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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

ICON-IP PTY LTD.,  
Plaintiff,

v.

SPECIALIZED BICYCLE COMPONENTS,  
INC.,  
Defendant.

Case No. 12-cv-03844-JST

**ORDER RE: MOTIONS TO EXCLUDE  
AND MOTIONS FOR SUMMARY  
JUDGMENT**

Re: ECF Nos. 152, 153, 167, 168, 169, 170,  
171, 173, 175

Before the Court are the following motions filed by Plaintiff Icon-IP Pty Ltd. (“Icon”) and Defendant Specialized Bicycle Components, Inc. (“Specialized”): (1) Defendant’s Motion Pursuant to F.R.E. 702/Daubert to Exclude the Opinions of Dr. Timothy Harrigan, ECF No. 152; (2) Defendant’s Motion for Summary Judgment, ECF No. 153; (3) Plaintiff’s Motion to Exclude Stephen M. Werner, Ph.D., P.E., ECF No. 168; (4) Plaintiff’s Motion to Exclude James McIlvain and Paragraphs 90, 104, 106, 127, 159, 163, 194 and 203 of the Expert Rebuttal Report of Jeffrey Kinrich, ECF No. 169; (5) Plaintiff’s Motion to Exclude the Testimony of Stephen G. Kunin and Bar Testimony Attacking the Competency of the Patent Office about Patent Law or Practice, ECF No. 170; (6) Defendant’s Motion Pursuant to F.R.E. 702/Daubert to Exclude the Expert Testimony of Frank Bernatowicz, ECF No. 171; (7) Plaintiff’s Motion to Exclude Roger Minkow, M.D., ECF No. 173; and (8) Icon’s Motion for Summary Judgment, ECF No. 175. The Court strikes the Motion to Exclude the Testimony of Stephen G. Kunin and Bar Testimony Attacking the Competency of the Patent Office about Patent Law or Practice filed at ECF No. 167 as duplicative of the motion filed at ECF No. 170.

For the reasons set forth below, the Court will: (1) deny Specialized’s motion to exclude Harrigan; (2) grant in part and deny in part Icon’s motion to exclude Werner; (3) deny Icon’s

1 motion to exclude McIlvain and certain paragraphs of Kinrich’s expert rebuttal report; (4) grant in  
2 part and deny in part Icon’s motion to exclude Kunin; (5) grant in part and deny in part  
3 Specialized’s motion to exclude Bernatowicz; (6) deny Icon’s motion to exclude Minkow;  
4 (7) grant in part and deny in part Specialized’s motion for summary judgment; and (8) grant in  
5 part and deny in part Icon’s motion for summary judgment.

6 **I. BACKGROUND**

7 In this patent infringement action involving bicycle seats, Icon alleges that bicycle seats  
8 manufactured, sold, and/or offered for sale by Specialized infringe two of its patents, U.S. Patent  
9 No. 6,254,180 (the “’180 patent”) and U.S. Patent No. 6,378,938 (the “’938 patent”). ECF No. 1.  
10 Specifically, Icon asserts that the accused saddles infringe Claims 1, 3-6, 12, 14, 15, 17, 21, and 22  
11 of the ’180 patent and Claims 1-3, 5, and 11-14 of the ’938 patent.

12 The ’180 patent, entitled “Bicycle Seat,” claims a support system that includes two buttock  
13 support portions. The support portions are coupled to a front portion and can be separated by a  
14 longitudinal slot. A hinge between each of the support portions and the front portion allows each  
15 support portion to undergo substantially independent arcuate movement having a component at  
16 least in a substantially vertical plane when the rider is sitting on the support portions and pedaling.  
17 The seat may be formed as a unitary shell, which may be covered by upholstery. Also, the seat  
18 may include stop means to limit the amount of movement of the support portions. A mounting rail  
19 may be coupled to the lower surface of the shell, and the front portion of the seat may have an  
20 undercut to secure this mounting rail.

21 The ’938 patent, entitled “Cycle Seat,” claims a bicycle seat comprising (1) an inclined  
22 abutment means dimensioned to receive only the portion of the rider’s anatomy adjacent to the  
23 ischial bones, so that soft tissue substantially outside the ischial bones is not compressed by the  
24 seat; and (2) support means that couple the seat to the bicycle so that the abutment means is  
25 permanently transverse with respect to the longitudinal axis of the bicycle. This arrangement  
26 means that, without other supports, it is not possible for a rider in a generally vertical position to  
27 permanently sit on the seat. The seat may consist of metal and plastic and may be padded for  
28 comfort.

1           The parties have each filed motions for summary judgment, and have collectively filed six  
2 motions to exclude expert testimony. The Court will first consider the motions to exclude, and  
3 then turn to the summary judgment motions.

4       **II.     JURISDICTION**

5           The Court has jurisdiction over this action for patent infringement pursuant to 28 U.S.C.  
6 § 1338.

7       **III.    MOTIONS TO EXCLUDE TESTIMONY**

8           **A.     Legal Standard**

9           Federal Rule of Evidence 702 provides:

10                   A witness who is qualified as an expert by knowledge, skill,  
11                   experience, training, or education may testify in the form of an  
                          opinion or otherwise if:

- 12                           (a) the expert’s scientific, technical, or other specialized  
                                  knowledge will help the trier of fact to understand the  
13                           evidence or to determine a fact in issue;  
                                  (b) the testimony is based on sufficient facts or data;  
14                           (c) the testimony is the product of reliable principles and  
                                  methods; and  
15                           (d) the expert has reliably applied the principles and methods  
                                  to the facts of the case.

16           The law of the regional circuit governs a district court’s evaluation of expert testimony in  
17 patent cases. See Micro Chem., Inc. v. Lextron, Inc., 317 F.3d 1387, 1390-91 (Fed. Cir. 2003)  
18 (whether to admit expert testimony is a procedural question that is not unique to patent law and is  
19 governed by the law of the regional circuit). In the Ninth Circuit, Rule 702 “contemplates a broad  
20 conception of expert qualifications.” Hangarter v. Provident Life & Accident Ins. Co., 373 F.3d  
21 998, 1015 (9th Cir. 2004) (quoting Thomas v. Newton Int’l Enters., 42 F.3d 1266, 1269 (9th Cir.  
22 1994)). “Shaky but admissible evidence is to be attacked by cross examination, contrary evidence,  
23 and attention to the burden of proof, not exclusion.” Primiano v. Cook, 598 F.3d 558, 564 (9th  
24 Cir. 2010). To testify as an expert, an individual “need not be officially credentialed in the  
25 specific matter under dispute.” Massok v. Keller Indus., Inc., 147 F. App’x 651, 656 (9th Cir.  
26 2005) (citing United States v. Garcia, 7 F.3d 884, 889-90 (9th Cir. 1993)).

27           On the other hand, “[u]nder Daubert, the trial court must act as a ‘gatekeeper’ to exclude  
28 junk science that does not meet Federal Rule of Evidence 702’s reliability standards.” Ellis v.

1 Costco Wholesale Corp., 657 F.3d 970, 982 (9th Cir. 2011) (citing Kumho Tire Co. v. Carmichael,  
2 526 U.S. 137, 145, 147-49 (1999)); see Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579  
3 (1993). To satisfy Daubert, scientific evidence must be both reliable and relevant. 509 U.S. at  
4 590-91, 597. The proponent of the expert bears the burden of proving admissibility. Lust By &  
5 Through Lust v. Merrell Dow Pharm., Inc., 89 F.3d 594, 598 (9th Cir. 1996).

6 The law pertaining to Daubert's reliability prong has been summarized as follows:

7 Reliable testimony must be grounded in the methods and procedures  
8 of science and signify something beyond "subjective belief or  
9 unsupported speculation." Daubert, 509 U.S. at 590. The inferences  
10 or assertions drawn by the expert must be derived by the scientific  
11 method. Id. In essence, the court must determine whether the  
12 expert's work product amounts to "good science." Daubert v.  
13 Merrell Dow Pharms., Inc., 43 F.3d 1311, 1315 (9th Cir. 1995)  
14 ("Daubert II") (quoting Daubert, 509 U.S. at 593). In Daubert, the  
15 Supreme Court outlined factors relevant to the reliability prong,  
16 including: (1) whether the theory can be and has been tested;  
17 (2) whether it has been subjected to peer review; (3) the known or  
18 potential rate of error; and (4) whether the theory or methodology  
19 employed is generally accepted in the relevant scientific  
20 community." Daubert, 509 U.S. at 593-94. The Supreme Court  
21 emphasized the "flexible" nature of this inquiry. Id. at 594. As later  
22 confirmed in Kumho Tire, "Daubert's list of specific factors neither  
23 necessarily nor exclusively applies to all experts or in every case.  
24 Rather the law grants a district court the same broad latitude when it  
25 decides how to determine reliability as [the court] enjoys in respect  
26 to its ultimate reliability determination." 526 U.S. at 141-42.

18 Abarca v. Franklin Cnty. Water Dist., 761 F. Supp. 2d 1007, 1021 (E.D. Cal. 2011). "The  
19 relevance prong under Daubert means that the evidence will assist the trier of fact to understand or  
20 determine a fact in issue." Henricksen v. ConocoPhillips Co., 605 F. Supp. 2d 1142, 1154 (E.D.  
21 Wash. 2009) (citing Daubert, 509 U.S. at 591-92).

22 **B. Defendant's Motion Pursuant to F.R.E. 702/Daubert to Exclude the Opinions  
23 of Dr. Timothy Harrigan (ECF No. 152)**

24 Specialized seeks an order excluding all opinions and testimony of Icon's expert, Dr.  
25 Timothy Harrigan, relating to (1) his manual testing of bicycle seats and (2) finite element  
26 modeling ("FEA"), which is a computer-based analysis method. ECF No. 152. Specialized  
27 contends that Harrigan's manual testing of saddles is unreliable and irrelevant because it does not  
28 involve measurements, criteria, or controls; because it is based on his subjective determinations;

1 and because it is unrelated to the loading that occurs during rider pedaling. Id. at 3. Specialized  
2 contends that the FEA model analyses are unreliable and irrelevant because they are based on  
3 incorrect assumptions regarding the structure and materials of the saddles and because Harrigan  
4 applied arbitrary loads that are not representative of the loads that occur during rider pedaling. Id.  
5 Specialized does not argue that Harrigan is not qualified to be an expert in this case.

6 **1. Manual Testing**

7 In order to assess whether the accused Specialized saddles infringe the relevant claims,  
8 Harrigan “visually studied the structural design” of the accused saddles and “manually tested”  
9 each one “by providing a load to the hinge on each of the saddles to observe and consider their  
10 mechanical characteristics.” Expert Report of Timothy P. Harrigan ScD MBA PE (“Harrigan  
11 Report”), ECF No. 194-1 at 7. He “then observed the deflection characteristics at the hinge  
12 regions and the support portions resulting from the load.” Id. He also “observed test riders on  
13 each of the accused Specialized saddles to assess how each rider would be positioned on the  
14 saddle, the interactions between the rider and the saddle, and the deflection characteristics of the  
15 saddle.” Id.

