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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

LAUGHING RABBIT, INC.,

Plaintiff,

v.

NATIONAL AUTOMOTIVE PARTS
ASSOCIATION,

Defendant.

CASE NO. C12-0402JLR

ORDER ON PLAINTIFF'S
MOTION FOR PARTIAL
SUMMARY JUDGMENT

I. INTRODUCTION

Plaintiff Laughing Rabbit, Inc. ("LRI") alleges that Defendant National Automotive Parts Association ("NAPA") infringed its design patent for a pocket-sized LED flashlight ("the '372 patent"). (Am. Compl. (Dkt. # 3) ¶¶ 1, 25.) As an affirmative defense, NAPA asserts that the '372 patent is invalid. (Ans. (Dkt. # 12) ¶¶ 5-6.) Before the court is LRI's motion for partial summary judgment on NAPA's patent invalidity defense. (Mot. (Dkt. # 16).) After considering the motion, all submissions filed in

1 support of and opposition to the motion, the balance of the record, and the applicable law,
2 the court GRANTS in part and DENIES in part LRI's summary judgment motion.

3 II. BACKGROUND

4 LRI is an Oregon corporation. (Am. Compl. ¶ 1.) It manufactures and distributes
5 specialty lighting products, including LED flashlights. (*Id.* ¶ 7.) LRI has sold its
6 products through national retailers and online since 1994. (*Id.* ¶ 8.) LRI is the exclusive
7 licensee of the '372 patent titled "Pocket Flashlight" at issue in this case. (*Id.* ¶ 9.) LRI
8 filed its amended complaint against NAPA on March 8, 2012, alleging patent and
9 trademark infringement, unfair competition, and violation of the Washington State
10 Consumer Protection Act, RCW 19.86. (*See generally id.*) With respect to the patent
11 infringement claim, LRI alleges that NAPA has "since at least as early as November 17,
12 2011[,] offered to sell LED flashlights substantially identical in appearance to [those for
13 which LRI is the exclusive patent licensee] to the public at 'www.napaonline.com' and
14 retail locations" (*Id.* ¶ 11.) LRI also asserts that NAPA "was placed on notice of
15 LRI's [patent] rights, by letter dated November 30, 2011," and "continued to sell the
16 accused product thereafter." (*Id.* ¶ 13.)

17 NAPA is a trade association (Resp. (Dkt. # 19) at 2), and its "jurisdiction of
18 formation" is Michigan (Ans. ¶ 2).¹ In NAPA's January 11, 2013, answer, NAPA
19 asserted numerous affirmative defenses, including patent invalidity, which is the basis of

20
21 ¹ The patent and trademark infringement claims, as well as the unfair competition claims,
22 are before the court based on the court's federal question jurisdiction. 28 U.S.C. § 1331. The
Washington State Consumer Protection Act claim is before the court based on the court's
supplemental jurisdiction. 28. U.S.C. § 1367.

1 LRI's instant motion for partial summary judgment. (Ans. ¶¶ 5-6; *see generally* Mot.)
2 Patent invalidity is a defense to patent infringement. *See, e.g., Agrizap, Inc. v.*
3 *Woodstream Corp.*, 520 F.3d 1337, 1341 (Fed. Cir. 2008). NAPA claims that the '372
4 patent does not meet the conditions for patentability required by the Patent Act in 35
5 U.S.C. §§ 102, 103, and/or 171. (Ans. ¶ 6.) NAPA claims that the '372 patent design is
6 not "new, original and ornamental" as required by 35 U.S.C. § 171, but rather "primarily
7 functional and dictated by its function," and therefore invalid. (*Id.*) NAPA also alleges
8 that flashlights with this same design were "publicly offered" "as early as 1993 which
9 constitute[s] invalidating prior art with respect to the design claimed in the '372 patent."
10 (*Id.*) With this assertion, NAPA appears to argue that the patent is invalid because it is
11 anticipated and obvious under 35 U.S.C. §§ 102 and 103, although NAPA does not
12 explicitly say so. (*See generally* Ans.)

