UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 17-1391

MICHAEL E. KAHR,

Plaintiff-Appellant,

v.

MICHAEL E. COLE AND
IRON WORKS CONSTRUCTION COMPANY, LLC

Defendants-Appellees.

Appeal from the United States District court, Eastern District of Wisconsin, Case No. 1:13-CV-1005-WCG, Judge William C. Griesbach

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BRIEF FOR DEFENDANTS-APPELLEES MICHAEL E. COLE AND IRON WORKS CONSTRUCTION COMPANY, LLC

April 17, 2017

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Michael M. Kahr **v.** Michael E. Cole

Case No. 17-1391

CERTIFICATE OF INTEREST

Counsel for the:
☐ (petitioner) ☐ (appellant) ☐ (respondent) ☒ (appellee) ☐ (amicus) ☐ (name of party)

Michael E. Cole and Iron Works Construction Company LLC

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10 % or more of stock in the party
Michael E. Cole	None	None
Iron Works Construction Co. LLC	None	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

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4/17/2017
Date

/s/Paul J. Robbennolt
Signature of counsel

Please Note: All questions must be answered

Paul J. Robbennolt
Printed name of counsel

cc:

Reset Fields

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STATEMENT OF RELATED CASES

Defendants and their counsel are unaware of any other appeals in or from the same civil action that have previously been before this or any appellate court. Likewise, Defendants and their counsel are unaware of any other cases pending in this or any other court that will directly affect or be directly affected by a decision in this case.

INTRODUCTION

The docks that are the subject of U.S. Patent No. 8,348,554 ("the '554 Patent") are not revolutionary. The prosecution history of the '554 Patent and the testimony of Appellant and his expert establish that the sole basis for patentability—the only feature that distinguishes the patented dock from the prior art—is the specific connection mechanism of the dock, set forth in the claim limitation requiring that "each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." In the patented dock, the dock segments are held together, and the dock is attached to the pilings, by fasteners that are inserted into the claimed apertures that are required to be placed in specific locations on the dock structure. Because of the particular placement of the apertures, the patented dock is capable of using a single fastener to perform both functions: holding the dock segments together and attaching the dock to the pilings.

It is undisputed that the Appellees' accused docks do not use the connection mechanism of the '554 Patent. Appellant's Brief at 27 (the accused dock "has most of the features claimed in the '554 patent, but it uses a different connection mechanism"). Specifically, as the district court held when it granted summary judgment of no literal infringement, the accused docks do not meet the claim limitation requiring that "each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." Because there is no aperture in the side wall, the accused docks cannot use a single fastener to connect the dock segments and attach the dock to the pilings. Nevertheless, the Appellant alleged that connection mechanism of the accused docks was equivalent to the "aperture" limitation of the '554 Patent claims,

Instead of the connection mechanism of the '554 Patent, the accused docks use a common connection mechanism that has long been used in construction, including dock construction. In this connection mechanism, called a "double-ear" connection by Appellant's expert, David Wentland, "overlapping members" are welded onto both ends of the dock segments. One end of the first dock segment has two "ears" welded onto it, while the nearer end of the next dock segment has a single plate welded onto it. The single plate of the second dock segment is placed between the two "ears" of the first dock segment, and a bolt is inserted through all three members to connect the two dock segments together. In the accused docks,

the bold does not, and cannot, play any role in attaching the dock to the pilings; a second fastener inserted through the cylindrical sleeve and into the piling attaches the dock to the piling. This double-ear connection is standard hardware that has been used in dock construction for years.

The district court correctly granted judgment of noninfringement under the doctrine of equivalents as a matter of law, on the grounds that the Appellant's claimed scope of equivalents ensnared the prior art. In so doing, the district court followed the procedure approved by this Court: it constructed hypothetical claims based on the asserted claims, but broad enough in scope to cover the accused docks literally, and then compared the asserted prior art to the hypothetical claims to determine whether the hypothetical claims were anticipated or rendered obvious by the prior art. The district court considered every limitation of the hypothetical claims, and made detailed to findings to support its conclusion that the hypothetical claims were obvious in light of the Berquist reference (U.S. Patent No. 3,964,221) in combination with either the Dock Manual by Max Burns or the Appellant's own admissions. In the proceedings below, the Appellant did not dispute the hypothetical claims adopted by the district court; did not dispute any of the evidence cited by the Appellee; did not identify a single claim limitation that was not disclosed in the cited prior art; and did not dispute that a person of ordinary

skill in the art would have reasons to combine the teachings of the cited prior art references.

The Appellant's belated efforts to criticize the district court's order are unavailing. Instead of citing specific errors in the district court's analysis or conclusions, the Appellant relies on general and conclusory statements that the district court presented "no articulated reason as to why any prior art references were anticipatory or would be combined in such a way as to render the claimed subject matter obvious." Appellant's Brief at 24. These allegations are patent incorrect. The district court's analysis and conclusions are detailed and thorough. The district court explicitly found—with citations—that the Berquist reference disclosed every limitation of the hypothetical claims except the double-ear connection mechanism. The district court further found that the double-ear connection mechanism was well-known in the prior art, citing both the Burns reference and the testimony of Appellant's own expert. Finally, the district court determined that the references disclose the use of known elements in traditional ways to yield predictable results; therefore, a person of ordinary skill in the art would have reason to combine the teachings of the references.

The Appellant has not shown any error in the district court's analysis and conclusions, either below or in his brief to this Court. Accordingly, Appellees respectfully request that the Court affirm the district court's judgment.

