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10

11 UNITED STATES DISTRICT COURT
12 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

13 JENS ERIK SORENSEN, as Trustee of
14 SORENSEN RESEARCH AND
15 DEVELOPMENT TRUST,

16 Plaintiff

17 v.

18 KYOCERA INTERNATIONAL, INC., a
19 California Corporation; KYOCERA
20 WIRELESS CORP., a California
21 Corporation; and DOES 1 – 100,

22 Defendants.

23 _____
24 and some related '184 patent cases¹

) Case No. 08cv411 BTM CAB;
) 08cv0060; 08cv0070; 08cv0304;
) 08cv0305; 08cv1670; 09cv0056;
) 09cv0058

) **SORENSEN'S OPPOSITION TO**
) **JOINT MOTION FOR LEAVE TO**
) **FILE SUMMARY JUDGMENT OF**
) **NO LIABILITY PRIOR TO THE**
) **ISSUANCE OF THE**
) **REEXAMINATION CERTIFICATE**

) Date: April 8, 2011
) Time: 11:00 a.m.
) Ctrm: 15
) Judge: Hon. Barry Ted Moskowitz

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27 _____
28 ¹ *Sorensen v. Big Lots, Inc.*, Case No. 09cv0057, is not included in this motion; Big Lots did not join in this motion.

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1 **INTRODUCTION**

2 35 U.S.C. §§ 307 and 252 do not provide this Court with “the opportunity to
3 dispose of all Sorensen litigation” before it, as tempting as that may seem. Accused
4 Infringers’² request for leave to file a dispositive motion on Patentee’s three-years-
5 stayed infringement cases while maintaining the stay in place is not warranted
6 procedurally or substantively.

7 1. Any lift of stay that would allow consideration of dispositive motions
8 must be equally applied to both sides. There is no legal authority to support the
9 requested unilateral lift of stay, allowing Accused Infringers to proceed on the merits
10 of their arguments, while Sorensen³ continues to be prohibited from proceeding on
11 the merits of his arguments.

12 2. Adjudication of Accused Infringer’s proposed motion, even if it had any
13 colorable merit, would require discovery and claim construction. This is
14 demonstrated in the proposed motion itself, at pages 3-7, which contains extensive
15 claim construction arguments, and the *Univ. of Virginia* case upon which Accused
16 Infringers rely which also involves an extensive claim construction. Per Patent
17 Local Rule 4, claim construction proceedings entail exchange of contentions,
18 briefing, and discovery, not to mention that preliminary invalidity contentions must
19 be served prior to commencement of claim construction proceedings. The Accused
20 Infringers have not yet been required to file preliminary invalidity contentions.

21 _____
22 ² Although the Joint Motion was only filed in *Sorensen v. Kyocera*, No. 08cv411, the
23 Joint Motion is signed by seven of the accused infringers in the related ‘184 patent cases,
24 and notice was recently given that Target Corporation also joins in the Joint Motion.
25 Furthermore, the Court has ordered that all of the remaining parties that signed the Joint
26 Motion are permitted to file motion papers that incorporate by reference the briefs filed
27 here in *Sorensen v. Kyocera*.

28 ³ Jens Erik Sorensen, as Trustee of Sorensen Research and Development Trust, is the
Defendant in Case No. 08cv1670, and the Plaintiff in the remaining captioned cases. For
ease of reference throughout, the parties will be designated as “Sorensen” and “Accused
Infringers.”

1 3. The proposed motion will not conserve judicial or party resources
2 because it is solely based on an aberrant, non-precedential, district court order that
3 runs directly contrary to statute, all Federal Circuit caselaw, and the unequivocal
4 legal prohibition on amending an expired patent, such as the '184 patent, in
5 reexamination.

6 4. Accused Infringers will not be unfairly prejudiced by being required to
7 comply with the Federal Rules of Civil Procedure and the ordinary procedures of a
8 federal tribunal when stay is lifted in these cases. “[T]he suppliant for a stay must
9 make out a clear case of hardship or inequity in being required to go forward, if there
10 is even a fair possibility that the stay for which he prays will work damage to some
11 one else.” *Landis v. No. American Co.*, 299 U.S. 248, 255 (1936). “[B]eing required
12 to defend a suit [if the stay is vacated], does not constitute a ‘clear case of hardship
13 or inequity’ within the meaning of *Landis*.” *Dependable Highway Exp., Inc. v.*
14 *Navigators Ins. Co.*, 498 F.3d 1059, 1066 (9th Cir. 2007).

15 5. The Accused Infringers’ request is also outside of the scope of
16 permissible motions in the Court’s Partial Lift Order which stated that the Court
17 “will not entertain any motions for summary judgment related to the substantive
18 issues being litigated before the Board of Patent Appeals and Interferences (‘BPAI’)”
19 (Partial Lift Order at 3:9-11) and also stated that no date for claim construction was
20 being set. The Accused Infringers’ proposed motion falls squarely within the
21 substance of the reexamination, and would require claim construction to be
22 completed by the Court as a prerequisite to the motion.

23
24 In addition to its procedural infirmities, the Accused Infringers’ proposed
25 summary judgment motion is substantively inappropriate because it is based solely
26 upon an aberrant interpretation of 35 U.S.C. § 307(b) in an unreported district court
27 order that is materially distinguishable from the ‘184 patent cases.

28 The relied-upon district court order rewrites 35 U.S.C. § 307(b), which

1 incorporates the provisions of 35 U.S.C. § 252, to apply not only to claims amended
2 during reexamination, but also to claims not amended during reexamination. This
3 same district court, in reconsideration of its order, affirmatively states that this
4 “appears to be an issue of first impression. No reexamination case law on this topic
5 has been located, and the parties have supplied no definitive evidence bearing on
6 Congress’s intent.”⁴

7 Even if this aberrant district court decision had merit, it could not be
8 analogized and applied to the ‘184 patent cases because the ‘184 patent expired in
9 February 2008 and is therefore incapable of being amended, a fact not present in the
10 aberrant district court opinion.

