

2019-2359, 2020-1217

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

SIONYX LLC, PRESIDENT AND FELLOWS OF HARVARD COLLEGE,
Plaintiffs-Cross-Appellants,

v.

HAMAMATSU PHOTONICS K.K., HAMAMATSU CORPORATION,
Defendants-Appellants,

DOES 1-10,
Defendant.

*Appeals from the United States District Court for the District of Massachusetts in
No. 1:15-cv-13488-FDS United States District Judge F. Dennis Saylor IV*

**PLAINTIFFS-CROSS APPELLANTS SIONYX, LLC AND PRESIDENT
AND FELLOWS OF HARVARD COLLEGE'S RESPONSE TO
PETITION FOR PANEL REHEARING AND REHEARING EN BANC**

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JANUARY 21, 2021

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2019-2359, 2020-1217
Short Case Caption SiOnyx LLC v. Hamamatsu Corporation
Filing Party/Entity SiOnyx, LLC, President and Fellows of Harvard College

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Date: 01/21/2021

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Name: William D. Belanger

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>SiOnyx, LLC</p>	<p>None</p>	<p>CF Sion, LLC</p>
<p>President and Fellows of Harvard College</p>	<p>None</p>	<p>None</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable Additional pages attached

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

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TABLE OF ABBREVIATIONS

Parties

HC	Appellant/Defendant Hamamatsu Corp.
HPK	Appellant/Defendant Hamamatsu Photonics K.K.
Harvard	Cross-Appellant/Plaintiff President and Fellows of Harvard College
SiOnyx	Cross-Appellant/Plaintiff SiOnyx, LLC

Patents

Disputed Patents	Collectively U.S. Patent Nos. 9,614,109; 9,293,499; 9,190,551; 8,994,135; 8,916,945; 8,742,528; 8,629,485; and 8,564,087 and all foreign family members and counterparts, unless indicated otherwise
United States Disputed Patents	Collectively U.S. Patent Nos. 9,614,109; 9,293,499; 9,190,551; 8,994,135; 8,916,945; 8,742,528; 8,629,485; and 8,564,087

Defined Terms

The Agreement	January 11, 2007 Mutual Non-Disclosure Agreement between SiOnyx and HPK
District Court	U.S. District Court for the District of Massachusetts
Hamamatsu	Collectively HPK and HC
Panel Opinion	<i>SiOnyx, LLC v. Hamamatsu Photonics K.K.</i> , 981 F.3d 1339 (Fed. Cir. 2020)

I. INTRODUCTION

The dispute in this case arises out of a non-disclosure agreement entered into between SiOnyx and HPK in 2007 (“the Agreement”). Under that Agreement, SiOnyx disclosed confidential information to HPK, with the understanding that HPK would use information it learned from SiOnyx only for joint development work and that SiOnyx would retain all rights to intellectual property, including patents, “in, or arising from” that information. Appx2881-2882. In clear violation of the Agreement, HPK secretly used SiOnyx’s confidential information not only to develop products but also to file patents claiming SiOnyx’s technology as its own (“the Disputed Patents”). As soon as SiOnyx learned of Hamamatsu’s clandestine actions, it filed suit in the District Court for the District of Massachusetts to regain control over its technology.

After a nearly three-week trial, Hamamatsu lost on every jury question, including the jury’s finding that Hamamatsu breached the Agreement. Appx7-8. As a result, the District Court awarded sole ownership of the U.S. Disputed Patents to SiOnyx and enjoined Hamamatsu from continuing to practice those Patents because it never should have been able to do so in the first place. Hamamatsu then appealed seven issues to this Court, including whether SiOnyx should be a sole owner of the Disputed Patents and whether the District Court abused its discretion in enjoining Hamamatsu from practicing those Patents as a remedy for breach of

contract or, in the alternative, whether the scope of the injunction for breach of contract is too broad. (*See generally* Blue Br.) The panel considered and rejected each of Hamamatsu’s issues on appeal. Panel Op. at *25. In its Petition for Rehearing, Hamamatsu seeks a second bite at the same arguments it already raised with respect to the scope of the injunction, in the hope of avoiding consequences for stealing SiOnyx’s technology.

