoving party has
18 no obligation to produce anything, even if
19 the nonmoving party would have the ultimate
20 burden of persuasion at trial ... In such a
21 case, the nonmoving party may defeat the
22 motion for summary judgment without producing
23 anything ... If, however, a moving party
24 carries its burden of production, the
25 nonmoving party must produce evidence to
26 support its claim or defense ... If the
nonmoving party fails to produce enough
evidence to create a genuine issue of
material fact, the moving party wins the
motion for summary judgment ... But if the
nonmoving party produces enough evidence to
create a genuine issue of material fact, the
nonmoving party defeats the motion.

210 F.3d at 1102-1103.

1 II. DUHN'S OBJECTIONS TO DECLARATION OF ROSS TOBIN.

2 Exhibit B to Cameron's motion is the Declaration of Ross
3 Tobin dated September 10, 2010. Although a copy of this
4 declaration is included with Cameron's courtesy copies, it is not
5 included in Doc. 446 and is, therefore, not yet part of the
6 record.

7 Mr. Tobin avers that he is currently an Account Manager III
8 for Cameron and that he had previously been District Manager at
9 the Cameron facility located at 2326 I-70 Frontage Road, Grand
10 Junction, Colorado.

11 In Paragraph 4 of his declaration, Mr. Tobin avers:

12 4. It was my responsibility to supervise and
13 coordinate the installation of Cameron's frac
14 mandrels at my facility. At least since
15 August 21, 2008, Cameron personnel, whether
16 in the field or at the Grand Junction
17 facility, have not placed the tubing-head
18 lockscrew in a configuration such that the
19 lockscrew would be in contact with the frac
20 mandrel. Cameron only offers and installs it
21 [sic] frac mandrels in a configuration where
the tubing head lockscrews do not contact the
frac mandrel. Since February 2009, when the
Installation Checklist procedure was
instituted, Cameron installed more than 841
frac mandrels with the lockscrews not in
contact with the frac mandrel. No customer
has complained or criticized Cameron's new
installation procedure.

22 Duhn objects to Paragraph 4 of Mr. Tobin's Declaration on
23 the grounds of lack of foundation and/or personal knowledge.

24 Duhn contends:

25 Mr. Tobin fully relied on spreadsheets
26 prepared by Cameron's counsel and took no
steps to verify that the information
contained therein was accurate.

1 Duhn refers to Mr. Tobin's deposition testimony at 28:14-20 and
2 31:2-11, attached as Exhibit 5 to Mr. Kolegraff's declaration
3 (Doc. 484). Mr. Tobin's deposition testimony makes clear that he
4 was referring to frac mandrels maintained at Vernal or Longview,
5 Texas, not Grand Junction, Colorado.

6 Duhn further objects to Paragraph 4 on the ground that Mr.
7 Tobin never saw "these" spreadsheets until October 27, 2010, the
8 day before his deposition and six weeks after he signed his
9 declaration:

10 Mr. Tobin's position has moved from Grand
11 Junction to Denver, so he does not even have
12 access to the underlying checklists, and is
13 no longer responsible for day to day
14 activities in Grand Junction ... Instead of
15 having any personal knowledge, Mr. Tobin has
16 placed complete and unwavering trust that
17 Cameron's installers and field workers are
18 following Cameron's procedures ... Mr. Tobin
19 states that Cameron has installed more than
20 841 frac mandrels with the lockscrews not in
21 contact with the frac mandrel. He has no
22 personal knowledge to support this statement
23 ... The number '841' was provided by his
24 counsel, and came from a spreadsheet Mr.
25 Tobin never saw until weeks after signing the
26 declaration.

19 In Paragraph 7 of his declaration, Mr. Tobin avers:

20 7. To date, at least 685 frac mandrels have
21 been received and documented under the
22 return-checklist procedure. The Return
23 Checklists of at least 615 mandrels indicate
24 the absence of dimples, thus, establishing
25 that each given frac mandrel was not placed
26 in the allegedly infringing 'dual load path'
configuration. It establishes at least 615
instances of noninfringement.

25 Duhn objects to Paragraph 7 for lack of foundation and/or
26 personal knowledge as stated in connection with Paragraph 4. See

1 *supra.*

2 In Paragraph 8 of his declaration, Mr. Tobin avers:

3 8. To date, Cameron has documented the
4 lifecycle of at least 535 mandrels. That is,
5 Cameron has in Installation and Return
6 checklist for at least 535 mandrels, each
7 such Installation Checklist indicating that
8 given mandrel was installed with the
9 lockscrews not run in and had no dimples on
10 it and each Return Checklist indicating the
11 condition of that mandrel when it returned.
12 Of those 535 lifecycles, these checklists
13 indicate that at least 523 mandrels left
14 Cameron's facility without dimples and
15 returned to Cameron's facility in the same
16 condition. Thus, these checklists evidence
17 at least 523 wells at which a Cameron mandrel
18 was used in a confirmed-as-noninfringing
19 manner.

20 Duhn objects to Paragraph 8 for lack of foundation and/or
21 personal knowledge as stated in connection with Paragraph 4. See
22 *supra.*

23 Cameron replies that Duhn's objections to Mr. Tobin's
24 declaration should be disregarded:

25 Mr. Tobin made it clear throughout his
26 deposition that he had been working with
Cameron's frac mandrel checklists
continuously over the past two years as the
District Manager of Cameron's Grand Junction,
Colorado facility, and worked with the
underlying spreadsheet in which information
from each of the checklists is recorded on a
monthly basis ... Duhn takes the quotes from
Mr. Tobin's testimony regarding the
particular charts generated from the
spreadsheets, and the particular compilations
of the checklists, which were prepared by
Cameron's counsel after the filing of the
Motion, and mischaracterizes the testimony to
assert that Mr. Tobin had not seen the
checklists he referred to in his Declaration
until after he signed the Declaration.

1 Mr. Tobin has not laid the foundation to admit this
2 information as a business record under Rule 803(6), Federal Rules
3 of Evidence. Cameron's response changes nothing. If Cameron is
4 presenting a compilation, summary, or abstract of business
5 records, it must lay the proper foundation. Duhn's objections to
6 Mr. Tobin's declaration are sustained.

7 III. STATEMENTS OF UNDISPUTED FACTS.

8 A. CAMERON.

9 1. U.S. Patent No. 6,920,925 ("the '925 Patent").

10 CUDF 1: The '925 patent, entitled Wellhead Isolation Tool,
11 was issued on July 26, 2005, listing only Rex Duhn and Robert
12 Meek as inventors.

13 *Duhn's Response:* UNDISPUTED.

14 CUDF 2: The asserted claims of the '925 patent contain the
15 following limitations: "a production tubular member" and "wherein
16 an axial force acts on the generally elongate annular member and
17 is reacted in both the first tubular member flange and the
18 secondary flange". Additionally, claim 1, and the claims based
19 thereon, of the '925 patent contains the limitation: "a casing."

20 *Supporting Evidence:* Ex. A.1 (the '925 Patent) at col. 13, lines
21 42-62; col. 24, lines 26-56.

22 *Duhn's Response:* UNDISPUTED that the claims
23 contain the language quoted, but DISPUTED because the meaning of
24 a patent claim limitation is a question of law for the Court, see
25 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-971
26 (Fed.Cir.1995). Duhn objects that Cameron is attempting to read

1 a claim limitation outside of its context by inappropriately
2 parsing limitation language, contending that the claim must be
3 read as a whole.

4 CUDF 3: Claims 13, 14, 31, and 86 contain limitations
5 requiring "lock screws." *Supporting Evidence*: Ex. A.1 (the '925
6 Patent) at col. 14, lines 42-67; col. 17, lines 8-25; col. 24,
7 lines 26-56.

8 *Duhn's Response*: UNDISPUTED that the claims
9 contain the language quoted, but DISPUTED because the meaning of
10 a patent claim limitation is a question of law for the Court, see
11 *Markman, supra*. Duhn objects that Cameron is attempting to read
12 a claim limitation outside of its context by inappropriately
13 parsing limitation language, contending that the claim must be
14 read as a whole.

15 CUDF 4: A "casing" is a "pipe extending from the surface of
16 the well down into the ground ... to the oil reservoir many
17 thousands of feet below ground." *Supporting Evidence*: Ex. A.2,
18 Expert Report of Boyadjieff, p. 4.