11 Thus, Sorensen respectfully requests the Court to deny the Accused Infringers’
12 motion for leave to file their proposed motion for summary judgment of no liability.
13 If, instead, the Court were to lift stay for all purposes, then Accused Infringers would
14 be free to file any motions that they deem appropriate.

15 16 **FACTUAL SUMMARY**

17 This Court has denied permission for Patentee Sorensen to proceed on the
18 merits of any of its claims or counterclaims involving the ‘184 patent continuously
19 since September 10, 2007 – a period of 3-1/2 years.

20 A merged *ex parte* reexamination currently pending before the USPTO on the
21 ‘184 patent has been ongoing since July 2007, but still is not complete. The claims
22 challenged in the reexamination are Claims 1, 2, 4, 6, 7, 8, 9, 10. Claims 3 and 5
23 were never challenged, and Claims 2 and 4, claims that were never asserted against
24 any of the Accused Infringers, were cancelled during the reexamination. No claims
25 have been amended and, as a matter of law discussed below, no claims can be
26 amended in reexamination because of the intervening expiration of the ‘184 patent

27
28 ⁴ *Univ. of Virginia Patent Foundation v. General Elec. Co.*, 2011 WL 453248,
at*8 (W.D.Va. Feb. 8, 2011).

1 on February 5, 2008.

2 Irrespective of the various developments within the reexamination, whether
3 favorable or not, that have been brought to the Court's attention over the course of
4 the last years, the Court has never agreed to allow the cases to proceed on their
5 merits.

7 ARGUMENT

9 **I. ANY LIFT OF STAY THAT WOULD ALLOW THE FILING OF 10 DISPOSITIVE MOTIONS MUST BE EQUALLY APPLIED TO BOTH 11 SIDES AND MUST ALLOW FOR ALL NECESSARY PROCEDURES.**

12 Accused Infringers are requesting the Court for a limited lift of stay, not for
13 the purpose of maintaining any *status quo* pending stay, but to allow them to file a
14 dispositive motion for summary judgment while the opposing party continues to be
15 prohibited from proceeding on any aspect of the cases. They go even further
16 suggesting that no claim construction would be required, nor any discovery.

17 First, Accused Infringers have not proffered a single legal authority that would
18 allow their requested one-sided stay. “[A] stay operates upon [a] judicial proceeding
19 itself” to “suspend[] judicial alteration of the status quo” while an injunction acts
20 upon a “party’s conduct.” *Nken v. Holder*, --- U.S. ---, 129 S.Ct. 1749, 1757-58
21 (2009). “The right to proceed in court should not be denied except under the most
22 extreme circumstances.” *Klein v. Adams & Peck*, 436 F.2d 337, 339 (2nd Cir. 1971)
23 (court vacated order granting injunction holding that “mere fact that plaintiff is
24 litigious is not an adequate basis from which to conclude that all his actions are
25 meritless”); *Commodity Futures Trading Com’n v. Chilcott Portfolio Management,
26 Inc.*, 713 F.2d 1477, 1484 (10th Cir. 1983) (court reversed stay order as abuse of
27 discretion citing, as one reason, serious adverse effects of broad stay on parties’
28 abilities to gather evidence and prosecute suits). “Considerations [of judicial
economy] should rarely if ever lead to such broad curtailment of the access to the

1 courts.” *Commodity Futures*, 713 F.2d at 1485.

2 Accused infringers are asking for a *unilateral* lift of the current stay, so that
3 they may proceed on issues they would like to proceed on, while simultaneously
4 keeping in place the prohibition on the Patentee from proceeding on any issues
5 whatsoever. Such an order would convert the existing stay into an injunction against
6 Patentee and is therefore unwarranted.

7 In addition, in order to proceed on their proposed motion would require claim
8 construction and related discovery. “When claims are amended during
9 reexamination following a rejection based on prior art [which Accused Infringers
10 assert occurred here], the claims are not deemed substantively changed as a matter of
11 law. There is no *per se* rule. To determine whether a claim change is substantive it is
12 necessary to analyze the claims of the original and the reexamined patents in light of
13 the particular facts, including the prior art, the prosecution history, other claims, and
14 any other pertinent information.” *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357,
15 1362-63 (Fed. Cir. 1991). Thus, claim construction is an essential part of the § 252
16 analysis. *See, e.g., Engineered Data Prods., Inc. v. GBS Corp.*, 506 F.Supp.2d 461,
17 467-75 (D. Colo. 2007) (stating basic legal axioms of claim construction prior to
18 engaging in lengthy claim construction for purposes of determination under § 252).
19 In fact, the *Univ. of Virginia* case upon which the Accused Infringers heavily rely
20 contains significant claim construction in order to address the issues of claim
21 continuity under 35 U.S.C. § 252. *Univ. of Virginia Patent Foundation v. General*
22 *Elec. Co.*, 2010 WL 4502599, at *4-10 (W.D.Va. Nov. 9, 2010).⁵ Thus, contrary to
23

24 ⁵ The *Univ. of Virginia* court stated as follows: “The resolution of this term's
25 [magnetization recovery period] meaning is both important to the Court's construction of
26 Claim 1 and crucial to the Court's decision on GE's motion for partial summary judgment
27 [under § 252], which is discussed in Section III. below. First, I will determine the meaning
28 of the “magnetization recovery period” limitation in Claim 1 as of the filing date of the
application for the patent in suit and prior to reexamination. Then I will address the parties'
arguments in the claim construction briefing and hearing over whether the meaning of the
term was altered by the reexamination proceedings. I reserve for Section III. discussion of

1 the Accused Infringers' suggestion, this Court cannot avoid claim construction and
2 with minimal effort wipe out Sorensen's rights under the '184 patent

3 If the Court agrees to lift stay to allow any motions that are unrelated to
4 maintenance of *status quo*, then lift needs to be uniformly applicable to both sides.
5 Accused Infringers would then be free to file any motion they deem legally
6 supportable, but within the context of equal access of all litigants to the due process
7 procedures of the Court. Claim construction and discovery would also need to
8 proceed.

