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APPELLANT'S BRIEF

2011-1363, -1364

**United States Court of Appeals
for the Federal Circuit**

ROBERT BOSCH LLC,

Plaintiff-Appellant,

v.

PYLON MANUFACTURING CORP.,

Defendant-Cross Appellant.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

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*Appeals from the United States District Court for the District of
Delaware in Case No. 08-CV-0542, Judge Sue L. Robinson.*

**PLAINTIFF-APPELLANT ROBERT BOSCH LLC'S
EN BANC BRIEF ON APPELLATE JURISDICTION**

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CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellant Robert Bosch LLC certifies the following:

1. The full name of every party or *amicus curiae* represented by me is:

Robert Bosch LLC

2. The name of the real parties in interest (if the parties named in the caption are not the real parties in interest) are:

Robert Bosch LLC

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties or *amici curiae* represented by me are:

Robert Bosch North America Corporation and Robert Bosch GmbH; no publicly held company owns 10% or more of Robert Bosch LLC's stock.

4. The names of all law firms and the partners or associates that appeared for the parties or *amici curiae* now represented by me in the trial court or agency or are expected to appear in this court are:

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September 17, 2012

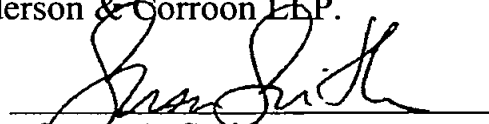

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STATEMENT OF RELATED CASES

This brief is filed in Appeals No. 2011-1363 and -1364.

This case was also the subject of *Robert Bosch LLC v. Pylon Manufacturing Corp.*, Appeal No. 2011-1096 (Fed. Cir.), which was argued before Judges Bryson, O'Malley, and Reyna on July 7, 2011, and decided on October 13, 2011. 659 F.3d 1142 (Fed. Cir. 2011).

This case was also the subject of Appeals No. 2011-1117 and -1118, which were dismissed for lack of jurisdiction on March 2, 2011. *Robert Bosch LLC v. Pylon Mfg. Corp.*, 413 Fed. Appx. 247 (Fed. Cir. 2011) (unpublished).

No other appeals have been taken in this case.

There are many cases pending in United States District Courts, and an investigation by the United States International Trade Commission, that involve one or more of the patents at issue in this appeal and may be directly affected by this Court's decision in the instant appeal and cross-appeal. None of these other cases is pending in the Supreme Court, this Court, or any other circuit court of appeals.

STATEMENT OF SUBJECT MATTER AND APPELLATE JURISDICTION

The District Court action from which this appeal is taken was brought under the patent laws of the United States, Title 35 of the United States Code. The District Court had jurisdiction over the subject matter of the action pursuant to 28 U.S.C. §§ 1331 and 1338(a) (2006).

As set forth in Robert Bosch LLC's June 24, 2011, motion to dismiss this appeal (*see* Docket Entries 25, 27) and the parties' subsequent briefing and argument, this Court lacks appellate jurisdiction because the judgment appealed from is not "final except for an accounting" as required by 28 U.S.C. § 1292(c)(2) (2006).¹

After the appeals, including the jurisdictional issues presented in Bosch's motion to dismiss, were argued before a panel of this Court on July 9, 2012, the Court *sua sponte* ordered a hearing en banc to consider whether it has jurisdiction over this appeal under Section 1292(c)(2).

¹ On August 1, 2011, a judge of this Court denied Bosch's motion (Docket Entry 29). Bosch's August 15, 2011 motion for review and reconsideration (*see* Docket Entries 33, 35) was also denied by single-judge order on October 24, 2011 (Docket Entry 38).

STATEMENT OF THE ISSUES

ISSUE I: Does 28 U.S.C. § 1292(c)(2) confer jurisdiction on this Court to entertain appeals from patent infringement liability determinations when a trial on damages has not yet occurred?

ISSUE II: Does 28 U.S.C. § 1292(c)(2) confer jurisdiction on this Court to entertain appeals from patent infringement liability determinations when willfulness issues are outstanding and remain undecided?

STATEMENT OF THE CASE

Bosch filed this action against Pylon Manufacturing Corp. in August 2008, asserting that Pylon was infringing Bosch's U.S. Patents Nos. 6,292,974 (the '974 patent), 6,675,434 (the '434 patent), 6,944,905 (the '905 patent) and 6,978,512 (the '512 patent), and that Pylon falsely advertised its beam blade products. (A357.) Pylon counterclaimed, asserting that Bosch infringed Pylon's U.S. Patent No. 6,640,380 (the '380 patent). (A399.)

The District Court dismissed Bosch's false-advertising claims on July 9, 2009 (A1).² On August 26, 2009, the District Court granted Pylon's motion to bifurcate damages and willfulness (A652, SA1), which Bosch opposed (A624), and stayed discovery on these issues (A652, SA1).³

On March 30, 2010, the District Court granted Bosch's motions for summary judgment of (i) Pylon's infringement of claims 1 and 8 of Bosch's '974 patent; (ii) no infringement of Pylon's '380 patent, and (iii) no inequitable conduct and no invalidity for derivation for Bosch's '905 and '434 patents. (A26.)⁴ The District Court also granted Pylon's motion for summary judgment of no

² *Robert Bosch LLC v. Pylon Mfg. Corp.*, 632 F. Supp. 2d 362 (D. Del. 2009).

³ The district court referred discovery issues to U.S. Magistrate Judge Thyng, who on December 23, 2009, denied the parties' cross-motions to compel production of certain documents. *Robert Bosch LLC v. Pylon Mfg. Corp.*, 263 F.R.D. 142 (D. Del. 2009).

⁴ *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 700 F. Supp. 2d 625 (D. Del. 2010).

infringement of Bosch's '512 patent, and denied Pylon's motion for summary judgment of invalidity of Bosch's '974 and '512 patents. (A27.)

Bosch's remaining claims were tried to a jury in April 2010. The jury found that (i) claim 13 of Bosch's '905 patent is valid and infringed, (ii) claim 13 of Bosch's '434 patent is valid and infringed; (iii) claim 7 of the '434 patent is valid but not infringed; (iv) claims 1 and 5 of the '434 patent are infringed but invalid for obviousness, and (v) claims 1 and 8 of Bosch's '974 patent are invalid for obviousness and derivation. (A187-91.)

The court entered judgment accordingly (A193) and the parties filed renewed motions for judgment as a matter of law or a new trial on various adverse jury verdicts, respectively.

In addition, based on the jury verdict that claims of Bosch's '905 and '434 patents are infringed and not invalid, Bosch filed a motion for a permanent injunction to enjoin Pylon from making, using, selling, offering for sale, or importing into the United States its infringing products for the remaining terms of the '905 and '434 patents.

On November 3, 2010, the District Court granted Bosch's motions for judgment as a matter of law that (i) claims 1 and 8 of the '974 patent are not invalid for obviousness, (ii) claim 8 of the '974 patent is not invalid for derivation,

and (iii) claims 1 and 5 of the '434 patent are not invalid for obviousness. (A194.)⁵ The District Court denied Bosch's motion for judgment as a matter of law that (i) claim 1 of the '974 patent is not invalid for derivation, and (ii) claim 7 of the '434 patent was infringed by Pylon's Generation 2 and 3 products. (A194–95.) The District Court denied all of Pylon's motions. (A195.)⁶

In the same order, the District Court denied Bosch's motion for entry of an injunction. (A195.)⁷ Bosch appealed the denial of its application for an injunction. The appeal was briefed and argued and on October 13, 2011, this Court reversed the District Court's decision.⁸

On March 9, 2011, the District Court issued an order and opinion finding that no inequitable conduct had occurred during the prosecution of the '974 patent. (A242.)⁹ The District Court entered a judgment on March 23, 2011. (A259.) These appeals followed.

⁵ *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 748 F. Supp. 2d 383 (D. Del. 2010).

⁶ *Id.*

⁷ *Id.*

⁸ *Robert Bosch LLC*, 659 F.3d at 1142.

⁹ *Robert Bosch LLC v. Pylon Mfg. Corp.*, 775 F. Supp. 2d 739 (D. Del. 2011).

STATEMENT OF THE FACTS

On June 30, 2009, Pylon moved the District Court to bifurcate the issues of willfulness and damages from the issues of liability in this case for the purposes of discovery and trial. (A612.) In its motion, Pylon argued that bifurcation was appropriate in view of the District Court judge's then-recent standing order providing for automatic bifurcation of willfulness and damages in patent infringement cases. (A613–16.)¹⁰

The District Court granted Pylon's motion on August 26, 2009, finding that "bifurcation is appropriate, if not necessary, in all but exceptional patent cases," because "discovery disputes related to document production on damages and the *Daubert* motion practice related to damages experts are a drain on scarce judicial resources." (A652, SA1.) The Court also acknowledged Bosch's "right to a jury trial on the issue of willfulness," but questioned "whether this right is so broad as to trump a court's right to manage its caseload, especially when the potential costs are so high." (A654, SA3.)

Proceedings on the issues of liability for willful infringement and damages remain stayed in the District Court.

¹⁰ Bosch opposed Pylon's motion to bifurcate. (A624).

SUMMARY OF THE ARGUMENT

ISSUE I: Does 28 U.S.C. § 1292(c)(2) confer jurisdiction on this Court to entertain appeals from patent infringement liability determinations when a trial on damages has not yet occurred?

The answer to this question is “no.” When a trial on damages has not yet occurred, any judgment that has been entered is not final. And because a trial on damages is not an “accounting,” 28 U.S.C. § 1292(c)(2) does not confer jurisdiction on this Court to entertain an interlocutory appeal under those circumstances.

ISSUE II: Does 28 U.S.C. § 1292(c)(2) confer jurisdiction on this Court to entertain appeals from patent infringement liability determinations when willfulness issues are outstanding and remain undecided?

The answer to this question is also “no.” When willfulness issues are outstanding and remain undecided, any judgment that has been entered is not final. And because a trial on willfulness is not an “accounting,” 28 U.S.C. § 1292(c)(2) does not confer jurisdiction on this Court to entertain an interlocutory appeal under those circumstances.

ARGUMENT

In general, only final decisions of the district courts are appealable. *See, e.g.,* 28 U.S.C. § 1295(a)(1) (2006); *Barnard v. Gibson*, 48 U.S. 650, 656 (1849) (“No point is better settled in this court, than that an appeal may be prosecuted only from a final decree.”). Congress has determined that piecemeal litigation is generally not permitted.¹¹ Interlocutory appeals are authorized only by certain exceptional statutes, which must be narrowly construed. *See, e.g., Switzerland Cheese Ass’n v. E. Horne’s Market, Inc.*, 385 U.S. 23, 24 (1966).

One of those statutes is 28 U.S.C. § 1292(c)(2) (2006), which grants this Court jurisdiction over “an appeal from a judgment in a civil action for patent infringement which . . . is final except for an accounting.”

¹¹ *See, e.g., Johnson v. Jones*, 515 U.S. 304, 309 (1995); *Richardson-Merrell Inc. v. Koller*, 472 U.S. 424, 430 (1985) (“In § 1291 Congress has expressed a preference that some erroneous trial court rulings go uncorrected until the appeal of a final judgment, rather than having litigation punctuated by piecemeal appellate review of trial court decisions which do not terminate the litigation” (internal quotation marks omitted)); *Nystrom v. Trex Co.*, 339 F.3d 1347, 1350 (Fed. Cir. 2003) (noting that with the exception of § 1292(c)(2), “piecemeal litigation is as strictly precluded by the rules of finality for patent cases as it is for any other case. Until the rules are changed, the parties and the district courts are obliged to conclude patent cases in strict compliance with the finality rule”).

The statute that became Section 1292(c)(2) was enacted in 1927.¹² At that time, the United States patent statutes provided for two different actions to recover money. One was an action at law for damages in a trial before a jury; the other was a bill in equity, by which a patent owner could seek an injunction, a monetary recovery, or both.¹³ Monetary recovery in equity came in two forms: (1) the “profits” made by the infringer, which were “to be accounted for by the defendant,” and (2) “the damages the complainant has sustained” as a result of the

¹² See Act of Feb. 28, 1927, Pub. L. No. 69-662, Ch. 228, 44 Stat. 1261, 1261 (1927) (“1927 Act,” copy attached at SA9) (“An Act to amend section 129 of the Judicial Code, allowing an appeal in a patent suit from a decree which is final except for the ordering of an accounting.”) (codified at 28 U.S.C. § 227a (1940)); see also Act of June 25, 1948, Pub. L. No. 80-773, Ch. 83, § 1292(a)(4), 62 Stat. 869, 929 (1948) (copy attached at SA11, codified at 28 U.S.C. § 1292(a)(4) (1948)); Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, § 125(c)(2), 96 Stat. 25, 36 (1982) (copy attached at SA12, codified at 28 U.S.C. § 1292(c)(2) (1982)).

¹³ As a practical matter, patent infringement was rarely litigated at law, because a patentee could recover only damages, but not an infringer’s profits. *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1567 (Fed. Cir. 1995) (dissent by Nies, J.), *rev’d on other grounds*, 520 U.S. 17 (1997); compare Act of July 8, 1870, Ch. 230, § 55, 16 Stat. 198, 206 (1870) (“1870 Act,” copy attached at SA6) (remedies in equity, codified as Rev. Stat. 4921), with *id.*, § 59, 16 Stat. at 207 (remedies at law, codified as Rev. Stat. 4919); see also *Birdsall v. Coolidge*, 93 U.S. 64, 69 (1876); *Coupe v. Royer*, 155 U.S. 565, 582 (1895). The remedies available at law and in equity continued to be separately codified at Sections 4919 and 4921 of the Revised Statutes, and later 35 U.S.C. §§ 67 and 70, until the modern version of 35 U.S.C. § 284 was enacted in 1952. See *Kori Corp. v. Wilco Marsh Buggies & Draglines Inc.*, 761 F.2d 649, 655 (Fed. Cir. 1985), *cert. denied*, 474 U.S. 902 (1985).

infringement.¹⁴ Act of Feb. 18, 1922, Pub. L. No. 67-147, Ch. 58, § 8, 42 Stat. 389, 392 (1922) (“1922 Act,” copy attached at SA8).¹⁵

The process of ascertaining the infringer’s profits was an “accounting.” The accounting, which was usually conducted by a master, involved an investigation into the parties’ account books in order to fix the amount of the defendant’s profits attributable to its misconduct and payable to the patent holder.¹⁶

¹⁴ Damages were recoverable only when “the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent.” *Birdsall*, 93 U.S. at 69. The statute therefore required a master to first assess the infringer’s profits, or conclude that they could not be ascertained, before considering evidence of damages. See *Georgia-Pacific Corp. v. United States Plywood Corp.*, 243 F. Supp. 500, 522 & n.19 (S.D.N.Y. 1965) (discussing Remarks of Rep. Henry, Hearings on H.R. 5231 (later reported as H.R. 5311) Before the House Committee on Patents, 79th Cong., 2d Sess. (1946), at 4).

¹⁵ The distinction between a patentee’s “damages” and the infringer’s “profits” has long been recognized by the courts. See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 505–06 (1964) (“In patent nomenclature what the infringer makes is profits; what the owner of the patent loses by such infringement is damages.” (quoting *Duplate Corp. v. Triplex Safety Glass Co.*, 298 U.S. 448, 451 (1936))); *Birdsall*, 93 U.S. at 68–69. The former had its origins in an action at law under the first Patent Acts, see *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1440 (Fed. Cir. 1998), while the latter remedy was adopted after Congress empowered Federal courts to hear patent infringement cases in equity. See, e.g., *Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1316 (Fed. Cir. 2007) (“When, . . . relief was sought which equity alone could give . . . in order to avoid a multiplicity of suits and to do complete justice, the court assumed jurisdiction to award compensation for the past injury, not, however, by assessing damages, which was the peculiar office of the jury, but requiring an account of profits” (quoting *Root v. Lake Shore & Michigan Southern Ry. Co.*, 105 U.S. 189, 207 (1881)) (alterations in original)).

¹⁶ See e.g., Dan B. Dobbs, *Dobbs’ Law of Remedies* § 4.3(5) (2d ed. 1993); Mark A. Thurmon, *Ending The Seventh Amendment Confusion: A Critical Analysis Of* (continued...)

In a suit at law, the procedures and remedies were different. The patentee would attempt to prove both infringement and its own damages (but not the infringer's profits) in a trial before a jury. *See* SA7, 1870 Act, Ch. 230, § 59, 16 Stat. at 207. There was no corresponding accounting remedy, and no right to an interlocutory appeal was provided under the predecessor to Section 1292(c). There is no reference in the statutes or legislative history to an "accounting" being the same proceeding as a jury trial in an action at law, where the jury could award the

The Right To A Jury Trial In Trademark Cases, 11 Tex. Intell. Prop. L.J. 1, 27–80 (2002); *see also* Joseph Story, *Commentaries On Equity Jurisdiction As Administered In England And America*, at 612 & n.3 (14th ed. 1918) ("in most cases of this sort the bill usually seeks an account . . . of the profits which have arisen from the use of the invention from the persons who have pirated the same." "The principle is that equity converts the infringer into a trustee as to the profits, a principle appropriate in equity by reference to a master, who can examine books and papers and examine the infringer and his employees on oath."); *Stevens v. Gladding*, 58 U.S. 447, 455 (1854) (equity entitled the patentee to an "account of the profits" earned by the infringer); *Tilghman v. Proctor*, 125 U.S. 136, 137, 157 (1888) ("the defendants, in accounting with the plaintiff for the profits made by them from the use of his invention"); *Duplate Corp.*, 298 U.S. at 459 (explaining that "The master advised an award of damages measured by a reasonable royalty" after concluding "that the defendants were not accountable for profits for the reason that the business had been conducted at a loss"); *Georgia-Pacific*, 243 F. Supp. at 516–31 (the "raison d'être" of an accounting was to determine "the infringer's profits as an independent measure of the patent owner's recovery").

patentee its damages, but not the infringer's profits. *See, e.g., Brown v. Lanyon*, 148 F. 838, 841 (8th Cir. 1906) (discussing *Coupe*, 155 U.S. at 583).¹⁷

In 1927, Congress elected to allow interlocutory appeals of patent cases in which an accounting had not yet been conducted, because accountings had become notoriously drawn-out and expensive.¹⁸ The predecessor statute to Section 1292(c)(2) was enacted to avoid this “great burden of expense,” *see McCullough v. Kammerer Corp.*, 331 U.S. 96, 98–99 & n.1 (1947) (quoting H. R. Rep. No. 1890, 69th Cong., 2d Sess. 1 (1927)), by permitting an interlocutory appeal in a “suit in equity” when the decree was “final except for the ordering of an accounting.” SA9, 1927 Act, Ch. 228, 44 Stat. at 1261.

¹⁷ Although law and equity were merged into a single civil action in 1938, courts continued to distinguish between the equitable remedy of an accounting of the infringer's profits and a jury's award of the patentee's damages. *See, e.g., Beaunit Mills, Inc., v. Eday Fabric Sales Corp.*, 124 F.2d 563, 565 (2d Cir. 1942) (“It is true that on issues of patent infringement a jury trial may be had under a claim for damages only, 35 U.S.C.A. § 67, as distinguished from a claim for injunction and accounting of profits. 35 U.S.C.A. § 70.”). This distinction is also carried forward in the modern version of the Federal Rules. *See* Fed. R. Civ. P. 55(a)(1)(A)–(B) (after a default judgment, a court may hold proceedings to “(A) conduct an accounting,” or “(B) determine the amount of damages.”).

¹⁸ As the Committee on Patents of the House of Representatives later noted, “the proceedings before masters, which are conducted in accordance with highly technical rules and are always expensive, are often protracted for decades and in many cases result in a complete failure of justice.” H.R. Rep. No. 1587, 79th Cong., 2d Sess., at 2 (1946); *see also Rite-Hite Corp. v. Kelly Co.*, 56 F.3d 1538, 1566–67 (Fed. Cir. 1995) (en banc) (dissent by Nies, J.); *Kori Corp.*, 761 F.2d at 654; Daniel C. Munson, *The Equitable Profits and Reasonable Royalty Remedies—An Economic Connection*, 76 J. Pat. & Trademark Off. Soc'y 887, 891–93 (1994).

Congress's 1946 amendments placed the remedy provisions of the Patent Act into substantially their modern form.¹⁹ In these amendments, which came eight years after law and equity were merged, Congress did away with the profits-accounting remedy in utility-patent infringement suits, leaving only the damages-trial remedy. Act of Aug. 1, 1946, Pub. L. No. 79-587, Ch. 726, 60 Stat. 778, 778 (1946) (copy attached at SA10); *see also* H.R. Rep. No. 1587, 79th Cong., 2d Sess., at 1 (1946).²⁰ Congress thus did away with the delay and other problems associated with the accounting procedure.²¹

¹⁹ When Title 35 was re-codified in 1952, the remedy provisions from the 1946 act were consolidated into the present 35 U.S.C. § 284, but otherwise remained substantially the same. *See Aro Mfg. Co.*, 377 U.S. at 506 n.20.

²⁰ These revisions were made possible both by the liberal pre-trial discovery provisions included in the Federal Rules (which allowed the parties to take discovery on damages prior to trial, rather than waiting for the court to order an accounting), *see, e.g., Binger v. Unger*, 7 F.R.D. 121, 121-22 (S.D.N.Y. 1946), and the Supreme Court's endorsement of reasonable-royalty damages (which permitted a patentee to recover damages even if it could not prove its lost profits or the existence of an established royalty rate). *See Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 235 U.S. 641, 647-49 (1915); *see also* SA8, 1922 Act, Ch. 58, § 8, 42 Stat. at 392 (codifying same).

²¹ *See* H.R. Rep. No. 1587, 79th Cong., 2d Sess., at 2 (1946) ("The evil attendant upon 'the law's delay' and the difficulty of adducing convincing proof of necessary facts is peculiarly exemplified in patent-infringement suits where profits are claimed. . . . by making it unnecessary to have proceedings before masters and empowering equity courts to assess general damages irrespective of profits, the measure represents proposed legislation which in the judgment of the committee is long overdue.").

Most significantly for the en banc issues in this appeal, Congress did not revise the interlocutory appeal provision to add interlocutory appellate jurisdiction in cases final except for a damages trial.

The simplest explanation for Congress's inaction is that Congress did not believe that allowing interlocutory appeals in cases where a damages trial was pending would be an appropriate new exception to the final-judgment rule. After all, jury trials do not present the "decades" of delay then associated with accountings. *See* H.R. Rep. No. 1587, 79th Cong., 2d Sess., at 2 (1946).

Pylon makes a more complicated argument: that Congress's choice not to amend the interlocutory appeal statute indicates Congress's understanding that the word "accounting" refers to damages trials. Otherwise, Pylon argues, the decision to leave the final-except-for-an-accounting statute in place makes no sense; it would be a useless statute, because "that remedy [accounting] has not been available for more than sixty years." (Docket Entry 26 at 2.)

But Section 1292(c) is not vestigial, because contrary to Pylon's argument, an accounting for profits is still an available remedy under the current design-patent statute. *See Nike*, 138 F.3d at 1438, 1442, 1447–48 (affirming the district

court's accounting of the design patent infringers' profits awarded under 35 U.S.C. § 289).²²

I. ISSUE I: A JURY TRIAL ON DAMAGES IS NOT AN ACCOUNTING, AND THIS COURT THEREFORE LACKS APPELLATE JURISDICTION

As described above, an accounting is, historically and literally, a different remedy from a jury trial on damages. And this is not a musty, academic distinction. The difference between what a master would do in reviewing the infringer's books of account in order to identify its profits due to the invention, and what a jury must do in assessing general patent damages, is highlighted by the qualitative character of some of the *Georgia-Pacific* factors used to assess a reasonable royalty, which involve not just the parties' existing royalty and profits figures from their books of account, but also, for example, the patentee's licensing and business strategy (factor 4), the competitive relationship between the patentee and the infringer (factor 5), the outcome of a hypothetical negotiation (factor 15), and ultimately "The nature of the patented invention" and "The utility and

²² A post-trial accounting also continues to be a viable remedy under other circumstances, for example, when the plaintiff seeks an accounting of post-trial infringing sales. See, e.g., *Whitserve, LLC v. Computer Packages, Inc.*, Nos. 2011-1206, -1261, 2012 U.S. App. LEXIS 17510, at *66–68 (Fed. Cir. Aug. 7, 2012); *Telcordia Techs., Inc. v. Cisco Sys., Inc.*, 592 F. Supp. 2d 727, 749–50 (D. Del. 2009), *aff'd in relevant part*, 612 F.3d 1365, 1379 (Fed. Cir. 2010); *Joyal Prods., Inc. v. Johnson Elec. N. Am., Inc.*, No. 04-5172 (JAP), 2009 WL 512156, at * 14–15 (D.N.J. Feb. 27, 2009), *aff'd*, 335 Fed. Appx. 48 (Fed. Cir. 2009).

advantages of the patent property over the old modes or devices” (factors 9 and 10). *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970). These evaluations are unlike the sometimes complex, but generally quantitative calculations and report associated with an accounting of profits. *See, e.g.*, Fed. R. Civ. P. 53 Advisory Committee Notes on 2003 Amendments (“matters of account” may be assigned to a master because they are “essentially ministerial determinations that require mastery of much detailed information but that do not require extensive determinations of credibility”); *W. H. Miner, Inc. v. Peerless Equipment Co.*, 115 F.2d 650, 653–56 (7th Cir. 1940) (accounting focused on, *e.g.*, the defendant’s overhead expenses for different business units, interest on invested capital, and bonus payments); *Nike*, 138 F.3d at 1438, 1442, 1447–48 (accounting focused on whether certain categories of costs could be deducted). Lost profits and price erosion, for further example, require similar assessments of the development of the market.²³

²³ The difference between the two procedures is also illustrated by the manner in which they allocate the burden of proof. In a jury trial on damages, the patentee bears the burden of proving its damages. *See, e.g., Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1336 (Fed. Cir. 2009). In contrast, because an accounting originated in equity, the infringer (rather than the patentee) was required to prove any apportionment, when it was necessary to avoid unjust enrichment. *See, e.g., W. H. Miner*, 115 F.2d at 654; *see also* 17 U.S.C. § 504(b) (2006); 15 U.S.C. § 1117(a)(3) (2006) (same in accountings for profits in copyright and trademark law).

Pylon has argued that Congress, by inaction, has acquiesced to judicial expansion of the interlocutory-appeal statute to cover cases final except for a jury trial on damages. (Docket Entry 26 at 7–8.) However, this Court has only rarely had occasion to address the issue. In its few precedential decisions, it has never held, citing apposite authority, that the statute permits the interlocutory appeal of liability issues when a separate jury trial on damages or willfulness remains pending. Many of those decisions discuss Section 1292(c)(2) only in dicta,²⁴ or when there was jurisdiction on other grounds.²⁵ Even when the discussion was apparently not dicta, it has only been in other contexts,²⁶ or without apparent

²⁴ See, e.g., *PODS, Inc. v. Porta Stor, Inc.*, 484 F.3d 1359, 1365 n.4 (Fed. Cir. 2007) (stating in dicta that a pending decision on enhancement of damages does not bar an immediate appeal under Section 1292(c)(2)); *Special Devices, Inc. v. OEA, Inc.*, 269 F.3d 1340, 1343 n.2 (Fed. Cir. 2001) (stating in dicta that the “accounting” of Section 1292(c)(2) “refers to infringement damages,” but citing no authority).

²⁵ See, e.g., *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1337 (Fed. Cir. 2009) (“we have jurisdiction under 28 U.S.C. § 1292(c)(1) and (2)”); *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552, 1555 (Fed. Cir. 1984) (court had jurisdiction under Section 1292(c)(1)).

²⁶ *Majorette Toys (U.S.) Inc. v. Darda, Inc., U.S.A.*, 798 F.2d 1390, 1391 (Fed. Cir. 1986) (proceedings to set the amount of the attorneys fees remained pending); *Johannsen v. Pay Less Drug Stores Nw., Inc.*, 918 F.2d 160, 164 (Fed. Cir. 1990) (damages trial for non-patent claims remained pending); *In re Calmar, Inc.*, 854 F.2d 461, 463–64 (Fed. Cir. 1988) (mandamus granted to vacate district court’s contempt order); *H. A. Jones Co. v. KSM Fastening Sys., Inc.*, 745 F.2d 630, 631 (Fed. Cir. 1984) (accounting for violation of an injunction remained pending).

discussion by the parties or citation to pertinent authority.²⁷ There is therefore no “settled statutory construction” of Section 1292(c)(2) for Congress to acquiesce to. *Helvering v. Hallock*, 309 U.S. 106, 119–21 & n.7 (1940). And even if there were, there is no evidence that Congress was ever informed of such a construction, and elected not to act. *Id.* at 120–21 (“we walk on quicksand when we try to find in the absence of corrective legislation a controlling legal principle.”).²⁸

To take appellate jurisdiction over this appeal pursuant to the first en banc issue, the Court must find that a jury trial on damages (and the associated discovery and pretrial proceedings) is literally an “accounting,” as that word is used in Section 1292(c). Otherwise, Congress’s limited grant of interlocutory

²⁷ *Cent. Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Solutions, P.C.*, 482 F.3d 1347, 1353 (Fed. Cir. 2007) (citing *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1581 (Fed. Cir. 1994), which held only that a prior decision appealed under Section 1292(c)(2) was not a final judgment); *PODS*, 484 F.3d at 1365 n.4 (citing only *Majorette Toys*, 798 F.2d 1390, 1391, *supra* note 26); *Calmar*, 854 F.2d at 463–64 (citing *McCullough*, 331 U.S. at 98, a case concerning an equitable accounting, not a damages trial); *Callaway Golf*, 576 F.3d at 1337 (no discussion or authority cited); *Special Devices*, 269 F.3d at 1343 n.2 (same); *see also Furminator, Inc. v. Kim Laube & Co.*, 410 Fed. Appx. 340, 341 (Fed. Cir. 2011) (unpublished) (citing *Calmar*, 854 F.2d at 463–64, *supra*); *Randall May Int’l, Inc. v. DEG Music Prods., Inc.*, 378 Fed. Appx. 989, 993 (Fed. Cir. 2010) (unpublished) (citing *Callaway Golf*, *supra*); *Respironics, Inc. v. Invacare Corp.*, 303 Fed. Appx. 865, 869 (Fed. Cir. 2008) (unpublished) (citing *Cent. Admixture Pharmacy Servs.*, *supra*).

²⁸ Congress’s technical amendments to the appeal provision to account for the merger of law and equity and the establishment of this Court, *see supra* note 12, also do not show that Congress endorsed a particular interpretation of the statute. *See Helvering*, 309 U.S. at 120 n.7.

jurisdiction would be expanded. Because a jury trial on damages is not an accounting, this Court lacks jurisdiction and the appeals should be dismissed as premature.

II. ISSUE II: OUTSTANDING ISSUES OF WILLFULNESS MAKE A JUDGMENT NON-FINAL, DETERMINATION OF WILLFULNESS IS NOT AN ACCOUNTING, AND THIS COURT THEREFORE LACKS APPELLATE JURISDICTION

Neither party to these appeals contends that when a jury trial on willful infringement remains pending, the judgment of the District Court is a final decision. A final decision “ends the litigation on the merits and leaves nothing for the court to do but execute the judgment.” *Nystrom*, 339 F.3d at 1350 (quoting *Catlin v. United States*, 324 U.S. 229, 233 (1945)). Here, the District Court’s judgment is not final because the parties will still engage in discovery, pre-trial motion practice, and a jury trial (as well as post-trial briefing) on willfulness issues, including whether there was an objectively high risk that Pylon infringed (because the defenses it presented at trial were unreasonable), and whether Pylon knew or should have known about this risk. *See Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs.*, 682 F.3d 1003, 1006–08 (Fed. Cir. 2012); *see also National Presto Indus. Inc. v. West Bend Co.*, 76 F.3d 1185, 1192–93 (Fed. Cir. 1996) (rejecting the argument that willfulness is an equitable issue for the court to decide).

A finding of willfulness “is only relevant in determining whether enhanced damages are warranted.” *In re Seagate Tech., LLC*, 497 F.3d 1360, 1368 (Fed. Cir. 2007) (en banc). Judgments “where assessment of damages or awarding of other relief remains to be resolved have never been considered to be ‘final’ within the meaning of” the statute. *See Liberty Mutual Ins. Co. v. Wetzel*, 424 U.S. 737, 744 (1976). The determinations to fix Pylon’s liability for willful infringement are therefore unlike the determinations of costs and attorneys fees that are owed, which do not prevent a judgment from being final. *See, e.g., Johannsen*, 918 F.2d at 163–64.

A determination of willfulness—in this case, the determination of Pylon’s state of mind—is not an accounting. Pylon has not argued that a willfulness determination is an accounting.

To take appellate jurisdiction over this appeal pursuant to the second en banc issue, the Court must find either that a judgment rendered with willfulness outstanding is nonetheless final, or that a determination of willfulness is literally an “accounting,” as that word is used in Section 1292(c). Otherwise, Congress’s limited grant of interlocutory jurisdiction would be expanded. When the willfulness issue (and potential resulting enhancement of damages and other awards) remains pending, the litigation is not ended and there is more for the District Court to do than execute the judgment, so such a judgment is not final.

And because a determination of willfulness is not an accounting, this Court lacks jurisdiction and the appeals should be dismissed as premature.

CONCLUSION

For the reasons described above, neither a jury trial on damages, nor a jury trial on willful infringement so that the District Court can determine whether to enhance damages, is an “accounting” as described in Section 1292(c)(2).

It may be that, for the reasons the District Court described in its bifurcation order (A652, SA1), Congress should expand this Court’s jurisdiction to include cases final except for damages and willfulness issues. On the other hand, such an expansion would contradict the accumulated wisdom of the final judgment rule, and create years of delay for successful patent owners—the same kind of delay the predecessor statute to Section 1292(c) was enacted to avoid.²⁹ Neither Congress nor the Supreme Court (*see* 28 U.S.C. § 1292(e)) has acted to expand this Court’s jurisdiction to include cases final except for damages and willfulness issues, and under the current statute, this Court lacks jurisdiction over these appeals. The appeals should therefore be dismissed, and the case should be remanded to the District Court for further proceedings, including a jury trial on damages and willful infringement.

²⁹ Trial of damages and willfulness issues to a separate jury from that of trial on liability also raises Seventh Amendment concerns when factual determinations underlying the two sets of issues overlap.

Dated: September 17, 2012

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark A. Hannemann", is written over a horizontal line.

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ADDENDUM

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

ORDER

At Wilmington this 9th day of July, 2009, consistent with the memorandum opinion issued this same date;

IT IS ORDERED that defendant's motion to dismiss plaintiff's claims for false advertising under 15 U.S.C. § 1125(a)(1)(B) (D.I. 35) is granted.


United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

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MEMORANDUM OPINION

Dated: 7/9/09
Wilmington, Delaware


ROBINSON, District Judge

I. INTRODUCTION

Plaintiff, Robert Bosch, LLC ("Bosch"), brought suit against defendant, Pylon Manufacturing Corporation ("Pylon"), for patent infringement and false advertising. (D.I. 31 at ¶ 1) The complaint (D.I. 1) was filed on August 25, 2008 and amended (D.I. 31) March 20, 2009. On April 7, 2009, defendant filed this motion, pursuant to Federal Rule of Civil Procedure 12(b)(6), to dismiss plaintiff's false advertising claims filed under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B). (D.I. 35 at 1) The court has jurisdiction pursuant to 28 U.S.C §§ 1331 and 1338. (D.I. 31 at ¶ 1) For the reasons set forth below, the court will grant defendant's motion to dismiss the false advertising claims arising under section 43(a) of the Lanham Act.

II. BACKGROUND

Defendant "manufactures and sells windshield wiper blades under the Michelin brand name, including the Optimum, Radius and Symphony products." (D.I. 35 at 1) Plaintiff alleges that defendant's products infringe four of its patents, all of which are related to frameless windshield wiper blades.¹ (D.I. 31 at ¶¶ 2-9; D.I. 42 at 2) Additionally, plaintiff alleges that defendant has used and continues to use "false and misleading descriptions of fact and representations of fact, which in commercial advertising or promotion, misrepresent the nature, characteristics, and qualities of [d]efendant's and [p]laintiff's goods and commercial activities." (D.I. 31 at ¶ 13)

¹ Plaintiff has alleged infringement of U.S. Patent Nos. 6,292,974, 6,675,434, 6,944,905, and 6,978,512.

Plaintiff points to two purportedly false statements from defendant's website, www.pylonhq.com, which plaintiff alleges are likely to mislead the public into believing that Michelin products are new and novel, and were developed by defendant and not by plaintiff. (D.I. 31 at ¶ 13). The purportedly false statements alleged by plaintiff are:

[1] Michelin's expertise . . . has inspired the development of a high performance, frameless all-weather wiper blade with many innovative features and benefits, including . . . Advanced Frameless Design . . . and Integrated High-Downforce Spoiler.

[2] The latest Michelin wiper blades on the market are all new and improved . . . adding functional features such as spoilers for improved wiper performance.

(*Id.* (omissions in original))

III. STANDARD OF REVIEW

In reviewing a motion filed under Federal Rule of Civil Procedure 12(b)(6), the court must accept all factual allegations in a complaint as true and take them in the light most favorable to plaintiff. See *Christopher v. Harbury*, 536 U.S. 403, 406 (2002). A complaint must contain "a short and plain statement of the claim showing that the pleader is entitled to relief, in order to give the defendant fair notice of what the . . . claim is and the grounds upon which it rests." *Bell Atl. Corp. v. Twombly*, 550 U.S. 545, 554-55 (2007) (internal quotations omitted). A complaint does not need detailed factual allegations; however, "a plaintiff's obligation to provide the 'grounds' of his 'entitle[ment] to relief requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.'" *Id.* (alteration in original) (citation omitted). The "[f]actual allegations must be enough to raise a right to relief above the speculative level on the assumption that all of the complaint's allegations are true." *Id.*

The Supreme Court's *Twombly* formulation of the pleading standard can be summed up thus: "[S]tating...a claim requires a complaint with enough factual matter (taken as true) to suggest" the required element. This "does not impose a probability requirement at the pleading stage," but instead "simply calls for enough facts to raise a reasonable expectation that discovery will reveal evidence of" the necessary element.

