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**UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

BRAVO SPORTS, INC., a California corporation; and VARIFLEX, INC., a Delaware Corporation,

Plaintiffs,

v.

NORTHPOLE (US) LLC, a Delaware corporation; NORTHPOLE (CHINA) LIMITED, a Chinese limited company; and NORTHPOLE LIMITED, a Hong Kong limited company,

Defendants.

CASE NO. SA CV 05-418 DOC (MLGx)

ORDER (1) DENYING DEFENDANTS’ MOTION FOR SUMMARY JUDGMENT OF OBVIOUSNESS INVALIDITY; (2) GRANTING DEFENDANTS’ MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT; (3) DENYING PLAINTIFFS’ MOTION TO TAKE ADDITIONAL DEPOSITIONS AS MOOT; and (4) GRANTING PLAINTIFFS’ UNOPPOSED MOTION TO AMEND EXPERT DISCLOSURES

Before the Court are the following motions: (1) Defendants’ Motion for Summary Judgment of Obviousness Invalidity (“Invalidity Motion”); (2) Defendants’ Motion for Summary Judgment of Non-Infringement (“Non-Infringement Motion”); (3) Plaintiffs’ Motion to Take Additional Depositions (“Deposition Motion”); and (4) Plaintiffs’ Unopposed Motion to Amend Expert Disclosures to Add a Rebuttal Report Concerning the Inequitable Conduct Counterclaim (“Disclosure Motion”). After considering the moving, opposing, and replying

1 papers, as well as oral argument by the parties, the Court hereby DENIES the Invalidity Motion,
2 GRANTS the Non-Infringement Motion, DENIES the Deposition Motion as MOOT, and
3 GRANTS the Disclosure Motion.

4 **I. BACKGROUND**

5 **A. Overview**

6 Prior to August 26, 1987, James P. Lynch (“Lynch”) invented a new portable canopy with
7 an automatic roof. On October 25, 1988, the USPTO issued United States Patent No. 4,779,635
8 (“the ‘635 Patent”) to Lynch for his portable canopy invention. On April 27, 2000, Plaintiff
9 Variflex (“Variflex”) purchased the ‘635 Patent from Lynch. Subsequent to the purchase, on
10 October 26, 2004, Variflex became a wholly owned subsidiary of Plaintiff Bravo Sports
11 (“Bravo”).

12 Plaintiffs claim that North Pole (US) LLC, North Pole (China) Limited, and North Pole
13 Limited (collectively, “North Pole”) have made, used, sold or offered for sale and imported
14 portable canopies which infringe claims 1, 2, 3, 4, 10, 11, 15, 16, and 18 of the ‘635 Patent.
15 Plaintiffs also argue that this infringement was willful because it had actual knowledge of the
16 patent prior to its alleged infringing activity, and thus, Plaintiffs are also seeking enhanced
17 damages, attorneys fees, and costs pursuant to 35 U.S.C. §§ 284-85. Plaintiffs also claim that
18 North Pole is actively inducing and/or contributing to the infringement of the ‘635 Patent by
19 selling the portable canopy to retailers, who then infringe the ‘635 Patent by selling the product.
20 North Pole has filed a counterclaim against Bravo and Variflex.

21 **B. Procedural Background**

22 Plaintiffs filed this action on May 3, 2005.

23 On March 9, 2006, the Court granted an order to stay this case pending the outcome of
24 the US Patent and Trademark Office’s reexamination of the patent-in-suit. The stay was lifted
25 by Court order on November 16, 2006. The parties have since been engaged in discovery.

26 Plaintiffs originally only named North Pole (US) LLC (“NP US”) as a defendant in this
27 action. In a Minute Order dated November 26, 2007, the Court granted Plaintiffs’ Motion for
28

1 Leave to File Second Amended Complaint, allowing Plaintiffs to amend to add North Pole
2 (China) Limited (“NP China”) and North Pole Limited (“NP Limited”) as defendants. NP China
3 and NP US are both subsidiaries of NP Limited. In that Minute Order, the Court found that
4 recently discovered evidence supported the allegations that NP China and NP Limited are
5 responsible for many of the allegedly infringing sales in this action.

6 In an Order dated December 21, 2007, the Court granted North Pole’s Motion for Leave
7 to Amend to Add a Counterclaim for Unenforceability of the ‘635 Patent due to alleged
8 inequitable conduct by Plaintiffs’ counsel. At issue were Defendants’ allegations that Plaintiffs’
9 counsel had failed to disclose two patents to the PTO during the reexamination of the ‘635
10 Patent.

11 In a Minute Order also dated December 21, 2007, the Court ordered the parties to show
12 cause regarding issues relating to the potential disqualification of Plaintiffs’ counsel arising from
13 the inequitable conduct counterclaim. In a Minute Order dated February 6, 2008, the Court
14 concluded that Plaintiffs’ counsel was permitted to continue representing Plaintiffs.
15 Furthermore, the Court bifurcated the trial of the inequitable conduct counterclaim, to be heard
16 by the Court during jury deliberations on infringement, damages, willfulness, and the validity of
17 the ‘635 Patent.

18 C. Reexamination

19 When Bravo filed this patent infringement lawsuit against NP US on May 3, 2005, Bravo
20 also filed a similar action against MAC Automotive. On September 21, 2005, MAC Automotive
21 filed a petition for re-examination of the ‘635 Patent in view of prior art that was not considered
22 in the first examination. The petition sought a re-examination of claims 1-6, 10, 11, and 15-19.
23 On March 9, 2006, the PTO issued an “Office Action in Ex Parte Re-examination,” in which it
24 concluded that claims 4 and 15 were patentable as written, but rejecting other claims initially in
25 light of the new prior art. Hartley Decl., Ex. 10 at 5.

26 Claim 4 was a dependent claim that incorporated the elements of claims 1, 2, and 3. The
27 examiner found after re-examination that “Claim 4 is patentable because the cited prior art
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1 patents and printed publications fail to teach a canopy structure, as defined in Claim 3, including
2 cantilever members each pivotally connected at a first end to a respective roof support member
3 and pivotally connected at a second end to the associated slide bracket.” *Id.* Claim 15 originally
4 was a dependent claim that incorporated the elements of claim 1. Claim 15 was determined to
5 be patentable for the same reason. *Id.*

6 In response, Bravo amended the claims so that all of the asserted claims required such a
7 cantilever member. An example of this claim limitation as set forth in claim 1 is as follows:

8 at least one cantilever member pivotally connected to at least one
9 roof support member and pivotally connected to a slide bracket
10 slideably received on a respective corner support member associated
11 with said at least one roof support member whereby pivotal
12 movement of said roof support members correspondingly slides said
13 slide bracket along said corner support member.

14 Reexamination Certif. at Col. 2, 5:11. Furthermore, claim 4 also additionally limits the
15 cantilever member with the following language:

16 whereby the cantilever members help support said roof support
17 members and whereby pivotal movement of said roof support
18 members acts to slide each of said slide brackets along its respective
19 corner support member and correspondingly contract the scissor
20 assemblies associated therewith.

21 *Id.* at Col. 3, 21:27. The PTO relied on the cited prior art patents and printed publications
22 without conducting its own prior art search. After Bravo amended the asserted claims, the PTO
23 allowed the asserted claims.