9 Thus, having failed to present support for their requested unilateral lift of stay,
10 Accused Infringers' request should be treated as a general request for lift of stay and,
11 for reasons already briefed to the Court elsewhere, stay should be lifted.

12 That being said, judicial and party resources would be wasted if the Court
13 were to order briefing on Accused Infringers' proposed summary judgment motion
14 because the motion fails miserably on its substance.

15 **II. THE PROPOSED SUMMARY JUDGMENT MOTION IS BASED**
16 **UPON AN ABERRANT INTERPRETATION OF 35 U.S.C. § 307(b)**
17 **AND § 252.**

18 In addition to the procedural and due process irregularities in the Accused
19 Infringers' request, the request should be denied because the proposed motion is
20 without substantive merit.

21 The Accused Infringers' argument that they are shielded from liability under
22 the provisions of 35 U.S.C. § 307 and § 252 is dead wrong. As tempting as it may
23 sound to wrap up all cases on the '184 patent with a single motion, these statutes are
24 not now implicated and will never be implicated under the facts of this case, when a
25 patent has expired during reexamination as it has with the '184 patent.

26 **A. Accused Infringers' summary judgment argument is based upon an**
27

28 the scope of the change in the meaning of the term." *Univ. of Virginia*, 2010 WL 4502599,
at *6.

1 **aberrant, non-precedential, district court order in *University of***
2 ***Virginia Patent Foundation v. General Electric Company.***

3 The sole case that supports the Accused Infringers' argument for "amendment
4 in effect" is a very recent district court opinion in *Univ. of Virginia Patent*
5 *Foundation v. General Elec. Co.*, 2010 WL 4502599 (W.D.Va. Nov. 9, 2010). The
6 Western District of Virginia is the first federal court in the country to find that
7 cancellation of a claim in reexamination can create an "amendment in effect" and
8 further trigger elimination of claim continuity under 35 U.S.C. § 252. Two
9 additional filings have occurred in that case, neither of which were noted in the
10 Accused Infringers' proposed Motion. The district court in *Univ. of Virginia* denied
11 reconsideration on February 8, 2011, and on March 4, 2011, the patent holder,
12 University of Virginia Patent Foundation, filed a Motion for Certification to Appeal
13 this issue to the Federal Circuit. *Univ. of Virginia Patent Foundation v. General*
14 *Elec. Co.*, 2011 WL 453248, at*8 (W.D.Va. Feb. 8, 2011) (*Univ. of Virginia II*)
15 (denial of reconsideration); *Univ. of Virginia*, No. 3:08-cv-00025, Plaintiff's Motion
16 for Certification to Appeal (Doc. 188) dated Mar. 4, 2011. See *Request for Judicial*
17 *Notice*, Exhibit 1 (*Univ. of Virginia II*) and Exhibit 2 (docket sheet for *Univ. of*
18 *Virginia* case).

19 On reconsideration, the district court in *Univ. of Virginia* recognized that the
20 issue of whether 35 U.S.C. § 307(b) encompasses an "amendment in effect" was a
21 matter of first impression, and acknowledged that "[n]o reexamination case law on
22 this topic has been located, and the parties have supplied no definitive evidence
23 bearing on Congress's intent." *Univ. of Virginia II*, 2011 WL 453248, at*8. Notably,
24 both the original opinion and the decision on reconsideration are unreported cases.

25 No federal court in this country, with the exception of the *Univ. of Virginia*
26 case, has ever found that § 252 denial of claim continuity can arise in the absence of
27 an amendment. The decision by the Western District of Virginia is plagued by the
28 same errors that undermine the Accused Infringers' arguments. The Virginia court

1 uses the change in scope test to find an alleged “amendment in effect” in order to
2 avoid the absence of any actual amendment to the claim, and impermissibly rewrites
3 § 307(b) to create a statutory basis upon which to eliminate claim continuity in the
4 absence of amendment.

5 In addition, the *Univ. of Virginia* case is dissimilar from the ‘184 patent cases
6 in at least three crucial ways:

7 1. Unlike the ‘184 patent which expired during reexamination, the *Univ. of*
8 *Virginia* patent had not expired and thus it was legally permissible to amend claims
9 during reexamination. The *Univ. of Virginia* court makes no suggestion that its
10 “amendment in effect” concept would extend to expired patents which are prohibited
11 from being amended.

12 2. Unlike the ‘184 patent cases, the *Univ. of Virginia* court had conducted
13 a detailed claim construction prior to applying a 35 U.S.C. § 252 analysis to patent
14 claims.

15 3. Unlike the ‘184 patent cases, the *Univ. of Virginia* court found the
16 requisite “clear and unmistakable” disavowal of claim scope by the patent holder
17 based upon evidence that the patent holder changed its position on claim
18 construction in connection with the “amendment in effect.” Sorensen has never
19 asserted that the term “laminated” should be defined as it was by the Examiner in the
20 Second Office Action. See *Univ. of Virginia II*, 2011 WL 453248, at *6-7; *Univ. of*
21 *Virginia*, 2010 WL 4502599, at *7-8; see also *Sorensen v. International Trade*
22 *Com’n*, 427 F.3d 1375, 1378-79 (Fed. Cir. 2005) (“Disclaimers based on disavowing
23 actions or statements during prosecution, however, must be both clear and
24 unmistakable.”). Accused Infringers rely heavily upon the Examiner’s statements
25 and actions, minimizing Sorensen’s consistent position that “laminated” should be
26 defined as it was originally by the District of New Jersey, which construction was
27 then adopted by the Examiner in the First Office Action. “[I]t is the applicant, not
28 the examiner, who must give up or disclaim subject matter that would otherwise fall

1 within the scope of the claims.” *Sorensen*, 427 F.3d at 1379.