19 *Duhn's Response*: UNDISPUTED that a casing is a
20 pipe extending from the surface into the ground, but DISPUTED
21 that a casing necessarily must reach the oil reservoir many
22 thousands of feet below ground and DISPUTED that the meaning of a
23 patent claim term is a question of law, citing *Markman, supra*.

24 CUDF 5: A "production tubular member" is "the inner round
25 pipe extending from the surface down to the oil or gas
26 reservoir." *Supporting Evidence*: Ex. A.2, Expert Report of

1 Boyadjieff, p. 5.

2 *Duhn's Response:* Duhn does not dispute this
3 construction but clarifies that a production tubular member may
4 be the inner-most casing for a well.

5 CUDF 6: The claimed wellhead assembly "of the '925 patent
6 does not include every element of those claims until it is fully
7 assembled at the location of the well." *Supporting Evidence:*
8 Ex. A.11, Declaration of Robert Meek, ¶ 2.

9 *Duhn's Response:* Duhn objects as vague the phrase
10 "fully assembled." DISPUTED: The wellhead assembly is complete
11 when each limitation of the claims has been met. There is no
12 requirement that the wellhead assembly include anything more than
13 the claimed limitations or that it be in a specific location. As
14 defined by the *Markman* ruling, there is no requirement that the
15 wellhead assembly be in use for a finding of infringement.

16 CUDF 7: During prosecution of the application for the '925
17 patent, then-pending claim 90 was a dependent claim based on
18 then-pending independent claim 72. The USPTO rejected then-
19 pending claim 72 but indicated that then pending claim 90 would
20 be allowable if rewritten into independent form. Duhn Oil amended
21 then-pending claim 72 to include "a plurality of lock-screws,"
22 and rewrote then-pending claim 90 into independent form.
23 *Supporting Evidence:* Ex. A.3, Duhn Oil's February 2005 Response
24 to Office Action, p. 23, 30 and 33.

25 *Duhn's Response:* Duhn objects to CUDF 7 as
26 incomplete: The applicants amended original claim 72 by adding

1 "and a plurality of lockscrews each radially threaded through one
2 of said first flange and second flange and engaging the generally
3 elongate, annular member, wherein the other of said first flange
4 and second flange is threaded on the generally elongate annular
5 member, wherein the second flange is fastened to the first
6 flange, and wherein the second flange is separate from the
7 generally elongate member." Otherwise UNDISPUTED.

8 2. The Accused Products.

9 CUDF 8: 8. Cameron has never sold or offered for sale
10 underground pipes, such as the casing or production tubular
11 member recited in the claims of the '925 patent. *Supporting*
12 *Evidence:* Ex. B, Tobin Declaration, ¶ 10.

13 *Duhn's Response:* DISPUTED to the extent Cameron
14 purports to construe the meaning of the terms of the '925 Patent;
15 otherwise UNDISPUTED.

16 3. No Infringement if Lockscrews Are Not Run-In.

17 CUDF 9: The Court determined that if the lockscrews are not
18 in contact with the frac mandrel, then there is no "dual load
19 path" as required by the "wherein" clause and, thus, no
20 infringement. *Supporting Evidence:* Transcript of Hearing on
21 January 6, 2009 (Doc. 287) at 183:20-184:13.

22 *Duhn's Response:* DISPUTED. The Court only
23 indicated that it would make a ruling regarding what was "not
24 within the call of the patent."

25 CUDF 10: If a Cameron frac mandrel is installed such that
26 the lockscrews are not in contact with the mandrel, there is no

1 infringement.

2 *Duhn's Response:* DISPUTED. Duhn contends that if
3 a Cameron frac mandrel is installed in such a way that the
4 lockscrews cannot be in contact with the mandrel, there is no
5 infringement, referring to Duhn's proposed Order (Doc. 476-1 at
6 2), with respect to which the Court has not ruled.

7 CUDF 11: During Mr. Rex Duhn's deposition on September 19,
8 2007, the following exchange took place:

9 Q [Cameron's Counsel]: So it is your opinion
10 that when a lock screw is screwed down to
11 engage the mandrel, that there will be no
12 load transfer unless there is a depression in
13 the frac mandrel?

14 A [Mr. Duhn]: Yes.

15 Q: And why is that?

16 A: You would have to have a contact shoulder
17 for lock pin to engage.

18 Q: So, in this configuration shown, are you
19 saying that's effectively the same as if the
20 [lockscrews] were removed, pin 58?

21 O [Duhn Oil's Counsel]: Objection, vague.

22 A [Mr. Duhn]: There's no place for it to
23 react the force.

24 Q [Cameron's Counsel]: No place for 58—

25 A: To react the force on the elongate
26 mandrel.

 Q: What if the pin 58 is screwed in real
tight, is your answer the same?

 A: It would be insufficient friction
coefficient to maintain the mandrel.

 Q: That's because there's no correspondent
depression on the frac mandrel for pin 58 to

1 engage?

2 A: Correct, you would have no shear point.

3 *Supporting Evidence:* Ex. A.8, Duhn Depo., dated Sept. 19, 2007,
4 at 39:14-40:12.

5 *Duhn's Response:* UNDISPUTED that the quoted
6 exchange occurred during Mr. Duhn's deposition with regard to
7 Claim 13. *Objection:* FRE 802.

8 CUDF 12: Mr. George Boyadjieff believes that any contact
9 between the lockscrews and the frac mandrel would be sufficient
10 to transfer loads in accordance with the "wherein" clause.

11 *Supporting Evidence:* Ex. A.9, First Supp. Boyadjieff Report, p.
12 3.

13 *Duhn's Response:* UNDISPUTED.

14 CUDF 13: On August 21, 2008, Cameron issued an engineering
15 bulletin to its field locations reminding Cameron personnel that
16 the lockscrews should not be run-in and should not contact the
17 frac mandrel. *Supporting Evidence:* Ex. B to Docket No. 255.

18 *Duhn's Response:* UNDISPUTED that Cameron sent out
19 an engineering bulletin to at least some Cameron installers;
20 otherwise DISPUTED: It is unclear if the bulletin went to all
21 "field locations" and whether the installers had previously been
22 informed not to tighten the lockscrews.

23 CUDF 14: The vast majority of Cameron's surface U.S. frac
24 mandrel installations are coordinated out of Cameron's Grand
25 Junction, Colorado facility. *Supporting Evidence:* Ex. B, Tobin
26 Declaration, ¶ 4.

1 *Duhn's Response:* Objection on the ground that the
2 cited evidence does not support the fact. [OWW - I agree;
3 paragraph 4 of Mr. Tobin's declaration quoted above does not
4 support this fact] and on the ground of vagueness as it is
5 unclear what "vast majority" means. **DISPUTED:** Cameron maintains
6 at least two other facilities that store and install frac
7 mandrels, i.e., Longview, Texas and Vernal, Utah. For the Encana
8 installations that are done by Cameron, the installations are all
9 done from Cameron's facility in Vernal, Utah.

10 4. Installation Checklists.

11 CUDF 15: In February 2009, Cameron began documenting the
12 installation of its frac mandrels at its Grand Junction facility.

13 *Duhn's Response:* UNDISPUTED.

14 CUDF 16: The below pictures are accurate representations of
15 the type of marking plate Cameron places on the hold-down flange
16 of its frac mandrels: [OWW - I could not copy the picture but it
17 is in Cameron's statement of undisputed facts]. *Supporting*
18 *Evidence:* Ex. B, Tobin Decl., ¶ 3.

19 *Duhn's Response:* DISPUTED. Cameron has not placed
20 marking plates on all its frac mandrels and has no defined plan
21 to get marking plates installed on all Encana-owned frac
22 mandrels.

23 CUDF 17: Cameron's marking plates conspicuously instruct
24 "DO NOT RUN IT TUBING HEAD LOCKSCREWS TO CONTACT FRAC MANDREL.
25 THIS HOLD-DOWN FLANGE FIRMLY SECURES THE FRAC MANDREL DURING FRAC
26 OP".

1 *Duhn's Response*: UNDISPUTED as to correct
2 quotation of plate text. DISPUTED on ground that not all
3 mandrels have been so marked and Cameron has presented no
4 evidence that the plates are conspicuously placed considering the
5 dirty, hostile and dangerous well site environment.

6 CUDF 18: Additionally, Cameron delivered its updated
7 installation procedures—which expressly state that the lockscrews
8 should not contact the frac mandrel—to its customers, and to
9 third parties that may come in contact with Cameron's mandrels.