24 **D. Claims**

25 Plaintiffs assert that Defendants infringe claims 1, 2, 3, 4, 10, 11, 15, 16, and 18 of the
26 ‘635 Patent. Claims 1, 4, and 15 are independent claims, and claims 2, 3, 10, 11, 16, and 18 are
27 dependent claims in that they possess additional limitations apart from the independent claims.
28

1 There are three disputed terms relevant to the instant motions, all three of which are contained in
2 all of the asserted claims. First, the asserted claims require a “roof support member including a
3 pair of *extendable* sections.” Reexamination Cert. at Col. 1, 48:49. Second, the asserted claims
4 require a “*latch means* associated with each said roof support member.” *Id.* at Col. 1, 62:63.
5 Third, the asserted claims require a “flexible covering . . . exerting a downward force on said
6 apex.” *Id.* at Col. 2, 12:18.

7 The relevant language to the first disputed term is as follows:

8 roof support member including a pair of extendable sections
9 moveable between a retracted state when said canopy structure is in
10 the collapsed state and an extended state when said canopy structure
11 is in the expanded state.

12 *Id.* at Col. 1, 48:52. The second disputed term is set forth in the following context:

13 and latch means associated with each said roof support member for
14 releaseably retaining the extendable sections of each respective roof
15 support member in the extended state to prevent folding of the
16 canopy structure into the collapsed state and whereby the downward
17 force exerted on said apex exerts an outward force component
18 tending to move said corner support members apart from one another
19 against said constraining means.

20 *Id.* at Cols. 1-2, 62:3. Finally, the third disputed term is stated in the claims as follows:

21 a flexible covering sized to extend across the canopy framework unit
22 and be supported by said roof support members to form a top for said
23 canopy structure, said covering having perimeter edge portions
24 extending between the top ends of adjacent ones of said corner
25 support members and a central peak portion exerting a downward
26 force on said apex.

27 *Id.* at Col. 2, 12:18.

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1 E. Instant Motions

2 In the instant Invalidity Motion, Defendants move for a finding, on summary judgment,
3 that the claims of the '635 Patent alleged in the action are invalid because the subject matter
4 "would have been obvious at the time the invention was made to a person having ordinary skill
5 in the art," pursuant to 35 U.S.C. § 103.

6 Defendants also move for a summary judgment of non-infringement in the Non-
7 Infringement Motion, arguing that three limitations asserted in the '635 Patent claims at issue
8 preclude infringement by Defendants' products.

9 In the Deposition Motion, Plaintiffs move the Court for leave to take depositions pursuant
10 to Fed. R. Civ. P. 30(b)(6) of the newly added defendants, NP Limited and NP China. Plaintiffs
11 also seeks depositions of Samuel F. Lamke, Rusty Summars, and Jerry Tombleson.

12 Finally, in the Disclosure Motion, Plaintiffs seek leave to amend their expert disclosures
13 to add a rebuttal expert to address the inequitable conduct counterclaim.

14 II. CLAIM INTERPRETATION

15 Patent infringement analysis involves two steps: (1) an interpretation of the asserted
16 claims, and (2) a comparison of the claims to the accused device. *Markman v. Westview*
17 *Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S. Ct.
18 1384 (1996). Claim interpretation is a matter of law for the Court. *Markman*, 52 F.3d at 979.
19 Thus, an infringement analysis is amenable to summary judgment, even though the analysis
20 involves both issues of law and questions of fact, if the court finds that there are no genuine
21 issues of material fact. *Phonometrics Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1463-64 (Fed. Cir.
22 1998). Many courts have chosen to hold a claim interpretation hearing, or *Markman* hearing, to
23 facilitate the claim interpretation process. *See e.g., Ethicon Endo-Surgery, Inc. v. United States*
24 *Surgical Corp.*, 93 F.3d 1572, 1577 (Fed. Cir. 1996).

25 Claim interpretation begins with the language of the claim. *Teleflex, Inc. v. Ficosa N.*
26 *Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002). Terms in the claim are generally given the
27 ordinary and customary meaning they would have to a person of ordinary skill in the art at the
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1 time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).
2 However, the terms must be read in the context of the entire patent. *Id.* at 1314. In interpreting
3 the claims, the court focuses primarily on the intrinsic evidence of record, including the claims
4 themselves, the specification, and if in evidence, the prosecution history. *Id.* at 1312-17.

5 Among the intrinsic evidence, the specification is always highly relevant to the claim
6 construction analysis—it is the single best guide to the meaning of a disputed term, and is
7 usually dispositive. *Id.* at 1315 (quoting *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576,
8 1582 (Fed. Cir. 1996)). “The specification is, thus, the primary basis for construing the claims.”
9 *Id.* (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)). In
10 addition to the specification, the court will also consider the prosecution history, consisting of
11 “the complete record” of the patent. *Id.* at 1317. However, because the prosecution history
12 often lacks the clarity of the specification, it is less useful for claim interpretation purposes. *Id.*

13 While the court may also consider extrinsic evidence, including expert testimony,
14 dictionaries, and learned treatises, as the Federal Circuit has recently made clear, such evidence
15 is generally viewed as less reliable than intrinsic evidence. *Phillips*, 415 F.3d at 1317-18.
16 Therefore, the court must use its discretion in admitting and weighing extrinsic evidence,
17 keeping in mind its inherent flaws. *Id.* at 1319.

18 As discussed above, Plaintiffs assert that Defendants infringe claims 1, 2, 3, 4, 10, 11, 15,
19 16, and 18 of the ‘635 Patent. Claims 1, 4, and 15 are independent claims, and claims 2, 3, 10,
20 11, 16, and 18 are dependent claims. The parties dispute the proper construction of three claim
21 terms which are contained in all of the asserted claims: (1) “roof support member including a
22 pair of *extendable* sections;” (2) “*latch means* associated with each said roof support member;”
23 and (3) “flexible covering . . . exerting a downward force on said apex.” The Court construes
24 each of these claims terms in turn.

25 **A. FIRST DISPUTED CLAIM TERM: “extendable sections”**

26 All of the asserted claims require a “roof support member including a pair of extendable
27 sections moveable between a retracted state when said canopy structure is in the collapsed state
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1 and an extended state when said canopy structure is in the expanded state.” The parties dispute
2 the meaning of the term “extendable” as it pertains to the claims.

3 Defendants argue for a claim construction in which the term “extendable sections” does
4 not include “foldable” sections. Defendants propose a construction for “roof support member
5 including a pair of extendable sections” as follows:

6 a roof support member including a pair of sections which are not
7 pivotally connected, but are moveable in a parallel relationship
8 relative to each other such that the overall length of the roof support
9 member can be increased.

10 Defs.’ Mot. at 14:5-8. Plaintiffs propose the following construction:

11 a roof support member that includes a pair of sections that are
12 moveable between a collapsed state and an expanded state, by
13 folding and unfolding, telescoping, connected at a pivot point, or
14 joined by any other type of construction that allows the roof support
15 members to extend and retract.

16 Pls. Opp. at 3:13-21.

17 In the specification, the only structure disclosed for the roof support members is that they
18 are “telescoping members.” The title of the patent itself indicates that the roof support structure
19 uses telescoping sections: “Collapsible Canopy with *Telescoping* Roof Support Structure.”
20 Tobin Decl., Ex. 1 (emphasis added). Although the patent title does not import limitations to the
21 claims, *see Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298 (Fed. Cir. 1999), the rest
22 of the ‘635 Patent leads to a conclusion that the term “extendable sections” should be construed
23 in a way that is limited to a roof support structure operating through telescopic movement.