13 LRI filed this motion for partial summary judgment on November 12, 2013,
14 pursuant to Federal Rule of Civil Procedure 56. (*See generally* Mot.) LRI argues that
15 summary judgment should be granted on NAPA's patent invalidity defense because
16 NAPA has not pleaded "sufficient facts" to demonstrate patent invalidity. (Mot. at 8.)
17 LRI further argues that NAPA does not have sufficient evidence about "the alleged prior
18 art product" (*id.* at 9), to show that the '372 patent was anticipated or obvious. LRI
19 finally contends that NAPA's functionality defense "fails as a matter of law as utility is a
20 requirement of all inventions submitted for Letters Patent . . ." under 35 U.S.C. § 101.
21 (*Id.*)
22

1 NAPA responded on January 2, 2014. (*See generally* Resp.) In its response,
2 NAPA characterizes LRI’s motion as “a late-filed motion to strike” NAPA’s patent
3 invalidity defense under Federal Rule of Civil Procedure 12(f) because LRI’s motion
4 “focuses on the sufficiency of NAPA’s pleading rather than the absence of material
5 factual disputes” (Resp. at 1); *see* Fed. R. Civ. P. 12(f). NAPA argues that the court
6 cannot grant this motion because LRI did not file its motion within the 21-day period
7 required by Rule 12(f). *See* Fed. R. Civ. P. 12(f)(2). NAPA finally asserts that LRI has
8 not met its summary judgment burden because LRI focused on utility patents rather than
9 on design patents and on the requirement that design patents be ornamental and not just
10 functional. (Resp. at 1.) NAPA’s response does not address at all its defenses that the
11 ’372 patent is invalid because it is anticipated or obvious. (*See generally* Resp.)

12 LRI filed a reply on January 8, 2014. (*See generally* Reply.) In its reply, LRI
13 addresses functionality under 35 U.S.C. § 171, which NAPA cited as a basis for
14 invalidity. (*Id.*; *see generally* Mot.) Along with its reply memorandum, LRI submits the
15 declaration of David Allen, the ’372 patent inventor, and several exhibits showing
16 different designs for pocket flashlights to demonstrate that the design is ornamental rather
17 than functional. (Allen Decl. (Dkt. # 20-1); Reply at 3.) This information was not
18 included in LRI’s original motion for summary judgment. (*See generally* Mot.) LRI’s
19 sole argument in its original moving papers for disputing NAPA’s affirmative defense
20 based on functionality was that the “NAPA’s averment fails as a matter of law as utility is
21 a requirement of all inventions submitted for Letter Patent” (Mot. at 5-6 (citing 35
22 U.S.C. § 101).)

III. ANALYSIS

A. Applicable Summary Judgment Standards

Summary judgment is appropriate if the evidence, when viewed in the light most favorable to the nonmoving party, demonstrates “that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *Galen v. Cnty. of L.A.*, 477 F.3d 652, 658 (9th Cir. 2007). A fact is “material” if it might affect the outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A factual dispute is “genuine” if the evidence is such that reasonable people could disagree about whether the facts claimed by the moving party are true. *Aydin Corp. v. Loral Corp.*, 718 F.2d 897, 902 (9th Cir. 1983). The moving party bears the initial burden of showing there is no genuine issue of material fact and that it is entitled to prevail as a matter of law. *Celotex*, 477 U.S. at 323. In moving for summary judgment against a party who will bear the ultimate burden of proof at trial, the movant’s burden will be satisfied if it points to an absence of evidence to support an essential element of the nonmoving party’s claim. *Id.* at 322-23.

If the moving party meets its burden, the nonmoving party “must make a showing sufficient to establish a genuine dispute of material fact regarding the existence of the essential elements” of its case in order to withstand summary judgment. *Galen*, 477 F.3d at 658. The court is “required to view the facts and draw reasonable inferences in the light most favorable to the [nonmoving] party.” *Scott v. Harris*, 550 U.S. 372, 378 (2007). Facts asserted by the party opposing the motion, if supported by affidavits or

1 other evidentiary material, are regarded as true. *See, e.g., Hunt v. Cromartie*, 526 U.S.
2 541, 551 (1999).