Phillips v. County of Allegheny, 515 F.3d 224, 234 (3d. Cir. 2008) (citations omitted). In the context of false advertising claims arising under the Lanham Act, the complaint must include "sufficiently detailed allegations regarding the nature of the alleged falsehood to allow [defendant] to make a proper defense." *Max Daetwyler Corp. v. Input Graphics, Inc.*, 608 F. Supp. 1549, 1556 (E.D. Pa. 1985).

IV. DISCUSSION

Section 43(a) of the Lanham Act states, in pertinent part:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which - -

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a). To state a claim for false advertising, a plaintiff must plead facts alleging that the defendant made false or misleading statements or descriptions of fact in commercial advertising or promotion that "misrepresent[ed] the nature, characteristics, qualities, or geographic origin of his ... goods, services, or commercial activities." 15 U.S.C. § 1125(a)(1)(B). "Only statements of fact capable of being proven

false are actionable under the Lanham Act because, when personal opinions on nonverifiable matters are given, the recipient is likely to assume only that the communicator believes the statements, not that the statement is true." *Parker v. Leam Skills Corp.*, 530 F. Supp. 2d 661, 679 (D. Del. 2008) (citations omitted).

"[M]isdescriptions or false representations of specific characteristics of a product," which are actionable under the Lanham act, are distinguished from puffery, which is not actionable. *Castrol, Inc. v. Pennzoil Co.*, 987 F.2d 939, 945 (3d Cir. 1993). *Castrol* defined puffery as "exaggeration or overstatement expressed in broad, vague and commendatory language." *Id.*

Plaintiff has pointed to two allegedly false advertisements which are specific enough to allow defendant to make a proper defense.² (See *supra* p. 2; D.I. 31 at ¶ 13) Essentially, plaintiff claims that the statements "new and improved," "innovative" and "development" constitute false advertising because it developed the technology and, therefore, defendant did not develop the products and the products cannot be "new and improved" or "innovative." (*Id.*)

Plaintiff's first claim for false advertising boils down to defendant's advertisement that it **developed** a "frameless all-weather wiper blade" and, by implication, Bosch did

² Although plaintiff points to two specific instances of purportedly false advertising, plaintiff took these statements out of context and omitted relevant language. Because plaintiff's claims are based on defendant's website, www.pylonhq.com (D.I. 35, ex. 1), and plaintiff does not question the authenticity of the attached exhibit, the court will consider the entire exhibit when deciding whether to grant the motion to dismiss. See *Pension Benefit Guaranty Corp. v. White Consolidated Industries, Inc.*, 998 F.2d 1192, 1196 (3d Cir. 1993) ("a court may consider an undisputedly authentic document that a defendant attaches as an exhibit to a motion to dismiss if the plaintiff's claims are based on the document").

not develop the said frameless wiper blade.³ (D.I. 31 at 4) This court, and other courts, have found that “false attribution of the authorship” of an invention or innovation is not an actionable false advertisement under § 43(a) of the Lanham Act.⁴ *Baden Sports, Inc. v. Molten USA, Inc.*, 556 F.3d 1300 (Fed. Cir. 2009);⁵ see *Monsanto Company v. Syngenta Seeds, Inc.*, 443 F. Supp. 2d 648, 653 (D. Del. 2006).⁶ Therefore, plaintiff

³ The full text of the alleged false advertisement reads:

Michelin's expertise in creating a rubber compound that allows your tires to grip the road in all kinds of weather has inspired the development of a high performance, frameless all-weather wiper blade with many innovative features and benefits, including:

....

(D.I. 35, ex. 1) The advertisement goes on to list about six of Michelin's supposedly innovative and beneficial features, including “Advanced Frameless Design” and “Integrated High-Downforce Spoiler.” (*Id.*) Although defendant asserts that plaintiff's selection of text is substantively different than the text of the advertisement in context, the distinction appears irrelevant to this motion as both the selected text and the full text include a statement which indicates that Pylon developed the frameless wiper blade.

⁴ Also, false advertising claims for false designation of authorship would create an overlap between the Lanham and Patent Acts. See *Baden Sports, Inc. v. Molten USA, Inc.*, 556 F.3d 1300, 1307 (Fed. Cir. 2009) (citing *Sybersound Records Inc. v. UAV Corp.*, 517 F.3d 1137, 1144 (9th Cir. 2008)).

⁵ The Federal Circuit found that “false attribution of the authorship of [an] innovation” does not “go to the nature, characteristics, or qualities of the goods, and [is] therefore not actionable under section 43(a)(1)(B).” *Baden Sports*, 556 F.3d at 1308 (citing *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003); *Sybersound Records*, 517 F.3d at 1144). In *Baden Sports*, the defendant's alleged false advertisements were almost identical to the advertisements presented in this case. 556 F.3d at 1307-08. Plaintiff alleged that defendant falsely stated that it had “developed [the] technology” at issue, and that the product was “new” and “innovative.” *Id.* The court did not allow plaintiff to proceed with false advertising claims under 15 U.S.C. § 1125(a)(1)(B) based on the alleged “false attribution of authorship of [the] invention.” *Id.* at 1308.

⁶ In *Monsanto*, plaintiff alleged five separate false advertising claims, including defendant's statement that it had developed its own products which had actually been

has not stated a claim under the Lanham Act for false advertising related to Pylon's statement that it developed a frameless windshield wiper blade.

The basis of the second false advertisement claim can be condensed down to defendant's assertions that its wiper blades are "new and improved" and "innovative."⁷ (D.I. 31 at ¶ 13) In context, the alleged false advertisement does not constitute a claim for false advertisement because defendant merely puffs, independently from listing specific features of the wiper blades, that its wipers are "new and improved" and that some features of the blades are "innovative." (D.I. 31 at ¶ 13) "Improved" and "innovative" are certainly statements of puffery as both statements are opinions and

developed by the plaintiff. 443 F. Supp. 2d at 652. This court found that the above statement regarding the intellectual origin of the product was not "directed to the nature, characteristics or qualities" of the product and, therefore, granted plaintiff's motion to dismiss the false advertising claim arising under 15 U.S.C. § 1125(a)(1)(B). *Id.* at 652-53 (citing *Dastar*, 539 U.S. at 38) (quotation marks omitted). A claim for false advertising arising out of false attribution of authorship for invention or innovation fits more neatly under "reverse passing off," which is laid out by 15 U.S.C. § 1125(a)(1)(A). *Monsanto*, 443 F. Supp. 2d at 652-53. Reverse passing off claims relating to false attribution of authorship, "however styled, [are] barred by the language and holding of *Dastar*." *Id.*

⁷ According to plaintiff, the false advertisement at issues is: "The latest Michelin wiper blades on the market are all new and improved ... adding functional features such as spoilers for improved wiper performance." (D.I. 31 at ¶ 13) The full text of the advertisement from the website reads:

The latest Michelin blades on the market are all new and improved. Some of the features include improving the performance of the rubber compounds, converting all conventional blades to riveted construction for added strength and adding functional features such as spoilers for improved wiper performance. Other enhancements include additional or improved rubber coatings for quiet operation, packaging that is more descriptive and easier to open and improved connectors for easier installation and better performance for the life of the product.

(D.I. 35, ex. 1)

cannot be proved to be false. Although “new,” taken independently, seems to be closer to a statement of fact because it embodies the concept of chronology and time which can be scientifically proven, phrases like “new and improved” are classic puffery. See e.g., *Laitram Machinery, Inc. v. Camitech A/S*, 884 F. Supp. 1074, 1083 (E.D. La. 1995) (statement that machines are “new and improved” is certainly puffery); *Outdoor Technologies, Inc. v. Vinyl Visions, LLC*, 83 U.S.P.Q. 2d 1418, 2006 WL 2849782, at *4 (S.D. Ohio 2006) (“phrases such as ‘best,’ ‘new and improved,’ or ‘redesigned and improved’” have all been held to be puffery). Plaintiff has not stated a claim under the Lanham act for defendant’s advertisements that its product was “new and improved” and “innovative.”

V. CONCLUSION

For the aforementioned reasons, defendant’s motion to dismiss plaintiff’s claims for false advertising under 15 U.S.C. § 1125(a)(1)(B) is granted.

An appropriate order will issue.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

MEMORANDUM ORDER

At Wilmington this 19th day of October, 2009, having reviewed the papers submitted by the parties regarding various pending motions;

IT IS ORDERED that:

1. **Bosch's motion for reconsideration.** Plaintiff Robert Bosch LLC ("Bosch") contends that my reliance on the Federal Circuit's analysis in *Baden Sports, Inc. v. Molten USA, Inc.*, 556 F.3d 1300 (Fed. Cir. 2009), constitutes a "manifest error of law" justifying reinstatement of its Lanham Act claim. Certainly a "manifest error of law" is grounds for reconsideration. However, I remain unconvinced that the dismissal of Bosch's Lanham Act claim was manifestly erroneous.

a. In its first amended complaint, Bosch alleges that defendant Pylon Manufacturing Corporation ("Pylon") used, "in commercial advertising or promotion," "false or misleading representations of fact" concerning "the nature, characteristics, [or] qualities . . . of [its] . . . commercial activities," in violation of section 43(a)(1)(B) of the

Lanham Act. More specifically, Pylon has allegedly asserted that “Michelin’s expertise . . . has inspired the development of a high performance, frameless all-weather wiper blade with many innovative features and benefits,” and that these wiper blades “are all new and improved . . . adding functional features such as spoilers for improved wiper performance.” (D.I. 31 at ¶ 13) Bosch has characterized the above assertions as false, that is, Pylon has falsely asserted “that it, not Bosch, developed the technology at issue here. That is a claim concerning Pylon and the Bosch corporate family’s respective commercial activities – for example, the two companies’ respective research, development, and engineering activities.” (D.I. 102 at 3)

b. According to Bosch, it (not its competitor, Pylon) developed the products at issue and any commercial representations of fact to the contrary are false. The Federal Circuit in *Baden* rejected Baden’s similar false advertising claims on the ground that Baden’s arguments “amount to an attempt to avoid the holding in *Dastar [Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003),]* by framing a claim based on false attribution of authorship as a misrepresentation of the nature, characteristics, and qualities of a good.” *Baden*, 556 F.3d at 1307 (emphasis added).

c. Bosch attempts to distinguish the *Baden* holding by asserting that its claim is directed to misrepresentations concerning Pylon’s “commercial activities,” not its “goods.” In support of this argument, Bosch cites two cases, *Proctor & Gamble Co. v. Haugen*, 222 F.3d 1262 (10th Cir. 2000), and *M&R Printing Equip., Inc. v. Anatol Equip. Manu. Co.*, 321 F. Supp. 2d 949 (N.D. Ill. 2004). These cases, however, are distinguishable on their facts, as the “false statements” at issue in both were clearly

directed to commercial activities, not to goods.¹ Indeed, it is not apparent to me that research, development and engineering activities that take place before a product reaches a commercial market should be considered “commercial” activities in the first instance. In the end, however, I conclude that Bosch’s attempt to distinguish between claiming credit for the activities leading to the development of a product and claiming credit for the product itself is a distinction without a difference.

d. For these reasons, I decline to reconsider my decision to grant Pylon’s motion to dismiss Bosch’s Lanham Act claim. Therefore, Bosch’s motion for reconsideration (D.I. 102) is denied.

2. Bosch’s motion for leave to amend. Bosch seeks permission to amend its complaint to add allegations of inequitable conduct, based on its assertion that one of the inventors of the Pylon ‘380 patent did not review the related application, but submitted an affidavit to the PTO that he had. Bosch asserts that its motion is not untimely because it was filed within two weeks of receiving the transcript from the inventor’s deposition. Bosch argues that the submission of a false affidavit to the PTO must be deemed material and, therefore, the proposed amendment is not futile and should be allowed.

¹In *Proctor & Gamble*, defendant had disseminated a message to the effect that the president of Proctor & Gamble was associated with the church of satan and that a large portion of the profits from certain marked goods “go to support his satanic church,” i.e., that its commercial activities were supporting an evil cause. 222 F.3d at 1268. Defendant in *M&R Printing* allegedly told M&R’s customers that M&R was bankrupt, i.e., its commercial activities would be ceasing. 321 F. Supp. 2d at 950.

a. While I agree that Bosch's motion to amend is timely and that the submission of a false affidavit to the PTO, regardless of its content, establishes at least a threshold level of materiality, I disagree that the proposed amendment passes muster under the Federal Circuit's holding in *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312 (Fed. Cir. 2009). More specifically, in *Exergen*, the Federal Circuit explained that,

although "knowledge" and "intent" may be averred generally, a pleading of inequitable conduct under Rule 9(b) must include sufficient allegations of underlying facts from which a court may reasonably infer that a specific individual (1) knew of the withheld material information or of the falsity of the material misrepresentation, and (2) **withheld or misrepresented this information with a specific intent to deceive the PTO.**

Id. at 1328-29 (emphasis added).

b. At this late stage of the proceedings, there is no allegation that the affiant at bar did not contribute to the invention, or that the application that matured into the '380 patent contains otherwise false representations. I certainly recognize that candor is the hallmark of the patent system and that false statements, about even ministerial acts, can have significance as to the survival of a patent in the review process. Nevertheless, I decline to allow an inequitable conduct claim to be pursued after the close of discovery when there are insufficient allegations of underlying facts from which I may reasonably infer that the material misrepresentation was made with a specific intent to deceive the PTO.

c. For the reasons stated, Bosch's motion for leave to amend (D.I. 125) is

denied.


United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC.,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

MEMORANDUM ORDER

At Wilmington this 30th day of March, 2010, having heard argument on, and having reviewed the papers submitted in connection with, the parties' proposed claim construction;

IT IS ORDERED that the disputed claim language of U.S. Patent Nos. 6,292,974 ("the '974 patent"), 6,675,434 ("the '434 patent"), 6,944,905 ("the '905 patent"), 6,978,512 ("the '512 patent") and 6,640,380 ("the '380 patent") shall be construed consistent with the tenets of claim construction set forth by the United States Court of Appeals for the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), as follows:

1. "[C]omponent:"¹ "A single- or multiple-part structure having a cross-section in the shape of a triangle or wedge." This construction is consistent with the claims as well as the specification. (col. 2:21-23; col. 3:33; col. 4:41) The court finds no support for defendant's proposed construction requiring the component to be "solid." Defendant also seeks to limit this construction according to one embodiment of the invention which

¹'974 patent, claim 1 (and dependent claims).

requires the component to have a hardness no greater than the hardness of the wiper strip. (col. 3:27-28) However, such an interpretation would render superfluous the hardness limitation of dependent claim 6, which requires that the component have “a hardness which is no greater than a hardness of said [] wiper strip.” Moreover, in its traversal of Ludwig, the patentee explained the hardness relationship of these two items, noting that the wiper strip and the component “can have different hardnesses, which on the other hand they must not necessarily have as well.” (D.I. 162 at JA00190-91)

2. “[M]ounted to said concave surface of said support element.”² “Secured to.” This construction is consistent with the claims as well as the specification. (col. 2:16-19; col. 2:29-30)

3. “[M]ounted directly to the convex surface of said support element.”³ “Secured directly to.” This construction is consistent with the claims as well as the specification. (col. 2:16-19; col. 2:29-30)

4. “[A] leading edge face.”⁴ “The surface of the component [forming an acute angle with the surface of the window] facing into the wind.” The parties generally agree that this limitation requires the surface of the component to face into the wind. The bracketed phrase, however, is contained in claim 1 and illuminates the construed phrase.

²’974 patent, claim 1 (and dependent claims).

³’974 patent, claim 1 (and dependent claims).

⁴’974 patent, claim 1 (and dependent claims).

5. “[W]herein said leading edge face is disposed on a face of said support element which faces away from the window.”⁵ Insofar as this phrase is unsupported by the specification and has no apparent plain meaning, it will not be construed.

6. “[W]herein each crosspiece disposed at the end sections of the two spring strips is provided with a covering cap.”⁶ “Crosspieces must be located at the terminal portions of the spring strips.” The construction is consistent with the specification of the ‘512 patent, which does not disclose an embodiment having crosspieces located other than at the terminal portions of the spring strips. It is likewise consistent with the prosecution history, in which the examiner rejected the claims of the ‘512 patent as anticipated by several prior art wiper blades having crosspieces disposed at the ends of the spring strips. (D.I. 165 at JA01077) The applicant did not traverse this rejection by noting that the crosspieces of the ‘512 patent could be disposed elsewhere along the spring strips. (*Id.* at JA01106) Nor can plaintiff convincingly invoke the doctrine of claim differentiation in its argument that dependent claim 4, which requires “at least one crosspiece . . . disposed at each end section[,]” mandates a broader interpretation of independent claim 1. *See Kraft Foods, Inc. v. Int’l Trading Co.*, 203 F.3d 1362, 1367-68 (Fed. Cir. 2000) (written description and prosecution history rebut any presumption arising from the doctrine of claim differentiation).

⁵974 patent, claim 2.

⁶‘512 patent, claim 1 (and dependent claims).

7. “[G]roove-like constrictions.”⁷ “A longitudinal groove wherein the lateral defining surface opposite the lower band surface of the spring strips is circular.” This construction is consistent with the only embodiments disclosed by the ‘512 patent. (col. 6:58-62; col. 7:24-25; col. 7:56-59) A construction requiring a circular lateral defining surface is supported by the prosecution history. During prosecution, the examiner rejected original claim 12 (now claim 9) under 35 U.S.C. § 112 as indefinite. (*Id.* at JA01077) In response, the applicant cited the description of the groove-like constrictions in Figure 6. (*Id.* at JA01106) With respect to Figure 6, the specification explains that “the two lateral defining surfaces of the constrictions are embodied spherically” (col. 6:16-19) Finally, spherical must be understood to mean circular, as the lateral surface cannot be spherical in cross section. (See D.I. 165 at JA01216)

8. “[A] wiper blade part.”⁸ Having an apparent plain meaning, no construction is necessary for this limitation. The parties do not dispute that this limitation is used interchangeably with “device piece.” There is no intrinsic support for defendant’s proposed construction that would require the wiper blade part to be “directly connected” to the support element. Defendant further proposes that the wiper blade part must be construed to connect to the “middle of the support element.” Such a construction, however, would render superfluous the portion of claim 13 which states that “the support element, **in its middle section**, includes a wiper blade part” (emphasis added)

⁷‘512 patent, claims 9 and 13.

⁸‘905 patent, claim 13.

9. “[W]ind deflection strip is disposed between and in contact with each respective end cap and the device piece.”⁹ This disputed phrase likewise has a plain meaning and requires no construction. Defendant’s proposed construction requiring the contact to be “constant, continuous and simultaneous” finds no support in the specification or the prosecution history.

10. “[B]ase body.”¹⁰ “The substantially plate-like section of the termination part.” This construction is consistent with the specification, which describes the base body as “plate-like” or “approximately plate-like.” (col. 3:28-30; col. 5:11-12; Figs. 3-5, 7, 9, 10)

11. “[B]racing itself on the wiper blade.”¹¹ “Supporting itself on both the support element and wiper strip.” Although claim 1 refers to bracing on both wiper strip (20) and support element (16), the inventive nature of the ‘434 patent, illuminated by the intrinsic record, does not require that such bracing be simultaneous. (See col. 1:52-2:17)

12. “[D]etent shoulder.”¹² “Part of a structure [support element or base body] that secures that structure to another.” This construction is consistent with the specification. (col. 4:39-45; Figs. 3-5)

⁹905 patent, claim 13.

¹⁰‘434 patent, claim 1 (and dependent claims).

¹¹‘434 patent, claim 1 (and dependent claims).

¹²‘434 patent, claims 1 (and dependent claims).

13. “[P]ointing toward the other end portion.”¹³ “Facing toward the other end portion.” This construction is consistent with the specification. (col. 5:21-25) The court rejects defendant’s proposal that the face be angled toward the other end portion. This construction would read out several embodiments in which the detent shoulders are positioned perpendicular to (and not angled toward) the other end portion. (Figs. 6, 8)

14. “[C]avities.”¹⁴ The language of claim 4 sufficiently describes the meaning of this limitation; further parsing would render this language superfluous.

15. “[P]rotrusions protruding;” “[A] protrusion protruding.”¹⁵ “Structure projecting from the support element.” This construction finds support in the specification (col. 7:21-26), which describes a manufacturing process whereby the support elements are cut out of a single wide spring band strip and subsequently separated from each other “by breaking the narrow connecting struts 400, as a result of which the protrusions 44 described in connection with FIG. 4 remain on each side of the support elements.” The construction flows from the plain and ordinary meaning of protrude: “to thrust forward” or “to cause to project.” Merriam-Webster Online Dictionary (2010). Defendant’s proposal that the structure must project “outwardly,” is unsupported by the intrinsic and extrinsic evidence of record.

16. “[L]ong sides;” “long sides of the support element.”¹⁶ “The longitudinal

¹³434 patent, claim 1 (and dependent claims).

¹⁴434 patent, claim 4.

¹⁵434 patent, claims 4 and 8.

¹⁶434 patent, claims 1, 4, 5, and 7.

side of the support element.” Defendant argues that this construction would encompass “sides” that are not “long,” and instead proposes a construction with reference to the longitudinal “edge” of the support element. Irrespective of the court’s disagreement with the logic of this argument, the ‘434 patent distinguishes between the long **sides** (claims 1, 4, 5, and 7) and the long **edges** (claim 11) of the support element.

17. “[H]ook legs:”¹⁷ “The portion of the hook-like extensions that cross the long side of the support element.” This construction finds support in the claims and the specification. (col. 4:32-34; 2:16-17)

18. “[D]etent tooth that protrudes from the long side of the support element.”¹⁸ “A protrusion, one surface of which defines a detent shoulder.” This construction is supported by the specification. While the specification describes the detent teeth of Figure 6 as having an angular structure (col 5:38-40), the court will not import the requirement that detent teeth have an angular structure based on one embodiment. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004).

19. “[R]ecess:”¹⁹ No construction is needed.

20. “[T]he face end of the support element.”²⁰ “A surface located at one end of the support element facing away from the other end.” This construction is consistent

¹⁷‘434 patent, claim 4.

¹⁸‘434 patent, claim 7.

¹⁹‘434 patent, claim 8.

²⁰‘434 patent, claim 8.

with the claims as well as the specification. (col. 2:39, Fig. 8) Defendant's proposed construction conflates the claimed "face end" with the '434 patent specification's reference to a "face end edge." While each "face end" has a terminal edge (col. 4:21-22), claim 8 explicitly refers only to the "face end."

21. "[I]nside wall:"²¹ "The wall of the termination part opposite the face end of the support element." This construction flows from the plain and ordinary meaning of the limitation. The court rejects defendant's proposed construction, which conflates the "face end" with the "face end edge," for the aforementioned reasons.

22. "[P]in passage:"²² "A passage constructed to couple the connector to a wiper arm pin without requiring the use of an adapter." This construction is consistent with the specification, which discusses the disadvantages of adaptors (col. 1:60-61) and explains that the connector of the present invention "permits coupling of a variety of wiper arms to a blade without requiring the use of adapters." (col. 4:37-39) Moreover, the specification does not describe an embodiment employing one. (See col. 1:56-64; col. 4:37-39)

23. "[T]ail space:"²³ "A space between the bridge and the rail." The parties do not dispute this construction.

24. "[F]orwardmost free end:"²⁴ "Forwardmost end of the rail, which is not

²¹'434 patent, claim 8.

²²'380 patent, claims 1, 23 and 24 (and dependent claims).

²³'380 patent, claims 1, 23 and 24 (and dependent claims).

²⁴'380 patent, claim 1 (and dependent claims).

connected to the central bridge.” The court rejects defendant’s proposal that construes the “forwardmost free end” as the “front end;” the front end of the rail does not equate to the claimed most forward end.

25. “[R]earward of said pin passage and said rivet passage.”²⁵ “Completely behind the pin and rivet passages.” This construction finds support in the specification. (See col. 6:43-49; 7:31-33) Defendant, by contrast, argues that the term “rearward of” must be construed to mean “behind the center of the circular hole of the pin and rivet passages.” The specification, however, repeatedly explains that “the forwardmost point of the tail rail is positioned entirely rearward of both the pin and rivet passages.” (col. 5:61-65; col. 7:13-20; col. 7:31-34) The figures demonstrate this relationship, as in each the forwardmost portion of the rail is positioned completely behind the rivet and pin passages. (Fig. 7, 8-13)

The prosecution history illuminates the meaning of this limitation. The examiner rejected the claims of the ‘380 patent as anticipated by Figure 5 of U.S. Patent No. 5,611,103 (“the Lee patent”). (D.I. 166, ex. 10 at JA1622) Figure 5 discloses a two passage connector with a rail which was segmented into three portions by the two passages. In their traversal, the applicants distinguished the invention of the ‘380 patent, noting that “the [] rail in Lee has segments that extend forward of both passages.” An inspection of Figure 5 reveals that the two rail segments forward of the passages are **entirely forward** in that no portion of the rail breaches the circumference of the passages’ rounded portions. Accordingly, the meaning of “rearwards” (relative to

²⁵ ‘380 patent, claims 1, 23 and 24 (and dependent claims).

the applicant's use of the term "forward") comports with the understanding that the invention of the '380 patent includes a rail located completely behind the passages.

Finally, extrinsic evidence in the form of inventor testimony confirms this understanding. Jerry Rosenstein, one of the named inventors of the '380 patent, testified at this deposition that "[t]he claim says that the forwardmost end of the rail . . . is behind the rivet passage" (D.I. 161, ex. C at 206:25-207:3)

26. "[R]ail-free hook insertion space:"²⁶ "A space without a rail, defined as the area that is directly below the bridge, forward of the pin passage, and directly between the side walls." This construction is consistent with the specification and, specifically, with all of the disclosed embodiments of the '380 patent. (col. 4:15-37) Moreover, the claim language explicitly identifies the bridge, pin passage and side walls as the boundaries that define this space.

27. "[C]avity:"²⁷ "A void in a wing's outer surface adjacent to a locking tab, which accommodates outward displacement and deflection of the locking tab." This construction is supported by the specification. (See col. 6:58-64)

28. "[E]ngagement tab:"²⁸ "A locking tab or structure on the inside surface of the side walls that assists in the coupling of a hook arm to the connector." This construction finds support in the specification. (See col. 4:15-30) The court rejects plaintiff's proposed construction, which seeks to conflate additional language from the

²⁶'380 patent, claim 1 (and dependent claims).

²⁷'380 patent, claims 9 and 23.

²⁸'380 patent, claims 9 and 23.

claims into this limitation, i.e., requiring that the locking tab (1) extend inwardly from the wing, (2) be partially formed by a cut-out in the wing, and (3) whose outward displacement and deflection is accommodated by a cavity in the wing.

29. "[O]utward lateral extent:"²⁹ "The outer wing surface." This construction is consistent with the claims and the specification. (See col. 8:47-51; col. 10:52-55)


United States District Judge

²⁹380 patent, claims 9 and 23.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC.,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

O R D E R

At Wilmington this 30th day of March 2010, consistent with the memorandum opinion issued this same date;

IT IS ORDERED that:

1. Bosch LLC's motion for summary judgment of infringement of the '974 patent (D.I. 169) is granted in part, to wit:

- a. Bosch LLC's motion is granted as to claims 1 and 8.
- b. Bosch LLC's motion is denied as to claim 2.

2. Bosch LLC's motion for summary judgment of noninfringement of the '380 patent (D.I. 171) is granted.

3. Bosch LLC's motion for summary judgment of no inequitable conduct and no invalidity for derivation with respect to the '974, '905, and '434 patents (D.I. 173) is granted in part, to wit:

- a. Bosch LLC's motion is granted as to the '905 and '434 patents.
- b. Bosch LLC's motion is denied as to the '974 patent.

4. Pylon's motion for summary judgment of noninfringement with respect to the

'974, '905, '434, and '512 patents, as well as that the '974 and '512 patents are invalid as anticipated or obvious (D.I. 177), is granted in part, to wit:

a. Pylon's motion with respect to the noninfringement of the '512 patent is granted.

b. Pylon's motion with respect to the noninfringement of the '974, '905, and '434 patents is denied.

c. Pylon's motion with respect to the invalidity of the '974 and '512 patents is denied.

5. Bosch LLC's motion to strike the expert report of Franz Buechele (D.I. 191) is denied as moot.


United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC.,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

David Ellis Moore, Esquire and Richard L. Horwitz, Esquire of Potter Anderson & Corroon LLP, Wilmington, Delaware. Counsel for Plaintiff and Counterclaim Defendant. Of Counsel: Michael J. Lennon, Esquire, Mark A. Hannemann, Esquire, R. Scott Roe, Esquire, Susan A. Smith, Esquire and Jeffrey S. Ginsberg, Esquire of Kenyon & Kenyon LLP, New York, New York.

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MEMORANDUM OPINION

Dated: March 30, 2010
Wilmington, Delaware


ROBINSON, District Judge

I. INTRODUCTION

Plaintiff Robert Bosch LLC ("Bosch LLC") is the owner, by way of assignment from non-party parent Robert Bosch GmbH ("Bosch GmbH"), of U.S. Patent Nos. 6,292,974 ("the '974 patent"), 6,675,434 ("the '434 patent"), 6,944,905 ("the '905 patent") and 6,978,512 ("the '512 patent") (collectively, "the Bosch patents"). The Bosch patents are directed to improvements over conventional bracketed windshield wiper blades. In this patent infringement action,¹ Bosch LLC asserts that defendant Pylon Manufacturing Corp. ("Pylon") has infringed the Bosch patents through the manufacture and sale of various wiper blade products that embody the patented inventions. (D.I. 1) In its answer to Bosch LLC's complaint, Pylon asserts various affirmative defenses and counterclaims including, inter alia, the noninfringement and invalidity of the Bosch patents. (D.I. 56) The answer also contains allegations that Bosch LLC has infringed Pylon's U.S. Patent No. 6,640,380 ("the '380 patent"). (*Id.*)

Both sides have proffered meanings for the disputed claim terms and move for summary judgment. Bosch moves for summary judgment of: (1) infringement of the '974 patent; (2) noninfringement of the '380 patent; and (3) no inequitable conduct and no invalidity for derivation with respect to the '974, '905, and '434 patents. (D.I. 169; D.I. 171; D.I. 173) Pylon moves for summary judgment of noninfringement with respect to the Bosch patents, as well as that the '974 and '512 patents are invalid as anticipated or obvious. (D.I. 177) Bosch also moves concurrently to strike the report of Pylon's expert, Franz Buechele ("Buechele"). (D.I. 191) The court has jurisdiction pursuant to

¹Bosch LLC's false advertising claims against Pylon have been dismissed. (D.I. 91)

28 U.S.C. § 1338. For the reasons that follow, the court grants in part and denies in part the motions.

II. BACKGROUND

A. The Parties and the Technology at Issue

Bosch LLC is a limited liability company formed under the laws of the State of Delaware. (D.I. 61 at ¶ 2) Bosch LLC engages in a broad spectrum of business, including the manufacture and distribution of high-quality automotive technology. Pylon is a Delaware corporation with a principal place of business in Deerfield Beach, Florida. (D.I. 56, Counterclaims at ¶ 1) Pylon specializes in the design, manufacture and marketing of wiper blades.

Conventional bracketed wiper blades derive their name from the multiple levels of brackets, or “yokes,” that create numerous pressure points along the wiping element. These models were plagued by a streaking problem - one more pronounced in vehicles with a curved windshield - associated with a failure of the wiper blade superstructure to evenly distribute the pressure applied by the wiper arm. (D.I. 176, ex. 3 at 23:11-20) Recesses in the superstructure, which frequently became clogged by debris, ice and snow, further exacerbated the uneven distribution of pressure by exposing the wiper blade to increased rigidity. (*Id.* at 24:15-22)

Beam (bracketless) wiper blades substitute the support superstructure of the conventional wiper blade with a spring elastic support element. (D.I. 176, ex. 2 at 9:12-17) The spring elastic support element mitigates the streaking problem by maintaining an even distribution of pressure in spite of any changes in windshield curvature. (D.I.

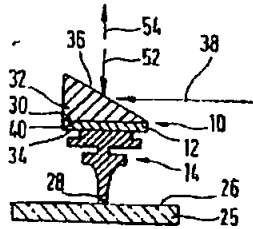
176, ex. 1 at 1:7-23) Beam blades have the additional advantages of a minimized profile and reduced noise levels during operation. (D.I. 176, ex. 2 at 17:25-18:7) However, while avoiding many of the problems that characterized the conventional superstructure blades, beam blades tend to "lift off" from the windshield at high speeds. (D.I. 176, ex. 1 at 1:24-46)

The Bosch patents have refined several aspects of beam blade technology, resulting in wiper blades that allow for better performance, visibility and safety on the road. The '974 patent, entitled "Glass Wiper Blade For Motor Vehicles," teaches a beam blade that prevents "lift-off" issues by deflecting wind up and over the blade through the use of a flexible spoiler on top of the support element. This deflection counteracts any "lift-off" tendency by creating additional downward force along the length of the wiper blade at higher speeds. ('974 patent at col. 1:58-2:3, 2:11-15)

Claim 1, which is representative of the invention of the '974 patent, claims:

[a] wiper blade for windows of motor vehicles, comprising a curved, band-shaped, spring-elastic support element which distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes; an elongated rubber-elastic wiper strip placeable on a window to be wiped and mounted to said concave surface of said support element which faces the window, substantially longitudinally parallel to said concave surface; a connection device provided for a wiper arm and arranged directly on a convex side of said support element; and a component which is separate from said wiper strip and is mounted directly to the convex surface of said support element so as to form a leading-edge face extending in a longitudinal direction of the support element and forming, as seen crosswise to its longitudinal extension, an acute angle with a plane which extends parallel to a plane formed by said convex surface.

Figure 3 of the '974 patent discloses the cross section of an exemplary wiper blade:



The subject matter of the '434 patent, entitled "Wiper Blade For The Glass Surfaces Of Motor Vehicles With An Elongated, Spring-Elastic Support Element," addresses innovations with respect to wiper blade end caps. End caps serve a safety function, preventing injury to those who handle the wiper blades by covering the often sharp ends of the support element. ('434 patent at col. 1:63-65) However, end caps can adversely affect the elasticity of the spring element which, in turn, disrupts the wiper strip's even distribution of pressure upon the windshield. (*Id.* at col. 1:46-50) The '434 patent discloses end caps that are used to maintain the integrity of the wiper blade without adversely affecting the elasticity of the beam. (*Id.*) Claim 1 claims

[a] wiper blade for windows or other glass of motor vehicles, having an elongated, spring-elastic support element, on whose side toward the window or glass an elongated, rubber-elastic wiper strip that can be placed against the window or glass is located parallel to the longitudinal axis, and on the side of the support element remote from the window or glass, in the middle portion of the support element, a device for attaching a driven wiper arm is disposed, the **two ends of the wiper blade each being covered** by a respective termination part in the region of the support element, characterized in that the termination part has a base body, located on the side of the support element remote from the window and bracing itself on the wiper blade, which base body is provided with hook-like extensions that cross the support element on both of its long sides and engage the side of the support element toward the window from behind; that at least one **detent shoulder** pointing toward the other end portion is disposed on each of the two end portions of the support element, and a counterpart shoulder present on the termination part is associated with the detent shoulder; and that at least one of the two shoulders and/or at least one of the two extensions is

elastically deflectable.

(emphasis added)

The '905 patent is entitled "Wiper Blade For Cleaning Screens In Particular On Motor Vehicles." Although existing separately from the '974 patent family, the '905 patent discloses the structure of a spoiler that could be used in conjunction with the invention of the '974 patent. The spoiler taught by the '905 patent includes two diverging legs, with an attack surface embodied on the outside of one leg, allowing for a reduction in both weight and material costs. ('905 patent at col. 1:55-64) An exemplary claim of the '905 patent reads:

1. A wiper blade for cleaning windows, comprising:

a band-like, elongated, spring-elastic support element, wherein a lower band surface of the support element oriented toward the window has an elongated, rubber-elastic wiper strip, disposed on it so that the longitudinal axes of these two parts are parallel, wherein the wiper strip can be placed against a window, and wherein an upper band surface of the support element has a **wind deflection strip** disposed on it, which extends in the longitudinal direction of the support element, is provided with an attack surface oriented toward the main flow of the relative wind, and is made of an elastic material, wherein the wind deflection strip has **two diverging legs**, viewed in transverse cross section, wherein the two diverging legs are connected to each other at a common base and wherein free ends of the two diverging legs oriented toward the window are supported on the support element of the wiper blade, and the attack surface is embodied on the outside of the one leg above the support element, and the legs form therebetween an angular hollow space that expands from an upper narrowest point of the base downwardly to the upper band surface of the support element and are in contact with the upper band surface of the support element said legs contacting the upper band surface at a location laterally spaced from said rubber-elastic wiper strip.

(emphasis added) The '905 patent also describes wiper blades that incorporate end caps. (col. 7:60-8:21)

The '512 patent, titled "Wiper Blade For Cleaning Vehicle Windows," describes

and claims a beam blade characterized by a support element consisting of two band-like spring strips that are connected by at least two welded crosspieces. ('512 patent at col. 1:42-63) The dual band configuration avoids the adverse elasticity effects associated with the use of a single band, while facilitating component installation. (*Id.* at col. 1:26-38) It is further specified that any such welded crosspieces disposed at the end sections of the beam should be covered by an end cap, preferably made of plastic. (*Id.* at col. 2:32-35) Exemplary claim 1 is directed to

[a] wiper blade for windows of motor vehicles, having an elongated, rubber-elastic wiper strip, which can be placed against the window and is connected to an elongated, spring-elastic support element so that their longitudinal axes are parallel, which support element is directly connected to a device for connecting the wiper blade to a driven wiper arm, wherein the support element has two band-like spring strips, which are situated in a plane that is disposed in front of the window, essentially parallel to the window, and whose, lower band surfaces are oriented toward the window and whose adjacent, inner longitudinal edges, which are disposed spaced a distance apart from each other, each protrude into a respective longitudinal groove, which grooves are associated with each longitudinal edge and are each open toward a respective longitudinal side of the wiper strip, and these two spring strips are connected to each other by at least two crosspieces disposed spaced apart from each other in the longitudinal direction, wherein each crosspiece has a middle section which extends spaced a distance apart from the upper band surfaces of the spring strips, producing bridge-like crosspieces defining a bridgewidth, where the distance between the two longitudinal strips is less than the bridge width, wherein the crosspieces are attached to the upper band surfaces of the two spring strips, wherein the crosspieces are welded to the two spring strips, so that the wiper strip from an end of the support element is insertable linearly between the longitudinal edges of the spring strips facing one another, and wherein each crosspiece disposed at the end sections of the two spring strips is provided with a covering cap preferably made of plastic.