24 Most importantly, the “Field of the Invention,” which is part of the specification,
25 expressly states the following:

26 The present invention specifically is directed to such shelter which
27 includes a self-contained roof support structure that telescopically
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1 expands with the remaining support framework. As such, this
2 invention is believed to be an improvement over my U.S. Pat. No.
3 4,641,676 issued 10 Feb. 1987 and entitled Collapsible Canopy
4 Structure.

5 *Id.* at Col. 1, 5:20. Patent No. 4,641,676 (“the ‘676 Patent”) discloses a canopy containing non-
6 telescoping folding roof members. *See* Defs.’ Hearing Exhibits Re: Extendable Sections, Exh. 6.

7 The Federal Circuit has explained that the ordinary meaning of a claim term may be
8 constricted by a court in at least one of four ways, one of which is described as follows:

9 a claim term will not carry its ordinary meaning if the intrinsic
10 evidence shows that the patentee distinguished the term from prior
11 art on the basis of a particular embodiment, expressly disclaimed
12 subject matter, or described a particular embodiment as important to
13 the invention.

14 *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-1367 (Fed. Cir. 2002) (citations
15 omitted). Here, the intrinsic evidence contained within the “Field of the Invention”
16 demonstrates that the patent satisfies this test for constricting the claim term; thus, the claim term
17 is appropriately constricted by the Court based on the patentee’s choice of language within the
18 specification. This conclusion would hold true even if the ordinary meaning of the term
19 “extendable sections” were to be given a broader scope.

20 The plain language explaining that the ‘635 Patent “specifically is directed to” a shelter
21 containing a roof that “telescopically expands” is very clear. The patentee drew attention to the
22 roof as a distinguishing factor between the ‘635 Patent and the ‘676 Patent. Furthermore, the
23 inventor relied on the telescoping roof sections as a key difference between the ‘635 Patent and
24 the prior art ‘676 Patent, which did not contain telescoping roof sections. The patentee’s chosen
25 language in the specification implied that the embodiment containing a roof that “telescopically
26 expands” was a crucial aspect of the invention described by the ‘635 Patent. Accordingly, the
27 inventor disclaimed a broader scope through reliance on this distinction. *See Phillips v. AWH*
28

1 *Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (explaining that “the specification may reveal an
2 intentional disclaimer, or disavowal, of claim scope by the inventor”). In such an instance, “the
3 inventor has dictated the correct claim scope, and the inventor’s intention, as expressed in the
4 specification, is regarded as dispositive.” *Id.* Statements distinguishing aspects of the prior art
5 are considered a disclaimer of those aspects from the claimed invention. *See Atofina v. Great*
6 *Lakes Chemical Corp.*, 441 F.3d 991, 997 (Fed. Cir. 2006).

7 Plaintiffs argue that the language in the “Field of Invention” does not disclaim non-
8 telescoping roof sections, because the patentee must have “explicitly disclaimed or clearly
9 disavowed this meaning in the specification or prosecution history.” *Housey Pharm., Inc. v.*
10 *Astrazeneca UK Ltd.*, 366 F.3d 1348, 1352 (Fed. Cir. 2004). However, “when the scope of the
11 invention is clearly stated in the specification, and is described as the advantage and distinction
12 of the invention, it is not necessary to disavow explicitly a different scope.” *On Demand*
13 *Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1340 (Fed. Cir. 2006). Here, the patentee
14 clearly indicated in the “Field of the Invention” that the invention contained telescoping roof
15 sections. This made the invention an improvement over the inventor’s prior invention, according
16 to the inventor. Accordingly, an interpretation of “extendable” encompassing a broader scope is
17 precluded. This is particularly the case where the telescoping roof members have been described
18 in the context of the invention as a whole and not just as a preferred embodiment. *See, e.g., C.R.*
19 *Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 864 (Fed. Cir. 2004) (“Statements that describe
20 the invention as a whole, rather than statements that describe only preferred embodiments, are
21 more likely to support a limiting definition of a claim term.”).

22 A limiting definition of “extendable sections” is also supported when viewing the rest of
23 the specification. The specification only teaches “extendable sections” to be “telescoping”
24 sections, and nothing else. In addition to the Field of Invention, the Abstract states “[t]he roof
25 support members are formed of extendable sections which preferably telescope with respect to
26 one another.” Tobin Decl, Ex. 1. The Summary of the Invention provides that “each roof
27 support member preferably comprises at least two telescoping sections, an inner telescoping
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1 section mounted to the apex portion and an outer telescoping portion mounted to a respective
2 corner support member and telescopically receiving the inner telescoping member [sic].” *Id.* at
3 Col. 3, 49:54. Furthermore, the Detailed Description of the Preferred Embodiment provides
4 “[r]oof support member is formed of a pair of extendable members, preferably in the form of an
5 inner telescoping member and an outer telescoping member which telescopically receives
6 member 42.” *Id.* at Col. 5, 64:67. No other embodiment is set forth anywhere in the patent.
7 Furthermore, the specification nowhere teaches that the “extendable sections” are anything other
8 than telescoping. Although Plaintiffs attempt to point to language in the specification that
9 describes the roof support members as “folding,” the specification only does so in relation to the
10 respective ends of the roof support members at the first and second pivot axes. Throughout the
11 ‘635 Patent, those parts that are pivotally connected are described as being foldable, but never
12 the extendable portions of the roof sections. In light of the language throughout the
13 specification, in combination with the specific description of the invention in the Field of
14 Invention, the Court finds that the inventor defined “extendable sections” as “telescoping.”

15 Plaintiffs’ arguments regarding claim differentiation are similarly unavailing. Under the
16 doctrine of claim differentiation, there is a presumption that each claim is different in scope,
17 particularly “where ‘there is a dispute over whether a limitation found in a dependent claim
18 should be read into an independent claim, and that limitation is the only meaningful difference
19 between the two claims.’” *RF Delaware, Inc. v. Pacific Keystone Techs.*, 326 F.3d 1255, 1263
20 (Fed. Cir. 2003) (citations omitted). Plaintiffs argue that claim differentiation applies here to
21 preclude limiting the definition of “extendable sections” to “telescoping” because claim 12,
22 which depends from claim 1, expressly limits the “extendable sections” to “telescoping”
23 sections. However, “claim differentiation can not broaden claims beyond the scope that is
24 supported by the specification,” and “[t]he presumption that separate claims have different scope
25 ‘is a guide, not a rigid rule.’” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 541 (Fed. Cir. 1998).
26 Thus, in light of the Court’s determination regarding the specification, claim differentiation does
27 not preclude the Court’s construction. Furthermore, the Court’s construction, set forth below,
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1 describes sections moving relative to each other, and claim 12 describes “inner and outer
2 telescoping sections.” Thus, claim 12 is indeed more limited in scope than the Court’s
3 construction of “extendable sections.”

4 There is also no need to analyze the extrinsic evidence, including the expert testimony at
5 odds with the written description, as the “extrinsic evidence . . . [is] less reliable than the patent
6 and its prosecution history.” *Phillips*, 415 F.3d at 1318. The specification itself establishes the
7 scope of the “extendable sections.” “[C]laims cannot be of broader scope than the invention that
8 is set forth in the specification.” *On Demand Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d
9 1331, 1340 (Fed. Cir. 2006).

