

**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

THE HOLMES GROUP, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.
)	03-40146-FDS
RPS PRODUCTS, INC.,)	
)	
Defendant.)	

**MEMORANDUM AND ORDER ON
CROSS-MOTIONS FOR SUMMARY JUDGMENT AND
DEFENDANT’S MOTIONS TO EXCLUDE**

SAYLOR, J.

This is a lawsuit for patent infringement. The dispute concerns replacement filters manufactured by defendant RPS Products, Inc., that are designed for use in portable air purifiers manufactured by plaintiff The Holmes Group, Inc., now JCS/THG, LLC.¹ Currently pending before the Court are cross-motions for summary judgment and two motions by defendant to exclude certain testimony proffered by plaintiff.²

¹ JCS/THG, LLC, is the successor in interest to Holmes. For the sake of convenience, both Holmes and JCS/THG will be referred to as “JCS.” JCS has not yet moved for substitution of a party-in-interest pursuant to Fed. R. Civ. P. 25(c).

² JCS has termed its motion one for partial summary judgment. While the complaint alleges that RPS infringed on the whole of patent ’147, the memorandum filed by JCS only addresses alleged infringement of Claims 1, 2, and 6.

I. Factual Background

A. The Parties

JCS is a company based in Milford, Massachusetts, that develops and manufactures consumer and office products, including air purifiers. RPS is a company based in Hampshire, Illinois. RPS manufactures replacement filters for many makes and models of household air purifiers, including JCS air purifiers.

B. Background of the Inventions

In general, portable air purifiers work by utilizing a fan to draw air into the purifier, passing it through a filter to remove unwanted particles, and then blowing the filtered air out. To work effectively, the filter must fit properly in the purifier and form a seal that prevents the drawn-in air from bypassing the filter. After a certain amount of time or use, the filter will no longer clean the air at an acceptable level and must be replaced.

JCS contends that the inventions at issue solve a problem concerning the replacement of purifier filters. According to JCS, ease of filter replacement is an important part of the design of the purifier, because if it is difficult to place the filter in the machine, it is more likely that the filter will not seal properly and the purifier will not function properly. In the past, most purifier filters had frames that required the consumer to squeeze the filters into position in the purifier. These filters relied on clamping friction alone to hold them in place. As a result, they often did not seal properly and were awkward to handle.

According to JCS, the inventions allow a replacement filter to be placed in a purifier with relative ease. Hanging mechanisms guide the filter into the proper position and eliminate the need for a friction fit. In addition, the inventions use a gasket on the outlet side of the filter, which,

together with the use of a plastic frame to hold the filter, aids the formation of the seal.

JCS also contends that the inventions solve a problem that had existed in the retail market for replacement filters. In the past, retailers generally stocked replacement filters for every air purifier that they sold. The inventory, however, did not turn over quickly because filters did not have to be frequently replaced. In addition, large-capacity purifiers generally required larger filters, and small-capacity purifiers generally required smaller filters. As a result, retailers had to stock a relatively large number of different-sized replacement filters and devote significant shelf space to the products. The inventions permit the use of a single size filter in multiple configurations in different-sized purifiers, thus reducing inventory requirements substantially.

C. The JCS Patents

JCS holds four relevant patents: (1) U.S. Letter Patent No. 6,425,932 (the '932 patent) was issued in July 2002; (2) U.S. Letter Patent No. 6,685,760 (the '760 patent) was issued in February 2004; (3) U.S. Letter Patent No. 7,041,147 (the '147 patent) was issued in May 2006; and (4) U.S. Letter Patent No. 7,276,100 (the '100 patent), was issued in September 2006.

D. Claimed Infringement of the '932 and '760 Patents

Patents '760, '147, and '100 are all continuations of the '932 patent.³ Shortly after the '932 patent issued on July 30, 2002, JCS began shipping air purifiers using the product name "Harmony." JCS contends that the Harmony machines and filters embody the inventions claimed in these patents. After JCS began selling the Harmony line, RPS began to manufacture and sell its own replacement filter, known as the "H600," for use in Harmony purifiers. RPS describes the

³ A continuation patent claims the filing date priority of the parent application, and must use the same disclosure as the parent, must name at least one of the same inventors as in the parent, and must be filed while the parent is still pending. Manual of Patent Examining Procedure ("MPEP") § 201.07.

Original H600 Filter assembly as having two “hangers,” each “hanger” having one “leg.” It contends that these “hangers” are “coupled to a lip” on the filter frame.

In July 2003, JCS sued RPS for patent infringement, claiming that the H600 replacement filter infringed on patent '932. The complaint was subsequently amended to claim further that the H600 infringed on patent '760. Claim 18 of the '932 patent describes:

A filter assembly for removable mounting to an air purifying device, comprising:

a frame;

a filter element mounted to said frame, and

a hanger having a pair of opposed legs configured to form a gap, said hanger being coupled to said frame for removably receiving a hanger support mounted to an air purifying device.

RPS permanently discontinued production of its Original H600 Filter on November 9, 2004.⁴

Since December 2003, RPS has manufactured and sold a revised H600 replacement filter (the “Revised H600 Filter”) for use in the Harmony models. According to RPS, it changed the design of the H600 filter for two reasons: (1) because JCS had made a claim for patent infringement, and (2) because the left hanger on the Original H600 Filter was interfering with the door-latching mechanism on the HAP-675 model purifier.

RPS describes its Revised H600 Filter as having one solid plastic device that functions as a “hanger,” which device has two “legs” that extend outwardly from the center and in opposite directions. This hanging device is attached, according to RPS, to the “lip” of the filter frame. When placed in a purifier, the hanging device engages supports on the purifier, by which the filter hangs.

⁴ JCS advised RPS of the existence of the '932 patent by letter dated November 27, 2002.

The meaning and use of the terms “hanger,” “leg,” “lip,” and “frame” were contested by the parties and both sides moved for summary judgment. On March 21, 2006, this Court issued a memorandum and order granting the motion for summary judgment of defendant RPS on the issue of patent infringement and finding that neither the original H600 nor the Revised H600 infringed on the ’932 or the ’760 patents. *See Holmes Group, Inc. v. RPS Prods.*, 424 F. Supp. 2d 271 (D. Mass. 2006) (“*Holmes I*”).

E. Issuance of the ’147 and ’100 Patents

In March 2005, a full year prior to the Court’s memorandum and order on the ’932 and ’760 patents, JCS filed a continuation patent application with the United States Patent and Trademark Office. In January 2006, two months before the Court’s order, the Patent Office allowed this continuation application for issuance as patent ’147. About four months later, in May 2006, patent ’147 was issued. The the ’147 patent was issued approximately seven weeks after the Court’s order on the ’932 and ’760 patents.

It is undisputed that JCS never informed the Patent Office of the ongoing litigation against RPS, and thus did not give the patent examiner a copy of the Court’s March 2006 order, prior to the issuance of the ’147 patent. In September 2006, JCS did provide a copy of the Court’s order to the patent examiner working on the ’100 application (also a continuation of ’932). That patent examiner was the same examiner who had handled the ’147 application.

F. The Current Claims

In June 2006, JCS filed a new complaint against RPS, alleging that the H600 filter infringed on the ’147 patent.

Patent ’147 shares a common specification with ’932. Claim 1 of ’147 is for a removable

filter assembly, with

a frame having a first surface including an outwardly projecting lip extending along a perimeter of said first surface;

. . . and a first member supported on and extending over said first surface . . . adapted to receive a first hanger support secured to the air purifying device.

RPS alleges that JCS has renamed what earlier patents called the “top wall” of the filter frame, so that it is now called the “first surface” of the frame. RPS further argues that although the Court’s March 2006 order construed the terminology and determined that the “top wall” and “lip” were different features of the frame, in patent ’147 JCS has attempted to define the “first surface” to include both the top wall and the “lip” in contravention of the holding of the order. *See Holmes I*, 424 F. Supp. 2d at 285-86.⁵ However, RPS contends that a correct reading of Claim 1 of patent ’147 results in the renaming of the “top wall” to be the “first surface,” but that the “first surface” and the “lip” are separate and distinct components of the frame.

Claim 2 of the ’147 patent, a dependent claim of Claim 1, further defines the claimed invention to include:

[A] second member supported on and extending over said first surface, said second member . . . adapted to receive a second hanger support secured to the air purifying device.