16 The thrust of Specialized’s argument is that this analysis must be excluded because it is not  
17 sufficiently scientific — Harrigan’s methodology has not been tested or peer-reviewed, and he did  
18 not take notes or collect data. But “Daubert’s list of specific factors neither necessarily nor  
19 exclusively applies to all experts or in every case.” Kumho Tire, 526 U.S. at 141; see also City of  
20 Pomona v. SQM N. Am. Corp., 750 F.3d 1036, 1044 (9th Cir. 2014) (“[T]hese factors are meant  
21 to be helpful, not definitive, and the trial court has discretion to decide how to test an expert’s  
22 reliability as well as whether the testimony is reliable, based on the particular circumstances of the  
23 particular case.” (internal quotation marks omitted)).

24 Here, Harrigan was tasked with assessing the structural characteristics of bicycle seats, and  
25 in particular with determining whether they include a “flexible area” that “allow[s] flexing to  
26 occur between each of the first and second support portions and the front portion so that each of  
27 the first and second support portions undergo substantially independent arcuate movement.”  
28 Order Construing Claims of United States Patent Nos. 6,254,180 and 6,378,938 (“Claim

1 Construction Order”), ECF No. 70 at 18. In this circumstance, the Court finds “it to be a matter of  
2 common sense” that a visual and manual inspection would be one acceptable way for a  
3 mechanical engineer to assess the structural characteristics of a bicycle seat. Correa v. Cruisers, a  
4 Div. of KCS Int’l, Inc., 298 F.3d 13, 26 (1st Cir. 2002). The Court concludes that Harrigan’s  
5 opinions based on his manual testing of bicycle saddles meet Daubert’s reliability and relevance  
6 requirements. Of course, the Daubert test “is not the correctness of the expert’s conclusions but  
7 the soundness of his methodology.” City of Pomona, 750 F.3d at 1044. Harrigan’s testimony will  
8 be open to attack on cross-examination, and it will be up to the jury to decide the appropriate  
9 weight to give this evidence.

10 **2. FEA Analyses**

11 Specialized does not argue that FEA is “junk science” or that it is never an appropriate  
12 methodology for testing the structural characteristics of bicycle saddles. Rather, Specialized  
13 contends that Harrigan’s analyses are not relevant or reliable because they are based on incorrect  
14 assumptions regarding the structure and materials of the saddles; because he erroneously modeled  
15 only one representative accused saddle and extrapolated his conclusions to cover all of the accused  
16 saddles; and because he applied arbitrary loads that are not representative of the loads that occur  
17 during rider pedaling. ECF No. 152 at 3, 18.

18 In his report, Harrigan explains that, in his opinion, “the variations of the material, size,  
19 and design of the accused Specialized saddles do not create any meaningful difference as it relates  
20 to [his] infringement analysis because all of the . . . accused Specialized saddles have similar  
21 physical characteristics.” Harrigan Report at 11, 25. He testified at his deposition that although  
22 the structure and materials of the saddles did differ from the inputs he used in his FEA analyses,  
23 these differences “didn’t matter” because they had no effect on the pattern of deformations that  
24 demonstrated the presence of the hinge specified in the claim language. Deposition of Timothy P.  
25 Harrigan (“Harrigan Dep.”), ECF No. 192-3 at 229-40. He explained, “In my professional opinion  
26 based on 30 years of doing finite element modeling, I didn’t need that degree of accuracy to assess  
27 the coupling between the two sides, or the lack of it.” Id. at 234. However, he did admit, “[I]f I  
28 had to do it again, I would just put in the right modulus.” Id. at 239. With respect to the loads

1 used in the FEA analyses, Harrigan acknowledged that he used an “isolated simplified load” to  
2 assess coupling. Id. at 243-44.

3 Harrigan is an expert in “computational modeling in biomechanics” who has “used, relied  
4 on and developed finite element modeling throughout [his] career.” Harrigan Report at 2. He  
5 acknowledges that the inputs he used in his computer modeling of the accused and prior art  
6 saddles do not create perfect models of these objects, but he opines that his models are accurate  
7 enough to inform his opinions concerning whether the saddles include a hinge allowing  
8 independent, arcuate movement of the support portions. Icon emphasizes that a numerical model  
9 is valid “if the assumptions in the model are appropriate for the answer being sought,” and in this  
10 case, Harrigan needed only to determine whether a hinge exists, not measure specific amounts of  
11 deformation. ECF No. 190 at 21. Taking into account Harrigan’s report and testimony  
12 concerning the level of precision necessary for an FEA analysis to be helpful in this situation, the  
13 Court concludes that Harrigan’s opinions will assist the trier of fact and that they are sufficiently  
14 reliable to be admissible under Rule 702. This is the type of “[s]haky but admissible evidence”  
15 that must “be attacked by cross examination, contrary evidence, and attention to the burden of  
16 proof, not exclusion.” Primiano, 598 F.3d at 564.

17 **C. Plaintiff’s Motion to Exclude Stephen M. Werner, Ph.D., P.E. (ECF No. 168)**

18 Plaintiff seeks an order excluding the testimony and opinions of Specialized’s expert, Dr.  
19 Stephen M. Werner, concerning indefiniteness, obviousness, and anticipation. ECF No. 168 at 1.  
20 Icon argues that: (1) Werner’s testimony regarding indefiniteness of the ’180 patent is untimely;  
21 (2) Werner’s invalidity opinions are conclusory; (3) Werner applied a legally erroneous  
22 methodology to determine that the claims of the ’938 patent are anticipated by prior art;  
23 (4) Werner should be precluded from arguing that U.S. Patent No. 4,369,998 to Blase (“Blase”),  
24 PCT Application No. PCT/EP95/01086 (“Urban”), and U.S. Patent No. 4,063,775 to Mesinger  
25 (“Mesinger”) have a hinge; (5) Werner should be precluded from relying on Exhibits S and T to  
26 his expert report because they are not prior art; (6) the physical saddles examined by Werner are  
27 not prior art; (7) Werner should not be permitted to reference litigation concerning foreign  
28 counterparts to the asserted patents; (8) Werner should be precluded from relying on Italian Patent

1 App. No. MI91 A 002879 (“Cassani”) and a patent issued in 1895 to Perry (“Perry”) as prior art;  
2 (9) Werner should be precluded from relying on the combination of each of U.S. Patent No.  
3 5,011,222 to Yates (“Yates”) and U.S. Patent No. 4,429,915 to Flager (“Flager”) with U.S. Patent  
4 No. 4,108,462 to Martin (“Martin”) as rendering the ’938 patent obvious; and (10) Werner’s non-  
5 infringement opinions regarding the ’180 patent should be excluded because they include  
6 improper legal argument concerning claim construction. ECF No. 168 at i-ii. Icon does not attack  
7 Werner’s qualifications as an expert. The Court considers these arguments in turn.

8 **1. Timeliness of Indefiniteness Defense**

9 Icon contends that Werner’s testimony that the ’180 patent is indefinite must be excluded  
10 because this testimony should have been disclosed at the claim construction stage. ECF No. 168  
11 at 3. Following the parties’ lead, the Court will address this issue below in connection with its  
12 discussion of Icon’s motion for summary judgment.

13 **2. Whether Invalidity Opinions are Conclusory**

14 Icon contends that Werner’s opinions concerning invalidity are conclusory and therefore  
15 impermissible under Federal Rule of Civil Procedure 26, Federal Rule of Evidence 702, and  
16 Daubert. ECF No. 168 at 4. First, Icon argues that Werner’s opinion that a person of ordinary  
17 skill in the art “would have at least a college degree and, in addition, have some educational  
18 training in engineering or several years of experience in mechanical design” is an unsupported  
19 conclusion because Werner does not discuss the factors he considered to reach that conclusion.  
20 ECF No. 168 at 4-5 (quoting Expert Report of Stephen M. Werner, Ph.D., P.E. (“Werner Report”),  
21 ECF No. 154-1 ¶¶ 28, 147). The Court finds that Werner’s identification of the level of ordinary  
22 skill in the art is proper. See Neutrino Dev. Corp v. Sonosite, Inc., 410 F. Supp. 2d 529, 536 (S.D.  
23 Tex. 2006) (expert’s statement that “she considered the level of ordinary skill in the art to be a  
24 person who ‘has been trained and passed one’s credentialing examinations’ . . . is sufficient to  
25 allow the jury to determine whether this is the appropriate level of ordinary skill in the art”). None  
26 of the cases Icon cites stand for the proposition that an expert’s report must include a discussion of  
27 the factors he used to evaluate the level of ordinary skill in the art. See Gen. Elec. Co. v. Joiner,  
28 522 U.S. 136, 146 (1997); Envntl. Designs, Ltd. v. Union Oil Co. of California, 713 F.2d 693, 696-



1 97 (Fed. Cir. 1983); Elder v. Tanner, 205 F.R.D. 190, 193 (E.D. Tex. 2001).

2 Icon also contends that Werner’s testimony that the ’180 and ’938 patents are obvious is  
3 conclusory because he does not explain how or why the prior art references he discusses (i.e. the  
4 commercially sold Mythos saddle with Blase, Urban, or Mesinger; and Yates or Flager in  
5 combination with Martin) would be combined. ECF No. 168 at 5-8. Icon argues that Werner has  
6 therefore failed to comply with the disclosure requirements of Federal Rule of Civil Procedure  
7 26(a)(2)(B) and the requirements for admissible expert testimony under Federal Rule of Evidence  
8 702 and Daubert. Icon further accuses Werner of improperly “using the invention as a roadmap to  
9 find its prior art components,” rather than considering the claimed invention “as a whole.” Ruiz v.  
10 A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004).

11 Upon review of Werner’s report, the Court concludes that his obviousness analysis is  
12 sufficient. Werner adequately discloses the precise prior art references that would be combined  
13 and how and why these combinations would be made. The Court will not discount Werner’s  
14 obviousness opinions on the basis that, at his deposition, he agreed “in general” with counsel’s  
15 suggestion that he “used the claims as a road map to find the - find the elements in the prior art.”  
16 Deposition of Stephen M. Werner, Ph.D, P.E. (“Werner Dep.”), ECF No. 168-5 at 19. In Ruiz, the  
17 Federal Circuit emphasized the importance of assessing the invention “as a whole,” rather than  
18 finding a prior art reference containing each component part “and on that basis alone declar[ing]  
19 the invention obvious.” 357 F.3d at 1275. Ruiz does not proscribe looking for individual claim  
20 elements in the prior art, and Werner’s deposition testimony does not establish that he failed to  
21 consider the inventions as a whole.

22 Third, Icon attacks Werner’s anticipation opinions as insufficiently detailed, and his claim  
23 charts as improper because, Icon contends, counsel prepared them. ECF No. 168 at 8-10. The  
24 Court concludes that the claim charts appended to Werner’s report are sufficiently detailed to  
25 satisfy Specialized’s disclosure requirements and to establish that his opinions will be helpful to  
26 the jury. The Court will not exclude Werner’s anticipation opinions based on Icon’s allegation  
27 that Werner did not prepare his own claim charts. Werner testified that “other than the  
28 formatting,” the charts are his original work product. Werner Dep. at 15. It is not surprising that

1 the charts are similar to claim charts prepared by counsel earlier in the litigation, as these charts  
2 necessarily address the same claims and prior art references.