3 On a summary judgment motion, the court must “view the evidence presented
4 through the prism of the substantive evidentiary burden” that applies at trial. *Anderson*,
5 477 U.S. at 254. A party asserting patent invalidity must prove a patent is invalid by
6 clear and convincing evidence. *See, e.g., Taurus IP, LLC v. DaimlerChrysler Corp.*, 726
7 F.3d 1306, 1322 (Fed. Cir. 2013); *see also* 35 U.S.C. § 282 (establishing a presumption
8 of patent validity giving rise to the clear and convincing evidence standard). “[A]
9 moving party seeking to have a patent held not invalid at summary judgment must show
10 that the nonmoving party, who bears the burden of proof at trial, failed to produce clear
11 and convincing evidence on an essential element of a defense upon which a reasonable
12 jury could invalidate the patent.” *Delano Farms Co. v. Cal. Table Grape Comm’n*, 940
13 F. Supp. 2d 1229, 1251 (E.D. Cal. 2013) (*quoting Eli Lilly & Co. v. Barr Labs., Inc.*, 251
14 F.3d 955, 962 (Fed. Cir. 2001)). A patentee has no burden to present factual evidence
15 affirmatively establishing the validity of its patent, even in support of its own motion for
16 summary judgment on the validity issue. *Massey v. Del Labs., Inc.*, 118 F.3d 1568, 1573
17 (Fed. Cir. 1997). Rather, a patentee moving for summary judgment can meet its burden
18 simply by pointing to the nonmoving party’s lack of evidence to support its patent
19 invalidity defense. *See, e.g., Celotex*, 477 U.S. at 323.

20 However, courts abuse their discretion when they grant summary judgment based
21 on new evidence introduced in the moving party’s reply brief. *See, e.g., Zamani v.*
22 *Carnes*, 491 F.3d 990, 997 (9th Cir. 2007). Because all inferences must be made in the

1 nonmoving party's favor, courts should either disregard new information presented in a
2 reply brief, or allow a nonmoving party to address the new evidence presented. *See, e.g.,*
3 *id.*

4 **B. NAPA's Asserted Grounds for Patent Invalidity**

5 NAPA styles its affirmative defense as a single defense of patent invalidity. (*See*
6 *Ans. ¶¶ 5-6.*) However, NAPA's defense is based on three sections of the Patent Act, 35
7 U.S.C. § 102, 103, 171, any one of which could independently support patent invalidity.
8 The court therefore considers each asserted ground of patent invalidity—functionality,
9 anticipation, and obviousness—as a separate defense, and addresses whether summary
10 judgment is appropriate as to each ground.

11 There are different statutory bases and standards for utility and design patents. *In*
12 *re Application of Aslanian*, 590 F.2d 911, 913(C.C.P.A. 1979). To be patentable, a
13 design must be for an article of manufacture, must meet the criteria of being new,
14 original, and ornamental, and must satisfy the other relevant requirements of Title 35.
15 *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997). Specifically,
16 section 171 of Title 35 states:

17 Whoever invents any new, original and ornamental design for an article of
18 manufacture may obtain a patent therefor, subject to the conditions and
19 requirements of this title.

19 The provisions of this title relating to patents for inventions shall apply to
20 patents for designs, except as otherwise provided.

20 35 U.S.C. § 171. With respect to NAPA's affirmative defense of functionality, a design
21 patent is invalid where the design serves a primarily functional, rather than primarily
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1 ornamental, purpose. *See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117,
2 1123 (Fed. Cir. 1993).