2 The Court in the case at bar is faced with the prospect of entertaining a motion
3 that seeks to deny Sorensen the right to enforce the ‘184 patent for the period prior to
4 the reexamination certificate, which in this case would constitute the entire 20-year
5 life of the patent. Need it be said, the Accused Infringers’ request is a significant
6 one. The Accused Infringers’ entire argument rests upon rewriting the statute
7 regarding the effect of a reexamined patent prior to the reexamination certificate to
8 include the alleged “amendment in effect.” The sole case which supports Accused
9 Infringers’ argument is the unreported, non-precedential *Univ. of Virginia* opinion,
10 which is further distinguishable upon the facts relating to claim construction and law
11 governing amendments to expired patents. That opinion, for which certification to
12 appeal has been filed, does not provide a basis for this Court to justify eliminating all
13 enforceable rights that ever existed under the ‘184 patent.

14
15 **B. Precedential statutes, caselaw, and administrative regulations**
16 **uniformly contradict the aberrant interpretation pressed by**
17 **Accused Infringers.**

18 Whereas Accused Infringers’ substantive arguments are based on non-
19 precedential law, precedential law demonstrates that their arguments are without
20 merit on several levels. There is no statutory basis to invoke the protections of, nor
21 trigger the tests under, 35 U.S.C. § 252, where no actual amendments to patent claim
22 language is made, as is the case with the ‘184 patent. Furthermore, even if § 252
23 could be triggered under an “amendment in effect” theory, that could not happen
24 with an expired patent which cannot, by law, be amended during reexamination.

25 ***1. Amendments to an expired patent in reexamination are***
26 ***prohibited under 37 CFR 1.530(j).***

27 Accused Infringers’ argument is predicated upon the assertion that an
28 “amendment in effect” occurred during reexamination. That is not legally possible.
Under 37 CFR 1.530(j), amendments to expired patents are prohibited in

1 reexamination proceedings:

2 No amendment may be proposed for entry in an expired patent.
3 Moreover, no amendment, other than the cancellation of claims, will
4 be incorporated into the patent by a certificate issued after the
5 expiration of the patent.”

6 37 CFR 1.530(j) (regulation entitled “Statement by patent owner in *ex parte*
7 reexamination; amendment by patent owner in *ex parte* or *inter partes*
8 reexamination; inventorship change in *ex parte* or *inter partes* reexamination”).

9 The Manual of Patent Examining Procedure (“MPEP”) provides the following
10 explanation:

11 Pursuant to 37 CFR 1.530(j), “[n]o amendment may be proposed for
12 entry in an expired patent.” Thus, if a patent expires during the
13 pendency of a reexamination proceeding for a patent, **all**
14 **amendments to the patent claims and all claims** added during the
15 proceeding are withdrawn. This is carried out by placing a diagonal
16 line across all **amended and new claims** (and text added to the
17 specification) residing in the amendment papers. The Patent Owner
18 should be notified of this in the next Office action. The Office action
19 will hold the amendments to be improper, and state that all subsequent
20 reexamination will be on the basis of the unamended patent claims.
21 This procedure is necessary since no amendments will be incorporated
22 into the patent by a certificate after the expiration of the patent.

23 MPEP § 2250 (Amendment by Patent Owner), ¶ III (emphasis added).

24 Thus, not only are amendments to expired patents prohibited, the amendments
25 that are specifically prohibited in expired patents undergoing reexamination are
26 precisely those identified in 35 U.S.C. § 307(b) – amended and new claims. *See*
27 MPEP § 2250, ¶ III. As a result, in the case of an expired patent there can never be,
28 in the precise language of 35 U.S.C. § 307(b), “[a]ny proposed amended or new
claim” that could trigger application of § 252. In other words, an expired patent in
reexamination can never have claims that require application of the § 252 provisions
regarding elimination of claim continuity.

1 The '184 patent expired on February 5, 2008⁶, shortly after reexamination
2 started. Thus, any amendment to the '184 patent claims is prohibited under U.S.
3 patent laws. Accused Infringers are aware of this prohibition -- Sorensen has
4 pointed it out in prior filings with the Court⁷ – yet they make no mention of this law
5 in their briefings.

6 The *Univ. of Virginia* decision, upon which Accused Infringers so heavily
7 rely, does not address an expired patent and even that otherwise aberrant decision
8 does not go so far as to try to modify the prohibition on amendments to an expired
9 patent in reexamination.

10 If the cancellation of claims 2 and 4 was in fact an “amendment in effect” as
11 the Accused Infringers argue, the Examiner was required to have withdrawn the
12 cancellation, hold the cancellation as improper, and so notify the patent holder,
13 Sorensen. *See* MPEP § 2250, ¶ III. This the Examiner never did. In fact, as
14 Accused Infringers have already noted, claims 2 and 4 were cancelled at the
15 suggestion of the Examiner, and the cancellation was duly entered by the Examiner.

16 Under 37 CFR 1.530(j), an Examiner is permitted to enter a cancellation of
17 claims in an expired patent, as was done with the '184 patent claims 2 and 4. As the
18 MPEP explains:

19
20 37 CFR 1.530(j) further states that “[m]oreover, no amendment, other
21 than the cancellation of claims, will be incorporated into the patent by
22 a certificate issued after the expiration of the patent.” Thus, at the

23 ⁶ Accused Infringers’ pleadings erroneously state that the expiration date was July
24 27, 2009, though this does not have any bearing on any parties’ analysis on these issues.
25 The '184 patent expired on February 5, 2008. *See* 35 U.S.C. § 154 (where patent
26 application contains specific reference to earlier filed application under 35 U.S.C. § 120,
27 the patent term ends 20 years from the date on which the earlier application was filed; in
28 the case of the '184 patent, the earlier application was filed on February 5, 1988).
Ironically, Accused Infringers’ error would put them on the hook for another year and a
half of damages beyond what Sorensen has asserted.