3 **3. Anticipation of the '938 Patent**

4 Icon argues that Werner's opinion that the claims of the '938 patent are anticipated by  
5 Martin, U.S. Patent No. 5,286,082 to Hanson ("Hanson"), Yates, Flager, Cassani, and the  
6 commercially sold Mythos, Flite and Turbo saddles is flawed because it is based on the argument  
7 that the patent is anticipated if it is infringed by the accused product, and this argument has been  
8 expressly rejected by the Federal Circuit. See Tate Access Floors, Inc. v. Interface Architectural  
9 Res., Inc., 279 F.3d 1357, 1367 (Fed. Cir. 2002); Zenith Elecs. v. PDI Commc'n Sys., 522 F.3d  
10 1348, 1363 (Fed. Cir. 2008). ECF No. 168 at 10-12. Werner's analysis is distinguishable from  
11 the approach proscribed in Tate and Zenith. He does not argue that the '938 patent is invalid  
12 because the prior art is identical to an infringing product. See Zenith, 522 F.3d at 1363. Rather,  
13 he assumes that Icon's understanding of the construed claims is correct, and then proceeds to  
14 demonstrate how, in his opinion, each element of the claims is found in the prior art. He does not  
15 dodge the claim language and simply compare the accused product to the prior art, as Tate and  
16 Zenith forbid.

17 **4. Hinges in Blase, Urban, and Mesinger**

18 Icon argues that Werner should be precluded from opining that Blase, Urban, and  
19 Mesinger include a hinge because he has not identified the hinge area in each reference. ECF No.  
20 168 at 12-13. Werner's report recites the Court's construction of the hinge terms, describing a  
21 flexible area separating each of the support portions from the front portion to allow flexing to  
22 occur between each of the first and second support portions and the front portion so that each of  
23 the first and second support portions undergo substantially independent arcuate movement.  
24 Werner Report ¶ 54. Werner then describes Blase, Urban, and Mesinger, using words and figures,  
25 and states that each has a front portion, two support portions, and hinges allowing this movement.  
26 Id. ¶¶ 58-81. This is sufficient to put Icon on notice that Werner will opine that Blase, Urban, and  
27 Mesinger each include hinges, i.e. flexible areas located between the front and support portions of  
28 the saddle. Icon apparently faults Werner for failing to draw arrows to the central parts of the

1 bicycle seats in his figures, as he did in his depictions of the prior art commercial saddles, *id.* ¶ 82,  
2 but the Court will not exclude his opinion that these prior art references disclose hinges on this  
3 basis.

4 **5. Exhibits S and T**

5 Icon contends that Exhibits S and T to Werner’s expert report, as well as paragraphs 88,  
6 89, and 93 of the report and any related testimony, should be excluded because these exhibits are  
7 not, on their face, prior art publications under 35 U.S.C. § 102(b). ECF No. 168 at 13-14.  
8 Following the parties’ lead, the Court will address this issue below in its discussion of Icon’s  
9 motion for summary judgment.

10 **6. Physical Saddles**

11 Icon contends that the portions of Werner’s report in which he relies on physical prior art  
12 saddles must be stricken because Specialized and Werner cannot establish that the saddles Werner  
13 examined were sold, offered for sale, or publicly available more than one year prior to the  
14 effective filing dates of the patents, and therefore they cannot be considered prior art under 35  
15 U.S.C. § 102(b). ECF No. 168 at 14-16. This question will also be addressed below in the  
16 Court’s discussion of Icon’s motion for summary judgment.

17 **7. Litigation of Foreign Counterparts**

18 Icon asserts that Werner’s opinions should be excluded to the extent he relies on materials  
19 from litigation in Italy concerning related patents, because these materials are irrelevant to the  
20 asserted U.S. patents and the U.S. patent law at issue in this case. ECF No. 168 at 17-18. It is true  
21 that “the theories and laws of patentability vary from country to country, as do examination  
22 practices” and that “[c]aution is required” when considering foreign patent proceedings,  
23 Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072 n.2  
24 (Fed Cir. 1994), but it does not follow that descriptions of the prior art in Icon’s Italian technical  
25 report and the factual findings of the Italian expert with respect to the prior art are not relevant.  
26 The Court will “not defer to decisions in foreign courts or patent offices on questions of validity.”  
27 Oki Am., Inc. v. Advanced Micro Devices, Inc., No. 04-cv-03171-CRB, 2006 WL 3290577, at \*8  
28 n. 2 (N.D. Cal. Nov. 13, 2006). But it will not exclude all opinions based in part upon materials

1 introduced in related litigation abroad.

2 **8. Cassani and Perry**

3 Icon challenges Werner’s reliance on the Cassani and Perry patents because they were not  
4 included in Specialized’s invalidity contentions. ECF No. 168 at 18-20. Specialized agrees that  
5 Werner may not rely on Perry, but seeks permission to amend its invalidity contentions to include  
6 Cassani. ECF No. 185 at 14. Specialized explains that after the Court issued its claim  
7 construction order, the parties stipulated to amendments to their respective contentions and  
8 Specialized disclosed to Icon a detailed claim chart on the Cassani reference. Id. When  
9 Specialized filed its amended contentions, however, this chart was inadvertently omitted. Id.  
10 Specialized’s request to amend its invalidity contentions comes extremely late, after the close of  
11 discovery, and is therefore denied. The Cassani claim chart attached to Werner’s report and  
12 Werner’s opinions regarding Cassani shall be stricken.

13 **9. Yates and Flager with Martin**

14 Icon also contends that the combination of each of Yates and Flager with Martin was not  
15 disclosed in Specialized’s invalidity contentions as rendering the ’938 patent obvious. ECF No.  
16 168 at 20. This issue will be addressed below in the Court’s discussion of Icon’s motion for  
17 summary judgment.

18 **10. Argument Regarding Non-infringement of ’180 Patent**

19 Finally, Icon contends that Werner’s non-infringement opinions regarding the ’180 patent  
20 include improper legal argument concerning the proper construction of the “hinge” terms and  
21 improper comparison of the embodiments in the specification with the accused products. ECF  
22 No. 168 at 20-24. Icon seeks to exclude the opinions contained in Sections VI.C.1-2 of Werner’s  
23 Rebuttal Report on this basis. ECF No. 203 at 13 n.1. See Rebuttal Expert Report of Stephen M.  
24 Werner (“Werner Rebuttal Report”), ECF No. 168-8. Specialized responds that Werner properly  
25 adopted the Court’s claim constructions and simply provided his non-infringement opinions based  
26 on how a person of ordinary skill in the art would understand the Court’s constructions. ECF No.  
27 185 at 15-18. In particular, Specialized notes that the Court did not construe “substantially  
28 independent arcuate movement,” and contends that it is appropriate for Werner to provide his

1 opinion that the accused saddles do not move enough to have a hinge that allows this degree of  
2 flexing. Id. at 16.

3 The construction of claims in light of the specification and prosecution history is a  
4 question for the court, not for the jury. Markman v. Westview Instruments, Inc., 517 U.S. 370,  
5 387 (1996). At trial, parties may introduce evidence as to the plain and ordinary meaning of terms  
6 not construed by the court, as long as the evidence does not amount to arguing claim construction  
7 to the jury. MediaTek Inc. v. Freescale Semiconductor, Inc., No. 11-cv-5341-YGR, 2014 WL  
8 971765, at \*4 (N.D. Cal. Mar. 5, 2014). “Arguing claim construction to the jury is inappropriate  
9 because it risks confusion and the likelihood that a jury will render a verdict not supported by  
10 substantial evidence.” Id. (quoting Apple v. Samsung, No. 12-cv-630-LHK, 2014 WL 660857, at  
11 \*3 (N.D. Cal. Feb. 20, 2014)); see also Cordis Corp. v. Boston Scientific Corp., 561 F.3d 1319,  
12 1337 (Fed. Cir. 2009) (“We have held that it is improper to argue claim construction to the jury  
13 because the risk of confusing the jury is high when experts opine on claim construction.” (internal  
14 quotation marks omitted)). In Mediatek, the court excluded an expert’s opinions as improperly  
15 arguing claim construction to the jury where the expert “relie[d] heavily on the prosecution  
16 history, specifications, and even provisional applications to explain and expound upon a specific  
17 meaning and/or requirements of the terms identified.” Id. at \*5. Here, the Court concludes that  
18 the challenged portions of Werner’s Rebuttal Report, which rely heavily on Werner’s  
19 interpretation of the specifications and preferred embodiments of the ’180 patent, similarly include  
20 improper claim construction arguments. Icon’s motion to exclude these opinions is therefore  
21 granted.

22 **D. Plaintiff’s Motion to Exclude James McIlvain and Paragraphs 90, 104, 106,**  
23 **127, 159, 163, 194 and 203 of the Expert Rebuttal Report of Jeffrey Kinrich (ECF No. 169)**

24 Icon moves for an order excluding the expert report and testimony of James McIlvain and  
25 the portions of the Expert Rebuttal Report of Jeffrey Kinrich that rely on McIlvain’s opinions.  
26 ECF No. 169 at 1-2. Icon contends that McIlvain is not an expert on the commercial success of  
27 Specialized’s saddles or demand for Specialized’s saddles compared to Nelson’s saddles, and that  
28 his opinions are unreliable and irrelevant because they are based on his subjective beliefs.

1           “The Ninth Circuit has found opinions based on an expert’s experience in the industry to  
2 be proper: ‘When evaluating specialized or technical expert opinion testimony, the relevant  
3 reliability concerns may focus upon personal knowledge or experience.’” GSI Tech., Inc. v.  
4 Cypress Semiconductor Corp., No. 11-cv-03613-EJD, 2015 WL 364796, at \*2 (N.D. Cal. Jan. 27,  
5 2015) (quoting United States v. Sandoval-Mendoza, 472 F.3d 645, 655 (9th Cir. 2006)).  
6 “Subjective beliefs and opinions are proper expert testimony.” Id. Here, McIlvain has extensive  
7 experience in the cycling equipment industry as journalist for and editor of cycling magazines. In  
8 this role, he has conducted product reviews and comparisons of cycling gear. His experience in  
9 the industry qualifies him to testify about his impressions of the Specialized and Nelson saddles he  
10 tested. See United States v. Brooks, 610 F.3d 1186, 1195-96 (9th Cir. 2010) (“The fact that  
11 Detective Hein lacked an advanced degree, supervisory experience, previous experience as an  
12 expert witness, or relevant publications did not render her unfit to provide expert testimony.”).

13           The Court concludes that McIlvain’s opinions will be helpful to the jury and that they are  
14 sufficiently reliable to be admissible. The weight to be accorded his testimony, in view of the fact  
15 that McIlvain does not purport to have a sophisticated understanding of patent law or engineering,  
16 did not consult other experts, and did not conduct any type of market study in forming his  
17 opinions, is a question for the jury. See Alaska Rent-A-Car, Inc. v. Avis Budget Grp, Inc., 738  
18 F.3d 960, 969-70 (9th Cir. 2013) (“Basically, the judge is supposed to screen the jury from  
19 unreliable nonsense opinions, but not exclude opinions merely because they are impeachable. The  
20 district court is not tasked with deciding whether an expert is right or wrong, just whether his  
21 testimony has substance such that it would be helpful to a jury.”).

22           Because the Court denies this motion insofar as it seeks the exclusion of McIlvain’s  
23 opinions, it also denies Icon’s request to exclude any opinions of Kinrich that rely on McIlvain.