10 *Supporting Evidence*: Ex. B, Tobin Decl. at ¶¶ 11-19.

11 *Duhn's Response*: DISPUTED as to whether all
12 customers, all third parties, and all operating companies that
13 may come in contact with the Cameron frac mandrel.

14 CUDF 19: Cameron has received from the field managers of its
15 customers Orion, Williams, Barrett, Anadarko and Bass, signed
16 acknowledgments indicating that his or her respective company has
17 received Cameron's revised installation procedures. *Supporting*
18 *Evidence*: Ex. B, Tobin Decl. at ¶¶ 11-19.

19 *Duhn's Response*: UNDISPUTED that Cameron has
20 received signed acknowledgements from customers Orion, Williams,
21 Barrett, Anadarko and Bass; DISPUTED to the extent the
22 acknowledgements do not identify the person signing as a "field
23 manager."

24 5. Cameron's Confirmed Non-Infringing Frac
25 Mandrel is "Substantial".

26 CUDF 20: Cameron's checklists indicate that Cameron has

1 installed at least 841 mandrels with the lockscrews not run in
2 and, as such, not in contact with the mandrel. *Supporting*
3 *Evidence*: Ex. B, Tobin Decl. ¶ 4.

4 *Duhn's Response*: Objection to foundation. See
5 *discussion supra*. DISPUTED. The evidence demonstrates that the
6 checklists that purportedly underlie this calculation are
7 unreliable. Cameron's own checklists show that Cameron has had
8 to buff out over 1000 dimples from its frac mandrels from
9 September 2009 to April 2010.

10 CUDF 21: Cameron's checklists indicate that at least 615
11 mandrels have returned to Cameron's facilities without dimples.
12 *Supporting Evidence*: Ex. B, Tobin Decl. ¶¶ 7-8.

13 *Duhn's Response*: Objection to foundation. See
14 *discussion supra*. DISPUTED for same reasons as CUDF 20.

15 CUDF 22: Cameron has an Installation Checklist and a Return
16 Checklist for at least 535 mandrels. *Supporting Evidence*: Ex. B,
17 Tobin Decl. ¶¶ 7-8.

18 *Duhn's Response*: Objection as irrelevant,
19 misleading and lacking foundation. See *discussion supra*.
20 DISPUTED because Cameron's pairing of Installation Checklists and
21 Return Checklists did not start until at least June 11, 2009 and
22 does not cover all of the infringing installations.

23 CUDF 23: Cameron's checklists indicate that of the at least
24 535 mandrels for which Cameron has both an Installation and a
25 Return Checklist, at least 523 mandrels were returned without
26 dimples. *Supporting Evidence*: Ex. B, Tobin Decl. ¶¶ 7-8.

1 *Duhn's Response: same as to CUDF 22 supra.*

2 In Cameron's reply brief in reply to Duhn's evidentiary
3 objections to CUDF 20-23, Cameron attaches as Exhibits A, B and C
4 the Declaration of Joe Norris, District Manager for Cameron's
5 Grand Junction, Colorado district office:

6 I am the person in charge of maintaining
7 Cameron's frac mandrel checklists for the
8 Grand Junction office. The following
9 checklists are records of Cameron's returns,
10 buffing, and installations of frac mandrels
11 in the Grand Junction office. These
12 checklists were made at or near the time of
13 these events, by (or from information
14 transmitted by) a person with knowledge of
15 these events. These checklists were kept in
16 the course of Cameron's regularly conducted
17 business activities. It has been the regular
18 practice of Cameron to make these checklists
19 since Cameron began its checklists
20 procedures.

21 6. Duhn Oil's Lockscrews.

22 CUDF 24: There are only so many horizontal penetrations a
23 flange can have, and the space necessary for the vertical bolts
24 extending through this flange defines the maximum limit. It is
25 impossible to have an "infinite number of lockscrews" within a
26 flange. *Supporting Evidence: Ex. A.7, Devlin Declaration at ¶ 4.*

*Duhn's Response: UNDISPUTED as to there being
only so many horizontal penetrations and that it is not possible
to have an infinite number of lockscrews; DISPUTED as to the
cause for the limitation.*

 B. DUHN'S STATEMENT OF ADDITIONAL MATERIAL FACTS.

 1. Cameron's Direct Infringement of the '925
Patent.

1 DUDF 25: When a customer purchases or rents a Cameron frac
2 mandrel, Cameron installs the frac mandrel in the tubing head at
3 its facility. *Supporting Evidence:* Kolegraff Decl., Ex. 7, Tobin
4 4/9/10 depo. at 23:19-24; Ex. 6, Tobin 9/8/09 depo. at 12:5-15.

5 DUDF 26: At the well site in the field, Cameron assembles
6 the wellhead assembly, including the frac mandrel in the tubing
7 head. This assembly includes attaching to "a casing" and
8 aligning "a production tubular member." *Supporting Evidence:* Ex.
9 7, Tobin Depo. at 24:1-25:9, 25:24-26:3; Ex. 6, Tobin Depo. at
10 12:6-17.

11 DUDF 27: In addition to assembling the wellhead, Cameron
12 performs testing of the wellhead assembly. *Supporting Evidence:*
13 Ex. 7, Tobin Depo. at 25:4-9; Ex. 6, Tobin Depo. at 43:18-44:4;
14 Ex. 1, Devlin 1/8/08 Depo. at 49:7-50:14.

15 DUDF 28: Cameron has assembled a wellhead that is within the
16 scope of claim 2 of the '925 Patent. *Supporting Evidence:* Ex. 1,
17 Devlin Depo. 15:16-21, 25:13-19, 27:14-17, 30:15-18, 31:22-24,
18 32:16-21, 33:5-11, 33:12-17, 20:15-18, 40:20-24, 41:14-24; Ex.
19 1a, Devlin Depo, Exh. 16; Ex. 8 Boyadjieff Report, 4-5; Ex. 9
20 Boyadjieff Supp. Report, 3.

21 2. Cameron's Indirect Infringement of '925 Patent.

22 DUDF 29: Cameron's frac mandrels have been used in an
23 infringing manner after April 2, 2009. *Supporting Evidence:* Ex.
24 6, Tobin Depo., 50:13-51:15, 68:9-69:23; Ex. 6a, Tobin Depo., Ex.
25 15; Ex. 6b, Tobin Depo. Ex. 17.; Ex. 4 and table summarizing
26 buffing checklists at Kolegraff Decl. ¶ 6.

1 DUDF 30: Cameron did not install placards of all of its frac
2 mandrels by April 2, 2009. *Supporting Evidence:* Ex. 6, Tobin
3 Depo. at 15:5-14, 15:18-25.

4 DUDF 31: Cameron did not instruct its employees to install
5 the frac mandrel without engaging the lockscrews - Cameron's
6 purported non-infringing use - until some time in 2008.
7 *Supporting Evidence:* Ex. 5, Tobin Depo. at 14:4-15:12.

8 3. Prosecution of the '925 Patent.

9 DUDF 32: The '925 Patent matured from Application Number
10 10/369,070 filed on February 19, 2003. *Supporting Evidence:* Ex.
11 18.

12 DUDF 33: Claim 86 of the '925 Patent was first submitted to
13 the Patent Office on November 15, 2004 as claim 90, which
14 depended upon claim 72. *Supporting Evidence:* Ex. 13, 11/15/04
15 Amendment at 34, 41.

16 DUDF 34: In a January 10, 2005, Final Office Action, the
17 Examiner allowed claim 90 as submitted. *Supporting Evidence:* Ex.
18 14, 1/10/05 Final Office Action at 4.

19 DUDF 35: In a January 10, 2005 Final Office Action, the
20 Examiner rejected claim 72 as anticipated. *Supporting Evidence:*
21 Ex. 14, 1/10/05 Final Office Action at 2.

22 DUDF 36: In an Amendment After Final submitted on February
23 22, 2005, the applicants amended then claim 90 to include the
24 limitations of base claim 72 - converting claim 90 from a
25 dependent to an independent claim. The applicants did not change
26 the scope of claim 90. *Supporting Evidence:* Ex. 15, Amendment

1 After Final at 30, 33.

2 DUDF 37: In the February 22, 2005 Amendment After Final, the
3 applicants amended claim 72, adding a limitation. *Supporting*
4 *Evidence*: Ex. 15, Amendment After Final at 23, 33.

