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

INDUSTRIAL TECHNOLOGY  
RESEARCH INSTITUTE,

Plaintiff/Counterclaim Defendant,

v.

LG ELECTRONICS, INC., and LG  
ELECTRONICS U.S.A., INC.,

Defendants/Counterclaim Plaintiffs.

and

LG DISPLAY CO., LTD.,

Intervenor.

CASE NO. 3:13-cv-2016-GPC-WVG

**ORDER:**

**(1) GRANTING ITRI'S MOTION  
FOR SUMMARY JUDGMENT;**

**[ECF No. 98]**

**(2) DENYING LG ELECTRONICS'  
MOTION FOR SUMMARY  
JUDGMENT**

**[ECF No. 112]**

**[REDACTED]**

**I. INTRODUCTION**

Before the Court are two motions for summary judgment. (ECF Nos. 98, 112.) Plaintiff Industrial Technology Research Institute ("ITRI") moves for summary judgment on Defendants LG Electronics, Inc. and LG Electronics U.S.A., Inc.'s



1 infringement. (ECF No. 112.)<sup>2</sup> On November 6, 2014, LGD filed a notice of joinder  
2 joining LGE’s motion. (ECF No. 116.) On November 7, 2014, ITRI filed an opposition  
3 to LGE’s motion. (ECF No. 118.) On November 21, 2014, LGE filed a reply to ITRI’s  
4 opposition. (ECF No. 134.)

5 **III. FACTUAL BACKGROUND**

6 On December 19, 2000, the United States Patent and Trademark Office (the  
7 “USPTO”) granted ITRI U.S. Patent No. 6,163,355 titled “In-plane switching array of  
8 TFT liquid crystal display in which an electrode on the same side of an insulating layer  
9 is made thinner than the source and drain” (the “355 patent”). (ECF No. 35-1.)

10 [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 [REDACTED])

16 [REDACTED]

17 [REDACTED]

18 ■ ■ ■ ■ ■ ■

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 [REDACTED]

26 \_\_\_\_\_

27 <sup>2</sup> LGE had previously filed this motion entirely under seal on September 19,  
28 2014. (ECF No. 85). However, LGE had failed to publicly file a redacted version of the  
motion and did not publicly file the redacted version until October 24, 2014. (See ECF  
No. 106.)

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[REDACTED]

Based on the FAC, ITRI alleges a single cause of action: patent infringement of

1 the '355 patent by LGE. (FAC.) ITRI alleges that three of LGE's monitors infringe the  
2 '355 patent: 23EA63V-P, 22EA53T-P, and 29EA93-P (the "Accused Monitors"). (*Id.*  
3 ¶ 14.) LGD manufactures and sells to LGE the liquid crystal displays in the Accused  
4 Monitors. (ECF No. 47-1, at 3; ECF No. 68, at 2.)

5 LGE's answer alleges thirteen affirmative defenses, including LGE's Seventh  
6 Affirmative Defense: [REDACTED]

7 [REDACTED]. (*See* Answer ¶ 29; ECF No. 111-1, at 1, 21–22.)

8 LGE's answer also alleges three counterclaims, including LGE's third count: a  
9 declaratory judgment of noninfringement. (*See* Answer ¶¶ 49–50.)

#### 10 IV. LEGAL STANDARD

11 Federal Rule of Civil Procedure 56 empowers the Court to enter summary  
12 judgment on factually unsupported claims or defenses, and thereby "secure the just,  
13 speedy and inexpensive determination of every action." *Celotex Corp. v. Catrett*, 477  
14 U.S. 317, 325, 327 (1986); FED. R. CIV. P. 56. Summary judgment is appropriate if the  
15 "pleadings, depositions, answers to interrogatories, and admissions on file, together  
16 with the affidavits, if any, show that there is no genuine issue as to any material fact  
17 and that the moving party is entitled to judgment as a matter of law." FED. R. CIV. P.  
18 56(c). A fact is material when it affects the outcome of the case. *Anderson v. Liberty*  
19 *Lobby, Inc.*, 477 U.S. 242, 248 (1986).

20 The moving party bears the initial burden of demonstrating the absence of any  
21 genuine issues of material fact. *Celotex*, 477 U.S. at 323. The moving party can satisfy  
22 this burden by demonstrating that the nonmoving party failed to make a showing  
23 sufficient to establish an element of his or her claim on which that party will bear the  
24 burden of proof at trial. *Id.* at 322–23. If the moving party fails to bear the initial  
25 burden, summary judgment must be denied and the Court need not consider the  
26 nonmoving party's evidence. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 159–60  
27 (1970).

28 Once the moving party has satisfied this burden, the nonmoving party cannot rest

1 on the mere allegations or denials of his pleading, but must “go beyond the pleadings  
2 and by her own affidavits, or by the ‘depositions, answers to interrogatories, and  
3 admissions on file’ designate ‘specific facts showing that there is a genuine issue for  
4 trial.’” *Celotex*, 477 U.S. at 324 (citing FED. R. CIV. P. 56 (1963)). If the non-moving  
5 party fails to make a sufficient showing of an element of its case, the moving party is  
6 entitled to judgment as a matter of law. *Id.* at 325. “Where the record taken as a whole  
7 could not lead a rational trier of fact to find for the nonmoving party, there is no  
8 ‘genuine issue for trial.’” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S.  
9 574, 587 (1986) (citing FED. R. CIV. P. 56 (1963)). In making this determination, the  
10 Court must “view [] the evidence in the light most favorable to the nonmoving party.”  
11 *Fontana v. Haskin*, 262 F.3d 871, 876 (9th Cir. 2001). The Court does not engage in  
12 credibility determinations, weighing of evidence, or drawing of legitimate inferences  
13 from the facts; these functions are for the trier of fact. *Anderson*, 477 U.S. at 255.

## 14 V. DISCUSSION

### 15 A. LGE’s Defense

16 A patent license is an agreement by the licensor not to sue the licensee for patent  
17 infringement. *See Jim Arnold Corp. v. Hydrotech Sys., Inc.*, 109 F.3d 1567, 1577 (Fed.  
18 Cir. 1997). The first sale/patent exhaustion doctrine “provides that the initial authorized  
19 sale of a patented item terminates all patent rights to that item.” *Quanta Computer, Inc.*  
20 *v. LG Electronics, Inc.*, 553 U.S. 617, 625 (2008). The parties disagree whether

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23 [REDACTED]  
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[REDACTED]

**B. Licensing Agreement**

The Court first turns to whether the '355 patent falls within the definition of

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[REDACTED]

**VI. CONCLUSION AND ORDER**

For the reasons stated above, **IT IS HEREBY ORDERED** that:

1. ITRI's Motion for Summary Judgment, (ECF No. 98), is **GRANTED**; and
2. LGE's Motion for Summary Judgment, (ECF No. 112), is **DENIED**.

DATED: December 9, 2014

  
HON. GONZALO P. CURIEL  
United States District Judge