24           **E. Plaintiff’s Motion to Exclude the Testimony of Stephen G. Kunin and Bar**  
25 **Testimony Attacking the Competency of the Patent Office about Patent Law or Practice**  
26 **(ECF No. 170)**

27           Icon seeks an order excluding the testimony of Specialized’s expert, Stephen G. Kunin,  
28 who plans to explain the policies, practices, and procedures of the U.S. Patent and Trademark

1 Office (“PTO”); describe the prosecution history of the ’180 patent; and express his opinion as to  
2 the proper level of deference to be given to the PTO in view of this file history. ECF No. 170 at 1,  
3 10; see Expert Report of Stephen G. Kunin (“Kunin Report”), ECF No. 170-2.

4 The Court will permit Kunin, who spent more than thirty-four years working at the PTO, to testify  
5 about the general practices and procedures of that office. See Szoka v. Woodle, No. 02-cv-5524,  
6 2004 WL 5512964, at \*3 (N.D. Cal. June 7, 2004) (“Given the complexity of patent litigation,  
7 courts have regularly permitted expert testimony by patent attorneys on a range of issues,  
8 including proceedings before the Patent and Trademark Office (PTO)”); see also Bausch & Lomb,  
9 Inc. v. Alcon Labs., Inc., 79 F. Supp. 2d 252, 256 (W.D.N.Y. 2000) (“Obviously PTO procedures  
10 are foreign to the average person, and it may be helpful to the jury to hear someone experienced in  
11 those procedures explain how they operate in terms that a layperson can understand.”). Kunin  
12 may also testify about the particular patent application at issue, to the extent that Specialized seeks  
13 to present evidence that there were defects in the process and to suggest that deference to the  
14 PTO’s determination may not be appropriate in this case. Bristol-Myers Squibb v. Rhone-Poulenc  
15 Rorer, 326 F.3d 1226, 1235 n.8 (Fed. Cir. 2003); Bausch & Lomb, 79 F. Supp. 2d at 255. When a  
16 challenger “has evidence that there actually were defects in the particular application process at  
17 issue in this case, thus suggesting that deference to the PTO’s determination may not be  
18 appropriate, it may seek to offer such evidence.” Bausch & Lomb, 79 F. Supp. 2d at 255.

19 Kunin may not, however, offer generalized testimony about quotas, time pressures, or the  
20 problems examiners generally face in completing their work at the PTO, as “the purpose of this  
21 testimony would be to attempt to undermine the presumption of validity under 35 U.S.C. § 282 by  
22 inviting the jury to speculate about possible defects, errors, or omissions in the application process  
23 that led to the issuance of the patent-in-suit.” Bausch & Lomb, 79 F. Supp. 2d at 255-56; see also  
24 Applied Materials, Inc. v. Advanced Semiconductors Materials Am., Inc., No. 92-20643, 1995  
25 WL 261407, at \*3 (N.D. Cal. April 25, 1995) (“Testimony about overwork, quotas, awards or  
26 promotions at the Patent Office, or the number of patents that issue annually or insinuating that the  
27 Patent Office does not do its job properly is . . . irrelevant speculation and would constitute an  
28 inappropriate attack on the Patent Office.”). Kunin also may not speculate about what the PTO

1 would have done had specific prior art references been brought to the examiner’s attention or offer  
2 legal opinions about the appropriate level of deference to be given to the PTO’s determination of  
3 patentability in this case. See Daubert, 509 U.S. at 599 (requiring more than “subjective belief or  
4 unsupported speculation” from expert testimony); United States v. Weitzenhoff, 35 F.3d 1275,  
5 1287 (9th Cir. 1993) (“It is well settled . . . that the judge instructs the jury in the law.”); Applied  
6 Materials, 1995 WL 261407, at \*3 (excluding former Patent Office employee’s testimony about  
7 what an examiner would have done if he had different information).

8 **F. Defendant’s Motion Pursuant to F.R.E. 702/Daubert to Exclude the Expert**  
9 **Testimony of Frank Bernatowicz (ECF No. 171)**

10 Specialized seeks an order excluding the reasonable royalty opinions of Icon’s damages  
11 expert, Frank Bernatowicz, on the basis that they are based on unreliable methodologies and rely  
12 on inappropriate evidence, no evidence, or evidence made up by Bernatowicz. ECF No. 171 at 2.  
13 Specifically, Specialized contends that Bernatowicz’s opinion that the patented inventions are the  
14 “driving factor” of Specialized’s accused sales is unsupported and unreliable; Bernatowicz’s  
15 determination of the baseline royalty rate is fundamentally flawed; Bernatowicz’s Georgia Pacific  
16 analysis is arbitrary and unreliable; Bernatowicz’s apportionment analysis is fundamentally  
17 flawed; Bernatowicz improperly failed to separately analyze the two patents-in-suit; and  
18 Bernatowicz’s report violates Federal Rule of Civil Procedure 26 because he failed to disclose the  
19 basis for statements that are fundamental to his opinions and because he failed to disclose phone  
20 conversations with other witnesses that he considered and relied upon in forming his opinions.  
21 Specialized does not challenge Bernatowicz’s qualifications as a damages expert or argue that his  
22 opinions are irrelevant. Rather, Specialized urges that Bernatowicz’s opinions should be excluded  
23 because they are “unsupported, unreliable, or grounded in junk science.” ECF No. 171 at 22.

24 Bernatowicz is a Certified Public Accountant, a Registered Professional Engineer, and an  
25 experienced damages expert. In preparing his damages report, he utilized the Georgia Pacific  
26 framework to calculate a reasonable royalty based upon a hypothetical negotiation between a  
27 willing licensor and licensee. Expert Report of Frank A. Bernatowicz (“Bernatowicz Report”),  
28 ECF No. 223-7 ¶¶ 35-114; see Georgia-Pacific Corp. v. U.S. Plywood Corp., 318 F. Supp. 1116,



1 1120 (S.D.N.Y. 1970). The Court notes at the outset that “any reasonable royalty analysis  
2 ‘necessarily involves an element of approximation and uncertainty.’” Lucent Techs., Inc. v.  
3 Gateway, Inc., 580 F.3d 1301, 1325 (Fed Cir. 2009) (quoting Unisplay, S.A. v. Am. Elec. Sign  
4 Co., Inc., 69 F.3d 512, 517 (Fed. Cir. 1995)). “Shaky but admissible evidence is to be attacked by  
5 cross examination, contrary evidence, and attention to the burden of proof, not exclusion.”  
6 Primiano, 598 F.3d at 564.

7 The Court concludes that most of Specialized’s criticisms of Bernatowicz’s opinions go to  
8 the weight that a jury should give his opinions, rather than their admissibility, and that these  
9 arguments are therefore improper bases to exclude Bernatowicz’s expert opinions. In particular,  
10 “the question of a reasonable royalty rate and the similarity of licensing agreements as a basis of  
11 reference for arriving at a reasonable royalty rate, are questions of fact.” Sargent Mfg. Co. v. Cal-  
12 Royal Prods., Inc., No. 08-cv-408 (VLB), 2012 WL 3101691, at \*6 (D. Conn. July 27, 2012)  
13 (citing Uniloc USA, Inc. v. Microsoft Corp., 632 F.3d 1292 (Fed. Cir. 2011); ResQNet.com, Inc.  
14 v. Lansa, Inc., 594 F.3d 860, 869 (Fed. Cir. 2010)); see also Virnetx, Inc. v. Cisco Sys., Inc., 767  
15 F.3d 1308, 1331 (Fed Cir. 2014) (explaining that “the degree of comparability” of license  
16 agreements was a factual issue best addressed by cross examination, rather than exclusion, and  
17 that the jury was “entitled to hear the expert testimony and decide for itself what to accept or  
18 reject”).

19 Upon review of Bernatowicz’s report, the Court concludes that his opinions pass muster  
20 under the reliability and relevance requirements of Daubert and Rule 702. Specialized may  
21 challenge Bernatowicz’s conclusions with respect to the “driving factor” of Specialized’s accused  
22 sales, his royalty rate calculations, his apportionment analysis, and his decision to analyze the  
23 patents together based on his assessment of comparable licenses on cross-examination.

24 Specialized also argues that Bernatowicz’s opinions must be excluded because he has  
25 failed to comply with the disclosure requirements of Federal Rule of Civil Procedure 26. ECF No.  
26 171 at 20-22. Courts enforce the disclosure requirement by excluding from use at trial  
27 information that was not properly disclosed, “unless the failure was substantially justified or is  
28 harmless.” Fed. R. Civ. P. 37(c)(1).

1 Specialized argues that Bernatowicz failed to disclose the basis for his statements that the  
2 patented inventions are “important and essential” and “enabled” Specialized to sell accused  
3 saddles, and that the patented inventions confer “comfort and performance,” which is the “driving  
4 factor” for Specialized’s accused sales. ECF No. 171 at 20 (citing Bernatowicz Report ¶ 45).  
5 Icon responds that Bernatowicz’s conclusions “were fully supported by his assessment of the  
6 industry, Specialized’s marketing material, and the patents-in-suit.” ECF No. 196 at 25. With the  
7 exception of the phone conversations discussed below, there is no suggestion in the briefing on  
8 this motion that Bernatowicz will seek to present additional bases for his opinions beyond those  
9 disclosed in his expert report. To the extent that he seeks to do so, Specialized may move for  
10 exclusion of such testimony at that time.

11 Specialized’s argument that Bernatowicz should not be permitted to rely on information  
12 gleaned from conversations with witnesses Paul Nelson, Peter Strover, and Timothy Harrigan is  
13 well-taken. See ECF No. 171 at 20-22. Bernatowicz’s report does not mention these phone  
14 conversations. Specialized apparently learned about them during Bernatowicz’s deposition, which  
15 took place after Harrigan’s deposition. Id. Icon argues that Bernatowicz was not required to  
16 disclose these conversations because they simply provided “a bit more color” to his understanding  
17 of the case, and that any improper failure to disclose was harmless both because Bernatowicz did  
18 not learn any new facts or obtain any new data in these conversations and because Specialized had  
19 the opportunity to question Bernatowicz about them during his deposition. ECF No. 196 at 25.

20 Rule 26 requires expert witnesses to disclose “a complete statement of all opinions the  
21 witness will express and the basis and reasons for them,” as well as “the facts or data considered  
22 by the witness in forming them.” Fed. R. Civ. P. 26(a)(2)(B). To the extent Bernatowicz relied on  
23 these phone conversations as part of the basis of his opinions, they should have been timely  
24 disclosed to Specialized. The Court will therefore grant Specialized’s request to preclude  
25 Bernatowicz from relying on these conversations in his testimony at trial.

26 **G. Plaintiff’s Motion to Exclude Roger Minkow, M.D. (ECF No. 173)**

27 Icon seeks an order excluding the testimony of Specialized’s expert, Roger Minkow, M.D.,  
28 because his opinions are unreliable and will not assist the trier of fact in determining whether the

1 accused products infringe the '938 patent. ECF No 173. Minkow is a medical doctor who has  
2 been a consultant to Specialized on the ergonomics of bicycle seats and other cycling equipment  
3 for more than fifteen years. His rebuttal report responds to the opinion of Icon's expert, Harrigan,  
4 that the accused saddles infringe the asserted claims of the '938 patent. Icon argues that:  
5 (1) Minkow's report is inadmissible because it was written by Specialized's counsel in violation of  
6 Federal Rule of Civil Procedure 26(a)(2)(B)(ii); (2) Minkow failed to apply the proper level of  
7 ordinary skill in the art; (3) Minkow should not be allowed to rely on the pressure map included in  
8 his report; (4) Minkow should not be allowed to testify on the shapes and contours of the accused  
9 saddles; and (5) Minkow should be excluded as a sanction pursuant to Federal Rule of Civil  
10 Procedure 37(c)(1). ECF No. 173 at i.