Pylon's '380 patent, entitled "Wiper Blade Connector," is directed to a connector for coupling various types of wiper blades to the wiper arm of a motor vehicle. Wiper

arms have a variety of configurations; the connector of the '380 patent facilitates the coupling of, e.g., pin and hook-type wiper arms. ('380 patent at col. 1:9-20, 2:38-41)

Representative claim 1 claims

[a] connector for connecting a wiper blade assembly to a wiper arm, said connector comprising:

- first and second side walls spaced from one another;
- a central bridge interconnecting said first and second side walls, said central bridge and first and second side walls defining a pin passage and a rivet passage; and
- a rail interconnecting said first and second side walls and vertically spaced from said central bridge to define a tail space between said bridge and said rail, said rail having a forwardmost free end positioned rearward of said pin passage and said rivet passage to define a rail-free hook insertion space below said bridge, forward of said pin passage, and between said side walls.

B. Activities Leading Up to the Filing of the Bosch Patents

1. Variflex

Adriaan Swanepoel ("Swanepoel"), a South African engineer, conceived of the "Variflex" bracketless wiper blade in the late 1980s. (D.I. 176, ex. 35 at 17:15-19:18) Unlike earlier incarnations, the Variflex blade tapered, in at least one dimension, away from the central connection device. (*Id.* at 90:1-18) In 1990, Swanepoel approached Anglo American Industrial Corporation ("AMIC") representatives Johannes Fehrser ("Fehrser") and Laurence Olivier ("Olivier") in an effort to develop and commercialize the Variflex blade. Fehrser, the CEO of an AMIC subsidiary, was charged with the responsibility of commercializing and marketing the Variflex project. (D.I. 176, ex. 36 at 22:13-21) Olivier was an AMIC executive who oversaw the business side of new technology developments. (D.I. 176, ex. 37 at 15:23-16:4)

Swanepoel's work vis-a-vis the Variflex blade culminated in several patents,

including U.S. Patent No. 5,325,564 ("the '564 patent"). In addition to improvements to the overall beam blade design, during 1990-1991, AMIC and Swanepoel allegedly considered beam blade peripherals, such as spoilers and end caps. (D.I. 207, ex. 1 at 24:8-13, ex. 2 at 20:20-21:14, ex. 3 at 20:19-24) Specifically, Pylon alleges that, in mid-1991, AMIC and Swanepoel sought to counteract the effects of "lift off." (D.I. 207, ex. 1 at 24:8-13, ex. 3 at 39:5-40:2) In connection with these efforts, Fehrsen and Swanepoel jointly and/or individually conceived of several prototype spoilers including: (1) a metal spoiler attached to the convex surface of the beam ("Spoiler to Beam"); (2) a rubber or elastomeric spoiler glued to the convex surface of the beam ("Triangular Spoiler"); and (3) an aerofoil built into the wiper strip such that the beam itself is inclined ("Inclined Beam"). (D.I. 207, ex. 1 at 35:18-36:11, 49:23-50:4, 52:25-54:6, ex. 2 at 33:8-34:1, see ex. 5 at 114:18-21) Correspondence between AMIC, Swanepoel and a South African patent attorney, dated April 9, 1992, references the possibility of filing patent applications to certain design concepts, including an application to "the use of a spoiler or aerofoil" on a beam wiper blade ("the Adams letter"). (D.I. 176, ex. 41 at 2-3) Fehrsen, Swanepoel and Olivier each testified that, prior to January 1992, AMIC and Swanepoel also considered the use of end caps to protect consumers from the sharp edges of the beam. (D.I. 207, ex. 1 at 57:6-58:2, ex. 2 at 34:5-13, ex. 3 at 65:24-66:9)

2. The AMIC/Bosch meetings

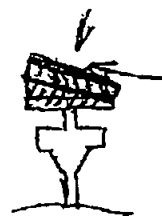
Concurrently, AMIC and Bosch GmbH engaged in a joint development proposal regarding the Variflex technology. The parties do not dispute that, during the initial discussions, AMIC provided Bosch GmbH with the results of high speed tests performed upon the Variflex blades. (D.I. 207, ex. 2 at 33:8-34:1) AMIC also supplied sample

blades to Bosch GmbH. (D.I. 176, ex. 35 at 27:8-18) These sample blades did not include any peripherals. (*Id.* at 29:7-14) The record demonstrates that the entities took part in several meetings during the early 1990s, with Fehrsen, Olivier and Swanepoel representing AMIC and Wilfred Merkel ("Merkel") and Wolfgang Leutsch ("Leutsch") representing Bosch GmbH. (D.I. 207, ex. 1 at 147:12-148:12, 170:13-22, ex. 3 at 54:2-55:6)

The parties' recollection of what transpired at these meetings diverges at the September 17, 1992 meeting ("the September meeting"). Pylon alleges it was at this meeting, between Fehrsen, Olivier, Merkel and Leutsch, and directed to the resolution of the "lift-off" issues, that Fehrsen disclosed the "Triangular Spoiler" and "Inclined Beam" solutions to Merkel and Leutsch. (D.I. 207, ex. 1 at 47:13-49:22, ex. 3 at 59:19-60:19, 62:9-63:14) Conversely, Bosch alleges that Merkel and Leutsch pitched the "Triangular Spoiler" idea, attributing only the "Inclined Beam" concept to Fehrsen. (D.I. 175, ex. 2 at 16:23-25; D.I. 176, ex. 39 at 23:13-23) The only documentary evidence regarding these disclosures is embodied in Fehrsen's meeting notes, depicted below, which diagram both solutions but do not attribute ownership of either concept. (D.I. 176, ex. 40)



"Triangular Spoiler"



"Inclined Beam"

The parties also dispute whether Fehrsen disclosed end caps to Bosch GmbH at the September meeting. Fehrsen and Olivier testified that, at this meeting, Fehrsen presented a sample beam blade with end caps. (D.I. 207, ex. 1 at 156:13-23, ex. 3 at 67:5-20) Bosch LLC denies these allegations. The allegedly disclosed end cap appears again in a jointly-prepared "Variflex terminology" diagram, which was prepared some seven months after the September meeting. (*Id.*, ex. 1 at 57:6-58:2, ex. 2 at 65:1-66:16; D.I. 243, ex. 85) Pylon also alleges that Thomas Kotlarski ("Kotlarski"), a Bosch employee and named inventor of the '434 patent, interfaced with Swanepoel and had access to this diagram as well as other AMIC files that pertained to the alleged disclosed end cap. (D.I. 207, ex. 1 at 84:8-16, ex. 2 at 36:5-37:5)

3. The Bosch patents

In October 1996, the business relationship between Bosch GmbH and AMIC formally ended. (D.I. 176, ex. 36 at 157:7-12) Bosch LLC alleges that Bosch GmbH continued to develop its own beam blade designs, and eventually filed the patent applications that resulted in, among others, the '974, '905 and '434 patents. In 1998, AMIC sold its interests in the Variflex technology to Trico Products Corporation ("Trico"), a competitor of Bosch GmbH.² (*Id.*, ex. 40) Bosch LLC does not dispute that it made several (unsuccessful) attempts to purchase or license beam blade technology from AMIC and then, after AMIC's transfer of intellectual property, from Trico. (D.I. 207, ex. 1 at 105:10-109:16) Fehrsen and Swanepoel subsequently left AMIC and joined Trico as

²The purchase agreement between AMIC and Trico includes a warranty by AMIC that Bosch GmbH had not made any use of the AMIC technology at issue. (*Id.* at ¶ 2.6) The purchase agreement further warranted that there was no joint development arising from the interaction between Bosch GmbH and AMIC. (*Id.* at ¶ 2.5)

consultants.³ (D.I. 176, ex. 36 at 117:190121:2, ex. 35 at 72:16-74:18)

After learning of Bosch GmbH's efforts to obtain patent protection, Trico requested that Fehrsen and Swanepoel memorialize their recollection regarding the conception of the spoiler and end cap technology, as well as the particulars regarding the joint development efforts between Bosch GmbH and AMIC. (D.I. 176, ex. 35 at 52:3-53:3, ex. 43 at 2) On July 12, 2001, Trico sent a letter to AMIC expressing its concerns regarding the subject matter of the pending patent applications.⁴ (D.I. 176, ex. 44) AMIC subsequently contacted Bosch LLC with respect to the contentions of Fehrsen and Swanepoel, to wit, that Fehrsen and Swanepoel were the sole inventors of, *inter alia*, the end cap and spoiler disclosed in the German counterparts to the '434 and '974 patents, respectively. (*Id.*, ex. 46) Bosch conducted an internal investigation in which it concluded that neither Fehrsen nor Swanepoel contributed to any of the subject matter found in these applications. (*Id.*, ex. 47, ex. 48) The Bosch patents do not list Fehrsen or Swanepoel among the named inventors.

C. The Accused Products

1. The accused Pylon products

Three versions of Pylon's beam blades, referred to as Generation 1, 2 and 3 beam blades, stand accused of infringing the Bosch patents. These wiper blades are marketed and sold under both the Toyota brand name and the Michelin brand name; the

³Swanepoel continues to provide consulting services to Trico. (D.I. 176, ex. 35 at 73:14-20)

⁴Specifically, Trico wrote to AMIC regarding the German counterparts to the '974 (DE 197 36 368) and '434 patents (DE 198 02 451).

Michelin brand name products are Optimum, Symphony, Radius, Weatherwise, and HydroEdge ("the Accused Pylon Products"). Pylon introduced the Generation 1 beam blade in 2006. (D.I. 175, ex. 13 at 37:24-38:4) According to Pylon's Engineering Manager David Frauman ("Frauman"), the Generation 1 beam blade consists of two beams, a spoiler, two end caps, a wiping strip and a mounting base, including a mounting base cover for connecting the wiper blade to the wiper arm. (*Id.*, ex. 14 at 49:2-5; ex. 7, 38:25-39:6, 98:2-3, 126:22-127:7) The Generation 2 beam blade, released in 2007, includes a single beam and modified end caps, which prevent the spoiler from sliding on the beam. (*Id.* at 90:8-91:5; 97:25-98:1) Pylon's Generation 3 beam blades, first sold in 2009, likewise have a single beam, but include a narrow longitudinal groove running along the center of the blade and a different end cap design. (*Id.* at 127:5-14, 130:20-131:3)

As a whole, the Accused Pylon Products have several similar characteristics. Each generation includes a beam, a triangular spoiler secured to a convex surface of a support element, two end caps, a wiping strip connected to a concave surface of a support element, and a mounting base for connecting the wiper blade to the wiper arm. (*Id.* at 38:25-39:6; ex. 3 at 296:11-297:15) A plastic beauty cover prevents exposure of the mounting base. The parties dispute whether the beauty cover also plays a role in connecting the wiper blade to a wiper arm, and whether it further prevents the spoiler from making any physical contact⁵ with the part that connects the wiper blade to a wiper

⁵Indeed, Pylon seemed acutely aware of the '905 patent, which requires that a section of the spoiler be disposed between, and in contact with, each respective end cap and the mounting base. ('905 patent at claim 13) An April 3, 2009 email from Pylon engineer Vambi Tolentino to Pylon's supplier cautioned that the supplied "spoiler

arm. (D.I. 178 at ¶¶ 22, 23; D.I. 198, ex. 57 at 117:23-118:5, ex. 60 at 26)

2. The accused Bosch product

Bosch LLC's U3 connector ("the U3 connector") is sold with certain Bosch Evolution brand wiper blades. The U3 connector allows the wiper blade to couple to one or more wiper arm types. The U3 connector has a semicircular cutout that requires a separate adapter to lockingly engage a wiper arm pin. (D.I. 175, ex. 3 at 187:16-19, ex. 26 at 346:17-348:3) This adapter is not part of the accused U3 connector. (D.I. 175, ex. 3 at 187:16-19)

III. STANDARD OF REVIEW

A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." *Horowitz v. Fed. Kemper Life Assurance Co.*, 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" *Matsushita*,

lengths do not leave a space with the cover. We are required to have a clearance between the cover & the spoiler to avoid patent infringement." (D.I. 198, ex 61)

475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will “view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion.” *Pa. Coal Ass’n v. Babbitt*, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

IV. DISCUSSION

A. Invalidity⁶

The standard of proof to establish the invalidity of a patent is “clear and convincing evidence.” *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1058 (Fed. Cir. 2004). In conjunction with this burden, the Federal Circuit has explained that,

[w]hen no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the

⁶Insofar as the court concludes *infra* that the Accused Pylon Products do not infringe the ‘512 patent, Pylon’s motion for summary judgment of invalidity with respect to the ‘512 patent is denied as moot. It is noteworthy, however, that the PTO considered all of the asserted prior art (DE 196 27 114, DE 196 27 115 and WO 98/50261), including the combinations of such proffered by Pylon, during prosecution of the ‘512 patent. (D.I. 165, ex. 7 at JA928, ex. 8 at JA1214-17)

level of skill in the art and whose duty it is to issue only valid patents.

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1304 (Fed. Cir. 2008) (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1359 (Fed. Cir. 1984)).

1. Anticipation

An anticipation inquiry involves two steps. First, the court must construe the claims of the patent in suit as a matter of law. See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998). Second, the finder of fact must compare the construed claims against the prior art. See *id.*

Proving a patent invalid by anticipation "requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation." *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (citations omitted). The Federal Circuit has stated that "[t]here must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). The elements of the prior art must be arranged or combined in the same manner as in the claim at issue, but the reference need not satisfy an ipsissimis verbis test. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. Mar. 26, 2009) (citations omitted). "In determining whether a patented invention is [explicitly] anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550,

1554 (Fed. Cir. 1995). The prosecution history and the prior art may be consulted “[i]f needed to impart clarity or avoid ambiguity” in ascertaining whether the invention is novel or was previously known in the art. *Id.* (internal citations omitted).

Pylon argues that the asserted claims of the '974 patent are invalid as anticipated by U.S. Patent No. 3,881,214 (“the '214 patent”).⁷ The '214 patent teaches a wiper blade comprised of a support element, a wiper strip and a metal backing strip combined with a rubber element. The metal backing strip/rubber element combination runs the length of the wiper blade along a channel formed by the support element. (D.I. 180, ex. 6) The '214 patent does not disclose the beam blade of the '974 patent. The expert report of Dr. Steven Dubowsky (“Dubowsky”), Bosch LLC’s expert, characterizes the inventions of the '214 and '974 patents as containing material differences. (D.I. 198, ex. 53) Specifically, Dubowsky opines that, instead of the beam blade of the '974 patent, the '214 patent teaches a wiper blade made of thermoplastic material comprising a “supporting structure” that has the function of a spring and includes recesses, the height of which decreases progressively from the center towards the distal ends of the wiping element, allowing the structure to deform during use and exert substantially uniform pressure on the window. (*Id.* at 11)

The parties’ experts also dispute the identity of the “curved, band-shaped spring-elastic support element” that “distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes” as claimed in the '974 patent. Pylon asserts that element 110 of the '214 patent meets this limitation. The

⁷The French equivalent of the '214 patent (FR 2 199 302) was considered during prosecution of the '974 patent. (D.I. 162, ex. 2 at 70, 83-95)

'214 patent teaches that element 110 accomplishes the function of "maintaining substantially undeformed the supporting structure 1 of the windshield wiper blade when the force applied onto the windshield wiper blade ceases, so that the latter, keeping always its original camber, is always in a position to accomplish its spring function." ('214 patent at col. 3:55-60) Dubowsky's deposition testimony, consistent with the specification of the '214 patent, argues that element 110 does not perform the pressure distribution function and is devoid of an initial curvature. (D.I. 198, ex. 55 at 311:5-314:9) Rather, Dubowsky submits that "supporting structure 1," provides the pressure distribution function. (*Id.* at 312:15-19) And while "supporting structure 1" could meet the "component" limitation⁸ of the '974 patent, a material issue of fact exists with respect to whether the same structure could simultaneously meet the "support element" limitation.

Moreover, the '214 patent does not disclose a connection device arranged directly on the convex side of the structure that Pylon argues meets the spring-elastic support element limitation of the '974 patent, i.e., element 110. ('274 patent at col. 2:12-14) The connection device is instead arranged directly on the "supporting structure 1." (*Id.* at col. 4:15-16)

Pylon has failed to carry the exceptional burden necessary to prevail on a motion for summary judgment of invalidity in which the PTO previously considered the only asserted prior art. See *PowerOasis*, 522 F.3d at 1304. For the aforementioned reasons, Pylon's motion for summary judgment of invalidity is denied to the extent that

⁸Bosch LLC's arguments that the '214 patent does not disclose a spoiler lack merit in light of the broadly construed "component" limitation.

the '214 patent does not anticipate the '974 patent.

2. Obviousness

“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.” 35 U.S.C. § 103(a). Obviousness is a question of law, which depends on several underlying factual inquiries.

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.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). “Because patents are presumed to be valid, see 35 U.S.C. § 282, an alleged infringer seeking to invalidate a patent on obviousness grounds must establish its obviousness by facts supported by clear and convincing evidence.” *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006) (citation omitted).

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 550 U.S. at 418. Likewise, a defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed. *Id.* at 418-19. The Supreme Court has emphasized the need for

courts to value “common sense” over “rigid preventative rules” in determining whether a motivation to combine existed. *Id.* at 419-20. “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420.

In addition to showing that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, a defendant must also demonstrate, by clear and convincing evidence, that “such a person would have had a reasonable expectation of success in doing so.” *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

Pylon argues that the asserted claims of the ‘974 patent are invalid as rendered obvious by (1) U.S. Patent No. 3,881,214 (“the ‘214 patent”), alone or in combination with U.S. Patent No. 5,325,564 (“the ‘564 patent”), and (2) rendered obvious in view of the ‘564 patent in combination with U.S. Patent No. 3,879,793 (“the ‘793 patent”). Pylon argues that, to the extent that the ‘214 patent fails to disclose any elements, these elements are taught by the ‘564 patent. Pylon argues alternatively that, treating the ‘564 patent as the primary reference and combining it with “component” of the ‘214 patent, one of ordinary skill would arrive at the claimed invention of claims 1, 2 and 8 of the ‘974 patent.

As an initial matter, Pylon has not demonstrated the presence of a motivation to combine the ‘214 patent and the ‘564 patent, based in common sense or otherwise. *KSR*, 550 U.S. at 418. The ‘564 patent teaches the basic elements of a beam blade. Pylon’s position is that the structure it identified as the “component” of the ‘214 patent

("supporting structure 1") may be combined with "spring backbone 10" of the '564 patent to address the lift-off problem solved by the '974 patent. (D.I. 180, ex. 9 at 4) As noted *supra*, the parties dispute the functionality of "supporting structure 1." Laboring under Dubowsky's characterization of "supporting structure 1," this would result in the combination of two pressure distribution elements; the court cannot comprehend any motivation that would lead one of ordinary skill in the art to combine two support elements.

Alternatively, Pylon argues that the '974 patent is rendered obvious by a combination of the '564 patent and the '793 patent. The '793 patent teaches a conventional wiper blade including a superstructure consisting of yokes and hinges. ('793 patent at col. 1:60-65, 2:39-45, Figs. 1, 3) The superstructure further includes "a primary yoke" in the shape of a triangular spoiler with a leading edge face that "forms an acute angle with respect to a plane extending substantially parallel to the surface to be wiped." (*Id.* at col. 3:55-57) Pylon argues that it would have been obvious to combine the beam blade of the '564 patent with the spoiler feature taught by the '793 patent "given the limited number of ways one of ordinary skill in the art would know to address the wind lift presented with the '564 patent." (D.I. 180, ex. 9 at 2)

The '793 patent notes that several "satisfactory" configurations exist for addressing the lift-off issue in conventional wiper blades, "including the use of fins or vanes, bifurcated tilting metal strip yokes, airfoils, and yokes pierced with a plurality of holes." ('793 patent at col. 1:23-26) Accordingly, significant issues of material fact exist with respect to whether the specific combination of a spoiler and beam blade was obvious to try. See *KSR*, 550 U.S. at 420. Specifically,

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Id.

Bosch LLC argues against the existence of any such common sense result, noting that if the lift-off issues with beam blades could be so easily solved, "it would not have taken decades to arrive at that structure." (D.I. 197 at 33) Moreover, Dubowsky opines that one of ordinary skill would have been concerned that the addition of a spoiler to the support element of a beam blade would undesirably increase the overall stiffness of the beam blade. (D.I. 235 at ¶ 21) In a related theory, Dubowsky submits that the '793 patent teaches away from the use of a separate spoiler in that

the anti-windlight configuration built into the superstructure [is] without the need for separate [spoiler] attachments commonly used in the past. The anti-windlift feature is provided by forming a ramp portion in the primary yoke and optionally in either or both of the secondary yokes

('793 patent at col. 3:48-55) Finally, Bosch LLC submits extensive evidence regarding secondary considerations of nonobviousness in connection with the '974 patent, including evidence of long felt need, commercial success and copying. While Bosch LLC must, as Pylon notes, demonstrate a nexus between the commercial success of its products and the invention of the '974 patent, *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988), it will have a chance to do so at trial. Indeed, several material issues preclude the grant of summary judgment of invalidity of the '974 patent. For these reasons, Pylon's motion is denied.

3. Derivation

“A person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented.” 35 U.S.C. § 102(f). Assertion of this subsection as a defense amounts to a claim that the patentee derived the invention from another. See *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993). A party bringing a claim for patent invalidity under 35 U.S.C. § 102(f) must demonstrate by clear and convincing evidence both conception of the invention by another and communication of the invention to the patentee. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997) (citing *Price*, 988 F.2d at 1190).

Conception is the “formation in the inventor’s mind of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (citations omitted). A conception must encompass all limitations of the claimed invention, and “is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.” *Singh v. Brake*, 317 F.3d 1334, 1340 (Fed. Cir. 2002) (citations omitted). Put differently, every limitation must be shown to have been known to the inventor at the time the invention is alleged to have been conceived. *Davis v. Reddy*, 620 F.2d 885, 889 (C.C.P.A. 1980) (citing *Schur v. Muller*, 372 F.2d 546, 551 (1967); *Anderson v. Anderson*, 403 F. Supp. 834, 846 (D. D.C. 1975)).

Upon the issuance of a patent, it is presumed that there are no inventors other than those listed on the patent. *Bd. of Educ. v. American Bioscience, Inc.*, 333 F.3d

1330, 1337 (Fed.Cir.2003). A party challenging this presumption must prove, by clear and convincing evidence, that it significantly contributed to the conception of the invention. *Id.* An inventor's testimony stating that he contributed to the conception at issue is not, by itself, enough to support a finding of inventorship. Such testimony must be corroborated by either contemporaneous documents, testimony of someone else or circumstantial evidence. *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1461 (Fed.Cir.1998). "Circumstantial evidence about the inventive process may also corroborate" the inventor's testimony. *Id.* (citing *Knorr v. Pearson*, 671 F.2d 1368).

Factors to be considered in assessing corroboration include:

(1) the relationship between the corroborating witness and the alleged prior user; (2) the time period between the event and trial; (3) the interest of the corroborating witness in the subject matter in suit; (4) contradiction or impeachment of the witness' testimony; (5) the extent and details of the corroborating testimony; (6) the witness' familiarity with the subject matter of the patented invention and the prior use; (7) probability that a prior use could occur considering the state of the art at the time; (8) impact of the invention on the industry, and the commercial value of its practice.

Woodland Trust v. Flowertree Nursery, 148 F.3d 1368, 1371 (Fed. Cir. 1998). "Whether the inventor's testimony has been sufficiently corroborated is evaluated under a 'rule of reason analysis,'" which requires that "an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the alleged inventor's story may be reached." *Ethicon* 135 F.3d at 1461 (quoting *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993)).

Bosch LLC advances two arguments in support of its motion for summary judgment that the '974, '905 and '434 patents are not invalid for derivation. As a procedural matter, Bosch LLC alleges that Pylon failed to properly plead its derivation

defense. Specifically, Bosch LLC alleges that the pleadings do not provide the requisite level of notice, and that prejudice will result if Pylon is allowed to maintain this defense. This argument is without merit. Federal Rule of Civil Procedure 8 ("Rule 8") requires a party to set forth affirmative defenses in a responsive pleading with a "short and plain statement." *McKesson Information Solutions, LLC v. Trizetto Group, Inc.*, 2005 WL 914776, at *1 (D. Del. April 20, 2005). A cursory review of Pylon's second amended answer reveals numerous instances that would put Bosch LLC on notice of both the existence and scope of Pylon's derivation defense. This notice is present in Pylon's (1) affirmative defense that the Bosch patents are invalid for failure to comply with the conditions of patentability set forth in 35 U.S.C. § 102; (2) affirmative defense that "one or more of [the Bosch patents] are invalid and unenforceable because the invention(s) were derived and/or misappropriated from the true inventors"; and (3) detailed allegations of the factual support for these defenses that span 10 pages in count III of its counterclaims. (D.I. 55 at 4, 6, 8-17)

Nor can the court agree with Bosch LLC's contentions that Pylon failed to act with reasonable diligence in asserting the derivation defense. The Third Circuit has held that Rule 8 requires an affirmative defense to be pled in the answer or "raised at the earliest practical moment thereafter." *Robinson v. Johnson*, 313 F.3d 128, 137 (3d Cir. 2002). Pylon learned of the Bosch GmbH/AMIC joint development efforts on or about May 5, 2009 pursuant to a subpoena served upon Trico. Pylon filed its second amended answer on May 22, 2009. This time line does not suggest a lack of diligence on Pylon's behalf.

Bosch LLC next attacks the merits of the derivation defense, arguing that Pylon

has not corroborated Fehrser's testimony and, accordingly, Pylon's defense is unsupported by clear and convincing evidence as a matter of law. Fehrser's testimony, standing by itself, cannot overcome the presumption that the Bosch patents identify the correct inventors. See *Price*, 988 F.2d at 1194. In recognition of this hurdle, the parties' arguments are primarily drawn to the characterization of Fehrser's notes from the September meeting, as well as the earlier Adams letter.

Because Fehrser's notes do not attribute the ownership of either solution, Bosch LLC argues that this evidence cannot corroborate his claims of inventorship. According to Bosch LLC, the only permissible inference arising from Fehrser's notes is that **someone** at the September meeting disclosed these ideas. Consistent with the uncertain ownership evinced by such an inference, the parties have offered conflicting testimony as to who actually conceived of the solutions depicted in Fehrser's notes. Merkel claims that he and Leutsch disclosed the Inclined Beam and Triangular Spoiler solutions, and that Fehrser merely copied them into his notes. Olivier's testimonial support of Fehrser's claim to the solutions displayed in his notes comports with the corroboration requirement.⁹

⁹Bosch LLC takes issue with Olivier's testimony as evidence of corroboration, citing to *Woodland Trust*. 148 F.3d at 1371. Specifically, Bosch LLC alleges that the close business relationship between Olivier and Fehrser, as well as Olivier's inability to recall, with exacting detail, a transaction that occurred seventeen years ago. First, any relationship between Olivier and Fehrser ended roughly a decade ago, and Olivier has no evident interest in this litigation. Moreover, the simple fact that Olivier needed to be refreshed by Fehrser's notes before testifying to Fehrser's disclosure does not, per se, render Olivier's testimony suspect.

While not inapposite to the corroboration analysis, these factors are less compelling due to the consistency between Olivier's testimony and the documentary evidence of record, including Fehrser's notes and the Adams letter. This treatment comports with *Woodland Trust*, in which the Federal Circuit explained that there is "a

Although conflicting testimony regarding inventorship can “create a genuine issue of material fact regarding the identity of the true inventor,” *Virginia Elec. & Lighting Corp. v. National Serv. Indus.*, 2000 WL 12729, at *6 (Fed. Cir. 2000), the inference that Fehrser conceived of the solutions depicted by his notes and communicated them to Merkel and Leutsch at the September meeting is supported by circumstantial evidence. *In re Jolley*, 308 F.3d 1317, 1325 (Fed. Cir. 2002) (explaining that “[c]orroboration may be established by sufficient circumstantial evidence of an independent nature”) (citations omitted). Notably, Bosch LLC’s earliest purported conception date for the ‘974 patent is April 23, 1996, postdating Fehrser’s notes by three and a half years. The Adams letter demonstrates that Fehrser and Olivier had considered the “lift-off” problem and were working to devise (or had already devised) a spoiler to counteract such issues. And while the Adams letter is necessarily vague in providing exact details regarding the spoiler, the sum of these pieces of circumstantial evidence supports the inference that Fehrser disclosed his ideas at the September meeting, which he later memorialized in his notes. These notes, which depict a Triangular Spoiler that is strikingly similar to Figure 3 of the ‘974 patent, permit a finding of corroboration for Fehrser’s testimony regarding his prior conception.

very heavy burden to be met by one challenging validity when **the only evidence is the oral testimony** of interested persons and their friends, particularly as to long-past events.” *Id.* (emphasis added).



"Triangular Spoiler"

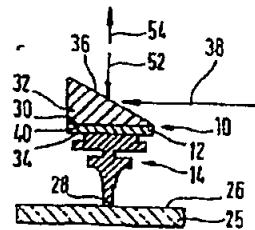


Fig. 3 of the '974 patent

Bosch LLC also questions the sufficiency of the disclosure of Fehrser's notes, arguing that, with respect to a prior conception, "courts require corroborating evidence of a contemporaneous disclosure that would enable one skilled in the art to make the invention." *Burroughs Wellcome Co. v. Barr Lab.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). In order to satisfy the enablement requirement, the disclosure must "teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1378 (Fed. Cir. 2009) (citations omitted). The determination of whether undue experimentation would be required to reduce an idea to practice is "reached by weighing many factual considerations." *Id.* (quoting *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). Resolving all facts in the light most favorable to Pylon, there are material issues of fact as to whether, upon viewing the solutions contained in Fehrser's notes, one of ordinary skill could arrive at the invention claimed by the '974 patent through the elementary task of gluing a triangular piece of rubber onto the top of a beam blade.

Pylon presents less compelling evidence of derivation with respect to the '905 and '434 patents. As noted above, the parties dispute whether, at the September meeting,

Fehrsen provided Bosch GmbH with a sample beam blade complete with end caps. Pylon proffers the Variflex terminology sheet, which was prepared several months after the meeting, as corroborative evidence for Fehrsen's claim that Bosch GmbH had access to a sample beam blade with end caps. Olivier's testimony comports with Fehrsen's claim. With respect to the diverging legs of the wind deflection strip required by the '905 patent, Pylon argues that such elements were well known in the art at the time of the meeting. (See U.S. Patent Nos. 3,088,155 and 3,881,214) However, Pylon fails to allege a conduit of communication between Fehrsen and the named inventors of the '905 patent, none of which were present at the September meeting. Irrespective of this lack of communication, Pylon also fails to compare the alleged disclosure to the limitations of the '905 patent. And while Pylon does proffer an attenuated route of communication through Kotlarski, a named inventor of the '434 patent, no evidence of record establishes that the end cap allegedly disclosed could enable the '434 patent. Specifically, Pylon does not identify a "detent shoulder" in the Variflex terminology sheet; nor do any of Pylon's witnesses testify to this effect. In view of such, Pylon's allegations regarding the derivation the '905 and '434 patents fail as a matter of law.

4. Inequitable Conduct

Applicants for patents and their legal representatives have a duty of candor, good faith, and honesty in their dealings with the United State Patent and Trademark Office ("PTO"). *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995); 37 C.F.R. § 1.56(a) (2003). The duty of candor, good faith, and honesty includes the duty to submit truthful information and the duty to disclose to the PTO information known to the patent applicants or their attorneys which is material to the examination of the patent

application. *Elk Corp. of Dallas v. GAF Bldg. Materials Corp.*, 168 F.3d 28, 30 (Fed. Cir. 1999). A breach of this duty constitutes inequitable conduct. *Mollins*, 48 F.3d at 1178. If it is established that a patent applicant engaged in inequitable conduct, then the patent application is rendered unenforceable. *Kingsdown Med. Consultants v. Hollister Inc.*, 863 F.2d 867, 877 (Fed. Cir. 1988).

In order to establish unenforceability based on inequitable conduct, a defendant must establish, by clear and convincing evidence, that: (1) the omitted or false information was material to patentability of the invention; or (2) the applicant had knowledge of the existence and materiality of the information; and (3) the applicant intended to deceive the PTO. *Mollins*, 48 F.3d at 1178. A determination of inequitable conduct, therefore, entails a two step analysis. First, the court must determine whether the withheld information meets a threshold level of materiality. A reference is considered material if there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. *Allied Colloids, Inc. v. American Cyanamid Co.*, 64 F.3d 1570, 1578 (Fed. Cir. 1995) (citations omitted). A reference, however, does not have to render the claimed invention unpatentable or invalid to be material. See *Merck v. Danbury Pharmacal*, 873 F.2d 1418 (Fed. Cir. 1989).

After determining that the applicant withheld material information, the court must then decide whether the applicant acted with the requisite level of intent to mislead the PTO. See *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1327 (Fed. Cir. 2009); *Baxter Int'l, Inc. V. McGaw Inc.*, 149 F.3d 1321, 1327 (Fed. Cir. 1998). "Intent to

deceive cannot be inferred solely from the fact that information was not disclosed; there must be a factual basis for finding a deceptive intent." *Herbert v. Lisle Corp.*, 99 F.3d 1109, 1116 (Fed. Cir. 1996). That is, "the involved conduct, viewed in light of all the evidence, including evidence indicative of good faith, must indicate sufficient culpability to require a finding of intent to deceive." *Kingsdown*, 863 F.2d at 876 (Fed. Cir. 1988). Evidence of specific intent must "be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement." *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008). A "smoking gun," however, is not required in order to establish an intent to deceive. See *Merck*, 873 F.2d at 1422.

Once materiality and intent to deceive have been established, the trial court must weigh them to determine whether the balance tips in favor of a conclusion of inequitable conduct. *N.V. Akzo v. E.I. DuPont de Nemours*, 810 F.2d 1148, 1153 (Fed. Cir. 1988). The showing of intent can be proportionally less when balanced against high materiality. *Id.* In contrast, the showing of intent must be proportionally greater when balanced against low materiality. *Id.*

Bosch argues that Pylon has elicited no evidence that would support any inference of specific intent to deceive the PTO with respect to the application for the '974 patent.¹⁰ However, "[a]n inference of intent to deceive is generally appropriate . . . when

¹⁰Insofar as Pylon has failed to meet its burden of demonstrating that no material issues of fact exist with respect to the derivation of the '905 and '434 patents, it has likewise failed to show that the inventors of these patents engaged in inequitable conduct in their interactions with the PTO. Pylon has not demonstrated that any other than the true inventors are listed on these patents and, accordingly, Pylon's inequitable conduct arguments regarding the '905 and '434 patents must fail due to the lack of an

(1) highly material information is withheld; (2) the applicant knew of the information [and] . . . knew or should have known of the materiality of the information; and (3) the applicant has not provided a credible explanation for the withholding.” *Praxair, Inc. v. ATMI, Inc.* 543 F.3d 1306, 1314 (Fed. Cir. 2008) (internal quotations and citations omitted). A failure to disclose the true inventorship of a patent is certainly a material omission. *See, e.g., Board of Education ex rel. Florida State University v. American Bioscience, Inc.*, 333 F.3d 1330, 1344 (Fed. Cir. 2003) (a patent applicant has a duty to assure that “only true inventors” are named in a patent application and that failure to do so may result in a finding of inequitable conduct); *Frank’s Casing Crew & Rental Tools, Inc. v. PMR Techs., Ltd.*, 292 F.3d 1363 (Fed. Cir. 2002) (holding a patent unenforceable due to inequitable conduct where two named inventors deliberately concealed a true inventor’s involvement in the conception of the invention and ‘engaged in a pattern of intentional conduct designed to deceive the attorneys and patent office as to who the true inventors were’).

Accordingly, viewing all the aforementioned evidence in the light most favorable to Pylon, there are genuine issues of material fact as to whether: (1) Fehrsen conceived of the subject matter claimed in the ‘974 patent; (2) Fehrsen disclosed it to Merkel and Leutsch; (3) Merkel and Leutsch committed a highly material omission by fraudulently representing to the PTO Fehrsen’s ideas as their own; and (4) Merkel and Leutsch intended to deceive the PTO by submitting false declarations in connection with the application that led to the ‘974 patent in which they claimed to be the original and first

alleged material omission. *See Gambro Lundia*, 110 F.3d at 1582.

inventors of the claimed subject matter. Moreover, a material issue of fact persists in whether intent to deceive the PTO is “the single most reasonable inference able to be drawn from the evidence to meet the clear and convincing standard. *Star Sci.*, 537 F.3d at 1366.

B. Infringement

A patent is infringed when a person “without authority makes, uses or sells any patented invention, within the United States . . . during the term of the patent.” 35 U.S.C. § 271(a). A two-step analysis is employed in making an infringement determination. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). First, the court must construe the asserted claims to ascertain their meaning and scope. *Id.* Construction of the claims is a question of law subject to de novo review. *See Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). The trier of fact must then compare the properly construed claims with the accused infringing product. *Markman*, 52 F.3d at 976. This second step is a question of fact. *See Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998).

