

United States District Court  
Northern District of California

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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

RESH, INC,  
Plaintiff,  
v.  
BARRETT CONRAD, et al.,  
Defendants.

Case No. 22-cv-01427-EJD

**ORDER ON CROSS MOTIONS FOR  
SUMMARY JUDGMENT**

Re: ECF Nos. 125, 126, 129

This is an action for patent infringement brought by Plaintiff Resh, Inc. against Defendants Robert Conrad, Inc. d/b/a Skimlite Manufacturing (“Skimlite”), James R. Conrad, and Barrett R. Conrad (collectively, “Defendants”) arising from Defendants’ manufacture and sale of telescoping poles used to clean swimming pools. Resh alleges Defendants’ pool pole products infringe U.S. Patent No. 11,141,852, entitled “Telepole Apparatus and Related Methods” (the “’852 Patent”).

Before the Court is Resh’s motion for summary judgment (ECF No. 126), Defendants’ motion for summary judgment (ECF No. 129), and Defendants’ motion to preclude expert testimony from Eric Resh (ECF No. 125).<sup>1</sup>

<sup>1</sup> Both parties’ briefs violate this Court’s requirements for footnotes. See Standing Order, Section IV(A)(4). The Court expects the parties to be familiar with the operative standing order. Future Case No.: 22-cv-01427-EJD

1 For the reasons set forth below, the Court GRANTS IN PART and DENIES IN PART the  
2 parties' motions for summary judgment and GRANTS IN PART Defendants' motion to exclude.

3 **I. BACKGROUND**

4 **A. The Parties**

5 Both parties sell poles for cleaning pools. Skimlite Manufacturing Inc. is a California  
6 corporation principally owned by father and son Defendants James Conrad ("Conrad Sr.") and  
7 Barrett Conrad ("Conrad Jr."). Skimlite has been selling and manufacturing swimming pool poles  
8 since the 1950s.

9 Resh is a California corporation comprised of husband and wife, Eric and Jenel Gonzalez  
10 Resh. Eric Resh started working as a pool man in the late 1980s cleaning swimming pools and has  
11 since "invented and patented a number of improved swimming pool tools to assist pool men as  
12 well as homeowners." This includes the '852 Patent's invention for "Telepole Apparatus and  
13 Related Methods," issued on October 12, 2021.

14 Resh alleges that Skimlite had been manufacturing "twist-and-clamp" pool poles for nearly  
15 60 years until Conrad Sr. encountered Resh's "button detent" poles at a 2012 trade show. Since  
16 then, Skimlite has allegedly been designing infringing poles using Resh's button detent  
17 technology.

18 **B. Procedural History**

19 Resh filed the complaint on March 7, 2022. Compl., ECF No. 1. After several rounds of  
20 motions to dismiss, Defendants answered the second amended complaint on September 25, 2024.  
21 Answer, ECF No. 146.

22 The Court held a *Markman* hearing and construed certain claim terms. ECF No. 93.

23 **C. The '852 Patent and the Accused Products**

24 The '852 Patent claims priority to a provisional application filed in September 2011. It  
25 purports to cover an improved telepole device. Resh accuses two sets of Defendants' pool poles:  
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27 non-complying footnotes may be stricken.  
28 Case No.: 22-cv-01427-EJD  
ORDER REGARDING MOTIONS FOR SUMMARY JUDGMENT

1 the “two-tube poles” and the “three-tube poles.” Resh relies on representative models for each set:  
2 the Model 6016 pole represents all two-tube poles, and Model 6317 represents all three-tube poles.  
3 In total, Resh accuses the following model numbers of Defendants’ pole products: 1012, 1016,  
4 6012, 6016, 6317, and 6323 (together, the “Accused Products”). *See* Statement of Undisputed  
5 Material Facts (“SUF”) ¶ 6, ECF No. 126-1.

6 **1. Two-Tube Poles**

7 Resh seeks summary judgment that the two-tube poles infringe claims 2, 11, 16, 18, 19,  
8 and 21 of the ’852 Patent. Those claims are recited below:

9 **2.** A telescoping pole apparatus, including:  
10 an outer tube having first and second ends, said first end  
11 of the outer tube having a collar associated therewith,  
12 said collar containing a selectively actuatable detent,  
13 said second end of said outer tube having structure for removably attaching a  
14 tool;  
15 an inner tube having first and second ends, said first end  
16 of said inner tube including a grip attached to the inner  
17 tube for a user to grasp and manipulate the apparatus,  
18 said second end of said inner tube being slidably  
19 received in the first end of the outer tube through an  
20 opening in said collar, said inner tube having a plurality  
21 of detent holes positioned to be engaged with said  
22 actuatable detent, said inner tube being a single wall  
23 tube that is hollow along at least substantially its length  
24 between said first and second ends of said inner tube;  
25 and  
26 said inner tube configured to slide within said outer tube  
27 to a selectable position relative to the outer tube, at  
28 which position said detent is configured to temporarily  
engage and hold said inner tube.

**11.** The apparatus of claim 2, wherein said grip has a larger diameter than the diameter of the inner tube.

**16.** The apparatus of claim 2, wherein said detent holes provide a plurality of selected lengthwise positions for said actuatable detent.

**18.** The apparatus of claim 2, said detent including a spring-actuated lever lock.

1           **19.** The apparatus of claim 2, said inner and outer tubes  
2 formed from a relatively lightweight material such as aluminum.

3           **21.** An improved telepole device, comprising:  
4 an outer tube element having first and second ends, said  
5 first end of the outer tube element having a collar  
6 element associated therewith , said collar element con-  
7 taining a detent means , said second end of the outer  
8 tube having attachment means for removably attaching  
9 a tool;  
10 an inner tube element having first and second ends;  
11 said second end of said inner tube element being received  
12 in the first end of the outer tube through an opening in  
13 said collar element;  
14 wherein said inner tube element is configured to readily  
15 slide within said outer tube element to a selected  
16 position along the length of the outer tube, and wherein  
17 said detent means is configured to temporarily lock the  
18 inner tube in that selected position within the outer tube.

12                           **2.       Three-Tube Poles**

13           Resh seeks summary judgment that the three-tube poles infringe claim 20 of the '852  
14 Patent. Claim 20 is recited below:

15           **20.** A telescoping pole apparatus, including:  
16 an outer tube having first and second ends, said first end  
17 of said outer tube having a collar associated therewith,  
18 said collar containing a selectively actuatable detent ,  
19 said second end of said outer tube having structure for  
20 removably attaching a tool;  
21 an inner tube having first and second ends, said first end  
22 of said inner tube including a grip attached to the inner  
23 tube for a user to grasp and manipulate the apparatus;  
24 an intermediate tube slidably interposed between said  
25 inner and outer tubes, said intermediate tube having  
26 first and second ends, said first end of said intermediate  
27 tube slidably received in the first end of said outer tube  
28 through an opening in said collar, said intermediate  
tube having a plurality of detent holes positioned to be  
engaged with said actuatable detent of said outer tube's  
collar, said second end of said intermediate tube having  
a collar associated therewith, said collar containing a  
selectively actuatable detent;  
said second end of said inner tube being slidably received  
in the second end of said intermediate tube through an  
opening in said intermediate tube's collar, said inner

1 tube having a plurality of detent holes positioned to be  
2 engaged with said actuatable detent of said intermedi-  
3 ate tube's collar;  
4 said intermediate tube configured to slide within said  
5 outer tube to a selectable position relative to said outer  
6 tube, at which position said detent of said outer tube is  
7 configured to temporarily engage and hold said inter-  
8 mediate tube; and  
9 said inner tube configured to slide within said intermedi-  
10 ate tube to a selectable position relative to said inter-  
11 mediate tube, at which position said detent of said  
12 intermediate tube is configured to temporarily engage  
13 and hold said inner tube.

## 14 **II. LEGAL STANDARD**

15 A court must grant summary judgment "if the movant shows that there is no genuine  
16 dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R.  
17 Civ. P. 56(a). The moving party bears the burden of demonstrating the absence of any genuine  
18 issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Once the movant has  
19 made this showing, the burden then shifts to the party opposing summary judgment to identify  
20 "specific facts showing there is a genuine issue for trial." *Id.* The party opposing summary  
21 judgment must then present affirmative evidence from which a jury could return a verdict in that  
22 party's favor. *Anderson v. Liberty Lobby*, 477 U.S. 242, 257 (1986).

23 On summary judgment, the court draws all reasonable factual inferences in favor of the  
24 non-movant. *Id.* at 255. In deciding a motion for summary judgment, "[c]redibility  
25 determinations, the weighing of the evidence, and the drawing of legitimate inferences from the  
26 facts are jury functions, not those of a judge." *Id.* However, conclusory and speculative testimony  
27 does not raise genuine issues of fact and is insufficient to defeat summary judgment. *See*  
28 *Thornhill Publ'g Co., Inc. v. GTE Corp.*, 594 F.2d 730, 738 (9th Cir. 1979).

If the burden of persuasion at trial would be on the non-moving party, then the moving  
party may satisfy its burden of production by pointing to an absence of evidence supporting the  
non-moving party's case, after which the non-movant must come forward with specific facts to  
demonstrate the existence of a genuine issue for trial. *Matsushita Elec. Indus. Co., Ltd. v. Zenith*

1 *Radio Corp.*, 475 U.S. 574, 586–87 (1986).

2 **III. DISCUSSION**

3 Resh seeks summary judgment on three issues: (1) Defendants have infringed claims 2, 11,  
4 16, 18–21 of the '852 Patent; (2) Defendants failed to prove invalidity; and (3) Defendants have  
5 failed to sufficiently corroborate two items of prior art with respect to the '852 Patent. Resh  
6 Mot. 1. For their part, Defendants oppose Resh's motion and also move for summary judgment of  
7 (1) invalidity of claims 1–3, 6–8, 11, 16, 18–19, and 21–24 (the "Challenged Claims") of the '852  
8 Patent as anticipated under 35 U.S.C. § 102; (2) invalidity of the Challenged Claims as obvious  
9 under 35 U.S.C. § 103; and invalidity of claim 20 for lack of written description under 35 U.S.C.  
10 § 112. Defendants also move to preclude Resh from introducing expert testimony from Eric Resh.

