

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

JOON PARK,  
  
Plaintiff,  
  
vs.  
  
CAS ENTERPRISES, INC dba KREG TOOL  
COMPANY,  
  
Defendant.  
  
\_\_\_\_\_  
AND ALL RELATED COUNTERCLAIMS.

CASE NO. 08-cv-0385 DMS (NLS)

**ORDER:**  
  
**(1) DENYING PLAINTIFF’S  
MOTION TO STRIKE EXHIBITS  
AND RELATED TESTIMONY**  
  
**(2) DENYING DEFENDANT’S  
MOTION FOR SUMMARY  
JUDGMENT OF INVALIDITY OF  
CLAIM 1 OF THE ‘988 PATENT**

[Docs. 225 & 241]

Pending before the Court is Defendant’s motion for summary judgment of invalidity of Claim 1 of U.S. Patent No. 6,637,988 (‘988 Patent) under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,843,167 (“Rushton”). Additionally, in response to several motions filed by Defendant, Plaintiff filed a motion to strike exhibits and related testimony that bears on the instant motion. The matters came on for hearing on May 7, 2010. Paul Adams appeared on behalf of Plaintiff. Timothy Zarley and Maha Sarah appeared on behalf of Defendant. For the reasons set forth below, both motions are denied.

///

1 **I.**

2 **BACKGROUND**

3 Three patents are at issue: United States Patent Nos. 6,637,988 ('988 Patent), 7,134,814 ('814  
4 Patent) and 7,374,373 ('373 Patent). All three patents are part of a family of patents, covering  
5 woodworking tools for drilling pocket holes. Because the facts are well known to the parties, the  
6 Court discusses only those facts that are relevant to the disposition of the subject motion.

7 The '988 patent issued on October 28, 2003. Claim 1 of the '988 patent provides:

8 An adjustable pocket drilling fixture comprising:

9 a base, a clamping face on said base, said clamping face defining a plane;

10 a clamp body, a clamping face on said clamp body opposing said clamping face  
11 on said base;

12 clamping structure interengaging said clamp body and said base, said clamping  
13 structure including a clamp actuator positioned adjacent said base to move said  
14 clamp body in a clamping direction;

15 a guide carrier, at least one drill guide in said guide carrier, said drill guide  
16 having an axis which intersects said plane of said clamping face on said base,  
17 said guide carrier being slidably mounted on said base to move in a direction  
18 parallel to said plane; and

19 gaging structure between said base and said guide carrier so that said guide  
20 carrier can be positioned at a predetermined distance from said base.

21 The '814 patent is a continuation-in-part of the '988 patent. When Plaintiff initially filed the  
22 application that matured into the '814 patent, claims 1 and 2 were identical to claim 1 of the '988  
23 patent. (*Compare* Doc. 41-2, Newman Decl. Ex. 2D, at 62, *with* '988 Patent, Claim 1.) The patent  
24 examiner rejected claims 1 and 2 on two grounds relevant here: 1) for double patenting by the '988  
25 patent, and 2) as anticipated by Rushton. (Farrell Decl. Ex. D. at 4.) Plaintiff thereafter amended  
26 claims 1 and 2 and obtained the '814 patent. (Farrell Decl. Ex. E.) The same patent examiner was  
27 involved in both the '988 and '814 patents, but he did not cite Rushton as prior art to the '988 patent.

28 Defendant filed the instant motion on March 19, 2010. (Doc. 225.) Plaintiff filed an  
opposition and Defendant filed a reply. (Docs. 237 & 245.) Plaintiff filed the motion to strike on  
April 23, 2010, and Defendant filed an opposition. (Docs. 241 & 259.)

///

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**II.**  
**DISCUSSION**

**A. Motion to Strike**

Plaintiff moves to strike reference to the Rushton patent because it is not listed in the prior art claim chart in Defendant’s final invalidity contentions, as required by the patent local rules. Plaintiff, however, referenced Rushton in his claim construction brief earlier in this litigation and is clearly aware of the Rushton patent. Nonetheless, Plaintiff’s concern is that Defendant did not elicit expert testimony regarding Rushton’s effect on the validity of the ‘988 patent, and thus, Plaintiff will be prejudiced if expert testimony on the subject is now permitted. Defendant has indicated it does not intend to use expert testimony regarding Rushton, but rather that its use of Rushton is limited to charts made by Plaintiff. Given Defendant’s proffer, the Court declines to strike use of the Rushton patent as prior art at this time. Accordingly, Plaintiff’s motion to strike is denied without prejudice.<sup>1</sup>

**B. Summary Judgment**

“Summary judgment is appropriate when no genuine issue of material fact exists and the moving party is entitled to judgment as a matter of law.” *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1380 (Fed. Cir. 2005) (citing Fed. R. Civ. P. 56(c)). “A material issue of fact is one that affects the outcome of the litigation and requires a trial to resolve the parties’ differing versions of the truth.” *S.E.C. v. Seaboard Corp.*, 677 F.2d 1301, 1306 (9th Cir. 1982). The moving party carries the initial burden of demonstrating that summary judgment is proper. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157 (1970). To meet this burden, the moving party must identify the pleadings, depositions, affidavits, or other evidence that it “believes demonstrates the absence of a genuine issue of material fact.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If the moving party satisfies this initial burden, then the burden shifts to the opposing party to show that summary judgment is not appropriate. *Id.* at 324. The opposing party’s evidence is to be believed, and all justifiable inferences are to be drawn in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). To avoid summary judgment, the opposing party cannot rest solely on conclusory allegations. *Berg v.*

---

<sup>1</sup> Plaintiff also moves to strike photographs and documents that were submitted with two motions later withdrawn by Defendant. The Court denies the motion as moot.