STATEMENT OF THE ISSUES

1. Whether the district court correctly granted summary judgment that the accused docks do not literally infringe the claims of the ‘554 Patent, because the accused docks do not meet the limitation that requires that “each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener.”

2. Whether the district court correctly granted judgment of non-infringement under the doctrine of equivalents as a matter of law pursuant to the ensnarement defense, because the hypothetical claim broad enough in scope to cover the accused products literally would not be patentable over the prior art.

3. Whether judgment of non-infringement under the doctrine of equivalents as a matter of law may be independently affirmed, because prosecution history estoppel bars the Appellant from asserting equivalents to the “aperture” limitation.

STATEMENT OF THE CASE

Appellant commenced this action on September 6, 2013. Appx58. He alleged that Appellee's accused docks infringe claims 1-4, 6, and 7 of the '554 Patent. Appx658. The '554 patent describes and claims a pan-like dock structure attachable to vertical pilings. Appx52-57.

On December 29, 2015, the district court issued a Decision and Order on the parties' cross motions for summary judgment. Appx242-259. The district court denied Appellant's motion for summary judgment of infringement, and granted Appellee's motion for summary judgment of no literal infringement because the accused docks do not satisfy the "aperture" limitation of every claim. Appx250. With respect to infringement under the doctrine of equivalents, the district court held that the Appellant's claim is not barred by prosecution history estoppel, Appx258, and indicated that the question of infringement under the doctrine was for the jury to decide. Appx258-59.

The case was tried before a jury between August 8 and August 10, 2016. On August 10, 2016, the jury returned a verdict of infringement under the doctrine of equivalents. Appx517.

Appellees moved for judgment as a matter of law pursuant to Rule 50(a) on August 10, 2016, Appx2, and moved for judgment of noninfringement as a matter of law pursuant to the ensnarement defense on September 9, 2016. Appx521. On

November 18, 2016, the district court granted Appellees' motion for judgment of noninfringement as a matter of law pursuant to the ensnarement defense. Appx2-20. The district court denied as moot the Appellees' Rule 50(a) motion. Appx20. Judgment was entered on November 18, 2016, Appx1, and the Appellant filed his notice of appeal on December 16, 2016.

The Appellant now appeals both (1) the district court's summary judgment Decision and Order that the accused docks do not literally infringe the claims of the '554 patent; and (2) the district court's judgment as a matter of law Decision and Order of non-infringement under the doctrine of equivalents. Because the Appellant has not met his burden of showing that the district court erred, Appellees respectfully request that this Court affirm the district court orders and judgment in their entirety.

STATEMENT OF THE FACTS

I. THE PATENTED TECHNOLOGY

A. THE '554 PATENT

The '554 patent generally describes and claims a dock structures, docks, and the method of assembling those structures. Appx52-57. Appellant is the sole inventor. Appx52. The '554 patent was filed on September 27, 2010, and issued on January 8, 2013. *Id.* At trial, the Appellant alleged that Appellees infringed claims 1-4, 6, and 7 of the '554 Patent. Appx658.

Claim 1 lists the basic elements of the claimed invention and is representative of the asserted claims:

> 1. A dock structure for use with vertical pilings, the structure comprising:
>
> a first end and a second end, a pair of opposing side walls, a pair of opposing end walls, one end wall disposed at each end of the structure and a floor;
>
> wherein the side walls, the end walls and the floor form a cavity;
>
> a pair of cylindrical rims disposed at the first end of the structure, each rim forming a vertically-disposed cylindrical opening in the floor and each opening being functionally adapted to receive a piling through it; and
>
> a pair of overlapping members formed at the second end of the structure;
>
> wherein each overlapping member has an aperture formed in it for receiving a fastener; and

> wherein each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener.

Appx57. The basic structural elements of claim 1 are: 1) a dock segment with side walls, end walls, and a flor that together form a cavity that may be filled with concrete; 2) two cylindrical rims at one end of the structure for receiving a piling; 3) two "overlapping members" at the opposite end of the structure; and 4) a connection mechanism that calls for "apertures" for receiving fasteners in "each overlapping member" and "each cylindrical rim and that portion of the side wall adjacent the rim." *Id.*

Claim 4 is another independent claim that recites essentially the same structure elements as claim 1. Appx57. Where claim 1 is directed to a "dock structure," claim 4 is directed to a "dock assembly" with at least one "dock element;" the dock element has the same limitations as the dock structure recited in claim 1. *Id.* Claims 2 and 6 are dependent claims that depend from claims 1 and 4, respectively, and add as an element "at least one reinforcement member extending between the opposing side walls." *Id.* Claims 3 and 7 are also dependent claims that depend from claims 1 and 4, respectively, and add as an element a requirement that the "cavity" be filled with concrete. *Id.*