“Direct infringement requires a party to perform each and every step or element of a claimed method or product.” *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1378 (Fed. Cir. 2007). “If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law.” *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). If an accused product does not infringe an independent claim, it also does not infringe any claim depending thereon. *See Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989). A

product that does not literally infringe a patent claim may still infringe under the doctrine of equivalents if the differences between an individual element of the claimed invention and an element of the accused product are insubstantial. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 24 (U.S. 1997). The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988) (citations omitted).

1. The '974 patent

Bosch has asserted that the Accused Pylon Products literally infringe claims 1, 2 and 8 of the '974 patent. The parties have filed cross-motions regarding infringement. (D.I. 169; D.I. 177) The court notes at the outset that a majority of Pylon's proposed constructions for the '974 patent were rejected during claim construction. Insofar as Pylon relies upon these rejected constructions, Pylon cannot prevail on its motion for summary judgment of noninfringement of the '974 patent. Accordingly, the relevant inquiry is whether Bosch LLC has carried its burden with respect to its cross-motion seeking summary judgement of infringement of the '974 patent.

a. "[A] curved, band-shaped, spring elastic support element which distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes

Pylon admits that the Accused Pylon Products include a curved, band-shaped, spring elastic support element which distributes the pressure applied by the wiper arm and has a concave and a convex surface which defines corresponding planes. (D.I. 175, ex. 16 at 20-21)

b. “[A]n elongated rubber-elastic wiper strip placeable on a window to be wiped and mounted to said concave surface of said support element which faces the window, substantially longitudinally parallel to said concave surface”

The Accused Pylon Products include a wiper strip that is positioned on a window and mounted to the concave surface of the support element that faces the window. (*Id.* at 22-23) Pylon further admits that each also has an elongated rubber-elastic wiper strip placeable on a window to be wiped which faces the window, substantially longitudinally parallel to the concave surface of the support element. (*Id.*)

By its order of the same date, the court has construed “mounted to” to mean “secured to.” Buechele testified that “[the Accused Pylon Products] include[] a wiper strip that is secured to a concave surface of a support element.” (D.I. 175, ex. 3 at 296:11-15) Irrespective of this admission, Pylon asserts that a threshold question exists with respect to both the meaning of the term “secured to,” as well as the propriety of its application to the Accused Pylon Products. Pylon alleges that the manner in which the wiper strip connects to the support element varies according to generation. Buechele testified that the Generation 1 wiper strip is linearly insertable into and out of a narrow space created by the two support elements and is “movable” but for the end caps, which hold the wiper strip in position. (D.I. 201, ex. 1 at 6-8) Buechele further describes the contact between the support element as a “mere touching” of the concave and convex surfaces by the wiper element. (*Id.*) Buechele applies similar reasoning and opines that because the wiper elements of Generation 2 and 3 are also movable, they are not “secured to” the support element within the meaning of the ‘974 patent. (*Id.*) Rather, Buechele concludes that the wiper blade is “merely on” the concave surface of the

support element. (*Id.*)

Pylon seeks to unreasonably limit the meaning of “secured to.” The prosecution history suggests simply that the wiper strip must be separate from the support element and “not merely on” it. (D.I. 162, ex. 2 at JA197) Requiring an “immovable” connection between the two elements would impermissibly limit the invention of the ‘974 patent to one preferred embodiment disclosed in Figure 3, as well as render superfluous dependent claim 3, which claims a “solidly joined” connection, and claim 5, which claims a “glued” connection. Even assuming that “secured to” contemplates a connection in which no movement is permitted in relation to the two objects, the court disagrees that the wiper blade is “merely on,” or even movable with respect to, the support element once the end caps are in place. It would be improper to consider the relationship of these two elements divorced from the functionality of the end caps. Accordingly, “secured to” properly encompasses a wiper strip linearly inserted into the support element and held in place by two end caps.

c. “[A] connection device provided for a wiper arm and arranged directly on a convex side of said support element”

Pylon admits that the Accused Pylon Products have a connection device provided for a wiper arm and arranged directly on the convex side of the support element. (D.I. 175, ex. 16 at 24-25)

d. “[A]nd a component which is separate from said wiper strip and is mounted directly to the convex surface of said support element so as to form a leading-edge face extending in a longitudinal direction of the support element and forming, as seen crosswise to its longitudinal extension, an acute angle with a plane which extends parallel to a plane formed by said convex surface”

All of the asserted claims of the '974 patent are directed to a wiper blade that comprises a "component." By its order of the same date, the court has construed "component" to mean "a single- or multiple-part structure having a cross-section in the shape of a triangle or wedge." Buechele acknowledges that the "component" of the '974 patent is a spoiler. (D.I. 175, ex. 3 at 253:6-10) He conceded at his deposition that the Accused Pylon Products each have a spoiler that is "generally triangular." (*Id.* at 296:19-21, 297:7-10) Accordingly, the Accused Pylon Products meet the "component" limitation.

Claims 1, 2 and 8 further require that the "component" be "mounted directly to the convex surface of [the] support element." The court has construed "mounted directly to" to mean "secured directly to." Frauman alleges that the components of the Accused Pylon Products contain claws that permit the component to be slidingly installed on and removed from the support element. (D.I. 181 at ¶ 6) According to Frauman, the end caps prevent the component from sliding off of the wiper blade. (*Id.*) Because the component is not permanently joined to the support element, Frauman opines that the Accused Pylon Products cannot meet this limitation. Consistent with this theory, Pylon submits that, if the bottom part of the groove were removed, the component would simply fall off. Retracting slightly from its position that only a permanent joinder can meet this limitation, Pylon argues alternatively that the "tongue-in-groove" construction present in the Accused Pylon Products does not allow the component to become directly secured to the wiper blade. Specifically, Pylon disputes that the "secured directly to" limitation can be met by the sliding engagement between the component and the wiper blade.

Pylon's allegations regarding the interaction between the component and the support element contemplate a separation of the two elements if the wiper blade is either disassembled (by removing the end caps) or broken (by disrupting the "tongue-in-groove" configuration). In this sense, Pylon is simply rearguing its position during claim construction that "mounted directly to" means "immovably secured to by gluing." And for the same reasons noted *supra* regarding "secured to," the court is not convinced by Pylon's allegations of ambiguity regarding the threshold of connectivity that must exist between two objects before one object may be properly described as "secured directly to" the other. No reasonable jury could conclude that one object is not "secured directly to" another if one must be disassembled or destroyed to separate the two.

Finally, Pylon does not dispute that the spoiler of the Accused Pylon Products includes a leading-edge face that faces into the wind and extends in a longitudinal direction of the support element. Nor does Pylon dispute that the leading-edge face forms an acute angle with a plane that extends parallel to a plane formed by the convex surface of the support element. (*Id.*, ex. 15 at 12-14)

e. "A wiper blade as defined in claim 1, wherein said leading-edge face is disposed on a face of said support element which faces away from the window"

The court was unable to glean the meaning of the additional limitation contained in dependent claim 2 and, accordingly, did not construe it. Consequently, summary judgment of infringement is denied with respect to this claim.

f. "A wiper blade as defined in claim 1, wherein said leading-edge face extends at least nearly over an entire length of the wiper blade."

Pylon does not dispute that, in each of the Accused Pylon Products, the leading-edge face extends at least nearly over the entire length of the wiper blade. (*Id.* at 14; ex. 17 at 4-5; ex. 30 at 1-3)

In sum, Pylon has failed to demonstrate existence of an issue of material fact with respect to infringement of claims 1 and 8 of the '974 patent. The Accused Pylon Products meet each limitation of these claims, and no reasonable juror could find otherwise. Accordingly, the court grants summary judgment that the Accused Pylon Products infringe claims 1 and 8 of the '974 patent.

2. The '434 patent

Bosch has asserted that all of the Accused Pylon Products literally infringe claim 1 and dependent claim 13 of the '434 patent, and that certain of the Accused Pylon Products literally infringe dependent claims 4, 5, 7 and 8. Because the court has rejected most of Pylon's proposed constructions for the disputed claim limitations of the '434 patent, Pylon cannot prevail in its motion for summary judgment of noninfringement of the '434 patent. The court briefly illustrates several issues of material fact in this regard.

a. "[B]racing itself on the wiper blade"

Claim 1 of the '434 patent claims a wiper blade comprising an end cap located on the support element and "bracing itself on the wiper blade." The court has construed this limitation to mean that the end cap is "supporting itself on both the support element and wiper strip." With respect to this limitation, Pylon asserts that "there is no dispute that none of the Accused Pylon Products have end caps that simultaneously brace

themselves on the support element and the wiper strip.” (D.I. 179 at 14) The court has rejected the notion that any such bracing by the end cap must be simultaneous; Pylon has failed to demonstrate that the Accused Pylon Products do not meet this limitation as a matter of law.

b. “[D]etent shoulder”

All of the asserted claims of the ‘434 patent recite a “detent shoulder,” which the court has construed to mean “part of a structure [support element or base body] that secures structure to another.” A reasonable jury could determine that this construction is broad enough to encompass the Accused Pylon Products, which engage and secure end caps through holes (Generation 1) or cut-outs (Generations 2 and 3) into the interior of the support element.

Pylon disputes that this limitation is met to the extent that the Accused Pylon Products “are merely practicing the prior art for end caps” (*Id.*) Pylon cites several patents¹¹ that allegedly demonstrate a nearly identical wiper blade/end cap configuration. Dubowsky has opined that material differences exist between the invention of the ‘434 patent and Pylon’s asserted patents. Irrespective of competing expert testimony in this regard, the Federal Circuit has made “unequivocally clear . . . that there is no ‘practicing the prior art’ defense to literal infringement.” *Tate Access Floors v. Interface Architectural Res.*, 279 F.3d 1357, 1365 (Fed. Cir. 2002) (citing *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1583 (Fed. Cir. 1995)).

¹¹The patents cited by Pylon include U.S. Patent Nos. 3,626,544, 5,493,750 and 3,785,002. The PTO considered each of these patents during examination of the ‘434 patent.

Indeed, “[l]iteral infringement exists if each of the limitations of the asserted claim(s) read on, that is, are found in, the accused device. Questions of obviousness in light of the prior art go to validity of the claims, not to whether an accused device infringes.” *Id.* at 1366.

On this record, the court cannot say that the Accused Pylon Products do not infringe the ‘434 patent as a matter of law. For the forgoing reasons, the court denies Pylon’s motion for summary judgment of noninfringement with respect to the ‘434 patent.

3. The ‘905 patent

Bosch has asserted that the Accused Pylon Products infringe claim 13 of the ‘905 patent literally or under the doctrine of equivalents. Claim 13 requires that “a section of the wind deflection strip” be “disposed between and in contact with” the end caps and device piece. The Accused Pylon Products each have a device piece that connects the wiper blade to the wiper arm. The parties’ dispute centers upon whether the plastic beauty cover that encloses the device piece interrupts whatever degree of continuity is required. It is Pylon’s position that the plastic beauty cover plays no role in connecting the wiper blade to a wiper arm. Dubowsky’s expert report comes to a contrary conclusion. (D.I. 198, ex. 60 at 25-28) Specifically, Dubowsky opines that the characterization of the beauty cover as a necessary extension of the device piece follows logically from its role in preventing vibration, as well as the accumulation of ice and snow in the device piece. Moreover, Dubowsky contends that, to the extent that the Accused Pylon Products contain a gap between the wind deflection strip and the device piece, any such gap is functionally insignificant. (*Id.*)

Pylon also argues that Bosch LLC is precluded from asserting infringement under

the doctrine of equivalents because the applicants of the '905 patent narrowed claim 13 during prosecution. (D.I. 179 at 21) In this regard, Pylon alleges that the applicants added the "in contact with" limitation to overcome prior art and, accordingly, surrendered all subject matter between the broader and narrower language. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (U.S. 2002). A thorough review of the prosecution history, however, reveals that the amendment adding the "in contact with" limitation was not made to overcome prior art, nor was it made as a prerequisite to patentability.¹² Consequently, the court will not entertain a presumption that, through this amendment, the applicants of the '434 patent have disclaimed subject matter. See *VDP Patent, LLC v. Welch Allyn Holdings, Inc.*, 623 F. Supp. 2d 364, 376 (S.D.N.Y. 2007).

At a minimum, issues of material fact exist with respect to the function of the beauty cover, as well as to whether or not it reads upon the aforementioned limitations of claim 13. Pylon's motion for summary judgment of noninfringement with respect to the '905 patent is denied.

4. The '512 patent

The Accused Pylon Products stand accused of infringing claims 1, 3, 8, 9 and 13 of the '512 patent. The '512 patent claims a beam blade characterized by a support element consisting of two band-like spring strips that are connected by at least two

¹²Indeed, the PTO twice allowed the original application claim that ultimately issued as claim 13 before the phrase "and in contact with" was added via examiner's amendment. (D.I. 164, ex. 6 at JA754, JA759, JA804-05) According to the examiner's amendment, the wind deflection strip was "set forth as in contact with the end cap and device piece to clarify the relationship of the end cap, deflective strip and device piece. (*Id.* at JA895)

welded crosspieces. Pursuant to the court's claim construction order, the limitation of claim 1 "wherein each crosspiece disposed at the end sections of the two spring strips" means that the "crosspieces must be located at the terminal portions of the spring strips."¹³ Bosch LLC does not dispute that the Accused Pylon Products do not have crosspieces on the ends of the spring strips. Accordingly, the Accused Pylon Products cannot meet this limitation of claim 1 as a matter of law. Because the remaining asserted claims of the '512 patent depend upon claim 1, Pylon's motion for summary judgment of noninfringement of the '512 patent is granted. *See Wahpeton*, 870 F.2d at 1553.

6. The '380 patent

Pylon has asserted that Bosch LLC's U3 connector literally infringes¹⁴ claims 1, 2, 9, 10, 23 and 24 of the '380 patent. Claims 1, 23 and 24 are independent claims; claims 2, 9 and 10 depend from claim 1. Because Pylon has failed to demonstrate the

¹³As explained in the court's claim construction order, the only embodiments disclosed by the '512 patent are characterized by crosspieces located at the terminal portions of the spring strips. This construction comports with the prosecution history, in which the examiner rejected the claims of the '512 patent in view of a prior art wiper blade which contained crosspieces located at the ends of the spring strips. The applicant did not traverse this rejection by noting that the crosspieces of the '512 patent could be located elsewhere. (D.I. 165 at JA01077)

¹⁴Pylon has also advanced the theory that the limitation "rearward of said pin passage and said rivet passage" is met by the U3 connector under a doctrine of equivalents analysis. The court is mindful of Bosch LLC's motion to strike the source of this theory, to wit, the supplemental expert report of Buechele. As explained in detail *infra*, because Pylon has failed to demonstrate a material issue of fact with respect to the presence of an additional limitation of the '380 patent, a doctrine of equivalents analysis will not prevent the grant of Bosch LLC's motion for summary judgment of noninfringement. Accordingly, the court denies the motion to strike as moot.

existence of a material issue of fact with respect to the presence of a "pin passage"¹⁵ in the U3 connector, the court grants Bosch's motion for summary judgment of noninfringement of the '380 patent.

i. "[P]in passage"

The term "pin passage" is recited by independent claims 1, 23 and 24 of the '380 patent. The court has construed this limitation to mean "a passage adapted to couple the connector to a wiper arm pin without requiring the use of an adapter." Pylon alleges that the existence of a genuine issue of material fact with respect to whether the U3 connector uses an "adapter" precludes the grant of summary judgment of noninfringement. Specifically, Pylon argues that Bosch LLC has admitted that the U3 connector does not require the use of an adapter to couple to the pin-type wiper arm. In support of this "admission," Pylon cites to the deposition testimony of Frank Katzenmeier ("Katzenmeier"), Bosch LLC's corporate representative assigned to the topic of the structure of the Evolution wiper blade. Katzenmeier testified as follows with respect to a Bosch-authored pamphlet regarding the Evolution wiper blade:

- Q. And then it reads: "No adapters required." Does that sort of speak for itself, that it is basically ready to be attached to a vehicle without the need of **additional** adapters?
- A. I would conclude that, yes. * * *
- Q. And there is also a statement that no adapters are required, so in other words, the Bosch Evolution would fit these hooks and pins without the need for an **additional** adapter? . . .
- A. The Bosch Evolution would fit if they have the below listed hook or pin sizes, that's correct.

¹⁵This limitation is present in each of the asserted claims of the '380 patent.

Q. Without an adapter? . . .

A. Without an **additional** adapter.

(D.I. 243, ex. 74 at 162:13-18, 165:14-166:5) (emphasis added) Contrary to Pylon's assertion of a clear admission that the U3 connectors do not require an adapter, all that the court can glean from this deposition is that the Evolution wiper blade does not require an **additional** adapter to couple the wiper blade to the wiper pin arm. This, of course, is irrelevant to a comparison of the U3 connector to the construed claims of the '380 patent.

Moreover, Pylon acknowledges that coupling requires placing the pin-type wiper arm into the semicircular passage of the U3 connector and "engaging the pin with a locking device that folds down on the connector." (D.I. 202 at 5) Pylon's "locking device" is part of the structure of the Evolution wiper blade and not the U3 connector itself. Accordingly, the parties do not seriously dispute that this "locking device" is required to couple the U3 connector to a pin-type arm. The opinion of Pylon's expert comports with this understanding; indeed, Buechele opined that an "adapter is needed so that the pin can be coupled to the wiper blade," the adapter "is not part of the U3 connector," and the semi-circular cut-out "does not couple the U3 connector to a pin-type [wiper] arm." (D.I. 175, ex. 3 at 186:13-25, 187:12-24) Pylon's characterization of this external mechanism (separate from the U3 connector and required to couple the U3 connector to a pin-type arm) as a "locking device" rather than an "adapter" cannot elicit a material issue of fact where none exists. The U3 connector does not contain the "pin passage" limitation of the '380 patent as a matter of law. In light of the forgoing, the

court grants Bosch LLC's motion for summary judgment of noninfringement of the '380 patent.

V. CONCLUSION

For the foregoing reasons, the court: (1) grants Bosch LLC's motion for summary judgment of infringement of the '974 patent (D.I. 169) with respect to claims 1 and 8 and denies it with respect to claim 2; (2) grants Bosch LLC's motion for summary judgment of noninfringement of the '380 patent (D.I. 171); (3) grants Bosch LLC's motion for summary judgment of no inequitable conduct and no invalidity for derivation (D.I. 173) with respect to the '905 and '434 patents and denies it with respect to the '974 patent; (4) grants Pylon's motion for summary judgment of noninfringement of the '512 patent (D.I. 177); (5) denies Pylon's motion for summary judgment of noninfringement of the '974, '905 and '434 patents (*Id.*); (6) denies Pylon's motion for summary judgment that the '974 and '512 patents are invalid as anticipated or obvious (D.I. 177); and (7) denies as moot Bosch LLC's motion to strike the expert report of Franz Buechele (D.I. 191). An appropriate order shall issue.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

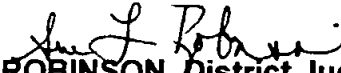
ROBERT BOSCH, LLC.,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

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****AMENDED MEMORANDUM OPINION**

Dated: April 12, 2010
Wilmington, Delaware


ROBINSON, District Judge

I. INTRODUCTION

Plaintiff Robert Bosch LLC ("Bosch LLC") is the owner, by way of assignment from non-party parent Robert Bosch GmbH ("Bosch GmbH"), of U.S. Patent Nos. 6,292,974 ("the '974 patent"), 6,675,434 ("the '434 patent"), 6,944,905 ("the '905 patent") and 6,978,512 ("the '512 patent") (collectively, "the Bosch patents"). The Bosch patents are directed to improvements over conventional bracketed windshield wiper blades. In this patent infringement action,¹ Bosch LLC asserts that defendant Pylon Manufacturing Corp. ("Pylon") has infringed the Bosch patents through the manufacture and sale of various wiper blade products that embody the patented inventions. (D.I. 1) In its answer to Bosch LLC's complaint, Pylon asserts various affirmative defenses and counterclaims including, inter alia, the noninfringement and invalidity of the Bosch patents. (D.I. 56) The answer also contains allegations that Bosch LLC has infringed Pylon's U.S. Patent No. 6,640,380 ("the '380 patent"). (*Id.*)

Both sides have proffered meanings for the disputed claim terms and move for summary judgment. Bosch moves for summary judgment of: (1) infringement of the '974 patent; (2) noninfringement of the '380 patent; and (3) no inequitable conduct and no invalidity for derivation with respect to the '974, '905, and '434 patents. (D.I. 169; D.I. 171; D.I. 173) Pylon moves for summary judgment of noninfringement with respect to the Bosch patents, as well as that the '974 and '512 patents are invalid as anticipated or obvious. (D.I. 177) Bosch also moves concurrently to strike the report of Pylon's expert, Franz Buechele ("Buechele"). (D.I. 191) The court has jurisdiction pursuant to

¹Bosch LLC's false advertising claims against Pylon have been dismissed. (D.I. 91)

28 U.S.C. § 1338. For the reasons that follow, the court grants in part and denies in part the motions.

II. BACKGROUND

A. The Parties and the Technology at Issue

Bosch LLC is a limited liability company formed under the laws of the State of Delaware. (D.I. 61 at ¶¶ 2) Bosch LLC engages in a broad spectrum of business, including the manufacture and distribution of high-quality automotive technology. Pylon is a Delaware corporation with a principal place of business in Deerfield Beach, Florida. (D.I. 56, Counterclaims at ¶¶ 1) Pylon specializes in the design, manufacture and marketing of wiper blades.

Conventional bracketed wiper blades derive their name from the multiple levels of brackets, or “yokes,” that create numerous pressure points along the wiping element. These models were plagued by a streaking problem - one more pronounced in vehicles with a curved windshield - associated with a failure of the wiper blade superstructure to evenly distribute the pressure applied by the wiper arm. (D.I. 176, ex. 3 at 23:11-20) Recesses in the superstructure, which frequently became clogged by debris, ice and snow, further exacerbated the uneven distribution of pressure by exposing the wiper blade to increased rigidity. (*Id.* at 24:15-22)

Beam (bracketless) wiper blades substitute the support superstructure of the conventional wiper blade with a spring elastic support element. (D.I. 176, ex. 2 at 9:12-17) The spring elastic support element mitigates the streaking problem by maintaining an even distribution of pressure in spite of any changes in windshield curvature. (D.I.

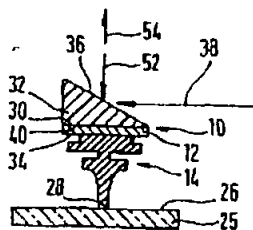
176, ex. 1 at 1:7-23) Beam blades have the additional advantages of a minimized profile and reduced noise levels during operation. (D.I. 176, ex. 2 at 17:25-18:7) However, while avoiding many of the problems that characterized the conventional superstructure blades, beam blades tend to “lift off” from the windshield at high speeds. (D.I. 176, ex. 1 at 1:24-46)

The Bosch patents have refined several aspects of beam blade technology, resulting in wiper blades that allow for better performance, visibility and safety on the road. The '974 patent, entitled “Glass Wiper Blade For Motor Vehicles,” teaches a beam blade that prevents “lift-off” issues by deflecting wind up and over the blade through the use of a flexible spoiler on top of the support element. This deflection counteracts any “lift-off” tendency by creating additional downward force along the length of the wiper blade at higher speeds. ('974 patent at col. 1:58-2:3, 2:11-15)

Claim 1, which is representative of the invention of the '974 patent, claims:

[a] wiper blade for windows of motor vehicles, comprising a curved, band-shaped, spring-elastic support element which distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes; an elongated rubber-elastic wiper strip placeable on a window to be wiped and mounted to said concave surface of said support element which faces the window, substantially longitudinally parallel to said concave surface; a connection device provided for a wiper arm and arranged directly on a convex side of said support element; and a component which is separate from said wiper strip and is mounted directly to the convex surface of said support element so as to form a leading-edge face extending in a longitudinal direction of the support element and forming, as seen crosswise to its longitudinal extension, an acute angle with a plane which extends parallel to a plane formed by said convex surface.

Figure 3 of the '974 patent discloses the cross section of an exemplary wiper blade:



The subject matter of the '434 patent, entitled "Wiper Blade For The Glass Surfaces Of Motor Vehicles With An Elongated, Spring-Elastic Support Element," addresses innovations with respect to wiper blade end caps. End caps serve a safety function, preventing injury to those who handle the wiper blades by covering the often sharp ends of the support element. ('434 patent at col. 1:63-65) However, end caps can adversely affect the elasticity of the spring element which, in turn, disrupts the wiper strip's even distribution of pressure upon the windshield. (*Id.* at col. 1:46-50) The '434 patent discloses end caps that are used to maintain the integrity of the wiper blade without adversely affecting the elasticity of the beam. (*Id.*) Claim 1 claims

[a] wiper blade for windows or other glass of motor vehicles, having an elongated, spring-elastic support element, on whose side toward the window or glass an elongated, rubber-elastic wiper strip that can be placed against the window or glass is located parallel to the longitudinal axis, and on the side of the support element remote from the window or glass, in the middle portion of the support element, a device for attaching a driven wiper arm is disposed, the **two ends of the wiper blade each being covered** by a respective termination part in the region of the support element, characterized in that the termination part has a base body, located on the side of the support element remote from the window and bracing itself on the wiper blade, which base body is provided with hook-like extensions that cross the support element on both of its long sides and engage the side of the support element toward the window from behind; that at least one **detent shoulder** pointing toward the other end portion is disposed on each of the two end portions of the support element, and a counterpart shoulder present on the termination part is associated with the detent shoulder; and that at least one of the two shoulders and/or at least one of the two extensions is

elastically deflectable.

(emphasis added)

The '905 patent is entitled "Wiper Blade For Cleaning Screens In Particular On Motor Vehicles." Although existing separately from the '974 patent family, the '905 patent discloses the structure of a spoiler that could be used in conjunction with the invention of the '974 patent. The spoiler taught by the '905 patent includes two diverging legs, with an attack surface embodied on the outside of one leg, allowing for a reduction in both weight and material costs. ('905 patent at col. 1:55-64) An exemplary claim of the '905 patent reads:

1. A wiper blade for cleaning windows, comprising:

a band-like, elongated, spring-elastic support element, wherein a lower band surface of the support element oriented toward the window has an elongated, rubber-elastic wiper strip, disposed on it so that the longitudinal axes of these two parts are parallel, wherein the wiper strip can be placed against a window, and wherein an upper band surface of the support element has a **wind deflection strip** disposed on it, which extends in the longitudinal direction of the support element, is provided with an attack surface oriented toward the main flow of the relative wind, and is made of an elastic material, wherein the wind deflection strip has **two diverging legs**, viewed in transverse cross section, wherein the two diverging legs are connected to each other at a common base and wherein free ends of the two diverging legs oriented toward the window are supported on the support element of the wiper blade, and the attack surface is embodied on the outside of the one leg above the support element, and the legs form therebetween an angular hollow space that expands from an upper narrowest point of the base downwardly to the upper band surface of the support element and are in contact with the upper band surface of the support element said legs contacting the upper band surface at a location laterally spaced from said rubber-elastic wiper strip.

(emphasis added) The '905 patent also describes wiper blades that incorporate end caps. (col. 7:60-8:21)

The '512 patent, titled "Wiper Blade For Cleaning Vehicle Windows," describes

and claims a beam blade characterized by a support element consisting of two band-like spring strips that are connected by at least two welded crosspieces. ('512 patent at col. 1:42-63) The dual band configuration avoids the adverse elasticity effects associated with the use of a single band, while facilitating component installation. (*Id.* at col. 1:26-38) It is further specified that any such welded crosspieces disposed at the end sections of the beam should be covered by an end cap, preferably made of plastic. (*Id.* at col. 2:32-35) Exemplary claim 1 is directed to

[a] wiper blade for windows of motor vehicles, having an elongated, rubber-elastic wiper strip, which can be placed against the window and is connected to an elongated, spring-elastic support element so that their longitudinal axes are parallel, which support element is directly connected to a device for connecting the wiper blade to a driven wiper arm, wherein the support element has two band-like spring strips, which are situated in a plane that is disposed in front of the window, essentially parallel to the window, and whose, lower band surfaces are oriented toward the window and whose adjacent, inner longitudinal edges, which are disposed spaced a distance apart from each other, each protrude into a respective longitudinal groove, which grooves are associated with each longitudinal edge and are each open toward a respective longitudinal side of the wiper strip, and these two spring strips are connected to each other by at least two crosspieces disposed spaced apart from each other in the longitudinal direction, wherein each crosspiece has a middle section which extends spaced a distance apart from the upper band surfaces of the spring strips, producing bridge-like crosspieces defining a bridgewidth, where the distance between the two longitudinal strips is less than the bridge width, wherein the crosspieces are attached to the upper band surfaces of the two spring strips, wherein the crosspieces are welded to the two spring strips, so that the wiper strip from an end of the support element is insertable linearly between the longitudinal edges of the spring strips facing one another, and wherein each crosspiece disposed at the end sections of the two spring strips is provided with a covering cap preferably made of plastic.

Pylon's '380 patent, entitled "Wiper Blade Connector," is directed to a connector for coupling various types of wiper blades to the wiper arm of a motor vehicle. Wiper

arms have a variety of configurations; the connector of the '380 patent facilitates the coupling of, e.g., pin and hook-type wiper arms. ('380 patent at col. 1:9-20, 2:38-41)

Representative claim 1 claims

[a] connector for connecting a wiper blade assembly to a wiper arm, said connector comprising:

- first and second side walls spaced from one another;
- a central bridge interconnecting said first and second side walls, said central bridge and first and second side walls defining a pin passage and a rivet passage; and
- a rail interconnecting said first and second side walls and vertically spaced from said central bridge to define a tail space between said bridge and said rail, said rail having a forwardmost free end positioned rearward of said pin passage and said rivet passage to define a rail-free hook insertion space below said bridge, forward of said pin passage, and between said side walls.

B. Activities Leading Up to the Filing of the Bosch Patents

1. Variflex

Adriaan Swanepoel ("Swanepoel"), a South African engineer, conceived of the "Variflex" bracketless wiper blade in the late 1980s. (D.I. 176, ex. 35 at 17:15-19:18) Unlike earlier incarnations, the Variflex blade tapered, in at least one dimension, away from the central connection device. (*Id.* at 90:1-18) In 1990, Swanepoel approached Anglo American Industrial Corporation ("AMIC") representatives Johannes Fehrsen ("Fehrsen") and Laurence Olivier ("Olivier") in an effort to develop and commercialize the Variflex blade. Fehrsen, the CEO of an AMIC subsidiary, was charged with the responsibility of commercializing and marketing the Variflex project. (D.I. 176, ex. 36 at 22:13-21) Olivier was an AMIC executive who oversaw the business side of new technology developments. (D.I. 176, ex. 37 at 15:23-16:4)

Swanepoel's work vis-a-vis the Variflex blade culminated in several patents,

including U.S. Patent No. 5,325,564 ("the '564 patent"). In addition to improvements to the overall beam blade design, during 1990-1991, AMIC and Swanepoel allegedly considered beam blade peripherals, such as spoilers and end caps. (D.I. 207, ex. 1 at 24:8-13, ex. 2 at 20:20-21:14, ex. 3 at 20:19-24) Specifically, Pylon alleges that, in mid-1991, AMIC and Swanepoel sought to counteract the effects of "lift off." (D.I. 207, ex. 1 at 24:8-13, ex. 3 at 39:5-40:2) In connection with these efforts, Fehrsen and Swanepoel jointly and/or individually conceived of several prototype spoilers including: (1) a metal spoiler attached to the convex surface of the beam ("Spoiler to Beam"); (2) a rubber or elastomeric spoiler glued to the convex surface of the beam ("Triangular Spoiler"); and (3) an aerofoil built into the wiper strip such that the beam itself is inclined ("Inclined Beam"). (D.I. 207, ex. 1 at 35:18-36:11, 49:23-50:4, 52:25-54:6, ex. 2 at 33:8-34:1, *see* ex. 5 at 114:18-21) Correspondence between AMIC, Swanepoel and a South African patent attorney, dated April 9, 1992, references the possibility of filing patent applications to certain design concepts, including an application to "the use of a spoiler or aerofoil" on a beam wiper blade ("the Adams letter"). (D.I. 176, ex. 41 at 2-3) Fehrsen, Swanepoel and Olivier each testified that, prior to January 1992, AMIC and Swanepoel also considered the use of end caps to protect consumers from the sharp edges of the beam. (D.I. 207, ex. 1 at 57:6-58:2, ex. 2 at 34:5-13, ex. 3 at 65:24-66:9)

2. The AMIC/Bosch meetings

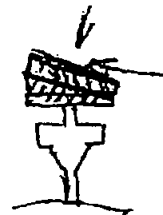
Concurrently, AMIC and Bosch GmbH engaged in a joint development proposal regarding the Variflex technology. The parties do not dispute that, during the initial discussions, AMIC provided Bosch GmbH with the results of high speed tests performed upon the Variflex blades. (D.I. 207, ex. 2 at 33:8-34:1) AMIC also supplied sample

blades to Bosch GmbH. (D.I. 176, ex. 35 at 27:8-18) These sample blades did not include any peripherals. (*Id.* at 29:7-14) The record demonstrates that the entities took part in several meetings during the early 1990s, with Fehrsen, Olivier and Swanepoel representing AMIC and Wilfred Merkel ("Merkel") and Wolfgang Leutsch ("Leutsch") representing Bosch GmbH. (D.I. 207, ex. 1 at 147:12-148:12, 170:13-22, ex. 3 at 54:2-55:6)

The parties' recollection of what transpired at these meetings diverges at the September 17, 1992 meeting ("the September meeting"). Pylon alleges it was at this meeting, between Fehrsen, Olivier, Merkel and Leutsch, and directed to the resolution of the "lift-off" issues, that Fehrsen disclosed the "Triangular Spoiler" and "Inclined Beam" solutions to Merkel and Leutsch. (D.I. 207, ex. 1 at 47:13-49:22, ex. 3 at 59:19-60:19, 62:9-63:14) Conversely, Bosch alleges that Merkel and Leutsch pitched the "Triangular Spoiler" idea, attributing only the "Inclined Beam" concept to Fehrsen. (D.I. 175, ex. 2 at 16:23-25; D.I. 176, ex. 39 at 23:13-23) The only documentary evidence regarding these disclosures is embodied in Fehrsen's meeting notes, depicted below, which diagram both solutions but do not attribute ownership of either concept. (D.I. 176, ex. 40)



"Triangular Spoiler"



"Inclined Beam"

The parties also dispute whether Fehrsen disclosed end caps to Bosch GmbH at the September meeting. Fehrsen and Olivier testified that, at this meeting, Fehrsen presented a sample beam blade with end caps. (D.I. 207, ex. 1 at 156:13-23, ex. 3 at 67:5-20) Bosch LLC denies these allegations. The allegedly disclosed end cap appears again in a jointly-prepared "Variflex terminology" diagram, which was prepared some seven months after the September meeting. (*Id.*, ex. 1 at 57:6-58:2, ex. 2 at 65:1-66:16; D.I. 243, ex. 85) Pylon also alleges that Thomas Kotlarski ("Kotlarski"), a Bosch employee and named inventor of the '434 patent, interfaced with Swanepoel and had access to this diagram as well as other AMIC files that pertained to the alleged disclosed end cap. (D.I. 207, ex. 1 at 84:8-16, ex. 2 at 36:5-37:5)

3. The Bosch patents

In October 1996, the business relationship between Bosch GmbH and AMIC formally ended. (D.I. 176, ex. 36 at 157:7-12) Bosch LLC alleges that Bosch GmbH continued to develop its own beam blade designs, and eventually filed the patent applications that resulted in, among others, the '974, '905 and '434 patents. In 1998, AMIC sold its interests in the Variflex technology to Trico Products Corporation ("Trico"), a competitor of Bosch GmbH.² (*Id.*, ex. 40) Bosch LLC does not dispute that it made several (unsuccessful) attempts to purchase or license beam blade technology from AMIC and then, after AMIC's transfer of intellectual property, from Trico. (D.I. 207, ex. 1 at 105:10-109:16) Fehrsen and Swanepoel subsequently left AMIC and joined Trico as

²The purchase agreement between AMIC and Trico includes a warranty by AMIC that Bosch GmbH had not made any use of the AMIC technology at issue. (*Id.* at ¶ 2.6) The purchase agreement further warranted that there was no joint development arising from the interaction between Bosch GmbH and AMIC. (*Id.* at ¶ 2.5)

consultants.³ (D.I. 176, ex. 36 at 117:190121:2, ex. 35 at 72:16-74:18)

After learning of Bosch GmbH's efforts to obtain patent protection, Trico requested that Fehrsen and Swanepoel memorialize their recollection regarding the conception of the spoiler and end cap technology, as well as the particulars regarding the joint development efforts between Bosch GmbH and AMIC. (D.I. 176, ex. 35 at 52:3-53:3, ex. 43 at 2) On July 12, 2001, Trico sent a letter to AMIC expressing its concerns regarding the subject matter of the pending patent applications.⁴ (D.I. 176, ex. 44) AMIC subsequently contacted Bosch LLC with respect to the contentions of Fehrsen and Swanepoel, to wit, that Fehrsen and Swanepoel were the sole inventors of, *inter alia*, the end cap and spoiler disclosed in the German counterparts to the '434 and '974 patents, respectively. (*Id.*, ex. 46) Bosch conducted an internal investigation in which it concluded that neither Fehrsen nor Swanepoel contributed to any of the subject matter found in these applications. (*Id.*, ex. 47, ex. 48) The Bosch patents do not list Fehrsen or Swanepoel among the named inventors.

C. The Accused Products

1. The accused Pylon products

Three versions of Pylon's beam blades, referred to as Generation 1, 2 and 3 beam blades, stand accused of infringing the Bosch patents. These wiper blades are marketed and sold under both the Toyota brand name and the Michelin brand name; the

³Swanepoel continues to provide consulting services to Trico. (D.I. 176, ex. 35 at 73:14-20)

⁴Specifically, Trico wrote to AMIC regarding the German counterparts to the '974 (DE 197 36 368) and '434 patents (DE 198 02 451).