⁷ *See Sorensen v. Rally*, Case No. 08cv305, at Doc. # 121 and 122.

1 time the NIRC [Notice of Intent to Issue Ex Parte Reexamination
2 Certificate] is to be issued, the examiner should ensure that all
3 rejected and objected to claims are canceled. The examiner should
4 issue an examiner's amendment canceling any such claims not already
5 canceled. The cancellation of the original patent claims is the only
6 "amendatory" change permitted in an expired patent.

7 MPEP § 2250, ¶ III (emphasis added).

8 Had the Examiner perceived that the cancellation in any way operated as an
9 impermissible amendment, it is to be assumed that the Examiner would have acted in
10 accordance with PTO rules and regulations and refused entry of the cancellation.
11 "[G]overnment officials are presumed to have 'properly discharged their official
12 duties.'" *In re Portola Packaging, Inc.*, 110 F.3d 786, 790 (Fed. Cir. 1997)
13 (superseded by statute on other grounds).

14 For this Court to hold that the Examiner's entry of a cancellation was, in
15 reality, an amendment of the remaining claims in reexamination would require the
16 Court to find that the Examiner acted in violation of 37 CFR 1.530(j) by entering an
17 "amendment" to the patent claims of an expired patent, and intended to subsequently
18 violate MPEP § 2250 by later issuing a reexamination certification containing an
19 impermissible amendment. There is no basis for such a conclusion.

20 The only other alternative for this Court to deal with these prohibitions would
21 be to rewrite 37 CFR 1.530(j) so as to allow for amendments to expired patents in
22 reexamination. This is not a viable option because it would require the Court to
23 engage in impermissible judicial legislation (*See Ricoh Co. v. Nashua Corp.*, 185
24 F.3d 884, 1999 WL 88969, at *2-3 (Fed. Cir. Feb. 18, 1999)) as will be discussed
25 later in the brief.

26 **2. 35 U.S.C. §§ 252 and 307 demonstrate that neither the**
27 **provisions of, or tests under, 35 U.S.C. § 252 are triggered**
28 **where no actual amendments to patent claim language is made.**

No claims have been or can be amended in reexamination given expiration of

1 the '184 patent. Claims 1, 3, 5, 6, 7, 8, 9, and 10 read the same, verbatim, as they did
 2 the day the patent was issued in June 1990, and when it expired in February 2008.
 3 Because no changes were made or can be made to these claims, 35 U.S.C. § 307(b)
 4 upon which the Accused Infringers' rely does not provide a statutory basis for this
 5 Court to shield Accused Infringers from liability under 35 U.S.C. § 252.

6 35 U.S.C. § 307 is from the chapter dealing with *ex parte* reexamination of
 7 patents and reads as follows:

8 **Certificate of patentability, unpatentability, and claim cancellation**

9
 10 (a) In a reexamination proceeding under this chapter, when the time for
 11 appeal has expired or any appeal proceeding has terminated, the
 12 Director will issue and publish a certificate canceling any claim of the
 13 patent finally determined to be unpatentable, confirming any claim of
 the patent determined to be patentable, and incorporating in the patent
any proposed amended or new claim determined to be patentable.

14 (b) Any proposed amended or new claim determined to be patentable
 15 and incorporated into a patent following a reexamination proceeding
 16 will have the same effect as that specified in section 252 of this title for
 17 reissued patents on the right of any person who made, purchased, or
 18 used within the United States, or imported into the United States,
 19 anything patented by such proposed amended or new claim, or who
 made substantial preparation for the same, prior to issuance of a
 certificate under the provisions of subsection (a) of this section.

20 35 U.S.C. § 307 (2002) (emphasis added).

21 35 U.S.C. § 252, as referred to in 35 U.S.C. § 307(b), reads in relevant part as
 22 follows:

23 **Effect of reissue**

24
 25 The surrender of the original patent shall take effect upon the issue of
 26 the reissued patent, and every reissued patent shall have the same effect
 27 and operation in law, on the trial of actions for causes thereafter arising,
 28 as if the same had been originally granted in such amended form, but in
so far as the claims of the original and reissued patents are substantially
identical, such surrender shall not affect any action then pending nor

1 abate any cause of action then existing, and the reissued patent, to the
2 extent that its claims are substantially identical with the original patent,
3 shall constitute a continuation thereof and have effect continuously from
4 the date of the original patent. . . .

5 35 U.S.C. § 252 (emphasis added).⁸

6 Paragraph (a) of § 307 specifies three events that can occur with a
7 reexamination certificate: (1) cancellation of a claim, (2) confirmation of a claim,
8 and (3) incorporation into the patent of any proposed amended or new claim. 35
9 U.S.C. § 307(a).

10 By its plain language, § 307(b) applies to only one of these events –
11 incorporation of an amended or new claim into the reexamined patent. Section
12 307(b) explicitly states that “[a]ny proposed amended or new claim ... will have the
13 same effect as that specified in section 252 of this title for reissued patents....” 35
14 U.S.C. § 307(b). Thus, it is only when there are amended or new claims in a
15 reexamined patent that § 252 may be considered, and its tests invoked.

16 Congress did not provide for application of 35 U.S.C. § 252 to claims that are
17 confirmed in a reexamination certificate. Nor does the cancellation of claims give
18 rise to application of § 252. Instead, under the law, the provisions of § 252
19 governing reissued patents apply to reexamined patents only to the extent of
20 amended or new claims. 35 U.S.C. § 307(b).

21 The Accused Infringers ignore the statutory provisions of § 307(b) – the
22 prerequisites to referring to § 252 – and jump straight into a challenge under the
23 claim continuity provisions for reissue patents under § 252. This they cannot do.

24
25 ⁸35 U.S.C. § 252 contains a second paragraph not quoted above, that addresses
26 intervening rights. Though some of the Accused Infringers’ amended affirmative defenses
27 made reference to intervening rights, it would appear that they have abandoned this aspect
28 of their defense. The Accused Infringers’ proposed motion makes no mention of
 intervening rights under the second paragraph of § 252 and is limited to asserting
 elimination of claim continuity under the first paragraph of § 252.