3 By way of contrast, the statutory basis for utility patents states that “[w]hoever
4 invents or discovers any new and useful process, machine, manufacture, or composition
5 of matter, or any new and useful improvement thereof, may obtain a patent therefor,
6 subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Contrary to
7 LRI’s assertion (Mot. at 5-6), however, the “utility” requirement of 35 U.S.C. § 101 is
8 not applied to design patents. The applicability of section 101 to design patents was
9 specifically considered by the court in *In re Finch*, 535 F.2d 70, 71-72 (C.C.P.A. 1976).
10 The court noted that the structure of section 171 for design patents is the same as section
11 101 for utility patents except that section 171 is modified for designs. *Id.* The court
12 concluded that because the second paragraph of section 171 makes the provisions of Title
13 35 applicable to designs “except as otherwise provided,” section 101 cannot be read into
14 section 171. *Id.* at 72 (“[T]he criteria of 35 U.S.C. § 101 are “otherwise provided” in 35
15 U.S.C. § 171 and that second paragraph of the latter cannot serve to permit the reading
16 thereinto the ‘useful’ criterion of 35 U.S.C. § 101.”). Thus, rejection of a design patent
17 for lack of utility is error. *Id.* at 72. Nevertheless, the *Finch* court held that section 102
18 (which relates to NAPA’s affirmative defense of anticipation) and section 103 (which
19 relates to NAPA’s affirmative defense of obviousness) can be read into section 171. *See*
20 *id.* at 71 (“The paragraph clearly makes numerous provisions, such as 35 U.S.C. § 102
21 and 35 U.S.C. § 103, applicable to designs.”).
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1 The Federal Circuit recently confirmed the view of the *Finch* court with respect to
2 the interplay between utility and design patents:

3 There are two differences in wording between the requirements for a design
4 patent under [35 U.S.C.] § 171 and for a utility patent under 35 U.S.C. §
5 101. Section 171 excludes the word “useful” (to distinguish design patents
6 from utility patents) and adds the word “original.” . . . [C]ourts have not
7 construed the word “original” as requiring that design patents be treated
8 differently than utility patents. Section 171 requires that the “conditions
9 and requirements of this title” be applied to design patents, thus requiring
10 the application of the provisions of sections 102 . . . and 103

11 *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009).

12 Thus, in addition to functionality, design patents are subject to affirmative defenses for
13 anticipation and obviousness under sections 102 and 103 of Title 35, respectively. *See*,
14 *e.g.*, 35 U.S.C. §§ 102, 103, 171.

15 A defendant alleging design patent invalidity must show by clear and convincing
16 evidence that at least one of the key characteristics for the patent is missing. *See, e.g.*,
17 *Innovative Scuba*, 26 F.3d at 1115. Patent invalidity is often a legal question that can be
18 resolved on undisputed facts. *See Microsoft Corp. v. i4i Limited P’ship*, __U.S.__, 131 S.
19 Ct. 2238, 2253 (2011) (Breyer, J., concurring) (“Many claims of invalidity rest . . . upon
20 how the law applies to facts as given.”). The three bases that NAPA has asserted for
21 patent invalidity in the affirmative defense at issue are discussed in more detail below.

22 1. Invalidity under 35 U.S.C. § 171 (“Functionality”)

As noted above, one requirement for a design patent under 35 U.S.C. § 171 is that
it be “ornamental.” 35 U.S.C. § 171. A design patent is invalid where the design serves
a primarily functional, rather than primarily ornamental, purpose. *See, e.g., L.A. Gear*,

1 988 F.2d at 1123. A design is “functional when the appearance of the claimed design is
2 ‘dictated by’ the use or purpose of the article.” *Id.* at 1123 (*citing In re Carletti*, 328 F.2d
3 1020, 1022 (C.C.P.A. 1964)). Courts find that “the design of the article is more likely to
4 serve a primarily ornamental purpose” when there are several ways to design a product to
5 achieve its intended function. *Id.* Thus, a party alleging patent invalidity can prevail by
6 showing that an article’s design is dictated by how the article is to be used. *Id.*

7 2. Invalidity under 35 U.S.C. § 102 (“Anticipation”)

8 Patents, whether for a design or otherwise, must be unanticipated as required by
9 35 U.S.C. § 102. In challenging a patent’s validity, one way a party can demonstrate that
10 a patent was anticipated is to show that the invention was in public use or on sale in the
11 United States more than a year prior to the date of application for the patent. *See* 35
12 U.S.C. § 102(b).² Courts look at “prior art” to determine whether a patent is novel and

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15 ²On September 16, 2011, section 102 and section 103 of Title 35 of the United States
16 Code were amended by the Leahy–Smith America Invents Act (“AIA”), Pub.L. No. 112–29, §
17 3(b)-(c), §§ 102–03, 125 Stat. 284, 285–87 (2011) (to be codified, in relevant part, at 35 U.S.C.
§§ 102–03). The relevant amendments are applicable only to patents and patent applications with
effective filing dates on or after March 16, 2013, *see id.* § 3(n)(1), 125 Stat. at 293, and are
therefore inapplicable to this dispute. *See Hamilton Beach Brands, Inc. v. Sunbeam Prods., Inc.*,
726 F.3d 1370, 1374 (Fed. Cir. 2013).