5 DUDF 38: On March 30, 2005, the Examiner issued a Notice of
6 Allowability, allowing, *inter alia*, claims 72 and 90 as submitted
7 in the February 22, 2005 Amendment After Final. *Supporting*
8 *Evidence*: Ex. 16, Notice of Allowability.

9 DUDF 39: The '925 Patent issued on July 26, 2005 with
10 original claim 90 issuing as claim 86 and original claim 72
11 issuing as claim 77. *Supporting Evidence*: Ex. 17; Ex. 18, Issue
12 Classification.

13 4. The Accused Device's "Lock Collar".

14 DUDF 40: The "lock collar" of Cameron's accused devices
15 transfers a portion of the axial load from the elongate annular
16 member to the secondary flange. *Supporting Evidence*: Ex. 8,
17 Boyadjieff Depo. at 141:2-25, 144:7-16; Cameron brief (Doc. 447)
18 at 24.

19 IV. NO DIRECT INFRINGEMENT BASED ON SALES, OFFERS FOR SALE,
20 OR USE.

21 Cameron moves for partial summary judgment on the ground
22 that Duhn cannot support its allegations of patent infringement
23 pursuant to 35 U.S.C. § 271(a) based on use, sales, or offers for
24 sale of allegedly infringing wellhead assemblies.² Cameron

25 ²35 U.S.C. § 271(a) provides:
26

1 asserts that the acts underlying each category of patent
2 infringement are different:

3 For example, if a supplier sells an
4 infringing widget to a customer, the supplier
5 is liable for infringement based on that
6 sale. However, the customer is not liable
7 for infringement, because there is no
8 purchased-based infringement. If the
9 customer then exports the infringing widget
10 overseas, he again would not be liable for
11 infringement. There is no export-based
12 infringement. The customer obviously cannot
13 be accused of infringement based on
14 manufacturing the widget, he did not make it,
15 he just bought it. However, if the customer
16 were to use the widget, he would be liable
17 based on that use. Thus, the supplier is
18 only liable to the patentee for an infringing
19 sale, while the customer is only liable to
20 the patentee for an infringing use. Who the
21 accused infringer is depends on which
22 category of infringement the patentee
23 asserts.

24 "Literal infringement of a claim exists when every
25 limitation recited in the claim is found in the accused device,
26 i.e., when the properly constructed claim reads on the accused
device exactly." *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532
(Fed.Cir.1996), cert. denied, 522 U.S. 812 (1997). "[A]ny
deviation from the claim precludes a finding of literal

21 Except as otherwise provided in this title,
22 whoever without authority makes, uses, offers
23 to sell, or sells any patented invention,
24 within the United States, or imports into the
25 United States any patented invention during
26 the term of the patent therefor, infringes the
patent.

27 Duhn conceded at the hearing that Cameron does not sell or offer to
28 sell the "casing" or "production tubular member" and that Cameron
29 is entitled to partial summary judgment on this ground.

1 infringement." *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d
2 1449, 1454 (Fed.Cir.1998). See also *London v. Carson Pirie Scott*
3 *& Co.*, 946 F.2d 1534, 1539 (Fed.Cir.1991): "There can be no
4 infringement as a matter of law if a claim limitation is totally
5 missing from the accused device." Relying on these principles,
6 Cameron contends:

7 Thus, if an accused infringer can show that
8 he 'used' a device lacking a component
9 corresponding to a claim limitation, he is
10 not liable for infringement based on that
11 use. Similarly, if an accused infringer can
12 show he sold a device lacking a component
13 corresponding to a claim limitation, he is
14 not liable for infringement based on that
15 sale.

16 Cameron contends that it does not use a wellhead assembly
17 with a "casing" or a "production tubular member," which are
18 required limitations of all of Duhn's asserted patent claims.
19 Cameron asserts that each of the patent claims describe a
20 "wellhead assembly" and includes the limitation "a production
21 tubular member." Claim 1 and the claims based thereon further
22 include the limitation "a casing." Cameron refers to the expert
23 report of Mr. Boyadjieff, one of Duhn's designated expert
24 witnesses, that "a casing" is a "pipe extending from the surface
25 of the well down into the ground ... to the oil reservoir many
26 thousands of feet below ground" and that a "'production tubular
27 member' is the inner round pipe extending from the surface down
28 to the oil or gas reservoir." Cameron contends that both of
29 these claim components are fixed in the ground and located at the
30 well site. Cameron refers to testimony of Mr. Meek, a named

1 inventor as well as a Duhn expert, that the claimed wellhead
2 assembly "of the '925 patent does not include every element of
3 those claims until it is fully assembled at the location of the
4 well."

5 Cameron moves for partial summary judgment on the ground
6 that it does not "use" an allegedly infringing wellhead assembly.
7 Asserting that "[t]his Court noted that infringing use
8 of a frac mandrel in a wellhead assembly requires employment in
9 the purpose from which the wellhead assembly's frac mandrel is
10 sold and intended," and to Duhn's assertion that "use"
11 encompasses testing and installation, Cameron refers to the
12 Court's statement at a hearing on January 25, 2010:

13 THE COURT: How is that a use? I understand,
14 and I think as Mr. Rogers stated it, a frac
15 mandrel is used by actually employing it to
16 carry out its designed function, which is to
17 dissipate force when the frac'ing of the well
18 is going on. And so I don't understand
19 testing or installation to be use in that
20 sense. In other words, I think the use of a
21 frac mandrel that is alleged to be infringed
22 would be employing the frac mandrel for the
23 purpose for which it's sold and intended.

24 (Doc. 408, 10:2-9).

25 Duhn responds that there is evidence that when a customer
26 purchases or rents a Cameron frac mandrel, Cameron installs the
27 frac mandrel in the tubing head at its facility; then Cameron
28 goes to the well site and assembles the wellhead assembly,
29 including the frac mandrel in the tubing head, which assembly
30 includes attaching to "a casing" and aligning "a production
31 tubular member"; and that Cameron performs testing of the

1 completed assembly.

2 Duhn asserts that these activities, performed on the entire
3 structure, constitute "use" of the '925 Patent, relying on the
4 following cases.

5 In *Waymark Corp. v. Porta Systems Corp.*, 245 F.3d 1364,
6 1367-1368 (Fed.Cir.2001), the Federal Circuit noted:

7 This court has established that testing is a
8 use of the invention that may infringe under
9 § 271(a) ... Nevertheless, the infringer must
10 use the 'patented invention.'

11 *Paper Converting Machine Co. v. Magna-Graphics Corp.*, 745 F.2d
12 11, 19-20 (Fed.Cir.1984), held:

13 Where, as here, significant, unpatented
14 assemblies of elements are tested during the
15 patent term, enabling the infringer to
16 deliver the patented combination in parts to
17 the buyer, without testing the entire
18 combination together as was the infringer's
19 usual practice, testing the assemblies can be
20 held to be in essence testing the patented
21 combination and, hence, infringement.

22 See also *General Electric Co. v. Sonosite, Inc.*, 568 F.Supp.2d
23 983, 992 (W.D.Wis.2008) ("Testing is a 'use' of an invention that
24 may infringe."); *McKesson Information Solutions, Inc. v. Bridge
25 Medical, Inc.*, 2005 WL 2346919 at * 5 (E.D.Cal., Sept. 23,
26 2005) ("'Using' requires use of the complete invention, and
encompasses 'assembly' and 'testing' of that invention."). As
Duhn notes, Cameron cites no case authority that testing and
assembly may constitute "use," relying instead upon spontaneous
comments from the Court responding to an issue that had not been
briefed by the parties.

1 Cameron replies that the testing of seals to which Duhn
2 refers is part of the alleged "making," not "use":

3 Duhn Oil refers to the installation of
4 Cameron's tubing head at the well site, and
5 testing of seals ... This is a part of Duhn
6 Oil's 'making' allegations. To the extent
7 there is ever any testing of seals by Cameron
8 at the well site, any such testing would be
9 done to confirm that the assembly is complete
(which would fall under the category of
'making'), and therefore would not be a 'use'
of the wellhead assembly for the purpose set
forth in the '925 patent, which is fracing.
Cameron is not a fracing company.

10 Cameron's customers and the fracing companies
11 that they hire are the only persons that
12 'use' Cameron's accused products. To the
13 extent that Cameron may be accused of
14 infringement for any such 'use,' those claims
15 would be limited to indirect infringement,
which would be a claim that Cameron allegedly
induced or contributed to the direct
infringement of the user. Duhn Oil's claims
of direct infringement against Cameron for
alleged 'use' should be disposed of as a
matter of law.