11 Icon argues first that Minkow's report must be excluded because "the only reasonable  
12 conclusion" from Minkow's deposition testimony is that he did not write his report. ECF No. 209  
13 at 6. See Numatics, Inc. v. Balluff, Inc. & H.H. Barnum Co., No. 13-11049, 2014 WL 7211167, at  
14 \*5-7 (E.D. Mich. Dec. 16, 2014) (excluding the testimony of a proposed expert based on the  
15 "inescapable" conclusion that he "is nothing more than a 'highly qualified puppet' and the  
16 opinions in his report do not reflect his own reasoned views of the case" (citing DataQuill Ltd. v.  
17 Handspring, Inc., No. 01 C 4635, 2003 WL 737785, at \*4 (N.D. Ill. Feb. 28, 2003))). In  
18 particular, Icon contends that at his deposition, Minkow was unable to clearly discuss the opinions  
19 in his report without coaching from Specialized's counsel and admitted that counsel typed the  
20 report for him. ECF No. 173 at 4-5.

21 Having reviewed Minkow's report and testimony, the Court concludes that Minkow's  
22 statements at his deposition do not establish that counsel impermissibly "ghostwrote" Minkow's  
23 report. Minkow testified that "counsel typed the report up," but that "[t]he information in the  
24 report came from me," including "[t]he ergonomics, the illustrations, the interpretation."  
25 Deposition of Roger Minkow, M.D. ("Minkow Dep."), ECF No 184-1 at 8. Minkow  
26 acknowledged that he "didn't write the law portions of this in that vernacular," but insisted that  
27 "the ideas and the illustrations came from me." Id. at 8-9. Because Minkow provided the  
28 information, analyses, and opinions expressed in his report, the Court will not exclude him as

1 “[a]n expert witness who is merely a party’s lawyer’s avatar.”<sup>1</sup> Numatics, 2014 WL 7211167, at  
2 \*3.

3 The Court also finds unconvincing Icon’s argument that Minkow’s opinions must be  
4 excluded because he did not consider the level of ordinary skill in the art. ECF No. 173 at 5-6.  
5 Icon relies on Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356 (Fed Cir. 2008), in  
6 which the Federal Circuit explained:

7 Patent claims are construed from the perspective of one of ordinary  
8 skill in the art. For the purposes of the doctrine of equivalents,  
9 identification of the claim elements as well as the determination of  
10 infringement itself are done from the perspective of one of ordinary  
11 skill in the art. What a prior art reference discloses or teaches is  
12 determined from the perspective of one of ordinary skill in the art.  
13 Whether a patent claim would have been obvious in light of prior art  
14 references is determined from the perspective of one of ordinary  
15 skill in the art.

16 Id. at 1361 n.3 (internal citations omitted). But Minkow presented only a literal infringement  
17 analysis. Specifically, he compared the claims with the accused saddles and gave his opinion  
18 about whether the saddles are contoured to match the shape of the gluteus maximus muscles,  
19 whether they compress soft tissue outside the ischial bones, and whether they permit a rider to sit  
20 upright with his backbone arranged generally vertically. These opinions, presented by a medical  
21 doctor who has extensive experience consulting with Specialized about the ergonomic advantages  
22 of the accused saddles, is relevant, reliable, and will be helpful to the jury. There is no basis to  
23 exclude these opinions because Minkow did not discuss his interpretation of the level of ordinary  
24 skill in the art.

25 The Court will not exclude Minkow’s testimony concerning a “representative” pressure  
26 map of an accused saddle. He testified at his deposition that he has experience reviewing such  
27 pressure maps, that he is generally familiar with the testing performed to produce such maps, and  
28 that he could identify the map in his report as being a pressure map of one of Specialized’s  
saddles. This knowledge is sufficient to satisfy Rule 702’s requirement that an expert opinion  
must be based on “sufficient facts or data” to be presented to the jury. Fed. R. Evid. 702(b). Icon

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<sup>1</sup> Moreover, if this Court excluded every expert whose report included some contribution from  
counsel, there would be very few experts testifying at trial.

1 does not argue that pressure maps are irrelevant or that studying them is an unreliable  
2 methodology – indeed, Icon’s own expert, Harrigan, relies heavily on such maps. Whether  
3 Minkow’s inability to identify precisely which saddle the map represents makes his testimony less  
4 credible is a question for the jury.

5 The Court also will not exclude Minkow’s testimony regarding the shapes and contours of  
6 the accused saddles. Although Icon describes this testimony as unacceptably conclusory, in fact,  
7 Minkow’s report provides a detailed explanation, including illustrations, of his opinion that the  
8 contour of the accused saddles does not match the contour of the gluteus maximus muscles. His  
9 opinions are properly explained and may be presented to the jury. Icon’s argument that Minkow  
10 failed to fully consider the Court’s claim construction, which describes abutment segments  
11 “contoured to provide a generally curved profile, matching the contour of the gluteus maximus  
12 muscles adjacent *a person’s ischial bones*” is a proper topic for cross-examination. Claim  
13 Construction Order at 20 (emphasis added).

14 Finally, the Court denies Icon’s request that Minkow’s opinions be excluded as a sanction  
15 pursuant to Federal Rule of Civil Procedure 37(c)(1). ECF No. 173 at 8-9. Icon contends that  
16 Minkow’s opinions are subjective, personal impressions that should have been disclosed during  
17 fact discovery. *Id.* Specialized acknowledges that Minkow was originally designated as a fact  
18 witness, and that in his fact discovery deposition, he truthfully stated that he had not been asked to  
19 serve as an expert in this case. ECF No. 183 at 7. Specialized later timely disclosed its decision to  
20 designate Minkow an expert, and Icon had the opportunity to depose him as an expert. The Court  
21 concludes that Minkow’s opinions are proper expert testimony and that they will be helpful to the  
22 jury in evaluating the characteristics of the accused saddles. Minkow was properly disclosed and  
23 deposed as an expert. Accordingly, there has been no improper “end-around the requirements of  
24 Rule 26(a)(1)” and sanctions would be inappropriate. ECF No. 173 at 9.

25 **IV. MOTIONS FOR SUMMARY JUDGMENT**

26 The Court will next consider each party’s motion for summary judgment. Specialized  
27 moves for summary judgment of: (1) invalidity of Claims 1, 3-6, 12, 14, 15, 17, 21, and 22 of the  
28 ’180 patent; (2) non-infringement of Claims 1, 3-6, 12, 14, 15, 17, 21, and 22 of the ’180 patent;

1 (3) non-infringement of Claims 1-3, 5, and 11-14 of the '938 patent; and (4) laches barring Icon's  
2 pre-suit claimed damages for alleged infringement of the '180 and '938 patents. ECF No. 153 at  
3 1. Icon moves for summary judgment in its favor on: (1) Specialized's defense of failure to mark;  
4 (2) Specialized's defense of lack of standing; (3) Specialized's defense of laches; (4) obviousness  
5 of the '180 and '938 patents; (5) indefiniteness of the '180 and '938 patents; (6) anticipation of the  
6 '938 patent based on Martin, Yates, West, Flager, Cassani, Mythos, Flite, and Turbo; and (7)  
7 whether the Mythos, Turbo, Turbomatic, and Flite saddles and Exhibits S and T to Werner's  
8 report are prior art. ECF No. 175 at i.

9 **A. Legal Standard**

10 Summary judgment is proper when "the movant shows that there is no genuine dispute as  
11 to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P  
12 56(c). An issue is "genuine" only if there is sufficient evidence for a reasonable factfinder to find  
13 for the non-moving party, and "material" only if the fact may affect the outcome of the case. See  
14 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248-49 (1986). All reasonable inferences must be  
15 drawn in the light most favorable to the non-moving party. Olsen v. Idaho State Bd. Of Med., 363  
16 F.3d 916, 922 (9th Cir. 2004). These standards apply with full force to summary judgment  
17 motions involving patent claims. See Union Carbide Corp. v. Am. Can Co., 724 F.2d 1567, 1571  
18 (Fed. Cir. 1984).

19 **B. Specialized's Motion for Summary Judgment (ECF No. 153)**

20 **1. Invalidity of the '180 Patent**

21 **a. Legal Standard**

22 Patents are presumed valid. 35 U.S.C. § 282(a). A party challenging the validity of a  
23 patent bears the burden of proving invalidity by clear and convincing evidence. Pfizer, Inc. v.  
24 Apotex, Inc., 480 F.3d 1348, 1359 (Fed. Cir. 2007). "Both anticipation under § 102 and  
25 obviousness under § 103 are two-step inquiries." Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928,  
26 933 (Fed. Cir. 2003). The first step is claim construction. Id. The second step requires a  
27 comparison of the properly construed claims to the prior art. Id.

28 For a claim to be anticipated under § 102, and thus invalid, "each claim element must be

1 disclosed, either expressly or inherently, in a single prior art reference, and the claimed  
2 arrangement or combination of those elements must also be disclosed, either expressly or  
3 inherently, in that same prior art reference.” Therasense, Inc. v. Becton, Dickinson & Co., 593  
4 F.3d 1325, 1332-33 (Fed. Cir. 2010). “Inherent anticipation requires that the missing descriptive  
5 material is necessarily present, not merely probably or possibly present, in the prior art.” Trintec  
6 Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295 (Fed. Cir. 2002) (internal quotation marks  
7 omitted). Whether prior art anticipates the accused device is a question of fact. Orion IP, LLC v.  
8 Hyundai Motor Am., 605 F.3d 967, 974 (Fed. Cir. 2010).

9 Under 35 U.S.C. § 103, a patent claim is invalid as obvious “if the differences between the  
10 claimed invention and the prior art are such that the claimed invention as a whole would have been  
11 obvious before the effective filing date of the claimed invention to a person having ordinary skill  
12 in the art to which the claimed invention pertains.” To determine whether this test is met, the  
13 Court examines four factors: (1) the scope and content of the prior art; (2) the differences between  
14 the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) any  
15 relevant secondary considerations (i.e., objective indicia of non-obviousness). KSR Int’l Co. v.  
16 Teleflex, Inc., 550 U.S. 398, 406 (2007) (quoting Graham v. John Deere Co. of Kansas City, 383  
17 U.S. 1, 17-18 (1966)). Importantly, “a patent composed of several elements is not proved obvious  
18 merely by demonstrating that each of its elements was, independently, known in the prior art.”  
19 KSR, 550 U.S. at 418. On the other hand, “when a patent simply arranges old elements with each  
20 performing the same function it had been known to perform and yields no more than one would  
21 expect from such an arrangement, the combination is obvious.” Id. at 417 (internal quotation  
22 marks omitted).