Michelin brand name products are Optimum, Symphony, Radius, Weatherwise, and HydroEdge ("the Accused Pylon Products"). Pylon introduced the Generation 1 beam blade in 2006. (D.I. 175, ex. 13 at 37:24-38:4) According to Pylon's Engineering Manager David Frauman ("Frauman"), the Generation 1 beam blade consists of two beams, a spoiler, two end caps, a wiping strip and a mounting base, including a mounting base cover for connecting the wiper blade to the wiper arm. (*Id.*, ex. 14 at 49:2-5; ex. 7, 38:25-39:6, 98:2-3, 126:22-127:7) The Generation 2 beam blade, released in 2007, includes a single beam and modified end caps, which prevent the spoiler from sliding on the beam. (*Id.* at 90:8-91:5; 97:25-98:1) Pylon's Generation 3 beam blades, first sold in 2009, likewise have a single beam, but include a narrow longitudinal groove running along the center of the blade and a different end cap design. (*Id.* at 127:5-14, 130:20-131:3)

As a whole, the Accused Pylon Products have several similar characteristics. Each generation includes a beam, a triangular spoiler secured to a convex surface of a support element, two end caps, a wiping strip connected to a concave surface of a support element, and a mounting base for connecting the wiper blade to the wiper arm. (*Id.* at 38:25-39:6; ex. 3 at 296:11-297:15) A plastic beauty cover prevents exposure of the mounting base. The parties dispute whether the beauty cover also plays a role in connecting the wiper blade to a wiper arm, and whether it further prevents the spoiler from making any physical contact⁵ with the part that connects the wiper blade to a wiper

⁵Indeed, Pylon seemed acutely aware of the '905 patent, which requires that a section of the spoiler be disposed between, and in contact with, each respective end cap and the mounting base. ('905 patent at claim 13) An April 3, 2009 email from Pylon engineer Vambi Tolentino to Pylon's supplier cautioned that the supplied "spoiler

arm. (D.I. 178 at ¶¶ 22, 23; D.I. 198, ex. 57 at 117:23-118:5, ex. 60 at 26)

2. The accused Bosch product

Bosch LLC's U3 connector ("the U3 connector") is sold with certain Bosch Evolution brand wiper blades. The U3 connector allows the wiper blade to couple to one or more wiper arm types. The U3 connector has a semicircular cutout that requires a separate adapter to lockingly engage a wiper arm pin. (D.I. 175, ex. 3 at 187:16-19, ex. 26 at 346:17-348:3) This adapter is not part of the accused U3 connector. (D.I. 175, ex. 3 at 187:16-19)

III. STANDARD OF REVIEW

A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." *Horowitz v. Fed. Kemper Life Assurance Co.*, 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" *Matsushita*,

lengths do not leave a space with the cover. We are required to have a clearance between the cover & the spoiler to avoid patent infringement." (D.I. 198, ex 61)

475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will “view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion.” *Pa. Coal Ass’n v. Babbitt*, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

IV. DISCUSSION

A. Invalidity⁶

The standard of proof to establish the invalidity of a patent is “clear and convincing evidence.” *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1058 (Fed. Cir. 2004). In conjunction with this burden, the Federal Circuit has explained that,

[w]hen no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the

⁶Insofar as the court concludes *infra* that the Accused Pylon Products do not infringe the '512 patent, Pylon's motion for summary judgment of invalidity with respect to the '512 patent is denied as moot. It is noteworthy, however, that the PTO considered all of the asserted prior art (DE 196 27 114, DE 196 27 115 and WO 98/50261), including the combinations of such proffered by Pylon, during prosecution of the '512 patent. (D.I. 165, ex. 7 at JA928, ex. 8 at JA1214-17)

level of skill in the art and whose duty it is to issue only valid patents.

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1304 (Fed. Cir. 2008) (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1359 (Fed. Cir. 1984)).

1. Anticipation

An anticipation inquiry involves two steps. First, the court must construe the claims of the patent in suit as a matter of law. See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998). Second, the finder of fact must compare the construed claims against the prior art. See *id.*

Proving a patent invalid by anticipation "requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation." *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (citations omitted). The Federal Circuit has stated that "[t]here must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). The elements of the prior art must be arranged or combined in the same manner as in the claim at issue, but the reference need not satisfy an *ipsissimis verbis* test. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. Mar. 26, 2009) (citations omitted). "In determining whether a patented invention is [explicitly] anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550,

1554 (Fed. Cir. 1995). The prosecution history and the prior art may be consulted “[i]f needed to impart clarity or avoid ambiguity” in ascertaining whether the invention is novel or was previously known in the art. *Id.* (internal citations omitted).

Pylon argues that the asserted claims of the ‘974 patent are invalid as anticipated by U.S. Patent No. 3,881,214 (“the ‘214 patent”).⁷ The ‘214 patent teaches a wiper blade comprised of a support element, a wiper strip and a metal backing strip combined with a rubber element. The metal backing strip/rubber element combination runs the length of the wiper blade along a channel formed by the support element. (D.I. 180, ex. 6) The ‘214 patent does not disclose the beam blade of the ‘974 patent. The expert report of Dr. Steven Dubowsky (“Dubowsky”), Bosch LLC’s expert, characterizes the inventions of the ‘214 and ‘974 patents as containing material differences. (D.I. 198, ex. 53) Specifically, Dubowsky opines that, instead of the beam blade of the ‘974 patent, the ‘214 patent teaches a wiper blade made of thermoplastic material comprising a “supporting structure” that has the function of a spring and includes recesses, the height of which decreases progressively from the center towards the distal ends of the wiping element, allowing the structure to deform during use and exert substantially uniform pressure on the window. (*Id.* at 11)

The parties’ experts also dispute the identity of the “curved, band-shaped spring-elastic support element” that “distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes” as claimed in the ‘974 patent. Pylon asserts that element 110 of the ‘214 patent meets this limitation. The

⁷The French equivalent of the ‘214 patent (FR 2 199 302) was considered during prosecution of the ‘974 patent. (D.I. 162, ex. 2 at 70, 83-95)

'214 patent teaches that element 110 accomplishes the function of "maintaining substantially undeformed the supporting structure 1 of the windshield wiper blade when the force applied onto the windshield wiper blade ceases, so that the latter, keeping always its original camber, is always in a position to accomplish its spring function."

('214 patent at col. 3:55-60) Dubowsky's deposition testimony, consistent with the specification of the '214 patent, argues that element 110 does not perform the pressure distribution function and is devoid of an initial curvature. (D.I. 198, ex. 55 at 311:5-314:9) Rather, Dubowsky submits that "supporting structure 1," provides the pressure distribution function. (*Id.* at 312:15-19) And while "supporting structure 1" could meet the "component" limitation⁸ of the '974 patent, a material issue of fact exists with respect to whether the same structure could simultaneously meet the "support element" limitation.

Moreover, the '214 patent does not disclose a connection device arranged directly on the convex side of the structure that Pylon argues meets the spring-elastic support element limitation of the '974 patent, i.e., element 110. ('274 patent at col. 2:12-14) The connection device is instead arranged directly on the "supporting structure 1." (*Id.* at col. 4:15-16)

Pylon has failed to carry the exceptional burden necessary to prevail on a motion for summary judgment of invalidity in which the PTO previously considered the only asserted prior art. *See PowerOasis*, 522 F.3d at 1304. For the aforementioned reasons, Pylon's motion for summary judgment of invalidity is denied to the extent that

⁸Bosch LLC's arguments that the '214 patent does not disclose a spoiler lack merit in light of the broadly construed "component" limitation.

the '214 patent does not anticipate the '974 patent.

2. Obviousness

“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.” 35 U.S.C. § 103(a). Obviousness is a question of law, which depends on several underlying factual inquiries.

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.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). “Because patents are presumed to be valid, see 35 U.S.C. § 282, an alleged infringer seeking to invalidate a patent on obviousness grounds must establish its obviousness by facts supported by clear and convincing evidence.” *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006) (citation omitted).

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 550 U.S. at 418. Likewise, a defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed. *Id.* at 418-19. The Supreme Court has emphasized the need for

courts to value “common sense” over “rigid preventative rules” in determining whether a motivation to combine existed. *Id.* at 419-20. “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420.

In addition to showing that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, a defendant must also demonstrate, by clear and convincing evidence, that “such a person would have had a reasonable expectation of success in doing so.” *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

Pylon argues that the asserted claims of the '974 patent are invalid as rendered obvious by (1) U.S. Patent No. 3,881,214 (“the '214 patent”), alone or in combination with U.S. Patent No. 5,325,564 (“the '564 patent”), and (2) rendered obvious in view of the '564 patent in combination with U.S. Patent No. 3,879,793 (“the '793 patent”). Pylon argues that, to the extent that the '214 patent fails to disclose any elements, these elements are taught by the '564 patent. Pylon argues alternatively that, treating the '564 patent as the primary reference and combining it with “component” of the '214 patent, one of ordinary skill would arrive at the claimed invention of claims 1, 2 and 8 of the '974 patent.

As an initial matter, Pylon has not demonstrated the presence of a motivation to combine the '214 patent and the '564 patent, based in common sense or otherwise. *KSR*, 550 U.S. at 418. The '564 patent teaches the basic elements of a beam blade. Pylon's position is that the structure it identified as the “component” of the '214 patent

("supporting structure 1") may be combined with "spring backbone 10" of the '564 patent to address the lift-off problem solved by the '974 patent. (D.I. 180, ex. 9 at 4) As noted *supra*, the parties dispute the functionality of "supporting structure 1." Laboring under Dubowsky's characterization of "supporting structure 1," this would result in the combination of two pressure distribution elements; the court cannot comprehend any motivation that would lead one of ordinary skill in the art to combine two support elements.

Alternatively, Pylon argues that the '974 patent is rendered obvious by a combination of the '564 patent and the '793 patent. The '793 patent teaches a conventional wiper blade including a superstructure consisting of yokes and hinges. ('793 patent at col. 1:60-65, 2:39-45, Figs. 1, 3) The superstructure further includes "a primary yoke" in the shape of a triangular spoiler with a leading edge face that "forms an acute angle with respect to a plane extending substantially parallel to the surface to be wiped." (*Id.* at col. 3:55-57) Pylon argues that it would have been obvious to combine the beam blade of the '564 patent with the spoiler feature taught by the '793 patent "given the limited number of ways one of ordinary skill in the art would know to address the wind lift presented with the '564 patent." (D.I. 180, ex. 9 at 2)

The '793 patent notes that several "satisfactory" configurations exist for addressing the lift-off issue in conventional wiper blades, "including the use of fins or vanes, bifurcated tilting metal strip yokes, airfoils, and yokes pierced with a plurality of holes." ('793 patent at col. 1:23-26) Accordingly, significant issues of material fact exist with respect to whether the specific combination of a spoiler and beam blade was obvious to try. *See KSR*, 550 U.S. at 420. Specifically,

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Id.

Bosch LLC argues against the existence of any such common sense result, noting that if the lift-off issues with beam blades could be so easily solved, "it would not have taken decades to arrive at that structure." (D.I. 197 at 33) Moreover, Dubowsky opines that one of ordinary skill would have been concerned that the addition of a spoiler to the support element of a beam blade would undesirably increase the overall stiffness of the beam blade. (D.I. 235 at ¶ 21) In a related theory, Dubowsky submits that the '793 patent teaches away from the use of a separate spoiler in that

the anti-windlight configuration built into the superstructure [is] without the need for separate [spoiler] attachments commonly used in the past. The anti-windlift feature is provided by forming a ramp portion in the primary yoke and optionally in either or both of the secondary yokes

('793 patent at col. 3:48-55) Finally, Bosch LLC submits extensive evidence regarding secondary considerations of nonobviousness in connection with the '974 patent, including evidence of long felt need, commercial success and copying. While Bosch LLC must, as Pylon notes, demonstrate a nexus between the commercial success of its products and the invention of the '974 patent, *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988), it will have a chance to do so at trial. Indeed, several material issues preclude the grant of summary judgment of invalidity of the '974 patent. For these reasons, Pylon's motion is denied.

3. Derivation

“A person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented.” 35 U.S.C. § 102(f). Assertion of this subsection as a defense amounts to a claim that the patentee derived the invention from another. See *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993). A party bringing a claim for patent invalidity under 35 U.S.C. § 102(f) must demonstrate by clear and convincing evidence both conception of the invention by another and communication of the invention to the patentee. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997) (citing *Price*, 988 F.2d at 1190).

Conception is the “formation in the inventor’s mind of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (citations omitted). A conception must encompass all limitations of the claimed invention, and “is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.” *Singh v. Brake*, 317 F.3d 1334, 1340 (Fed. Cir. 2002) (citations omitted). Put differently, every limitation must be shown to have been known to the inventor at the time the invention is alleged to have been conceived. *Davis v. Reddy*, 620 F.2d 885, 889 (C.C.P.A. 1980) (citing *Schur v. Muller*, 372 F.2d 546, 551 (1967); *Anderson v. Anderson*, 403 F. Supp. 834, 846 (D. D.C. 1975)).

Upon the issuance of a patent, it is presumed that there are no inventors other than those listed on the patent. *Bd. of Educ. v. American Bioscience, Inc.*, 333 F.3d

1330, 1337 (Fed.Cir.2003). A party challenging this presumption must prove, by clear and convincing evidence, that it significantly contributed to the conception of the invention. *Id.* An inventor's testimony stating that he contributed to the conception at issue is not, by itself, enough to support a finding of inventorship. Such testimony must be corroborated by either contemporaneous documents, testimony of someone else or circumstantial evidence. *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1461 (Fed.Cir.1998). "Circumstantial evidence about the inventive process may also corroborate" the inventor's testimony. *Id.* (citing *Knorr v. Pearson*, 671 F.2d 1368).

Factors to be considered in assessing corroboration include:

(1) the relationship between the corroborating witness and the alleged prior user; (2) the time period between the event and trial; (3) the interest of the corroborating witness in the subject matter in suit; (4) contradiction or impeachment of the witness' testimony; (5) the extent and details of the corroborating testimony; (6) the witness' familiarity with the subject matter of the patented invention and the prior use; (7) probability that a prior use could occur considering the state of the art at the time; (8) impact of the invention on the industry, and the commercial value of its practice.

Woodland Trust v. Flowertree Nursery, 148 F.3d 1368, 1371 (Fed. Cir. 1998). "Whether the inventor's testimony has been sufficiently corroborated is evaluated under a 'rule of reason analysis,'" which requires that "an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the alleged inventor's story may be reached." *Ethicon* 135 F.3d at 1461 (quoting *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993)).

Bosch LLC advances two arguments in support of its motion for summary judgment that the '974, '905 and '434 patents are not invalid for derivation. As a procedural matter, Bosch LLC alleges that Pylon failed to properly plead its derivation

defense. Specifically, Bosch LLC alleges that the pleadings do not provide the requisite level of notice, and that prejudice will result if Pylon is allowed to maintain this defense. This argument is without merit. Federal Rule of Civil Procedure 8 ("Rule 8") requires a party to set forth affirmative defenses in a responsive pleading with a "short and plain statement." *McKesson Information Solutions, LLC v. Trizetto Group, Inc.*, 2005 WL 914776, at *1 (D. Del. April 20, 2005). A cursory review of Pylon's second amended answer reveals numerous instances that would put Bosch LLC on notice of both the existence and scope of Pylon's derivation defense. This notice is present in Pylon's (1) affirmative defense that the Bosch patents are invalid for failure to comply with the conditions of patentability set forth in 35 U.S.C. § 102; (2) affirmative defense that "one or more of [the Bosch patents] are invalid and unenforceable because the invention(s) were derived and/or misappropriated from the true inventors"; and (3) detailed allegations of the factual support for these defenses that span 10 pages in count III of its counterclaims. (D.I. 55 at 4, 6, 8-17)

Nor can the court agree with Bosch LLC's contentions that Pylon failed to act with reasonable diligence in asserting the derivation defense. The Third Circuit has held that Rule 8 requires an affirmative defense to be pled in the answer or "raised at the earliest practical moment thereafter." *Robinson v. Johnson*, 313 F.3d 128, 137 (3d Cir. 2002). Pylon learned of the Bosch GmbH/AMIC joint development efforts on or about May 5, 2009 pursuant to a subpoena served upon Trico. Pylon filed its second amended answer on May 22, 2009. This time line does not suggest a lack of diligence on Pylon's behalf.

Bosch LLC next attacks the merits of the derivation defense, arguing that Pylon

has not corroborated Fehrsen's testimony and, accordingly, Pylon's defense is unsupported by clear and convincing evidence as a matter of law. Fehrsen's testimony, standing by itself, cannot overcome the presumption that the Bosch patents identify the correct inventors. See *Price*, 988 F.2d at 1194. In recognition of this hurdle, the parties' arguments are primarily drawn to the characterization of Fehrsen's notes from the September meeting, as well as the earlier Adams letter.

Because Fehrsen's notes do not attribute the ownership of either solution, Bosch LLC argues that this evidence cannot corroborate his claims of inventorship. According to Bosch LLC, the only permissible inference arising from Fehrsen's notes is that **someone** at the September meeting disclosed these ideas. Consistent with the uncertain ownership evinced by such an inference, the parties have offered conflicting testimony as to who actually conceived of the solutions depicted in Fehrsen's notes. Merkel claims that he and Leutsch disclosed the Inclined Beam and Triangular Spoiler solutions, and that Fehrsen merely copied them into his notes. Olivier's testimonial support of Fehrsen's claim to the solutions displayed in his notes comports with the corroboration requirement.⁹

⁹Bosch LLC takes issue with Olivier's testimony as evidence of corroboration, citing to *Woodland Trust*. 148 F.3d at 1371. Specifically, Bosch LLC alleges that the close business relationship between Olivier and Fehrsen, as well as Olivier's inability to recall, with exacting detail, a transaction that occurred seventeen years ago. First, any relationship between Olivier and Fehrsen ended roughly a decade ago, and Olivier has no evident interest in this litigation. Moreover, the simple fact that Olivier needed to be refreshed by Fehrsen's notes before testifying to Fehrsen's disclosure does not, per se, render Olivier's testimony suspect.

While not inapposite to the corroboration analysis, these factors are less compelling due to the consistency between Olivier's testimony and the documentary evidence of record, including Fehrsen's notes and the Adams letter. This treatment comports with *Woodland Trust*, in which the Federal Circuit explained that there is "a

Although conflicting testimony regarding inventorship can “create a genuine issue of material fact regarding the identity of the true inventor,” *Virginia Elec. & Lighting Corp. v. National Serv. Indus.*, 2000 WL 12729, at *6 (Fed. Cir. 2000), the inference that Fehrsen conceived of the solutions depicted by his notes and communicated them to Merkel and Leutsch at the September meeting is supported by circumstantial evidence. *In re Jolley*, 308 F.3d 1317, 1325 (Fed. Cir. 2002) (explaining that “[c]orroboation may be established by sufficient circumstantial evidence of an independent nature”) (citations omitted). Notably, Bosch LLC’s earliest purported conception date for the ‘974 patent is April 23, 1996, postdating Fehrsen’s notes by three and a half years. The Adams letter demonstrates that Fehrsen and Olivier had considered the “lift-off” problem and were working to devise (or had already devised) a spoiler to counteract such issues. And while the Adams letter is necessarily vague in providing exact details regarding the spoiler, the sum of these pieces of circumstantial evidence supports the inference that Fehrsen disclosed his ideas at the September meeting, which he later memorialized in his notes. These notes, which depict a Triangular Spoiler that is strikingly similar to Figure 3 of the ‘974 patent, permit a finding of corroboration for Fehrsen’s testimony regarding his prior conception.

very heavy burden to be met by one challenging validity when **the only evidence is the oral testimony** of interested persons and their friends, particularly as to long-past events.” *Id.* (emphasis added).



"Triangular Spoiler"

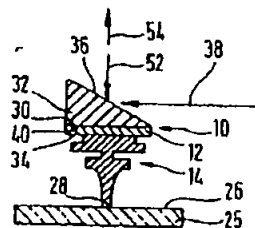


Fig. 3 of the '974 patent

Bosch LLC also questions the sufficiency of the disclosure of Fehrsen's notes, arguing that, with respect to a prior conception, "courts require corroborating evidence of a contemporaneous disclosure that would enable one skilled in the art to make the invention." *Burroughs Wellcome Co. v. Barr Lab.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). In order to satisfy the enablement requirement, the disclosure must "teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1378 (Fed. Cir. 2009) (citations omitted). The determination of whether undue experimentation would be required to reduce an idea to practice is "reached by weighing many factual considerations." *Id.* (quoting *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). Resolving all facts in the light most favorable to Pylon, there are material issues of fact as to whether, upon viewing the solutions contained in Fehrsen's notes, one of ordinary skill could arrive at the invention claimed by the '974 patent through the elementary task of gluing a triangular piece of rubber onto the top of a beam blade.

Pylon presents less compelling evidence of derivation with respect to the '905 and '434 patents. As noted above, the parties dispute whether, at the September meeting,

Fehrsen provided Bosch GmbH with a sample beam blade complete with end caps. Pylon proffers the Variflex terminology sheet, which was prepared several months after the meeting, as corroborative evidence for Fehrsen's claim that Bosch GmbH had access to a sample beam blade with end caps. Olivier's testimony comports with Fehrsen's claim. With respect to the diverging legs of the wind deflection strip required by the '905 patent, Pylon argues that such elements were well known in the art at the time of the meeting. (See U.S. Patent Nos. 3,088,155 and 3,881,214) However, Pylon fails to allege a conduit of communication between Fehrsen and the named inventors of the '905 patent, none of which were present at the September meeting. Irrespective of this lack of communication, Pylon also fails to compare the alleged disclosure to the limitations of the '905 patent. And while Pylon does proffer an attenuated route of communication through Kotlarski, a named inventor of the '434 patent, no evidence of record establishes that the end cap allegedly disclosed could enable the '434 patent. Specifically, Pylon does not identify a "detent shoulder" in the Variflex terminology sheet; nor do any of Pylon's witnesses testify to this effect. In view of such, Pylon's allegations regarding the derivation the '905 and '434 patents fail as a matter of law.

4. Inequitable Conduct

Applicants for patents and their legal representatives have a duty of candor, good faith, and honesty in their dealings with the United State Patent and Trademark Office ("PTO"). *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995); 37 C.F.R. § 1.56(a) (2003). The duty of candor, good faith, and honesty includes the duty to submit truthful information and the duty to disclose to the PTO information known to the patent applicants or their attorneys which is material to the examination of the patent

application. *Elk Corp. of Dallas v. GAF Bldg. Materials Corp.*, 168 F.3d 28, 30 (Fed. Cir. 1999). A breach of this duty constitutes inequitable conduct. *Mollins*, 48 F.3d at 1178. If it is established that a patent applicant engaged in inequitable conduct, then the patent application is rendered unenforceable. *Kingsdown Med. Consultants v. Hollister Inc.*, 863 F.2d 867, 877 (Fed. Cir. 1988).

In order to establish unenforceability based on inequitable conduct, a defendant must establish, by clear and convincing evidence, that: (1) the omitted or false information was material to patentability of the invention; or (2) the applicant had knowledge of the existence and materiality of the information; and (3) the applicant intended to deceive the PTO. *Mollins*, 48 F.3d at 1178. A determination of inequitable conduct, therefore, entails a two step analysis. First, the court must determine whether the withheld information meets a threshold level of materiality. A reference is considered material if there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. *Allied Colloids, Inc. v. American Cyanamid Co.*, 64 F.3d 1570, 1578 (Fed. Cir. 1995) (citations omitted). A reference, however, does not have to render the claimed invention unpatentable or invalid to be material. See *Merck v. Danbury Pharmacal*, 873 F.2d 1418 (Fed. Cir. 1989).

After determining that the applicant withheld material information, the court must then decide whether the applicant acted with the requisite level of intent to mislead the PTO. See *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1327 (Fed. Cir. 2009); *Baxter Int'l, Inc. V. McGaw Inc.*, 149 F.3d 1321, 1327 (Fed. Cir. 1998). "Intent to

deceive cannot be inferred solely from the fact that information was not disclosed; there must be a factual basis for finding a deceptive intent.” *Herbert v. Lisle Corp.*, 99 F.3d 1109, 1116 (Fed. Cir. 1996). That is, “the involved conduct, viewed in light of all the evidence, including evidence indicative of good faith, must indicate sufficient culpability to require a finding of intent to deceive.” *Kingsdown*, 863 F.2d at 876 (Fed. Cir. 1988). Evidence of specific intent must “be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008). A “smoking gun,” however, is not required in order to establish an intent to deceive. See *Merck*, 873 F.2d at 1422.

Once materiality and intent to deceive have been established, the trial court must weigh them to determine whether the balance tips in favor of a conclusion of inequitable conduct. *N.V. Akzo v. E.I. DuPont de Nemours*, 810 F.2d 1148, 1153 (Fed. Cir. 1988). The showing of intent can be proportionally less when balanced against high materiality. *Id.* In contrast, the showing of intent must be proportionally greater when balanced against low materiality. *Id.*

Bosch argues that Pylon has elicited no evidence that would support any inference of specific intent to deceive the PTO with respect to the application for the '974 patent.¹⁰ However, “[a]n inference of intent to deceive is generally appropriate . . . when

¹⁰Insofar as Pylon has failed to meet its burden of demonstrating that no material issues of fact exist with respect to the derivation of the '905 and '434 patents, it has likewise failed to show that the inventors of these patents engaged in inequitable conduct in their interactions with the PTO. Pylon has not demonstrated that any other than the true inventors are listed on these patents and, accordingly, Pylon's inequitable conduct arguments regarding the '905 and '434 patents must fail due to the lack of an

(1) highly material information is withheld; (2) the applicant knew of the information [and] . . . knew or should have known of the materiality of the information; and (3) the applicant has not provided a credible explanation for the withholding.” *Praxair, Inc. v. ATMI, Inc.* 543 F.3d 1306, 1314 (Fed. Cir. 2008) (internal quotations and citations omitted). A failure to disclose the true inventorship of a patent is certainly a material omission. *See, e.g., Board of Education ex rel. Florida State University v. American Bioscience, Inc.*, 333 F.3d 1330, 1344 (Fed. Cir. 2003) (a patent applicant has a duty to assure that “only true inventors” are named in a patent application and that failure to do so may result in a finding of inequitable conduct); *Frank’s Casing Crew & Rental Tools, Inc. v. PMR Techs., Ltd.*, 292 F.3d 1363 (Fed. Cir. 2002) (holding a patent unenforceable due to inequitable conduct where two named inventors deliberately concealed a true inventor’s involvement in the conception of the invention and ‘engaged in a pattern of intentional conduct designed to deceive the attorneys and patent office as to who the true inventors were . . . ’).

Accordingly, viewing all the aforementioned evidence in the light most favorable to Pylon, there are genuine issues of material fact as to whether: (1) Fehrsen conceived of the subject matter claimed in the '974 patent; (2) Fehrsen disclosed it to Merkel and Leutsch; (3) Merkel and Leutsch committed a highly material omission by fraudulently representing to the PTO Fehrsen’s ideas as their own; and (4) Merkel and Leutsch intended to deceive the PTO by submitting false declarations in connection with the application that led to the '974 patent in which they claimed to be the original and first

alleged material omission. *See Gambro Lundia*, 110 F.3d at 1582.

inventors of the claimed subject matter. Moreover, a material issue of fact persists in whether intent to deceive the PTO is “the single most reasonable inference able to be drawn from the evidence to meet the clear and convincing standard. *Star Sci.*, 537 F.3d at 1366.

B. Infringement

A patent is infringed when a person “without authority makes, uses or sells any patented invention, within the United States . . . during the term of the patent.” 35 U.S.C. § 271(a). A two-step analysis is employed in making an infringement determination. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). First, the court must construe the asserted claims to ascertain their meaning and scope. *Id.* Construction of the claims is a question of law subject to de novo review. See *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). The trier of fact must then compare the properly construed claims with the accused infringing product. *Markman*, 52 F.3d at 976. This second step is a question of fact. See *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998).

“Direct infringement requires a party to perform each and every step or element of a claimed method or product.” *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1378 (Fed. Cir. 2007). “If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law.” *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). If an accused product does not infringe an independent claim, it also does not infringe any claim depending thereon. See *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989). A

product that does not literally infringe a patent claim may still infringe under the doctrine of equivalents if the differences between an individual element of the claimed invention and an element of the accused product are insubstantial. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 24 (U.S. 1997). The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988) (citations omitted).

1. The '974 patent

Bosch has asserted that the Accused Pylon Products literally infringe claims 1, 2 and 8 of the '974 patent. The parties have filed cross-motions regarding infringement. (D.I. 169; D.I. 177) The court notes at the outset that a majority of Pylon's proposed constructions for the '974 patent were rejected during claim construction. Insofar as Pylon relies upon these rejected constructions, Pylon cannot prevail on its motion for summary judgment of noninfringement of the '974 patent. Accordingly, the relevant inquiry is whether Bosch LLC has carried its burden with respect to its cross-motion seeking summary judgement of infringement of the '974 patent.

a. "[A] curved, band-shaped, spring elastic support element which distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes

Pylon admits that the Accused Pylon Products include a curved, band-shaped, spring elastic support element which distributes the pressure applied by the wiper arm and has a concave and a convex surface which defines corresponding planes. (D.I. 175, ex. 16 at 20-21)

b. “[A]n elongated rubber-elastic wiper strip placeable on a window to be wiped and mounted to said concave surface of said support element which faces the window, substantially longitudinally parallel to said concave surface”

The Accused Pylon Products include a wiper strip that is positioned on a window and mounted to the concave surface of the support element that faces the window. (*Id.* at 22-23) Pylon further admits that each also has an elongated rubber-elastic wiper strip placeable on a window to be wiped which faces the window, substantially longitudinally parallel to the concave surface of the support element. (*Id.*)

By its order of the same date, the court has construed “mounted to” to mean “secured to.” Buechele testified that “[the Accused Pylon Products] include[] a wiper strip that is secured to a concave surface of a support element.” (D.I. 175, ex. 3 at 296:11-15) Irrespective of this admission, Pylon asserts that a threshold question exists with respect to both the meaning of the term “secured to,” as well as the propriety of its application to the Accused Pylon Products. Pylon alleges that the manner in which the wiper strip connects to the support element varies according to generation. Buechele testified that the Generation 1 wiper strip is linearly insertable into and out of a narrow space created by the two support elements and is “movable” but for the end caps, which hold the wiper strip in position. (D.I. 201, ex. 1 at 6-8) Buechele further describes the contact between the support element as a “mere touching” of the concave and convex surfaces by the wiper element. (*Id.*) Buechele applies similar reasoning and opines that because the wiper elements of Generation 2 and 3 are also movable, they are not “secured to” the support element within the meaning of the '974 patent. (*Id.*) Rather, Buechele concludes that the wiper blade is “merely on” the concave surface of the

support element. (*Id.*)

Pylon seeks to unreasonably limit the meaning of "secured to." The prosecution history suggests simply that the wiper strip must be separate from the support element and "not merely on" it. (D.I. 162, ex. 2 at JA197) Requiring an "immovable" connection between the two elements would impermissibly limit the invention of the '974 patent to one preferred embodiment disclosed in Figure 3, as well as render superfluous dependent claim 3, which claims a "solidly joined" connection, and claim 5, which claims a "glued" connection. Even assuming that "secured to" contemplates a connection in which no movement is permitted in relation to the two objects, the court disagrees that the wiper blade is "merely on," or even movable with respect to, the support element once the end caps are in place. It would be improper to consider the relationship of these two elements divorced from the functionality of the end caps. Accordingly, "secured to" properly encompasses a wiper strip linearly inserted into the support element and held in place by two end caps.

c. "[A] connection device provided for a wiper arm and arranged directly on a convex side of said support element"

Pylon admits that the Accused Pylon Products have a connection device provided for a wiper arm and arranged directly on the convex side of the support element. (D.I. 175, ex. 16 at 24-25)

d. "[A]nd a component which is separate from said wiper strip and is mounted directly to the convex surface of said support element so as to form a leading-edge face extending in a longitudinal direction of the support element and forming, as seen crosswise to its longitudinal extension, an acute angle with a plane which extends parallel to a plane formed by said convex surface"

All of the asserted claims of the '974 patent are directed to a wiper blade that comprises a "component." By its order of the same date, the court has construed "component" to mean "a single- or multiple-part structure having a cross-section in the shape of a triangle or wedge." Buechele acknowledges that the "component" of the '974 patent is a spoiler. (D.I. 175, ex. 3 at 253:6-10) He conceded at his deposition that the Accused Pylon Products each have a spoiler that is "generally triangular." (*Id.* at 296:19-21, 297:7-10) Accordingly, the Accused Pylon Products meet the "component" limitation.

Claims 1, 2 and 8 further require that the "component" be "mounted directly to the convex surface of [the] support element." The court has construed "mounted directly to" to mean "secured directly to." Frauman alleges that the components of the Accused Pylon Products contain claws that permit the component to be slidingly installed on and removed from the support element. (D.I. 181 at ¶ 6) According to Frauman, the end caps prevent the component from sliding off of the wiper blade. (*Id.*) Because the component is not permanently joined to the support element, Frauman opines that the Accused Pylon Products cannot meet this limitation. Consistent with this theory, Pylon submits that, if the bottom part of the groove were removed, the component would simply fall off. Retracting slightly from its position that only a permanent joinder can meet this limitation, Pylon argues alternatively that the "tongue-in-groove" construction present in the Accused Pylon Products does not allow the component to become directly secured to the wiper blade. Specifically, Pylon disputes that the "secured directly to" limitation can be met by the sliding engagement between the component and the wiper blade.

Pylon's allegations regarding the interaction between the component and the support element contemplate a separation of the two elements if the wiper blade is either disassembled (by removing the end caps) or broken (by disrupting the "tongue-in-groove" configuration). In this sense, Pylon is simply rearguing its position during claim construction that "mounted directly to" means "immovably secured to by gluing." And for the same reasons noted *supra* regarding "secured to," the court is not convinced by Pylon's allegations of ambiguity regarding the threshold of connectivity that must exist between two objects before one object may be properly described as "secured directly to" the other. No reasonable jury could conclude that one object is not "secured directly to" another if one must be disassembled or destroyed to separate the two.

Finally, Pylon does not dispute that the spoiler of the Accused Pylon Products includes a leading-edge face that faces into the wind and extends in a longitudinal direction of the support element. Nor does Pylon dispute that the leading-edge face forms an acute angle with a plane that extends parallel to a plane formed by the convex surface of the support element. (*Id.*, ex. 15 at 12-14)

e. "A wiper blade as defined in claim 1, wherein said leading-edge face is disposed on a face of said support element which faces away from the window"

The court was unable to glean the meaning of the additional limitation contained in dependent claim 2 and, accordingly, did not construe it. Consequently, summary judgment of infringement is denied with respect to this claim.

f. "A wiper blade as defined in claim 1, wherein said leading-edge face extends at least nearly over an entire length of the wiper blade."

Pylon does not dispute that, in each of the Accused Pylon Products, the leading-edge face extends at least nearly over the entire length of the wiper blade. (*Id.* at 14; ex. 17 at 4-5; ex. 30 at 1-3)

In sum, Pylon has failed to demonstrate existence of an issue of material fact with respect to infringement of claims 1 and 8 of the '974 patent. The Accused Pylon Products meet each limitation of these claims, and no reasonable juror could find otherwise. Accordingly, the court grants summary judgment that the Accused Pylon Products infringe claims 1 and 8 of the '974 patent.

2. The '434 patent

Bosch has asserted that all of the Accused Pylon Products literally infringe claim 1 and dependent claim 13 of the '434 patent, and that certain of the Accused Pylon Products literally infringe dependent claims 4, 5, 7 and 8. Because the court has rejected most of Pylon's proposed constructions for the disputed claim limitations of the '434 patent, Pylon cannot prevail in its motion for summary judgment of noninfringement of the '434 patent. The court briefly illustrates several issues of material fact in this regard.

a. "[B]racing itself on the wiper blade"

Claim 1 of the '434 patent claims a wiper blade comprising an end cap located on the support element and "bracing itself on the wiper blade." The court has construed this limitation to mean that the end cap is "supporting itself on both the support element and wiper strip." With respect to this limitation, Pylon asserts that "there is no dispute that none of the Accused Pylon Products have end caps that simultaneously brace

themselves on the support element and the wiper strip.” (D.I. 179 at 14) The court has rejected the notion that any such bracing by the end cap must be simultaneous; Pylon has failed to demonstrate that the Accused Pylon Products do not meet this limitation as a matter of law.

b. “[D]etent shoulder”

All of the asserted claims of the ‘434 patent recite a “detent shoulder,” which the court has construed to mean “part of a structure [support element or base body] that secures structure to another.” A reasonable jury could determine that this construction is broad enough to encompass the Accused Pylon Products, which engage and secure end caps through holes (Generation 1) or cut-outs (Generations 2 and 3) into the interior of the support element.

Pylon disputes that this limitation is met to the extent that the Accused Pylon Products “are merely practicing the prior art for end caps” (*Id.*) Pylon cites several patents¹¹ that allegedly demonstrate a nearly identical wiper blade/end cap configuration. Dubowsky has opined that material differences exist between the invention of the ‘434 patent and Pylon’s asserted patents. Irrespective of competing expert testimony in this regard, the Federal Circuit has made “unequivocally clear . . . that there is no ‘practicing the prior art’ defense to literal infringement.” *Tate Access Floors v. Interface Architectural Res.*, 279 F.3d 1357, 1365 (Fed. Cir. 2002) (citing *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1583 (Fed. Cir. 1995)).

¹¹The patents cited by Pylon include U.S. Patent Nos. 3,626,544, 5,493,750 and 3,785,002. The PTO considered each of these patents during examination of the ‘434 patent.

Indeed, “[l]iteral infringement exists if each of the limitations of the asserted claim(s) read on, that is, are found in, the accused device. Questions of obviousness in light of the prior art go to validity of the claims, not to whether an accused device infringes.” *Id.* at 1366.