Hamamatsu’s argument for panel and *en banc* rehearing—which Hamamatsu only raised briefly in its voluminous briefing before the merits panel—is that the District Court’s breach-of-contract injunction is too broad to satisfy Rule 65 of the Federal Rules of Civil Procedure because it prohibits Hamamatsu from “making, using, using, offering for sale, selling, or importing products practicing the [D]isputed [P]atents.” (Pet. at 2.) But the reason that the panel easily dispatched this argument is that there is no bright-line rule demarking what language is improper for an injunction. This Court has held that the determination of the proper scope of an injunction is dependent on the circumstances of the case. For example, in *Oakley, Inc. v. Sunglasses Hut International*, this Court explained, “[w]e have even upheld an injunctive order employing nonspecific language *on the ground that the detailed record of the case ameliorated any risk of unwarranted contempt actions.*” 316 F.3d 1331, 1346-47 (Fed. Cir. 2003) (emphasis added) (citing *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1359 (Fed. Cir. 1999)).

The record here is extensive, providing Hamamatsu with ample information from which it understands what activities are enjoined. Evidence presented at trial established that HPK used SiOnyx's information to obtain the Disputed Patents, Appx5144- 5164 at Appx5158, HPK prosecuted those claims and therefore understands what the claims mean, Appx3025, and HPK makes and sells products that practice those Patents, Appx1238 at 103:3-7. Hamamatsu further requested that the District Court clarify the scope of its injunction by excluding a specific class of products, which the District Court declined to do. Appx2472.

Considering the circumstances of this case, there is no error in the merits panel's determination that the scope of the District Court's injunction is proper or in its treatment of this tertiary argument in Hamamatsu's crowded appeal. Panel Op. at *25.

II. BACKGROUND

Dr. James Carey and Prof. Eric Mazur of Harvard discovered and patented a unique process for improving the performance of photonic devices for long (near infrared and infrared) wavelengths of light by adding a texture, created by laser processing, to silicon. Appx932 at 23:7-21. Dr. Carey and Prof. Mazur then founded SiOnyx, and Dr. Carey continued his research to refine and commercialize that technology. Appx944 at 35:4-19.

In January of 2007, SiOnyx entered into the Agreement with HPK to explore joint development of commercial products employing SiOnyx's technology. Appx2881-2882. The Agreement provides that SiOnyx is the owner of all patents "in, or arising from" any confidential information it disclosed to HPK. *Id.* With the Agreement in place, Dr. Carey sent device architectures and information regarding SiOnyx's proprietary processes and resulting texture to HPK. Appx560-564 at 87:7-91:22; Appx570 at 97:19-25; Appx608-610 at 135:17-137:19 (discussing Appx2883-2885). Dr. Carey's inventions showed a three-fold increase in performance over HPK's standard devices. Appx601-603 at 128:4-130:1. Despite these impressive results, HPK told SiOnyx it had no interest in SiOnyx's technology and did not extend the Agreement past its one-year term. Appx626 at 12:2-16.

Unbeknownst to SiOnyx, HPK continued to use SiOnyx's confidential information in clear violation of the Agreement. HPK improperly used this information to develop its own product line and to file the Disputed Patents claiming Dr. Carey's technology as HPK's own. *See, e.g.*, Appx1030-1032 at 38:23-40:15 (discussing Appx5707-5719); *see also* Appx7 at Q1-2 (jury verdict finding breach of Agreement by HPK); Appx3021; Appx3026; Appx5144-5164; Appx6267. Before filing these Patents, the HPK employees named as inventors submitted invention disclosure forms, expressly stating that the information

obtained from SiOnyx formed the basis of the inventions claimed. Appx5144-5164 at Appx5158. The specifications of the Disputed Patents contain a number of embodiments, all of which teach forming the claimed “irregular asperity” with Dr. Carey’s laser-processing technology disclosed to HPK under the Agreement. *See, e.g.*, Appx3025-3114. These laser-processing embodiments provide the necessary § 112 support for the full scope of the each claim of the Disputed Patents. Appx651-652 at 37:1-38:10 (explaining that every embodiment in ’945 Disputed Patent uses pulsed laser and is same as what SiOnyx disclosed under Agreement). Hamamatsu witnesses further testified that Hamamatsu’s products practice the claims of the Disputed Patents. Appx1238 at 103:3-7.

In light of this overwhelming evidence, the jury unsurprisingly found that HPK breached the Agreement. Appx7. As a result, the District Court granted SiOnyx sole owner of the United States Disputed Patents as a remedy for HPK’s breach. Appx14-17. As the District Court explained, “[t]here appears to be no doubt, based on the jury’s verdict, that the disputed patents arose, at least in part from the use of [SiOnyx’s] confidential information. There was substantial evidence that HPK employees used the confidential information in the course of developing the technology that resulted in the [Disputed Patents], and it is difficult to construe the verdict reasonably in any other way.” Appx15. Based on this transfer of ownership to SiOnyx and the terms of the Agreement, the District Court

further enjoined Hamamatsu from “practicing” the Disputed Patents, which Hamamatsu never should have filed or owned in the first place. Appx4-6; Appx17-18.