16 Cameron requests that the Court finds as a matter of law that
17 Duhn's direct infringement claims to be presented at trial be
18 limited to making.

19 Cameron's motion for partial summary judgment on this ground
20 is DENIED; case authority supports Duhn's position that testing
21 and assembly in the field can constitute use for purposes of
22 direct infringement.

23 Cameron further seeks partial summary judgment of no
24 infringement for instances where Cameron can prove that its frac
25 mandrel was used in a noninfringing manner:

26 Duhn Oil cannot satisfy its burden by

1 alleging that infringement occurred in one
2 instance and then assume infringement
3 occurred in every instance. Duhn Oil must
4 prove the totality of its allegations with a
5 preponderance of evidence. Duhn Oil cannot
6 meet its burden. In contrast, Cameron's
7 checklist procedure proves that Cameron's
8 mandrels were used hundreds of times in a
9 nonfringing manner.

10 Cameron cites *L & W, Inc. v. Shertech, Inc.*, 471 F.3d 1311, 1318
11 (Fed.Cir.2006) :

12 Shertech [the patentee] cannot simply
13 'assume' that all of L & W's products are
14 like the one Dr. Holmes tested and thereby
15 shift the burden to L & W to show that is not
16 the case. When a patentee with the burden of
17 proof seeks summary judgment of infringement,
18 it must make a prima facie showing of
19 infringement as to each accused device before
20 the burden shifts to the accused infringer to
21 offer contrary evidence.

22 Relying on *L & W, Inc.*, Cameron asserts that "the Federal Circuit
23 has repeatedly rejected a patentee's attempt to establish
24 infringement against an entire category of products by presenting
25 evidence relating to only a subset of that category." Cameron
26 contends:

Duhn Oil cannot assert that *all* of Cameron's
mandrels are used in an allegedly infringing
manner by asserting, or even proving, that
some of Cameron's mandrels were used that
way. Cameron should not have to pay damages
for instances where Duhn Oil cannot prove
with a preponderance of evidence that
infringement occurred.

Cameron refers to evidence of allegedly non-infringing use when
the lockscrews are not run in and asserts that it can prove
hundreds of instances pursuant to its checklist procedure,
commenced in early 2009.

1 Cameron further argues that Duhn's purported evidence of
2 infringement does not "outweigh" Cameron's evidence of
3 noninfringement. Essentially, Cameron argues that Duhn's
4 evidence that the frac mandrel will not work if the lockscrews
5 are not run in is not credible:

6 Duhn Oil contends that Cameron's frac mandrel
7 will not work with the lockscrews not run in
8 because they will 'dance.' Mr. Boyadjieff,
9 Duhn Oil's expert, stated that '[c]ustomers
10 needed to use the lock screws in the tubing
11 spool to contain the frac tree.' Duhn Oil's
12 assertions are without support and simply
13 wrong. Mr. Boyadjieff conceded that he has
14 not done any calculation to determine if or
15 when Cameron's mandrel would fail because the
16 lockscrews were not run in. Further, he
17 conceded that the only Cameron frac mandrels
18 he has seen undergo a fracing process were in
19 two videos provided by Cameron. And he
20 agreed that those videos show Cameron's
21 mandrels undergoing a frac job with tubing
22 head lockscrews not run in, and that there
23 was no failure or so-called 'dancing.'

24 Cameron contends that Duhn has presented no evidence that a
25 Cameron frac mandrel would fail or fail to work properly if the
26 tubing head lockscrews were not run in:

Duhn Oil bases its entire argument by taking
out of context a statement by Mr. Tom Taylor,
a Cameron engineer, discussing that he had
heard someone was concerned about the
possible occurrence of 'dancing.' However,
after reading Mr. Boyadjieff's perversion of
his testimony, Mr. Taylor made it clear that
there has never been any instance of
'dancing.'

Cameron contends that it "is also quite telling" that Duhn
presents no evidence from a third party stating that the
lockscrews must be run in for Cameron's frac mandrel to work.

1 Cameron cites *E-Pass Technologies, Inc. v. 3Com Corp.*, 473 F.3d
2 1213, 1222-1223 (Fed.Cir.2007):

3 If, as E-Pass argues, it is 'unfathomable'
4 that no user in possession of one of the
5 accused devices and its manual has practiced
6 the accused method ..., E-Pass should have
7 had no difficulty in meeting its burden of
8 proof and in introducing evidence of even one
9 such user.

10 Cameron contends that it has received written acknowledgements
11 from its customers, acknowledging that they are aware of
12 Cameron's procedures that the lockscrews not be run in to contact
13 the mandrel. Cameron also refers to evidence that Duhn's
14 inspection of Cameron's facilities and seen "countless" mandrels
15 without dimples and asserts that Duhn has repeatedly presented
16 isolated instances where the lockscrews were run in to assert
17 that the lockscrews are always run in. Cameron contends that the
18 Court should hold Duhn to its evidentiary burden and grant
19 partial summary judgment of noninfringement for Cameron for the
20 at least 615 instances in which Cameron can show through its
21 checklists that its mandrel was used with the lockscrews not run
22 in.

23 Duhn responds that Cameron's position is without merit
24 because it attempts to conflate standards for damages with
25 standards for infringement liability. Duhn cites *Lucent*
26 *Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1317
(Fed.Cir.2009), cert. denied sub nom. *Microsoft Corp. v. Lucent*
Technologies, Inc., ___ U.S. ___, 130 S.Ct. 3324 (2010):

To infringe a method claim, a person must

1 have practiced all steps of the claimed
2 method ... [A] finding of infringement can
3 rest on as little as one instance of the
 claimed method being performed during the
 pertinent time period.

4 That Cameron can identify some instances of purported non-
5 infringement, Duhn contends, has no bearing on whether Cameron is
6 liable for direct infringement of the '925 Patent:

7 [E]ven if Cameron can show some instances
8 where there is no direct infringement, that
9 is not sufficient to grant summary judgment
10 of non-infringement; Duhn need only show that
11 there is some direct infringement ... [T]here
 is not disputing that Cameron infringed. The
 amount of infringement is a factual question
 - here, a genuine factual dispute - for
 determining damages, not liability.

12 Duhn also argues that Cameron's evidence of non-infringement
13 where the lockscrews are not run in is "highly suspect,"
14 referring to Duhn's objections to Mr. Tobin's declaration
15 discussed *supra*.

16 Cameron's motion for partial summary judgment on this ground
17 is DENIED; questions of fact remain to be resolved at trial.

18 V. NO CONTRIBUTORY INFRINGEMENT.

19 Cameron moves for partial summary judgment on the ground
20 that Cameron's "confirmed-as-noninfringing configuration is
21 substantially used, and, as such, precludes a finding of
22 contributory infringement as a matter of law."

23 35 U.S.C. § 271(c) provides:

24 Whoever offers to sell or sells within the
25 United States or imports into the United
26 States a component of a patented machine,
 manufacture, combination or composition, or a
 material or apparatus for use in practicing a

1 patented process, constituting a material
2 part of the invention, knowing the same to be
3 especially made or especially adapted for use
4 in an infringement of such patent, and not a
5 staple article or commodity of commerce
6 suitable for substantial noninfringing use,
7 shall be liable as a contributory infringer.

8 Cameron cites *Cross Medical Products, Inc. v. Medtronic Sofamor*
9 *Danek*, 424 F.3d 1293, 1312 (Fed.Cir.2005):

10 In order to succeed on a claim of
11 contributory infringement, in addition to
12 proving an act of direct infringement,
13 plaintiff must show that defendant 'knew that
14 the combination for which its components were
15 especially made was both patented and
16 infringing' and that defendant's components
17 have 'no substantial non-infringing use.'

18 Cameron asserts that Duhn cannot satisfy this test.

19 Cameron asserts that Duhn must make a *prima facie* showing
20 that there are no substantial non-infringing uses for the
21 allegedly infringing product and must overcome any rebuttal
22 evidence presented by Cameron. See *Golden Blount, Inc. v. Robert*
23 *H. Peterson Co.*, 438 F.3d 1354, 1363 (Fed.Cir.2006). If Duhn
24 fails to provide evidence that the accused device has no
25 substantial non-infringing use, the allegation of contributory
26 infringement cannot stand. *Lucent Technologies, Inc. v. Gateway,*
Inc., 2007 WL 925502 at *4 (S.D.Cal., March 19, 2007):

Under 35 U.S.C. § 271(c), the determination
of whether there are substantial
noninfringing uses focuses on 'the thing
sold' by the one accused of contributing to
infringement. *Hodosh v. Block Drug Co.,*
Inc., 833 F.3d 1575, 1578 (Fed.Cir.1987); see
also *Aquatex Industries, Inc. v. Techniche*
Solutions, 419 F.3d 1374, 1380 n. **
(Fed.Cir.2005) (noting that the proper
question for contributory infringement was

1 whether defendant's product as sold was a
2 staple article, not whether the product
3 contained components that themselves could
4 have other noninfringing uses.

