

United States District Court  
For the Northern District of California

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

STEVEN ROTH,	No	C 08-02156 VRW
Plaintiff,		ORDER
v		
LOOS & COMPANY, INC and SEISMIC SOLUTIONS, INC,		
Defendants.		

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Defendants Loos & Company, Inc ("Loos") and Seismic Solutions, Inc ("Seismic Solutions") have moved for summary judgment on plaintiff Steven Roth's indirect infringement claims. Doc #62. Roth opposes the motion and argues that triable issues of fact exist. For the reasons stated below, defendants' motion for summary judgment (Doc #62) is DENIED.

I

On April 25, 2008, Roth filed a complaint alleging infringement of United States Patent No. 7,188,809 ("the '809



1 Lobby, 477 US 242, 248 (1986). "Only disputes over facts that  
2 might affect the outcome of the suit under the governing law will  
3 properly preclude the entry of summary judgment." *Id.* The burden  
4 of establishing the absence of a genuine issue of material fact  
5 lies with the moving party. See Celotex Corp v Carrett, 477 US  
6 317, 322-23 (1986). Summary judgment is granted only if the moving  
7 party is entitled to judgment as a matter of law. FRCP 56(c).

8 To defeat summary judgment, the nonmoving party may not  
9 simply rely on the pleadings, but must produce significant  
10 probative evidence, by affidavit or as otherwise provided in FRCP  
11 56, supporting the claim that a genuine issue of material fact  
12 exists. TW Elec Service, Inc v Pacific Elec Contractors Ass'n, 809  
13 F2d 626, 630 (9th Cir 1987). The evidence presented by the  
14 nonmoving party "is to be believed, and all justifiable inferences  
15 are to be drawn in his favor." Anderson, 477 US at 255. "[T]he  
16 judge's function is not himself to weigh the evidence and determine  
17 the truth of the matter but to determine whether there is a genuine  
18 issue for trial." *Id* at 249.

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20 A

21 First, Loos and Seismic Solutions seek summary judgment  
22 that Roth has presented no evidence of direct infringement of the  
23 '809 patent. Loos and Seismic Solutions argue that since use of  
24 their product does not result in "biting into" the threaded rod or  
25 stiffener pipe, there is no direct infringement of the '809 patent.  
26 Roth argues that because proper use of the RS-1 clip results in  
27 "biting into" there is evidence of direct infringement.

28 Roth provides evidence of "biting into" in three forms: (1)

1 his second supplemental answers to defendants' first set of  
2 interrogatories, (2) his deposition of June 30, 2009 and (3) tests  
3 performed by an expert.

4 Roth's second supplemental answers to defendants' first  
5 set of interrogatories describe a demonstration conducted by Roth  
6 in December 2008. During this test, Roth used one of the RS-1  
7 clips and found that the "outer edge of the RS-1 Clip did torque  
8 [sic] and bite into the stiffener member (pipe)." Doc #83.

9 Roth further presents his deposition of June 30, 2009,  
10 during which he described the tests he performed with the RS-1 clip  
11 and his observation that the clip "bites into the pipe." Doc #83.

12 Roth additionally provides expert testimony that  
13 indicates "biting into." Roth's expert concludes that "[a]s a  
14 result of bolting the RS-1 clip onto the stiffener pipe and  
15 threaded rod, at least one edge of each clip tested caused  
16 deformation and cutting (i.e., biting) into the stiffener pipe."  
17 Doc #83 Exh F.

18 The court has construed "biting into" to mean "penetrates  
19 the surface of." Doc #70 at 9. Loos and Seismic Solutions argue  
20 in their reply that because the RS-1 clip merely forces its way  
21 into the stiffener member in the form of a "microscopic mark,"  
22 there is no evidence of "biting into." Doc #73 at 9. But "biting  
23 into" does not require "embedding in the surface." Doc #70 at 9.  
24 A small "bite" is after all a "bite." Roth has therefore  
25 supplemented the factual record adequately to avoid summary  
26 judgment on this issue. It remains a factually contested matter  
27 whether "biting" occurs whereby the '809 patent is infringed by the  
28 parts manufactured, distributed and sold by Loos and Seismic

1 Solutions. Summary judgment on this issue is therefore DENIED.  
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4 B

5 Loos and Seismic Solutions also seek summary judgment  
6 that Roth cannot establish that Loos and Seismic Solutions  
7 possessed the specific intent to encourage any of their customers  
8 to infringe any claim of the '809 patent. Loos and Seismic  
9 Solutions argue that because Roth has produced no evidence in  
10 support of his claim, Loos and Seismic Solutions are entitled to  
11 summary judgment. Loos and Seismic Solutions further argue that  
12 the opinion-of-counsel letter received by Loos on March 27, 2008  
13 negates the specific intent required for a finding of induced  
14 infringement.

15 In response, Roth presents the following evidence in  
16 support of his claim that Loos and Seismic Solutions intended for  
17 any of their customers to infringe any asserted claim of the '809  
18 patent:

19 It is undisputed that the defendants sell the RS-1 clip.  
20 The RS-1 clip has all of the physical limitations of claim 1 of the  
21 '809 patent. The defendants provide detailed instructions. Doc  
22 #83, Exh C. Installation of the RS-1 clips as per instructions  
23 cause the RS-1 clip to perform all of the functions called for in  
24 claim 1 of the '809 patent. Doc #83, Exh B, F.

25 Roth further presents evidence that he personally  
26 notified Loos of the '809 patent on November 13, 2007. The fact  
27 that this event occurred in late 2007 is undisputed. On February  
28 26, 2008, plaintiff's counsel sent a letter to Loos articulating

1 that the "[m]anufacture, use or sale of Part RS1 clearly  
2 constitutes an infringement of U S 7,188,809." Doc #64, Exh 8.  
3 Roth presents evidence that between November 2007 and March 2008,  
4 Loos continued to sell RS-1 clips with knowledge of the '809 patent  
5 and without the benefit of an opinion-of-counsel letter.

6 Roth has therefore produced significant probative  
7 evidence supporting his claim that Loos induced infringement of the  
8 '809 patent. The court DENIES summary judgment on the second issue  
9 as it relates to Loos.

10 In its reply, Seismic Solutions argues for the first time  
11 that Roth has not produced any evidence that Seismic Solutions was  
12 aware of the '809 patent. Doc #79 at 6. In general, "[i]t is  
13 improper for the moving party to 'shift gears' and introduce new  
14 facts or different legal arguments in the reply brief than [those  
15 that were] presented in the moving papers." William W Schwarzer, A  
16 Wallace Tashima and James M Wagstaffe, Federal Civil Procedure  
17 Before Trial § 12:107 (The Rutter Group 2009). Parties are  
18 required to raise all of their arguments in their opening brief to  
19 prevent "sandbagging" of the nonmoving party and to provide  
20 opposing counsel the chance to respond. Corson and Gruman Co v  
21 NLRB, 899 F2d 47, 50 n 4 (DC Cir 1990). Seismic Solutions'  
22 argument regarding its awareness of the '809 patent is deemed  
23 waived because it was not raised in the motion and initial  
24 supporting documents. The court therefore DENIES summary judgment  
25 on the second issue as it relates to Seismic Solutions.

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III

As explained above, the court DENIES defendants' motion for summary judgment.

IT IS SO ORDERED.



VAUGHN R WALKER

United States District Chief Judge