On this record, the court cannot say that the Accused Pylon Products do not infringe the ‘434 patent as a matter of law. For the forgoing reasons, the court denies Pylon’s motion for summary judgment of noninfringement with respect to the ‘434 patent.

3. The ‘905 patent

Bosch has asserted that the Accused Pylon Products infringe claim 13 of the ‘905 patent literally or under the doctrine of equivalents. Claim 13 requires that “a section of the wind deflection strip” be “disposed between and in contact with” the end caps and device piece. The Accused Pylon Products each have a device piece that connects the wiper blade to the wiper arm. The parties’ dispute centers upon whether the plastic beauty cover that encloses the device piece interrupts whatever degree of continuity is required. It is Pylon’s position that the plastic beauty cover plays no role in connecting the wiper blade to a wiper arm. Dubowsky’s expert report comes to a contrary conclusion. (D.I. 198, ex. 60 at 25-28) Specifically, Dubowsky opines that the characterization of the beauty cover as a necessary extension of the device piece follows logically from its role in preventing vibration, as well as the accumulation of ice and snow in the device piece. Moreover, Dubowsky contends that, to the extent that the Accused Pylon Products contain a gap between the wind deflection strip and the device piece, any such gap is functionally insignificant. (*Id.*)

Pylon also argues that Bosch LLC is precluded from asserting infringement under

the doctrine of equivalents because the applicants of the '905 patent narrowed claim 13 during prosecution. (D.I. 179 at 21) In this regard, Pylon alleges that the applicants added the "in contact with" limitation to overcome prior art and, accordingly, surrendered all subject matter between the broader and narrower language. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (U.S. 2002). A thorough review of the prosecution history, however, reveals that the amendment adding the "in contact with" limitation was not made to overcome prior art, nor was it made as a prerequisite to patentability.¹² Consequently, the court will not entertain a presumption that, through this amendment, the applicants of the ***905 patent have disclaimed subject matter. *See VDP Patent, LLC v. Welch Allyn Holdings, Inc.*, 623 F. Supp. 2d 364, 376 (S.D.N.Y. 2007).

At a minimum, issues of material fact exist with respect to the function of the beauty cover, as well as to whether or not it reads upon the aforementioned limitations of claim 13. Pylon's motion for summary judgment of noninfringement with respect to the '905 patent is denied.

4. The '512 patent

The Accused Pylon Products stand accused of infringing claims 1, 3, 8, 9 and 13 of the '512 patent. The '512 patent claims a beam blade characterized by a support element consisting of two band-like spring strips that are connected by at least two

¹²Indeed, the PTO twice allowed the original application claim that ultimately issued as claim 13 before the phrase "and in contact with" was added via examiner's amendment. (D.I. 164, ex. 6 at JA754, JA759, JA804-05) According to the examiner's amendment, the wind deflection strip was "set forth as in contact with the end cap and device piece to clarify the relationship of the end cap, deflective strip and device piece. (*Id.* at JA895)

welded crosspieces. Pursuant to the court's claim construction order, the limitation of claim 1 "wherein each crosspiece disposed at the end sections of the two spring strips" means that the "crosspieces must be located at the terminal portions of the spring strips."¹³ Bosch LLC does not dispute that the Accused Pylon Products do not have crosspieces on the ends of the spring strips. Accordingly, the Accused Pylon Products cannot meet this limitation of claim 1 as a matter of law. Because the remaining asserted claims of the '512 patent depend upon claim 1, Pylon's motion for summary judgment of noninfringement of the '512 patent is granted. See *Wahpeton*, 870 F.2d at 1553.

6. The '380 patent

Pylon has asserted that Bosch LLC's U3 connector literally infringes¹⁴ claims 1, 2, 9, 10, 23 and 24 of the '380 patent. Claims 1, 23 and 24 are independent claims; claims 2, 9 and 10 depend from claim 1. Because Pylon has failed to demonstrate the

¹³As explained in the court's claim construction order, the only embodiments disclosed by the '512 patent are characterized by crosspieces located at the terminal portions of the spring strips. This construction comports with the prosecution history, in which the examiner rejected the claims of the '512 patent in view of a prior art wiper blade which contained crosspieces located at the ends of the spring strips. The applicant did not traverse this rejection by noting that the crosspieces of the '512 patent could be located elsewhere. (D.I. 165 at JA01077)

¹⁴Pylon has also advanced the theory that the limitation "rearward of said pin passage and said rivet passage" is met by the U3 connector under a doctrine of equivalents analysis. The court is mindful of Bosch LLC's motion to strike the source of this theory, to wit, the supplemental expert report of Buechele. As explained in detail *infra*, because Pylon has failed to demonstrate a material issue of fact with respect to the presence of an additional limitation of the '380 patent, a doctrine of equivalents analysis will not prevent the grant of Bosch LLC's motion for summary judgment of noninfringement. Accordingly, the court denies the motion to strike as moot.

existence of a material issue of fact with respect to the presence of a “pin passage”¹⁵ in the U3 connector, the court grants Bosch’s motion for summary judgment of noninfringement of the ‘380 patent.

i. “[P]in passage”

The term “pin passage” is recited by independent claims 1, 23 and 24 of the ‘380 patent. The court has construed this limitation to mean “a passage adapted to couple the connector to a wiper arm pin without requiring the use of an adapter.” Pylon alleges that the existence of a genuine issue of material fact with respect to whether the U3 connector uses an “adapter” precludes the grant of summary judgment of noninfringement. Specifically, Pylon argues that Bosch LLC has admitted that the U3 connector does not require the use of an adapter to couple to the pin-type wiper arm. In support of this “admission,” Pylon cites to the deposition testimony of Frank Katzenmeier (“Katzenmeier”), Bosch LLC’s corporate representative assigned to the topic of the structure of the Evolution wiper blade. Katzenmeier testified as follows with respect to a Bosch-authored pamphlet regarding the Evolution wiper blade:

Q. And then it reads: “No adapters required.” Does that sort of speak for itself, that it is basically ready to be attached to a vehicle without the need of **additional** adapters?

A. I would conclude that, yes.

* * *

Q. And there is also a statement that no adapters are required, so in other words, the Bosch Evolution would fit these hooks and pins without the need for an **additional** adapter? . . .

A. The Bosch Evolution would fit if they have the below listed hook or pin sizes, that’s correct.

¹⁵This limitation is present in each of the asserted claims of the ‘380 patent.

Q. Without an adapter? . . .

A. Without an **additional** adapter.

(D.I. 243, ex. 74 at 162:13-18, 165:14-166:5) (emphasis added) Contrary to Pylon's assertion of a clear admission that the U3 connectors do not require an adapter, all that the court can glean from this deposition is that the Evolution wiper blade does not require an **additional** adapter to couple the wiper blade to the wiper pin arm. This, of course, is irrelevant to a comparison of the U3 connector to the construed claims of the '380 patent.

Moreover, Pylon acknowledges that coupling requires placing the pin-type wiper arm into the semicircular passage of the U3 connector and "engaging the pin with a locking device that folds down on the connector." (D.I. 202 at 5) Pylon's "locking device" is part of the structure of the Evolution wiper blade and not the U3 connector itself. Accordingly, the parties do not seriously dispute that this "locking device" is required to couple the U3 connector to a pin-type arm. The opinion of Pylon's expert comports with this understanding; indeed, Buechele opined that an "adapter is needed so that the pin can be coupled to the wiper blade," the adapter "is not part of the U3 connector," and the semi-circular cut-out "does not couple the U3 connector to a pin-type [wiper] arm." (D.I. 175, ex. 3 at 186:13-25, 187:12-24) Pylon's characterization of this external mechanism (separate from the U3 connector and required to couple the U3 connector to a pin-type arm) as a "locking device" rather than an "adapter" cannot elicit a material issue of fact where none exists. The U3 connector does not contain the "pin passage" limitation of the '380 patent as a matter of law. In light of the forgoing, the

court grants Bosch LLC's motion for summary judgment of noninfringement of the '380 patent.

V. CONCLUSION

For the foregoing reasons, the court: (1) grants Bosch LLC's motion for summary judgment of infringement of the '974 patent (D.I. 169) with respect to claims 1 and 8 and denies it with respect to claim 2; (2) grants Bosch LLC's motion for summary judgment of noninfringement of the '380 patent (D.I. 171); (3) grants Bosch LLC's motion for summary judgment of no inequitable conduct and no invalidity for derivation (D.I. 173) with respect to the '905 and '434 patents and denies it with respect to the '974 patent; (4) grants Pylon's motion for summary judgment of noninfringement of the '512 patent (D.I. 177); (5) denies Pylon's motion for summary judgment of noninfringement of the '974, '905 and '434 patents (*Id.*); (6) denies Pylon's motion for summary judgment that the '974 and '512 patents are invalid as anticipated or obvious (D.I. 177); and (7) denies as moot Bosch LLC's motion to strike the expert report of Franz Buechele (D.I. 191). An appropriate order shall issue.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	
_____)	

VERDICT SHEET

Dated: April 22, 2010

We, the jury, unanimously find as follows:

I. U.S. Patent No. 6,292,974 ("The '974 Patent")

A. Invalidity

1. Do you find that Pylon has proven, by clear and convincing evidence, that any of the asserted claims of the '974 patent are invalid as being obvious in view of the prior art?

Checking "no" below indicates a finding for Bosch.

Checking "yes" below indicates a finding for Pylon. For any "yes" response, please place a check in the box next to each item of prior art that you are relying on in reaching your obviousness decision.

Claim	No	Yes	Prior Art
1	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/> U.S. Patent No. 3,879,793 <input checked="" type="checkbox"/> U.S. Patent No. 3,881,214 <input type="checkbox"/> U.S. Patent No. 3,942,212 <input type="checkbox"/> U.S. Patent No. 5,325,564
8	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/> U.S. Patent No. 3,879,793 <input checked="" type="checkbox"/> U.S. Patent No. 3,881,214 <input type="checkbox"/> U.S. Patent No. 3,942,212 <input type="checkbox"/> U.S. Patent No. 5,325,564

2. Do you find that Pylon has proven, by clear and convincing evidence, that any of the asserted claims of the '974 patent are invalid because one or more named inventors did not himself invent the claimed subject matter but, instead, learned of it from another?

Question 2 continues on the next page.

Question 2, continued.

Checking "no" below indicates a finding for Bosch.

Checking "yes" below indicates a finding for Pylon. For any "yes" response, please place a check in the box next to the prior inventor(s).

Claim	No	Yes	Prior Inventor(s)
1	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/> Johannes Fehrsen <input type="checkbox"/> Adriaan Swanepoel
8	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/> Johannes Fehrsen <input type="checkbox"/> Adriaan Swanepoel

II. U.S. Patent No. 6,675,434 ("The '434 Patent")

A. Infringement

3. Do you find that Bosch has proven, by a preponderance of the evidence, that any of Pylon's Generation 1, 2 or 3 wiper blades infringe any of the asserted claims of the '434 patent?

Checking "yes" below indicates a finding for Bosch.

Checking "no" below indicates a finding for Pylon.

Accused Product	Claim 1		Claim 5		Claim 7		Claim 13	
	Yes	No	Yes	No	Yes	No	Yes	No
Generation 1	✓						✓	
Generation 2	✓		✓			✓	✓	
Generation 3	✓		✓			✓	✓	

B. Invalidity

4. Do you find that Pylon has proven, by clear and convincing evidence, that any of the asserted claims of the '434 patent are invalid as being obvious in view of the prior art?

Checking "no" below indicates a finding for Bosch.

Checking "yes" below indicates a finding for Pylon. For any "yes" response, please place a check in the box next to each item of prior art that you are relying on in reaching your obviousness decision.

Claim	No	Yes	Prior Art
1	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/> U.S. Patent No. 3,083,394 <input checked="" type="checkbox"/> U.S. Patent No. 3,116,507 <input type="checkbox"/> U.S. Patent No. 5,325,564
5	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/> U.S. Patent No. 3,083,394 <input checked="" type="checkbox"/> U.S. Patent No. 3,116,507 <input type="checkbox"/> U.S. Patent No. 5,325,564
7	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/> U.S. Patent No. 3,083,394 <input type="checkbox"/> U.S. Patent No. 3,116,507 <input type="checkbox"/> U.S. Patent No. 5,325,564
13	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/> U.S. Patent No. 3,083,394 <input type="checkbox"/> U.S. Patent No. 3,116,507 <input type="checkbox"/> U.S. Patent No. 5,325,564

III. U.S. Patent No. 6,944,905 ("The '905 Patent")

A. Infringement

5. Do you find that Bosch has proven, by a preponderance of the evidence, that any of Pylon's Generation 1, 2 or 3 wiper blades infringe Claim 13 of the '905 patent?

Checking "yes" below indicates a finding for Bosch.

Checking "no" below indicates a finding for Pylon.

Accused Product	Claim 13	
	Yes	No
Generation 1	✓	
Generation 2	✓	
Generation 3	✓	

B. Invalidity

6. Do you find that Pylon has proven, by clear and convincing evidence, that claim 13 of the '905 patent is invalid as being obvious in view of the prior art?

Question 6 continues on the next page.

Question 6, continued.

Checking "no" below indicates a finding for Bosch.

Checking "yes" below indicates a finding for Pylon. For any "yes" response, please place a check in the box next to each item of prior art that you are relying on in reaching your obviousness decision.

Claim	No	Yes	Prior Art
13	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/> U.S. Patent No. 6,279,191 <input type="checkbox"/> British Patent GB 2,106,775 <input type="checkbox"/> PCT WO 99/02383

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC,

Plaintiff,

V.

PYLON MANUFACTURING CORP.,

Defendant.

Civ. No. 08-542-SLR

JUDGMENT IN A CIVIL CASE

For reasons stated in the jury verdict of April 23, 2010;

IT IS ORDERED AND ADJUDGED that judgment be and is hereby entered in favor of plaintiff Robert Bosch, LLC and against defendant Pylon Manufacturing Corp. as to U.S. Patent No. 6,944,905.

IT IS FURTHER ORDERED that judgment be and is hereby entered in favor of defendant Pylon Manufacturing Corp. and against plaintiff Robert Bosch, LLC as to U.S. Patent Nos. 6,292,974 and 6,675,434.

Joe L. Robinson
United States District Judge

Dated: 4/28/2010

Nicole Faganaro
(By) Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC,

Plaintiff,

v.

PYLON MANUFACTURING CORP.,

Defendant.

Civ. No. 08-542-SLR

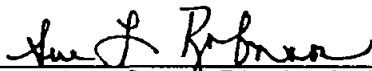
AMENDED JUDGMENT IN A CIVIL CASE

For reasons stated in the jury verdict of April 23, 2010;

IT IS ORDERED AND ADJUDGED that judgment be and is hereby entered in favor of plaintiff Robert Bosch, LLC and against defendant Pylon Manufacturing Corp. as to U.S. Patent No. 6,944,905.

IT IS FURTHER ORDERED that judgment be and is hereby entered in favor of plaintiff Robert Bosch, LLC and against defendant Pylon Manufacturing Corp. as to claim 13 of U.S. Patent No. 6,675,434.

IT IS FURTHER ORDERED that judgment be and is hereby entered in favor of defendant Pylon Manufacturing Corp. and against plaintiff Robert Bosch, LLC as to U.S. Patent No. 6,292,974 and claims 1, 5, and 7 of U.S. Patent No. 6,675,434.



United States District Judge

Dated: 5/3/2010


(By) Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

ORDER

At Wilmington this 3rd day of November 2010, consistent with the memorandum opinion issued this same date;

IT IS ORDERED that:

1. Bosch's renewed motion for JMOL or for a new trial (D.I. 309) is granted in part, to wit:
 - a. Bosch's motion for JMOL is granted and its motion for new trial is conditionally granted with respect to the obviousness of claims 1 and 8 of the '974 patent.
 - b. Bosch's motion for JMOL is granted and its motion for new trial is conditionally granted with respect to the obviousness of claims 1 and 5 of the '434 patent.
 - c. Bosch's motion for JMOL is granted and its motion for a new trial is conditionally granted with respect to the derivation of claim 8 of the '974 patent.
 - d. Bosch's motion for JMOL or for a new trial is denied with respect to the derivation of claim 1 of the '974 patent.

e. Bosch's motion for JMOL or for a new trial is denied with respect to the infringement of claim 7 of the '434 patent.

2. Pylon's renewed motion for JMOL or to amend the judgment with respect to non-infringement of claim 13 of the '434 patent (D.I. 316) is denied.

3. Pylon's renewed motion for JMOL or to amend the judgment with respect to invalidity of claim 13 of the '434 patent (D.I. 318) is denied.

4. Pylon's renewed motion for JMOL or for a new trial with respect to the invalidity of the '905 patent (D.I. 320) is denied.

5. Bosch's motion for leave to file a sur-reply (D.I. 351) is denied as moot.

6. Bosch's motion for a permanent injunction (D.I. 311) is denied.


United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

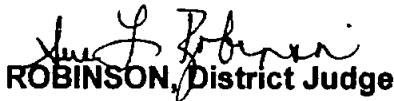
ROBERT BOSCH, LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

David Ellis Moore, Esquire and Richard L. Horwitz, Esquire of Potter Anderson & Corroon LLP, Wilmington, Delaware. Counsel for Plaintiff and Counterclaim Defendant. Of Counsel: Michael J. Lennon, Esquire, Mark A. Hannemann, Esquire, R. Scott Roe, Esquire, Susan A. Smith, Esquire and Jeffrey S. Ginsberg, Esquire of Kenyon & Kenyon LLP, New York, New York.

Ashley Blake Stitzer, Esquire and Stephen B. Brauerman, Esquire of Bayard, P.A., Wilmington, Delaware. Counsel for Defendant and Counterclaim Plaintiff. Of Counsel: Gregory L. Hillyer, Esquire and Javier Sobrado, Esquire of Feldman Gale, P.A., Bethesda, Maryland, James A. Gale, Esquire of Feldman Gale, P.A., Miami, Florida.

MEMORANDUM OPINION

Dated: November 3, 2010
Wilmington, Delaware


ROBINSON, District Judge

I. INTRODUCTION

Presently before the court are six motions brought in this patent infringement action involving Robert Bosch LLC ("Bosch") and Pylon Manufacturing Corp. ("Pylon") relating to Bosch's United States Patent Nos. 6,292,974 ("the '974 patent"), 6,675,434 ("the '434 patent"), and 6,944,905 ("the '905 patent") (collectively, the "Bosch patents"). (D.I. 1) The procedural history of this action is complex and is described in greater detail below. Pending before the court are: (1) Bosch's renewed motion for judgment as a matter of law ("JMOL") or, in the alternative, for a new trial (D.I. 309); (2) Pylon's renewed motion for JMOL concerning the non-infringement of claims 1, 5 and 13 of the '434 patent (D.I. 316); (3) Pylon's renewed motion for JMOL or, in the alternative, motion to amend or alter the judgment concerning the invalidity of claim 13 of the '434 patent (D.I. 318); (4) Pylon's renewed motion for JMOL or, in the alternative, for a new trial regarding the invalidity of the '905 patent (D.I. 320); (5) Bosch's motion for leave to file a sur-reply in opposition to Pylon's motion for JMOL or, in the alternative, motion for a new trial regarding the invalidity of the '905 patent (D.I. 351); and (6) Bosch's motion for a permanent injunction (D.I. 311).

II. BACKGROUND¹

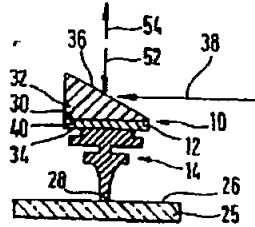
A. Patents in Suit

This case involves the refinement of several aspects of beam blade technology found in the Bosch patents, resulting in wiper blades that allow for better performance, visibility and safety on the road. The '974 patent, entitled "Glass Wiper Blade For Motor Vehicles," teaches a beam blade that prevents "lift-off" issues by deflecting wind up and over the blade through the use of a flexible spoiler on top of the support element. This deflection counteracts any "lift-off" tendency by creating additional downward force along the length of the wiper blade at higher speeds. ('974 patent at col. 1:58-2:3, 2:11-15) Claim 1, which is representative of the invention of the '974 patent, claims

[a] wiper blade for windows of motor vehicles, comprising a curved, band-shaped, spring-elastic support element which distributes a pressure applied by a wiper arm and has a concave and a convex surface which defines corresponding planes; an elongated rubber-elastic wiper strip placeable on a window to be wiped and mounted to said concave surface of said support element which faces the window, substantially longitudinally parallel to said concave surface; a connection device provided for a wiper arm and arranged directly on a convex side of said support element; and a component which is separate from said wiper strip and is mounted directly to the convex surface of said support element so as to form a leading-edge face extending in a longitudinal direction of the support element and forming, as seen crosswise to its longitudinal extension, an acute angle with a plane which extends parallel to a plane formed by said convex surface.

(*Id.* at col. 4:16-32) Figure 3 of the '974 patent discloses the cross section of an exemplary wiper blade:

¹This court's previous opinion on summary judgment, *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 700 F. Supp. 2d 625 (D. Del. 2010), provides a detailed description of the activities leading up to the filing of the Bosch patents and the nature of the Pylon products accused of infringing the Bosch patents ("Accused Pylon Products"). (D.I. 291 at 7-13)



The subject matter of the '434 patent, entitled "Wiper Blade For The Glass Surfaces Of Motor Vehicles With An Elongated, Spring-Elastic Support Element," addresses innovations with respect to wiper blade end caps. End caps serve a safety function, preventing injury to those who handle the wiper blades by covering the often sharp ends of the support element. ('434 patent at col. 1:63-65) However, end caps can adversely affect the elasticity of the spring element which, in turn, disrupts the wiper strip's even distribution of pressure upon the windshield. (*Id.* at col. 1:46-50) The '434 patent discloses end caps that are used to maintain the integrity of the wiper blade without adversely affecting the elasticity of the beam. (*Id.*) Claim 1 claims

[a] wiper blade for windows or other glass of motor vehicles, having an elongated, spring-elastic support element, on whose side toward the window or glass an elongated, rubber-elastic wiper strip that can be placed against the window or glass is located parallel to the longitudinal axis, and on the side of the support element remote from the window or glass, in the middle portion of the support element, a device for attaching a driven wiper arm is disposed, the two ends of the wiper blade each being covered by a respective termination part in the region of the support element, characterized in that the termination part has a base body, located on the side of the support element remote from the window and bracing itself on the wiper blade, which base body is provided with hook-like extensions that cross the support element on both of its long sides and engage the side of the support element toward the window from behind; that at least one detent shoulder pointing toward the other end portion is disposed on each of the two end portions of the support element, and a counterpart shoulder present on the termination part is associated with the detent shoulder; and that at least one

of the two shoulders and/or at least one of the two extensions is elastically deflectable.

(*Id.* at col. 7:41-65)

The '905 patent is entitled "Wiper Blade For Cleaning Screens In Particular On Motor Vehicles." Although existing separately from the '974 patent family, the '905 patent discloses the structure of a spoiler that could be used in conjunction with the invention of the '974 patent. The spoiler taught by the '905 patent includes two diverging legs, with an attack surface embodied on the outside of one leg, allowing for a reduction in both weight and material costs. ('905 patent at col. 1:55-64) The '905 patent also describes wiper blades that incorporate end caps. (*Id.* at col. 7:60-8:21) Claim 13 of the '905 patent, which is at issue in this case, reads:

13. A wiper blade for cleaning windows, comprising:

a band-like, elongated, spring-elastic support element, wherein a lower band surface oriented toward the window has an elongated, rubber-elastic wiper strip, which can be placed against the window, disposed on it so that the longitudinal axes of these two parts are parallel and wherein an upper band surface of the support element has a wind deflection strip disposed on it, wherein the wind deflection strip extends in a longitudinal direction of the support element, is provided with an attack surface oriented toward the main flow of the relative wind, and is made of an elastic material, wherein the wind deflection strip has two diverging legs, viewed in transverse cross section, wherein the two diverging legs are connected to each other at a common base and wherein free ends of the two diverging legs oriented toward the window are supported on the support element, and the attack surface is embodied on the outside of the one leg, wherein the upper band surface of the support element, in its middle section, includes a wiper blade part for connecting the wiper blade to a reciprocally driven wiper arm and is supported, wherein an end cap is respectively disposed at both ends of the support element, and wherein a section of the wind deflection strip is disposed between and in contact with each respective end cap and the device piece.

(*Id.* at col. 7:60-8:21)

B. Litigation History

Bosch filed this patent infringement action against Pylon on August 25, 2008, alleging that Pylon infringed certain claims of various wiper blade patents owned by Bosch. Following discovery, on November 12, 2009, Bosch moved for summary judgment of infringement of the '974 patent (D.I. 169), non-infringement of Pylon's U.S. Patent No. 6,640,380 ("the '380 patent") (D.I. 171), and no inequitable conduct and no invalidity for derivation of the '974 patent, the '905 patent and the '434 patent (D.I. 173). On the same date, Pylon moved for summary judgment of non-infringement and invalidity of four patents owned by Bosch. (D.I. 177)

The court granted in part and denied in part the parties' motions for summary judgment on March 30, 2010.² (D.I. 271) Specifically, the court: (1) granted Bosch's motion for summary judgment of infringement of the '974 patent with respect to claims 1 and 8 and denied summary judgment with respect to claim 2; (2) granted Bosch's motion for summary judgment of non-infringement of the '380 patent; (3) granted Bosch's motion for summary judgment of no inequitable conduct and no invalidity for derivation with respect to the '905 and '434 patents and denied summary judgment with respect to the '974 patent; (4) granted Pylon's motion for summary judgment of non-infringement of U.S. Patent No. 6,978,512 ("the '512 patent"); (5) denied Pylon's motion for summary judgment of non-infringement of the '974, '905 and '434 patents; (6) denied Pylon's motion for summary judgment that the '974 and '512 patents were invalid as anticipated or obvious; and (7) denied as moot Bosch's motion to strike the

²An amended memorandum opinion regarding the parties' motions for summary judgment issued on April 12, 2010. (D.I. 291)

expert report of Pylon's expert, Franz Buechele ("Buechele"). On the same date, the court issued its claim construction opinion. (D.I. 270)³

On April 12, 2010, the court entered an order granting in part and denying in part the parties' motions in limine. (D.I. 290) The court's order precluded Bosch from offering the post-discovery opinions of its expert, Steven Dubowsky ("Dubowsky"), which equate "bracing the wiper blade," as claimed by the '434 patent, with "touching" the support element and the wiper strip. (*Id.* at ¶ 1) The court found Dubowsky's post-discovery theory to be inconsistent with the specification of the '434 patent, both parties' proffered claim constructions, and the construction adopted by the court. (*Id.*) The court also granted in part Bosch's motions in limine to limit the prior art references that Pylon could rely on as invalidating prior art. (*Id.* at ¶ 2) A list attached to the court's order specifies the precise prior art patents and patent combinations on which the parties were permitted to present evidence at trial. (D.I. 290, Ex. A) In reaching its conclusion on the admissibility of invalidating prior art combinations, the court reviewed Pylon's expert report and assessed how much information the jury could appropriately and realistically assess. (3/30/10 Tr. at 35:7-11) The jury verdict sheet, which was agreed to by the parties, further reduced the number of prior art patents on which the jury could base its verdict, although the verdict sheet failed to provide the same level of specificity regarding permissible combinations of prior art patents. (D.I. 299)

A jury trial was held between April 15 and April 23, 2010. At trial, Bosch claimed that Pylon infringed the '434 patent and the '905 patent, and Pylon challenged the

³The court's claim construction opinion may be found at *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 2010 WL 1417874 (D. Del. Mar. 30, 2010).

validity of the '974 patent, the '434 patent and the '905 patent.

C. The Jury Verdict

On April 23, 2010, the jury found that claims 1 and 8 of the '974 patent were invalid on two grounds: (1) obviousness in view of the prior art; and (2) derivation from Johannes Fehrsen ("Fehrsen"). (D.I. 299 at 1-2) The jury also determined that claims 1 and 5 of the '434 patent were invalid for obviousness in light of the prior art, but claims 7 and 13 of the '434 patent and claim 13 of the '905 patent were valid. (*Id.* at 3) Furthermore, the jury found that Pylon infringed claims 1, 5 and 13 of the '434 patent and claim 13 of the '905 patent (*Id.* at 4), but did not infringe claim 7 of the '434 patent (*Id.* at 2). The parties filed their post-trial motions on May 26, 2010.

III. DISCUSSION

A. Motion for Judgment as a Matter of Law

To prevail on a renewed motion for judgment as a matter of law ("JMOL"), following a jury verdict under Federal Rule of Civil Procedure 50(b), the moving party "must show that the jury's findings, presumed or express, are not supported by substantial evidence or, if they were, that the legal conclusion(s) implied [by] the jury's verdict cannot in law be supported by those findings." *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1348 (Fed. Cir. 1998) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir. 1984)) (internal quotations omitted). "'Substantial' evidence is such relevant evidence from the record taken as a whole as might be accepted by a reasonable mind as adequate to support the finding under review." *Perkin-Elmer Corp.*, 732 F.2d at 893. In assessing the sufficiency of the evidence, the court must give the

non-moving party, “as [the] verdict winner, the benefit of all logical inferences that could be drawn from the evidence presented, resolve all conflicts in the evidence in his favor, and in general, view the record in the light most favorable to him.” *Williamson v. Consol. Rail Corp.*, 926 F.2d 1344, 1348 (3d Cir. 1991); *Perkin-Elmer Corp.*, 732 F.2d at 893. The court may not determine the credibility of the witnesses or “substitute its choice for that of the jury between conflicting elements of the evidence.” *Id.* In sum, the court must determine whether the evidence reasonably supports the jury's verdict. *See Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1014 (Fed. Cir. 1998).

1. Invalidity

The burden of proof to establish the invalidity of a patent is “clear and convincing evidence.” *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1058 (Fed. Cir. 2004). In conjunction with this burden, the Federal Circuit has explained that,

[w]hen no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1304 (Fed. Cir. 2008) (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1359 (Fed. Cir. 1984)).

a. Obviousness

“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.” 35 U.S.C. § 103(a). Obviousness is a question of law, which

depends on several underlying factual inquiries.

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.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966)). "Because patents are presumed to be valid, see 35 U.S.C. § 282, an alleged infringer seeking to invalidate a patent on obviousness grounds must establish its obviousness by facts supported by clear and convincing evidence." *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006) (citation omitted).

"[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 550 U.S. at 418. A defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed. *Id.* at 418-19. The Supreme Court has emphasized the need for courts to value "common sense" over "rigid preventative rules" in determining whether a motivation to combine existed. *Id.* at 419-20. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 420. However, in determining what would have been obvious to one of ordinary skill in the art at the time

of invention, the use of hindsight is not permitted. See *id.* at 421.

Although an expert is not the only source for evidence that it would be obvious for one skilled in the art to combine references to reach the claimed product, “some kind of motivation must be shown from some source, so that the jury can understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented [product].” *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (quoting *Innogenetics, N.V. v. Abbott Laboratories*, 578 F. Supp. 2d 1079, 1086 (W.D. Wis. 2007)). “[T]he motivation to modify a reference can come from the knowledge of those skilled in the art, from the prior art reference itself, or from the nature of the problem to be solved.” *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356-57 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998)). In addition to showing that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, a defendant must also demonstrate, by clear and convincing evidence, that “such a person would have had a reasonable expectation of success in doing so.” *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

(1) '974 patent

Pursuant to the court's in limine order, Pylon presented evidence to show the obviousness of the '974 patent in light of prior art U.S. Patent No. 5,325,564 (“the '564 patent”) in combination with one of several other prior art patents. These additional patents included, among others, U.S. Patent Nos. 3,879,793 (“the '793 patent”) and

3,881,214 ("the '214 patent"). The court's in limine order, viewed in light of the options available on the jury's verdict sheet, precluded a finding of obviousness based on any single prior art reference and any combination of prior art references that did not include the '564 patent. However, the jury checked boxes on its verdict sheet indicating that claim 1 of the '974 patent was obvious in light of the '793 patent and/or the '214 patent and claim 8 of the '974 patent was obvious in light of the '214 patent, failing to indicate obviousness in light of the '564 patent on either claim 1 or claim 8 of the '974 patent. (D.I. 299 at ¶ 1)

In support of its motion for JMOL, Bosch argues that the jury's verdict cannot be based on substantial evidence because the court's in limine order barred Pylon from arguing the invalidity of claims 1 and 8 of the '974 patent for obviousness based on the '793 patent and the '214 patent, either alone or in combination with each other. (D.I. 310 at 19-20) Even if Pylon were permitted to present evidence of obviousness based only on the '793 patent and/or the '214 patent, Bosch contends that the prior art references, either alone or in combination with each other, do not describe a wiper blade featuring each limitation of the '974 patent. (*Id.* at 22) Moreover, Bosch contends that deference should be given to the validity of the '974 patent because both the '793 patent and the '214 patent were considered by the United States Patent and Trademark Office ("USPTO") during the prosecution of the '974 patent. (*Id.*)

In response, Pylon argues that the verdict sheet did not place any limitations on finding claims 1 and 8 of the '974 patent obvious in light of the '793 patent and/or the '214 patent. (D.I. 330 at 18) Contrary to Bosch's contention, Pylon maintains that the '214 patent and the '793 patent contain features that can be associated with each

limitation of the '974 patent. (*Id.* at 19) According to Pylon, the beam blade does not constitute a "missing element" because its features were well-known in the art at the time of the invention, and the '974 patent is designed to counteract wind lift problems experienced on all wiper blades, not just beam blades. (*Id.* at 19-20) Pylon also points to the testimony of Bosch's expert, who conceded that one of ordinary skill in the art would understand from the teachings of the '793 patent that a triangular shape having an inclined ramp counteracts wind lift regardless of whether the spoiler is on a beam blade or a bracketed blade. (*Id.* at 23) Pylon also relies on the testimony of its own expert regarding known wind lift problems to demonstrate a motivation to combine the '793 and '214 patents and show that a person of ordinary skill in the art could ascertain a common sense solution to this problem by using triangular shapes on top of the wiper blades without any unexpected results. (*Id.* at 24)

After reviewing the evidence presented at trial in the light most favorable to Pylon as the verdict winner, the court concludes that the jury's obviousness verdict with respect to claims 1 and 8 of the '974 patent was not based on substantial evidence. The court's in limine order precluded Pylon from presenting evidence in support of the invalidity of the '974 patent based on the '793 patent and/or the '214 patent in the absence of the '564 patent, and Pylon does not dispute that it complied with the court's order. As a result, no expert testimony supports the theory that one of ordinary skill in the art would be motivated to place a spoiler on top of a beam blade to reduce wind lift based on the teachings of the '793 patent and/or the '214 patent. Although the jury's verdict sheet did not preclude the jury from reaching its finding, Pylon was responsible for presenting its evidence to the jury in a manner that would allow the jury to find by

clear and convincing evidence that the Bosch patents were invalid. Given that no evidence was presented at trial on the invalidity of the '974 patent in light of the '793 patent and the '214 patent, either alone or in combination with each other, the court concludes that the jury did not have substantial evidence to determine that claims 1 and 8 of the '974 patent were invalid for obviousness.

(2) '434 patent

Pursuant to the court's in limine order, Pylon presented evidence to show the obviousness of claims 1, 5 and 13 of the '434 patent in light of the '564 patent in combination with one of several other prior art patents. These additional patents included, among others, U.S. Patent Nos. 3,083,394 ("the '394 patent") and 3,116,507 ("the '507 patent"). The court's in limine order, viewed in light of the options available on the jury's verdict sheet, precluded a finding of obviousness based on any single prior art reference or any combination of prior art references that did not include the '564 patent. The jury checked boxes on its verdict sheet indicating that claims 1 and 5 of the '434 patent were obvious in light of the '394 patent and/or the '507 patent, but the jury failed to indicate obviousness in light of the '564 patent on either claim 1 or claim 5 of the '434 patent. (D.I. 299 at ¶ 4) The jury further found that claim 13 of the '434 patent was valid. (*Id.*)

(a) Claims 1 and 5

In support of its motion for JMOL regarding the non-obviousness of the '434 patent, Bosch again argues that the court's in limine order barred Pylon from arguing obviousness based on the '394 patent and the '507 patent, either alone or in

combination with each other. (D.I. 310 at 25) Furthermore, Bosch contends that the '394 and '507 patents are interchangeable and do not support a claim for obviousness because they fail to describe the beam blade, connection device and end cap described in the '434 patent. (*Id.* at 26) Bosch also maintains that deference should be given to the validity of the '434 patent because the type of technology described in the '394 patent and the '507 patent was considered by the USPTO during the prosecution of the '434 patent. (*Id.* at 24)

Pylon responds that the limitations allegedly missing from the prior art cited by the jury were already part of the relevant prior art at the time of the patent, and a separate reference for those limitations was not necessary given the limitations that are expressly disclosed in the '394 and '507 patents. (D.I. 330 at 27) In particular, Pylon notes that its expert revealed a termination part "supporting itself on **both** the support element and the wiper strip" in both the '394 patent and the '507 patent in accordance with the court's construction.⁴ (*Id.* at 28) According to Pylon, the advantages provided by the '434 patent over the prior art were available prior to the filing of the '434 patent, and a person of ordinary skill in the art would not expect a safety feature such as an end cap to provide an unexpected result. (*Id.* at 30) Furthermore, Pylon's expert maintained that the use of an end cap on one end of the wiper blade renders obvious the use of an end cap on the other end. (*Id.* at 28)

After reviewing the evidence presented at trial in the light most favorable to Pylon as the verdict winner, the court concludes that the jury's obviousness verdict with

⁴The court construed "bracing itself on the wiper blade" to mean "supporting itself on both the support element and the wiper strip." (D.I. 270 at 5)

respect to claims 1 and 5 of the '434 patent was not based on substantial evidence. The court's in limine order precluded Pylon from presenting evidence in support of the invalidity of the '434 patent based on the '394 patent and/or the '507 patent in the absence of the '564 patent, and Pylon complied with the court's order. As a result, no expert testimony supports the theory that one of ordinary skill in the art would be motivated to place end caps that brace themselves on the wiper blade on both ends of the blade based on the teachings of the '394 patent and/or the '507 patent. Although the jury's verdict sheet did not preclude the jury from reaching its finding, Pylon was responsible for presenting its evidence to the jury in a manner that would allow the jury to find by clear and convincing evidence that the Bosch patents were invalid. Given that no evidence was presented at trial on the invalidity of the '434 patent in light of the '394 patent and the '507 patent, either alone or in combination with each other, the court concludes that the jury did not have substantial evidence to determine that claims 1 and 5 of the '434 patent were invalid for obviousness.