5 Cameron submits it can prove the "confirmed-as-noninfringing
6 configuration of its mandrels is substantially used":

7 Cameron's checklists conclusively show that
8 its mandrels have been used hundreds of times
9 in a confirmed noninfringing manner. And
10 while Duhn Oil may present instances of
11 alleged infringement, isolated instances do
12 not support Duhn's claim that there is no
13 substantial noninfringing use.

14 Duhn responds that Cameron's analysis is faulty because it
15 relies upon later developed installation procedures to excuse
16 earlier infringing sales and contends that the focus should be on
17 whether the products had a non-infringing use at the time of the
18 sale. Duhn cites *Bassick Mfg. Co. v. Adams Grease Gun*
19 *Corporation*, 52 F.2d 36, 40 (2nd Cir.1931) and the Scheduling
20 Order Following Pretrial Conference filed on September 29, 2010
21 (Doc. 467):

22 1. The issue of contributory infringement in
23 Cameron's Motion for Partial Judgment of No
24 Infringement (Docket 446, filed September 12,
25 2010), shall be limited to the issue of
26 contributory infringement after April 2009.

27 Duhn argues that there is no dispute that Cameron sold and placed
28 into its rental pool the bulk of its frac mandrels prior to
29 developing its modified installation procedures and there is no
30 evidence that, prior to 2008, Cameron had developed a non-
31 infringing method of using its product. Therefore, Duhn
32 contends, Cameron bears the burden of showing substantial non-

1 infringing uses for all sales of the product, including those
2 before the development of Cameron's non-infringing method.
3 Moreover, Duhn asserts, there is a genuine issue of material fact
4 whether Cameron's purported non-infringing use even is an
5 acceptable substitute for the patented system, referring to
6 evidence that installers continued to run in the lockscrews after
7 2008:

8 Thus, even if Cameron had instructed its
9 installers or customers not to run in the
10 screws, the continued running in of the
11 screws creates a genuine issue of fact as to
12 whether the purportedly non-infringing
13 configuration is acceptable to customers.

14 In reply, Cameron submits additional charts summarizing the
15 checklists since the filing of the motion and contends:

16 These charts summarizing Cameron's summary
17 judgment evidence, and the corresponding
18 compilations of these checklists, demonstrate
19 the irrefutable evidence through which
20 Cameron has established the substantial
21 noninfringing use for its accused frac
22 mandrel products. For example, the Exhibit F
23 chart listing the 'Documented Lifecycles' of
24 Cameron's frac mandrels show that since the
25 April 16, 2009 implementation of the buffing
26 procedures through which Cameron confirmed
27 that its mandrels were 'clean' and without
28 dimples or indentations when sent into the
29 field, Cameron has documented 531 returns
30 with a corresponding installation after
31 buffing. Of those 531 'Documented
32 Lifecycles,' 519 of the returns confirmed
33 that the frac mandrels had no
34 dimples/indentations when returned to
35 Cameron's facility.

36 Having established at least 519 instances in
37 which Cameron's accused frac mandrels were
38 installed and then returned with no
39 dimples/indentations on the frac mandrels
40 (which confirms that the mandrels were used

1 in a confirmed non-infringing configuration
2 with the tubing head lockscrews not in
3 contact with the frac mandrel), Cameron has
4 established the substantial noninfringing use
5 for its accused frac mandrel products.

6 Cameron acknowledges the Court's limitation regarding
7 contributory infringement to contributory infringement after
8 April 2009. In its reply brief, Cameron requests the Court
9 reconsider the limitation and recognize that the "substantial
10 confirmed noninfringing use for which Cameron's accused products
11 are suitable ... is a suitable use that is inherent in the design
12 of the product and has existed since the first sale of the
13 accused products":

14 Although Cameron's implementation of its
15 checklists procedures in 2009 provides the
16 evidentiary proof through which Cameron has
17 established that its accused products are
18 suitable for such use, this proven suitable
19 use did not come about by any change in the
20 product design, just a change in the use.
21 Cameron's accused frac mandrel products have
22 always been suitable for use with the tubing
23 head lockscrews not in contact with the frac
24 mandrel. A finding of no contributory
25 infringement after April, 2009, based on the
26 indisputable fact that the accused products
are suitable for use with the lockscrews not
in contact with the frac mandrel, inherently
means that there can be no liability for
contributory infringement since the first
sale of the accused product.

27 Cameron's request for reconsideration is denied because it
28 was requested for the first time in the reply brief. Moreover,
29 Cameron has three versions of the frac mandrel ("old style" with
30 a narrow groove; "new style" with a wide groove; and "original
31 "original design" with no groove). The only one at issue where

1 the lockscrews were not run in is the Original Design, not the
2 New Style Design. Cameron is not entitled to partial summary
3 judgment because questions of fact remain to be resolved at
4 trial.

5 VI. NO INDUCEMENT OF INFRINGEMENT AFTER APRIL 2, 2009.

6 Cameron argues that, since April 2, 2009, Cameron, in
7 accordance with the Court's Order, has been specifically
8 instructing its customers not to run in the lockscrews and to
9 only use the confirmed-as-noninfringing configuration. Even if a
10 third party were to run in the lockscrews, Cameron asserts,
11 Cameron did not have the specific intent to induce that
12 infringement and is entitled to partial summary judgment that it
13 did not induce others to infringe after April 2, 2009.

14 As explained in *Water Technologies Corp. v. Calco, Ltd.*, 850
15 F.2d 660, 668 (Fed.Cir.1988):

16 The patent statute provides that '[w]hoever
17 actively induces infringement of a patent
18 shall be liable as an infringer.' 35 U.S.C.
19 § 271(b). Thus, a person infringes by
20 actively and knowingly aiding and abetting
another's direct infringement. Although
section 271(b) does not use the word
'knowingly,' the case law and legislative
history uniformly assert such a requirement.

21 See also *Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1363
22 (Fed.Cir.2003):

23 To succeed on this theory, a plaintiff must
24 prove that the defendants' 'actions induced
25 infringing acts and that [they] knew or
26 should have known [their] actions would
induce actual infringement.' ... However,
that defendants have 'knowledge of the acts
alleged to constitute infringement' is not

1 enough ... '[P]roof of actual intent to cause
2 the acts which constitute the infringement is
3 a necessary prerequisite to finding active
4 inducement.' ... 'While proof of intent is
5 necessary, direct evidence is not required;
6 rather, circumstantial evidence may suffice.

7 Duhn responds that partial summary judgment on this ground
8 is inappropriate: "While Cameron may have taken steps at some
9 point to discourage infringement, there is a legitimate question
10 of fact as to when these steps actually occurred." Duhn refers
11 to evidence that the placards instructing customers not to run in
12 the lockscrews were applied as the mandrels were returned and
13 that, as of September 9, 2009, he could not say how many placards
14 had been applied to the mandrels. In addition, Duhn contends,
15 evidence of direct infringement after April 2, 2009 indicates
16 that Cameron's efforts were incomplete, referring to evidence
17 that some mandrels left Cameron's facility without dimples after
18 April 2, 2009 and returned with dimples. Thus, Duhn argues,
19 there is a genuine issue of material fact as to if or when there
20 is a cut-off date for Cameron's inducement of infringement.

21 Cameron replies that Duhn has no evidence that Cameron
22 encouraged anyone to use the frac mandrels in the allegedly
23 infringing configuration after April 2, 2009:

24 Any possible questions regarding the steps
25 that Cameron has taken to encourage the use
26 of the confirmed-as-noninfringing
 configuration is still no evidence of
 inducement of the alleged direct infringement
 of others, which would be encouragement of
 allegedly infringing configuration.

 Cameron's motion for partial summary judgment is DENIED on

1 this ground; issues of fact and issues relating to damages remain
2 for trial.