18 The pre-AIA version of 35 U.S.C. § 102 stated, in relevant part:

19 A person shall be entitled to a patent unless—

- 20 (a) the invention was known or used by others in this country, or patented
21 or described in a printed publication in this or a foreign country, before
the invention thereof by the applicant for patent, or
22 (b) the invention was patented or described in a printed publication in this
or a foreign country or in public use or on sale in this country, more

1 unanticipated; “prior art” is knowledge that is available to a person of ordinary skill in the
2 art. *See, e.g., Eli Lilly & Co. v. Zenith Goldline Pharm., Inc.*, 471 F.3d 1369, 1375 (Fed.
3 Cir. 2006). This defense “requires the presence in a single prior art disclosure of all
4 elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck &*
5 *Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). A design is anticipated when the average
6 observer takes the new design for a design that already exists. *See Int’l Seaway Trading*
7 *Corp.*, 589 F.3d at 1237.

8 3. Invalidity under 35 U.S.C. § 103 (“Obviousness”)

9 Patents must also be nonobvious. *See* 35 U.S.C. § 103. A patent is obvious “if the
10 differences between the claimed invention sought to be patented and the prior art are such
11 that the subject matter as a whole would have been obvious” at the time of invention “to a
12 person having ordinary skill in the art to which the claimed invention pertains.” 35
13 U.S.C. § 103(a). Obviousness is ultimately a legal question. *See, e.g., Wyers v. Master*
14 *Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010). Courts rely on four underlying factual
15 inquiries to determine whether a patent is invalid as obvious: (1) the scope and content of
16 the prior art; (2) the differences between the prior art and the claims at issue; (3) the level
17 of ordinary skill in the art; and (4) any relevant secondary considerations, such as
18 commercial success, unsolved needs for such an invention, and the failure of others to
19 produce the same or comparable inventions. *Graham v. John Deere Co.*, 383 U.S. 1, 17-

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21 than one year prior to the date of the application for patent in the
United States. . . .

22 35 U.S.C. § 102(a), (b) (2010).

1 18 (1966). Although factor four includes “secondary considerations,” this factor is often
2 an important component of the obviousness analysis. *KSR Intern. Co. v. Teleflex Inc.*,
3 550 U.S. 398, 415 (2007). In looking at prior art to determine obviousness, courts can
4 consider whether two or more pieces of prior art could have been combined to create the
5 claimed patent or whether a single piece of prior art could have been modified to create
6 it. *Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1351-52 (Fed. Cir. 2010).

7 **C. NAPA’s Functionality Affirmative Defense**

8 NAPA argues that LRI’s design patent is invalid because it is functional and not
9 ornamental as required by 35 U.S.C. § 171. In moving for summary judgment against
10 NAPA, LRI has to show only that NAPA lacks evidence for its functionality defense
11 because NAPA bears the burden of proving the defense at trial by clear and convincing
12 evidence. *Celotex*, 477 U.S. at 322-23. LRI addressed patent invalidity based on
13 functionality only superficially in its initial motion. (*See generally* Mot.) LRI stated that
14 NAPA’s functionality claim “fails as a matter of law as utility is a requirement of all
15 inventions submitted for Letters Patent . . .” under 35 U.S.C. § 101. (Mot. at 5-6.) As
16 noted above, LRI’s statement of the law concerning the applicability of the “utility”
17 requirement of 35 U.S.C. § 101 to design patents is incorrect. *In re Finch*, 535 F.2d at
18 71-72. More importantly, in its original moving papers, LRI never addressed the issue at
19 hand: whether the design patent here is primarily functional, which would render it
20 invalid under 35 U.S.C. § 171, or primarily ornamental, which would negate NAPA’s
21 functionality defense. (*See generally* Mot.) Thus, LRI did not meet its initial burden on
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1 summary judgment with respect to NAPA's functionality affirmative defense because
2 LRI only addressed utility and not functionality. *See Celotex*, 477 U.S. at 322-23.