11 The Court begins by addressing the motion to exclude, the outcome of which may impact  
12 resolution of the motion for summary judgment. The Court will then resolve the issues raised in  
13 the motions for summary judgment, starting with infringement and followed by invalidity.

14 **A. Motion to Exclude**

15 Defendants argue that Resh should be precluded from introducing "expert testimony from  
16 Eric Resh" at summary judgment or trial. Mot. to Preclude 1. The deadline to provide  
17 designations of opening experts with reports was March 27, 2024. On that date, Resh served a  
18 document stating "at this time, Plaintiff Resh does not designate any experts but reserves the right  
19 to designate rebuttal experts. Additionally, Resh also notes that, based on the expertise of Eric  
20 Resh, he may provide lay opinion testimony." Plaintiff's Designation of Opening Experts with  
21 Reports, ECF No. 125-1 at 4. Defendants contend that, if Resh intended to provide testimony  
22 based on the "expertise" of its founder, Eric Resh, then it was required to provide a proper expert  
23 disclosure for Mr. Resh under Federal Rule of Civil Procedure 26.

24 In response, Resh explains that the above statement should have included the word  
25 "experience" rather than "expertise." ECF No. 127. In other words, Mr. Resh is not being offered  
26 as an expert, and Resh "does not intend to have Eric Resh testify outside of the bounds of  
27 appropriate lay opinion testimony." *Id.* The issue is whether Mr. Resh's declaration, despite the

1 above assurances, does nevertheless fall outside the bounds of appropriate lay testimony.

2 Under Federal Rule of Evidence 701, a lay witness may provide opinions “rationally based  
3 on the witness’s perception” that are “not based on scientific, technical, or other specialized  
4 knowledge within the scope of Rule 702.” *United States v. Holmes*, No. 22-10312, 2025 WL  
5 583307, at \*6 (9th Cir. Feb. 24, 2025) (citing Fed. R. Evid. 701). “[W]hether evidence is more  
6 properly offered by an expert or a lay witness depends on the basis of the opinion, not its subject  
7 matter.” *Id.* (quotations omitted). If the basis of a witness’s opinion is “technical or specialized  
8 knowledge,” then that opinion falls within Rule 702. *Id.* But if the basis of the opinion is “just  
9 familiarity with the subjects,” then it is proper lay opinion under Rule 701. *Id.*

10 Although Resh conceded it “does not intend to have Eric Resh testify outside of the bounds  
11 of appropriate lay opinion testimony,” it simultaneously argues that Eric Resh, as the inventor,  
12 “may qualify as an expert and testify what his claims would mean in the relevant art.” *See* Resh  
13 Reply 6 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 991). Both cannot be true.  
14 If Eric Resh is a lay witness, he cannot testify on matters that are within the scope of expert  
15 testimony. If he is an expert witness, he should have been designated under the procedure outlined  
16 in Rule 26. Because he was not designated as an expert witness, the Court treats him as a lay  
17 witness.

18 The Court takes some issue with the Resh Declaration because Mr. Resh, a lay witness,  
19 opines on issues traditionally reserved for experts requiring specialized knowledge. For example,  
20 Mr. Resh repeatedly discusses what a person of skill in the art (POSA) would have understood,  
21 what a POSA would have been motivated to do, and whether a POSA would have had a  
22 reasonable success in modifying inventions in a particular way. *See, e.g.*, Resh Decl. ¶¶ 54–59,  
23 ECF No. 126-2 at 37. The declaration also extensively discusses the structure, operation, and  
24 function of various poles.

25 In *Fresenius*, the court resolved a dispute over whether an individual’s declaration  
26 provided “solely lay testimony, solely expert testimony, or a combination of both lay and expert  
27 testimony.” *Fresenius Med. Care Holdings, Inc. v. Baxter Int’l, Inc.*, No. 597, 2006 WL 1330002,

1 at \*3 (N.D. Cal. May 15, 2006). The court explained that when “declarants compare [prior art] to  
2 the patent, they provide testimony that ... requires specialized knowledge,” and “this they are not  
3 permitted to do as laypersons.” *Id.* (cleaned up). At the same time, “courts regularly allow lay  
4 witnesses” to “testify with regard to their personal knowledge of a particular invention or piece of  
5 prior art.” *Id.* With that in mind, the *Fresenius* court ultimately permitted the witness testimony  
6 limited to his “personal knowledge regarding the machine and the way that it operates” but  
7 prohibited the witness from “comparing the [prior art] to the [asserted patent].” *Id.*

8 Similarly, in *Briese Lichttechnik Vertriebs GmbH v. Langton*, the court considered whether  
9 to strike the defendant’s (a lay witness) declaration for improperly offering expert testimony in a  
10 patent case involving relatively uncomplicated technology—umbrella-shaped light reflectors for  
11 use in photograph and videography. No. 09 CIV. 9790 LTS MHD, 2012 WL 5457681, at \*6  
12 (S.D.N.Y. Nov. 8, 2012). Based on his personal experience and background with the accused  
13 products, the witness testified that three elements of an asserted claim did not appear in the  
14 accused product. The court permitted his testimony “as a lay witness on the structure and  
15 operation of the [accused products]” given his experience working with the relevant equipment but  
16 prohibited him from “pars[ing] the terms of the patent claims to opine as to whether the patent  
17 reads on the [accused product]” or “mapping the claim language of the patent to the structures in  
18 the accused [product].” *Id.* at \*6.

19 The Court finds persuasive *Fresenius* and *Briese*’s treatment of similar testimony and will  
20 follow those courts’ guidance. Here, given the straightforward nature of the technology involved  
21 in this case and Mr. Resh’s experience and background with the relevant products, the Court will  
22 permit him to testify as to the structure and operation of the pool poles to the extent they are not  
23 based on specialized knowledge. Even if he has personal knowledge of the pool poles based on  
24 his experience in the industry, “there is no ‘on the job’ exception to Rule 702.” *Holmes*, 2025 WL  
25 583307, at \*8. Thus, any opinions that rely on his specialized knowledge, training, or skill will be

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1 stricken as expert testimony—this includes testimony regarding what a POSA<sup>2</sup> would or would not  
2 understand or do, the comparison of patent claims to accused products or prior art poles, and any  
3 ultimate opinion as to invalidity or infringement resulting from his lay observations.

4 Accordingly, “some statements in the [Resh] Declaration exceed the scope of lay  
5 testimony and should be stricken.” *See Fresenius*, 2012 WL 5457681, at \*6. The Court will strike  
6 the paragraphs of Mr. Resh’s declaration that impermissibly wade into testimony requiring  
7 specialized knowledge. But the paragraphs discussing the structure and operation of the pool  
8 poles will not be disturbed, even if they are discussed in the context of the prior art.

9 Defendants’ motion to exclude is therefore GRANTED IN PART. The Court will  
10 STRIKE paragraphs 21–25, and 42–46, 52–55, 57, and 59 of the Resh Declaration as proffering  
11 testimony that requires specialized knowledge. As for paragraphs 12–19, the Court finds them  
12 deficient for a separate reason. Those paragraphs, which concern when certain pool pole  
13 competitors “began making, selling, and offering for sale” certain poles, lack any foundation as to  
14 how Mr. Resh has personal knowledge about the contents of those paragraphs. Because that issue  
15 can be remedied, the Court will not strike them but will not consider them when ruling on the  
16 present motions.

17 With the above ruling in mind, the Court turns to the arguments regarding infringement  
18 and invalidity.

19 **B. Infringement**

20 Resh seeks summary judgment that Defendants’ “two-tube poles” infringe claims 2, 11,  
21 16, and 18, 19, and 21, and Defendants’ “three tube poles” infringe claim 20 of the ’852 Patent.  
22 Although judgment in favor of Defendants is appropriate with respect to the Challenged Claims  
23 for being invalid as obvious, the Court nonetheless considers the parties’ infringement arguments,  
24 which are relevant to claim 20.<sup>3</sup>

25 \_\_\_\_\_  
26 <sup>2</sup> As described below, the parties agree for this motion that the POSA would be someone with  
specialized knowledge.

27 <sup>3</sup> Claim 20 is not subject to the obviousness ruling because Defendants did not move for summary  
judgment of invalidity based on obvious for that claim.

1                   **1. Evidentiary Issues**

2                   Before reaching the substantive infringement arguments, the Court will address the  
3 “evidentiary failures” Defendants contend preclude summary judgment.<sup>4</sup> Defendants’ Mot. 21.

4                   **a. Representative Models**

5                   Resh asserts that Defendants’ Model 6016 is representative of all the two-tube pole models  
6 and Defendants’ Model 6317 is representative of all three-tube pole models for three reasons: first,  
7 Eric Resh stated as much in his declaration. *See* Resh Decl. ¶ 6 (“Of the Accused Products, (a)  
8 Defendants’ Model 6016 is representative of all ‘2 tube’ models/versions of the Accused Products  
9 and (b) Defendants’ Model 6317 is representative of all ‘3 tube’ models/versions of the Accused  
10 Products.”). Second, Conrad Sr. testified as to whether his “button-style poles” generally have  
11 certain limitations of the ’852 Patent. J. Conrad Dep. 184:2–5, ECF No. 126-2 at 163. Conrad Sr.  
12 continued to answer questions about the poles grouped together, without identifying any  
13 meaningful difference between the poles such that that they needed to be treated separately.  
14 Third, in responding to interrogatories, Defendants identified limitations it contended were not  
15 present in “each of the Accused Products.” Skimlite Resp. to Second Set of ROGs 5, ECF No.  
16 126-2 at 152. In other words, Defendants themselves group the products together and failed to  
17 identify any meaningful difference for purposes of evaluating infringement.

18                   The Court finds that Resh has met its burden to show that Defendants’ Model 6016 is  
19 representative of all the two-tube pole models, and Defendants’ Model 6317 is representative of  
20 all three-tube pole models for purposes of patent infringement. Conrad Sr. made no effort to  
21 distinguish between models during his deposition, and, other than for claim 20, Defendants  
22 identified no difference among the “Accused Products” when responding to Resh’s interrogatories.  
23 Even for claim 20, although Defendants state that their interrogatory response is limited to the  
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25 \_\_\_\_\_  
26 <sup>4</sup> Defendants argue that Exhibit 7, the deposition transcript of Jim Conrad, should be excluded as  
27 not authenticated because there is no reporter’s certificate. Defendants’ MSJ 21. The Court is  
28 surprised this minor oversight was not resolved informally. Moreover, the issue has since been  
resolved. *See* 132-1, Ex. 26. Further disputes regarding Conrad Sr.’s deposition testimony are  
addressed below.