10 Finally, due to the notice function of a claim, a definition that limits “extendable sections”
11 to “telescoping” sections is supported by the Federal Circuit’s preference for the narrower
12 meaning “[w]here there is an equal choice between a broader and a narrower meaning of a
13 claim.” *Athletic Alternatives, Inc. v Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).
14 “The specification shall contain a written description of the invention, and of the manner and
15 process of making and using it, in such full, clear, concise, and exact terms as to enable any
16 person skilled in the art to which it pertains . . . to make and use the same.” 35 U.S.C. § 112.
17 Where the patent is poorly written and the patentee fails to use full, clear, concise, and exact
18 terms, it would be inequitable to grant the patentee a broader meaning than that which he or she
19 claims to make the patent an improvement over a prior patent. Here, the patentee proclaimed
20 telescopic expansion of the roof to be a unique feature and improvement over the ‘676 Patent.
21 Accordingly, the Court construes the term “extendable sections” to mean the following: *the roof*
22 *support members have at least two pieces that move wherein one piece moves relative to another*
23 *piece in a telescopic relation from a retracted to an extended state.*

24 **B. SECOND DISPUTED CLAIM TERM: “latch means”**

25 All of the asserted claims also require “latch means associated with each said roof support
26 member for releaseably retaining the extendable sections of each respective roof support
27 member in the extended state to prevent folding of the canopy structure into the collapsed state.”
28

1 Defendants propose a means-plus-function limitation to construe “latch means” subject to
2 35 U.S.C. § 112, ¶6, because the claim term uses the word “means” and recites functions.

3 Defendants’ proposed construction is as follows:

4 Function: for releasably retaining the extendable sections of each
5 respective roof support member in the extended state to prevent
6 folding of the canopy structure in to the collapsed state and whereby
7 downward force exerted on said apex exerts an outward force
8 component tending to move said corner support members apart from
9 one another.

10 Structure: a button latch between two telescoping sections.

11 Defs.’ Mot. at 20:15-21. Bravo proposes the following construction: “‘latch’ is a releasable
12 button and hole or detent, quick release pin, spring pin, screw lock, and mechanical equivalents.”

13 Pls.’ Opp. at 13:9-12. In the alternative, Bravo proposes the following means-plus-function
14 limitation for construing “latch means”:

15 Function: for releasably retaining the extendable sections of each
16 respective roof support member in the extended state to prevent
17 folding of the canopy structure into the collapsed state.

18 Structure: a button latch and mating hole structure, and equivalent
19 structures.

20 *Id.* at 13:12-19.

21 First, the Court concludes that “latch means” is a means-plus-function claim subject to 35
22 U.S.C. §112, ¶6. The Court presumes that the “applicant advisedly used the word ‘means’ to
23 invoke the statutory mandates for means-plus-function clauses.” *Rodime PLC v. Seagate Tech.,*
24 *Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999). Although Plaintiffs argue that “latch” is not a
25 means-plus-function limitation, the Court finds this argument unavailing. Plaintiffs argue that
26 “latch” denotes sufficient structure, and, therefore, §112, ¶6 does not apply. *See Lighting World,*
27 *Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004). However, the term
28

1 “latch” could take many different possible structures and does not alone denote sufficient
2 structure in these circumstances. *See Laitram Corp. v. Rexnord*, 939 F.2d 1533, 1536 (Fed. Cir.
3 1991) (“[t]he recitation of some structure in a means plus function element does not preclude the
4 applicability of section 112(6) . . . [where it] merely serves to further specify the function of that
5 means.”). Thus, “latch means” is a means-plus-function claim.

6 Having determined that the claim term is a means-plus function claim, the Court must
7 determine “both identification of the claimed function and identification of the structure in the
8 written description necessary to perform that function.” *Micro Chem., Inc. v. Great Plains*
9 *Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999).

10 In a means-plus-function claim, “[t]he function is properly identified as the language after
11 the ‘means for’ clause and before the ‘whereby’ clause, because a whereby clause that merely
12 states the result of the limitations in the claim adds nothing to the substance of the claim.”
13 *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003).
14 Here, the “whereby” clause, “whereby downward force exerted on said apex exerts an outward
15 force component tending to move said corner support members apart from one another,” does
16 just that – it states the result of the limitations. This “whereby” clause merely describes the
17 result of locking the latch means. “A ‘whereby’ clause that merely states the result of the
18 limitations in the claim adds nothing to the patentability or substance of the claim.” *Texas*
19 *Instruments Inc. v. U.S. Intern. Trade Com’n*, 988 F.2d 1165, 1172 (Fed. Cir. 1993). Thus the
20 Court construes the function to be the following: *for releasably retaining the extendable sections*
21 *of each respective roof support member in the extended state to prevent folding of the canopy*
22 *structure into the collapsed state.*

23 Defendants seek to include the location of the “latch means” in the definition of the
24 structure. Plaintiffs argue that the specific location of the latch means stated throughout the
25 Patent as part of the preferred embodiment does not perform the function described above. *See*
26 *Wenger Mfg., Inc. v. Coating Machinery Systems, Inc.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001) (“a
27 court may not import . . . structural limitations from the written description that are unnecessary
28

1 to perform the claimed function.”). Plaintiffs explain that the location in the preferred
2 embodiment “recognizes that placing the button latch on the roof supports allows the button
3 latch to perform the function of retaining the roof supports in the extended state when they are
4 comprised of telescoping members.” Pls.’ Opp. at 19:15-20. Plaintiffs further state that:

5 [i]f the extendable sections of the roof supports extend in some other
6 manner – such as by folding and unfolding – placement of the button
7 latch in another location may well be necessary for the button latch
8 to perform the described function. The ability of the button latch to
9 perform that function is not dependent upon the placement of the
10 latch in the specific location disclosed on the preferred embodiment.
11 Instead, the location of the button latch will be determined by the
12 nature of the extendable sections used in the roof supports.

13 *Id.* at 19:21-27. However, the Court has construed the “extendable sections” above as having at
14 least two telescoping pieces. Nonetheless, even though the “extendable sections” have been
15 constricted by the Court to only include those moving in a telescopic relation to each other,
16 Defendants have not shown that the location of the latch means is absolutely necessary to
17 perform the specified function. For example, there may be latch means on the ends of telescopic
18 sections, which latch those ends to other portions of the canopy, yet still retain the extendable
19 sections in the extended state and prevent the canopy from collapsing. Thus, the location of the
20 button latch between the telescoping members is not, on its face, necessary to perform the
21 claimed function. Accordingly, the court construes the structure as follows: *a button latch.*

22 **C. THIRD DISPUTED CLAIM TERM: “flexible covering . . . exerting a**
23 **downward force on said apex”**

24 Finally, all of the asserted claims require:

25 a flexible covering sized to extend across the canopy framework unit
26 and be supported by said roof support members to form a top for said
27 canopy structure, said covering having perimeter edge portions
28

1 extending between the top ends of adjacent ones of said corner
2 support members and a central peak portion exerting a downward
3 force on said apex.

4 Defendants propose a means-plus-function limitation to construe this term subject to 35 U.S.C. §
5 112, ¶6. Defendants' proposed construction is as follows:

6 Function: exert a downward force on said apex.

7 Structure: the covering is supported above the roof frame by a force
8 creating projection at the apex, such as a spring-biased center post
9 assembly.

10 Defs.' Mot. at 25:13-14 and 26:21-23. Plaintiffs propose the following construction of the
11 disputed term: "The covering has a central peak portion, the weight of which exerts a downward
12 force on the apex."