1 There has been no amendment in the reexamination to Claims 1, 3, 5, 6, 7, 8, 9, and
2 10 – the words of these claims remain unaltered from the original patent. Because
3 these claims were not amended, there is no statutory basis under § 307(b) for
4 application of § 252. Period.

5
6 **3. *The Federal Circuit has never applied the provisions of 35***
7 ***U.S.C. § 252 to a reexamined patent where there had been no***
8 ***change in the actual language of the claims during***
reexamination.

9 In every instance where the Federal Circuit has applied the provisions of § 252
10 to reexamined patent claims, there has been a change in the actual language of the
11 claims during reexamination, i.e., there have been amendments to the claims. *See,*
12 *e.g., Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1304-05
13 (Fed. Cir. 2008) (amendments to language of claim 1 during reexamination involved
14 deletion of words and insertion of new words); *Neupak, Inc. v. Ideal Mfg. & Sales*
15 *Corp.*, 41 Fed. Appx. 435, 442, 2002 WL 1363568, at *6 (Fed. Cir. 2002)
16 (amendments to language of claim 7 during reexamination involved adding the word
17 “removable” to make the phrase “a removable connection”); *Laitram Corp. v. NEC*
18 *Corp.*, 163 F.3d 1342, 1344-46 (Fed. Cir. 1998) (amendments to language of claims
19 1 and 2 during reexamination involved deletion of words and insertion of new
20 words); *Bloom Eng’g Co. v. North Am. Mfg. Co.*, 129 F.3d 1247, 1248-50 (Fed. Cir.
21 1997) (amendments to language of claims 2 and 13 involved deletion of words and
22 insertion of new words); *Fortel Corp. v. Phone-Mate, Inc.*, 825 F.2d 1577, 1579-81
23 (Fed. Cir. 1987) (amendments to language of claim 8 involved deletion of words and
24 insertion of new words).⁹

25 ⁹ Even MPEP § 2250, which deals exclusively with the making of amendments to a
26 patent in reexamination, makes clear that amended claims and new claims involve actual
27 changes to the words of the claims. Amendments to claims in no manner include the
28 situation where there is no revision to the text of the claim language itself, but only an
asserted change in claim construction. *See* MPEP § 2250 (amendments to claims involve
revisions to the text of the claims).

1 In *Kaufman*, the Federal Circuit recognized the need to confirm that
2 reexamined claims fall into the category of claims under § 307(b) that trigger
3 application of § 252. The Federal Circuit reprinted the text of § 307, emphasizing
4 the language from both paragraphs which indicate that the provisions of § 252 only
5 apply to amended and new claims. *Kaufman Co. v. Lantech, Inc.*, 807 F.2d 970,
6 975-76 (Fed. Cir. 1986). Every one of the claims of the reexamined patent at issue in
7 *Kaufman* were amended, i.e., the text of the claims was changed during
8 reexamination. Before jumping into an analysis of § 252, the Federal Circuit first
9 confirmed that the reexamined claims were in the category of claims which trigger
10 application of § 252:

11
12 Because all of the claims of the reexamined '920 patent are now, in the
13 language of § 307(b), in the category of a "proposed amended or new
14 claim determined to be patentable and incorporated following a
15 reexamination proceeding" those claims "have the same effect as that
specified in § 252 of this title for reissued patents...." We therefore
examine § 252 and related cases.

16 *Kaufman*, 807 F.2d at 976.

17 Never has the Federal Circuit found that § 252 can be triggered in the absence
18 of an amended or new claim in reexamination.¹⁰ The *Univ. of Virginia* court
19 acknowledges this fact, but Accused Infringers refuse to so acknowledge in their
20 briefing.

21 **4. The "change in scope" test under 35 U.S.C. § 252 cannot be**
22 **used to create an "amendment in effect" where there has been**
23 **no actual amendment to the claims.**

24
25 ¹⁰ *Elkay*, upon which Accused Infringers rely, does not address the "amended or new
26 claim" language of § 307(b). *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed.
27 Cir. 1999). *Elkay* merely holds that both amendments and patentee arguments during
28 prosecution are relevant when evaluating claim construction. *Id.* However, claim
construction for purposes of § 252 is not triggered unless an "amended or new claim" is
incorporated into a reexamined patent.

1 The Accused Infringers’ misreading of case law leads them to argue that the
2 relevant legal question for applying § 252 is not whether there has been a change in
3 the *actual words of a claim*, but rather whether there has been a change to the *scope*
4 *of a claim*. See Joint Motion, Attachment A-1 at 8:24-10:11. This puts the proverbial
5 cart before the horse. It is only when a patent holder changes the language of its
6 claim through an amendment in reissue or reexamination that there is then triggered
7 consideration of whether that change in claim language created a change in the scope
8 of the claim under § 252.

9 Section 252 was intended to ameliorate the harsh effect of a patent holder’s
10 surrender of its patent under the reissue statutes, i.e., once a reissue patent issues, the
11 original patent is treated as though it never existed. *Seattle Box Co. v. Industrial*
12 *Crating & Packing, Inc.*, 731 F.2d 818, 827 (Fed. Cir. 1984). The first paragraph
13 of § 252, which is quoted in Argument II.B.2 above, deals with the continuity of
14 claims as between the original patent and a reissue patent or, as applied under §
15 307(b), a reexamined patent. *Seattle Box*, 731 F.2d at 827-28. The second paragraph
16 of § 252, not quoted above, limits the scope of a reissue patent or, as applied under §
17 307(b), a reexamined patent so as to protect intervening rights. *BicLeisure Prods.,*
18 *Inc. v. Windsurfing Int’l, Inc.*, 1 F.3d 1214, 1220-21 (Fed. Cir. 1993).