3 VII. NO INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS.

4 Cameron moves for partial summary judgment on the ground
5 that there is no infringement of the '925 Patent under the
6 doctrine of equivalents. Cameron asserts that Duhn is estopped
7 from asserting the doctrine of equivalents for the asserted
8 claims; that Duhn may not vitiate the recited "lockscrews"; and
9 that the "lock collar" employed by Cameron is not legally
10 equivalent to the claimed "lockscrews."

11 Infringement under the doctrine of equivalents requires that
12 the accused product contain each limitation of the claim or its
13 equivalent. *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351,
14 1359 (Fed.Cir.2000). Infringement under the doctrine of
15 equivalents occurs when a claimed limitation and the accused
16 product perform substantially the same function in substantially
17 the same way to obtain substantially the same result. *V-*
18 *Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1313
19 (Fed.Cir.2005). An element in the accused product is equivalent
20 to a claim limitation if the differences between the two are
21 "insubstantial to one of ordinary skill in the art. *KCJ Corp.*,
22 *id.* Each element contained in a patent claim is deemed material
23 to defining the scope of the patented invention, and thus the
24 doctrine of equivalents must be applied to individual elements of
25 the claim, not to the invention as a whole. *Warner-Jenkinson*
26 *Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997).

1 However, prosecution history estoppel prevents the application of
2 the doctrine of equivalents as a tool to recapture subject matter
3 surrendered during prosecution. *KCJ Corp., id.* Application of
4 the rule precluding use of the doctrine of equivalents to
5 recapture claim scope surrendered during patent acquisition is a
6 question of law. *Id.*

7 In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535
8 U.S. 722 (2002), the Supreme Court held:

9 Prosecution history estoppel requires that
10 the claims of a patent be interpreted in
11 light of the proceedings before the PTO
12 during the application process. Estoppel is
13 a 'rule of patent construction' that ensures
14 that claims are interpreted by reference to
15 those 'that have been cancelled or rejected.'
16 ... The doctrine of equivalents allows the
17 patentee to claim those insubstantial
18 alterations that were not captured in
19 drafting the original patent claim but which
20 could be created through trivial changes.
21 When, however, the patentee originally
22 claimed the subject matter alleged to
23 infringe but then narrowed the claim in
24 response to a rejection, he may not argue
25 that the surrendered territory comprised
26 unforeseen subject matter that should be
deemed equivalent to the literal claims of
the issued patent. On the contrary, '[b]y
the amendment [the patentee] recognized and
emphasized the difference between the two
phrases[,] ... and [t]he difference which
[the patentee] thus disclaimed must be
regarded as material.'

22 A rejection indicates that the patent
23 examiner does not believe the original claim
24 could be patented. While the patentee has
25 the right to appeal, his decision to forego
26 an appeal and submit an amended claim is
taken as a concession that the invention as
patented does not reach as far as the
original claim ... Were it otherwise, the
inventor might avoid the PTO's gatekeeping

1 role and seek to recapture in an infringement
2 action the very subject matter surrendered as
a condition of receiving the patent.

3 Prosecution history estoppel ensures that the
4 doctrine of equivalents remains tied to its
underlying purpose. Where the original
5 application once embraced the purported
equivalent but the patentee narrowed his
6 claims to obtain the patent or to protect its
validity, the patentee cannot assert that he
7 lacked the words to describe the subject
matter in question. The doctrine of
8 equivalents is premised on language's
inability to capture the essence of
9 innovation, but a prior application
describing the precise element at issue
10 undercuts that premise. In that instance the
prosecution history has established that the
11 inventor turned his attention to the subject
matter in question, knew the words for both
12 the broader and narrower claim, and
affirmatively chose the latter.

13 535 U.S. at 733-734.

14 A. Prosecution History Estoppel/Duhn May Not Vitiates
15 the Recited "Lockscrews".

16 Cameron argues that Duhn is estopped from asserting the
17 doctrine of equivalents for Claims 13, 14, 31 and 86 because of
18 the amendments Duhn made to obtain the '925 Patent. Cameron
19 contends that the prosecution history regarding Claims 13, 14, 31
20 and 86 is "virtually identical" to that addressed in *Honeywell*
21 *Int'l, Inc. v. Hamilton, Sundstrand Corp.*, 370 F.3d 1131
22 (Fed.Cir.2004), cert. denied, 545 U.S. 1127 (2005).

23 In *Honeywell*, the Federal Circuit addressed "whether
24 rewriting a dependent claim into independent form, coupled with
25 the cancellation of the original independent claim, constitutes a
26 narrowing amendment when the dependent claim includes an

1 additional claim limitation not found in the cancelled
2 independent claim or circumscribes a limitation found in the
3 cancelled independent claim." 370 F.3d at 1141. The Federal
4 Circuit stated:

5 In this case there is no question that the
6 original independent claims (application
7 claims 16 and 32 of the '893 and application
8 claims 48 and 49 of the '194 patent) were
9 rejected for reasons related to
10 patentability. All of the original
11 independent claims were rejected as obvious
12 in view of the prior art. The original
13 independent claim upon which application
14 claim 35 depended was also rejected as
15 indefinite under 35 U.S.C. § 112, paragraph
16 two. These rejected independent claims
17 (application claims 17 and 35 of the '893
18 patent and claim 51 of the '194 patent) were
19 rewritten into independent form in order to
20 secure their allowance.

21 A presumption of surrender therefore arises
22 if rewriting the dependent claims into
23 independent form, along with canceling the
24 original independent claims, constitutes a
25 narrowing amendment. Honeywell argues that
26 prosecution history estoppel cannot occur
where a dependent claim is merely rewritten
into independent form. Honeywell contends
that, although it surrendered its broader
independent claims, there is no presumption
of surrender because the scope of the
rewritten claims themselves have not been
narrowed. We disagree.

27 *Id.* at 1141. Relying on *Festo Corp. v. Shoketsu Kinzoku Kogyo*
28 *Kabushiki Co.*, 535 U.S. 722 (2002), and Federal Circuit opinions
29 following *Festo*, the *Honeywell* Court held:

30 In *Festo* the Supreme Court explained that
31 '[a] patentee's decision to narrow his claims
32 through amendment may be presumed to be a
33 general disclaimer of the territory between
34 the original claim and the amended claim.'
35 535 U.S. at 740 ... When the scope of the

1 patent claim is narrowed to secure the
2 patent, the court 'must regard the patentee
3 as having conceded an inability to claim the
4 broader subject matter.' *Id.* at 737 ... The
5 scope of the patentee's concession is
6 determined on a limitation-by-limitation
7 basis ... It necessarily follows that the
8 presumption of surrender applies only to the
9 amended or newly added limitation; there is
10 no surrender of territory as to unamended
11 limitations that were present in the original
12 claim. Thus, when a claim is rewritten from
13 dependent into independent form and the
14 original independent claim is cancelled, 'the
15 correct focus is on whether [the] amendment
16 surrendered subject matter.' ... Under such
17 circumstances, the surrendered subject matter
18 is defined by the cancellation of independent
19 claims that do not include a particular
20 limitation and the rewriting into independent
21 form of dependent claims that do include that
22 limitation. Equivalents are presumptively
23 not available with respect to that added
24 limitation.

13 In this case there is a presumptive surrender
14 of all equivalents to the inlet guide vane
15 limitation. The only independent claims
16 asserted in this case, claims 4, 8 and 19,
17 were originally dependent on independent
18 application claims 16, 32, 48 and 49, which
19 did not include the inlet guide vane
20 limitation. Claims, 4, 8 and 19 included the
21 inlet guide vane limitation. Claims 4, 8 and
22 19 were rewritten into independent form, and
23 the original independent claims were
24 cancelled, effectively adding the inlet guide
25 vane limitation to the claimed invention.
26 Honeywell is presumptively estopped from
recapturing equivalents to the inlet guide
vane limitation.

22 370 F.3d at 1143-1144.