13 First, the Court concludes that the claim term language of "downward force on said apex"
14 is not a means-plus-function claim subject to 35 U.S.C. §112, ¶6. "[A] claim term that does not
15 use 'means' will trigger the rebuttable presumption that §112 ¶ 6 does not apply." *CCS Fitness,*
16 *Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed. Cir. 2002). "[T]he presumption flowing
17 from the absence of the term 'means' is a strong one that is not readily overcome." *Lighting*
18 *World v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004). The Federal Circuit
19 has "seldom held that a limitation not using the term 'means' must be considered to be in means-
20 plus-function form." *Id.* at 1362.

21 Defendants argue that the presumption is overcome with this claim because "the claim
22 fails to 'recite sufficiently definite structure' or recites a 'function without reciting sufficient
23 structure for performing that function.'" *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d
24 1311, 1319 (Fed. Cir. 2004). Defendants argue that the asserted claim language fails to define a
25 structure that "causes or allows a peak portion of the canopy to 'exert[] a downward force on
26 said apex' which 'exerts an outward force component.'" Defs' Mot. at 25:11-14. However, the
27 relevant claim language applicable to the covering limitation is clear and conveys sufficient
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1 structure of the covering that exerts the downward force on the apex of the canopy.

2 Defendants' construction is an improper attempt to import limitations from the preferred
3 embodiment relating to a different claim term into the disputed limitation. Claims 1, 4, and 15,
4 the independent claims, describe an "apex," but do not mention or require the existence of a
5 spring-biased central post assembly identified in the preferred embodiment. Claims 6-8, which
6 depend from claim 1, are the claims that limit the apex to the central post assembly identified in
7 the preferred embodiment. Thus, it is inappropriate to import these limitations into the covering
8 limitation in the independent claims.

9 Here, the claim clearly defines the flexible covering to have a central peak portion that
10 exerts a downward force on the apex. This is not a circumstance where there is a function cited
11 without a sufficient structure for performing that function. Accordingly, the Court construes this
12 claim term as follows: *the covering has a central peak portion that exerts a downward force on*
13 *the apex*. The Court finds no need to read language regarding the weight of the covering into the
14 claim, where that weight is not stated in the Patent.

15 **III. SUMMARY JUDGMENT**

16 **A. LEGAL STANDARD**

17 Summary judgment is proper if "the pleadings, depositions, answers to interrogatories,
18 and admissions on file, together with the affidavits, if any, show that there is no genuine issue as
19 to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.
20 R. Civ. P. 56(c).

21 The Court must view the facts and draw inferences in the manner most favorable to the
22 non-moving party. *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S. Ct. 993 (1962);
23 *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1161 (9th Cir. 1992). The moving party bears
24 the initial burden of demonstrating the absence of a genuine issue of material fact for trial, but it
25 need not disprove the other party's case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256,
26 106 S. Ct. 2505 (1986); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-25, 106 S. Ct. 2548 (1986).
27 When the non-moving party bears the burden of proving the claim or defense, the moving party
28

1 can meet its burden by pointing out the absence of evidence of a genuine issue of material fact
2 from the non-moving party. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 806-07
3 (Fed. Cir. 1999).

4 Once the moving party meets its burden, the “adverse party may not rest upon the mere
5 allegations or denials of the adverse party’s pleading, but the adverse party’s response, by
6 affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is
7 a genuine issue for trial. If the adverse party does not so respond, summary judgment, if
8 appropriate, shall be entered against the adverse party.” Fed. R. Civ. P. 56(e); *see also*
9 *Anderson*, 477 U.S. at 248-49. Furthermore, a party cannot create a genuine issue of material
10 fact simply by making assertions in its legal papers. There must be specific, admissible evidence
11 identifying the basis for the dispute. *S.A. Empresa de Viacao Aerea Rio Grandense v. Walter*
12 *Kidde & Co., Inc.*, 690 F.2d 1235, 1238 (9th Cir. 1980). The Supreme Court has held that “[t]he
13 mere existence of a scintilla of evidence . . . will be insufficient; there must be evidence on
14 which the jury could reasonably find for [the opposing party].” *Anderson*, 477 U.S. at 252.

15 B. INVALIDITY

16 Defendants move for summary judgment on the ground that the asserted claims in the
17 ‘635 Patent are invalid for obviousness.

18 A patent is presumed valid. 35 U.S.C. § 282. The party challenging validity has the
19 burden of proving by clear and convincing evidence that the patent is invalid. *Oakley, Inc. v.*
20 *Sunglass Hut Int’l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003); *Mas-Hamilton Group v. LaGard, Inc.*,
21 156 F.3d 1206, 1216 (Fed. Cir. 1998). A purported invention is unpatentable if “differences
22 between the subject matter sought to be patented and the prior art are such that the subject matter
23 as a whole would have been obvious at the time the invention was made to a person having
24 ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *see also*
25 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966). Obviousness is determined by analyzing
26 the following factors: (i) scope and content of prior art, (ii) differences between the art and the
27 claims at issue, (iii) the level of ordinary skill in the art, and (iv) objective evidence of
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1 nonobviousness, which may include commercial success, long felt but unresolved need, and
2 acquiescence of others in the industry to the patent's validity. *KSR Int'l Co. v. Teleflex, Inc.*, 127
3 S. Ct. 1727, 1734 (2007) (citing *Graham*, 383 U.S. at 17-18). Summary judgment on
4 obviousness is appropriate where "the content of the prior art, the scope of the patent claim, and
5 the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim
6 is apparent in light of these factors." *Id.* at 1745-1746.

7 Defendants have failed to resolve material disputes regarding these factors in their favor.
8 For a number of reasons, the Court finds that summary judgment on obviousness is not
9 appropriate. First, Defendants rely largely on the facts surrounding the reexamination in support
10 of their Invalidity Motion. Specifically, Defendants point to the conclusions made by the
11 Examiner "that the cited prior art patents and printed publications fail to teach a canopy
12 structure, as defined in Claim 3, including cantilever members each pivotally connected at a first
13 end to a respective roof support member and pivotally connected at a second end to the
14 associated slide bracket." Defendants argue that two prior art patents, the Magary and Morel
15 Patents, disclose a cantilever member just like the one claimed. These two patents were not
16 considered by the PTO during reexamination. Accordingly, Defendants argue that the PTO
17 would have reached a different conclusion on obviousness if it had considered these patents.
18 Furthermore, Defendants argue that one of ordinary skill in the art would have had good reason
19 to add the Magary or Morel cantilever member, and, therefore, the addition of one of these
20 cantilever members would have been obvious to one of skill in the art at the time of the
21 invention.

22 Defendants' conclusions are quick to favorably interpret the scope of the Examiner's
23 conclusions. Specifically, Defendants argue that the Examiner concluded that the only element
24 missing in the prior art was a cantilever member. However, the Examiner explicitly stated that
25 the "prior art patents and printed publications fail to teach a canopy structure, as defined in
26 Claim 3, including cantilever members" Thus, it was not just that the prior art failed to
27 disclose cantilever members. Instead, the Examiner appears to have upheld the claims with this
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1 limitation because nothing else had disclosed a cantilever member in conjunction with the
2 features of the particular canopy in the '635 Patent. Plaintiffs argue that:

3 the new and non-obvious use of cantilevers claimed in the '635
4 Patent was their use *in conjunction with* three other structures –
5 scissor assemblies, the slide brackets, and the extendable roof
6 sections – to create a new feature and function: an integrated, all-in-
7 one canopy with a cathedral ceiling that erects automatically by the
8 process of simply pulling two opposite legs apart.