RPS contends that when Claims 1 and 2 are read together, JCS is now using the term “member”

⁵ In the March 2006 order, the Court determined that RPS did not infringe on the ’932 or ’760 patents, in part because the legs of the hangers on the RPS air filters were attached to the lip, while the legs of the hangers described in the patent claims were attached to the top wall. RPS also contends that Claim 6 of the ’147 patent, which states “a filter assembly as defined in claim 2, wherein said first and second members extend from said lip,” is also controlled by the Court’s earlier ruling.

to refer to what the specification (and previous patents) called hanger “legs.”⁶ RPS further argues that although the Court’s March 2006 order determined that the specification and claims of patents ’932 and ’760 only support two-legged hangers, in patent ’147, JCS now claims one-membered hangers.⁷

JCS contends that even before it applied for the ’932 patent, it had conceived of the idea that the replacement filters could be attached to the air purifier by hangers with one or two (or some other number of) legs and that the legs could be attached to the top wall of the filter frame itself or to the lip on the top wall. However, it determined that the best configuration for a replacement filter was hangers with two legs attached to the top wall of the filter frame, so that is what it disclosed as the preferred embodiment in the specification for patent ’932. It contends that it is not improper to file a continuation application to protect an embodiment other than what was disclosed in the initial (parent) patent’s specification, even if a competitor is marketing that embodiment for sale, as long as the inventor actually invented that embodiment at the time of the parent patent application. JCS contends, therefore, that it filed the ’147 continuation application to ensure that it also had patent rights to filters with one-legged hangers and filters with hangers attached to the lip of the filter frame.

The parties have filed cross-motions for summary judgment regarding the ’147 patent. RPS contends that (1) the ’147 patent is unenforceable because JCS unreasonably delayed in prosecuting it; (2) the ’147 patent is unenforceable because JCS intentionally concealed the

⁶ Claims 3 and 4 are dependent on Claim 2 and address the orientation of the members: extending towards each other (Claim 3) and extending away from each other (Claim 4).

⁷ See *Holmes I*, 424 F. Supp. 2d at 284-85.

existence of the relevant litigation and Court order from the Patent Office, with intent to deceive the Patent Office; (3) Claims 1 - 4 and 6 of the '147 patent are invalid for noncompliance with the written description requirement of 35 U.S.C. § 112;⁸ (4) Claims 1, 2, and 6 of the '147 patent are invalid for obviousness under 35 U.S.C. § 103; (5) Claims 1, 2, and 6 of the '147 patent are invalid as indefinite under 35 U.S.C. § 112; (6) the '147 patent is invalid for double patenting; (7) the '147 patent uses different terminology to refer to the same parts described in the '932 and '760 patents, but does not actually describe anything new, and that because the Court has already found that RPS has not infringed on those patents, it must also conclude that RPS did not infringe on the '147 patent; and (8) JCS' claim for money damages is barred because it failed to respond to discovery requests on the issue.

JCS responds that (1) any delay in the prosecution was minor, was not in bad faith, and cannot form the basis of a prosecution laches defense; (2) the ongoing litigation and March 2006 order regarding the '932 and '760 patents were not material to the '147 patent application, and the failure to tell the patent examiner was inadvertent; (3) the '147 patent meets the written description requirement of § 112; (4) RPS has not established a *prima facie* case of obviousness because it relies on nothing more than two pieces of unrelated prior art; (5) properly construed, Claims 1, 2, and 6 of the '147 patent are not indefinite; (6) no double patenting occurred; (7) the '147 patent does more than affect a terminology change on the '932 and '760 patents, and the H600 filters (in both the original and revised designs) literally infringe the '147 patent and infringe the '147 patent by equivalence; and (8) JCS complied with its discovery obligations.

⁸ The summary judgment memorandum of RPS contends that Claims 1-4 and 6 of patent '147 are invalid for failure to comply with § 112. In its response, JCS only addresses Claims 1, 2, and 6 with respect to § 112 compliance. In its reply brief, RPS only addresses Claims 1, 2 and 6 of patent '147 with respect to § 112.

RPS has also filed two motions to exclude certain testimony offered by JCS, which the Court will address first.

II. Analysis – Motions to Exclude

A. Expert Testimony of Carolyn Elmore

As one of its affirmative defenses, defendant contends that patent '147 is unenforceable because plaintiff engaged in inequitable conduct during its prosecution. Specifically, defendant contends that plaintiff intentionally withheld from the '147 patent examiner information about the ongoing litigation on the '932 and '760 patents and did so with the intent to deceive. In response to that argument, plaintiff has proposed to offer expert testimony from Carolyn Elmore, a patent attorney with nine years of experience as a patent examiner. Defendant has moved to exclude Ms. Elmore's testimony. For the reasons set forth below, the motion will be granted in part and denied in part.

In Ms. Elmore's expert report, she explains the patenting process and opines as to (1) whether the existence of the litigation and the March 2006 order were material to the '147 patent application; (2) whether plaintiff violated its duty of candor to the patent office by withholding information about the order, and thus engaged in inequitable conduct; and (3) whether the failure of plaintiff to disclose the order to the patent examiner was done with intent to deceive. In substance, plaintiff contends that this testimony will help show that its conduct was not out-of-the-ordinary or contrary to the expectations of a patent examiner and therefore could not have been inequitable.

Defendant contends (1) that the issue of materiality is a question of law—a question for the judge, not the jury—and thus expert testimony on the subject would not help the trier of fact

and is therefore not admissible; (2) that in patent law, inequitable conduct is an equitable defense to a claim of infringement and is therefore not a jury issue and not an appropriate subject for expert testimony; and (3) that Ms. Elmore is a chemical engineer and patent attorney, who has no expertise that would qualify her to opine as to whether intent to deceive can be inferred from certain corporate acts or omissions.

An expert witness may not testify as to another person's intent. No level of experience or expertise will make an expert witness a mind-reader. *See Se-Kure Controls, Inc. v. Vanguard Prods. Group, Inc.*, 2008 WL 169054 at *3 (N.D. Ill. Jan. 17, 2008). Ms. Elmore may not, therefore, testify as to the subjective state of mind of plaintiff or its representatives.

Her testimony as to materiality is, however, of a different character. Whether information is material turns on an analysis of whether there is a substantial likelihood that an objectively reasonable examiner would have considered the information important in deciding whether to allow the application to issue as a patent. *See Jeneric/Pentron, Inc. v. Dillon Co.*, 171 F. Supp. 2d 49, 79 (D. Conn. 2001). "If [the expert] can shed light on what a reasonable examiner would have considered important, [her] testimony is admissible." *Se-Kure Controls, Inc.*, 2008 WL 169054, at *3. She may, therefore, testify as to how patent practitioners generally interact with the patent office and whether plaintiff's conduct was out-of-the-ordinary or contrary to the expectations of a reasonable patent examiner. She may also testify as to and explain the patenting process. Such testimony would be potentially helpful to the trier of fact.

Although an expert witness may testify as to ultimate issues, an expert may not testify as to legal conclusions. *Levin v. Dalva Brothers, Inc.*, 459 F.3d 68, 79 (1st Cir. 2006) ("[A]n expert

may not offer an opinion concerning a legal question.”).⁹ Her proposed testimony that the conduct was “inequitable” is an ultimate conclusion that, in context, would not be helpful to the finder of fact, and might be confusing or misleading. Accordingly, while Ms. Elmore may testify as to whether a reasonable patent examiner would have considered the information to be material, she may not testify as to the conclusion that plaintiff engaged in inequitable conduct. *See Se-Kure*, 2008 WL 169054 at *3.

For the reasons explained later in this opinion, the Court concludes that summary judgment is inappropriate at this stage on the question of inequitable conduct. Thus, while specific objections will be entertained and ruled upon at trial, Ms. Elmore’s testimony will be governed by the above principles, subject to developments at trial. Defendant’s motion to exclude Ms. Elmore’s testimony will therefore be granted in part and denied in part.

B. Affidavits of Anthony Bennett and Frank Marino

In further opposition to defendant’s claim of inequitable conduct, plaintiff has submitted affidavits from Anthony Bennett and Frank Marino, two attorneys involved in the prosecution of the ’147 patent. In these affidavits, Bennett and Marino attest that there was no intent to deceive in their failure to disclose the existence of the litigation to the patent office and that at all times they acted in good faith.