19 When the reissue/reexamined claims are identical to their original
20 counterparts, there is no elimination of claim continuity under the first paragraph of
21 § 252 and no grant of intervening rights under the second paragraph of § 252. *See*
22 *Bloom Eng’g*, 129 F.3d at 1250 (“Applying § 252, when the reexamined or reissued
23 claims are identical to those of the original patent, they shall ‘have effect
24 continuously from the date of the original patent.’”); *In re Mark Indus.*, 751 F.2d
25 1219, 1225 (Fed.Cir. 1984) (Federal Circuit reversed district court denial of
26 retroactive effect to reissued claims where three claims of reissue patent and were
27 identical their counterparts in original patent); *Seattle Box*, 731 F.2d at 830 (“If valid
28 claims in the original patent appear unaltered in the reissue patent, the doctrine of

1 intervening rights affords no protection to the alleged infringer.”); *Philip Morris, Inc.*
2 *v. Brown & Williamson Tobacco Corp.*, 641 F.Supp. 1438, 1485-86 (M.D.Ga. 1986)
3 (holding that intervening rights did not apply to shield accused process from liability
4 where reissued claims were identical to their corresponding claims in original
5 patent).

6 It is only when claim language is altered through reissue or reexamination that
7 a court must determine under the first paragraph of § 252 whether the
8 reissued/reexamined claims are “substantially identical” to their original counterparts
9 so as to address elimination of claim continuity with respect to the amended or new
10 claims. The analysis requires determination of whether “substantive changes” were
11 made to the original claims. *Predicate Logic*, 544 F.3d at 1304-05.

12 First, if there have been changes to the words of the claim, courts have
13 clarified that a substantive change does not arise from the mere fact that a
14 reissued/reexamined claim is not identical to its original counterpart. *Kaufman*, 807
15 F.2d at 978 (rejecting argument that any change made to claims during
16 reexamination should be deemed “substantive”). In determining whether substantive
17 changes were made, the test is not merely whether different words were used, but
18 rather whether the scope of the subject claim was substantively changed during
19 reissue/reexamination. *Neupak*, 41 Fed. Appx. at 442, 2002 WL 1363568, at *6
20 (citing *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1346 (Fed. Cir. 1998)); *Bloom*
21 *Eng’g*, 129 F.3d at 1249-50. This same test for “substantive change” applies when
22 determining whether to grant intervening rights under the second paragraph of § 252.
23 *Kaufman*, 807 F.2d at 977-78; *Seattle Box*, 731 F.2d at 829-30.

24 The Accused Infringers misapply the test for “substantive change” to suggest
25 to this Court that there is no need for an amendment to the claims to invoke the harsh
26 effect of denying claim continuity under § 252. There is no legal support for this
27 approach.

28 The Accused Infringers use the “change in scope” test to find an alleged

1 “amendment in effect” in order to avoid the absence of any actual amendment to the
2 claims. This is an inaccurate representation of the law. The test that the Federal
3 Circuit uses under § 252 – courts must evaluate the change in scope of the claim, not
4 the use of different words – does not apply in cases such as this one, where the
5 claims of the reissue/reexamined patent are identical to their counterparts in the
6 original patent. *See supra Seattle Box*, 731 F.2d at 830; *Bloom Eng’g*, 129 F.3d at
7 1250; *In re Mark Indus.*, 751 F.2d at 1225.

8
9 **5. *Accused Infringers have not shown that they relied to their***
10 ***detriment on a claim construction of the term “laminated” that***
11 ***was purportedly changed during reexamination.***

12 “35 U.S.C. § 252 protects third persons who rely on the scope of the claim as
13 originally granted, as against subsequent changes in scope by reissue.” *Slimfold Mfg.*
14 *Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1117 (Fed. Cir. 1987). The alleged
15 infringer in *Slimfold* argued, like the Accused Infringers do here, that the patent
16 holder could not recover for infringement prior to the reissue date under the
17 provisions of paragraph 1 of § 252. *Slimfold*, 810 F.2d at 1114. The court in *Slimfold*
18 rejected this argument. The court noted that the amendment to claims 1 through 3,
19 which consisted of changes to the actual text of the claim language, were made in
20 response to the Examiner’s rejection that the claims were vague and indefinite under
21 35 U.S.C. § 112, and that the patent holder so conceded when it changed the claims.
22 However, the court in *Slimfold* found no substantial change to the claims under these
23 facts, and further that the accused infringer “did not demonstrate that it relied to its
24 detriment on any aspect of the original claims that was changed by reissue.”
25 *Slimfold*, 810 F.2d at 1116-17. The court noted that “this long-standing judicial
26 interpretation of 35 U.S.C. § 252 ... reflects the continuing efforts of courts to reach
27 a just result.” *Id.* at 1117.

28 Accused Infringers have not even suggested that they relied to their detriment
upon a claim construction of the term “laminated” that was allegedly changed in

1 reexamination. Under Accused Infringers' argument, it is the Examiner's claim
2 construction adopted in the second non-final office action that governs the term
3 "laminated" from the date of patent issuance to reexamination certificate. According
4 to Accused Infringers, the definition of "laminated" changed with cancellation to the
5 District of New Jersey's claim construction, and it is this construction that applies
6 post-certificate.¹¹

7 There has been no showing here that the Accused Infringers, during the 20-
8 year life of the '184 patent, relied upon a claim construction of the term "laminated"
9 that was not adopted until nearly 1 ½ years after the '184 patent expired, by the
10 Examiner in the second non-final office action dated August 21, 2009. Throughout
11 the entire life of the '184 patent there has been only one judicial interpretation of the
12 term "laminated" upon which a third party could have relied -- the District of New
13 Jersey's claim construction, which is the precise claim construction that the Accused
14 Infringers argue will apply to the disputed term given the asserted change in claim
15 construction. Because Accused Infringers cannot show detrimental reliance on a
16 claim construction that was not adopted until after patent expiration, a just result
17 would require this Court to deny Accused Infringers the protections of § 252.