1 “specific model numbers” 6317 and 6323 because “[o]ther models would lack several additional  
2 features in Claim 20,” they *do not actual identify* the additional features. Skimlite Resp. to Second  
3 Set of ROGs 7. This is not enough to raise a genuine factual dispute regarding whether claim 20  
4 can apply to the other models—particularly where Defendants failed to articulate any differences  
5 between the models beyond the above conclusory statement.

6 In *Kenexa*, the court rejected defendants’ argument that plaintiff failed to prove their  
7 products function in the same manner for purposes of infringement where defendants responded to  
8 an interrogatory “specifically ask[ing] defendants why each product did not infringe,” yet  
9 defendants “responded in the same manner for all.” *Kenexa Brassring, Inc. v. Taleo Corp.*, 751 F.  
10 Supp. 2d 735, 747 (D. Del. 2010). The court also found persuasive defendants’ testimony  
11 explaining “how the products worked without differentiating any differences between them.” *Id.*  
12 So too here, based on the interrogatory response and Defendants’ past treatment of the products as  
13 a whole during deposition, Resh has shown its proposed representatives are appropriate. *See*  
14 *Carnegie Mellon Univ. v. Marvell Tech. Grp., Ltd.*, 807 F.3d 1283, 1295 (Fed. Cir. 2015)  
15 (discussing products together where defendant failed to “identif[y] differences between them  
16 material to the outcome”).

17 Defendants contend that the selected models are not representative, citing opinions from  
18 their expert, Mr. Pratt. *See* Pratt Resp. Rep. ¶ 34, ECF No. 129-3 at 476.<sup>5</sup> That paragraph simply  
19 states that “Resh also bears the burden of demonstrating that each model of the Accused Products  
20 infringes.” *Id.* ¶ 34, ECF No. 129-3 at 490. Mr. Pratt then “proceeds in the same manner as  
21 Resh’s contentions” and “analyz[e] models 6016 and 6317 as representative of the other models of  
22 Accused Products.” *Id.* He does not opine on the differences between the models or otherwise  
23 provide any basis for why the selected representative models cannot serve as representatives.

24 Accordingly, there is no genuine dispute that Models 6016 and 6317 can be treated as  
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26 <sup>5</sup> Defendants cite *L&W, Inc. v. Shertech, Inc.*, 471 F.3d 1311 (Fed. Cir. 2006). There, the Federal  
27 Circuit concluded that an infringement expert could not assume “without support” that one  
28 accused product was “typical” of all the accused products. Resh’s typicality showing here was  
sufficient.

1 representative for an infringement analysis.

2 **b. Infringing Acts by the Conrads**

3 Defendants argue that Resh submitted no evidence regarding any infringing act taken by  
4 either Barrett Conrad or James Conrad. Defendants refer to their motion to dismiss the Second  
5 Amended Complaint, in which they sought to dismiss claims against the Conrads. *See* ECF No.  
6 115. The Court dismissed all claims against Conrad Jr. for improper venue, and dismissed  
7 induced infringement claims against Conrad Sr. *See* ECF No. 18. Although the Court declined to  
8 dismiss direct infringement claims against Conrad Sr., Resh has not met its burden to show that  
9 summary judgment as to Conrad Sr.’s personal liability is appropriate. Resh states that it  
10 “continues to submit that [the Conrads] are liable for the reasons previously submitted in  
11 opposition to” Defendants’ motion to dismiss but does not otherwise refer to any evidence in the  
12 record.

13 Accordingly, the Court denies as moot Resh’s motion as to direct infringement of Conrad  
14 Jr. as resolved in the Court’s prior order. Nor is Resh entitled to summary judgment of direct or  
15 indirect infringement of Conrad Sr. based on his reference to arguments made in opposing  
16 Defendants’ motion to dismiss.

17 **c. Evidence of the Structure of Accused Products**

18 Defendants argue Resh submitted no evidence regarding “the structure” of any of the six  
19 different models of poles it accuses of infringement and failed to explain how each of the Accused  
20 Products meet the claims. Defendants’ Mot. 21 (citing *Traxcell Techs., LLC v. Sprint Comm’ns*  
21 *Co.*, 15 F.4th 1121, 1130 (Fed. Cir. 2021) and *Cellspin Soft, Inc. v. Fitbit, Inc.*, 2022 WL 2784467,  
22 at \*7 (N.D. Cal. June 15, 2022)). The Court declines to deny Resh’s summary judgment motion  
23 of infringement on this basis. Resh has attached to his motion declarations, various filings in this  
24 case, deposition transcripts, interrogatory responses, and other bates-stamped documents. It is  
25 unclear what additional “evidence” Defendants believe is required.

26 Nor is *Traxcell*, a case involving alleged infringement of four patents relating to self-  
27 optimizing wireless networks and navigation technology, persuasive here. The Federal Circuit in

1 that case agreed plaintiff had failed to create a genuine issue about whether defendant’s accused  
2 technology met the asserted claims. *Traxcell*, 15 F.4th at 1130. The infringement allegations  
3 involved use of self-optimizing network technology and mobile devices. This case is starkly  
4 different. The ’852 Patent relates to components and structures of pool poles, and the Accused  
5 Products are pool poles. Unlike the complex infringement theory asserted in *Traxcell*, Resh’s  
6 infringement theory is straightforward, and Resh supplies a sufficiently detailed basis for that  
7 theory.

8 **2. Whether the Accused Products Infringe the Asserted Claims**

9 A patent is directly infringed when a person “without authority makes, uses, offers to sell,  
10 or sells any patented invention, within the United States or imports into the United States any  
11 patented invention during the term of the patent.” 35 U.S.C. § 271(a). Determining infringement  
12 is a two-step analysis. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995)  
13 (en banc), aff’d, 517 U.S. 370 (1996). First, the court must construe the asserted claims to  
14 ascertain their meaning and scope. *Id.* The trier of fact must then compare the properly construed  
15 claims with the accused infringing product. *Id.* This second step is a question of fact. *Bai v. L &*  
16 *L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998). The patent owner bears the burden of  
17 proving infringement by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena*  
18 *Lab’ys Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988).

19 “Literal infringement of a claim exists when every limitation recited in the claim is found  
20 in the accused device.” *Kahn v. Gen. Motors Corp.*, 135 F.3d 1472, 1477 (Fed. Cir. 1998). “If  
21 any claim limitation is absent from the accused device, there is no literal infringement as a matter  
22 of law.” *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). A  
23 product that does not literally infringe a patent claim may still infringe under the doctrine of  
24 equivalents if the differences between an individual limitation of the claimed invention and an  
25 element of the accused product are insubstantial. *See Warner–Jenkinson Co. v. Hilton Davis*  
26 *Chem. Co.*, 520 U.S. 17, 24 (1997). The patent owner has the burden of proving infringement and  
27 must meet its burden by a preponderance of the evidence. *See SmithKline*, 859 F.2d at 889

1 (citations omitted).

2 Resh argues Defendants’ February 15, 2024 Interrogatory responses prove infringement  
3 because Defendants identify only two claim elements as not present in the Accused Products.  
4 Resh Mot. 5; *see also* SUF ¶ 9. The Interrogatory response states that, for claim 2, the following  
5 two elements “are not present in each of the Accused Products”: (1) “said second end of said outer  
6 tube having structure for removably attaching a tool” (the “structure element”); and (2) “said first  
7 end of said inner tube including a grip attached to the inner tube for a user to grasp and manipulate  
8 the apparatus” (the “grip element”). Skimlite Resp. to Second Set of Interrogatories at 6. For  
9 claims 11, 16, 18, and 19, Defendants state that “[t]he Accused Products do not infringe [these  
10 claims] for at least the same reasons that they do not infringe Claim 2 from which [they]  
11 depend[.]” *Id.* at 6–7. And for claim 21, Defendants identified only the “structure element” as  
12 missing. *Id.* at 7.

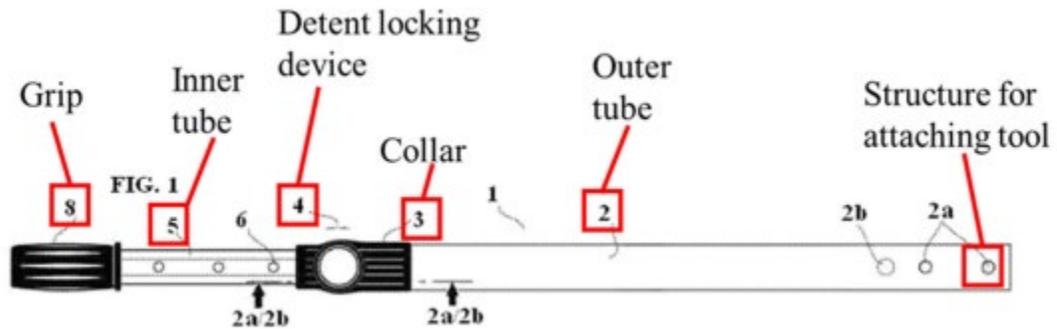
13 Consistent with the Interrogatory response, Defendants’ expert, Mr. Pratt, opined only as  
14 to why the Accused Products lack the above two limitations: the structure and grip elements.  
15 *See* Pratt Responsive Rep. ¶¶ 57–60 (opining that the Accused Products do not infringe claim 2  
16 because they lack the structure and grip elements); 61 (opining that the Accused Products do not  
17 infringe claims 11, 16, 18, and 19 for same reason); and 75–81 (opining that the Accused Products  
18 do not infringe claim 21 because they lack the structure element).

19 Thus, the salient issue for determining infringement is whether Defendants’ dispute over  
20 these two limitations is genuine. *See* Defendants’ Mot. 22 (“[S]ummary judgment should still be  
21 denied because there are genuine disputes of material fact as to the presence of [these] claim  
22 limitations.”). The Court addresses the two limitations below.