Defendant asks the Court to strike these affidavits. It contends that during discovery plaintiff repeatedly invoked the attorney-client privilege in response to requests concerning the issue of inequitable conduct, and that plaintiff did not disclose Bennett and Marino as witnesses

⁹ The Federal Circuit “defers to the law of the regional circuits on matters of procedural law that do not implicate issues of patent law.” *Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098, 1106 (Fed. Cir. 2003). First Circuit law therefore governs the resolution of this evidentiary question.

on that subject. Defendant further alleges that even after plaintiff waived the attorney-client privilege as to the testimony of Bennett and Marino, it nonetheless continues to claim the privilege with respect to certain documents that directly relate to their conduct regarding the alleged inequitable conduct. Defendant argues that because plaintiff is abusing the attorney-client privilege, the affidavits must be stricken. Alternatively, it contends that the affidavits should be stricken because plaintiff failed to supplement its initial disclosures and responses to interrogatories.

Plaintiff responds that it complied with all discovery rules, and that while it is still claiming attorney-client privilege with respect to some documents in this litigation, it has disclosed all documents related to the non-disclosure of the '932 and '760 litigation and court order to the patent office. It contends that it did not list Bennett and Marino as trial witnesses in the initial disclosures because their testimony does not support a claim made by plaintiff; rather, they are witnesses plaintiff will use to respond to a defense that (it now knows) defendant intends to raise. According to plaintiff, when it responded to defendant's interrogatories, it identified Bennett and Marino as individuals with discoverable information concerning the issue of disclosing the prior litigation to the Patent Office, but that when it responded specifically to the question of witnesses it intended to call at trial, it stated that because no trial date had yet been set, it had not conclusively determined who its trial witnesses would be.¹⁰ Plaintiff contends that parties do not generally disclose their trial witnesses until the pre-trial conference and that there is no rule requiring earlier disclosure.

¹⁰ Plaintiff further notes that defendant never requested the opportunity to depose either Bennett or Marino.

The Court declines to exclude the testimony of Bennett and Marino or to strike their affidavits. As an initial matter, defendant's arguments that plaintiff somehow engaged in improper delay during discovery is without basis. Nearly two-thirds of defendant's argument in support of its motion to exclude is devoted to a recitation of the discovery timeline in this case. According to defendant, plaintiff filed its first response to interrogatories on January 22, 2007, but did not supplement its responses until January 9, 2008, nearly one year later; similarly, plaintiff filed its response to defendant's request for admissions on February 20, 2007, but did not supplement its responses until January 9, 2008.

What defendant does not acknowledge, however, is that all proceedings were stayed from April 3, 2007, until October 2007, during which time the parties engaged in an unsuccessful attempt at mediation. No discovery occurred during this time period. Once discovery resumed, all of plaintiff's discovery responses were filed *before* the January 15, 2008, deadline for completion of fact discovery. Thus, contrary to defendant's suggestions, plaintiff did not engender any prejudicial delay.

Moreover, the Court is not persuaded, on the present record, that plaintiff has abused the attorney-client privilege. Plaintiff has represented to this Court that it has "produced all communications between JCS and its counsel and all communications among counsel regarding the disclosure decision." Defendant points, however, to plaintiff's supplemental responses to defendant's document requests, where plaintiff objected that the request sought "materials protected by the attorney client privilege." But it went on to respond,

Without waiving the objections above, Plaintiff will produce to the extent such documents are in its possession, custody, or control, responsive documents that concern the disclosure or non-disclosure of the Holmes/RPS litigation or litigation

materials to the patent office in connection with the U.S. Patent Application Serial No. 11/609, 541.

(emphasis added). Defendant objects to plaintiff's continued invocation of attorney-client privilege. But this boilerplate language appears to be meaningless in light of the fact that plaintiff has produced documents responsive to defendant's request and represented to the Court that *all* relevant documents have been produced. In the absence of a more specific showing, defendant has not convinced the Court that plaintiff has withheld relevant documents or otherwise abused the privilege.

Accordingly, defendant's motion to exclude the Bennett and Marino affidavits will be denied.

III. Analysis – Summary Judgment

A. Standard for Summary Judgment

In assessing a motion for summary judgment, the court must “pierce the pleadings and . . . assess the proof in order to see whether there is a genuine need for trial.” *Mesnick v. General Elec. Co.*, 950 F.2d 816, 822 (1st Cir. 1991) (quoting *Garside v. Osco Drug, Inc.*, 895 F.2d 46, 50 (1st Cir. 1990)). The burden is upon the moving party to show, based upon the pleadings, discovery, and disclosure materials on file, “that there is no genuine issue as to any material fact and that the movant is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c)(2).

Once the moving party has satisfied its burden, the burden shifts to the non-moving party to set forth specific facts showing that there is a genuine, triable issue. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986). A genuine issue is one “that a reasonable jury could resolve . . . in

favor of the nonmoving party.” *United States v. One Parcel of Real Property*, 960 F.2d 200, 204 (1st Cir. 1992). A fact is material “when [it] has the potential to change the outcome of the suit under the governing law if found favorably to the nonmovant.” *Parrilla-Burgos v. Hernandez-Rivera*, 108 F.3d 445, 448 (1st Cir. 1997) (quoting *Martinez v. Colon*, 54 F.3d 980, 984 (1st Cir. 1995)). Where the parties have cross-moved on a particular count, the court must assess each motion separately and determine, for each motion, whether there is no genuine issue as to any material fact and the movant is entitled to judgment. *See Wightman v. Springfield Terminal Ry.*, 100 F.3d 228, 230 (1st Cir. 1996); *see generally* 10A CHARLES A. WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 2720 (1998).

For patent infringement claims, it is appropriate to address claims construction in the context of a motion for summary judgment. *See, e.g., Biogen v. Burex Labs, Inc.*, 113 F. Supp. 2d 77, 81 (D. Mass. 2000), *vacated in part on other grounds*, 318 F.3d 1132 (Fed. Cir. 2003). If the Court’s claims construction precludes literal infringement, and “the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997).

B. Prosecution Laches

Defendant contends that the ’147 is unenforceable due to prosecution laches. It asserts that plaintiff waited too long (seven years) after filing the ’932 patent application to file the continuation application that eventually became patent ’147. Plaintiff responds that delay alone is insufficient to establish laches, and that defendant has pointed to no evidence beyond the mere length of the delay from which the Court could conclude that plaintiff acted intentionally and

improperly. The Court agrees with plaintiff and concludes that the prosecution laches defense fails as a matter of law.

“[P]rosecution laches may render a patent unenforceable when it has issued only after an unreasonable and unexplained delay in prosecution.” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., LP (“Symbol II”)*, 422 F.3d 1378, 1385 (Fed. Cir. 2005); see *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 464, 466 (1924); *Woodbridge v. United States*, 263 U.S. 50, 56-57 (1923). Delay in the filing of continuation applications may be unfair when the applicant’s competitors do not have fair notice as to what is patented and what they must do to design around the patent. However, the filing of a continuation application is permitted by statute, 35 U.S.C. § 120, and thus the doctrine of prosecution laches “should be used sparingly lest statutory provisions be unjustifiably vitiated. The doctrine should be applied only in egregious cases of misuse of the statutory patent system.” *Symbol II*, 422 F.3d at 1385. Prosecution laches is equitable in nature, and its applicability is subject to the discretion of the Court. *Id.*

In *Symbol II*, where the district court found prosecution laches, there was an 18-to-39 year delay, and the applicant’s patents occupied the top thirteen positions for the longest patent prosecutions from 1914 to 2001. *Id.* at 1386. The applicant had repeatedly abandoned allowed claims and then refiled those very same claims in order to delay their issuance and prejudice competitors. According to the district court, the applicant had engaged in “culpable neglect” and had interfered with intervening public and private rights. *Id.* In affirming the district court’s decision, the Federal Circuit emphasized the “considerable evidence” of unreasonable delay. *Id.* at 1385-86.

Here, by contrast, only five to seven years elapsed between the filing of the '932 application and the filing of the '147 continuation application. Fewer than three years elapsed between the granting of the '932 patent and the filing of the '147 continuation application. The delay in this case is hardly comparable to the delay in *Symbol II*.

Moreover, there is insufficient evidence that the delay was improper. Defendant notes that plaintiff "repeatedly re-filed its patent application in multiple successive continuations that extended the prosecution nearly seven years," and that the continuation application that led to the '147 patent was filed five years after RPS first introduced the H600 filter. From this, defendant concludes that its intervening rights have been unfairly prejudiced. But this argument is little more than a repackaged allegation of delay, and as the Federal Circuit has cautioned, delay alone is insufficient to warrant a finding of laches. *Id.* at 1385 ("[T]here are no strict time limitations for determining whether continued refiling of patent applications is a legitimate utilization of statutory provisions or an abuse of those provisions."). Indeed, in patent infringement cases involving continuation applications, it will often be the case that the continuation patent was filed *after* the allegedly infringing device had been on the market for some time. *Cf. Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988) ("It should be made clear . . . that there is nothing improper, illegal or inequitable in filing a patent application for the purpose of obtaining a right to exclude a known competitor's product from the market.").