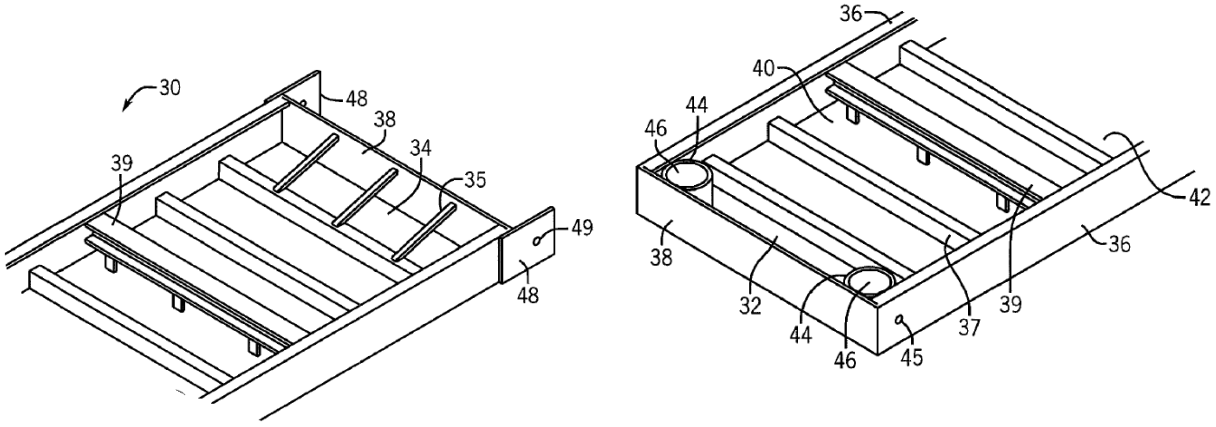
B. APART FROM THE CLAIMED CONNECTION MECHANISM, THE CLAIMED DOCKS WERE WELL-KNOWN IN THE ART

As Appellant and his expert readily admit, nearly every element of the asserted claims of the '554 patent was well-known in the art when the application for the '554 Patent was filed. *See* Appx355-356 (Appellant's trial testimony); Appx398-399 (trial testimony of Appellant's expert, David Wentland); Appx661-667, 671-672, 677 (Mr. Wentland's deposition testimony). With one exception, each of the structural elements of the asserted claims of the '554 Patent was well-known in the prior art before the Appellant's invention. For example, dock segments with side walls, end walls, and a floor that formed a cavity to be filled with concrete were known. Appx398 (Wentland testimony). Additionally, dock segments with two cylindrical rims for receiving pilings were known. Appx335 (Kahr testimony). Dock segments with overlapping members were also known in the art. Appx399 (Wentland testimony). The elements added in the dependent claims were also undisputedly known in the prior art before the Plaintiff's invention: prior art docks used concrete, Appx398 (Wentland testimony), and the use of steel reinforcing members for construction, and in particular in concrete, is well-known. Appx725-731 (in rejecting claims, the examiner states that the "provision of at least one reinforcement member would have been an obvious matter of design choice, since it is well-known to reinforce construction type

members by providing additional framework such as bracing, studs, beams or ribs").

Thus, according to the Appellant's own testimony, the only novel feature of his patented dock was the connection mechanism used to connect the dock segments together and attach the dock to the piles—the claimed "apertures" in the overlapping members, cylindrical rims, and portions of the sidewall adjacent the cylindrical rims.[1] Appx355-356 (Kahr testimony).

The Appellant's unique connection mechanism operates as shown in the portions of Figure 5 of the '554 patent, inserted and described below.



[1] During trial, the Appellant attempted to identify other features that were new, but could not successfully do so. Specifically, the Appellant claimed that cross-bracing was new, but admitted that it was not in the patent claims (Appx355); asserted that prefabrication was new, but again admitted that it does not appear in the claims (Appx356); stated that using the sleeves to drill holes was new, but admitted that it is not in the claims (Appx356); and finally asserted that he had not seen a pan-shaped structure for concrete before, Appx355-356, but later admitted that he himself had built such structures in the past, before his '554 patent (Appx356).

Appx55. As claimed in the '554 patent, one end of each dock segment has "overlapping members" (48) that extend from side walls (36) at the second end (34). Appx55-56. As the name suggests, these overlapping members "overlap" the side walls of the first end (32) of an adjacent dock segment, such that the two dock sections may be coupled together. *Id.* To secure the dock in place, vertical piles extend through cylindrical rims (44) positioned in the corners of the second end of the adjacent dock segment. *Id.* The claims of the '554 patent require a hole ("aperture") (45) in each of the cylindrical rims and adjacent side walls, and a hole (49) in each overlapping member. *Id.* When the two dock segments are aligned, the hole in each overlapping member aligns with the hole in the corresponding cylindrical rim/sidewall of the adjacent dock segment. *Id.* A fastener can be inserted in the aligned holes (45, 49) to connect the two dock segments together, and simultaneously couple the dock segments to the vertical piles. *Id.* "With the apertures 45, 49 aligned in collinear fashion, the fastener 60 can be affixed as shown in FIG. 6." *Id.* Figure 6 of the '554 patent, provided below, illustrates this unique single-fastener connection mechanism.