23 **a. Structure Element**

24 Claims 2 and 20 recite a “structure for removably attaching a tool,” and claim 21 recites an  
25 “attachment means for removably attaching a tool.” Although Defendants now argue that the  
26 holes on the Accused Products should not be treated as a “structure” or “attachment,” they took  
27 the opposite position during claim construction briefing. In describing the technological

1 background of the '852 Patent, Defendants' responsive claim construction brief explained that the  
 2 claims recite "common features including 'a structure for removably attaching a tool' (e.g., holes  
 3 2a)." Defendants' Responsive Claim Construction Brief 2–3, ECF No. 49. In other words,  
 4 Defendants explained that the holes in Figure 1, *are the structure* for attaching a tool. If there was  
 5 any doubt, Defendants' claim construction brief also annotated Figure 1 from the patent as shown  
 6 below, identifying the holes with the label "structure for attaching tool."



13 *Id.* at 3.

14 Despite the unambiguous representation above, Defendants now argue that this  
 15 interpretation is inconsistent with the '852 Patent. Defendants' Mot. 22. Mr. Pratt explains that  
 16 "[h]oles are a void" where "no structure is present." Pratt Resp. Rep. ¶ 43; *see also id.* ¶¶ 44–45  
 17 (explaining that the '852 Patent "discloses that the holes receive other structures" and opining that  
 18 these descriptions "are consistent with the plain and ordinary understanding that holes are voids  
 19 and not structures"). But this opinion cannot be reconciled with Defendants' prior explicit  
 20 representation that the holes were the structure for attaching a tool. Particularly when Conrad Sr.  
 21 agreed during his deposition the Accused Products "have structure for removably attaching a  
 22 tool." J. Conrad Dep. 192:7–11.

23 Defendants appear to be seeking a belated construction of the term "structure" to exclude  
 24 holes. The Court declines to do so when Defendants previously had the opportunity to seek  
 25 construction of the term. Although courts "may engage in rolling claim construction, in which the  
 26 court revisits and alters its interpretation of the claim terms as its understanding of the technology  
 27 evolves," this is not one of those situations. *Conoco, Inc. v. Energy & Env't Int'l, L.C.*, 460 F.3d

1 1349, 1359 (Fed. Cir. 2006); *see also Fujifilm Corp. v. Motorola Mobility LLC*, No. 12-CV-  
2 03587-WHO, 2015 WL 757575, at \*5 (N.D. Cal. Feb. 20, 2015) (citations and quotations omitted)  
3 (“While district courts retain discretion to hear belated claim construction arguments, ... they are  
4 not obligated to rule on such arguments when raised for the first time in summary judgment  
5 briefs”). Defendants’ only justification for now arguing that holes are not a “structure” or  
6 “attachment means” under the ’852 Patent is because “[a]s the case developed, it became clear that  
7 labeling the ‘holes’ as [a structure] was inconsistent with the ’852 patent.” Defendants’ Mot. 23,  
8 n.3. The Court is not persuaded. Defendants identify no reason why they could not have analyzed  
9 the patent sooner and developed this theory at the time of claim construction or otherwise  
10 requested a construction of the term sooner.

11 Accordingly, there is no genuine dispute that the “structure element” is present in the  
12 Accused Products.

13 **b. Grip Element**

14 Defendants argue that the Accused Products lack “a grip attached to the inner tube” as  
15 required by claims 2, 11, 16, and 18–20. Although Conrad Sr. testified that the Accused Products  
16 meet this limitation (*see* J. Conrad Dep. 192:7–193:2), Defendants contend that the Accused  
17 Products lack this feature based on a read of the ’852 Patent specification. Defendants’ Mot. 22.  
18 The ’852 Patent distinguishes the claimed devices from prior art poles where the grip merely  
19 “fit[s] very tightly” over the tube, but “can be knocked off the end of the inside tube.” *Id.*  
20 Because the grips on the Accused Products “fit very tightly over the tube, can be knocked off, and  
21 do not include a rivet or screw,” Defendants argue the Accused Products’ grip do not meet the grip  
22 as described in the claims. For this argument, Defendants rely on Mr. Pratt, who opines that the  
23 grips on the Accused products do not meet the claim limitation because they are not “attached” in  
24 the way described by the specification. *See* Pratt Responsive Rep. ¶¶ 48–53, 59–60, 73–74.

25 Resh argues that Defendants are again seeking a belated construction of “grip” to cover  
26 only grips attached to the pole by screws or rivets. Resh Mot. 5–6. The Court agrees. During  
27 claim construction, Defendants characterized the “grip” of the ’852 Patent as a “common feature.”

1 It did not seek a construction of the term. The Court thus construes “grip” as having its plain and  
2 ordinary meaning. And the plain and ordinary meaning of grip does not cover only those grips  
3 attached using screws or rivets. Again, Defendants provide no justification regarding why it failed  
4 to seek a construction of grip at the appropriate time.

5 Accordingly, no genuine dispute exists over whether the “grip” limitation is present in the  
6 Accused Products.

7 \* \* \*

8 Resh’s motion for summary judgment as to infringement of claims 2, 11, 16, 18–21 of the  
9 ’852 Patent is GRANTED as set forth above but DENIED as to any infringement against the  
10 Conrads.

11 **C. Invalidity**

12 Both parties ask the Court to resolve invalidity issues on summary judgment. Defendants  
13 seek summary judgment of invalidity of the Challenged Claims in view of the (1) the A.G. Pro  
14 pole, (2) U.S. Patent Publication No. 2010/0244475 (“Hatcher”), and/or (3) the Skimlite 5008 pole  
15 in combination with U.S. Patent No. 5,220,707 (“Newman”). Defendants also seek summary  
16 judgment that claim 20 is invalid under § 112 for lack of written description. Resh moves for  
17 summary judgment on invalidity in his favor because Defendants failed to corroborate the A.G.  
18 Pro Pole and the Solakian Pole.

19 “A moving party seeking to invalidate a patent at summary judgment must submit such  
20 clear and convincing evidence of invalidity so that no reasonable jury could find otherwise.”  
21 *Boston Sci. Corp. v. Cordis Corp.*, 422 F. Supp. 2d 1102, 1108 (N.D. Cal. 2006).

22 **1. Anticipation**

23 The Challenged Claims are invalid if the A.G. Pro Pole or the Solakian Pole (1) were  
24 “known or used by others” in the United States, or “patented or described in a printed publication”  
25 anywhere before, September 2011, or (2) were “in public use or on sale” in the United States more  
26 than one year before September 2011. 35 U.S.C. §§ 102(a)–(b). To establish that an asserted  
27 reference is prior art under § 102(b), the patent challenger must prove, by clear and convincing

1 evidence, that it predates the critical date. *ATEN Int'l Co. v. Uniclass Tech. Co.*, 932 F.3d 1364,  
2 1368 (Fed. Cir. 2019) (citations omitted).

3 Whether a reference is prior art is a question of law based on underlying factual questions.  
4 *ATEN*, 932 F.3d at 1367 (citing *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151,  
5 1157 (Fed. Cir. 2004)). Whether a reference is publicly accessible is a question of fact. *Id.* (citing  
6 *In re NTP, Inc.*, 654 F.3d 1279, 1296 (Fed. Cir. 2011)). The '852 Patent claims priority to  
7 U.S. Provisional Application Ser. No. 61/538,074, filed Sep. 22, 2011. To establish that the A.G.  
8 Pro Pole or the Solakian Pole qualifies as prior art, Defendants must prove by clear and  
9 convincing evidence that it existed prior to September 22, 2011. *See ATEN*, 932 F.3d at 1368.

10 **a. The A.G. Pro Pole**

11 Defendants contend that the A.G. Pro Pole (shown below), allegedly made, used, offered  
12 for sale, and sold as early as 2000 by a pool man named Ray Leduc, is prior art and renders the  
13 '852 Patent invalid.



14  
15  
16  
17 Defendants argue that the A.G. Pro Pole is invalidating prior art to the '852 Patent because  
18 it contains all elements of the Challenged Claims and because the pole was known, used, offered  
19 for sale, and sold in the United States many years before September 2011. In support, Defendants  
20 rely primarily on the testimony of Mr. Leduc, the inventor. Mr. Leduc testified that he made his  
21 first A.G. Pro pole from a Mr. Long Arm pole that he purchased at Home Depot. He altered the  
22 pole using adapters and testified that he publicly used the pole to clean his client's pools in the  
23 early 2000s. Leduc Decl. ¶¶ 7–10, ECF No. 129-3 at 163; Leduc Dep. 56:17–57:16–20, ECF No.  
24 129-3 at 181.<sup>6</sup> He testified that he stored the pole in the back of his truck so that it was publicly  
25 visible and gave the pole to Arthur Grimmit, the person who sold Mr. Leduc the adapters that he

26  
27 <sup>6</sup> The A.G. Pro Pole in Defendants' possession is identified and referred to at points in the parties'  
28 briefings as "Exhibit 88."

1 affixed to the Mr. Long Arm poles. Mr. Grimmit testified that he received the pole and used it to  
2 clean his pool in the early 2000s. Grimmit Dep. 25:3–26:18, ECF No. 129-3. Additionally,  
3 Mr. Leduc purportedly sold his pole to Superior Pool Products (“SCP”), a southern California pool  
4 store. An SCP employee, Danny Cervantez, testified that he purchased the poles from Mr. Leduc  
5 on behalf of SCP. Cervantez Dep. 23:3–24:17, ECF No. 129-3 at 285.

6 Resh disputes Defendants’ showing on several grounds, but mainly because Defendants  
7 have not sufficiently corroborated Mr. Leduc’s testimony about the A.G. Pro Pole. “The law has  
8 long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence  
9 absent other evidence that corroborates that testimony.” *Finnigan Corp. v. Int’l Trade Comm’n*,  
10 180 F.3d 1354, 1366 (Fed. Cir. 1999). Here, Defendants do proffer some evidence corroborating  
11 the mere testimonial evidence. Defendants produced Exhibit 88, “an original A.G. Pro Pole,” and  
12 multiple boxes of what Mr. Leduc claims are left over grips and adapters that he used to make the  
13 A.G. Pro poles. Mr. Leduc also provided invoices dated in 2000 or 2001 documenting his  
14 purchase of the components. And Mr. Cervantes testified that he purchased the poles from  
15 Mr. Leduc on behalf of SCP and verified that the store created vendor records when a party sold a  
16 pole.