Hamamatsu appealed seven issues to this Court, most of which were aimed at avoiding any remedies instituted by the District Court. Among many other arguments, Hamamatsu argued that the District Court abused its discretion in entering an injunction for breach of contract. (Blue Br. at 50-56.) Hamamatsu also argued, briefly, in the alternative that the District Court abused its discretion in the scope of what it enjoined, arguing that “[a]n injunction based on patent infringement must be related to the products adjudged to be infringing.” (*Id.* at 58 (citing *Int’l Rectifier Corp. v. IXYS Corp.*, 383 F.3d 1312, 1316 (Fed. Cir. 2004); *Additive Controls & Measurement Sys. v. Flowdata, Inc.*, 986 F.2d 476, 479-80 (Fed. Cir. 1993)).)

Over these arguments and the case law cited by Hamamatsu, the merits panel upheld the District Court’s breach-of-contract injunction, as well as all six of the other issues Hamamatsu raised. Panel Op. at *16, 25. The panel rejected Hamamatsu’s primary argument regarding the injunction, finding it did not “operate[] only to punish Hamamatsu for its past conduct.” Panel Op. at *16. The panel continued that “it was not an abuse of discretion for the district court to determine that the harm to SiOnyx from Hamamatsu’s head start in developing its

products and premature entrance to the market was irreparable and not adequately remedied by money damages.” *Id.* The panel rejected the remainder of Hamamatsu’s arguments, including its hastily-presented alternative argument that the scope of the injunction is improper, by explaining “[w]e have considered the parties’ remaining arguments but find them unpersuasive.” Panel Op. at *25.

III. REASONS FOR DENYING THE PETITION

A. Panel Rehearing is Unwarranted Because Hamamatsu Merely Repeats Arguments that the Panel Already Rejected

Petitions for panel review should not be used “to reargue issues previously presented that were not accepted by the merits panel during initial consideration of the appeal.” Fed. Cir. Information Sheet re Petitions for Rehearing and Petitions for Hearing and Rehearing *en Banc*.¹ Despite this prohibition, Hamamatsu’s Petition recycles the same arguments and cases as its prior briefs. The panel’s decision to reject Hamamatsu’s arguments does not mean that the panel “overlooked or misapprehended” any point of fact or law. Fed. R. App. P. 40(a)(2). Hamamatsu simply disagrees with outcome of its appeal. But this does not support or require panel rehearing.

¹ available at http://www.cafc.uscourts.gov/sites/default/files/cmecf/Petitions_Rehearing_En_Banc_-_Information_Sheet.pdf, revised Aug. 21, 2018 (last visited Jan. 13, 2021).

Just like its Petition, Hamamatsu’s Blue Brief relied on *International Rectifier*, *Forest Laboratories*, and *Additive Controls* to argue that the injunction is too broad because injunctions must be limited to “devices not more than colorably different from the adjudicated devices.” (*Compare* Blue Br. at 58-59 (citing and quoting *Int’l Rectifier*, 383 F.3d at 1316, *Forest Labs., Inc. v. Ivax Pharms., Inc.*, 501 F.3d 1263, 1271 (Fed. Cir. 2007); and *Additive Controls*, 986 F.2d at 479-80 *with* Pet. at 6-7 (same)). The only case included anywhere in Hamamatsu’s Petition that is not also discussed in Hamamatsu’s Blue Brief is *MACOM Technology Solutions Holdings, Inc. v. Infineon Technologies, AG*, 881 F.3d 1323, 1332 (Fed. Cir. 2018). But, Hamamatsu relied on *MACOM* in its Yellow Brief in reply to SiOnyx’s distinctions over *International Rectifier*, *Forest Laboratories*, and *Additive Controls*. (Yellow Br. at 34-35.)

Hamamatsu claims no fewer than seven times in its Petition that SiOnyx agrees that *MACOM* supports rehearing because Hamamatsu cited it in response to distinctions SiOnyx raised over *International Rectifier*, *Forest Laboratories*, and *Additive Controls* in its Red Brief. (*See, e.g.*, Pet. at 2, 6.) This argument does not hold water. In identifying factual distinctions over the cases Hamamatsu cited in its opening brief, SiOnyx did not admit that any other case is controlling here or renders improper the District Court’s injunction improper. (Red Br. at 47-48.) Regardless, Hamamatsu’s Petition arguments regarding *MACOM* at a minimum

show that all of the case law in its Petition for Rehearing was already presented to the merits panel.²

Having considered the exact same arguments as Hamamatsu's petition, the panel did not misapprehend or overlook any of Hamamatsu's arguments. The Panel rather, found Hamamatsu's injunction-scope arguments "unpersuasive" and therefore declined to reverse the District Court's decision. Panel Op. at *25.