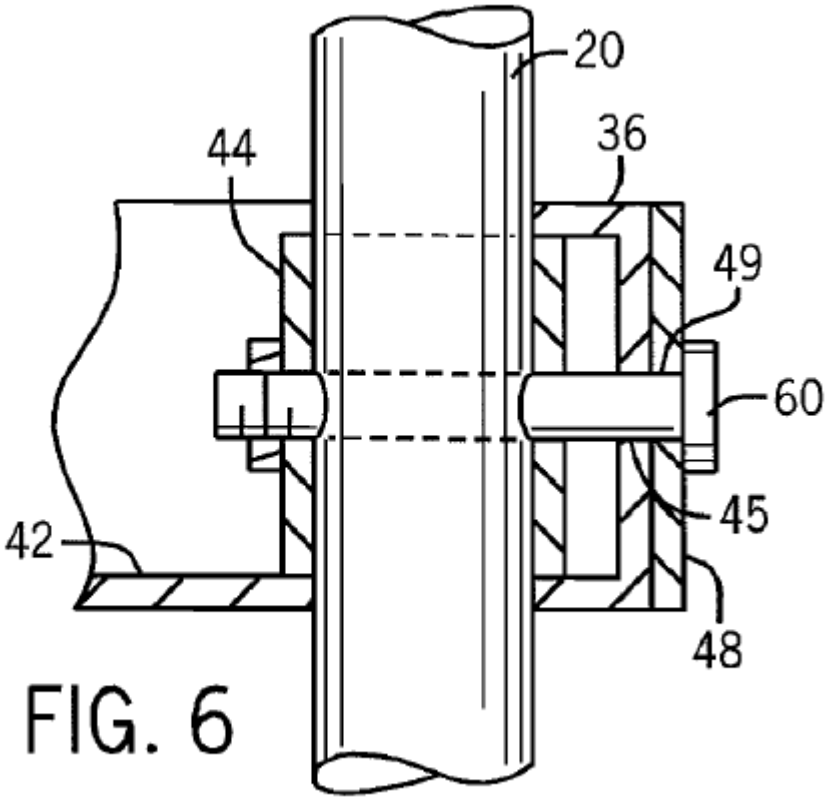


FIG. 6

Appx55.

C. ALLOWANCE OF THE ASSERTED CLAIMS WAS BASED ON THE CLAIMED CONNECTION MECHANISM

The application for the '554 Patent included the two independent claims that became asserted claims 1 and 4.[2] Appx715-717. As filed, however, those claims **did not** require the "apertures" that form the unique connection mechanism of the '554 patent. *Id.* Instead, the aperture limitation was set forth in original dependent claims 2 and 6, which recited the additional element "wherein each overlapping

[2] Asserted claim 4 was originally claim 5 in the application, but was renumbered due to claim cancellations.

member has an aperture formed in it for receiving a fastener and wherein each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." *Id.*

In the first Office Action, the Patent Examiner rejected the independent claims under 35 U.S.C. § 102 as anticipated by a prior art patent to Berquist. Appx705-706. The examiner found **every** element of the independent claims taught by Berquist. *Id.* The examiner also rejected the rest of the now-asserted claims as either anticipated or obvious: original claims 3 and 8 (now asserted claims 2 and 6), which add reinforcement members, because reinforcement members would be "an obvious matter of design choice … well –known" in the art, and original claims 4 and 9 (now asserted claims 3 and 7), which add concrete, because a second prior art patent to Jennings discloses dock structures filled with concrete, and it would have been obvious to combine the teachings of Berquist and Jennings. *Id.* The examiner did not reject original claims 2 and 6, which recited only the additional limitation requiring the "apertures" that make up the unique connection mechanism of the '554 Patent. *Id.*

Appellant did not dispute the Examiner's position that the now-asserted claims were unpatentable without the aperture element. Appx725-731. Instead, he amended the independent claims to incorporate the "apertures"—i.e., the Appellant's unique connection mechanism—from the allowable dependent claims,

after which the claims were allowed. *Id.* Thus, the aperture limitation is the basis for patentability of all of the asserted claims.

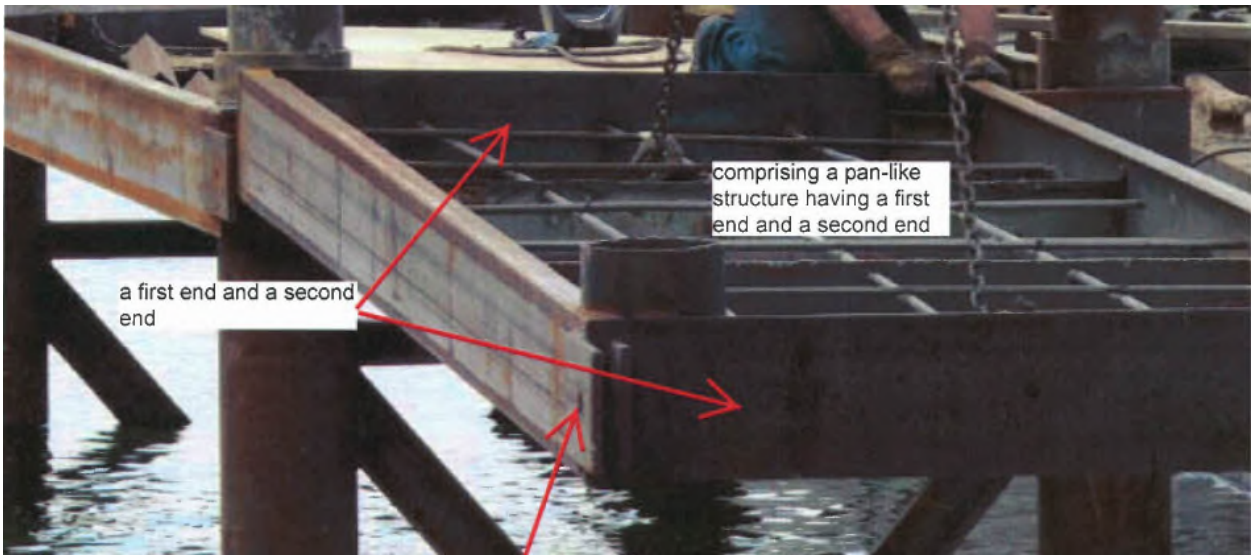
II. THE APPELLEES' ACCUSED DOCKS

A. THE ACCUSED DOCKS USE AN ENTIRELY DIFFERENT CONNECTION MECHANISM

As Appellant acknowledges, the Appellees' accused docks "use[] a different connection mechanism" than that claimed in the '554 Patent. Appellant's Brief at 27. Specifically, the accused docks do not satisfy the requirement that "each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." *See* Appx248-50.