23 The Federal Circuit has often employed the “teaching, suggestion, or motivation” (“TSM”)  
24 test to determine whether a particular combination of prior art would have been obvious to one of  
25 ordinary skill in the art at the time of the invention. See In re Translogic Tech., Inc., 504 F.3d  
26 1249, 1259-60 (Fed. Cir. 2007). Under that test, a court asks whether the prior art would have  
27 provided a motivation, teaching, or suggestion to combine aspects of the prior art. Id. at 1259.  
28 The U.S. Supreme Court has, however, cautioned that the TSM test should be applied in a flexible,

1 non-rigid fashion, taking into account “common sense” and “the inferences and creative steps that  
2 a person of ordinary skill in the art would employ.” KSR, 550 U.S. at 418-21.

3 Specialized contends that the ’180 patent is invalid as both anticipated and obvious. The  
4 Court considers these arguments in turn.

5 **b. Anticipation of Claim 1 of the ’180 Patent**

6 **i. Blase**

7 Specialized argues first that Blase discloses every limitation of Claim 1 of the ’180 patent,  
8 which claims a support system including: (1) two support portions; (2) a front portion coupled to  
9 the support portions; and (3) “a hinge between the first and second support portions and the front  
10 portion for allowing each of the first and second support portions to undergo substantially  
11 independent arcuate movement having a component at least in a substantially vertical plane when  
12 the rider is seated on the support portions and performing a pedaling motion.” ECF No. 153 at 10-  
13 12.

14 Icon disputes that Blase anticipates Claim 1. ECF No. 192 at 4-6. In particular, Icon  
15 asserts that Blase discloses an undercarriage of a bicycle seat, not a bicycle seat or support system,  
16 and that Blase does not disclose a flexible area separating each of the support portions from the  
17 nose, as required by the Court’s claim construction order. See Claim Construction Order at 18  
18 (construing the “hinge” term in Claim 1 to require “at least one flexible area separating each of the  
19 support portions from the front portion to allow flexing to occur.”).

20 The Court finds that summary judgment of anticipation by Blase is unwarranted because  
21 there are conflicts in the expert testimony concerning whether Blase includes the required hinge  
22 element. Specifically, although Specialized’s expert identifies a hinge in this prior art reference,  
23 Icon’s expert, Harrigan, has opined that the movement in Blase occurs throughout the wire  
24 undercarriage of the seat, so that it does not include a “flexible area separating each of the support  
25 portions from the front portion.” Claim Construction Order at 18; see also id. at 6 (“Because the  
26 hinges, support portions, and front portion are claimed as distinct elements, they are discrete and  
27 must be individually met for purposes of finding infringement.”). Harrigan relies on his FEA  
28 analysis of the Blase saddle to support his opinion that Blase does not include a separate hinge



1 area that allows the support portions (in Blase, the rear loops), to flex substantially independently.

2 Construing this conflicting expert testimony in the light most favorable to Icon, the Court  
3 finds that there is a genuine dispute of material fact that precludes summary judgment of  
4 anticipation. See Olsen, 363 F.3d at 922 (on summary judgment, the Court must view the  
5 evidence in the light most favorable to the non-moving party); Garter-Bare Co. v. Munsingwear,  
6 Inc., 650 F.2d 975, 979-82 (9th Cir. 1980) (reversing a district court's grant of summary judgment  
7 where the parties provided conflicting expert testimony, but the district court granted summary  
8 judgment by relying solely on the moving party's expert testimony); Brocade Commc'ns Sys., Inc.  
9 v. A10 Networks, Inc., 843 F. Supp. 2d 1018, 1024-25 (N.D. Cal. Jan. 6, 2012) (relying on expert  
10 declarations to find that a genuine dispute of material fact precluded summary judgment).

11 **ii. Urban**

12 Specialized also contends that Urban discloses every limitation of Claim 1. ECF No. 153 at  
13 12-13. Icon disputes this anticipation argument and the opinions of Specialized's expert, Werner.  
14 ECF No. 192 at 6-8. It argues that Urban does not disclose a flexible area that separates the front  
15 of the saddle from the rear of the saddle; rather, according to Icon and its expert, the front and rear  
16 of the rails move uniformly. Moreover, Icon contends, the Urban patent teaches a seat that is  
17 designed to receive the weight of the rider throughout the perineum and the coccyx, rather than  
18 through two separate support regions. Construing this conflicting testimony in the light most  
19 favorable to Icon, the Court concludes that there is a genuine dispute of material fact that  
20 precludes summary judgment of anticipation as to Urban.

21 **iii. Mesinger**

22 Next, Specialized contends that Mesinger discloses every limitation of Claim 1. ECF No.  
23 153 at 13-14. The Court also finds that conflicting expert testimony creates a genuine dispute of  
24 material fact precluding summary judgment of anticipation as to Mesinger. Specifically, although  
25 Specialized's expert, Werner, opines that Mesinger discloses each claim element, Icon's expert,  
26 Harrigan, states that the cantilevered arrangement in Mesinger means that the support portions are  
27 coupled together, and therefore do not move independently of each other as required by Claim 1 of  
28 the '180 patent. Furthermore, to the extent that Mesinger does have one flexible area within the

1 meaning of the '180 patent, Harrigan has stated that it does not anticipate claim 1 because, on re-  
2 examination, the '180 patent was amended to require two separate hinges in order to distinguish it  
3 from prior art similar to Mesinger.

4 **iv. Prior Art Commercial Saddles**

5 Finally, Specialized contends that the Mythos, Flite, and Turbomatic saddles, which it  
6 states were on sale in the U.S. beginning in 1993 (Mythos) and at least as early as 1994 (Flite and  
7 Turbomatic) include each limitation of Claim 1. ECF No. 153 at 9, 14-19. In response, Icon  
8 argues first that Specialized has failed to prove that the actual seats that its expert tested are prior  
9 art and that the testing of these saddles should therefore be disregarded. The Court will address  
10 this argument below in its discussion of Icon's motion for summary judgment. Second, Icon  
11 argues that these saddles do not anticipate the claims of the '180 patent because they do not allow  
12 substantially independent movement. In light of the conflicting expert testimony concerning  
13 (1) whether these prior art saddles contain hinges, as claimed in the '180 patent, and particularly  
14 whether they allow for independent movement of the support portions of the seat; and (2) the  
15 usefulness of instrumented rider testing, FEA, and manual testing to reach anticipation and  
16 infringement opinions in this case, the Court concludes that Specialized has not met its burden to  
17 establish that it is entitled to summary judgment that claim 1 of the '180 patent is anticipated by  
18 the prior art commercial saddles it has identified.

19 **c. Anticipation of Dependent Claims 3-6 of the '180 Patent**

20 Claims 3-6 depend on Claim 1 of the '180 patent. Because a genuine dispute of material  
21 fact exists as to whether Claim 1 is anticipated by the prior art, Specialized has also failed to meet  
22 its burden to show that it is entitled to summary judgment with respect to these dependent claims.

23 **d. Anticipation of Claims 12, 14, 15, 17, 21, and 22 of the '180**  
24 **Patent**

25 Similarly, the Court will deny summary judgment on anticipation of Claims 12 and 14  
26 because each of these claims includes a hinge element that allows the two support portions of the  
27 seat to undergo substantially independent movement, as discussed above. The Court will deny  
28 summary judgment that Claims 15, 17, 21, and 22 are anticipated by the prior art because each

1 depends on Claim 14.

2 **e. Obviousness of the '180 Patent**

3 Specialized's motion includes a cursory argument that, even under Icon's definition of the  
4 level of ordinary skill in the art, the asserted claims of the '180 patent are obvious because they  
5 involve nothing more than simple substitution of known elements according to known methods to  
6 yield a predictable result. ECF No. 153 at 22. See KSR, 550 U.S. at 416. For example,  
7 Specialized states, the combination of the Mythos saddle with any of Blase, Urban, or Mesinger  
8 renders the asserted claims of the '180 patent obvious. Specialized then refers the Court to  
9 Werner's report for more detailed analysis. ECF No. 153 at 22.

10 Icon is correct that these arguments are insufficient to meet Specialized's burden to show  
11 that it is entitled to summary judgment that the '180 patent is invalid because it is obvious. ECF  
12 No. 192 at 13-15. Dr. Werner does not offer any opinions as to how a person of ordinary skill in  
13 the art would combine Mythos with the teachings of Mesinger, Urban, or Blase to arrive at the  
14 claimed invention of the '180 patent, which he was required to do. See ActiveVideo Networks,  
15 Inc. v. Verizon Commc'ns, Inc., 694 F.3d 1312, 1327 (Fed. Cir. 2012) (finding testimony of  
16 expert witness conclusory, factually unsupported, and insufficient where "[t]he expert failed to  
17 explain how specific references could be combined, which combination(s) of elements in specific  
18 references would yield a predictable result, or how any specific combination would operate or read  
19 on the asserted claims"); Hynix Semiconductor Inc. v. Rambus Inc., 2009 WL 112834, at \*6 (N.D.  
20 Cal. Jan. 16, 2009) ("[A] challenger must 'articulate how [a prior art] reference anticipates or  
21 makes obvious the [claim at issue].'" (citing Koito Mfg. Co. v. Turn-Key-Tech, LLC, 381 F.3d  
22 1142, 1151-52 (Fed. Cir. 2004)). Construing the evidence in the light most favorable to Icon,  
23 Harrigan's opinion that none of Specialized's identified obviousness combinations render the  
24 patents invalid is sufficient to create a genuine issue of material fact for the jury.

25 **2. Non-infringement of the '180 Patent**

26 **a. Legal Standard**

27 "To support a summary judgment of noninfringement it must be shown that, on the correct  
28 claim construction, no reasonable jury could have found infringement on the undisputed facts or

1 when all reasonable factual inferences are drawn in favor of the patentee.” NetWord, LLC v.  
2 Centraal Corp., 242 F.3d 1347, 1353 (Fed. Cir. 2001). “To establish literal infringement, all of the  
3 elements of the claim, as correctly construed, must be present in the accused system.” Id. For  
4 literal infringement of a § 112(f) limitation, the accused device must perform an identical function  
5 to the one recited in the claim and must use the same structure, materials or acts found in the  
6 specification, or their equivalents. IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1430  
7 (Fed. Cir. 2000). Whether an accused device “performs the identical function with the same  
8 structure, materials, or acts described in the specification or an equivalent thereof, is a question of  
9 fact.” Id.

10 **b. All Asserted Claims**

11 Specialized argues first that it is entitled to summary judgment of non-infringement  
12 because if Harrigan’s manual testing and FEA analyses are excluded, Icon has no evidence to  
13 support infringement. ECF No. 153 at 23. Because the Court is denying Specialized’s motion to  
14 exclude Harrigan’s testimony, this argument fails.

15 Second, Specialized argues that any movement of the support portions of the accused  
16 saddles is de minimis and therefore does not meet the claim limitation that a hinge must allow  
17 flexing so that the rear support portions of the saddle undergo substantially independent arcuate  
18 movement. ECF No. 153 at 24-26. Specialized contends that such small movements would not be  
19 felt by the rider and would not confer the benefits intended by the ’180 patent. Id. Icon is correct  
20 however, that Harrigan’s expert opinion that the accused saddles do have a hinge and a  
21 Specialized saddle designer’s description of Specialized saddles as including a flexible portion  
22 located between the front and rear portions are sufficient to establish that there is a genuine issue  
23 of material fact as to whether the accused saddles include a hinge. See ECF No. 192 at 15-17.  
24 Moreover, the “energy return” and “comfort” benefits cited by Specialized are discussed in the  
25 specification; they are nowhere to be found in the claim language. See Johnson & Johnston  
26 Assocs. v. R.E. Serv. Co., 285 F.3d 1046, 1052 (Fed. Cir. 2002) (“[T]he law of infringement  
27 compares the accused product with the claims as construed by the court.”).