3 Although NAPA did not present evidence supporting a functionality defense in
4 response to LRI's original motion, it was not required to do so when LRI failed to meet
5 its initial burden. *Cf. id.* NAPA also did not have access to the declaration and
6 attachments related to functionality that LRI included in its reply when NAPA responded
7 to LRI's motion. (*See generally* Mot.; Allen Decl.; Attachs. A-E6.) LRI only
8 meaningfully addressed NAPA's functionality affirmative defense in its reply brief, by
9 providing evidence in the form of a declaration and attachments. (Allen Decl.; Attachs.
10 (Dkt. # 20-1) A-E6.) It would be an abuse of discretion for the court to rely on the new
11 evidence that LRI attached to its reply memorandum to grant summary judgment without
12 giving NAPA a chance to respond to it. *See, e.g., Zamani*, 491 F.3d at 997.

13 Considering the evidence that LRI filed along with its reply brief, however, would
14 effectively allow LRI to circumvent the court's case schedule by allowing LRI to meet its
15 initial summary judgment burden after the court's dispositive motions deadline has
16 passed. (*See* Sched. Ord. (Dkt. # 11) at 2.) The court set the deadline for dispositive
17 motions on November, 12, 2013 (*id.*), and LRI timely filed its motion for summary
18 judgment on that date (*see generally* Mot). However, LRI did not file the evidence in
19 support of its argument about functionality until its January 8, 2014, reply. (*See*
20 *generally* Reply.) Relying on LRI's late-filed evidence would undermine the court's case
21 schedule and violate the spirit, if not the letter, of the court's order. Accordingly, the
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1 court will not rely on the new evidence presented in LRI's reply, and denies summary
2 judgment on this defense.

3 **D. NAPA's Anticipation and Obviousness Affirmative Defenses**

4 Summary judgment as to obviousness or anticipation is appropriate when the
5 "factual inquiries [underlying these legal questions] present no lingering genuine issues."
6 *Beckson Marine, Inc. v. NFM, Inc.*, 292 F.3d 718, 723 (Fed. Cir. 2002). For NAPA to
7 prevail on an anticipation affirmative defense, it has to show by clear and convincing
8 evidence that the LED flashlight design was in public use or on sale in the United States
9 one year prior to the date of application for the '372 patent. *See* 35 U.S.C. § 102.³ To
10 show obviousness, NAPA must demonstrate that the claimed invention was obvious to a
11 person of ordinary skill in the LED flashlight art based on the prior art that existed at the
12 time of invention. *See* 35 U.S.C. § 103.⁴ In its answer, NAPA alleged that "LRI and/or

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15 ³ Once again, this citation refers to the prior version of 35 U.S.C. § 102. *See supra*
16 note 2.

17 ⁴ This citation refers to the prior version of 35 U.S.C. § 103. *See supra* note 2. The pre-
AIA version of 35 U.S.C. § 103 stated, in relevant part:

- 18 (a) A patent may not be obtainable though the invention is not identically
19 disclosed or described as set forth in section 102 of this title, if the differences
20 between the subject matter sought to be patented and the prior art are such the
21 that subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negated by the manner in
which the invention was made.

22 35 U.S.C. § 103.

1 inventor David Allen publicly offered Photon lights⁵ as early as 1993 which constitute[s]
2 invalidating prior art” (Ans. ¶ 6.) Although the allegation that prior art existed at
3 the time of invention is relevant to proving invalidity on both of these grounds, NAPA
4 must do more than make a single factual assertion at the summary judgment stage. By
5 pointing to a lack of evidence to support this defense, LRI shifted the burden to NAPA to
6 show evidence that creates a genuine dispute about this material fact. In its response,
7 NAPA does not address these patent invalidity defenses, and provides no evidence at all
8 regarding the prior art underlying its anticipation and obviousness defenses. (*See*
9 *generally* Resp.) NAPA has not demonstrated a genuine dispute. Therefore, the court
10 grants summary judgment in favor of LRI on NAPA’s anticipation and obviousness
11 invalidity affirmative defenses.