The accused docks have an open box frame with collars at one end to receive pilings that are driven into the lake bottom. Appx137-144. The collars extend above the top of the open box frame to accommodate a pin that passes through the collars and the piling to attach the dock to the pilings. *Id.* This pin, however, has nothing to do with connecting the dock segments together. In the accused docks, the dock segments are connected together using an entirely different connection mechanism, one that Appellant's expert Mr. Wentland refers to as a "double-ear connection." Appx399 at p. 337.

In the "double-ear connection," two "ears," or metal plates, are welded to one end of a dock segment, as shown below:



A single plate, or tab, is welded to the adjacent dock segment. The "ears" on the first dock segment are spaced apart and are therefore able to receive between them the single tab from the adjoining dock section. *Id.* All three plates have holes in them. In operation, the tab on the second dock segment is placed between the "ears" on the first dock segment, and a bolt is inserted through all three holes to connect the dock segments, as shown below:



The hinged connection between dock sections in the accused docks is **isolated from** the dock's attachment to vertical pilings. Specifically, a pin is inserted through a hole in each cylindrical collar to attach the dock to a piling, but that pin does not also attach to any portion of an adjacent dock section. Moreover, as shown above, the hole in the collar does not align with, or lie adjacent to, **any other hole**.

B. THE CONNECTION MECHANISM OF THE ACCUSED DOCKS WAS WELL-KNOWN IN THE PRIOR ART BEFORE THE PLAINTIFF'S INVENTION

The "double-ear connection" used in the accused docks is a common connection mechanism that was well-known in the art, including in dock

construction, long before the invention of the '554 patent. The Appellant's expert witness readily admitted this fact:

> Q: Prior to seeing Mr. Kahr's docks, had you seen docks that incorporated a connection mechanism like that in the accused docks, or two plates that were either bolted or pinned together?
>
> A: Other than the accused docks, have I seen this anywhere else, is what you're asking me? This sort of connection?
>
> Q: Yes, that's right.
>
> A: Absolutely.
>
> Q: Okay. Have you seen it for years?
>
> A: Yes.

Appx665. *See also* Appx666, 677 (same); Appx 399 (same). Mr. Wentland's testimony is confirmed by multiple prior art references, which show this precise double-ear connection mechanism used on docks well before the filing date of the '554 patent.

For example, Patent No. 5,713,296 to Gervasi, filed in 1996, was cited during prosecution of the '554 patent. Appx733-42. Gervasi describes a concrete floating dock, and shows and describes the double-ear connection as a "swivel connection assembly" as shown below:

U.S. Patent No. 5,713,296 to Gervasi

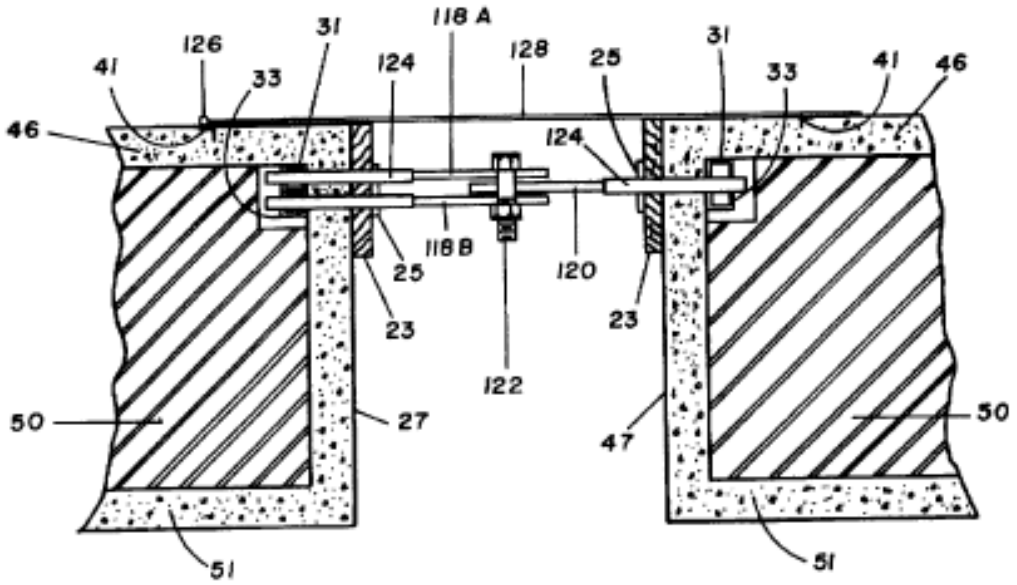
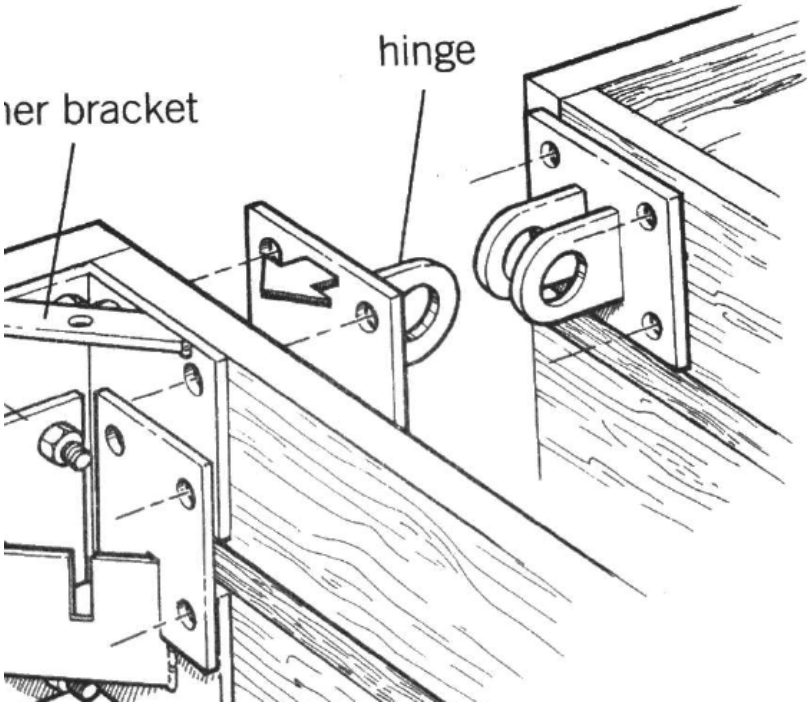