17 Despite the above evidence, genuine factual disputes preclude summary judgment for both  
18 parties as to whether the AG Pro Pole qualifies as invalidating prior art. Resh has raised  
19 legitimate challenges to Defendants’ proffered evidence. For instance, the pole at issue is more  
20 than 20 years old. Exhibit 88, the only physical example, is undated, and Defendants rely on  
21 Mr. Leduc’s testimony to explain when Exhibit 88 was assembled. While it is possible that  
22 Mr. Leduc used the components identified in the boxes to construct the A.G. Pro Pole over twenty  
23 years ago, a fact finder must weigh the credibility of his story. Beyond the testimony of the  
24 inventor himself, Defendants rely on invoices for commercially available components used by  
25 pool workers. The invoices confirm that the components were purchased at the relevant time, but  
26 they do not establish that Mr. Leduc used those components to assemble Exhibit 88. And the  
27 vendor record confirms that Mr. Leduc was a vendor at SPC, but it does not show what Mr. Leduc

1 sold. Nor have Defendants produced receipts from sales from the pole at the relevant time.  
2 Additionally, Resh cites to the declaration of Tom Carlisi, whose testimony raises doubts to Mr.  
3 Leduc’s story.<sup>7</sup> Mr. Carlisi states that at least once a week every week from 1999–2001, he went  
4 into the pool distributor store where Mr. Leduc purportedly sold the A.G. Pro Poles, but he never  
5 saw an AG Pro Pole in the stores. He also attests that he never saw the pole in the back of  
6 Mr. Leduc’s truck with Mr. Leduc’s pool cleaning tools, or in any pool man’s truck, and more  
7 generally, he never saw or heard anything about the AG Pro pole. Holland Decl. Ex. 12.

8 Holistically, Defendants tell a compelling story about the pool pole and its origins, but  
9 summary judgment must be denied even under a rule of reason because of genuine factual disputes  
10 over whether the physical Exhibit 88 was the original A.G. Pro Pole and whether it was offered for  
11 sale or sold during the 2000–2001 timeframe. Those issues are more appropriately resolved by a  
12 fact finder.<sup>8</sup>

13 Accordingly, neither party is entitled to summary judgment as to whether the AG Pro Pole  
14 renders the ’852 Patent invalid.

15 **b. Solakian Pole**

16 Resh seeks summary judgment that Defendants have not sufficiently corroborated the  
17 Solakian Pole, a physical pool pole Defendants assert as prior art. Defendants respond that three  
18 witnesses testified that they and others in the industry “knew of the pole long before the priority  
19 date of the ’852 patent.” Defendants Mot. One of the declarants is Mike Solakian, who testifies  
20 that an unidentified person brought a prototype (the Solakian Pole) to Mr. Solakian’s business.  
21 Solakian Decl., ECF No. 126-2 at 222. The second declaration is from Dick Gross who testifies  
22 that the Solakian Pole was stored at one of his company’s shops from about 2002–2012. D. Gross  
23

24 \_\_\_\_\_  
25 <sup>7</sup> Even if Mr. Carlisi’s testimony is “purely negative” such that it should be given “no great value,”  
26 the Court finds it, combined with the other evidence in the record casting doubt on the A.G. Pro  
27 Pole’s origins, is sufficient to defeat summary judgment. *See* Defendants’ Reply 11 (quoting *The*  
28 *Barbed Wire Cases*, 143 U.S. 275, 288 (1892)).

<sup>8</sup> Because the Court concludes factual issues surrounding the assembly and timing of the A.G. Pro Pole preclude summary judgment, the Court need not evaluate whether the pole contains all elements of the relevant claims.

1 Decl., ECF No. 126-2 at 231. The third is from Mr. Gross’s son, Rich Gross who attested to  
2 similar facts as his father regarding the Solakian Pole. R. Gross Decl., ECF No. 129-3 at 112.

3 The Court agrees these declarations, combined with the existence of physical pole itself,  
4 raise a genuine dispute regarding whether the Solakian Pole existed prior to September 22, 2011.

5 Resh raises no other issues with respect to the Solakian Pole’s status as potential prior art.  
6 Because factual disputes remain surrounding the genesis of the Solakian pole, summary judgment  
7 of no invalidity based on the Solakian Pole is not appropriate.

8 \* \* \*

9 For the foregoing reasons, summary judgment is DENIED for both parties as to invalidity  
10 based on anticipation.

11 **2. Obviousness**

12 A patent claim is invalid as obvious under 35 U.S.C. § 103 “if the differences between the  
13 claimed invention and the prior art are such that the claimed invention as a whole would have been  
14 obvious before the effective filing date of the claimed invention to a person having ordinary skill  
15 in the art to which the claimed invention pertains.” 35 U.S.C. § 103; *see also KSR Int’l Co. v.*  
16 *Teleflex Inc.*, 550 U.S. 398, 406–07 (2007). “Under § 103, the scope and content of the prior art  
17 are to be determined; differences between the prior art and the claims at issue are to be  
18 ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background,  
19 the obviousness or nonobviousness of the subject matter is determined.” *KSR*, 550 U.S. at 406  
20 (citations and quotation marks omitted). Assessing obviousness is based on an “expansive and  
21 flexible approach” that “need not seek out precise teachings directed to the specific subject matter  
22 of the challenged claim, for a court can take account of the inferences and creative steps that a  
23 person of ordinary skill in the art would employ.” *Janssen Pharms., Inc. v. Teva Pharms. USA,*  
24 *Inc.*, 97 F.4th 915, 925 (Fed. Cir. 2024) (citations omitted).

25 The Federal Circuit has emphasized the “clear distinction in [its] case law between a patent  
26 challenger’s burden to prove that a skilled artisan would have been motivated to combine prior art  
27 references and the additional requirement that the patent challenger also prove that the skilled

1 artisan would have had a reasonable expectation of successfully achieving the claimed invention  
2 from the combination.” *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1344 (Fed.  
3 Cir. 2021). These are separate requirements; a finding that Defendants have demonstrated a  
4 motivation to combine prior art references does not necessarily mean that they have also  
5 demonstrated a reasonable expectation of success in achieving the claimed invention by doing so.  
6 *Id.*

7 **a. The Level of Ordinary Skill in the Art**

8 Defendants’ expert opines that a POSA would likely have had either a high school  
9 education and at least 4 years of experience in the mechanical arts, such as mechanical, industrial,  
10 or general engineering, or a bachelors’ degree in mechanical, industrial, or general engineering  
11 and at least one year of work experience. Pratt Decl. ¶ 65. Resh contends that the level of  
12 ordinary skill in the art is “a pool man who has worked at least 2–3 years in the field [of  
13 swimming pool telescoping poles] cleaning swimming pools.” See Resh’s Response to  
14 Interrogatory No. 11.

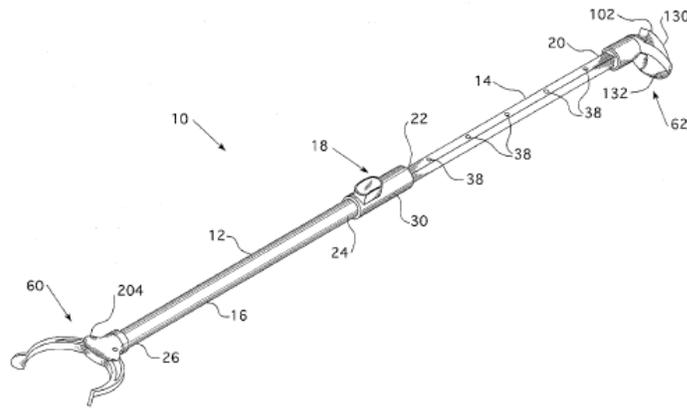
15 Although he disagrees with the relevant “field” for the ’852 Patent, Mr. Pratt states his  
16 opinions “would not change” if the Court adopts Resh’s position. Pratt Decl. ¶ 66. The Court  
17 therefore applies Resh’s definition of a POSA for purposes of these motions.

18 **b. Hatcher**

19 For Hatcher, Defendants assert only obviousness as a basis to invalidate the Challenged  
20 Claims. See Defendants’ Reply 1 (“Defendants do not contend that Hatcher anticipates the  
21 asserted claims.”). “Though less common, in appropriate circumstances, a patent can be obvious  
22 in light of a single prior art reference if it would have been obvious to modify that reference to  
23 arrive at the patented invention.” *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir.  
24 2016).

25 Hatcher was published on September 30, 2010 and describes an “extendable reaching  
26 tool.” The publication explains that extendable tools, such as the one described in Hatcher, can be  
27 used to reach objects close or remote. For example, a person picking fruit may need a short tool to

1 reach fruit slightly out of reach, or they may need a longer tool for fruit near the top of the tree.  
 2 Hatcher [0002]. Hatcher explains that the claimed concept provides for an easy to assemble  
 3 extendable tool with an internal drive assembly. Below shows Figure 1 from Hatcher:



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 11  
 12 Resh admits that Hatcher discloses most limitations of the Challenged Claims.  
 13 SUF ¶¶ 163–168, 176–178, 180–188, 191–196, 200–201, 212 (limitations 1[pre]-1[e], 1[g]-1[i],  
 14 2[pre]-2[b], 2[d]-2[i], 6-8, 11, 16, 18, 21[pre]-21[c], 21[e]-21[h], and 24). But he disputes that  
 15 Hatcher discloses the “structure for removably attaching a tool” and raises a few additional  
 16 arguments as to Hatcher, addressed below. To be clear, though, it is Defendants’ burden “to prove  
 17 by clear and convincing evidence that a skilled artisan would have been motivated to combine the  
 18 teachings of the prior art references to achieve the claimed invention, and that the skilled artisan  
 19 would have had a reasonable expectation of success in doing so.” *Novartis Pharm. Corp. v. W.-*  
 20 *Ward Pharm. Int’l Ltd.*, 923 F.3d 1051, 1059 (Fed. Cir. 2019) (citation and internal quotation  
 21 marks omitted). Only then does the burden shift to Resh to raise a genuine dispute of material  
 22 fact.