1 *Kincheloe*, 794 F.2d 457, 459 (9th Cir. 1986). Instead, it must designate specific facts showing there  
2 is a genuine issue for trial. *Id.* More than a “metaphysical doubt” is required to establish a genuine  
3 issue of material fact.” *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586  
4 (1986).

5 **C. Invalidity**

6 To prevail on a motion for summary judgment alleging patent invalidity, the moving party must  
7 overcome the statutory presumption that the patent is valid. *See* 35 U.S.C. § 282; *IPXL*, 430 F.3d at  
8 1381. This is not an easy task. Indeed, the moving party can only overcome the presumption with  
9 “clear and convincing evidence” of patent invalidity. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d  
10 1276, 1281 (Fed. Cir. 2005) (internal citation omitted). Consistent with the burden-shifting procedure  
11 for summary judgment, if the moving party, or challenger,

12 provides evidence sufficient to establish a prima facie showing on an issue, the burden  
13 of production of evidence shifts to the patent owner. If the patent owner provides some  
14 contradictory evidence, then the trier of fact must resolve the conflict with the  
challenger, as noted, bearing the burden of persuasion by clear and convincing  
evidence.

15 1 Donald S. Chisum, *Chisum on Patents* § 3.04[1][b][v] (2005).

16 Here, Defendant asserts claim 1 of the ‘988 patent is invalid as being anticipated by the  
17 Rushton patent. “Anticipation under 35 U.S.C. § 102 means lack of novelty, and is a question of fact.”  
18 *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). Determining whether a claim is anticipated  
19 involves two steps: (1) construing the claims, and (2) comparing the properly construed claims to the  
20 prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1346 (Fed. Cir. 2002) (citations  
21 omitted). *See also* 1 Chisum, *supra*, § 3.02[1][g] (quoting *Key Pharmaceuticals, Inc. v. Hercon Labs.*  
22 *Corp.*, 161 F.3d 709 (Fed. Cir. 1998)) (“First is construing the claim, a question of law for the court,  
23 followed by . . . a comparison of the construed claim to the prior art.”) “To anticipate, every element  
24 and limitation of the claimed invention must be found in a single prior art reference, arranged as in the  
25 claim.” *Brown*, 265 F.3d at 1351 (citations omitted). *See also IPXL*, 430 F.3d at 1381 (quoting  
26 *Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368, 1373 (Fed. Cir. 2001)) (same). This  
27 is the same test for determining infringement, *i.e.*, “[t]hat which infringes if later anticipates if  
28 earlier.” *Brown*, 265 F.3d at 1351 (quoting *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556,

1 1573 (Fed. Cir. 1986)).

2 Defendant contends that because the original claims 1 and 2 of the '814 patent were identical  
3 to claim 1 of the '988 patent and were anticipated by Rushton, it follows that claim 1 of the '988 is  
4 also anticipated by Rushton. Plaintiff argues that the Examiner's findings are irrelevant because the  
5 Examiner was not analyzing the claims as subsequently construed by this Court.

6 During patent prosecution in the PTO, claims are given their broadest possible interpretation.  
7 *In re Zletz*, 893 F.2d 319, 321-322 (Fed. Cir. 1989). The reason is "that during patent prosecution  
8 when claims can be amended, ambiguities should be recognized, scope and breadth of language  
9 explored, and clarification imposed." *Id.* During litigation, patent claims are construed based on other  
10 considerations, such as the specification, prosecution history, prior art and other claims. *Atlantic*  
11 *Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 846 (Fed. Cir. 1992).

12 Here, the only evidence put forth by Defendant is from a determination made before the claims  
13 had been construed. However, the first step in a validity analysis is to interpret the claims. *TI Group*  
14 *Auto. Sys. (N. Am.), Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1139 (Fed. Cir. 2004). There is no  
15 basis to assume that the Examiner's findings of anticipation would be the same after the Court's  
16 construction. Defendant has not put forth clear and convincing evidence that Rushton anticipates each  
17 and every claim limitation of Claim 1 of the '988 patent as those limitations have been construed here.  
18 Accordingly, Defendant's motion is denied.

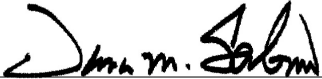
19 **III.**

20 **CONCLUSION**

21 For these reasons, Defendant's motion for summary judgment is denied. Plaintiff's motion to  
22 strike is denied without prejudice.

23 **IT IS SO ORDERED.**

24 DATED: May 13, 2010

25   
26 \_\_\_\_\_  
27 HON. DANA M. SABRAW  
28 United States District Judge