FIG. 10

Appx. 738. "[A] swivel connection assembly 26 , is illustrated in FIGS. 9, 10. Steel plates 118A, 118B comprised of substantial steel plating are welded in a spaced relationship whereby sandwiching steel plate 120. A substantial bolt and nut 122 provides the pivotal point." Appx741 at 5:18-24.

Additionally, *The Dock Manual* by Burns, published in 1999, shows and describes the double-ear connection mechanism, as shown below:

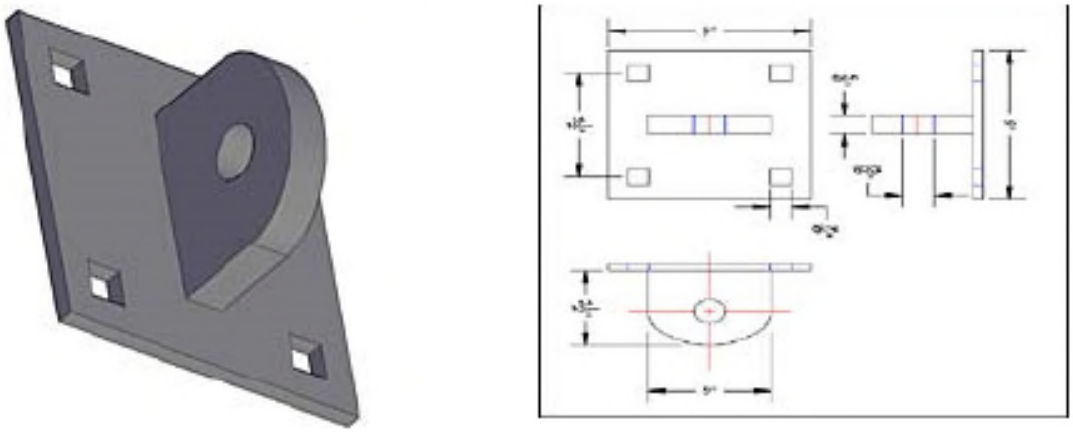
Burns, Max, *The Dock Manual*, Canada, Storey Books, 1999 ("the Dock Manual")



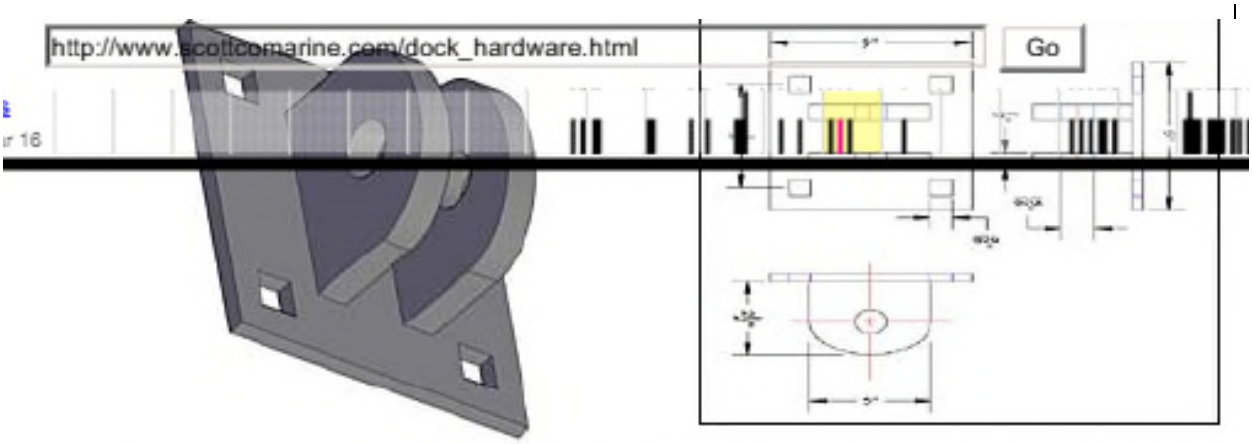
Appx692. Additionally, an internet advertisement from 2009 (Appx 744-754) illustrates a double-ear connector for connecting dock sections for sale, as shown below.

Scottco Marine website, April 13, 2009, Internet Archive

Single "T" Male



(WH-SM) The Single "T" Male has one 5/8" tab with a hole for a 3/4" Connector Pin **(B-PIN)** and is used with a Single "T" Female **(WH-SF)** or Outside Corner Female **(WH-OCF)**. The male and female singles can both be used to make finger attachments by bolting them to the side of a dock. They can also be used to make ramps by bolting them to seawalls.