18
19
20 **III. IT IS NOT WITHIN THE PROVINCE OF THIS COURT TO**
21 **REWRITE U.S. PATENT LAWS TO CREATE A NEW REMEDY FOR**
22 **ACCUSED INFRINGERS.**

23 "A statute is by definition the law to be followed-not disregarded, effectively
24 repealed, rewritten, or overruled (unless unconstitutional)-in the federal courts. This
25 court has noted not only the truism that courts are not at liberty to repeal a statute but
26 also the impropriety of judicial legislation diminishing a statute's effect." *In re Mark*

27 ¹¹ To the extent that Accused Infringers assert "amendment in effect," amendments
28 do not become effective in a patent until issuance and publication of the reexamination
certificate. MPEP § 2250.

1 *Industries*, 751 F.2d 1219, 1224 (Fed.Cir. 1984).

2 In § 307(b), Congress specifically provided for application of § 252 in the
3 event of amended and new claims only. Congress made no such provision in the
4 context of cancellation of claims, nor in the context of claims that were not amended
5 in reexamination. This Court should decline to act where Congress has not done so.

6 The Federal Circuit has previously refused to apply intervening rights under §
7 252 in the absence of Congressional legislation. In *Ricoh*, an accused infringer
8 asserted that the patent holder had impermissibly circumvented the mandates of the
9 reissue statute, specifically, the intervening rights provisions of 35 U.S.C. § 252, by
10 filing for a continuation application instead of a reissue proceeding. *Ricoh Co. v.*
11 *Nashua Corp.*, 185 F.3d 884, 1999 WL 88969, at *2-3 (Fed. Cir. Feb. 18, 1999).
12 The alleged infringer asked the district court to grant intervening rights under § 252
13 in the context of the continuation application, but the district court refused. In
14 upholding the district court, the Federal Circuit noted that Congress had specifically
15 provided for intervening rights in § 252 of the reissue statute, but not in the context
16 of continuation applications. The Federal Circuit found that to limit rights under a
17 continuation application “is a matter of policy for Congress, not for us.” *Ricoh*, 185
18 F.3d 884, 1999 WL 88969, at *3. The Federal Circuit concluded as follows:

19 Absent congressional indication that intervening rights are to be
20 applied in the context of continuation applications, we reject [alleged
21 infringer’s] argument that we should judicially adopt equitable
22 safeguards, in contravention of established precedent, when Congress
itself has declined to do so.

23 *Ricoh*, 185 F.3d 884, 1999 WL 88969, at *3.

24 Congress specifically provided for application of § 252 of the reissue statute to
25 reexamination proceedings, but limited that application to the context of amended
26 and new claims only. Congress did not make such provision in the context of
27 cancellation of claims, nor where there is no amendment to claims. In the absence of
28 congressional intent that cancellation of certain claims can trigger application of §

1 252 to other claims that have not been amended, the Court should decline the
2 Accused Infringers' invitation to rewrite § 307(b). A decision to deny retroactive
3 effect under § 252 with respect to claims that have not been amended in
4 reexamination is a matter of policy for Congress, not for the courts.

5 The Accused Infringer's arguments would also require modification of the
6 provisions governing amendments to expired patents. 37 CFR 1.530(j) would have
7 to be repealed or re-written, because it currently states that no amendments may be
8 proposed for entry in an expired patent, and no amendments, other than cancellation
9 of claims, will be incorporated into a reexamination certification for an expired
10 patent. Likewise, MPEP § 2250 with its explicit prohibition on amended claims in
11 expired patents would also have to be disregarded.

12 The Accused Infringers' request to this Court is a request to rewrite U.S.
13 patent law and should be denied.

14
15 **CONCLUSION**

16 The Court in the case at bar is being asked to make an exception to stay to
17 allow one side to file a dispositive motion, without the other side being allowed to
18 file any motions, conduct any discovery, and without any claim construction being
19 performed. Furthermore, the Court is being asked, by way of the proposed motion,
20 to rewrite U.S. patent laws in order to shield Accused Infringers from liability and
21 eliminate all enforceable rights under the '184 patent. The Court should decline
22 Accused Infringers' invitation to engage in such a broad ranging violations of
23 procedural and substantive U.S. patent law.

24 Wherefore, Sorensen respectfully requests that the Court to deny Accused
25 Infringers' leave to file the proposed meritless motion. If the Court grants the
26 request, however, lift of stay must apply evenly to both sides.

27 DATED this Friday, March 25, 2011
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JENS ERIK SORENSEN, as Trustee of
SORENSEN RESEARCH AND DEVELOPMENT
TRUST, Plaintiff

/s/ Melody A. Kramer

Melody A. Kramer, Esq.
Attorney for Plaintiff

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PROOF OF SERVICE

I, Melody A. Kramer, declare: I am and was at the time of this service working within in the County of San Diego, California. I am over the age of 18 year and not a party to the within action. My business address is the Kramer Law Office, Inc., 9930 Mesa Rim Road, Suite 1600, San Diego, California, 92121.

On Friday, March 25, 2011, I served the following documents:

SORENSEN’S OPPOSITION TO JOINT MOTION FOR LEAVE TO FILE SUMMARY JUDGMENT OF NO LIABILITY PRIOR TO THE ISSUANCE OF THE REEXAMINATION CERTIFICATE

REQUEST FOR JUDICIAL NOTICE IN SUPPORT OF SORENSEN’S OPPOSITION TO JOINT MOTION FOR LEAVE TO FILE SUMMARY JUDGMENT OF NO LIABILITY PRIOR TO THE ISSUANCE OF THE REEXAMINATION CERTIFICATE

Service was effectuated by electronically filing the documents via the CM/ECF system for the United States District Court for the Southern District of California in the above-identified case, and relying upon the ECF emailing to distribute service to all parties.

I declare that the foregoing is true and correct, and that this declaration was executed on Friday, March 25, 2011, in San Diego, California.

/s/ Melody A. Kramer

Melody A. Kramer