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**c. Stop Means Claims**

The Court concludes that Specialized is entitled to summary judgment that the accused saddles do not infringe Claims 12 and 22 of the '180 patent. Claims 12 and 22 include “stop means” that limit the amount of movement of the support portions. The Court identified the stop means terms as being governed by 35 U.S.C. § 112(f). Claim Construction Order at 19. It identified the relevant function as limiting movement of the support portions and the corresponding structure as follows: “as shown in figures 29 and 32-36, the rearwardly extending free end sections 145, which are spaced from the lower surface of the shell 11 and which extend from outwardly extending sections 159, where the sections 159 and 145 may form a continuously curved profile.” Id.

Icon contends that the ends of the rails of the accused saddles perform the same function as the stop means in the '180 patent and that they are structural equivalents of the structure disclosed in the specification. ECF No. 192 at 18. See IMS Tech., 206 F.3d at 1430 (to determine infringement of a means plus function claim, one must determine whether the accused device “performs the identical function with the same structure, materials, or acts described in the specification or an equivalent thereof”). Icon acknowledges that “in the accused Specialized saddles, the ends of the rails are not spaced from each respective support portion like the structure in the specification,” but contends that this difference is “insignificant.” ECF No. 192 at 19.

In its claim construction order, the Court described the relevant structure as comprising “rearwardly extending free end sections . . . spaced from the lower surface of the shell,” and performing the function of limiting the amount of movement of the support portions. Claim Construction Order at 19. Icon does not dispute that the rails on the accused saddles that it identifies as “stop means” are not “free” or “spaced from the lower surface of the shell” such that the shell would move freely until it contacts the stop means. Rather, the rails are attached to the bottom of the accused saddles. Even if Icon and its expert are correct that the rails do perform the function of limiting the amount of movement of the support portions of the saddle, it is clear that they do not perform that function “in substantially the same way to achieve substantially the same result.” See IMS Tech., 206 F.3d at 1435. Accordingly, Specialized is entitled to summary

1 judgment that the accused saddles do not infringe Claims 12 and 22 of the '180 patent, which  
2 include the "stop means" terms.

3 **3. Non-infringement of the '938 Patent**

4 Specialized contends that it is entitled to summary judgment that the accused saddles do  
5 not infringe the '938 patent because (1) they do not have abutment means; (2) they compress soft  
6 tissue; and (3) they are not permanently transverse. ECF No. 153 at 28-31. Icon disputes this  
7 argument. With respect to the first and third arguments, Icon has established that there remains a  
8 genuine dispute of material fact. Icon points to evidence that the accused saddles do have  
9 abutment means because the portions of the shells of the accused saddles that support the ischial  
10 bones (as distinct from the entire saddles) are both inclined and shaped to follow the contour of the  
11 gluteus maximus muscles. ECF No. 192 at 19-22. Icon also offers evidence that this abutment  
12 means is permanently transverse with respect to the longitudinal axis of the bicycle and that,  
13 without other supports, it is not possible to permanently sit on the abutment means with the  
14 backbone of the rider arranged generally vertically. *Id.* at 23-24. While it may be possible to  
15 balance vertically on a Specialized saddle, Icon argues, the rider would no longer be sitting with  
16 his ischial bones on the abutment means, as described in the '938 patent.

17 The argument that Specialized's saddles do not infringe the '938 patent because they do  
18 not compress soft tissue is less straightforward. Specialized contends that it is entitled to summary  
19 judgment because Icon's expert admits that pressure on the tissue outside the ischial bones is  
20 generally low on a Specialized saddle, but the claims require that the soft tissue is not compressed  
21 at all. ECF No. 153 at 30. Icon maintains that the saddles do infringe, because the claims require  
22 that "substantially all" or a "majority" of the soft tissue outside the area adjacent to the ischial  
23 bones is not compressed, and therefore some compression outside the ischial bones is permitted.  
24 ECF No. 192 at 22-23. Upon review of the '938 patent, it is clear that the claims are not  
25 consistent in this respect. Claim 1 recites that "the rider's soft tissue substantially outside the  
26 ischial bone(s) is not compressed by the seat when the rider is on the seat." Looking at this  
27 language, it seems that Specialized has the better of the argument. The claim does not allow for  
28 any compression of tissue substantially outside the ischial bones, and Harrigan acknowledges that

1 there is “generally low” compression on the accused saddles. On the other hand, Claim 13 works  
2 in Icon’s favor, as it describes a bicycle seat dimensioned “so that substantially all the soft tissue  
3 surrounding said portion of the person’s seating anatomy is not compressed or squeezed by the  
4 seat when the person is on the seat.” In other words, some small amount of compression of some  
5 tissue is permitted by this claim, as long as substantially all of the soft tissue is not compressed.

6 In view of this variation in the claim language, the Court concludes that Specialized is  
7 entitled to summary judgment of non-infringement of those claims that require that soft tissue  
8 substantially outside the ischial bones not be compressed because the parties do not dispute that  
9 the Specialized saddles do compress some tissue outside the ischial bones. This includes Claim 1  
10 (“the rider’s soft tissue substantially outside the ischial bone(s) is not compressed by the seat when  
11 the rider is on the seat”); Claims 2 and 3, which depend on Claim 1; and Claim 11 (“the rider’s  
12 soft tissue substantially outside the seat is not compressed by the seat when the rider is on the  
13 seat”).

14 **4. Laches**

15 Finally, Specialized seeks summary judgment that Icon’s claimed damages are barred by  
16 laches.

17 **a. Legal Standard**

18 Laches is an equitable defense to patent infringement. “The application of the defense of  
19 laches is committed to the sound discretion of the district court.” A.C. Aukerman Co. v. R.L.  
20 Chaides Constr. Co., 960 F.2d 1020, 1032 (Fed. Cir. 1992) (en banc). To invoke the laches  
21 defense, a defendant has the burden to prove by a preponderance of the evidence both that “the  
22 plaintiff delayed filing suit for an unreasonable and inexcusable length of time from the time the  
23 plaintiff knew or reasonably should have known of its claim against the defendant” and that “the  
24 delay operated to the prejudice or injury of the defendant.” Id. at 1032, 1045. The “district court  
25 must weigh all pertinent facts and equities,” including “the length of the delay, the seriousness of  
26 prejudice, the reasonableness of excuses, and the defendant’s conduct or culpability,” in order “to  
27 determine whether the patentee dealt unfairly with the alleged infringer by not promptly bringing  
28 suit.” Id. at 1034.

1 A delay in filing suit exceeding six years after actual or constructive knowledge of the  
2 alleged infringing activity gives rise to a presumption of laches. Id. at 1035-36. This presumption  
3 may be overcome by “evidence directed to showing either that the patentee’s delay was reasonable  
4 or that the defendant suffered no prejudice or both.” Id. at 1038. The evidence “need only be  
5 sufficient to raise a genuine issue” – “the presumption of laches may be eliminated by offering  
6 evidence to show an excuse for the delay or that the delay was reasonable, even if such evidence  
7 may ultimately be rejected as not persuasive.” Id.

8 Icon argues that, in light of the Supreme Court’s recent decision in Petrella v. Metro-  
9 Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014), the defense of laches should not bar a claim for  
10 damages occurring within the six-year damages limitations period established by 35 U.S.C. § 286.  
11 ECF No. 192 at 24. In deciding Petrella, the Supreme Court explicitly left Aukerman intact. See  
12 Petrella, 134 S. Ct. at 1974 n.15. Therefore, although the Federal Circuit has granted en banc  
13 review of the issue, Aukerman is, at the present time, still controlling precedent. See SCA  
14 Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, No. 2013-1564, 2014 WL 7460970  
15 (Fed Cir. Dec. 30, 2014).

16 **b. Discussion**

17 Specialized contends that it is entitled to summary judgment that Icon’s claimed damages  
18 are barred by laches because Icon and its predecessor, Nelson Seating, unreasonably delayed filing  
19 the lawsuit for a period of about ten to eleven years. ECF No. 153 at 31-35. Specialized argues  
20 that it has been materially prejudiced by this delay because it has made substantial investments in  
21 the Body Geometry saddle line, which includes the accused saddles. Had Specialized received  
22 earlier notice, it contends, the company could have proceeded differently by producing stiffer  
23 saddles or by pursuing prior art saddle designs.

24 The Court concludes that Specialized is not entitled to summary judgment on its laches  
25 defense because it has not established that no genuine dispute of material fact exists. First, factual  
26 disputes between the parties remain as to whether Icon, or its predecessors in interest, had actual  
27 or constructive knowledge of alleged infringement more than six years prior to the filing of suit,  
28 such that there is a presumption of laches. For example, Icon contends that Specialized has failed



1 to establish that the Specialized saddles of which Icon and its predecessors may have been actually  
2 aware were the same or similar to the saddles accused in this suit. ECF No. 192 at 25. Viewing  
3 the evidence in the light most favorable to Icon, it is also not clear whether saddles similar to the  
4 accused saddles were sold so pervasively in the marketplace that Icon had constructive knowledge  
5 of infringement. Second, assuming that the presumption arises, Icon has introduced sufficient  
6 evidence to raise a genuine dispute as to either delay or prejudice. See Aukerman, 960 F.2d at  
7 1038. Viewing the evidence in the light most favorable to Icon, a genuine dispute of material fact  
8 remains as to whether any delay in filing suit was excusable in light of illness and other litigation  
9 activities and whether such delay prejudiced Specialized. Accordingly, Specialized is not entitled  
10 to summary judgment on its laches defense.

11 **C. Icon’s Motion for Summary Judgment (ECF No. 175)**

12 **1. Failure to Mark**

13 Icon first seeks summary judgment on Specialized’s defense of failure to mark. ECF No.  
14 175 at 3. In its response, Specialized withdraws this defense. ECF No. 187 at 1. The request for  
15 summary judgment is therefore denied as moot. See E.E.O.C. v. Fred Meyer Stores, Inc., 954 F.  
16 Supp. 2d 1104, 1116 (D. Or. 2013); Matsuda v. Wada, 101 F. Supp. 2d 1315, 1325 (D. Haw.  
17 1999).

18 **2. Standing**

19 Icon also seeks summary judgment on Specialized’s standing defense. ECF No. 175 at 5.  
20 In its response, Specialized withdrew this defense. ECF No. 187 at 1. However, Specialized has  
21 since submitted a notice to the Court stating that it wishes to withdraw this withdrawal in light of a  
22 recently filed lawsuit in Australia involving rights to the patents-in-suit. ECF No. 218. Because  
23 the Australian litigation does not create a genuine dispute of material fact as to standing, for the  
24 reasons discussed at the hearing on these motions, the Court denies Specialized’s request to  
25 withdraw its withdrawal of this defense and denies Icon’s request for summary judgment as moot.

26 **3. Laches**

27 Icon seeks summary judgment on Specialized’s laches defense because, it contends,  
28 Specialized has no evidence that it was prejudiced as a result of Icon’s alleged delay in filing suit.

1 ECF No. 175 at 7-11. The legal standard for the equitable defense of laches is discussed in  
2 Section IV.B.4.a, above.