23 Cameron argues that Duhn amended its claims "in almost
24 exactly the same manner" as the patentee in *Honeywell*. During
25 the prosecution of the '925 Patent, then-pending Claim 90 was a
26 dependent claim based on then-pending independent Claim 72. In

1 order to overcome rejections from the USPTO, Duhn amended then-
2 pending Claim 72 to include "a plurality of lock-screws," and re-
3 wrote then-pending Claim 90, which already included the "lock-
4 screws" limitation, into independent form. Cameron argues that,
5 by amending then-pending Claim 72 to include the "lock-screws,"
6 Duhn conceded that then-pending Claim 72 was not patentable as
7 originally presented and that, accordingly, this amendment
8 carries the same effect as cancellation for purposes of the
9 doctrine of equivalents. By amending these claims, Cameron
10 contends, which issued as Claims 77 and 86, respectively, Duhn
11 narrowed the scope of its claims by adding the "lock-screws"
12 limitation to obtain the '925 Patent. Cameron further argues
13 that Duhn's amendments to then-pending Claims 72 and 90 precludes
14 application of the doctrine of equivalents with respect to the
15 "lock screws" recited in issued Claims 13, 14 and 31. By making
16 the claim amendments, Duhn surrendered claim scope between the
17 original claim and the specific structure of the "lock screws."
18 Cameron contends:

19 The doctrine of equivalents requires analysis
20 of technology a patentee is entitled to
21 recapture and what technology he surrendered
22 to obtain his patent. Thus, it would be
23 illogical and overly formulaic to say that
24 Duhn Oil disclaimed a technology on some
25 claims but is allowed to recapture that same
26 technology via other claims using nearly
27 identical language. Indeed, similar claims
28 terms in a patent should be interpreted as
29 having similar scope.

30 Duhn responds that *Honeywell* has no application because
31 *Honeywell* requires the cancellation of the independent claim,

1 which was not done here.

2 At a hearing on May 5, 2008, Cameron conceded that Duhn did
3 not cancel an independent claim as was done in *Honeywell* but
4 argues:

5 And what they did in this case is they didn't
6 cancel the independent claim; they added a
7 bunch of other stuff to it and turned it into
8 another claim. They morphed it into a whole
9 different claim. It certainly didn't get
10 issued as the independent claim it was
11 started as. So technically they didn't
12 cancel it, but effectively they did. And so
13 that's really their defense to this. They
14 say *Honeywell* doesn't apply.

15 ... [I]t's a pure legal question for this
16 Court to resolve, and, you know, from a
17 perspective of patent jurisprudence, to me
18 it's a[n] easy decision to say the *Honeywell*
19 decision is not just limited to actually
20 cancelling claims when you effectively cancel
21 them by changing them and moving them off
22 over somewhere else. It's the same as
23 cancelling them.

24 (CT, Doc. 199, p. 81:18-82:7).

25 At the hearing, Duhn responded that *Honeywell* is not
26 applicable, even given Cameron's effective cancellation argument:

Honeywell is a situation where you have an
independent claim and the examiner at the
Patent Office says that a dependent claim, if
it were added to the independent claim, would
make that claim patentable. And then what
happens is you essentially - and you can do
this a number of ways. You can either keep
that independent claim and add the dependent
claim language - and it was very clear that
that would create an estoppel, but as
opposing counsel pointed out, sometimes what
people were doing was essentially re-writing
a brand new claim that included both.

Neither of those happened here. In fact,
what happened here was the 'wherein' clause

1 was added to the independent claim, and that
2 is what was argued as making these claims
patentable.

3 The fact that there are some dependent claims
4 that later became independent claims that
5 have the 'wherein' clause in them and also
6 have this added language about the second
lock screws does not mean that the lock screw
language was required to obtain allowance of
that claim.

7 So *Honeywell* is basically founded on the
8 principal that if you have to add something
9 to a claim to get it allowed, you can't later
10 argue that that ought to be ignored. But
11 there's no - we did not add the second lock
12 screws to get those claims allowed, and
therefore we would argue that we are entitled
to a range of equivalence as to that element
because it's not the element that allowed us
to get the claims allowed.

(CT, Doc. 199, p. 108:25-109:25).

13 For the reasons stated by the Court at the hearing on
14 November 15, 2010, Duhn's contention that *Honeywell* is
15 inapplicable is rejected and Duhn is estopped by the prosecution
16 history from arguing that Cameron's frac mandrel is the
17 equivalent of Duhn's frac mandrel as to Claims 13, 14, 31 and 86
18 of the '925 Patent.³

19 With regard to Claims 13, 14 and 31, at the hearing Cameron
20 cited *Glaxo Wellcome, Inc. v. Impax Laboratories, Inc.*, 356 F.3d
21 1348 (Fed.Cir.2004). Cameron described *Glaxo*:

22 [I]t resolves the issue - it's called
23

24 ³This ruling makes unnecessary consideration of Cameron's
25 contention that partial summary judgment should be granted on the
26 ground that the "lock collar" or "lock ring" of the TSWS is not
legally equivalent to the "lock screws" of Claims 13, 14, 31 and 86
of the '925 Patent.

1 'infectious estoppel.' So it says even if
2 these other claims didn't go through this
3 *Honeywell* process and get amended and get ...
4 barred from Doctrine of Equivalence coverage,
5 that claim limitation of the second set of
6 lock screws that is barred from equivalence
7 coverage in - based on *Honeywell*, it infects
8 all the other claims that have that same
9 language. So *Glaxo* [sic] from the federal
10 circuit tells us you've got infectious
11 *Honeywell* estoppel that spreads cover to 13,
12 41 [sic] and 31.

13 (CT, Doc. 199, p. 80:24-81:8].

14 In *Glaxo*, *Glaxo* applied for a patent and obtained the '798
15 patent for a sustained release formulation of bupropion
16 hydrochloride. The key ingredient for achieving sustained
17 release is HPMC. Many of the patent claims as originally filed
18 did not recite HPMC as a limitation. During the prosecution of
19 the patent, the examiner rejected the claims that did not recite
20 HPMC for lack of enablement under 35 U.S.C. § 112. *Glaxo* amended
21 those claims to overcome the rejection. *Impax* filed two
22 Abbreviated New Drug Applications with the FDA in which *Impax*
23 certified that its generic sustained release bupropion
24 hydrochloride did not infringe *Glaxo's* '798 patent because the
25 sustained release agent in *Impax's* proposed composition was HPC.
26 *Glaxo* sued *Impax* for patent infringement. *Impax* was granted
summary judgment on the basis of prosecution history estoppel.
The District Court ruled that *Glaxo's* amendments narrowed the
patent with respect to sustained release and that at the time of
Glaxo's amendments, anyone skilled in the art would have known
that HPMC and HPC were substantially equivalent. On appeal, the

1 Federal Circuit ruled that, by the amendments, Glaxo surrendered
2 other controlled sustained release agents known to act as
3 equivalents of HPMC. 354 F.3d at 1352. In the section of the
4 opinion captioned "Infectious Estoppel," the Federal Circuit
5 ruled:

6 Claim 1 of the '798 patent originally recited
7 HPMC as the sustained release agent for
8 bupropion. Thus, the applicant did not amend
9 the HPMC limitation of claim 1. Because the
10 applicant did not narrow this claim, Glaxo
11 contends that the *Festo* presumption does not
12 operate to divest claim 1 of the equivalents
13 armor. Thus, Glaxo asserts that the district
14 court erred in removing the doctrine of
15 equivalents from the equation used to
16 evaluate infringement of this claim.
17 According to Glaxo, claim 1 is plagued by
18 'infectious estoppel,' an ailment Glaxo
19 alleges the district court impermissibly
20 imparted on the claim. Glaxo misdiagnoses
21 the legal situation.

22 Under the law of this circuit, the *Festo* bar
23 to the doctrine of equivalents applies to all
24 of the '798 claims containing the 'critical'
25 HPMC limitation. This court has noted that
26 subject matter surrendered via claim
27 amendments during prosecution is also
28 relinquished for other claims containing the
29 same limitation ... This court follows this
30 rule to ensure consistent interpretation of
31 the same claim terms in the same patent

32 *Id.* at 1356.

33 The net effect in *Glaxo* was that Glaxo was limited to HPMC
34 and could not claim the doctrine of equivalents to other
35 sustained release agents.

36 Cameron's motion for partial summary judgment is GRANTED as
37 to 13, 14 and 31 of the '925 Patent on the ground of infectious
38 estoppel.

1 CONCLUSION

2 For the reasons stated:

3 1. Cameron's motion for partial summary judgment of no
4 infringement is GRANTED IN PART AND DENIED IN PART;

5 2. Counsel for Cameron shall prepare and lodge a form of
6 order consistent with this Memorandum Decision within five (5)
7 court days following service of this Memorandum Decision.

8 IT IS SO ORDERED.

9 Dated: December 2, 2010

/s/ Oliver W. Wanger
UNITED STATES DISTRICT JUDGE

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