23 ***Structure for removably attaching a tool (claims 1, 2, 21).*** Independent claims 1, 2, and  
 24 21 of the ’852 Patent require the pole to have a “structure for removably attaching a tool.” Resh  
 25 disputes that the tool disclosed in Hatcher is removably attachable and that Hatcher has such a  
 26 structure. SUF ¶ 169. Citing the Pratt Declaration, Defendants argue that a POSA would have  
 27 found it obvious to modify the end of Hatcher’s pole to removably attach the tool. Pratt Decl.

1 ¶¶ 485–90. Mr. Pratt opines that structures for removably attaching tools were ubiquitous in prior  
2 art telepoles by 2011. *Id.* ¶ 486 (citing Newman at Fig. 1, 1:15–22 (disclosing a threatened post)).  
3 He also opines that a POSA would have recognized the advantages of including a structure for  
4 removably attaching a tool on Hatcher’s device. For example, having a structure for removably  
5 attaching a tool would allow the user to use the telepole for multiple applications, it would make  
6 transporting multiple tools easier, and it could increase the life of the pole. *Id.* ¶¶ 486–88.  
7 Regarding whether a POSA would have had a reasonable expectation of success, Mr. Pratt opines  
8 that it would have been a “straightforward manner of engineering” to adapt these known structures  
9 for use with Hatcher’s pole. *Id.* ¶ 489.

10 In response, Resh relies on paragraphs 52–55 of the Resh Declaration. Because these  
11 paragraphs have been stricken (*see supra* Section III(A)), the Court cannot consider them.  
12 Defendants have provided evidence that a POSA would have found it obvious to modify the end  
13 of Hatcher’s pole to removably attach the tool. Pratt Decl. ¶¶ 482–490. Additionally, Resh  
14 admitted that “telepoles having an outer tube that has structure for removably attaching a tool were  
15 publicly known, used, and sold for cleaning swimming pools before September 22, 2011.” Smith  
16 Decl., Ex. 1012 at RFA 179.

17 Thus, even crediting Resh’s counter evidence that “Hatcher does not lend itself at all to  
18 removing its gripping tool from the end of the pole” (Resh Decl. ¶ 55), this is a situation where the  
19 claimed subject matter involves “the simple substitution” of “one known element” (a pool pole  
20 lacking a structure to attach a tool) with another (a structure for attaching a tool). *See KSR*, 550  
21 U.S. at 417. Here, Defendants have presented clear and convincing evidence that the technique of  
22 having an outer tuber with a structure for removably attaching a tool “has been used to improve”  
23 devices, and the fasteners needed to convert a fixed connection to a removable connection were  
24 known and not inventive in 2011. Pratt Decl. ¶¶ 485–86. Additionally, beyond a conclusory  
25 statement that Hatcher does not lend itself to removing the gripping tool, Resh identifies no  
26 evidence from which the Court can find a genuine dispute.

27 Based on this evidence in the record, Defendants have met its burden regarding this

1 limitation.

2           ***Pole for cleaning a pool (claim 1)***. Claim 1 requires: “the lengths of said outer and inner  
3 tubes when engaged with each other being sufficient to permit a user gripping said first end of said  
4 inner tube to manipulate the swimming pool cleaning tool at the second end of said outer tube  
5 against the bottom of a swimming pool while the user is standing on the side of the pool.” The  
6 Court construed this term to have its plain and ordinary meaning. Defendants contend Hatcher  
7 disclosed this claim or renders it obvious because it is a telescoping pole that is at least long  
8 enough to clean pools, and a POSA would have found it obvious to modify the length of the pole  
9 to suit the pool. Defendants’ Mot. 13 (citing Pratt Decl. ¶¶ 502–504).

10           Resh disputes that Hatcher discloses this term or renders it obvious. In support, he relies  
11 on paragraph 56 of the his declaration, which states: “Hatcher does not disclose ‘the lengths of  
12 said outer and inner tubes when engaged with each other being sufficient to permit a user gripping  
13 said first end of said inner tube to manipulate the swimming pool cleaning tool at the second end  
14 of said outer tube against the bottom of a swimming pool while the user is standing on the side of  
15 the pool’ [Claim 1[j]].” Resh Decl. ¶ 56. This paragraph was not stricken because the testimony  
16 does not rely on specialized knowledge; any lay person looking at Hatcher can observe whether or  
17 not it says the above.

18           That said, even though not stricken, the statement is conclusory and not enough, standing  
19 alone, to raise a genuine dispute over whether Hatcher renders this limitation obvious. It’s true  
20 Hatcher says nothing about pools. But Mr. Pratt explains that Hatcher discloses “various  
21 modification and alternatives” could be developed in light of the overall teachings of the  
22 disclosure, such that a POSA would have recognized that this includes the length. Pratt Decl.  
23 ¶ 503. According to Mr. Pratt, it follows then that a POSA would have recognized that they could  
24 manufacture Hatcher’s device to an appropriate length to reach the bottom of a deep pool. *Id.*  
25 Mr. Pratt also opines that a POSA would have known that a variety of devices were capable of  
26 cleaning a swimming pool and would have recognized that Hatcher’s grasper could grasp objects  
27 from the bottom of a swimming pool. *Id.* But even if the grasper is not considered a pool

1 cleaning tool, Mr. Pratt opines that a POSA would have been motivated to swap the grasper for a  
2 pool cleaning tool based on the desire to design a pole to suit the application for which it is  
3 intended. *Id.*; *see also id.* ¶ 174. This makes sense. A person in the pool cleaning business with  
4 only Hatcher’s pole would be motivated to replace the grasper with a brush, for example, if that  
5 person needed to brush the sides of a pool.

6 Based on the record before it, the Court finds that Defendants have met their burden  
7 regarding this limitation.

8 ***Pool cleaning tool attached with a v-clip (claim 3).*** Claim 3 recites: “a swimming pool  
9 cleaning tool attached to said second end of said outer tube using at least one v-clip that can be  
10 inserted into two holes positioned opposite each other near the end of said outside tube.” Hatcher  
11 does not disclose this claim. Defendants argue that a POSA would have found it obvious to  
12 combine a standard v-clip with Hatcher’s pole because the using v-clips in this manner was known  
13 in the art and “the standard way to connect a swimming pool cleaning tool to a pole.” SMUF ¶  
14 189. And a POSA would have found it obvious to use this “known configuration” (the v-clip)  
15 with the structure for attaching a pool cleaning tool (addressed above), according to Mr. Pratt,  
16 because any changes to the existing mechanism would have involved “nothing more than drilling  
17 particular holes in the end of an outer pole and attaching a standard pool cleaning tool to the pole.”  
18 Defendants’ Mot. 14 (citing Pratt Decl. ¶¶ 192–98, 316–18, 533–35).

19 Resh responds that “V-clips are not at all compatible with Hatcher,” and therefore a POSA  
20 would not have a reasonable expectation of success in modifying Hatcher in the way Defendants’  
21 argue. Resh Decl. ¶ 57. This opinion in Resh’s declaration has been stricken, though, so the  
22 Court cannot consider it. Resh has not identified any other evidence from which the Court can  
23 find a material dispute preventing summary judgment on this limitation in Defendants’ favor.  
24 Even assuming as true that v-clips are not compatible with Hatcher, it is undisputed that v-clips  
25 are not new. And Defendants have shown by clear and convincing evidence that it would have  
26 been obvious to modify Hatcher to include structure for removably attaching a tool—such that v-  
27 clips could be used with Hatcher’s modified end piece.

1           **Lightweight material (claim 19).** Claim 19 recites that the telepole tubes are made of a  
2 “relatively lightweight material such as aluminum.” Hatcher does not disclose the materials used  
3 for its poles, but Defendants argue a POSA would have found it obvious to make Hatcher’s tubes  
4 out of a relatively lightweight material. Defendants’ Mot. 14. Mr. Pratt opines that a POSA  
5 “would have recognized that it was desirable to make the pole from a lightweight material” and  
6 “such poles were known in the industry.” Pratt Decl. ¶ 555; *see also* SUF ¶ 179 (undisputed that  
7 aluminum poles were well known in the industry). Mr. Pratt also opines that a POSA would have  
8 been motivated to combine the aluminum pole with Hatcher, noting that such motivation would  
9 have stemmed from a desire to make a lighter pole. Pratt Decl. ¶ 555; *see also* SUF ¶ 199  
10 (undisputed that a “POSA would have recognized by 2011 that it would have been desirable to  
11 make Hatcher’s tubes from a lightweight material”). Additionally, based on the existence of  
12 aluminum pool poles already in the industry, it is plain to see that—and Resh does not dispute—a  
13 POSA would have had a reasonable expectation of success in using an aluminum pole.

14           Resh raises no genuine dispute warranting denial of summary judgment based on this  
15 limitation.

16           **Grasper (claim 22).** Claim 22 requires that the “tool” of claim 21 “is a swimming pool  
17 cleaning tool.” The dispute regarding this limitation is whether a POSA would have found it  
18 obvious to modify Hatcher to remove the existing grasper and replace it with a swimming pool  
19 cleaning tool. Defendants proffered sufficient evidence showing that it would be obvious. *See*  
20 *supra* at 24–25 (discussion regarding claim 1). It also consistent with common sense that, once  
21 Hatcher has a structure for removably attaching a tool, a person cleaning a pool would find it  
22 obvious to attach an appropriate pool cleaning tool instead of a grasper. When a technology is  
23 simple, the Court’s obviousness analysis “may include recourse to logic, judgment, and common  
24 sense available to the person of ordinary skill that do not necessarily require explication in any  
25 reference or expert opinion.” *See Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329  
26 (Fed.Cir.2009).

27           As to this limitation, Resh points to a paragraph of the Resh Declaration, which, though

1 not stricken, does not bear on whether or not it would be been obvious for a POSA to modify  
2 Hatcher. *See* Resh Decl. ¶ 56.