(b) Claim 13

In its renewed motion for JMOL, Pylon contends that the jury erred in concluding that claim 13 of the '434 patent was valid because the prior art expressly discloses the plastic end cap contained in claim 13 of the '434 patent. (D.I. 319 at 4) Specifically, Pylon contends that the additional plastic end cap limitation in claim 13 of the '434 patent is comparable to the one described in the '507 prior art patent cited by the jury in finding claim 1 of the '434 patent obvious. (*Id.*) Pylon further observes that Bosch's expert failed to contest the teaching of plastic end caps in the prior art. (*Id.* at 7)

In response, Bosch urges the court to grant its motion for JMOL and find claim 1 valid but, regardless of the court's conclusion on the validity of claim 1 of the '434 patent, Bosch contends that the court should not grant Pylon's motion for JMOL on claim 13 because a reasonable jury could have found that claim 13 of the '434 patent was valid. (D.I. 334 at 4-6) Bosch maintains that, while claim 1 does not require the end cap to be "elastically deflectable," claim 13 describes an end cap that must be made of elastic plastic. In this regard, the only evidence Pylon produced at trial in support of its argument was the '507 patent, which does not specify that the end cap is elastically deflectable. (*Id.* at 7-8) Bosch further argues that the prior art cited by the jury fails to disclose all of the relevant limitations of claim 13 of the '434 patent, and Pylon failed to present admissible evidence of a motivation to combine those references by one of ordinary skill in the art. (*Id.* at 12-13) In addition, Bosch claims that its evidence of secondary factors such as the commercial success of the wiper blades and the long-felt need in the industry for the features embodied in claim 13 of the '434 patent further bolsters its contention that the court should uphold the jury verdict regarding the validity of claim 13. (*Id.* at 13-16)

After reviewing the evidence presented at trial in the light most favorable to Bosch as the verdict winner, the court concludes that the jury's non-obviousness verdict with respect to claim 13 of the '434 patent was based on substantial evidence. Although the jury was not required to specify which evidence it relied upon or rejected in reaching its verdict, for purposes of responding to the issues raised by Pylon's motion for JMOL, the court concludes that sufficient evidence existed from which a reasonable jury could find claim 13 of the '434 patent valid. Even assuming the court were to

uphold the jury's finding of obviousness on claim 1 of the '434 patent, claim 13 contains an additional limitation. The jury could reasonably conclude that the prior art references cited by Pylon failed to meet the teachings of claim 13 of the '434 patent, particularly with respect to the elastic plastic material specified by claim 13 which is not clearly present in the prior art presented by Pylon at trial. Furthermore, Pylon presented little to no evidence of a motivation to combine elements of the prior art to achieve the '434 patent. Pylon had the burden of proving the obviousness of claim 13 of the '434 patent by clear and convincing evidence, and the court cannot substitute its own judgment for the jury's where conflicting elements of evidence are present. Given that substantial evidence was presented at trial on the validity of claim 13 the '434 patent, the court upholds the jury's conclusion that claim 13 of the '434 patent is valid.

(3) '905 patent

The jury concluded that claim 13 of the '905 patent was not obvious in light of U.S. Patent No. 6,279,191 ("the '191 patent") and British Patent GB 2,106,775 ("the '775 patent"). In its motion for JMOL, Pylon argues that no reasonable jury could conclude that claim 13 of the '905 patent is valid because expert testimony showed that the prior art references were nearly identical to claim 13 of the '905 patent. (D.I. 321 at 9) According to Pylon, the prior art of record expressly discloses physical contact between the spoiler of a beam blade and either the device piece or the end caps, and Pylon's expert testified that one of ordinary skill in the art would have been motivated to combine the features of the '191 patent and the '775 patent because a hollow spoiler offers cost and production advantages. (*Id.* at 9-10)

Bosch responds that the jury verdict should be upheld because Pylon did not

disclose each and every limitation of claim 13 of the '905 patent in the prior art references. (D.I. 335 at 4) Specifically, Bosch contends that the '905 patent requires contact between the spoiler, both end caps, and the device piece, and the prior art presented by Pylon did not meet those requirements due to a space between the end caps and the spoiler as well as a space between the device piece and the spoiler. (*Id.* at 5) Bosch maintains that the jury could have credited Dubowsky's testimony regarding the absence of a motivation by one of ordinary skill in the art to eliminate the gaps between the spoiler and the device piece or the spoiler and the end caps in the '191 patent, whereas Buechele's testimony regarding a motivation to combine the '191 patent with the '775 patent falls outside the scope of his expert report. (*Id.* at 10, 17) Moreover, Bosch maintains that secondary considerations regarding the commercial success of wiper blades embodying claim 13 of the '905 patent further support the jury's verdict regarding the validity of claim 13 of the '905 patent. (*Id.* at 18)

After reviewing the evidence presented at trial in the light most favorable to Bosch as the verdict winner, the court concludes that the jury's non-obviousness verdict with respect to claim 13 of the '905 patent was based on substantial evidence. Although the jury was not required to specify which evidence it relied upon or rejected in reaching its verdict, for purposes of responding to the issues raised by Pylon's motion for JMOL, the court concludes that sufficient evidence existed from which a reasonable jury could find claim 13 of the '905 patent valid. The jury could reasonably conclude that the prior art references cited by Pylon failed to meet the teachings of claim 13 of the '905 patent, particularly with respect to the required contact between the spoiler, the device piece and the end caps specified by claim 13. Although the court does not

dispute that Pylon presented expert testimony in support of its obviousness argument, the jury was charged with making credibility determinations regarding the expert witnesses. Pylon had the burden of proving the obviousness of claim 13 of the '905 patent by clear and convincing evidence, and the court cannot substitute its own judgment for the jury's where conflicting elements of evidence are present. Given that substantial evidence was presented at trial on the validity of claim 13 the '905 patent, the court upholds the jury's conclusion that claim 13 of the '905 patent is valid.

b. Derivation of the '974 patent

At trial, Pylon claimed that the '974 patent was invalid under 35 U.S.C. § 102(f), which states: "A person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented." Assertion of this subsection as a defense amounts to a claim that the patentee derived the invention from another. *See Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993). A party bringing a claim for patent invalidity under 35 U.S.C. § 102(f) must demonstrate, by clear and convincing evidence, both conception of the invention by another and communication of the invention to the patentee. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997) (citing *Price*, 988 F.2d at 1190).

Conception is the "formation in the inventor's mind of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (citations omitted). A conception must encompass all limitations of the claimed invention, and "is complete only when the idea is so clearly defined in the inventor's

mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.” *Singh v. Brake*, 317 F.3d 1334, 1340 (Fed. Cir. 2002) (citations omitted). Put differently, every limitation must be shown to have been known to the inventor at the time the invention is alleged to have been conceived. *Davis v. Reddy*, 620 F.2d 885, 889 (C.C.P.A. 1980) (citing *Schur v. Muller*, 372 F.2d 546, 551 (1967); *Anderson v. Anderson*, 403 F. Supp. 834, 846 (D. D.C. 1975)).

Upon the issuance of a patent, it is presumed that there are no inventors other than those listed on the patent. *Bd. of Educ. v. Am. Bioscience, Inc.*, 333 F.3d 1330, 1337 (Fed. Cir. 2003). A party challenging this presumption must prove, by clear and convincing evidence, that it significantly contributed to the conception of the invention. *Id.* An inventor’s testimony stating that he contributed to the conception at issue is not, by itself, enough to support a finding of inventorship. Such testimony must be corroborated by either contemporaneous documents, testimony of someone else or circumstantial evidence. *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1461 (Fed. Cir. 1998). “Circumstantial evidence about the inventive process may also corroborate” the inventor’s testimony. *Id.* (citing *Knorr v. Pearson*, 671 F.2d 1368).

Factors to be considered in assessing corroboration include:

- (1) the relationship between the corroborating witness and the alleged prior user;
- (2) the time period between the event and trial; (3) the interest of the corroborating witness in the subject matter in suit; (4) contradiction or impeachment of the witness’ testimony; (5) the extent and details of the corroborating testimony; (6) the witness’ familiarity with the subject matter of the patented invention and the prior use; (7) probability that a prior use could occur considering the state of the art at the time; (8) impact of the invention on the industry, and the commercial value of its practice.

Woodland Trust v. Flowertree Nursery, 148 F.3d 1368, 1371 (Fed. Cir. 1998).

"Whether the inventor's testimony has been sufficiently corroborated is evaluated under a 'rule of reason analysis,'" which requires that "an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the alleged inventor's story may be reached." *Ethicon*, 135 F.3d at 1461 (quoting *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993)).

The standard for finding communication of a prior conception requires "communication of a complete conception . . . sufficient to **enable** one of ordinary skill in the art to construct and successfully operate the invention." *Gambro Lundia*, 110 F.3d at 1577 (quoting *Hedgewick v. Akers*, 497 F.2d 905, 908, 182 U.S.P.Q. 167, 169 (C.C.P.A. 1974)). Communication of the conception to the patentee may be made by either public knowledge or private communications, and must be sufficient to enable one skilled in the art to make the patented invention. *Cordance Corp. v. Amazon.com, Inc.*, 687 F. Supp. 2d 449, 479 (D. Del. 2010).

(1) Claim 8

In its renewed motion for JMOL, Bosch alleges that the jury's finding that Bosch derived claim 8 of the '974 patent from Fehrser is not supported by substantial evidence because Pylon failed to prove Fehrser's conception of claim 8, which states "wherein said leading-edge face extends at least nearly over an entire length of the wiper blade." (D.I. 310 at 6) Bosch contends that Fehrser did not testify about this limitation at trial, and Adriaan Swanepoel ("Swanepoel"), a South African engineer who worked with Fehrser on wiper blade technology, testified that he could "not recall any

discussion on the lengthwise extent of such a spoiler.” (*Id.*) Pylon responds that Swanepoel conceived of the spoiler contained in claim 8 in a 1991 memorandum, and this spoiler served as the starting point for Fehrsen’s ideas to mount an elastic spoiler on the convex surface of a beam blade. (D.I. 330 at 3) Based on Swanepoel’s testimony and Fehrsen’s notes from the September 1992 meeting, Pylon contends that it was readily understood that the length of the spoiler would depend on necessity and that the spoiler had a continuous profile across the blade. (*Id.* at 3-4) Pylon also maintains that claim 8 of the ‘974 patent does not add any patentably distinct subject matter and was well-known in the art at the time of Fehrsen’s conception. (*Id.* at 4)

After reviewing the evidence presented at trial in the light most favorable to Pylon as the verdict winner, the court concludes that the jury’s derivation verdict regarding claim 8 of the ‘974 patent was not based on substantial evidence. If anything, Swanepoel’s 1991 memorandum supports a finding that claim 8 of the ‘974 patent was derived from Swanepoel rather than Fehrsen. However, the jury declined to accept the theory that claim 8 of the ‘974 patent was derived from Swanepoel after reviewing the evidence. Pylon’s contention that the 1991 memorandum served as the “starting point” for Fehrsen’s allegedly derived concept is conclusory and lacks evidentiary support to show how Swanepoel’s conception differs from Fehrsen’s conception and/or the claim 8 limitation of the ‘974 patent.

The court concludes that Fehrsen’s 1992 meeting notes also fail to support the jury’s derivation finding because they show only a cross-section of the wiper blade and give no indication of whether the leading edge face extends at least nearly over the entire length of the blade as specified in claim 8. Swanepoel’s testimony does nothing

to fill the gaps in Fehrsen's notes because he testified that he recalled no discussion regarding the length of the leading edge face of the spoiler. Furthermore, evidence that claim 8 was well-known in the prior art has no bearing on a derivation analysis. Given that no evidence presented at trial illustrated the length of the leading edge face as described in claim 8 of the '974 patent, the court concludes that the jury did not have substantial evidence to determine that claim 8 was invalid as derived from Fehrsen.

(2) Claim 1

Bosch alleges that the jury's derivation verdict on claim 1 of the '974 patent is erroneous because Pylon did not sufficiently corroborate Fehrsen's testimony regarding his conception of claim 1 of the '974 patent. (D.I. 310 at 9) Specifically, Bosch claims that Swanepoel's testimony is insufficient corroboration as a matter of law because Swanepoel is an interested witness and possible co-inventor who receives royalties from a Bosch competitor and whose testimony was enhanced by his preparation by Pylon's attorneys. (*Id.* at 9-10) According to Bosch, Fehrsen's meeting notes likewise give no indication of whether Fehrsen originated the ideas contained in his sketches or whether he made notations on ideas that were presented by Bosch at the September 1992 meeting. (*Id.* at 8) Furthermore, Bosch maintains that the testimony of Wilfried Merkel ("Merkel"), a named inventor of the '974 patent, regarding his communication of claim 1 at the September 1992 meeting must be credited because Swanepoel did not attend the meeting where the invention of claim 1 was allegedly communicated and testified that he did not "have any idea what happened at the meeting." (*Id.* at 7)

Pylon responds that Swanepoel is not an interested witness and his testimony

provided sufficient corroboration of the conception of claim 1 by Fehrsen, particularly in combination with Fehrsen's testimony, Fehrsen's notes and circumstantial evidence. (D.I. 330 at 10-11) According to Pylon, it was within the province of the jury to credit Fehrsen's testimony regarding his communication of claim 1 of the '974 patent over Merkel's conflicting testimony. (*Id.* at 6) In addition, Pylon contends that Swanepoel's testimony, Fehrsen's meeting notes, and several circumstantial factors directly support Fehrsen's testimony that Fehrsen communicated the idea for claim 1 of the '974 patent to Bosch at the September 1992 meeting. (*Id.*)

After reviewing the evidence presented at trial in the light most favorable to Pylon as the verdict winner, the court concludes that the jury's derivation verdict regarding claim 1 of the '974 patent was based on substantial evidence. Although the court acknowledges that Fehrsen's testimony alone is not enough to support a claim for derivation, the court finds that Swanepoel's testimony corroborates Fehrsen's testimony of the conception of claim 1 of the '974 patent, and it was within the province of the jury to assess Swanepoel's credibility as a witness. The court agrees that Swanepoel's testimony regarding the September 1992 meeting is not conclusive because he did not attend the meeting, but this does not mean that the jury was required to credit Merkel's testimony instead. Furthermore, while Fehrsen's meeting notes do not clarify who originated the conceptions embodied in his sketches, the jury determined that Fehrsen originated the ideas after a review of the notes in combination with circumstantial factors. Fehrsen's testimony, his meeting notes and various circumstantial factors support not only his conception of claim 1 of the '974 patent, but also his communication of that conception at the September 1992 meeting. Given that

substantial evidence was presented at trial regarding the derivation of claim 1 of the '974 patent from Fehrsen, the court upholds the jury's conclusion that claim 1 of the '974 patent is invalid for derivation.

2. Infringement

A patent is infringed when a person "without authority makes, uses or sells any patented invention, within the United States . . . during the term of the patent." 35 U.S.C. § 271(a). A two-step analysis is employed in making an infringement determination. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). First, the court must construe the asserted claims to ascertain their meaning and scope. See *id.* Construction of the claims is a question of law subject to de novo review. See *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). The trier of fact must then compare the properly construed claims with the accused infringing product. See *Markman*, 52 F.3d at 976. This second step is a question of fact. See *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998).

"Direct infringement requires a party to perform each and every step or element of a claimed method or product." *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1378 (Fed. Cir. 2007). "If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law." *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). If an accused product does not infringe an independent claim, it also does not infringe any claim depending thereon. See *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989). However, "[o]ne may infringe an independent claim and not infringe a claim dependent

on that claim.” *Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1359 (Fed. Cir. 2007) (quoting *Wahpeton Canvas*, 870 F.2d at 1552) (internal quotations omitted). A product that does not literally infringe a patent claim may still infringe under the doctrine of equivalents if the differences between an individual limitation of the claimed invention and an element of the accused product are insubstantial. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 24, 117 S. Ct. 1040, 137 L. Ed. 2d 146 (1997). The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence. See *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988) (citations omitted).

a. Claim 7 of the ‘434 patent

Bosch claims that the jury erred in finding that claim 7 of the ‘434 patent was not infringed by the Accused Pylon Products. Claim 7 describes a “detent shoulder . . . embodied on a detent tooth that protrudes from the long side of the support element.” (‘434 patent at col. 7:27-29) The court construed this limitation to mean “[a] protrusion, one surface of which defines a detent shoulder” and declined to import the angular structure requirement of the detent teeth depicted in figure 6 based on one embodiment. (D.I. 270 at ¶ 18) The court construed the “long sides” of the support element to mean the “longitudinal sides of the support element,” noting that the ‘434 patent distinguishes between the long sides and the long edges. (*Id.* at ¶ 16)

Specifically, the court stated:

Defendant argues that this construction would encompass “sides” that are not “long,” and instead proposes a construction with reference to the longitudinal “edge” of the support element. Irrespective of the court’s disagreement with the logic of this argument, the ‘434 patent distinguishes

between the long **sides** (claims 1, 4, 5, and 7) and the long **edges** (claim 11) of the support element.

(*Id.*)

According to Bosch, Pylon's only testimony in support of its argument for non-infringement of claim 7 impermissibly contradicted the court's claim construction order. (D.I. 310 at 32-33) Bosch contends that, while it presented evidence of infringement under the court's claim construction in the form of Dubowsky's expert testimony, Pylon's only non-infringement testimony was based on a rejected claim construction that the "long side" refers only to the outermost edge of the left and right sides. (*Id.*) Bosch claims that Pylon caused confusion by trying to distinguish the side and the edge in a manner contrary to the court's claim construction. (D.I. 341 at 27) In response, Pylon contends that a jury verdict finding infringement of claim 7 is not compelled by the court's construction of the terms in that claim, nor do the parties' experts' differing interpretations of the terms compel a judgment for Bosch. (D.I. 330 at 35) Pylon argues that the jury was entitled to credit the testimony of Pylon's expert over Bosch's expert, who presented a complicated theory that divided the surface of the support element into middle, left and right zones and was not supported by the figures of the '434 patent or any expert report. (*Id.* at 36) Pylon further contends that its defense did not contradict the court's claim construction order, and Pylon's expert explained how his understanding of the "long sides" of the support element was consistent with the '434 patent's description in figure 6. (*Id.*)

After reviewing the evidence presented at trial in the light most favorable to Pylon as the verdict winner, the court concludes that the jury's non-infringement verdict

regarding claim 7 of the '434 patent was based on substantial evidence. The court acknowledges that the testimony presented by Pylon strained the limits of the term "long side" as defined by the court's claim construction order. However, the court rejects Bosch's argument that Pylon's expert testimony rose to the level of violating the court's claim construction order. Bosch had the burden of proving the infringement of claim 7 of the '434 patent by a preponderance of the evidence, and the court cannot substitute its own judgment for the jury's where conflicting evidence is present. Given that Pylon presented substantial evidence in support of its claim of non-infringement of claim 7 of the '434 patent, the court denies Bosch's motion for JMOL with respect to the non-infringement of claim 7 of the '434 patent.

b. Claims 1, 5 and 13 of the '434 patent

In its renewed motion for JMOL, Pylon argues that no reasonable jury could have found that claims 1, 5 and 13 of the '434 patent were infringed based on the court's claim construction of the term "bracing itself on the wiper blade." (D.I. 317) The court construed "bracing itself on the wiper blade" to mean "supporting itself on both the support element and the wiper strip." (D.I. 270 at ¶ 11) The court further explained that "[a]lthough claim 1 refers to bracing on both wiper strip (20) and support element (16), the inventive nature of the '434 patent, illuminated by the intrinsic record, does not require that such bracing be simultaneous." (*Id.*)

Pylon contends that the Accused Pylon Products do not meet the requirements of the court's claim construction because they do not brace themselves on both the support element and the wiper strip. (D.I. 317 at 5) According to Pylon, both parties' experts agreed that the end caps in the Accused Pylon Products support themselves

only on the support element. (*Id.* at 6) Furthermore, Pylon maintains that evidence showing both the end cap and the wiper strip supported on the support element is not sufficient to demonstrate a functional relationship between the end cap and the wiper strip as required by the court's claim construction. (*Id.*) Bosch responds that Dubowsky's testimony (which tracks the court's claim construction, the jury instructions and the verdict) supports the theory that the end cap contained in the Accused Pylon Products was supported by both the wiper strip and the support element. (D.I. 333 at 3-4) According to Bosch, the physical exhibits of the Accused Pylon Products also show that the end caps in the infringing products support themselves on both the support element and the wiper strip. (*Id.* at 4) Furthermore, Bosch maintains that the court rejected Pylon's alternative claim construction and affirmed in the jury instructions that "bracing" does not require "touching" as long as a functional relationship exists between the end caps and the wiper strip. (*Id.* at 3)

After reviewing the evidence presented at trial in the light most favorable to Bosch as the verdict winner, the court concludes that the jury's infringement verdict regarding claims 1, 5 and 13 of the '434 patent was based on substantial evidence. The jury could find Dubowsky's testimony more credible and rely on its own conclusions concerning the Accused Pylon Products, and the court cannot substitute its own judgment for the jury's where, as here, conflicting evidence is present. Given that substantial evidence supported the jury's finding of infringement of claims 1, 5 and 13 of the '434 patent, the court denies Pylon's motion for JMOL with respect to the infringement of those claims.

B. Motion for a New Trial

The decision to grant or deny a new trial is within the sound discretion of the trial court and, unlike the standard for determining judgment as a matter of law, the court need not view the evidence in the light most favorable to the verdict winner. *See Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 36 (1980). Federal Rule of Civil Procedure 59(a) provides, in pertinent part:

A new trial may be granted to all or any of the parties and on all or part of the issues in an action in which there has been a trial by jury, for any of the reasons for which new trials have heretofore been granted in actions at law in the courts of the United States.

New trials are commonly granted where: (1) the jury's verdict is against the clear weight of the evidence, and a new trial must be granted to prevent a miscarriage of justice; (2) newly-discovered evidence surfaces that would likely alter the outcome of the trial; (3) improper conduct by an attorney or the court unfairly influenced the verdict; or (4) the jury's verdict was facially inconsistent. *See Zarow-Smith v. N.J. Transit Rail Operations*, 953 F.Supp. 581, 584 (D.N.J.1997) (citations omitted). The court, however, must proceed cautiously and cannot substitute its own judgment of the facts and assessment of the witnesses' credibility for the jury's independent evaluation. Nevertheless,

[w]here a trial is long and complicated and deals with a subject matter not lying within the ordinary knowledge of jurors a verdict should be scrutinized more closely by the trial judge than is necessary where the litigation deals with material which is familiar and simple, the evidence relating to ordinary commercial practices. An example of subject matter unfamiliar to a layman would be a case requiring a jury to pass upon the nature of an alleged newly discovered organic compound in an infringement action.

Siemens Medical Solutions USA, Inc. v. Saint-Gobain Ceramics & Plastics, Inc., 615 F. Supp. 2d 304, 309-10 (D. Del. 2009) (quoting *Lind v. Schenley Indus. Inc.*, 278 F.2d 79, 90-91 (3d Cir.1960)). Pursuant to Fed. R. Civ. P. 50(c), if the court grants a renewed motion for JMOL, it must also conditionally rule on any motion for a new trial by determining whether a new trial should be granted if the judgment is later vacated or reversed. Fed. R. Civ. P. 50(c)(1).

1. Obviousness of the '974 patent and the '434 patent

Bosch argues that the jury's verdict of obviousness of claims 1 and 8 of the '974 patent and claims 1 and 5 of the '434 patent is against the weight of the evidence and warrants a new trial. (D.I. 310 at 27) Specifically, Bosch contends that its expert testified that the prior art patents did not embody every limitation of the claimed inventions, and Pylon presented no evidence of a motivation by one of ordinary skill in the art to combine the prior art patents to achieve the claimed invention. (*Id.* at 27-28) Furthermore, Bosch maintains that the prior art was either literally considered by the PTO or it was cumulative to other prior art considered by the PTO, and secondary factors such as the commercial success of the blades also support Bosch's claim for non-obviousness. (*Id.* at 28-30) Pylon counters that the jury was free to accept the opinions of its expert over Bosch's expert, and the evidence of secondary considerations presented by Bosch does not control the obviousness determination and was not adequately substantiated. (D.I. 330 at 32-33)

Pursuant to Fed. R. Civ. P. 50(c)(1), the court conditionally grants a new trial on the obviousness of claims 1 and 8 of the '974 patent and claims 1 and 5 of the '434

patent because the jury's verdict was against the clear weight of the evidence. Both parties presented evidence on prior art references upon which the jury could have reasonably based its verdict. However, the jury based its obviousness verdict on combinations of prior art not presented at trial by either party because they were precluded by the court's in limine order. As such, the jury's verdict goes against the clear weight of the evidence and, if this court's order granting Bosch's motion for JMOL is reversed on appeal, a new trial is warranted on the obviousness of claims 1 and 8 of the '974 patent and claims 1 and 5 of the '434 patent. Accordingly, Bosch's motion for a new trial on the obviousness of claims 1 and 8 of the '974 patent and claims 1 and 5 of the '434 patent is conditionally granted.

2. Derivation of the '974 patent

Bosch also argues that the jury's derivation finding is against the weight of the evidence taken as a whole and a new trial is warranted to prevent a miscarriage of justice. (D.I. 310 at 12) Bosch points to Merkel's testimony regarding the sketch pad on which he allegedly proposed the invention at the September 1992 meeting and to Swanepoel's lengthy manuals on beam-blade technology that did not mention the spoiler invention. (*Id.* at 12-13) Bosch alleges that the jury overlooked Fehrsen's admission that Anglo American Industrial Corporation ("AMIC") lacked expertise with rubber beam blade technology in September of 1992, as well as evidence showing that Fehrsen was skeptical about the '974 patent working, his preference being instead the second inclined beam solution contained in his notes. (*Id.* at 14) Furthermore, Bosch contends that neither Swanepoel nor Fehrsen claimed ownership of the spoiler

invention when Merkel presented it on behalf of Bosch at the 1997 meeting in Leipzig. (*Id.*) According to Bosch, Fehrsen warranted that Bosch had not used any of AMIC's beam blade technology before selling it to Trico Products Corporation ("Trico"), a Bosch competitor, who neither caused AMIC to sue Bosch for infringement nor made products incorporating the spoiler found in the '974 patent. (*Id.* at 15-16) Moreover, Bosch points to inconsistencies in Fehrsen's testimony to further indicate that the weight given to his testimony by the jury was misplaced. (*Id.* at 16-18)

Pylon responds that a new trial should not be granted because the jury's verdict on the derivation of claims 1 and 8 of the '974 patent was not against the clear weight of the evidence. (D.I. 330 at 13) Pylon notes that Bosch never produced the flip chart that allegedly contained Merkel's drawing of the '974 patent and that Merkel expressed uncertainty regarding whether the flip chart ever existed. (*Id.*) Furthermore, Pylon contends that Bosch's failure to bring a beam blade to market prior to its joint venture with AMIC undercuts its suggestion that its superior understanding of beam blade technology enabled it to propose a spoiler. (*Id.* at 14) Pylon also maintains that Fehrsen's admission that he preferred the inclined beam design does not disprove that he conceived of both designs. (*Id.* at 14-15) According to Pylon, Fehrsen and Swanepoel adequately explained their failure to assert ownership over the design of the '974 patent at the 1997 meeting because they believed Bosch would not commercialize the product without a license, which they refused to grant. (*Id.* at 15) Moreover, Pylon contends that the minor inconsistencies in the testimony of Fehrsen and Swanepoel is insufficient to warrant a new trial. (*Id.* at 16)

To the extent Bosch contends that the jury's verdict is against the weight of the evidence, the court acknowledges that it need not construe the evidence in the light most favorable to Pylon in the context of determining whether a new trial is warranted. However, even without the benefit of this less stringent standard, the court concludes that the jury's derivation verdict regarding claim 1 of the '974 patent is supported by sufficient evidence, and the court is not persuaded that the jury's verdict shocks the conscience or results in a miscarriage of justice. The court acknowledges that Bosch presented evidence in the form of witness testimony, manuals and circumstantial factors in support of its argument. However, Pylon also presented witness testimony, notes from the September 1992 meeting and circumstantial factors in support of its derivation claim regarding claim 1 of the '974 patent, and the court shall not overturn the jury's factual findings where a clear evidentiary basis for those findings exists. Accordingly, the court concludes that a new trial is not warranted with respect to the derivation of claim 1 of the '974 patent.

Pursuant to Fed. R. Civ. P. 50(c)(1), the court conditionally grants a new trial on the derivation of claim 8 of the '974 patent because the jury's verdict was against the clear weight of the evidence. As previously explained in the court's ruling on Bosch's motion for JMOL regarding the derivation of claim 8 of the '974 patent, no evidence was presented at trial from which a jury could reasonably conclude that the claim 8 limitation regarding the length of the leading edge face extending across the wiper blade was derived from Fehrsen. As a result, the jury's verdict goes against the clear weight of the evidence presented at trial, and if this court's order granting Bosch's motion for JMOL is reversed on appeal, a new trial is warranted on the derivation of claim 8 of the '974

patent. Accordingly, Bosch's motion for a new trial on the derivation of claim 8 of the '974 patent is conditionally granted.

3. Infringement of claim 7 of the '434 patent

At the conclusion of its argument for JMOL regarding the infringement of claim 7 of the '434 patent, Bosch briefly requests a new trial without referencing any evidence specific to that request. (D.I. 310 at 33) To the extent Bosch contends that the jury's verdict is against the weight of the evidence, the court acknowledges that it need not construe the evidence in the light most favorable to Pylon in the context of determining whether a new trial is warranted. However, even without the benefit of this less stringent standard, the court concludes that the jury's non-infringement verdict regarding claim 7 of the '434 patent is supported by sufficient evidence, and the court is not persuaded that the jury's verdict results in a miscarriage of justice.

4. Pylon's closing argument and expert testimony

Bosch alleges that Pylon presented expert testimony which was not disclosed in Buechele's expert report, and Pylon's counsel made an improper closing argument that unfairly influenced the jury verdict, thus warranting a new trial. (D.I. 310 at 33) Specifically, Bosch contends that Buechele's testimony describing the relationship of the '214 patent to claim 8 of the '974 patent fell outside the scope of Buechele's expert report. (*Id.* at 34) Bosch maintains that Buechele's testimony describing the placement of the end caps in the '434 patent as a mere design choice also exceeds the scope of his expert report. (*Id.* at 35) Furthermore, Bosch contends that Buechele's claim that he himself designed the beam blade with the spoiler as shown in the '974 patent may

have contributed to the jury's finding that claims 1 and 8 of the '974 patent were obvious. (*Id.* at 35-36) According to Bosch, Pylon's closing argument was also improper because Pylon's counsel repeatedly referred to the absence of Wolfgang Leutsch and Thomas Kotlarski, two named inventors of the '974 patent, in violation of the stipulated pretrial order stating that "a party's failure to call a witness identified on the witness list shall not be commented on during trial." (*Id.* at 37) Bosch contends that Pylon also disregarded the court's order to refrain from referring to the infringement of the '974 patent, and Pylon misstated the law of derivation by telling the jury that "if there is derivation on claim 1, claim 8 likewise goes because all the elements of claim 1 are in claim 8." (*Id.* at 37-38) Bosch maintains that the court's curative instructions to the jury were insufficient to cure the harm caused by Pylon's closing argument. (*Id.* at 37)

In response, Pylon contends that all of the expert testimony Bosch cites was contained in the expert reports and was known to Bosch through discovery. (D.I. 330 at 37) Citing *Genzyme Corp. v. Atrium Medical Corp.*, 315 F. Supp. 2d 552, 584 (D. Del. 2004), Pylon also maintains that its closing arguments do not warrant a new trial because they did not rise to the level of affecting a **"substantial right in the context of the entire trial record."** (*Id.* at 41) Pylon claims that the court's curative instruction remedied Pylon's statements regarding the absence of certain witnesses from trial. (*Id.* at 42) Furthermore, Pylon notes that Bosch did not object to Pylon's reference to the non-infringement of claims 1 and 8 of the '974 patent at trial and, regardless, the statements regarding non-infringement were inconsequential because the jury did not rule on infringement of those claims. (*Id.*) Pylon contends that its reference to the

derivation of claim 1 as it relates to claim 8 was proper because the only additional limitation in claim 8 was well-known in the prior art and Bosch failed to object at trial. (*Id.* at 43)

To the extent Bosch contends that the jury's verdict was unfairly influenced by Pylon's counsel's improper conduct, the court acknowledges that it need not construe the evidence in the light most favorable to Pylon in the context of determining whether a new trial is warranted. However, even without the benefit of this less stringent standard, the court is not persuaded that the jury's verdict was unfairly influenced by Pylon's actions. The court acknowledges that Bosch has identified certain conduct by Pylon's trial counsel which may reasonably be questioned. In particular, Pylon's counsel mentioned the "missing witnesses" and the infringement of the '974 patent in closing arguments, contrary to the court's instructions. However, the court finds that it is not reasonably probable that Buechele's testimony and Pylon's closing argument had a significant influence on the jury's deliberations, and the court's curative instruction was sufficient to remedy any prejudice caused by the statements. Accordingly, the court concludes that a new trial is not warranted due to Pylon's counsel's misconduct.

5. Cumulative references on claim 13 of the '905 patent

Pylon argues that the court should grant a new trial on the validity of claim 13 of the '905 patent because the jury was unfairly prejudiced by Bosch's argument that International Publication WO 00/34090 ("the '090 publication") was substantively considered by the patent examiner and the prior art relied upon by Pylon was cumulative to the '090 publication. (D.I. 321 at 12) Bosch responds that the USPTO did, in fact, consider the '090 publication during the prosecution of the '905 patent

because the '090 publication published in between the foreign filing date and the U.S filing date of the '905 patent, and USPTO regulations require an examiner to consider intervening references without regard to the claimed priority date and make any appropriate rejections to pending claims. (*Id.* at 20-22) According to Bosch, the examiner in the instant case considered the '090 publication and allowed the claims of the '905 patent over the '090 publication. (*Id.* at 22-23) Even if the court were to determine that the '090 publication was neither relevant to the '905 patent nor considered by the examiner, Bosch contends that it properly cross-examined Pylon's expert regarding whether the prior art presented by Pylon at trial was cumulative to the references considered by the examiner. (*Id.* at 24) Moreover, Bosch contends that Pylon could not have been so prejudiced as to warrant a new trial when Pylon neither addressed the '090 publication during its re-direct nor sought a curative instruction, and Bosch refrained from raising its cumulative references argument during closings, consistent with Pylon's request. (*Id.* at 26-27)

Pylon replies that the examiner did not allow the claims of the '905 patent over the '090 publication because the foreign priority claim of the '905 patent was perfected and the USPTO regulations do not require an examiner to issue a rejection on references filed between the foreign priority date and the U.S. filing date. (D.I. 344 at 18) According to Pylon, Bosch's speculation that the examiner considered the '090 publication during the examination of claim 13 of the '905 patent was its sole justification for cross-examining Pylon's expert regarding whether the references presented by Pylon were cumulative to the '090 publication. (*Id.* at 21) Furthermore, Pylon justifies its failure to request a curative instruction by noting that it feared further

discussion of the '090 publication would only continue to prejudice the jury. (*Id.* at 22)

To the extent Pylon contends that the jury's verdict was unfairly influenced by Bosch's argument regarding the '090 publication, the court acknowledges that it need not construe the evidence in the light most favorable to Bosch in the context of determining whether a new trial is warranted. However, even without the benefit of this less stringent standard, the court cannot find it reasonably probable that Buechele's testimony on cross-examination regarding the '090 publication had a significant influence on the jury's deliberations, particularly because Bosch did not refer to the '090 publication again in its closing arguments and Pylon did not bother to re-direct its expert or request a curative instruction regarding Bosch's cross-examination of Pylon's expert. Accordingly, the court concludes that a new trial is not warranted as a result of Bosch's argument that the '090 publication was substantively considered by the patent examiner and the prior art relied upon by Pylon was cumulative to the '090 publication.

C. Motion to Alter or Amend the Judgment

The purpose of a motion to alter or amend the judgment is to "correct manifest errors of law or fact or to present newly discovered evidence." *Max's Seafood Café By Lou-Ann, Inc. v. Quinteros*, 176 F.3d 669, 677 (3d Cir. 1999). Therefore, a court should alter or amend its judgment only if the movant demonstrates at least one of the following: (1) a change in the controlling law; (2) availability of new evidence not available when summary judgment was granted; or (3) a need to correct a clear error of law or fact or to prevent manifest injustice. *See id.*

Citing to the evidence presented in support of its renewed motion for JMOL on

the validity of claim 13 of the '434 patent, Pylon contends that no evidence supports the jury's finding that end caps made of plastic were not disclosed in the '507 patent or otherwise known in the prior art. (D.I. 319 at 9-10) According to Pylon, it would be a manifest injustice to uphold the validity of claim 13 as non-obvious in view of the '507 patent. (*Id.*) Bosch responds that Pylon's motion to alter or amend the judgment should not be granted because it is based on the same argument Pylon presented in support of its motion for JMOL under Fed. R. Civ. P. 50(b). (D.I. 334 at 16) Unlike motions raised under Rule 50(b), Bosch contends that motions made under Rule 59(e), to alter or amend a judgment to prevent manifest injustice, are reserved for "exigent circumstances such as a case of manifest and extreme abuse of the jury's function." (*Id.* at 16-17) Bosch notes that Rule 59(e) is "an improper device to set aside a jury verdict based upon evidentiary insufficiency." *Hegger v. Green*, 646 F.2d 22, 28 (2d Cir. 1981).