(WH-SF) The Single "T" Female has two 1/2" tabs with holes for a 3/4" Connector Pin **(B-PIN)** and is used with a Single "T" Male **(WH-SM)** or Outside Corner Male **(WH-OCM)**. The male and female singles can both be used to make finger attachments by bolting them to the side of a dock. They can also be used to make ramps by bolting them to seawalls.

Appx749-50.

III. PROCEDURAL BACKGROUND

A. THE DISTRICT COURT GRANTED SUMMARY JUDGMENT OF NO LITERAL INFRINGEMENT BECAUSE THE ACCUSED DOCKS DO NOT SATISFY THE "APERTURE" LIMITATION

After claim construction, the parties filed cross motions for summary judgment. Appx242. The district court held that the accused docks do not literally infringe the asserted claims, because they do not satisfy the "aperture" limitation. Appx249-250 ("the accused dock does not have an aperture in the portion of the sidewall adjacent to the cylindrical rims").

The district court additionally held that the Appellant's assertion of infringement under the doctrine of equivalents was not barred by prosecution history estoppel. Appx257-258. As described above, Appellant amended the independent claims of the '554 Patent during prosecution to include the limitation "wherein each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." *See* Appx725-731. By adding this limitation, Kahr narrowed the claims to require his unique connection mechanism, and thus disclaimed other mechanisms for coupling the dock segments to one another and to pilings. However, the district court held that the "rationale underlying the amendment was to distinguish dock segments which are locked together by the supporting posts and cannot be adjusted in height from dock segments that are joined using fasteners and can be adjusted in height." Appx257-

258. With this, the district court reserved the question of infringement under the doctrine of equivalents for the jury. Appx258-259.

B. TRIAL

After the district court's summary judgment order holding that the accused docks do not literally infringe the asserted claims of the '554 Patent, a jury trial was held on the issue of infringement under the doctrine of equivalents on August 8-10, 2016. The jury returned a verdict of infringement under the doctrine of equivalents, and further found willful infringement. Appx517-518. The court and the parties reserved the legal issue of ensnarement for resolution by the court after trial. Appx323.

C. THE DISTRICT COURT GRANTED JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS AS A MATTER OF LAW, BECAUSE THE ASSERTED EQUIVALENT ENSNARES THE PRIOR ART

After trial, as agreed by the parties and the district court, Appellees filed a motion for judgment of non-infringement under the doctrine of equivalents as a matter of law pursuant to the ensnarement defense. Appx523-49. In their motion, the Appellees proposed hypothetical claims that were based on the asserted claims, but were broad enough in scope to cover the accused docks literally. Appx542. The Appellant did not object to the Appellees' proposed hypothetical claims, nor did he propose his own hypothetical claims. Appx755-63.

The district court adopted they hypothetical claims proposed by the Appellees and analyzed the ensnarement issue by comparting the hypothetical claims to the prior art references cited by the Appellees—the Berquist reference, the Burns reference (the Dock Manual), and the Appellant's own admissions (through his testimony and that of his expert, Mr. Wentland). Appx9-20. The district court held that, although the Burns reference "in its entirety does disclose every limitation of the hypothetical claim," Appx19, it did not anticipate the hypothetical claims because the elements were not disclosed in connection with a single embodiment. Appx12-13; Appx19 (Burns "does not describe one dock that contains every element"). However, the district court held that the hypothetical claims would have been unpatentable as obvious in view of the prior art. Appx16-20. Specifically, the district court held that the combination of the Berquist reference and either the Burns reference or the Appellant's admissions render the hypothetical claims unpatentable as obvious. *Id.* In the course of its analysis, the district court made detailed findings, with citations, that the Berquist reference discloses every limitation of the hypothetical claims except those that describe the accused docks' connection mechanisms.[3] Appx16, Appx18. The district court found that the Burns reference disclosed the limitations that describe the

[3] The district court also found that the Burns reference disclosed each of these limitations. Appx16.

connection mechanism, Appx16-18, and that Appellant and his expert confirmed that the "double-ear" connection was well-known in the art before the '554 Patent. *Id.* Finally, the district court held that a person of ordinary skill in the art would have reason to combine the teachings of the prior art references:

> Although the Dock Manual does not describe one dock that contains every element, the book in its entirety does disclose every limitation of the hypothetical claim. Further, the book describes various methods of designing, building, and maintaining a dock. A builder can pick and choose any combination of features to create the structure. Defendants contend that every element discussed in the book in relation to the accused docks does what it has always done and yields predictable results. This is sufficient to meet Defendants' production burden. … Plaintiff did not discuss the prior art in relation to the hypothetical claim or challenge Defendants' assertion that the predictable consequences of combining the features in the Dock Manual—or the aggregate of the elements of the Berquist Patent, the Dock Manual, and the trial testimony—render the hypothetical claim obvious.

Appx19. Accordingly, the district court found that the hypothetical claims covering the asserted equivalency ensnare the prior art, and the accused docks do not infringe under the doctrine of equivalents as a matter of law. Appx19-20.