12 In responding to LRI’s motion, NAPA contends that LRI improperly focuses on
13 the insufficiency of NAPA’s pleading its patent invalidity affirmative defenses. (*See*
14 Resp. at 1-2.) NAPA asserts that the court therefore has no basis on which to grant
15 summary judgment. (*Id.* at 1.) But NAPA’s assertions fail for two reasons. First, a court
16 may grant summary judgment solely on the pleadings if it determines there is no genuine
17 dispute. *See, e.g., Allen v. Educ. Cmty. Credit Union*, No. C06-16MJP, 2006 WL
18 1495775, at *3 (W.D. Wash. 2006). Second, although LRI discusses what it describes as
19 NAPA’s insufficient pleadings in the summary judgment motion, LRI also points to
20 NAPA’s lack of evidence related to the prior art underlying NAPA’s anticipation and

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22 ⁵ “Photon” is the name under which LRI sells the LED flashlights designed from the ’372
patent. (Am. Compl. ¶ 2-3.)

1 obviousness affirmative defenses. (*See* Mot. at 8-9.) NAPA has failed to understand its
2 own burden, as well as LRI's burden, at the summary judgment stage. All LRI must do
3 as the party moving for summary judgment against NAPA is show that NAPA lacks
4 evidence from which a reasonable jury could determine that the patent is invalid under a
5 clear and convincing evidentiary standard. *See Celotex*, 477 U.S. at 322-23. LRI has
6 done so. (*See generally* Mot.) Therefore, there is no factual dispute as to these two
7 grounds of patent invalidity.

8 Finally, despite NAPA's contention to the contrary, LRI's summary judgment
9 motion is not a late-filed Rule 12(f) motion to strike. (Resp. at 1.) Although LRI states
10 at the end of its motion that NAPA's patent invalidity affirmative defense "should be
11 stricken" from NAPA's answer, (Mot. at 10), LRI properly cites summary judgment
12 standards in its motion and bases its arguments on these standards. (*See id.* at 8-9).
13 Furthermore, LRI's motion does not mention Rule 12(f). (*See generally id.*) Thus, this
14 motion is properly characterized as one for summary judgment, not as a motion to strike.
15 For the reasons above, the court grants summary judgment in LRI's favor on NAPA's
16 anticipation and obviousness affirmative defenses.

17 **E. The Court Will Not Consider LRI's Alternative Request under Rule 12(e)**

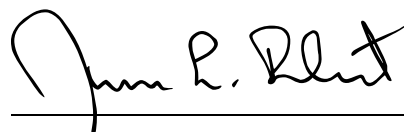
18 LRI also requests that the court "consider alternative relief under Rule 12(e) for a
19 more definite statement" if the court finds summary judgment inappropriate. (Mot.
20 at 10.) However, a Rule 12(e) motion is proper only where a party's pleading is so
21 indefinite that the other party cannot determine the claim being asserted. *Gregory Vill.*
22 *Partners, L.P. v. Chevron U.S.A., Inc.*, 805 F. Supp. 2d 888, 896 (N.D. Cal. 2011).

1 Although NAPA did not explicitly claim that LRI's patent was invalid as anticipated or
2 obvious under 35 U.S.C. §§ 102 and 103, its assertion to that effect was not so indefinite
3 that LRI could not determine on what grounds NAPA claimed patent invalidity. In
4 addition, because the court grants partial summary judgment as to the anticipation and
5 obviousness defenses, there is no longer a need to clarify NAPA's asserted defenses. For
6 these reasons the court does not consider LRI's alternative request for a more definite
7 statement under Rule 12(e).

8 IV. CONCLUSION

9 The court DENIES LRI's motion for partial summary judgment as to the
10 functionality ground for patent invalidity, but GRANTS summary judgment in favor of
11 LRI on NAPA's anticipation and obviousness affirmative defenses. NAPA has failed to
12 demonstrate a genuine dispute of material fact that the '372 patent is invalid because it is
13 anticipated or obvious under a clear and convincing evidentiary standard.

14 Dated this 11th day of February, 2014.

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17 JAMES L. ROBART
18 United States District Judge
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