There is no error in the panel's decision because this Court's precedent makes clear that there is no bright-line rule for determining what scope of injunction is proper. Instead, the scope of injunctions is dependent on the circumstances of the case, including the amount of detail in the record. *MACOM* addresses a preliminary injunction, entered without the benefit of a complete record developed during a trial. 881 F.3d at 1327. By contrast, this Court has found that cases with a fulsome

² Hamamatsu also relies on statements made by SiOnyx during Oral Arguments to claim that SiOnyx concedes that the case law Hamamatsu relies on in its Petition renders the injunction improper. (*See* Pet. at 5 (citing Oral Arg. at 21:40-21:54), 8-9 (citing Oral Arg. at 23:31-23:52).) Again, at most, the Oral Argument quotes show that the merits panel questioned SiOnyx's counsel about the scope of the injunction and therefore considered the arguments raised in Hamamatsu's briefing. As quoted, SiOnyx acknowledged that the correct standard for enforcing patent infringement injunctions is that the injunction covers "products that were litigated . . . [and] products that are only colorably different from the products that were litigated." (*Id.* (citing Oral Arg. At 23:31-23:52)); *see also* *TiVo Inc. v. EchoStar Corp.*, 646 F.3d 869, 882 (Fed. Cir. 2011) (*en banc*). But Hamamatsu's petition does not concern the proper standard for *enforcement* of an injunction. (*See* Pet. at 4.) Accordingly, this quote does not further Hamamatsu's argument.

record, like the present case, can support a broader injunction under Rule 65 of the Federal Rules of Civil Procedure.

In *Signtech*, for example, this Court found an injunction prohibiting “any further infringement of the ’552 patent” did not run afoul of Rule 65 of the Federal Rules of Civil Procedure. 174 F.3d at 1359. The Court explained that “any danger of unwarranted contempt actions is minimal, if not completely non-existent, because of the detailed record on which this injunction was entered. . . . This decision, of necessity, leaves open whether a later device produced by Signtech, which is more than trivially different from the devices found to infringe, is within the scope of the ’552 patent claims and therefore an infringing device.” 174 F.3d at 1359. Likewise, in *Streck, Inc. v. Research & Diagnostic Systems, Inc.*, this Court explained, “Mere inclusion of the phrase ‘from otherwise infringing the asserted claims,’ when taken in the context of the entire order and record on which it was entered, does not render the injunction overbroad.” 665 F.3d 1269, 1293 (Fed. Cir. 2012).

This Court relied on *Signtech* in *Oakley* to uphold an injunction preventing the defendant from “making, using, importing, selling, or offering to sell any products with Emerald (green) or Ice (blue) lenses that infringe the ’902 patent.” 316 F.3d at 1346. Like Hamamatsu, the defendant in *Oakley* raised the concern that the injunction did not have enough specificity to allow it to design around the

injunction. *Compare id.* at 1347 with *Pet.* at 10 (“subjecting Appellants to the threat of unwarranted contempt proceedings over, for example, products HPK develops independently of any SiOnyx confidential information.”). The *Oakley* panel explained in response that certainty is unnecessary and that “open question[s]” regarding the enjoined activity do not render an injunction improper under Rule 65 of the Federal Rules of Civil Procedure. 316 F.3d at 1347.

The record informing the scope of the injunction in this case is abundant. At trial, for example, documents and witness testimony established that Hamamatsu used SiOnyx’s confidential information to file the Disputed Patents it is now enjoined from practicing, Appx5144-5164 at Appx5158, that the confidential information HPK misappropriated from SiOnyx enables the full scope of the claims, Appx651-652 at 37:1-38:10, that Hamamatsu prosecuted the claims of the Disputed Patents and therefore cannot claim ignorance as to what those claims cover, Appx3025, and that Hamamatsu’s products practice the claims of the Disputed Patents, Appx1238 at 103:3-7. Hamamatsu further moved the District Court to modify its injunction to exclude “wet-etched” products that Hamamatsu claimed it had independently invented. *See SiOnyx, LLC v. Hamamatsu Photonics K.K.*, C. A. 1:15-cv-13488, Dkt. 830, Order Denying Defendants’ Motion for Clarification or Modification of Injunction (D. Mass. Sept. 24, 2019); *see also id.* at Dkt. 805 (Appx2472), Dkt. 806, Dkt. 812. The District Court denied that

Motion, again giving Hamamatsu plenty of context to understand the scope of the injunction. *See, e.g., Oakley*, 316 F.3d at 1246-47 (rejecting concerns that injunction was not specific enough to allow party to design around).