Finally, defendant contends that plaintiff lacked a reasonable basis for filing the continuation application and therefore plaintiff must have intended to prejudice RPS. The Court disagrees. Although defendant is correct that the claims presented in the '147 patent were new, a continuation application is not limited to previously rejected claims. On the contrary, a

continuation application containing new claims is appropriate when, for example, an applicant seeks to claim a different embodiment of an invention disclosed in the common specification or to rewrite claims with a different scope. *See* Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. REV. 63, 76 (2004). No doubt there is a potential for abuse of the continuation process. *See id.* (“In the most extreme cases, patent applicants add claims during the continuation process to cover ideas they never thought of themselves but instead learned from a competitor.”). But in this case, defendant relies on little more than the timeline of events to establish that plaintiff abused the system. That timeline—without additional evidence that plaintiff improperly delayed issuance of the ’147 patent—is insufficient evidence to prove laches. *See Symbol II*, 422 F.3d at 1385.

In short, the delay in issuing the ’147 patent, while not necessarily desirable or commendable, does not constitute egregious behavior sufficient to give rise to a prosecution laches defense. Accordingly, the defense of prosecution laches fails as a matter of law and summary judgment in favor of plaintiff is appropriate as to that defense.

C. Inequitable Conduct

Defendant further contends that the ’147 patent is unenforceable because plaintiff engaged in inequitable conduct during its prosecution. Specifically, defendant contends that plaintiff intentionally withheld from the ’147 patent examiner information about the ongoing litigation on the ’932 and ’760 patents and did so with the intent to deceive. While acknowledging that it did not disclose the litigation to the examiner, plaintiff contends that the litigation was not material to the patentability of ’147 and that at all times it acted in good faith.

A patent may be rendered unenforceable if the patent applicant engages in inequitable

conduct. *Li Second Family L.P. v. Toshiba Corp.*, 231 F.3d 1373, 1377-78 (Fed. Cir. 2000).

Under the relevant regulations,

(a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. . . .

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

37 C.F.R. § 1.56. In order to establish that plaintiff secured the '147 patent by inequitable conduct, defendant must prove by clear and convincing evidence that (1) the existence of the litigation and the Court's March 2006 order were material to '147's patentability, and (2) defendant intended to deceive the PTO by failing to disclose the information. *See Kingsdown*, 863 F.2d at 872. "Once the threshold levels of materiality and intent have been established, the trial court must weigh materiality and intent to determine whether the equities warrant a conclusion that inequitable conduct occurred." *Toshiba Corp.*, 231 F.3d at 1378. For the

reasons provided below, the Court concludes that genuine disputes of material fact exist, that preclude summary judgment for either party on the question of inequitable conduct.

1. **Materiality**

Information is “material” if there is a substantial likelihood that a reasonable examiner would have considered the information important in deciding whether to allow the application to issue as a patent. *See Jeneric/Pentron*, 171 F. Supp. 2d at 79. The Manual of Patent Examining Procedure (“MPEP”) provides that when the subject matter for which a patent is being sought is (or has been) involved in litigation, “the existence of such litigation and any other material information arising therefrom must be brought to the attention” of the patent examiner. MPEP § 2001.06(c).¹¹ Because the litigation concerned the ’932 and ’760 patents, which deal with replacement filters for the Harmony air purifiers, and the ’147 application also dealt with replacement filters for the same air purifiers, defendant contends that the subject matter was the same, and thus the existence of the litigation was *per se* material. Support for this interpretation can be found in the case law. *See, e.g., Nilssen v. Osram Sylvania, Inc.*, 504 F.3d 1223, 1234 (Fed. Cir. 2007) (“It is clear from the language of § 2001.06(c) that the existence of the litigation itself is material information that an examiner needs to have. It is important because it signals the examiner that other material information relevant to patentability may become available through the litigation proceedings. The PTO obviously considers such information material and there is no basis for us to conclude otherwise.”).¹²

¹¹ The MPEP is available on the United States Patent and Trademark Office’s website at <http://www.uspto.gov/web/offices/pac/mpep/>.

¹² *Nilssen* was a relatively extreme case. The *Nilssen* court held 14 patents invalid or unenforceable for various types of inequitable conduct during their prosecution. All eight patents found unenforceable for failure to

This portion of § 2001.06(c) of the MPEP must be considered in context. The same provision also refers to such material information as including “evidence of possible prior public use or sales, questions of inventorship, prior art, allegations of fraud, inequitable conduct or violation of the duty of disclosure.” MPEP § 2001.06(c). These issues all go towards the validity of the patent being litigated. In fact, in most of the cases where the patent applicant has failed to disclose litigation involving a related or parent patent, the validity of the related or parent patent has been challenged in the litigation. *See, e.g., DaimlerChrysler AG v. Feuling Advanced Techs., Inc.*, 276 F. Supp. 2d 1054, 1063 (S.D. Cal. 2003) (defendant failed to disclose to the PTO, during prosecution of two continuation applications, that the parent patent was the subject of litigation and that the parent patent’s validity was challenged in that litigation); *Kothmann Enters.*, 455 F. Supp. 2d at 637; *Nilssen*, 504 F.3d at 1234 (the defendant, in the not-disclosed ongoing litigation, made “generalized allegations of invalidity”). Here, in the litigation between plaintiff and defendant that was not disclosed to the examiner, defendant argued that it did not infringe on the ’932 and ’760 patents, but did not allege that those patents were invalid.

Moreover, the MPEP does not have the force of law. *Kothmann Enters. v. Trinity Indus.*, 455 F. Supp. 2d 608, 617 (S.D. Tex. 2006). The regulations, which do have the force of law, expressly require disclosure of litigation pending during reissue or reexamination proceedings. 37 C.F.R. § 1.178(b). They contain no such express requirement, however, when litigation relating to a parent patent is pending during the prosecution of a continuation application. *Kothmann*, 455 F. Supp. 2d at 617.

disclose the related litigation were each also found invalid and unenforceable for one or more other reasons, such as inappropriately claiming small entity status and thus paying a lesser fee to the PTO, withholding prior art, and/or claiming inappropriate priority dates to avoid having to disclose prior art.

In any event, even if litigation involving the parent patent is not *per se* material according to the MPEP, defendant advances other arguments that the litigation and March 2006 order were, in this case, material and should have been disclosed.

First, a patent will not issue to an entity that did not invent the subject matter being patented. *See* 35 U.S.C. § 102(f). Defendant contends that the litigation record illustrates the history of air filters with one-legged hangers, and constitutes evidence that defendant, and not the plaintiff, invented the one-legged hanger.¹³ Thus, defendant argues, if the patent examiner had been given the litigation history, he or she may not have issued patent '147 to plaintiff.

Second, defendant contends that the March 2006 order held that the specification in the '932 patent did not support hangers with one leg, or support a conclusion that the lip was part of the top wall of the filter frame.¹⁴ In the '147 patent, plaintiff defined the lip as part of the top wall (albeit using different terminology), and patented one-legged hangers. Defendant therefore argues that the Court order in connection with the parent patent is inconsistent with the position taken by plaintiff in the '147 application, and is therefore material per 37 C.F.R. § 1.56(b)(2).

Ultimately, the Court need not—indeed, should not—decide the materiality question at this stage, because, as described below, there is a genuine dispute of material fact as to whether plaintiff's failure to disclose the litigation was intended to deceive. As the Federal Circuit has explained, "The more material the omission or the misrepresentation, the lower the level of intent required to establish inequitable conduct." *Critikon, Inc. v. Becton Dickinson Vascular Access*,

¹³ Plaintiff, of course, argues (1) that it had conceived the idea of both one-legged and two-legged hangers from the beginning, but initially decided to manufacture and patent only filters with two-legged hangers, and (2) that the '147 patent was an attempt to protect the full scope of its initial invention, including one-legged hangers.

¹⁴ Because the '932 patent is the parent of the '147 patent, they share a common specification.

120 F.3d 1253, 1256 (Fed. Cir. 1997). Engaging in a conclusive materiality analysis, without a contemporaneous inquiry into plaintiff's intent, would not be productive. Summary judgment as to that issue will therefore be denied.