3 Even if the presumption of laches applies, Icon argues, Icon is entitled to summary  
4 judgment because it has sufficient evidence to rebut this presumption and to shift the burden of  
5 proof back to Specialized, and Specialized’s statements concerning the economic prejudice it has  
6 suffered as a result of the delay are insufficient to meet this burden. Icon argues that statements  
7 that Specialized “could have” proceeded differently in its development of the Body Geometry  
8 saddles cannot satisfy its burden to “prove that the change in economic position would not have  
9 occurred had the patentee sued earlier.” ECF No. 175 at 11 (quoting Gasser Chair Co., Inc. v.  
10 Infanti Chair Mfg. Corp., 60 F.3d 770, 775 (Fed. Cir. 1995)).

11 Icon has failed to establish that no genuine dispute of material fact exists with respect to  
12 Specialized’s laches defense. Viewing the evidence in the light most favorable to Specialized,  
13 there is evidence from which the factfinder could conclude that Specialized was prejudiced due to  
14 the alleged delay because any liability for infringement of the ’180 and ’938 patents was not  
15 established before Specialized invested substantial resources in the development and expansion of  
16 its accused Body Geometry saddles. See Adelberg Labs., Inc. v. Miles, Inc., 921 F.2d 1267, 1272  
17 (Fed. Cir. 1990) (“Making heavy capital investment and increasing production can constitute  
18 prejudice.”).

19 **4. Obviousness of the ’180 and ’938 Patents**

20 Icon seeks partial summary judgment that the ’938 patent is not obvious in light of the  
21 combination of Martin with Yates and Flager on the grounds that Specialized has failed to produce  
22 any evidence that these combinations render any of the claims of the ’938 patent obvious. In  
23 addition, to the extent that the Court excludes Werner’s testimony that the ’180 patent is obvious  
24 based on the combination of Mythos with Urban, Blase, or Mesinger, Icon seeks summary  
25 judgment of non-obviousness of the ’180 patent due to Specialized’s lack of admissible evidence.  
26 ECF No. 175 at 11.

27 **a. ’938 patent**

28 Icon argues first that Specialized cannot rely on the combination of Martin with Yates or

1 Flager because this combination was not identified in Specialized’s invalidity contentions. ECF  
2 No. 175 at 13. Second, Icon contends that even if this combination had been properly disclosed,  
3 Specialized does not have any evidence that these combinations render any of the asserted claims  
4 obvious because its expert, Werner, provides only conclusory assertions on this subject. *Id.* at 13-  
5 15; see Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316, 1329 (Fed. Cir. 2001)  
6 (“Broad conclusory statements offered by Telemac’s experts are not evidence and are not  
7 sufficient to establish a genuine issue of material fact.”).

8 The Court concludes that Specialized’s invalidity contentions adequately disclose these  
9 obviousness combinations. In the body of the document, Specialized references its claim charts at  
10 B-1 and B-2 and states: (1) “Martin anticipates each of the Asserted Claims of the ’938 Patent”  
11 and (2) “In the extraordinarily broad fashion in which Icon is apparently interpreting the Asserted  
12 Claims of the ’938 patent, myriad prior art bicycle seats would render the Asserted Claims invalid,  
13 including at least Hanson, Yates, West, Flager, Cassani, Mythos, Flite, and Turbo.” Specialized’s  
14 Amended Invalidity Contentions & Accompanying Document Production Pursuant to Patent L.R.  
15 3-3 & 3-4, ECF No. 175-14 at 11. Each page of claim chart B-1 states: “Each Asserted Claim Is  
16 Anticipated by and/or Obvious in Light of Martin Either Alone or in Combination with Other  
17 Prior Art.” The only other prior art discussed is that in claim chart B-2, which includes Yates and  
18 Flager. These contentions were adequate to put Icon on notice that Specialized sought to rely on  
19 this combination of prior art in its obviousness analysis.

20 The Court has addressed Icon’s arguments that Werner’s invalidity opinions should be  
21 excluded as conclusory in Section III.C.2, above. Werner’s opinions are sufficient to raise an  
22 issue of fact with regards to the obviousness of the ’938 patent claims. Icon has therefore failed to  
23 show that it is entitled to summary judgment on this issue.

24 **b. ’180 patent**

25 Icon argues that to the extent the Court excludes Werner’s opinions that the ’180 patent is  
26 obvious based on the Mythos in combination with Blase, Mesinger, or Urban, Icon is entitled to  
27 summary judgment that the ’180 patent is not obvious because the only evidence that Specialized  
28 has produced to support its obviousness defense and counterclaim is Werner’s testimony. ECF

1 No. 175 at 15. The Court has addressed Icon’s arguments that Werner’s invalidity opinions  
2 should be excluded as conclusory at Section III.C.2, above. Because the Court is not excluding  
3 Werner’s obviousness opinions, Icon’s argument is unavailing.

4 **5. Waiver of Indefiniteness Arguments**

5 **a. ’938 patent**

6 Icon first contends that it is entitled to summary judgment that the ’938 patent is not  
7 invalid as indefinite because Specialized has failed to provide any support for this counterclaim  
8 and defense. ECF No. 175 at 15-16. In its response, Specialized withdraws its defense of  
9 indefiniteness as to the ’938 patent claims. ECF No. 187 at 7. Thus, Icon’s request for relief is  
10 moot.

11 **b. ’180 patent**

12 Second, Icon seeks summary judgment that the hinge terms of the ’180 patent are not  
13 indefinite. ECF No. 175 at 16. Icon has withdrawn its contention that Specialized’s expert  
14 opinions on this subject are untimely because they were not disclosed at the claim construction  
15 stage. ECF No. 202 at 8. It maintains, however, that Icon is entitled to summary judgment on this  
16 issue because Werner’s opinions on indefiniteness do not raise a genuine issue of material fact. Id.  
17 at 8-9. This argument is unpersuasive. Icon has failed to establish that Werner’s opinions should  
18 be excluded on the basis that they are not his own. The Court concludes that Werner’s analysis of  
19 the hinge terms in the ’180 patent and, in particular, his opinion that “[t]he claims are indefinite  
20 because it is unclear what degree of independent movement there must be in response to what  
21 magnitude of load to constitute a hinge” is sufficient to raise a genuine issue of material fact with  
22 respect to indefiniteness. Werner Report ¶ 169.

23 **6. Anticipation of ’938 Patent**

24 Icon contends that it is entitled to summary judgment that the ’938 patent is not anticipated  
25 by Martin, Hanson, Yates, Flager, Cassani, Mythos, Flite, and Turbo because Werner’s testimony  
26 on this issue is legally flawed. ECF No. 175 at 19-21. The Court addresses Icon’s argument that  
27 Werner’s testimony on this issue should be excluded in Section III.C.3, above. Because Icon’s  
28 summary judgment argument is premised on the exclusion of Werner’s opinions on this point and

1 because the Court is denying the request to exclude, the motion for summary judgment on this  
2 issue is also denied.

3 **7. Physical saddles and Exhibits S & T to Dr. Werner's Report**

4 Icon seeks summary judgment that the Mythos, Turbo, Turbomatic, and Flite saddles  
5 identified and examined by Werner and Exhibits S and T to Werner's report are not prior art. ECF  
6 No. 175 at 21-25.

7 The Court grants summary judgment that Exhibits S and T are not prior art. Exhibit S is a  
8 printout from a webpage, dated July 20, 1997. Exhibit T is packaging for the Mythos saddle,  
9 bearing a copyright publication notice of 1993. Regardless of whether Specialized can establish a  
10 proper publication date for each of these exhibits, it points to no evidence establishing that the  
11 exhibits were publicly accessible. See In re Lister, 583 F.3d 1307, 1312-13 (Fed. Cir. 2009).  
12 Furthermore, the Court notes that Exhibit S, a printout from an internet archive, has not been  
13 properly authenticated. See Open Text S.A. v. Box, Inc., No. 13-cv-04910-JD, 2015 WL 428365,  
14 at \*2 (N.D. Cal. Jan. 30, 2015).

15 The Court denies summary judgment that the physical Mythos, Turbo, Turbomatic, and  
16 Flite saddles examined by Werner are not prior art. Icon contends that Specialized has offered no  
17 evidence that the saddles examined were sold, offered for sale, or publicly available more than one  
18 year prior to the effective filing date of the asserted patents and that Icon is therefore entitled to  
19 summary judgment. ECF No. 175 at 23. In response, Specialized points to the testimony of  
20 James McCarvill, who examined the saddles that Werner tested and testified that they were  
21 examples of prior art saddles sold by his former employer, U.S. distributor Quality Bicycle  
22 Products ("QBP"). ECF No. 187 at 16-17. Specialized also notes that the Flite and Turbomatic  
23 saddles examined by Werner bear date stamps of 1993 and 1991, respectively, but does not  
24 dispute Icon's contention that the date stamps are inadmissible hearsay. Id.

25 McCarvill's deposition testimony raises a genuine issue of material fact as to whether the  
26 saddles examined by Werner are examples of prior art saddles. At his deposition, McCarvill  
27 identified one Mythos saddle as "an identical-looking saddle, with the same designs as the saddles  
28 we were selling in those years, in 1994." Deposition of James McCarvill ("McCarvill Dep."),

1 ECF No. 160-4, at 27. In his discussion of a second example, he stated that “[i]n ’95 it would be a  
2 saddle with the same technology, the same rails, the same look,” and that there was no design  
3 difference between that saddle and the one sold in 1995 “that I’m aware of.” Id. at 28. He  
4 identified the Turbo as “a similar saddle,” and commented that the two examples presented to him  
5 “look identical” to the Turbo saddles he had sold at a bicycle retailer in the 1980’s. Id. at 31-32.  
6 With respect to the Flite saddles, he commented that each was “identical to what we were selling  
7 in those years.” Id. at 35-36. The Turbomatic saddles were described as “[v]ery similar, if not the  
8 same,” and “[v]ery similar, if not identical.” Id. at 39. McCarvill explained that in discussing the  
9 Mythos, he meant “identical” to indicate that the saddles were identical “[i]n physical appearance”  
10 and “[i]n the technologies that they may have.” Id. at 45.

11 Icon is correct that McCarvill does not have an engineering background, never designed a  
12 saddle, and never studied the structural characteristics of saddles. McCarvill Dep., ECF No. 193-  
13 24, at 66-67. But he testified that he had the expertise to identify whether saddles are technically  
14 identical based on his “30 years of experience purchasing saddles.” Id. The weight to accord his  
15 testimony is a question for the finder of fact.

16 **V. CONCLUSION**

17 For the foregoing reasons, the Court hereby: (1) denies Specialized’s motion to exclude  
18 Harrigan; (2) grants in part and denies in part Icon’s motion to exclude Werner; (3) denies Icon’s  
19 motion to exclude McIlvain and certain paragraphs of Kinrich’s expert rebuttal report; (4) grants  
20 in part and denies in part Icon’s motion to exclude Kunin; (5) grants in part and denies in part  
21 Specialized’s motion to exclude Bernatowicz; (6) denies Icon’s motion to exclude Minkow; (7)  
22 grants in part and denies in part Specialized’s motion for summary judgment; and (8) grants in  
23 part and denies in part Icon’s motion for summary judgment.

24 IT IS SO ORDERED.

25 Dated: March 31, 2015

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JON S. TIGAR  
United States District Judge