9 Pls.' Opp. at 9:11-15. If the PTO had simply been relying on the cantilever members in
10 isolation, then it would have likely concluded that these members were obvious based on the
11 other prior art that was before it. However, "a patent composed of several elements is not
12 proved obvious merely by demonstrating that each of its elements was, independently, known in
13 the prior art." *KSR Int'l Co.*, 127 S. Ct. at 1741. Thus, it stands to reason that the PTO relied on
14 the cantilever members' use in conjunction with the other elements of the canopy.

15 Two patents submitted in the reexamination and relied upon by the PTO disclosed
16 cantilever members similar to those disclosed in the '635 Patent: the Baker '915 Patent ("Baker
17 Patent") and the Hall '931 Patent ("Hall Patent"). The Baker Patent, issued in 1924, discloses a
18 "Sun and Wind Shield." Hartley Decl., Ex. 6. The Baker Patent contains top supporting rods
19 connected to supporting uprights with a hinge. *See id.* Braces are pivoted at their respective
20 ends to the supporting rods and to a sleeve slidable along the supporting upright. *See id.* at 1,
21 96:101. The Hall Patent, issued in 1978, discloses an "Umbrella Shelter." The Hall Patent
22 contains ribs pivotally mounted in a rib holder. Hartley Decl., Ex. 12 at Col. 2, 52:58. The ribs
23 are raised and lowered by strut links which are pivotally attached to a slide ring. *Id.* at Col. 3,
24 4:11, 12:15. The PTO considered this prior art and nonetheless concluded that the '635 Patent
25 was non-obvious and valid in light of the cantilever members in combination with the other
26 features of the canopy.

27 The Magary and Morel Patents may have features that make them more similar to the
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1 '635 Patents than the Hall and Baker Patents, and, therefore, more likely to lead to a conclusion
2 of obviousness. However, they do not lead to a conclusion that there is no genuine issue of
3 material fact as to obviousness for the purposes of summary judgment, particularly in light of the
4 ways in which the '635 Patent cantilever members interact with the scissor assemblies, slide
5 brackets, and extendable roof sections. The Magary Patent, issued in 1955, discloses a "cabin"
6 structure. Tobin Decl, Ex. 3. The Magary Patent contains a strut pivotally connected between a
7 brace and extension and a sleeve slidably mounted on a tubular member. *Id.* at Col. 5, 18:39.
8 The Morel Patent, issued in 1959, discloses a canopy control system and has a similar cantilever
9 member to that disclosed in the '635 Patent. Tobin Decl, Ex. 4. Although these two patents
10 both disclose cantilever members, they do not disclose cantilever members that interact with
11 other features contained in the canopy in the '635 Patent, namely the scissor assemblies, slide
12 brackets, and extendable roof sections in combination. Thus, there exist genuine disputes as to
13 whether the scopes of the Magary and Morel Patents bear greater relation to the structure in the
14 '635 Patent than the Baker and Hall Patents already before the Examiner to lead to a conclusion
15 of obviousness.

16 Furthermore, Defendants have not shown that they have eliminated genuine disputes as to
17 the second *Graham* factor. Specifically, Defendants have failed to show that there is no genuine
18 issue of material fact regarding whether the Morel Patents and Magary Patents suggest
19 combining the cantilever members with the scissor assemblies, slide brackets, and extendable
20 roof sections of the '635 Patent in geometrical combination to make it all work together.
21 Plaintiffs' and Defendants' experts have submitted contradictory reports regarding the link
22 between the prior art and the asserted claims. Given the close nature of this assessment,
23 summary judgment is inappropriate. The ultimate trier of fact should determine whether the
24 prior art Morel and Magary Patents suggest a cantilever member as used in the '635 Patent.

25 The level of ordinary skill in the art of canopies, the third *Graham* factor, presents a
26 disputed material fact which prevents summary judgment on obviousness. Defendants' expert
27 claims that:

28

1 one of ordinary skill in the art of canopy and tent design typically (1)
2 has a bachelors degree in a technical field, most typically in
3 industrial design, (2) has received some training from a manufacturer
4 or designer of such products, including exposure to the types of
5 materials, constructions, and manufacturing methods typically
6 utilized, (3) has received additional training by way of attending
7 various trade shows, such as the Outdoor Retailer Show (ORS),
8 NSGA show, the Super Show, and the Friedrichshaven Show, where
9 a designer is exposed to various components and materials and
10 techniques for assembling such products, and (4) has 10 years of
11 design experience or more.

12 Tobin Decl., Ex. 3 at 3. In contrast, Plaintiffs' experts state a different level of skill attributable
13 to one of ordinary skill in the art. Specifically, "the qualifications of such a person would range
14 from a high school degree and approximately five years of experience in the canopy industry to a
15 college degree and approximately two years of experience in the canopy industry." Hartley
16 Decl., Ex. 2(a) at ¶ 12. These experts reach different conclusions regarding whether one of
17 ordinary skill in the art would have found the addition of the cantilever member to the '635
18 Patent to be obvious. The ultimate trier of fact must make a factual determination regarding the
19 level of ordinary skill in the art in order to determine whether the prior art patents suggest a use
20 of the cantilever member as employed in the '635 Patent. Without knowing the skill level of one
21 ordinarily skilled in the art of canopies, it is impossible to reach a conclusion on obviousness and
22 resolve whether Defendants' experts are correct in asserting that the prior art would suggest the
23 cantilever member's use in the '635 Patent, or whether Plaintiffs' experts are correct that the
24 prior art would not suggest such a use.

25 Given that these crucial *Graham* factors are in material dispute, summary judgment
26 regarding obviousness would not be appropriate. This is not a case where "the content of the
27 prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material
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1 dispute, and the obviousness of the claim is apparent in light of these factors.” *KSR Int’l Co.*,
2 127 S. Ct. at 1745-1746. Accordingly, Defendants’ Invalidity Motion is hereby DENIED.

3 C. NON-INFRINGEMENT

4 Defendants assert that they are entitled to summary judgment of non-infringement based
5 on the alleged absence of the three claim limitations construed above: (1) “extendable sections;”
6 (2) “latch means;” and (3) “flexible covering . . . having a central peak portion exerting a
7 downward force on said apex.” As each of these claim limitations is contained in each and every
8 asserted claim, Defendants would be entitled to summary judgment for non-infringement if they
9 could show that there is no genuine issue of material fact as to any one of the claim limitations.
10 Defendants are entitled to summary judgment because there are no genuine issues of material
11 fact regarding infringement, either literally or under a doctrine of equivalents theory, as to the
12 first and second claim limitations, as set forth below. No reasonable jury could find in Plaintiffs’
13 favor regarding infringement of these two claim limitations.

14 After interpreting the asserted claims to determine their meaning and scope, a court
15 performing a literal infringement analysis must determine whether those claims read on the
16 accused product. *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995).
17 “To establish literal infringement, every limitation set forth in a claim must be found in an
18 accused product, exactly.” *Id.* Furthermore, “[l]iteral infringement of a means-plus-function
19 claim requires that the relevant structure in the accused device perform the identical function
20 recited in the claim and be identical or equivalent to the corresponding structure in the
21 specification.” *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308 (Fed. Cir.
22 2003).