2. Intent to Deceive

Even if plaintiff failed to disclose material information to the PTO, in order to establish inequitable conduct, defendant must also establish that plaintiff withheld the information with an intent to deceive or mislead. Direct evidence of intent is frequently lacking, but intent may be inferred from the circumstances. *Id.* Intent is quintessentially an issue for trial. *See Pearson v. First NH Mortg. Corp.*, 200 F.3d 30, 35 n.2 (1st Cir. 1999) (“Certain issues such as fraud, intent, and knowledge lend themselves to trial, rather than summary judgment. These matters can often only be proved by reliance upon circumstantial evidence except in the rare case where there is uncontroverted proof of a ‘smoking gun.’” (quotation omitted)). And when the materiality question is unclear, as it is here, evidence of intent to deceive may have a dispositive effect on outcome of the inequitable conduct defense. *See Critikon, Inc.*, 120 F.3d at 1256.

The Court concludes that, at this stage, there is insufficient evidence upon which to decide the intent question. On the one hand, Bennett and Marino both propose to testify that they did not intend to deceive the PTO. On the other, an inference of intent to deceive might be justified given plaintiff's admission that the '147 patent was drafted to “cover the invention disclosed” in the common specification and in light of the litigation's disputed materiality. Summary judgment on the question of inequitable conduct will therefore be denied.

D. Compliance with the Written Description Requirement of Section 112

In order for a continuation patent to gain the benefit of the filing date of the parent patent

application, “the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood v. American Airlines*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). Section 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112.

Defendant argues that Claims 1 - 4 and 7 of the '147 patent are invalid for failure to comply with § 112. Specifically, defendant contends that the specification discloses only two-legged hangers, and because the '147 claims purport to cover one-legged hangers, those claims are invalid. Plaintiff responds that nothing in the specification limits it to two-legged hangers and that it adequately discloses an embodiment utilizing one-legged hangers. The Court agrees with plaintiff and concludes that no reasonable factfinder could find that '147 is invalid for failure to comply with the writing requirement of § 112.

“To fulfill the written description requirement, the patent specification must clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.” *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998) (internal quotations omitted). Because continuation applications refer back to the specification of the parent patent, the written description requirement for a continuation application is satisfied if the specification in the parent application is phrased such that one would conclude that the inventor had invented the configurations claimed in the continuation application at the time of the original parent application. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (“The test for

sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter”) (internal quotations omitted).

The specification need not describe the configuration claimed in the continuation application in detail. “A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005). When construing the parent specification and disclosure, it is important not to impose limitations from the claims in the parent patent onto the specification.

To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so. One of the best ways to teach a person of ordinary skill in the art how to make and use the invention is to provide an example of how to practice the invention in a particular case.

Phillips v. AWH Corp., 415 F.3d 1303, 1323 (Fed. Cir. 2005) (internal citations omitted). The Federal Circuit has cautioned “against limiting the claimed invention to preferred embodiments or specific examples in the specification.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002). If the specification were to define the limits of the invention completely, there would be no need for the claims. *Phillips*, 415 F.3d at 1312.

At the same time, it is not sufficient for purposes of § 112 that the parent specification and disclosure would lead someone with knowledge in the field “to speculate as to modifications that the inventor might have envisioned, but failed to disclose.” *Lockwood*, 107 F.3d at 1572. Nor is it sufficient that the continuation claims be “obvious” derivations from the parent specification.

Id. at 1571. Whether a specification complies with the written description requirement of § 112 is a question of fact. *Gentry Gallery*, 134 F.3d at 1479. Furthermore, because a patent is presumed valid under § 282, defendant must prove invalidity by clear and convincing evidence. *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1366 (Fed. Cir. 2009).

Figure 26 to the '932 patent specification and disclosure describes a “filter assembly includ[ing] first and second hangers 118, 120. Each hanger 118, 120 *preferably* includes a pair of legs 119 attached to the top wall 158 . . .” (emphasis added). The specification discloses that the *preferred* embodiment includes a hanger with a pair of legs. It also implicitly discloses other hanger configurations (for example, with just one leg). Bearing in mind the Federal Circuit’s admonition not to use a specification’s preferred embodiment to limit the scope of a claim, *Teleflex, Inc.*, 299 F.3d at 1328, no reasonable factfinder could find, *by clear and convincing evidence*, invalidity for noncompliance with the written description requirement.

Notwithstanding the guidance from the Federal Circuit, defendant invokes the March 2006 order construing the '932 patent and specification, in which the Court stated, the “specification discloses only a 1:2 hanger-to-leg ratio.” *Holmes I*, 424 F. Supp. 2d at 284; *see also id.* (“Plainly, the specification describes the embodiment as having two hangers, each of which has two legs.”). According to defendant, it is law of the case that the specification covers only two-legged hangers and, accordingly, the '147 claims covering only one-legged hangers are invalid under § 112. The Court disagrees.

Defendant reads the March 2006 order out of context. The Court’s statement that the “specification discloses only a 1:2 hanger-to-leg ratio” was used to confirm its interpretation of Claim 18 of the '932 patent, not to limit the scope of the specification. *Id.* at 284. In the course

of interpreting the language of the claim, the Court looked to the specification for confirmation of its reading. *Id.* at 284-85. Because the “specification disclose[d] only a 1:2 hanger-to-leg ratio,” the Court validated its reading of the claim’s plain language as “describing one or more hangers where each hanger has two legs that are opposed to each other in such a way as to define a gap between them.” *Id.* at 285. Read in context, the statement upon which defendant relies does not compel invalidation of those claims.

By contrast, the § 112 issue presently before the Court requires it to examine the scope of the specification, not to interpret the language of a claim. On that issue, the Court concludes that defendant has not proffered clear and convincing evidence that persons of ordinary skill in the art would be unable to recognize that JCS invented one-legged hangers as described in Claims 1 - 4 and 7 of the ’147 patent. *See Gentry Gallery*, 134 F.3d at 1479. Plaintiff is therefore entitled to judgment as a matter of law on this issue.

E. Obviousness

Defendant next complains that Claims 1, 2, and 6 of the ’147 patent are invalid as obvious under 35 U.S.C. § 103. Subsection (a) of that section provides: “A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the 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.” In *KSR International Co. v. Teleflex Inc.*, the Supreme Court examined the prohibition on patenting obvious inventions. 550 U.S. 398, 417-22 (2007). The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103

likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. In order to examine an allegation of obviousness under § 103,

‘ . . . the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.’

Id. at 406 (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). Because a patent is presumed valid by statute, 35 U.S.C. § 282; *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006), defendant must rebut the presumption of nonobviousness by clear and convincing evidence. *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2008).

Defendant contends that the ’147 patent is obvious in that it attempts to claim a predictable variation of prior art. Defendant points to U.S. Patent No. 3,999,969 (filed Dec. 28, 1976) and U.S. Patent No. 4,473,158 (filed Sep. 25, 1984), and argues that plaintiff has attempted to claim an obvious combination of elements of these two patents. The ’969 patent describes an air filter unit that filters air carried from an air carrying conduit into a room; the ’158 patent describes a file hanging system. Defendant contends that the ’147 patent at issue here merely substitutes the hangers shown in the ’158 patent for the clamping devices shown in the ’969 patent, and this variation would have been obvious one with ordinary skill in the art.

Plaintiff argues that defendant has not established a *prima facie* case of obviousness. It

contends that defendant has done little more than point to two unrelated pieces of prior art, and that defendant has failed to articulate why it would have been obvious to combine elements of the '969 and '158 patents.

The Court agrees with plaintiff. In order to prevail on a claim of obviousness, a defendant must provide evidence of the “level of ordinary skill in the pertinent art.” 383 U.S. at 17; *see KSR*, 550 U.S. at 412-13. A defendant must also show how it would have been obvious to a person with such skill to utilize the subject variation. *KSR*, 550 U.S. at 424-26. Defendant has done neither of these things. Even assuming that the '147 patent embodies a predictable variation of the prior art, defendant has made no showing that this variation would have been obvious to a person with ordinary skill in the field.

First, defendant has failed to articulate, much less establish by clear and convincing evidence, the level of ordinary skill in the field. *Cf. id.* at 412-13 (concluding, based on expert testimony and the parties' stipulations, that the level of ordinary skill in pedal design was an undergraduate degree in mechanical engineering, or an equivalent amount of industry experience, and familiarity with pedal control systems for vehicles). Defendant has also failed to make a case that the variation would have been obvious to an individual with such skill. *Cf. id.* at 424-26. Defendant relies on little more than one conclusory statement: “The air filtration device industry has long known of filters comprised of a frame, a filter mounted in the frame, and one or more mounting devices attached to the top of the frame, as shown in [the '969 patent].” This is plainly insufficient to rebut the presumption of validity.