Pylon's arguments concerning the invalidity of claim 13 of the '434 patent have already been considered by the court. Pylon has not demonstrated that alteration or amendment of the judgment is warranted based on a need to correct a clear error of law or fact or to prevent manifest injustice.

D. Motion for a Permanent Injunction

In *eBay Inc. v. MercExchange, L.L.C.* (hereinafter "*eBay*"), the Supreme Court overruled the Federal Circuit's prior "general rule that courts will issue permanent injunctions against patent infringement absent exceptional circumstances." 547 U.S. 388, 126 S. Ct. 1837, 164 L. Ed. 2d 641 (2006) (vacating and remanding

MercExchange, L.L.C. v. eBay Inc., 401 F.3d 1323, 1339 (2005)). Under *eBay*, permanent injunctions in patent cases must be based on a case-by-case assessment of the traditional equitable factors governing injunctions. *Id.* at 392-93. That is, to be awarded a permanent injunction, a plaintiff must demonstrate that: (1) "it has suffered an irreparable injury;" (2) "remedies available at law, such as monetary damages, are inadequate to compensate for that injury;" (3) "considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted;" and (4) "the public interest would not be disserved by a permanent injunction." *Id.* "[T]he decision whether to grant or deny injunctive relief rests within the equitable discretion of the district courts, and that discretion must be exercised consistent with traditional principles of equity, in patent disputes no less than in other cases governed by such standards." *Id.* at 393.

Bosch contends that it suffered irreparable harm in the form of a loss of market share, loss of customers, loss of business opportunities, loss of good will and brand loyalty, and price erosion due to Pylon's infringement. (D.I. 353 at 11-12) According to Bosch, monetary damages alone are insufficient compensation for its statutory right to exclude its competitor from using the patented technology, and it is impossible to calculate what Bosch's market share would have been but for Pylon's infringement. (*Id.* at 14-15) Furthermore, Bosch contends that Pylon's unstable financial condition makes it unlikely Bosch would be able to recover the amounts to which it is entitled. (*Id.* at 15) In weighing the balance of hardships the parties would suffer, Bosch contends that, without a permanent injunction to protect its right to exclude a direct competitor, Bosch

may need to lay off employees and will not be able to recoup its research and development costs. (*Id.* at 15-16) In contrast, Bosch observes that Pylon wrongfully profited from the sale of infringing products for the past several years. (*Id.* at 16) Moreover, Bosch maintains that the denial of a permanent injunction would harm the public interest by exposing the public to Pylon's inferior product, reducing the value of patents and disincentivizing scientific progress. (*Id.* at 16-17)

Pylon first responds that Bosch's motion for a permanent injunction is premature because discovery on damages has yet to be taken in this bifurcated trial. (D.I. 331 at 9) Turning to the four factors of the permanent injunction analysis, Pylon contends that Bosch's undue delay in seeking the injunction indicates that Bosch did not suffer irreparable injury. (*Id.* at 11-12) Furthermore, Pylon maintains that Bosch cannot demonstrate the inadequacy of money damages because Bosch operates in a different segment of the market and has offered to exchange its patent rights for licensing agreements and monetary compensation. (*Id.* at 13-16) According to Pylon, Bosch's damages theories regarding Pylon's potential inability to pay a monetary judgment are highly speculative and do not warrant the entry of a permanent injunction. (*Id.* at 16-17) Pylon contends that the balance of equities also weighs in its favor because, while Bosch is an international conglomerate with a diverse product base in multiple industries, Pylon is a small domestic corporation that focuses on the manufacture and sale of wiper blades and its business would be profoundly affected by a permanent injunction. (*Id.* at 18) Furthermore, Pylon argues that its continuing right to compete outweighs the public interest in protecting valid patent rights because the jury's verdict

will likely not survive post-trial or appellate review. (*Id.* at 19-20) If the court enters an injunction despite Pylon's contentions, Pylon requests that the court stay enforcement of the injunction pending appeal. (*Id.* at 20)

Although the quantum of evidence required under *eBay* is relatively unclear, the court concludes that Bosch has not met its burden for a permanent injunction. The *eBay* Court specifically cautioned against the application of categorical rules, classifications, and assumptions in permanent injunction analyses. *Id.* Nevertheless, courts, presumably struggling to balance the absence of a presumption of irreparable harm with a patentee's right to exclude, have frequently focused upon the nature of the competition between plaintiff and defendant in the relevant market in the context of evaluating irreparable harm and the adequacy of money damages. Courts awarding permanent injunctions typically do so under circumstances in which the plaintiff practices its invention and is a direct market competitor.⁵ Plaintiffs also frequently succeed when their patented technology is at the core of its business, and/or where the

⁵See, e.g., *Muniauction, Inc. v. Thomson Corp.*, 502 F. Supp. 2d 477, 482 (W.D. Pa. 2007) ("Plaintiff and defendants are direct competitors in a two-supplier market. If plaintiff cannot prevent its only competitor's continued infringement of its patent, the patent is of little value"); *Johns Hopkins Univ. v. Datascope Corp.*, 513 F. Supp. 2d 578, 586 (D. Md. 2007) (granting permanent injunction where infringing product was plaintiffs' "only competition" and "thus, its sale reduce[d] the [p]laintiffs' market share"); *Transocean Offshore Deepwater Drilling, Inc. v. GlobalSantaFe Corp.*, No. Civ. A. 03-2910, 2006 WL 3813778, at *4 (S.D. Tex. Dec. 27, 2006) (granting permanent injunction requiring structural modifications to infringing deepwater drilling rigs where "the customer base for deep water drill rigs is small, and [defendant] has not only used [its] rigs equipped with the infringing structure to compete for the same customers and contracts as [plaintiff], but also to win contracts over competing bids from [plaintiff]").

market for the patented technology is volatile or still developing.⁶

The court notes at this juncture that Bosch has not provided a clear, summary-level overview of the relevant market for the wiper blade technology at issue. Furthermore, on the record before the court, it does not appear that Bosch and Pylon are the only market participants, and Bosch does not contest Pylon's identification of Federal Mogul, Trico and Shell as additional beam blade competitors. (D.I. 331 at 15) Even assuming that Bosch had clearly defined a relevant market in which Bosch and Pylon are the major market players, the parties failed to provide the court with a breakdown illuminating their relative market percentages. This is not a clear case of a two-supplier market wherein a sale to Pylon necessarily represents the loss of a sale to Bosch. *Cf. TruePosition, Inc. v. Andrew Corp.*, 611 F. Supp. 2d 400 (D. Del. 2009) (holding that infringement by a direct competitor in a two-supplier market mitigates in favor of enhanced damages). In addition, Bosch manufactures a wide variety of automotive and home products, and wiper blades alone are not at the core of its business. In light of Bosch's failure to define a relevant market, the existence of additional competitors and the non-core nature of Bosch's wiper blade business in

⁶See *Martek Biosciences Corp. v. Nutrinova Inc.*, 520 F. Supp. 2d 537, 558-59 (D. Del. 2007) (granting permanent injunction where plaintiff was a direct competitor "likely to lose market share that it may not be able to recapture," as plaintiff's patented technology was its primary revenue source, and defendant was plaintiff's only competitor and was "targeting [plaintiff's] customers in that industry"); *TiVo, Inc. v. EchoStar*, 446 F. Supp. 2d 664 (E.D. Tex. 2006) (granting permanent injunction where: (1) parties were direct competitors; (2) "plaintiff [was] losing market share at a critical time in the market's development"; (3) the parties agreed that customers in the relevant market tend to remain customers of the company they first purchased from; and (4) as a "relatively new company with only one primary product," plaintiff's "primary focus is on growing a customer base specifically around the product" competing with the infringing product).

relation to its business as a whole, the court concludes that Bosch has failed to show that it would suffer irreparable harm absent a permanent injunction.

IV. CONCLUSION

For the foregoing reasons, the court: (1) denies Bosch's renewed motion for JMOL or for a new trial with respect to the derivation of claim 1 of the '974 patent and the infringement of claim 7 of the '434 patent and grants the motion in all other respects (D.I. 309); (2) denies Pylon's renewed motion for JMOL with respect to non-infringement of claims 1, 5 and 13 of the '434 patent (D.I. 316); (3) denies Pylon's renewed motion for JMOL or to alter or amend the judgment with respect to the invalidity of claim 13 of the '434 patent (D.I. 318); (4) denies Pylon's renewed motion for JMOL or for a new trial with respect to the invalidity of the '905 patent (D.I. 320); (5) denies Bosch's motion for leave to file a sur-reply (D.I. 351) as moot; and (6) denies Bosch's motion for a permanent injunction (D.I. 311). An appropriate order shall issue.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH, LLC,

Plaintiff,

v.

PYLON MANUFACTURING CORP.,

Defendant.

Civ. No. 08-542-SLR

**FINAL JUDGMENT FOLLOWING POST TRIAL MOTION PRACTICE
PURSUANT TO FED. R. CIV. P. 54 (b)**

For reasons stated in the court's opinion and order of March 9, 2011;

IT IS ORDERED AND ADJUDGED that judgment be and is hereby entered in favor of plaintiff Robert Bosch, LLC and against defendant Pylon Manufacturing Corp. as to Pylon's claim of unenforceability of U.S. Patent No. 6,292,974.

United States District Judge

Dated: 3/23/11

(By) Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH LLC,)	
)	
Plaintiff,)	
)	
v.)	Civ. No. 08-542-SLR
)	
PYLON MANUFACTURING CORP.,)	
)	
Defendant.)	

MEMORANDUM ORDER

At Wilmington this 26th day of August, 2009, having reviewed defendant's motion for bifurcation and the papers submitted in connection therewith;;

IT IS ORDERED that the motion (D.I. 70) is granted for the reasons that follow:

1. **Bifurcation.** I have determined that bifurcation is appropriate, if not necessary, in all but exceptional patent cases.

a. In the first instance, the judges of this court have carried a substantial patent docket for the last decade.¹ Although limited damages discovery may be relevant for purposes of exploring settlement and the issue of commercial success, in my experience, discovery disputes related to document production on damages and the *Daubert* motion practice related to damages experts are a drain on scarce judicial resources.²

b. Aside from the burden imposed on the court, the burden imposed on a

¹As of today's date, I have 89 pending patent cases.

²I do not bother to address the mischief that lawyers can perpetrate with extravagant damages figures or the hyperbole that can accompany claims of willfulness.

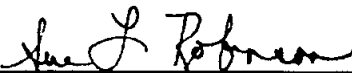
jury in a patent trial is extraordinary. More specifically, juries are tasked with resolving complex technical issues regarding infringement and invalidity, many times with respect to multiple patents and/or multiple prior art references. Absent bifurcation, jurors then are expected to understand the commercial complexities of the relevant market (or, even more impenetrable, the commercial complexities of the hypothetical market) in order to determine the economic consequences of their liability decisions.

c. There has been much consternation of late over the variable, arguably excessive, damages verdicts of juries. Given the burdens described above, I have concluded that bifurcation promotes the just and efficient resolution of what damages, if any, should be awarded by: (1) giving the parties - those with the most expertise in the market - the first opportunity to translate the Federal Circuit's final legal decision on liability into practical commercial consequences; or (if the parties cannot resolve the matter) (2) giving the damages jury a focused dispute to resolve.

d. Finally, absent the use of such administrative tools as bifurcation (also referred to as separation of issues), timed trials, etc., the burden of managing a substantial patent caseload will be reflected in extending the time needed to reach trial on the merits.

2. **Willfulness.** Plaintiff specifically contends that the issue of willfulness should not be bifurcated from the issue of infringement, arguing that it is entitled under the Seventh Amendment to have the same jury decide both infringement and willfulness in one trial. This argument has been rejected by the Federal Circuit in *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed. Cir. 2008), a decision that is wholly consistent with the fact that willfulness requires qualitatively and quantitatively different proof than does

infringement and, therefore, need not be tried at the same time. I note as well that, ultimately, a finding of willfulness is of no moment unless and until the district court, in its sole discretion, chooses to increase damages by reason of the finding; willfulness is a damages issue, not a liability issue. Finally, although I respect plaintiff's right to a jury trial on the issue of willfulness, I query whether this right is so broad as to trump a court's right to manage its caseload, especially when the potential costs³ are so high.


United States District Judge

³Willfulness is an intrusive and inflammatory issue to discover and try.

1, 1979, and ending midnight Mar. 31, 1982, see Paragraph 5 of Article XI of the Panama Canal Treaty of 1977 and sections 2101 and 2201 to 2203 of Pub. L. 96-70, title II, Sept. 27, 1979, 93 Stat. 493, formerly classified to sections 3831 and 3841 to 3843, respectively, of Title 22, Foreign Relations and Intercourse.

§ 1292. Interlocutory decisions

(a) Except as provided in subsections (c) and (d) of this section, the courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory orders of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

(2) Interlocutory orders appointing receivers, or refusing orders to wind up receiverships or to take steps to accomplish the purposes thereof, such as directing sales or other disposals of property;

(3) Interlocutory decrees of such district courts or the judges thereof determining the rights and liabilities of the parties to admiralty cases in which appeals from final decrees are allowed.

(b) When a district judge, in making in a civil action an order not otherwise appealable under this section, shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order. The Court of Appeals which would have jurisdiction of an appeal of such action may thereupon, in its discretion, permit an appeal to be taken from such order, if application is made to it within ten days after the entry of the order: *Provided, however*, That application for an appeal hereunder shall not stay proceedings in the district court unless the district judge or the Court of Appeals or a judge thereof shall so order.

(c) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

(1) of an appeal from an interlocutory order or decree described in subsection (a) or (b) of this section in any case over which the court would have jurisdiction of an appeal under section 1295 of this title; and

(2) of an appeal from a judgment in a civil action for patent infringement which would otherwise be appealable to the United States Court of Appeals for the Federal Circuit and is final except for an accounting.

(d)(1) When the chief judge of the Court of International Trade issues an order under the provisions of section 256(b) of this title, or when any judge of the Court of International Trade, in issuing any other interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of

opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

(2) When the chief judge of the United States Court of Federal Claims issues an order under section 798(b) of this title, or when any judge of the United States Court of Federal Claims, in issuing an interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

(3) Neither the application for nor the granting of an appeal under this subsection shall stay proceedings in the Court of International Trade or in the Court of Federal Claims, as the case may be, unless a stay is ordered by a judge of the Court of International Trade or of the Court of Federal Claims or by the United States Court of Appeals for the Federal Circuit or a judge of that court.

(4)(A) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction of an appeal from an interlocutory order of a district court of the United States, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, granting or denying, in whole or in part, a motion to transfer an action to the United States Court of Federal Claims under section 1631 of this title.

(B) When a motion to transfer an action to the Court of Federal Claims is filed in a district court, no further proceedings shall be taken in the district court until 60 days after the court has ruled upon the motion. If an appeal is taken from the district court's grant or denial of the motion, proceedings shall be further stayed until the appeal has been decided by the Court of Appeals for the Federal Circuit. The stay of proceedings in the district court shall not bar the granting of preliminary or injunctive relief, where appropriate and where expedition is reasonably necessary. However, during the period in which proceedings are stayed as provided in this subparagraph, no transfer to the Court of Federal Claims pursuant to the motion shall be carried out.

(e) The Supreme Court may prescribe rules, in accordance with section 2072 of this title, to provide for an appeal of an interlocutory decision to the courts of appeals that is not otherwise provided for under subsection (a), (b), (c), or (d).

(June 25, 1948, ch. 646, 62 Stat. 929; Oct. 31, 1951, ch. 655, § 49, 65 Stat. 726; Pub. L. 85-508, § 12(e), July 7, 1958, 72 Stat. 348; Pub. L. 85-919, Sept. 2, 1958, 72 Stat. 1770; Pub. L. 97-164, § 125, Apr. 2, 1982, 96 Stat. 38; Pub. L. 99-620, title IV, § 412, Nov. 8, 1984, 98 Stat. 8362; Pub. L. 100-702, title V, § 501, Nov. 19, 1988, 102 Stat. 4652; Pub. L. 102-572, title I, § 101, title IX, §§ 902(b), 906(c), Oct. 29, 1992, 106 Stat. 4506, 4516, 4518.)

HISTORICAL AND REVISION NOTES

Based on title 28, U.S.C., 1940 ed., §§ 225(b), 227, 227a, and section 61 of title 7 of the Canal Zone Code (Mar. 3, 1911, ch. 231, §§ 128, 129, 36 Stat. 1133, 1134; Feb. 13, 1925, ch. 229, § 1, 43 Stat. 937; Feb. 28, 1927, ch. 228, 44 Stat. 1261; Apr. 3, 1926, ch. 102, 44 Stat. 233; May 20, 1926, ch. 347, § 13(a), 44 Stat. 587; Apr. 11, 1928, ch. 354, § 1, 45 Stat. 423; May 17, 1932, ch. 190, 47 Stat. 158).

Section consolidates sections 225(b), 227 and part of 227a of title 28, U.S.C., 1940 ed., with necessary changes in phraseology to effect the consolidation.

The second paragraph of section 225(b) of title 28, U.S.C., 1940 ed., relating to review of decisions of the district courts, under section 9 of the Railway Labor Act (section 159 of title 45), was omitted as covered by section 1291 of this title.

Words in section 227 of title 28, U.S.C., 1940 ed., "or decree," after "interlocutory order," were deleted, in view of Rule 65 of the Federal Rules of Civil Procedure, using only the word "order."

Provisions of sections 227 and 227a of title 28, U.S.C., 1940 ed., relating to stay of proceedings pending appeal were omitted as superseded by Federal Rules of Civil Procedure, Rule 73.

Provisions of section 227 of title 28, U.S.C., 1940 ed., requiring an additional bond by the district court as a condition of appeal were omitted in view of Federal Rules of Civil Procedure, Rule 73.

Words in section 227 of title 28, U.S.C., 1940 ed., "and sections 346 and 347 of this title shall apply to such cases in the circuit courts of appeals as to other cases therein," at the end of the first sentence of section 227 of title 28, U.S.C., 1940 ed., were deleted as fully covered by section 1254 of this title, applicable to any case in a court of appeals. Other procedural provisions of said section 227 were omitted as covered by section 2101 et seq. of this title.

In subsection (4), which is based on section 227a of title 28, U.S.C., 1940 ed., words "civil actions" were substituted for "suits in equity" and word "judgments" was substituted for "decree," in view of Rules 2 and 54 of the Federal Rules of Civil Procedure.

The provision of sections 227 and 227a of title 28, U.S.C., 1940 ed., that appeal must be taken within thirty days after entry of order, decree or judgment is incorporated in section 2107 of this title.

The provisions of section 227a of title 28, U.S.C., 1940 ed., relating to stay of proceedings pending appeal, were omitted as superseded by Rule 73 of the Federal Rules of Civil Procedure.

The district courts for the districts of Hawaii and Puerto Rico are embraced in the term "district courts of the United States." (See definitive section 451 of this title.) Consequently the specific reference in section 225 of title 28, U.S.C., 1940 ed., to "the United States district courts for Hawaii" was omitted.

The District Court for the District of Puerto Rico is not enumerated in section 225(b) of title 28, U.S.C., 1940 ed., nevertheless subsection (2) of the revised section does not except such court. Thus in conformity with the last sentence of section 864, title 48, U.S.C., 1940 ed. For distribution of said section 864, see Distribution Table.

Section 61 of title 7 of the Canal Zone Code is also incorporated in sections 1291 and 1294 of this title.

AMENDMENTS

1992—Subsec. (d)(2). Pub. L. 102-572, § 902(b)(1), 906(c), substituted "When the chief judge of the United States Court of Federal Claims issues an order under section 798(b) of this title, or when any judge of the United States Court of Federal Claims" for "When any judge of the United States Claims Court".

Subsec. (d)(3). Pub. L. 102-572, § 902(b)(3), substituted "Court of Federal Claims" for "Claims Court" in two places.

Subsec. (d)(4). Pub. L. 102-572, § 902(b), substituted "United States Court of Federal Claims" for "United States Claims Court" in subpar. (A) and "Court of Fed-

eral Claims" for "Claims Court" in two places in subpar. (B).

Subsec. (e). Pub. L. 102-572, § 101, added subsec. (e).

1988—Subsec. (d)(4). Pub. L. 100-702 added par. (4).

1984—Subsec. (b). Pub. L. 98-620, § 412(a), inserted "which would have jurisdiction of an appeal of such action" after "The Court of Appeals".

Subsec. (c)(1). Pub. L. 98-620, § 412(b), inserted "or (b)" after "(a)".

1982—Subsec. (a). Pub. L. 97-164, § 125(a)(1), substituted "Except as provided in subsections (c) and (d) of this section, the courts" for "The courts" in introductory provisions.

Subsec. (a)(4). Pub. L. 97-164, § 125(a)(2), (3), struck out par. (4) which related to judgments in civil actions for patent infringement which were final except for accounting.

Subsecs. (c), (d). Pub. L. 97-164, § 125(b), added subsecs. (c) and (d).

1958—Pub. L. 85-619 designated existing provisions as subsec. (a) and added subsec. (b).

Par. (1). Pub. L. 85-508 struck out reference to District Court for Territory of Alaska. See section 81A of this title which established a United States District Court for the State of Alaska.

1951—Par. (1). Act Oct. 31, 1951, inserted reference to District Court of Guam.

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by section 101 of Pub. L. 102-572 effective Jan. 1, 1993, see section 1101(a) of Pub. L. 102-572, set out as a note under section 905 of Title 2, The Congress.

Amendment by sections 902(b) and 906(c) of Pub. L. 102-572 effective Oct. 29, 1992, see section 911 of Pub. L. 102-572, set out as a note under section 171 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Section 502 of title V of Pub. L. 100-702 provided that: "The amendment made by section 501 [amending this section] shall apply to any action commenced in the district court on or after the date of enactment of this title [Nov. 19, 1988]."

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of this title.

EFFECTIVE DATE OF 1958 AMENDMENT

Amendment by Pub. L. 85-508 effective Jan. 3, 1959, on admission of Alaska into the Union pursuant to Proc. No. 3269, Jan. 3, 1959, 24 F.R. 81, 73 Stat. c16, as required by sections 1 and 8(c) of Pub. L. 85-508, see notes set out under section 81A of this title and preceding section 21 of Title 48, Territories and Insular Possessions.

TERMINATION OF UNITED STATES DISTRICT COURT FOR THE DISTRICT OF THE CANAL ZONE

For termination of the United States District Court for the District of the Canal Zone at end of the "transition period", being the 30-month period beginning Oct. 1, 1979, and ending midnight Mar. 31, 1982, see Paragraph 5 of Article XI of the Panama Canal Treaty of 1977 and sections 3831 and 3841 to 3843 of Title 22, Foreign Relations and Intercourse.

[§ 1293. Repealed. Pub. L. 87-189, § 3, Aug. 30, 1961, 75 Stat. 417]

Section, acts June 25, 1948, ch. 646, 62 Stat. 829; Mar. 18, 1959, Pub. L. 86-3, § 14(b), 73 Stat. 10, provided for appeal from supreme court of Puerto Rico to court of appeals for first circuit. See section 1258 of this title.

A subsequent section 1293, added Pub. L. 95-598, title II, § 236(a), Nov. 6, 1978, 92 Stat. 2667, which related to bankruptcy appeals, did not become effective pursuant to section 402(b) of Pub. L. 95-598, as amended, set out as an Effective Date note preceding section 101 of Title 11, Bankruptcy.

Reissues.	more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.
Several patents for separate parts of the thing patented.	
Effect of patent so reissued.	And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.
No new matter.	
Disclaimer;	SEC. 54. <i>And be it further enacted</i> , That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the patent office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.
to be in writing, attested and recorded.	
Pending actions not affected.	
What courts to have jurisdiction of patent cases.	SEC. 55. <i>And be it further enacted</i> , That all actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court, or by the supreme court of the District of Columbia, or of any Territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the claimant [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expiration thereof.
Injunctions.	
Damages for infringements.	
Actions to be brought within what time.	

SEC. 56. *And be it further enacted*, That a writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the supreme court of the District of Columbia or of any Territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy.

Writs of error or appeal to the Supreme Court of the United States.

SEC. 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or drawings belonging to the patent office, and of letters-patent under the signature of the commissioner or acting commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters-patent, certified in like manner, shall be prima facie evidence of the fact of the granting of such foreign letters-patent, and of the date and contents thereof.

Written, &c. copies of papers, &c. under the hand and seal of the commissioner to be competent evidence when, &c.
Who entitled to copies.
Foreign letters-patent.

SEC. 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Suits in regard to interfering patents.

SEC. 59. *And be it further enacted*, That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a circuit court, or in the supreme court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Either patent may be declared void, &c.

Rights of parties to the suit, &c. only affected.

Damages for infringement of patent, how recovered.

Court may enter judgment for not over three times the amount of actual damages found by verdict and costs.

SEC. 60. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the patent office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer.

Patentee may maintain suits for infringements of any material, &c. part of patent, although the specifications are too large.

Plaintiff not to recover costs unless, &c.

Courts to issue subpoenas to secure, in contested cases	contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such District or Territory, commanding him to appear and testify before any officer in such District or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 869 of the Revised Statutes relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."
Provisions governing	SEC. 8. That section 4921 of the Revised Statutes be, and the same is hereby, amended to read as follows:
R. A., sec. 809, p. 165	"SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. If on the proofs it shall appear that the complainant has suffered damage from the infringement or that the defendant has realized profits therefrom to which the complainant is justly entitled, but that such damages or profits are not susceptible of calculation and determination with reasonable certainty, the court may, on evidence tending to establish the same, in its discretion, receive opinion or expert testimony, which is hereby declared to be competent and admissible, subject to the general rules of evidence applicable to this character of testimony; and upon such evidence and all other evidence in the record the court may adjudge and decree the payment by the defendant to the complainant of a reasonable sum as profits or general damages for the infringement: <i>Provided</i> , That this provision shall not affect pending litigation. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; but in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a decree issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to indorse the same upon the file wrapper of the said patent or patents and to incorporate the same as a part of the contents of said file or file wrapper; and for each notice required to be furnished to the Commissioner of Patents in compliance herewith a fee of 50 cents shall be taxed by the clerk as costs of suit."
R. S., sec. 4921, p. 952, amended.	
Actions for infringements	
Injunctions	
Vol. 29, p. 694, amended	
Recovery of damages.	
Expert testimony to determine amount, etc.	
Proviso	
Pending cases not affected	
Time limit for action, etc.	
Notice to Commissioner of Patents	
Details.	
Notice of decision to be indorsed on file wrapper, etc.	
Fee to be taxed	

CHAP. 227.—An Act Amending section 3 of the Act approved January 12, 1923, entitled "An Act to distribute the commissioned line and engineer officers of the Coast Guard in grades, and for other purposes."

February 28, 1927.
[S. 4287.]
[Public, No. 661.]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 3 of the Act approved January 12, 1923, entitled "An Act to distribute the commissioned line and engineer officers of the Coast Guard in grades, and for other purposes," be amended by adding thereto the following proviso:

Coast Guard.
Vol. 42, p. 1131,
amended.
Retired officers.

"*Provided further,* That commissioned officers Daniel P. Foley, Francis M. Dunwoody, Howard M. Broadbent, Frank H. Newcomb, and Horace B. West, shall have the rank of commodore on the retired list without any increase of pay by reason of the passage of this Act."

Officers to have rank
of commodore.

Approved, February 28, 1927.

CHAP. 228.—An Act To amend section 129 of the Judicial Code, allowing an appeal in a patent suit from a decree which is final except for the ordering of an accounting.

February 28, 1927.
[S. 4357.]
[Public, No. 662.]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That when in any suit in equity for the infringement of letters patent for inventions, a decree is rendered which is final except for the ordering of an accounting, an appeal may be taken from such decree to the circuit court of appeals: *Provided,* That such appeal be taken within thirty days from the entry of such decree or from the date of this act; and the proceedings upon the accounting in the court below shall not be stayed unless so ordered by that court during the pendency of such appeal.

Judicial Code.
Appeals to circuit
court of appeals in pat-
ent infringement suits.
Vol. 43, p. 637, amend-
ed.
Proviso.
Time limit, etc.

Approved, February 28, 1927.

CHAP. 229.—An Act To amend paragraph (c) of section 4 of the Act entitled "An Act to create the Inland Waterways Corporation for the purpose of carrying out the mandate and purpose of Congress as expressed in sections 201 and 500 of the Transportation Act, and for other purposes," approved June 3, 1924.

February 28, 1927.
[S. 4671.]
[Public, No. 663.]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That paragraph (c) of section 4 of the Act entitled "An Act to create the Inland Waterways Corporation for the purpose of carrying out the mandate and purpose of Congress as expressed in sections 201 and 500 of the Transportation Act, and for other purposes," approved June 3, 1924, be, and the same is hereby, amended to read as follows:

Inland Waterways
Corporation.
Vol. 43, p. 831, amend-
ed.

"(c) In addition to the six members, the Secretary of War shall appoint an individual from civil life, or (notwithstanding section 1222 of the Revised Statutes or any other provision of law, or any rules and regulations issued thereunder) detail an officer from the Military Establishment of the United States, as chairman of the board. Any officer so detailed at the date of the passage of this amendatory Act shall, during his term of office as chairman, have the rank, pay, and allowances of a major general, United States Army, and shall be exempt from the operation of any provision of law or any rules or regulations issued thereunder which limits the length of such detail or compels him to perform duty with troops. Any individual appointed from civil life shall, during his term of office as chairman, receive a salary not to exceed \$10,000 a year, to

Advisory Board.
Appointment of ci-
vilian, or detail of
Army officer, as chair-
man.

Army officer to have
rank, etc., of major
general.

Pay for civilian.

39 Stat. 933.
20 U. S. C. § 15.

\$350,000, to be expended for the same purposes and in the same manner as provided in section 7 of the Smith-Hughes Vocational Education Act, as amended October 3, 1917."

Approved August 1, 1946.

[CHAPTER 726]

AN ACT

August 1, 1946
[H. R. 8311]
[Public Law 587]

To amend Revised Statutes, 4921 (U. S. C. A., title 35, Patents, sec. 70), providing that damages be ascertained on the basis of compensation for infringement.

Patents.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4921 of the Revised Statutes of the United States (35 U. S. C. A. 70) is hereby amended to read as follows:

Power of courts to grant injunctions, etc.

"The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a judgment being rendered in any case for an infringement the complainant shall be entitled to recover general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court. The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.

Recovery in infringement cases.

Attorney's fees.

Expert or opinion evidence in determining compensation.

"The court is hereby authorized to receive expert or opinion evidence upon which to determine in conjunction with any other evidence in the record, due compensation for making, using, or selling the invention, and such expert or opinion evidence is hereby declared to be competent and admissible subject to the general rules of evidence applicable thereto.

Assessment of damages.

"The court shall assess said damages, or cause the same to be assessed, under its direction and shall have the same power to increase the assessed damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; but recovery shall not be had for any infringement committed more than six years prior to the filing of the complaint in the action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to endorse the same upon the file wrapper of the said patent or patents, and to incorporate the same as a part of the contents of said file or file wrapper."

Endorsement.

Effective date; pending causes of action.

This Act shall take effect upon approval and shall apply to pending causes of action in which the taking of the testimony has not been concluded: *Provided, however,* That pending causes of action in which the taking of the testimony has been concluded are to be governed by the statute in force at the time of approval of this Act as if such statute had not been amended.

Approved August 1, 1946.

§ 1257. State courts; appeal; certiorari

Final judgments or decrees rendered by the highest court of a State in which a decision could be had, may be reviewed by the Supreme Court as follows:

(1) By appeal, where is drawn in question the validity of a treaty or statute of the United States and the decision is against its validity.

(2) By appeal, where is drawn in question the validity of a statute of any state on the ground of its being repugnant to the Constitution, treaties or laws of the United States, and the decision is in favor of its validity.

(3) By writ of certiorari, where the validity of a treaty or statute of the United States is drawn in question or where the validity of a State statute is drawn in question on the ground of its being repugnant to the Constitution, treaties or laws of the United States, or where any title, right, privilege or immunity is specially set up or claimed under the Constitution, treaties or statutes of, or commission held or authority exercised under, the United States.

CHAPTER 83—COURTS OF APPEALS

Sec.

1291. Final decisions of district courts.

1292. Interlocutory decisions.

1293. Final decisions of Puerto Rico and Hawaii Supreme Courts.

1294. Circuits in which decisions reviewable.

§ 1291. Final decisions of district courts

The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court.

§ 1292. Interlocutory decisions

The courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory orders of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

(2) Interlocutory orders appointing receivers, or refusing orders to wind up receiverships or to take steps to accomplish the purposes thereof, such as directing sales or other disposals of property;

(3) Interlocutory decrees of such district courts or the judges thereof determining the rights and liabilities of the parties to admiralty cases in which appeals from final decrees are allowed;

(4) Judgments in civil actions for patent infringement which are final except for accounting.

§ 1293. Final decisions of Puerto Rico and Hawaii Supreme Courts

The courts of appeals for the First and Ninth Circuits shall have jurisdiction of appeals from all final decisions of the supreme courts of Puerto Rico and Hawaii, respectively in all cases involving the Constitution, laws or treaties of the United States or any authority exercised thereunder, in all habeas corpus proceedings, and in all other civil cases where the value in controversy exceeds \$5,000, exclusive of interest and costs.

(2) The chapter heading of chapter 51 of title 28, United States Code, is amended by striking out "COURT OF CLAIMS" and inserting in lieu thereof "UNITED STATES CLAIMS COURT".

**ABOLISHMENT OF UNITED STATES COURT OF CUSTOMS AND PATENT
APPEALS**

Repeal.
28 USC 831
et seq.

SEC. 122. (a) Chapter 58 of title 28, United States Code, and the item relating to chapter 53 in the chapter analysis of part III of such title, are repealed.

(b) Section 957 of title 28, United States Code, is amended—

- (1) in subsection (a) by striking out "(a)", and
- (2) by repealing subsection (b).

**TECHNICAL AND CONFORMING AMENDMENTS RELATING TO REPEAL OF
COURT OF CUSTOMS AND PATENT APPEALS**

SEC. 123. Sections 1255 and 1256 of title 28, United States Code, and the items relating to sections 1255 and 1256 in the section analysis of chapter 81 of such title, are repealed.

COURTS OF APPEALS JURISDICTION

SEC. 124. Section 1291 of title 28, United States Code, is amended—

- (1) by inserting "(other than the United States Court of Appeals for the Federal Circuit)" after "courts of appeals"; and
- (2) by adding at the end thereof the following new sentence: "The jurisdiction of the United States Court of Appeals for the Federal Circuit shall be limited to the jurisdiction described in sections 1292 (c) and (d) and 1295 of this title."

Infra;
post, p. 37.

INTERLOCUTORY DECISIONS

SEC. 125. (a) Section 1292(a) of title 28, United States Code, is amended—

- (1) by striking out "The courts" and inserting in lieu thereof "Except as provided in subsections (c) and (d) of this section, the courts";
- (2) by striking out the semicolon at the end of paragraph (3) and inserting in lieu thereof a period; and
- (3) by striking out paragraph (4).

(b) Section 1292 of title 28, United States Code, is amended by adding at the end thereof the following new subsections:

Exclusive
jurisdiction.

"(c) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

"(1) of an appeal from an interlocutory order or decree described in subsection (a) of this section in any case over which the court would have jurisdiction of an appeal under section 1295 of this title; and

Post, p. 37.

"(2) of an appeal from a judgment in a civil action for patent infringement which would otherwise be appealable to the United States Court of Appeals for the Federal Circuit and is final except for an accounting.

Ante, p. 28.

"(d)(1) When the chief judge of the Court of International Trade issues an order under the provisions of section 256(b) of this title, or when any judge of the Court of International Trade, in issuing

any other interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

“(2) When any judge of the United States Claims Court, in issuing an interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

“(3) Neither the application for nor the granting of an appeal under this subsection shall stay proceedings in the Court of International Trade or in the Claims Court, as the case may be, unless a stay is ordered by a judge of the Court of International Trade or of the Claims Court or by the United States Court of Appeals for the Federal Circuit or a judge of that court.”.

Stay of appeal.

CIRCUITS IN WHICH DECISIONS ARE REVIEWABLE

SEC. 126. Section 1294 of title 28, United States Code (including that section as it will become effective on April 1, 1984), is amended by striking out “Appeals” and inserting in lieu thereof “Except as provided in sections 1292(c), 1292(d), and 1295 of this title, appeals”.

Ante, p. 36;
Infra.

JURISDICTION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SEC. 127. (a) Chapter 83 of title 28, United States Code, is amended by adding at the end thereof the following new sections:

“§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

28 USC 1295.

“(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

“(1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to copyrights or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title;

“(2) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
ROBERT BOSCH V. PYLON MFG CORP, 2011-1363, -1364**

CERTIFICATE OF SERVICE

I, John C. Kruesi, Jr., being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by KENYON & KENYON LLP, Attorneys for Appellant, to print this document. I am an employee of Counsel Press.

On the **17th Day of September, 2012**, I served the within **PLAINTIFF-APPELLANT ROBERT BOSCH LLC'S *EN BANC* BRIEF ON APPELLATE JURISDICTION** upon:

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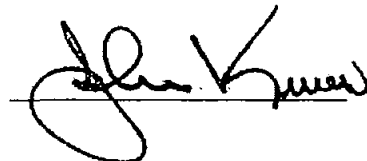
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via Federal Express, overnight delivery, by causing 2 true copies of it, enclosed in a properly addressed wrapper, to be deposited in an official depository of FedEx.

Unless otherwise noted, 31 copies have been hand-delivered to the Court on the same date as above.

September 17, 2012



**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS AND TYPE STYLE
REQUIREMENTS**

1. This brief complies with the type-volume limitation of the Court's August 7, 2012 Order granting a hearing en banc.

 X The brief contains 5,461 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii) and Federal Circuit Rule 32(b), or

 The brief uses a monospaced typeface and contains lines of text, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6).

 X The brief has been prepared in a proportionally spaced typeface using MS Word 2003 in a 14 point Times New Roman font or

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September 17, 2012
Date

(s) 
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