3 Accordingly, Defendants have met their burden to show no genuine dispute of material fact  
4 as to this limitation.

5 ***Concrete finishing tool (claim 23)***. Claim 23 recites “wherein the tool is a concrete  
6 finishing tool.” Defendants argue a POSA would have found it obvious to attach a concrete  
7 finishing tool to Hatcher. Mr. Pratt opines that “[c]oncrete finishing tools, and specifically  
8 concrete float tools, incorporate similar capabilities as the drywall finishing tool disclosed in”  
9 Hatcher. Pratt Decl. ¶ 189 (referring to Jungklaus); *see also* ¶ 610 (applying analysis of concrete  
10 finishing tool to Hatcher). Mr. Pratt also opines that a POSA “would have known that a wide  
11 arrangement of devices were capable of cleaning a swimming pool in some manner” and “would  
12 have been motivated to select a tool that is appropriate for the desired use case.” *Id.* ¶ 174. With  
13 respect to the concrete finishing tool, specifically, Mr. Pratt opines that a POSA would have  
14 recognized that it would have been “a matter of routine engineering to modify, or replace” the tool  
15 of Hatcher “with an adaptor having a float for leveling and smoothing wet concrete.” *Id.* ¶ 189  
16 (applying opinion in context of Jungklaus); *see also id.* ¶ 609 (applying same opinion to Hatcher).

17 Resh’s only rebuttal evidence is a stricken statement from Mr. Resh. SUF ¶ 211 (citing  
18 Resh Decl. ¶ 59). As above, it makes sense that a POSA would find it obvious to replace the  
19 grasper with a pool cleaning tool. It also makes sense that one of those tools would be a concrete  
20 finishing tool.

21 \* \* \*

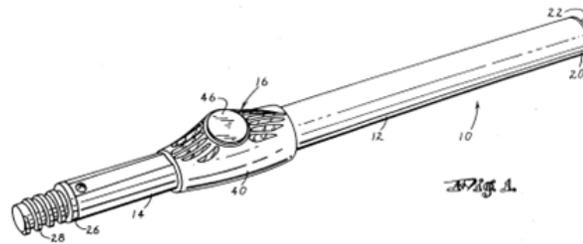
22 In sum, all of the elements of the Challenged Claims as described in ’852 Patent either  
23 existed in Hatcher or were common in previous poles. Based on the evidence before the Court, it  
24 is not genuinely disputed that a pool man with 2–3 years of experience in the pool cleaning field  
25 would have found it predictable to combine these features with reasonable success in doing so.

c. Skimlite 5008 and Newman

The Skimlite 5008 is a pool pole made by Defendants that has been sold in the United States prior to 2011. SUF ¶¶ 38–39. The Skimlite 5008 pole is shown below:



Newman is applicant admitted prior art and discussed in the background of the '852 Patent. '852 Patent, 5:33–63. Newman, issued in 1993, is titled “Tool Reach Extender with Locking Assembly” and discloses a detent locking mechanism on the pole, as shown below in Figure 1:



Defendants argue that Newman would anticipate most claims of the '852 Patent, except that the smaller pole attaches to the tool and the larger pole attaches to the grip (the opposite of the claims). Pratt Decl. ¶ 353. Because the '852 Patent explains that the claimed formation (the lower tube is the outer tube, and the upper tube is inner) was typical in pool poles, Defendants contend “Resh’s claims merely combine a known pole configuration with a known detent locking mechanism.” Defendants Mot. 16 (citing Pratt Decl. ¶ 359).

First, as to reasons to combine, Defendants rely on Mr. Pratt who opines that POSAs had only one of two options for where to place the structure for attaching the tool: either the outer tube or the inner tube. Pratt Decl. ¶ 355. He explains that choosing to switch sides would have been “simply a matter of sizing the component to fit the pole and the tube.” *Id.* (referring to Hatcher [0027], which explains that the pole configuration can be reversed). Defendants contend that

1 POSAs would have been motivated to substitute Newman’s detent locking mechanism for the  
 2 locking mechanism on the Skimplite 5008 because the twistable locking mechanism (1) could  
 3 loosen and cause undesirable movement of the inner tube, and (2) could become hard to tighten on  
 4 cold days. *See* Defendants’ Mot. 16. For this, Defendants point to the specification of the ’852  
 5 Patent, which generally discusses the shortcomings of the locking mechanism used in prior art  
 6 poles (*see* ’852 Patent, col. 4:6–24) and Mr. Pratt’s opinion with respect to the A.G. Pro Pole  
 7 (Pratt Decl. ¶ 648). Neither of these are sufficient to determine that a POSA would have been  
 8 motivated to substitute Newman’s detent locking mechanism for the mechanism on the Skimplite  
 9 5008. The specification does not speak to what a POSA would have been motivated to do, and  
 10 Mr. Pratt’s opinion with respect to the A.G. Pro Pole is not persuasive because factual disputes  
 11 remain over whether it can be treated as prior art. Without the above evidence, the Court is left  
 12 with only attorney argument on both sides. Although expert testimony is not always needed,  
 13 particularly when “[t]he technology is simple,” there appear to be “underlying factual issues in  
 14 dispute as to” this issue. *See Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1365  
 15 (Fed. Cir. 2008).

16 Defendants have not met their burden to show that a POSA would have found it obvious to  
 17 substitute Newman’s detent locking mechanism for the twistable lock on the Skimplite 5008 pole.  
 18 The Court need not evaluate the parties’ arguments with respect to the other claim limitations and  
 19 whether they are obvious in light of Skimplite 5008 combined with Newman.

### 20 3. Secondary Considerations

21 Before reaching an ultimate determination on whether summary judgment of obviousness  
 22 is appropriate, the Court must consider the secondary considerations of nonobviousness. *See In re*  
 23 *Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1078–79  
 24 (Fed. Cir. 2012). “[T]he burden of persuasion remains with [Defendants] during litigation because  
 25 every issued patent is entitled to a presumption of validity.” *ZUP, LLC v. Nash Mfg., Inc.*, 896  
 26 F.3d 1365, 1373 (Fed. Cir. 2018) (quoting *Novo Nordisk A/S v. Caraco Pharm. Labs., Ltd.*, 719  
 27 F.3d 1346, 1353 (Fed. Cir. 2013)). While this burden of persuasion remains with Defendants,

1 Resh “bears the burden of production with respect to evidence of secondary considerations of  
2 nonobviousness.” *Id.* “Such secondary considerations as commercial success, long felt but  
3 unsolved needs, failure of others, etc., might be utilized to give light to the circumstances  
4 surrounding the origin of the subject matter sought to be patented.” *Graham v. John Deere Co. of*  
5 *Kansas City*, 383 U.S. 1, 17–18 (1966).

6 Resh identifies several pieces of evidence he argues raise genuine issues of material fact  
7 underlying the ultimate conclusion of obviousness. First, based on Resh’s declaration, there were  
8 no telescoping poles with the claimed configuration prior to Resh’s invention in the ’852 Patent.  
9 Resh Decl. ¶ 10. Second, Resh contends that he has identified at least six infringing companies,  
10 thus demonstrating evidence of copying. For this, he points to filings submitted to the PTO  
11 wherein he argued that several companies copied. *See, e.g.*, Holland Decl. Ex. 3 at RESHL4084-  
12 000938–992. Third, two independent pool industry manufacturers purportedly indicated that they  
13 were skeptical of the ’852 Patent’s concepts. SUF ¶ 35 (citing Solakian Decl.; D. Gross Decl.).  
14 Fourth, Conrad Sr. “gasp[ed]” when he first saw Resh’s inventions. SUF 46. And finally, Resh  
15 contends that “Defendants themselves had been in the telescoping pole business for decades” and  
16 “they never found it ‘obvious’ to make any pole with the ’852 patent’s combination of features,  
17 until after seeing Resh’s inventions.” Resh Mot. 21.

18 Defendants respond that secondary considerations cannot overcome obviousness for three  
19 reasons (1) the strength of Defendants’ prima facie case of obviousness overcomes any secondary  
20 sources, (2) Resh failed to identify specific secondary considerations when prompted in an  
21 interrogatory and instead referred Defendants “to hundreds of pages” of the prosecution history,  
22 and (3) Resh failed to identify the requisite nexus. On the second point, Defendants argue this  
23 failure “to clearly identify its secondary considerations” constitutes waiver. Defendants Mot. 19.  
24 The Court disagrees; the proper recourse to challenge the clarity of interrogatory responses was  
25 during fact discovery.

26 On the first point, the Federal Circuit has held that secondary considerations cannot  
27 overcome a strong showing of obviousness, including on summary judgment. *ZUP*, 896 F.3d at

1 1375. The question then arises: what is a “strong showing” of obviousness? The Federal Circuit  
 2 has explained that “where a claimed invention represents no more than the predictable use of prior  
 3 art elements according to established functions,” evidence of “secondary indicia are frequently  
 4 deemed inadequate to establish non-obviousness.” *Ohio Willow Wood Co. v. Alps S., LLC*, 735  
 5 F.3d 1333, 1344 (Fed. Cir. 2013). That captures the present situation. As described below, Resh’s  
 6 secondary considerations as presented cannot overcome Defendants’ showing of obviousness.

7 **Copying.** The Federal Circuit has explained that “a nexus between the copying and the  
 8 novel aspects of the claimed invention must exist for evidence of copying to be given significant  
 9 weight in an obviousness analysis.” *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d  
 10 1356, 1364 (Fed. Cir. 2012) (citations omitted). To show copying, Resh refers to over 50 pages in  
 11 the ’852 Patent’s prosecution history which purportedly show that, in addition to Defendants, three  
 12 other companies have copied Resh’s invention. *See* Holland Decl. Ex. 3 at RESHL4084-000938–  
 13 992. The Court will not parse through over 50 pages of argument raised in a separate proceeding  
 14 to discern arguments raised before the PTAB. Resh offers no reason why the Court can—or  
 15 should—treat those arguments as incorporated by reference here. Accordingly, the Court will not  
 16 consider Resh’s arguments made in the PTAB to the extent the arguments are not also before this  
 17 Court.