Because defendant has not made a showing that would entitle it to a trial on this issue, judgement in favor of plaintiff on the question of obviousness is warranted.

F. Indefiniteness

Defendant argues that Claims 1, 2, and 6 of the '147 patent are invalid as indefinite under 38 U.S.C. § 112. In relevant part, Section 112 provides that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Interpreting this language, the Federal Circuit requires “that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, *i.e.*, what subject matter is covered by the exclusive rights of the patent.” *Halliburton Energy Serv, Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008). Without such definiteness, “competitors cannot avoid infringement, defeating the public notice function of patent claims.” *Id.*

Accordingly, a claim is indefinite, and therefore invalid, if it does not reasonably apprise those skilled in the art of its scope. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1374 (Fed. Cir. 2008). This standard is satisfied, however, only if the claims are “not amenable to construction or [are] insolubly ambiguous.” *Halliburton Energy Servs.*, 514 F.3d at 1250. As before, the '147 patent is presumed to be valid. 35 U.S.C. § 282. Defendant, therefore, can demonstrate invalidity for indefiniteness “only if . . . no narrowing construction can properly be adopted.” *Microprocessor Enhancement Corp.*, 520 F.3d at 1374 (quotation omitted). Defendant bears the burden of rebutting the presumption of validity by clear and convincing evidence. *Aero Products Intern., Inc. v. Intex Recreation Corp.*, 466 F.3d 1000, 1015-160 (Fed. Cir. 2006).

Defendant focuses its indefiniteness argument on a single word contained in Claim 1: “perimeter.” That claim includes the following language: “a frame having a first surface including

an outwardly projecting lip extending along a *perimeter* of said first surface.” Defendant contends that the use of the word “perimeter” in that claim is contrary to the specification. Specifically, according to defendant, “perimeter” can only mean “the boundary of a closed plane figure.” Defendant therefore interprets “perimeter” to mean the outer boundary of the first surface.¹⁵ Defendant argues that this construction contradicts the specification, which shows and describes the lip extending around a vertical perimeter of the frame, not a horizontal perimeter of the first surface. Defendant concludes: “Clearly claim 1 contains an inherent contradiction because the lip does not extend around the perimeter of the first surface.”

The Court is not persuaded. Defendant would interpret the word “perimeter” to mean a rectangle, or as defendant phrases it, “the boundary of a closed plane figure.” But the ordinary meaning of the word, the specification, and the claims demonstrate that “perimeter” should not be given so narrow an interpretation. Rather, the Court agrees with plaintiff that “perimeter” means “an edge or linear boundary.”

First, the dictionary provided by defendant defines “perimeter” as “a line or strip bounding or protecting an area.” WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 874 (1986). Second, the specification and claims, when read together, support this conclusion. The specification states, “Preferably the frame 146 includes a lip 170 that extends around *the perimeter* of the frame 146 formed with a recess for receiving the gasket 174,” and Claim 1 states, “a frame having a first surface including an outwardly projecting lip extending along *a perimeter* of said first surface.” The specification, in describing the lip’s position relative to the frame, uses the definite article

¹⁵ In arguing for noninfringement, defendant equates the term “first surface” with “top wall.” For reasons discussed below, the Court concludes that “first surface” is not equivalent to “top wall.” For the sake of its indefiniteness argument, however, defendant assumes that “first surface” does not equal “top wall.”

“the,” which suggests that the frame has only one perimeter. Claim 1, in describing the lip’s position relative to the first surface, uses the indefinite article “a,” which suggests that the first surface has more than one perimeter. Read together, therefore, it is clear that the lip extends along *the* perimeter of, and encloses, the frame. The lip also extends along *a* perimeter of, but does not enclose, the first surface. Read this way, use of the word “perimeter” in the specification and in Claim 1 is entirely consistent, and defendant’s contention that there exists an inherent contradiction between the specification and Claim 1 is incorrect.

Accordingly, because the use of “perimeter” in Claim 1 reasonably apprises those skilled in the art of the Claim’s scope, independent Claim 1 and dependent Claims 2 and 6 are not invalid for indefiniteness. Judgment in favor of plaintiff on the issue of indefiniteness is therefore warranted.

G. Double Patenting

In its final challenge to the validity of the ’147 patent, defendant argues that Claims 1, 2, and 6 are invalid for obviousness-type double patenting and Claims 2 and 6 are invalid for statutory double patenting. “The double patenting doctrine generally prevents a patentee from receiving two patents for the same invention.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1372 (Fed. Cir. 2005). There are two types of double patenting: (1) statutory double patenting, and (2) obvious-type double patenting. *Id.* at 1372-73. The former is grounded in the language of § 101 of Title 35, which provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain *a patent* therefor.” Statutory double patenting prevents a party from obtaining more than one patent for inventions that are identical in scope. *Perricone*, 432

F.3d at 1372-73. Obviousness-type double patenting is “a judicially created doctrine adopted to prevent claims in separate applications or patents that do not recite the ‘same’ invention, but nonetheless claim inventions so alike that granting both exclusive rights would effectively extend the life of patent protection.” *Id.* at 1373. The statutory presumption of validity requires the defendant to point to clear and convincing evidence that the ’147 patent is invalid for double patenting. *Id.* at 1372.

1. Obvious-Type Double Patenting

Defendant contends that Claims 1, 2, and 6 of the ’147 patent are invalid for obvious-type double patenting because they are essentially identical to Claim 2 of the ’760 patent. Whatever the merits of this argument, both parties acknowledge that obvious-type double patenting can be overcome by the proper filing of a terminal disclaimer. *Id.* at 1375; *see* 37 C.F.R. § 1.321(c). Such disclaimer joins the two patents in duration and ownership, 37 C.F.R. § 1.321(c)(3), thereby preventing a patentee from “effectively extend[ing] the life of patent protection.” *Perricone*, 432 F.3d at 1373.

Plaintiff’s sole argument in response to defendant’s contention of obvious-type double patenting is that it filed a terminal disclaimer. On this record, however, summary judgment is not proper because a genuine dispute remains as to whether such a disclaimer was properly filed. Plaintiff has provided the Court with a declaration of an attorney who avers to having filed the disclaimer. Plaintiff has also provided (1) a copy of the patent application, which indicates a terminal disclaimer was filed; (2) a copy of the purported terminal disclaimer; (3) a check payable to the PTO, for a sum that indicates the terminal disclaimer has been filed; and (4) a return receipt from the PTO itemizing the items filed in support of the ’147 patent. Defendant notes, however,

that (1) the official file of the '147 patent does not contain a terminal disclaimer and (2) the front page of the '147 patent does not reflect a terminal disclaimer, even though such information would appear had such a disclaimer been filed.¹⁶ Plaintiff replies that this is an administrative oversight by the PTO. Whether or not that is true, a genuine dispute of material fact exists as to whether plaintiff properly filed a terminal disclaimer.

2. Statutory Double Patenting

With little detail or explanation, defendant contends that Claims 2 and 6 of the '147 patent are invalid for statutory double patenting. It argues that Claims 2 and 6 of '147 patent have substantially the same scope as Claim 2 of the '760 patent. According to defendant, it is not possible to infringe the '147 patent without infringing the '760 patent, and the '147 patent is therefore invalid.

The Court is not persuaded by defendant's conclusory arguments. Claims 2 and 6 of the '147 patent would be invalid for statutory double patenting if it were not possible to infringe the '147 patent without infringing the '760 patent. *See In re Goodman*, 11 F.3d 1046, 1052 (Fed. Cir. 1993) (“If the claimed inventions are identical in scope, the proper rejection is under 35 U.S.C. § 101 because an inventor is entitled to a single patent for an invention.”). Here, however, it would be possible to infringe the '147 patent without infringing the '760 patent. For example, Claims 2 and 6 of the '147 patent include first and second members “supported on and extending over” a “first surface.” Moreover, as discussed below, the first surface includes the lip. Thus, a

¹⁶ Plaintiff contends that in any event, “even if [it] had not filed a terminal disclaimer and paid the fee, such filing may be made even after a patent has issued.” Assuming that statement is correct, plaintiff has not submitted evidence that it in fact filed a terminal disclaimer after the '147 patent issued; rather, it contends it filed the disclaimer *before* the patent issued.

device would infringe the '147 patent if it placed the first and second members on the lip portion of the first surface.