Case law from this Court further makes clear that there is no bright-line requirement that an injunction to list specific products or be limited by its terms to the adjudicated products to comply with Rule 65. (*See* Pet. at 3-4.) In *Metalcraft of Mayville, Inc. v. the Toro Co.*, for example, this Court upheld an injunction prohibiting the enjoined party from “making using, selling, and offering to sell lawnmowers equipped with platform suspension systems that infringe [] patent[.]” 848 F.3d 1358, 1369-70 (Fed. Cir. 2017). In *United Construction Products, Inc. v. Tile Tech, Inc.*, for another example, this Court upheld an injunction prohibiting “any and all acts of infringement of the [’365 patent], *including*” a list of “hypothetical examples following the term ‘including.’” 843 F.3d 1363, 1371-72 (Fed. Cir. 2016). That injunction is no more specific than the injunction in the present case as it also does not list any specific adjudicated products, as Hamamatsu claims is required. (Pet. at 3-4.)

The cases discussed above further demonstrate that there is no conflict between the merit panel’s decision and the cases Hamamatsu cites in its Petition. In upholding the injunction issued without limitation to specific products, *United Construction* cites with approval *International Rectifier*, which is one of the main

cases on which Hamamatsu relies. 843 F.3d at 1371 (citing *Int'l Rectifier*, 383 F.3d at 1315); *see also, e.g., Metalcraft*, 848 F.3d at 1369 (same). *Oakley* discusses *Additive Controls* with approval. 316 F.3d at 1321 (citing *Additive Controls*, 986 F.3d at 480); *Signtech*, 174 F.3d at 1356 (same). And, consistent with the discussion above, *International Rectifier* analyzes *Signtech*, finding it materially distinct because the record in *Signtech* was so much more detailed. *Int'l Rectifier*, 383 F.3d at 1317 (citing *Signtech*, 174 F.3d at 1359). Accordingly, the merits panel's decision here is consistent with precedent from this Court.

Because none of the cases relied on by Hamamatsu in its briefing below or in its Petition mandate a change in scope of the District Court's injunction, the merits panel did not overlook or misapprehend any point of fact or law. Fed. R. App. P. 40(a)(2). Hamamatsu simply did not succeed in convincing the panel that the District Court abused its discretion. Panel Op. at *25. Accordingly, Hamamatsu's Petition for Panel Rehearing should be denied.

B. Rehearing *en Banc* is Also Unwarranted Because the Panel's Decision is Correct and, in Any Event, Raises No Issues Worthy of the *en Banc* Court's Attention

Hamamatsu's Petition for Rehearing *en banc* should be denied. As set forward by Rule 35 of the Federal Rules of Appellate Procedure, *en banc* rehearing "will not be ordered unless (1) *en banc* consideration is necessary to secure or

maintain uniformity of the court’s decisions; or (2) the proceeding involves a question of exceptional importance.” Neither circumstance is present here.

First, as discussed above, the scope of the injunction entered by the District Court is consistent with this Court’s precedent. *See, e.g., United Constr.*, 843 F.3d at 1371-72; *Streck*, 665 F.3d at 1293; *Oakley*, 316 F.3d at 1246-47; *Signtech*, 174 F.3d at 1359. These cases affirm injunctions of similar scope to the one entered in this case on a fulsome record and many of them do so after citing with approval the same cases Hamamatsu claims are contrary to the merits panel’s decision. *See, e.g., Oakley*, 316 F.3d at 1346 (citing *Additive Controls*, 986 F.2d at 480). The record in this case – including evidence presented at trial and the briefing before the Massachusetts District Court on the scope of the injunction – provides Hamamatsu with more than sufficient information to understand the scope of the injunction. *See* § III.A. The merits panel’s decision is therefore consistent with this precedent and does not raise any questions of uniformity requiring intervention of the full Court.

Second, Hamamatsu has not argued in its Petition that this case raises questions of exceptional importance because it does not. The only questions raised by Hamamatsu’s petition are specific to this case, which, even if they were decided incorrectly, do not warrant intervention from the *en banc* Court. Rather, as discussed above, Hamamatsu’s Petition presents questions of whether this

particular injunction is insufficiently clear, given the record before the district court. Accordingly, Hamamatsu's Petition for Rehearing *en Banc* should be denied.

IV. CONCLUSION

For the above reasons, SiOnyx and Harvard respectfully request that Hamamatsu's Petition for Panel Rehearing and Rehearing *en Banc* be denied.

Date: January 21, 2021

/s/ William Belanger _____

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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