18 Separate from the pages Resh cites from the prosecution history to show copying, he also  
 19 refers to the declaration of Travis Schonleber, a sales representative for various products in the  
 20 swimming pool industry. Schonleber Decl., ECF No. 126-2 at 139. Mr. Schonleber testifies that  
 21 he observed third-party poles which had the “same type of lever lock mechanism to adjust the pole  
 22 length,” and which had other aspects claimed in the ’852 Patent. *Id.* ¶ 4; *see also id.* ¶ 8  
 23 (describing the aluminum interior tubes and the holes drilled in the side the lever lock). Resh  
 24 refers to a second declaration from Mr. Resh describing how he saw another lever-lock pool pole  
 25 at a trade show that had three concentric tubes with a lever-lock, detent holes, v-clips, and a grip  
 26 configured in the same manner of the pole described in the ’852 Patent. *See* Holland Decl., Ex.  
 27 25.

1 Both declarations include photographs where the Court can see the above features.  
2 Accordingly, Resh’s proffered evidence is “reasonably commensurate with the scope of the  
3 claims.” *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013) (quotations omitted). Based  
4 on the above, Resh has presented evidence, albeit weak, that the copying is tied to a specific  
5 product that “embodies the claimed features and is coextensive with them.” *Brown & Williamson*  
6 *Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000).

7 ***Skepticism and gasp.*** “Evidence of industry skepticism is a question of fact that weighs in  
8 favor of non-obviousness.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1335 (Fed. Cir. 2016). As  
9 to skepticism, Resh relies on two declarations in the record. The first declaration in no way  
10 suggests the declarant was skeptical of the ’852 Patent’s concepts. *See generally* Solakian Decl.  
11 The second describes several reasons why the declarant chose not to pursue making a pole with  
12 intermediate locking stops, including because it “would have been very involved to try to make  
13 the pole commercially” which would have required “a mold for making components such as the  
14 locking mechanism.” D. Gross Decl.

15 Finally, Mr. Resh claims that Conrad Sr. “gasp[ed]” when he “first saw the features of the  
16 assembled ’852 claimed inventions.” Resh Decl. ¶ 20. Surprise can constitute skepticism, which  
17 can support nonobviousness. *See, e.g., Circuit Check Inc. v. QXQ Inc.*, 795 F.3d 1331, 1337 (Fed.  
18 Cir. 2015) (holding testimony that third parties were ‘worried’ or ‘surprised’ was sufficient to  
19 establish skepticism). Conrad Sr. denies this occurred. Whether or not Conrad Sr. expressed  
20 surprise at Mr. Resh’s invention is not for the Court to resolve. But even if true, one gasp by a  
21 competitor is not compelling evidence that those in the industry were skeptical about the  
22 workability of the claimed pole configuration. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317,  
23 1335-36, 119 U.S.P.Q.2d 1301 (Fed. Cir. 2016) (“Doubt or disbelief by skilled artisans regarding  
24 the likely success of a combination or solution weighs against the notion that one would combine  
25 elements in references to achieve the claimed invention.”).

26 \* \* \*

27 Balancing all of the secondary considerations, in light of the strong evidence of

1 obviousness based on Hatcher, Resh’s objective evidence of non-obviousness, even if fully  
2 credited by a jury, would fail to make a difference in this case. *See Wyers v. Master Lock Co.*, 616  
3 F.3d 1231, 1246, 95 USPQ2d 1525 (Fed. Cir. 2010) (“[W]here the inventions represented no more  
4 than the predictable use of prior art elements according to their established functions, the  
5 secondary considerations are inadequate to establish nonobviousness as a matter of law.”).

6 In sum, based on the undisputed facts, the Challenged Claims are invalid as obvious in  
7 light of Hatcher when combined with existing components.

#### 8 4. Written Description

9 Defendants contend that claim 20 of the ’852 Patent is invalid for failing to meet the  
10 written description requirement of 35 U.S.C. § 112. That section provides the following:

11 A valid patent must include a specification that contains a written description of  
12 the invention, and of the manner and process of making and using it, in such full,  
13 clear, concise, and exact terms as to enable any person skilled in the art to which  
14 it pertains, or with which it is most nearly connected, to make and use the same,  
and shall set forth the best mode contemplated by the inventor or joint inventor of  
carrying out the invention.

15 *Id.* § 112(a). The Federal Circuit has interpreted § 112(a) as containing both a “written  
16 description” requirement and an “enablement” requirement. *Ariad Pharms., Inc. v. Eli Lilly &*  
17 *Co.*, 598 F.3d 1336, 1344 (Fed. Cir. 2010). Defendants argue that the Challenged Claims fail the  
18 prior requirement.

19 The test for sufficiency of a patent’s written description, as required by Section 112(a), “is  
20 whether the disclosure of the application relied upon reasonably conveys to those skilled in the  
21 art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at  
22 1351. The written description inquiry is a question of fact. *Id.* “Compliance with the written  
23 description requirement . . . is amenable to summary judgment in cases where no reasonable fact  
24 finder could return a verdict for the non-moving party.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*,  
25 522 F.3d 1299, 1307 (Fed. Cir. 2008). “A party must prove invalidity for lack of written  
26 description by clear and convincing evidence.” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*,  
27 782 F.3d 671, 682 (Fed. Cir. 2015).

1           Claim 20 requires a telescoping pole having three tubes (outer, intermediate, inner), two  
2 collars, and two detent locking mechanisms. SUF ¶ 224. Defendants assert that the '852 Patent  
3 specification does not describe a telescoping pole having three tubes, an “intermediate tube,” two  
4 collars, or two detent locking mechanisms, and these features were not described in the originally  
5 filed claims of patent, nor in the provision application underlying the '852 Patent. Defendants’  
6 Mot. 20 (citing Pratt Decl. ¶¶ 616, 628).

7           Defendants are correct that the specification is silent regarding the “intermediate tube”  
8 limitation of claim 20. Resh argues that support for this claim can be found in Resh’s '561 co-  
9 pending application, which issued as U.S. Patent No. 11,090,798, because material in the '561  
10 application is “incorporated by reference” into the '852 Patent. Resh Reply 8. In response,  
11 Defendants insist that the incorporation by reference doctrine is available only for material in a  
12 “U.S. patent or U.S. patent application *publication*.” 37 C.F.R. § 1.57(d) (emphasis added). And  
13 because Resh points to the application number, not the patent application *publication* number, he  
14 cannot rely on material in that document to support claim 20.

15           Defendants cite no case law, from the Federal Circuit or otherwise, suggesting different  
16 treatment of a patent *application* as opposed to a patent application *publication* is appropriate  
17 under these circumstances. In fact, the Federal Circuit has not distinguished references to the  
18 applications in this manner. *See Allergan USA, Inc. v. MSN Lab ’ys Priv. Ltd.*, 111 F.4th 1358,  
19 1374 (Fed. Cir. 2024) (“Originally filed claims have long been held to be part of the specification  
20 to be considered in any § 112 analysis.”). In *Allergan*, the Federal Circuit concluded that a claim  
21 of “the originally filed patent application” contained adequate support for the challenged claim in  
22 a § 112 analysis. The Federal Circuit explicitly referred to and relied on the “application”  
23 number—it did not refer to the publication number. *See id.*; *see also Trs. of Columbia Univ. in*  
24 *City of New York v. Symantec Corp.*, 811 F.3d 1359, 1366 (Fed. Cir. 2016) (*Trustees*)  
25 (“provisional applications incorporated by reference are effectively part of the specification as  
26 though it was explicitly contained therein.”); *see also Otto Bock HealthCare LP v. %20Ossur HF*,  
27 557 F. App’x 950, 955–56 (Fed. Cir. 2014) (“In fact, 37 C.F.R. 1.57(d) specifically envisions

1 using a U.S. patent application incorporated by reference to define structure for the purpose of 35  
2 U.S.C. § 112, ¶ 6.”).<sup>9</sup>

3 Based on the above, the Court is not convinced that Resh’s oversight in failing to amend  
4 the patent during prosecution to include the publication number necessarily results in an  
5 ineffective incorporation by reference in this case. Defendants are therefore not entitled to  
6 summary judgment of invalidity of claim 20 for lack of written description under § 112.

7 **IV. CONCLUSION**

8 For the foregoing reasons, the Court rules as follows:

9 1. Resh’s Motion is **GRANTED IN PART** and **DENIED IN PART**. Resh is entitled  
10 to summary judgment that Defendants’ two-tube poles infringe claims 2, 11, 16, 18, 19, and 21 of  
11 the ’852 Patent and Defendants’ three-tube poles infringe claim 20. Resh is not entitled to  
12 summary judgment of infringement as to Defendants Conrad Jr. and Conrad Sr. Resh’s remaining  
13 motion is denied.

14 2. Defendants’ Motion is **GRANTED IN PART** and **DENIED IN PART**.  
15 Defendants are entitled to summary judgment that claims 1–3, 6–8, 11, 16, 18–19, and 21–24 of  
16 the ’852 Patent are invalid as obvious under 35 U.S.C. §103. Defendants are not entitled to  
17 summary judgment that claim 20 is invalid for lack of written description under 35 U.S.C. §112.

18 3. The Court sets a Trial Setting Conference on **April 10, 2025, at 11:00 AM** in San  
19 Jose, Courtroom 4, 5th Floor before Judge Edward J. Davila. The parties shall submit a Joint Trial  
20 Setting Conference Statement by **April 1, 2025**. See Section IV(C) of the Court’s Standing Order  
21 for Civil Cases.

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23

24

25 <sup>9</sup> At least one court in this District has rejected a similar argument raised in the context of claim  
26 construction. See *DNA Genotek Inc. v. Spectrum Sols. L.L.C.*, No. 3:21-CV-00516-RSH-DDL,  
27 2022 WL 17331255, at \*19, n.16 (S.D. Cal. Nov. 29, 2022), *aff’d sub nom. DNA Genotek Inc. v.*  
28 *Spectrum Sols. LLC*, No. 2023-2017, 2025 WL 502040 (Fed. Cir. Feb. 14, 2025) (finding  
argument that “incorporation by reference of a provisional application is ineffective because a  
provisional application is not a U.S. patent or U.S. patent application publication” had merit but  
nonetheless deferring to Federal Circuit’s ruling in *Trustees* suggesting otherwise).

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**IT IS SO ORDERED.**

Dated: March 11, 2025



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EDWARD J. DAVILA  
United States District Judge