By contrast, a device that placed the first and second hangers on the lip would not infringe the '760 patent. Claim 2 of the '760 patent (which is dependent on Claim 1 of the '760 patent) describes a “first hanger” and “second hanger” “coupled to said top wall” and located “at said lip.” In this Court’s previous decision, it concluded that the lip of the '760 patent was separate and distinct from the top wall. *Holmes I*, 424 F. Supp. 2d at 286-87. Thus, by placing first and second hangers on the lip, a device would not infringe the '760 patent because those hangers would not be coupled to the top wall. Because it is possible to infringe the '147 patent without infringing the '760 patent, Claims 2 and 6 of the '147 patent do not claim inventions of substantially identical subject matter as Claim 2 of the '760 patent. *See In re Lonardo*, 119 F.3d 960, 965 (Fed. Cir. 1997).

3. Conclusion

For these reasons, plaintiff is entitled to judgment on defendant’s claim of statutory double patenting. However, because a genuine dispute of material fact exists as to whether plaintiff filed a terminal disclaimer, summary judgment on the issue of obvious-type double patenting is inappropriate.

H. The Claim of Patent Infringement

Having declined at this stage to invalidate the '147 patent, the next question is whether the H600 Filter and Revised H600 Filter infringe Claims 1, 2, and 6 of that patent.

1. The Standard

The assessment of a patent infringement claim is a two-step process. First, the court must

construe the meaning and scope of the patent claim. Second, the court must “compare the properly construed claim to the accused device to determine whether all of the claim limitations are present either literally or by a substantial equivalent.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1247 (Fed. Cir. 1998).

“[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Markman v. West View Instruments, Inc.*, 517 U.S. 370, 372 (1996). When “the parties do not dispute any relevant facts regarding the accused product but disagree over which of the [proffered possible meanings of the claims is] the proper one, the question of literal infringement collapses to one of claim construction and is thus amenable to summary judgment.” *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1578 (Fed. Cir. 1996); *see also Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 3 F. Supp. 2d 104, 107 (D. Mass. 1998) (“[I]f there are no genuine issues of material fact, summary judgment as is appropriate in a patent infringement case as in any other.”).

2. Meaning and Scope of the Patents

In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), the Federal Circuit clarified the proper approach to claims construction and set forth principles for determining the hierarchy and weight of the definitional sources that give the patent its meaning. These sources include “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Id.* at 1314 (citing *Innova Pure Water Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)).

The claims of a patent “define the invention to which the patentee is entitled the right to

exclude.” *Phillips*, 415 F.3d at 1312 (citing *Innova*, 381 F.3d at 1115). The words of a claim are to be given their “ordinary and customary meaning” as a person of ordinary skill in the art in question would understand them. *Id.* at 1312-13 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). In doing so, the claim should be read “in the context of the entire patent, including the specification.” *Id.* at 1313. In some cases, claim construction “involves little more than the application of the widely accepted meaning of commonly understood words.” *Id.* at 1314. However, the Court may also look to other sources, because terms may have “a particular meaning in a field of art” and patentees “frequently use terms idiosyncratically.” *Id.*

One such source is the claims themselves. Because claim terms are normally used consistently throughout the patent, the meaning of the term in one claim is likely the meaning of that same term in another. *Id.* Further, a term used in another claim may help define the disputed term: for example, “the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” *Id.* at 1314-15.

The claims must also be read in view of the specification set forth in the patent. *Id.* at 1315. “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* (citing *Vitronics*, 90 F.3d at 1582). “[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess.” *Id.* at 1316.

a. **'147 Patent Claims Construction**

Plaintiff contends that the H600 Filter and the Revised H600 Filter infringe Claims 1, 2, and 6 of the '147 patent. All agree that Claims 2 and 6 are dependent claims. The Court, therefore, need only decide whether Claim 1 is infringed; if it is not, then defendant has not infringed the '147 patent.

Claim 1 of the '147 patent provides, in relevant part,

a frame having a first surface including an outwardly projecting lip extending along a perimeter of said first surface;

. . . and a first member supported on and extending over said first surface . . . adapted to receive a first hanger support secured to the air purifying device.

The parties have two specific disagreements about the meaning of Claim 1.

First, defendant contends that the “lip” referred to in Claim 1 is not a part of the “first surface,” but rather a separate and distinct feature. According to defendant, the Court’s March 2006 order essentially resolves this issue because the '147 and '760 patents are in substance the same—that is, the term “first surface” in the '147 patent means “top wall” as that term is used in the '760 patent. Thus, because the Court previously concluded that the “lip” and “top wall” were separate features of the '760 patent, *Holmes I*, 424 F. Supp. 2d at 286-87, so too are the “lip” and “first surface” separate features of the '147 patent. By contrast, plaintiff contends that the term “first surface” should be construed to mean the exterior or upper boundary of the frame, *including* the “lip.” According to plaintiff, “first surface” is not the equivalent of “top wall,” and Claim 1 *defines* the “first surface” as including the “lip.” The two, therefore, are not separate features.

Second, defendant contends that the phrase “a first member supported on and extending over said first surface” means that the first member is supported on and extends over the wall, not solely the lip. Again, defendant argues that the Court’s March 2006 order is dispositive. According to defendant, the term “first member” in the ’147 patent is equivalent to the term hanger “leg” in the ’760 patent. Because the Court previously concluded that the hanger in the ’760 patent could be “coupled to the top wall of the frame, *or* to the top wall and the lip, *but not solely* the lip,” *id.* at 287 (emphasis in original), neither can the first member be supported on or extend solely over the lip in the ’147 patent. In response, plaintiff interprets the phrase “a first member supported on and extending over said first surface” as including a first member supported on and extending over the lip. According to plaintiff, because the term “first surface” includes the lip, it necessarily follows that the first member, which is supported on and extends over the first surface, may be supported on and extend over the lip.

Thus, the Court must decide two issues: First, whether the “lip” is part of the “first surface”; and second, whether the “first member” may be supported on and extend over the “lip.”

i. The Claim Language

The parties first dispute whether the “lip” is part of the “first surface.” The Court agrees with plaintiff that it is.

As an initial matter, the term “first surface” is not equivalent to the term “top wall.” Claim 7 of the ’147 patent provides, “A filter assembly as defined in claim 1, wherein said frame first surface includes a top wall, and said frame further includes a bottom wall and first and second side wall connecting said top and bottom walls.” If defendant were correct that “first surface” meant “top wall,” Claim 7 would be redundant. It would provide for a “filter assembly as defined in

claim 1, wherein said frame [*top wall*] includes a *top wall*.” A court should not interpret a claim so as to produce a redundancy. *See Phillips*, 415 F.3d at 1324-25 (relying on dependent claims to interpret an independent claim and rejecting an interpretation that created a redundancy).

Next, contrary to the assertions of defendant, it is apparent from the language of Claim 1 that the “lip” is part of the “first surface.” As matter of simple grammar, Claim 1 provides that the first surface includes the lip: “[A] frame having a first surface *including* an outwardly projecting lip extending along a perimeter of said first surface.” The word “having” modifies the term “frame,” whereas the word “including” modifies the term “first surface,” and indicates that the “lip” is part of the “first surface.” If, as defendant contends, the “lip” were not part of the “first surface,” Claim 1 would have provided, “a frame having a first surface [*and*] an outwardly projecting lip extending along a perimeter of said first surface.” Accordingly, the Court concludes that the “lip” referred to in Claim 1 is part of the “first surface.”

The parties’ second disagreement is whether the “first member” may be supported on and extend solely over the “lip.” Defendant’s position is that it may not; plaintiff takes the opposite view. Again, the Court agrees with plaintiff.

In relevant part, Claim 1 provides, “. . . a first member supported on and extending over said *first surface*.” The language indicates that the “first member” is supported on and extends over the “first surface,” which the Court has concluded includes the “lip.” It follows, therefore, that the “first member” may be supported on and extend over the “lip.” Nothing in the language of Claim 1 indicates to the contrary. Defendant again asserts that “first surface” means “top wall,” and, as a result, Claim 1 requires that the “first member” be supported on and extend over the top wall (first surface). This argument is unavailing for reasons already described. The term

“first surface” in the ’147 patent is not equivalent to the term “top wall” in the ’760 patent.

ii. The Specification Language

The language of the specification supports the conclusion that the lip is part of the “first surface” and that the “first member” may be supported on and extend over the “lip.” The specification provides:

The frame 146 of the filter assembly 116 has an exterior surface 150 and preferably includes a top wall 158, a bottom wall 160, and first and second opposing walls 162, 164 connecting the top and bottom walls 158, 160 with the first filter element 148 being positioned within the walls.