23 Under the doctrine of equivalents, a patent holder is able to claim equivalence for “those
24 insubstantial alterations that were not captured in drafting the original patent claim but which
25 could be created through trivial changes.” *Festo v. Shoketsu Kinzoku Kogyu Kabushiki*, 535
26 U.S. 722, 730, 122 S. Ct. 1831 (2002). A particular element in the accused product is equivalent
27 to a limitation in the claim if the differences between them are insubstantial. *AquaTex Indus. v.*
28

1 *Techniche Solutions*, 419 F.3d 1374, 1382 (Fed. Cir. 2005). The Court’s analysis in this inquiry
2 focuses on whether the element in the accused product “performs substantially the same function
3 in substantially the same way to obtain the same result as the claim limitation.” *Id.* (quoting
4 *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S. Ct. 854 (1950))
5 (internal quotation omitted). The doctrine of equivalents thus generally applies where the
6 accused device incorporates only an insubstantial change that adds nothing of significance to the
7 patented invention. *Valmont Indus. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1043 (Fed. Cir.
8 1993).

9 “A determination of infringement, both literal and under the doctrine of equivalents, is a
10 question of fact.” *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372 (Fed. Cir.
11 2001). However, the question of infringement becomes a question of law where the parties do
12 not dispute any relevant facts regarding the structure or composition of the accused device.
13 *Athletic Alternatives v. Prince Mfg.*, 73 F.3d 1573, 1578 (Fed. Cir. 1996). “Thus, a literal
14 infringement issue is properly decided upon summary judgment when no genuine issue of
15 material fact exists, in particular, when no reasonable jury could find that every limitation recited
16 in the properly construed claim either is or is not found in the accused device.” *Bai v. L & L*
17 *Wings*, 160 F.3d 1350, 1353 (Fed. Cir. 1998).

18 A claim of infringement under the doctrine of equivalents can also be resolved on
19 summary judgment, where “no reasonable jury could determine two elements to be equivalent.”
20 *Id.* at 1353-54 (quoting *Warner-Jenkinson* 520 U.S. 17, 39 n.8, 117 S. Ct. 1040 (1997)).
21 However, summary judgment of non-infringement under the doctrine of equivalents is a “high
22 hurdle,” “requiring delicate balancing of many factual components.” *Vehicular Techs. Corp. v*
23 *Titan Wheel Intern., Inc.*, 212 F.3d 1377, 1381 (Fed. Cir. 2000). “Because infringement under
24 the doctrine of equivalents often presents difficult factual determinations, a summary conclusion
25 that a reasonable jury could not find infringement is often illusive.” *Leggett & Platt, Inc. v.*
26 *Hickory Springs Mfg. Co.*, 285 F.3d 1353, 1360 (Fed. Cir. 2002); *see also Graver Tank*, 339
27 U.S. at 609-610 (“a finding of equivalence is a determination of fact . . . final determination
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1 requires a balancing of credibility, persuasiveness and weight of evidence.”). However, the
2 doctrine of equivalents is not a license to ignore or “erase meaningful structural and functional
3 limitations of the claim on which the public is entitled to rely in avoiding infringement.” *Perkin-*
4 *Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed. Cir. 1987). “Liability for
5 infringement thus requires, without exception, that an accused product contain each limitation or
6 its equivalent.” *Athletic Alternatives*, 73 F.3d at 1582. This rule, known as the “all limitations”
7 rule, “requires that equivalence be assessed on a limitation-by-limitation basis, as opposed to
8 from the perspective of the invention as a whole.” *Freedman Seating Co. v. American Seating*
9 *Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005) (citations omitted). In addition, “an element of an
10 accused product or process is not, as a matter of law, equivalent to a limitation of the claimed
11 invention if such a finding would entirely vitiate the limitation.” *Id.* at 1358-59 (citations
12 omitted). Furthermore, the doctrine of equivalents cannot be used to “recapture subject matter
13 that was relinquished during prosecution of the patent.” *Athletic Alternatives*, 73 F.3d at
14 1582 (citing *Hogan AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951 (Fed. Cir. 1993)).

15 The Court discusses each of the disputed claim terms.

16 **1. FIRST DISPUTED CLAIM TERM: *the roof support members have at***
17 ***least two pieces that move wherein one piece moves relative to another***
18 ***piece in a telescopic relation from a retracted to an extended state***

19 The parties do not dispute the relevant facts about literal infringement based on the first
20 disputed claim term. Instead, their dispute centers around the proper claim construction. Thus,
21 now that the Court has construed this claim limitation, non-infringement under a literal
22 infringement theory can be determined as a matter of law.

23 It is undisputed that the roof support members in the accused devices do not satisfy this
24 claim limitation, but instead operate by folding. Accordingly, no reasonable jury could find that
25 *this* limitation recited in the asserted claims is found exactly in the accused devices, and,
26 therefore, no reasonable jury could find that *every* limitation recited in the properly construed
27 claims is found exactly in the accused devices. Furthermore, this finding applies to all asserted
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1 claims, because the limitation is contained in all of the independent claims. *Wahpeton Canvas*
2 *Co. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989) (“One who does not infringe an
3 independent claim cannot infringe a claim dependent on (and thus containing all the limitations
4 of) that claim.”). Accordingly, this claim limitation precludes a finding of literal infringement.

5 In addition, Defendants are entitled to judgment as a matter of law regarding infringement
6 under the doctrine of equivalents as to this claim limitation. Defendants and Plaintiffs have
7 submitted contradictory expert reports concerning whether Defendants’ products infringe under
8 the doctrine of equivalents. Although there is typically a delicate balancing of many factual
9 components required to find non-infringement under the doctrine of equivalents, the
10 circumstances in this action are such that no reasonable jury could find the two claim elements to
11 be identical between the ‘635 Patent and the accused product.

12 As an initial matter, Plaintiffs suggested at oral argument that the Court should look to the
13 total context of how the canopy operates for the doctrine of equivalents analysis. However, this
14 is not the proper test. Instead, as stated above, the Court is to assess equivalence “on a
15 limitation-by-limitation basis, as opposed to from the perspective of the invention as a whole.”
16 *Freedman Seating Co.*, 420 F.3d at 1358 (Fed. Cir. 2005). Here, the “all-limitations” rule leads
17 to a finding in favor of Defendants as a matter of law.

18 Specifically, the claim limitation requires that the roof support members have at least two
19 pieces moving in a telescopic relation with each other. However, the accused products’ roof
20 support members contain two pieces that fold. These pieces do not move in any telescopic
21 relation to each other in any way. This difference between the terms is a substantial difference,
22 in that the two elements are completely different structures. A finding of infringement under the
23 doctrine of equivalents would “erase meaningful structural and functional limitations of the
24 claim on which the public is entitled to rely in avoiding infringement.” *Perkin-Elmer Corp.*, 822
25 F.2d at 1532 (Fed. Cir. 1987). Here, the public was entitled to rely on the specific and explicit
26 structural limitation of the claim, namely the movement of the roof members in a telescopic
27 relation. This limitation puts any potential inventors on notice of the limitation, but also allows
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1 them to try other structures as improvements. These other structures include sections that fold,
2 rather than telescopically expand. A finding of infringement would completely undermine the
3 claim limitation that put the public on notice.