Defendant contends that the specification equates the term “surface” with term “wall.” The Court disagrees. The specification provides that the “exterior surface . . . *includes* a top wall 158, a bottom wall 160, and first and second opposing walls 162, 164” The word “includes” indicates that the walls are component parts of the surface, and do not, by themselves, make up the whole of the surface. This comports with the language of the ’147 claims, which does not equate the term “first surface” with “top wall.” Accordingly, the specification confirms the interpretation of Claim 1, which provides that the “first surface” includes the “lip.”

While the specification provides less support for plaintiff’s second position—that the first member may be supported on and extend over the lip—it does not compel a different conclusion. The specification provides, “Each hanger 118, 120 preferably includes a pair of legs 119 attached to the top wall 158 at the lip 170” According to defendant, this language requires that the “first member” be supported on and extend over the “top wall,” not the “lip.” But indicating that the “first member” is attached to the “top wall” at the “lip” does not mean that the member cannot be supported on and extend over the “lip,” which is part of the “first surface.” In any event,

“although the specification often describes very specific embodiments of the invention, [the Federal Circuit has] repeatedly warned against confining the claims to those embodiments.” *Phillips*, 415 F.3d at 1324-25. Given the clarity with which the claims themselves speak, the Court declines to read the specification as limiting as limiting the scope of Claim 1.

In sum, the Court concludes that, as used in Claim 1, the “first surface” includes the “lip” and the “first member” may be supported on and extend over the “lip.” Because the disputes concerning Claim 1 can be resolved by its language and that of the specification, and because the parties do not rely on extrinsic evidence, the Court need go no further in its claim construction analysis.

3. Comparison of the Claims as Construed to the Accused Device

a. Literal Infringement

To infringe a claim literally, each and every claim limitation must be present in the accused device exactly as claimed, and therefore “any deviation from the claim precludes a finding of literal infringement.” *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1454 (Fed. Cir. 1998). Furthermore, “[a]ll limitations in a claim must be considered meaningful.” *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 546 (Fed. Cir. 1994). The Court concludes that both the H600 Filter and the Revised H600 Filter literally infringe the ’147 patent.

Because “the parties do not dispute any relevant facts regarding the [H600 Filter and the Revised H600 Filter] but disagree over which of the [proffered possible meanings of the claims is] the proper one, the question of literal infringement collapses to one of claim construction” *Athletic Alternatives, Inc.*, 73 F.3d at 1578. The Court has rejected defendant’s proffered construction of the disputed claims. Accordingly, because the accused products contain each of

these limitations (the only limitations in dispute), the Court concludes that the H600 Filter and Revised H600 Filter literally infringe Claims 1, 2, and 6 of the '147 patent.

b. Infringement by Equivalents

Because the Court has concluded that the H600 Filter and Revised H600 Filter literally infringe the '147 patent, it need not address infringement by equivalents.

F. Discovery on Damages

Defendant contends that plaintiff violated discovery rules regarding damages disclosures and therefore is prohibited from collecting damages in this case. Rule 26 requires that even prior to a specific discovery request on damages, each party must provide the other with a computation of each category of damages it claims, including background evidence upon which the calculations are based. *See* Fed. R. Civ. P. 26(a)(1)(A)(iii). A party who fails to make appropriate disclosures pursuant to Rule 26(a) may be barred from presenting the evidence at trial. *See* Fed. R. Civ. P. 37(c). Alternatively, the Court may impose other sanctions or require payment of reasonable expenses and attorney's fees. *Id.*

Defendant contends that plaintiff made no initial disclosures on damages and then refused to respond to interrogatories specifically requesting damages information. When plaintiff did respond, those responses were incomplete, because they did not include the documents or exhibits on which plaintiff's calculations were based. Defendant argues that because of plaintiff's intentional disregard for its discovery responsibilities, plaintiff should be barred from offering any evidence as to damages. And without evidence of actual harm, defendant argues that plaintiff is not entitled to damages.

Plaintiff concedes that it did not make initial disclosures on damages, contending that as of

the scheduled time for initial disclosures it did not have sufficient information as to defendant's sales of allegedly infringing filters and therefore was unable to calculate its damages. Plaintiff also contends that as of the scheduled time for initial disclosures it was negotiating a stipulation agreement with defendant regarding damages. Further, plaintiff states that when the negotiations broke down, it provided damages information to defendant and asked defendant if supplemental responses were required. According to plaintiff, defendant never requested additional information.

In arguing that plaintiff should be barred from collecting monetary damages, defendant essentially asks this Court to dismiss with prejudice any claims plaintiff may have for actual damages. Dismissal with prejudice under Fed. R. Civ. P. 37(c) is "the harshest sanction, other than contempt, which may be visited on a party." *Benitez-Garcia v. Gonzalez-Vega*, 468 F.3d 1, 4 (1st Cir. 2006). The First Circuit has long held that "[w]here dismissal with prejudice is involved, . . . a case should not be dismissed with prejudice except 'when a plaintiff's misconduct is particularly egregious or extreme.'" *Id.* at 5 (quoting *Benjamin v. Aroostook Med. Ctr., Inc.*, 57 F.3d 101, 107 (1st Cir. 1995)). At this stage, the Court is not convinced that plaintiff's conduct rises to that high threshold. Thus, the Court is not inclined to impose such an extreme sanction.

At the same time, plaintiff's failure to comply with its initial discovery obligations is troublesome. Initial disclosures are a routine but important part of every case. Moreover, the Court is not persuaded by plaintiff's explanation that defendant failed to request supplementation of those responses plaintiff did eventually provide. Having acknowledged that it failed to initially disclose a computation of damages, plaintiff was under a continuing duty to supplement its

responses until they were complete, whether or not defendant made a specific request. *See* Fed. R. Civ. P. 26(a)(1)(A)(iii), (e).

Although the Court is disinclined to dismiss plaintiff's claims for money damages, it would nonetheless entertain a proposal from defendants for some compensatory sanction short of dismissal, such as an award of reasonable fees and costs defendant has incurred as a result plaintiff's actions. The Court will therefore deny defendant's motion for summary judgment on the basis of discovery abuse without prejudice to defendant's right to seek sanctions of a less extreme nature.

IV. Conclusion

For the foregoing reasons, and to the extent set forth above:

1. The Motion of Defendant RPS Products, Inc., to Exclude the Testimony of Carolyn Elmore is GRANTED in part and DENIED in part.
2. The Motion of Defendant RPS Products, Inc., to Exclude the Bennett and Marino Affidavits is DENIED.
3. The Motion of Defendant RPS Products, Inc., for Summary Judgment is DENIED as follows:
 - a. DENIED as to Count I (patent infringement);
 - b. DENIED as to Affirmative Defense 4 (prosecution laches);
 - c. DENIED as to Affirmative Defense 3 (inequitable conduct);
 - d. DENIED as to Affirmative Defense 2 (invalidity for failure to comply with the writing requirement of 35 U.S.C. § 112);
 - e. DENIED as to Affirmative Defense 2 (invalidity for obviousness under 35

U.S.C. § 103);

f. DENIED as to Affirmative Defense 2 (invalidity for indefiniteness under 35

U.S.C. § 112);

g. DENIED as to Affirmative Defense 5 (double patenting); and

h. DENIED without prejudice as to its contention that Holmes' claim for money damages is barred.

4. The Motion of Plaintiff the Holmes Group, Inc. for Summary Judgment is

GRANTED in part and DENIED in part as follows:

a. GRANTED as to Count I (patent infringement);

b. GRANTED as to Affirmative Defense 4 (prosecution laches);

c. DENIED as to Affirmative Defense 3 (inequitable conduct);

d. GRANTED as to Affirmative Defense 2 (invalidity for failure to comply with the writing requirement of 35 U.S.C. § 112);

e. GRANTED as to Affirmative Defense 2 (invalidity for obviousness under 35 U.S.C. § 103);

f. GRANTED as to Affirmative Defense 2 (invalidity for indefiniteness under 35 U.S.C. § 112); and

g. GRANTED in part and DENIED in part as to Affirmative Defense 5 (double patenting).

So Ordered.

/s/ F. Dennis Saylor
F. Dennis Saylor IV
United States District Judge

Dated: June 25, 2010