4 The scope of the differences between folding and telescopically expanding sections is
5 analogous to other differences found by the Federal Circuit to preclude infringement under the
6 doctrine of equivalents. *See, e.g., Freedman Seating Co. v. American Seating Co.*, 420 F.3d
7 1350 (Fed. Cir. 2005) (finding that a rotatably mounted seat base is not equivalent to a “slidably
8 mounted” seat base, and that such a difference “is not a ‘subtle difference in degree,’ but rather,
9 ‘a clear, substantial difference or difference in kind.’” (citing *Ethicon Endo-Surgery, Inc. v. U.S.*
10 *Surgical Corp.*, 149 F.3d 1309, 1321 (Fed. Cir. 1998))); *Minebea Co., Ltd. v. Think Outside,*
11 *Inc.*, 159 Fed. Appx. 197, 2006 WL 172218 (Fed. Cir. 2006) (sliding structure not equivalent to
12 “pivot structure” for keytop of keyboard); *Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d
13 1420, 1423-1426 (Fed. Cir. 1997) (a finding of infringement of patented containers for
14 discarding syringes under the doctrine of equivalents, where the accused product differed from
15 the claimed invention because the slot was located on the interior of the container rather than at
16 the top of the container, would vitiate the “slot at the top of the container body” and “extending
17 over said slot” limitations). In contrast to the above cited cases, the Federal Circuit found in
18 *Ethicon* that there existed genuine issues of material fact, with respect to infringement of a
19 stapler patent under the doctrine of equivalents, where the limitation of the claim stated that the
20 lockout mechanism was located in the path of the pusher assembly of a stapler, and the accused
21 product’s lockout mechanism was located in the path of the pusher assembly. *Ethicon*, 149 F.3d
22 at 1312-1313. There, the accused product’s lockout mechanism lost contact with the pusher
23 assembly temporarily just prior to staple firing, whereas the claimed lockout mechanism always
24 contacted the pusher assembly during staple firing. *Id.* at 1321. Nonetheless, genuine issues
25 existed because the claim limitation was not vitiated; instead, the noted difference was “a subtle
26 difference in degree, not a clear, substantial difference or difference in kind.” *Id.*

27 In the instant case, the difference between telescoping and folding sections is more
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1 similar to the former cases rather than the *Ethicon* case. Specifically, the difference between
2 folding and telescoping is not a difference in degree; instead, it is a difference in kind. *See id.*
3 The claimed limitation requires telescoping; the accused products fold. A finding of equivalence
4 between the claim elements would entirely vitiate the limitation that the sections must
5 telescopically move in relation to each other. Folding sections simply do not satisfy this
6 requirement, nor do they represent a trivial change. Thus, because a finding of equivalence
7 would vitiate the telescopic relation limitation, Defendants are entitled to judgment as a matter of
8 law as to infringement of this claim term. *See Freedman Seating Co.*, 420 F.3d at 1358.

9 **2. SECOND DISPUTED CLAIM TERM: *Structure: a button latch;***
10 ***Function: for releasably retaining the extendable sections of each***
11 ***respective roof support member in the extended state to prevent folding of***
12 ***the canopy structure into the collapsed state***

13 For the same reasons that the first disputed claim term prevents a finding of literal
14 infringement, the second disputed claim term also precludes such a finding. Specifically, the
15 structure is unable to perform the identical function as that set forth in the function of this
16 means-plus-function term because the accused devices do not contain “extendable sections” as
17 properly construed.

18 In addition, Defendants are entitled to judgment as a matter of law regarding infringement
19 under the doctrine of equivalents as to this claim limitation. Here, the function sets forth the
20 requirement that the button latch releasably retain “the *extendable sections* of each respective
21 roof support member in the *extended* state.” Thus, a finding of equivalence would “erase
22 meaningful structural and functional limitations of the claim” just as it would with respect to the
23 first disputed claim term. *See Perkin-Elmer Corp.*, 822 F.2d at 1532. The only difference
24 between the analysis of the two disputed claim terms is that the first places the limitation in the
25 structure and the second places the limitation in the function. Either way, the limitations would
26 be vitiated by a finding of equivalence for the purposes of infringement. The button latch of the
27 accused products simply cannot serve the function of releasably retaining extendable sections,
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1 where those extendable sections do not exist, nor is it a trivial change from the button latch that
2 does releasably retain extendable sections in the '635 Patent. Thus, for the same reasons as the
3 first disputed claim term, Defendants are entitled to summary judgment in their favor as to
4 infringement of the second disputed claim term.

5 **3. THIRD DISPUTED CLAIM TERM: *the covering has a central peak***
6 ***portion that exerts a downward force on the apex***

7 Finally, genuine issues of material fact exist regarding infringement as to this claim
8 limitation. Specifically, it is undisputed that the accused devices contain a covering with a
9 central peak portion. However, Defendants contest whether the coverings of the accused devices
10 exert a downward force on the apex. Defendants argue that the accused devices' covers are
11 "simply draped over the roof support members such that [their] weight is carried along the roof
12 members." Defs.' Reply at 24:15-17. Plaintiffs have presented evidence showing that the
13 accused canopies have a flexible covering with a central peak portion that exerts a downward
14 force on the apex of the frame. Hartley Decl., Ex. 6 at ¶¶ 15-17; Ex. 7(c) at 5-6. Plaintiffs
15 explain that the weight of the cover applies the downward force on the apex of the underlying
16 frame. Pls.' Opp. at 29:16-17. Furthermore, Plaintiffs have submitted evidence to show that,
17 when the accused products are in an expanded state and the slider is in the locked position, non-
18 excessive downward forces cause an outward force to be exerted along the roof support
19 members that tends to push the corner supports apart. Hartley Decl, Ex. 6 at ¶¶ 15-17; Ex. 7(c)
20 at 5-6. Thus, sufficient evidence has been presented to create genuine issues of material fact as
21 to the accused products infringing this claim limitation.

22 **4. CONCLUSION**

23 Given that Defendants are entitled to judgment as a matter of law regarding infringement
24 on the first two disputed claim terms, and these claim limitations are contained in each and every
25 asserted claim, summary judgment is appropriately entered in Defendants' favor. Accordingly,
26 Defendants' Non-Infringement Motion is hereby GRANTED.

1 **VI. DISPOSITION**

2 For the above mentioned reasons, Defendants' Motion for Summary Judgment of
3 Obviousness Invalidity is hereby DENIED.

4 Defendants' Motion for Summary Judgment of Non-Infringement is hereby GRANTED.

5 Plaintiffs' Unopposed Motion to Amend Expert Disclosures to Add a Rebuttal Report
6 Concerning the Inequitable Conduct Counterclaim is GRANTED as unopposed. The Court
7 gives Plaintiffs leave to amend their expert disclosures to add a rebuttal expert to address the
8 inequitable conduct counterclaim.

9 Plaintiffs' Motion to Take Additional Depositions is hereby DENIED as MOOT.

10 Plaintiffs' claims for infringement are adjudicated in Defendants' favor by the instant Order.
11 Accordingly, Plaintiffs' requests to conduct additional depositions in pursuit of their claims are
12 moot.

13 Defendants' remaining counterclaims are set for trial on August 12, 2008 at 8:30 a.m.
14 The Final Pre-trial Conference is scheduled for July 21, 2008 at 8:30 a.m.

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16 IT IS SO ORDERED.

17 DATED: July 2, 2008

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DAVID O. CARTER
21 United States District Judge
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