SUMMARY OF THE ARGUMENT

The district court correctly found that the accused docks do not literally infringe any claim of the '554 Patent. All of the asserted claims require that "each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it" for receiving a fastener to connect the dock segments and to connect the dock to the pilings. The accused docks do not have an aperture in the sidewall. This Court should reject the Appellant's argument that an aperture in a plate welded onto the end of the side wall satisfies this limitation. The '554 Patent itself confirms that such structures are not the "side wall." Even if they could be considered to be a part of the "side wall," the aperture in the accused docks is not in "that portion of the side wall adjacent the rim." Accordingly, the accused docks do not infringe the asserted claims literally.

The district court also correctly held that the accused docks do not infringe under the doctrine of equivalents as a matter of law, because the Appellant's infringement allegations ensnare the prior art. The "aperture" limitations that describe the unique connection mechanism of the '554 Patent claims provided the only basis for patentability for all of the asserted claims. As noted above, the accused docks do not incorporate the "aperture" required by the asserted claims, but instead use a connection mechanism that Appellant's expert calls a "double-ear" connection. The double-ear connection was well-known in the prior art before

the ‘554 Patent was filed, as confirmed by numerous prior art references and by the testimony of the Appellant’s own expert. The district court carefully analyzed the prior art and the hypothetical claim that covers the accused equivalent structure, and found that the hypothetical claim would be unpatentable as obvious in light of prior art references.

The Appellant’s unsupported assertion that the district court provided “no articulated reason as to why any prior art references were anticipatory or would be combined in such a way as to render the claimed subject matter obvious,” Appellant’s Brief at 24, ignores the district court’s detailed analysis and conclusions. The district court discussed the prior art references and their disclosures in detail, and carefully analyzed the patentability of the hypothetical claims. The Appellant does not dispute any of the district court’s factual findings or citations to the prior art, nor does he articulate any reason that a person of skill in the art would not combine the teachings of the relevant prior art references. In short, the Appellant does not raise a single substantive error in the district court’s analysis.

Finally, this Court should affirm the district court’s judgment of no infringement because prosecution history estoppel bars the Appellant’s allegations of infringement under the doctrine of equivalents. The record shows that the Appellant added the “aperture” limitations to all of the asserted claims during

prosecution to distinguish his claims from the prior art. A narrowing amendment made during prosecution raises a rebuttable presumption that the doctrine of equivalents is unavailable for the amended language. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 US 727 (2002). The Plaintiff is unable to rebut this presumption, and thus barred by prosecution history estoppel from asserting that the connection mechanism of the accused docks is equivalent to the aperture limitation.

ARGUMENT

I. STANDARD OF REVIEW

A. SUMMARY JUDGMENT

This Court reviews a grant of summary judgment under the law of the regional circuit in which the district court sits. *Charles Mach. Works, Inc. v. Vermeer Mfg. Co.*, 723 F.3d 1376, 1378 (Fed. Cir. 2013) (citing *Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1344 (Fed. Cir. 2012)). The Seventh Circuit reviews a grant of summary judgment *de novo*. *Chicago Regional Council of Carpenters Pension Fund v. Schal Bovis, Inc.*, 826 F.3d 397, 403 (7th Cir. 2016). Summary judgment is appropriate if "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." *Charles Mach. Works.*, 723 F.3d at 1378 (quoting FED. R. CIV. P. 56(a)). All justifiable inferences are to be drawn in favor of the non-movant. *Id.* (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, (1986)). On appeal from a grant of summary judgment, this Court must determine "whether, after resolving reasonable factual inferences in favor of the patentee, the district court correctly concluded that no reasonable jury could find infringement." *Charles Mach. Works.*, 723 F.3d at 1378 (quoting *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1312 (Fed. Cir. 2009)).

B. JUDGMENT AS A MATTER OF LAW

In reviewing a grant of a motion for judgment as a matter of law, this Court once again applies the standard of review of the regional circuit in which the district court sits. *Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc.*, 725 F.3d 1377, 1380 (Fed. Cir. 2013) (citing *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340, 1343 (Fed. Cir. 2012); *Micro Chem., Inc. v. Lextron, Inc.*, 317 F.3d 1387, 1390–91 (Fed. Cir. 2003)). The Seventh Circuit reviews a district court's grant of judgment as a matter of law *de novo*. *Lasley v. Moss*, 500 F.3d 586, 590 (7th Cir. 2007) (citing *Zimmerman v. Chicago Bd. Of Trade*, 360 F.3d 612, 623 (7th Cir. 2004)).

The ensnarement defense and prosecution history estoppel are both legal questions, properly decided by a court on motion for summary judgment or judgment as a matter of law. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1324 (Fed. Cir. 2009) (citing *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997)). Both legal issues are reviewed by this Court *de novo*. *Id.* (citing *Festo Corp. v. SHoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359, 1368 (Fed. Cir. 2003); *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 683 (Fed. Cir. 1990)). In either case, resolution of underlying factual issues are reviewed for clear error. *DePuy Spine*, 567 F.3d at

1324 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 493 F.3d 1368, 1376 (Fed. Cir. 2007)).

C. THE JURY'S FINDINGS AND VERDICT ARE IRRELEVANT TO THIS APPEAL

In his brief, the Appellant addressed the standard of review of the jury's verdict regarding infringement, willful infringement, and damages. Appellant's Brief at 25-26. Because Appellees have not appealed the jury verdict, the jury's factual findings and verdict are irrelevant to this appeal. The application of the "ensnarement defense" is an issue of law for the court, not for the jury. *DePuy*, 567 F.3d at 1324. The ensnarement defense is a limitation on the doctrine of equivalents that is "separate and distinct from the jury's equivalence analysis," and may be "imposed even if a jury has found equivalence as to each claim element." *Id.* at 1323.

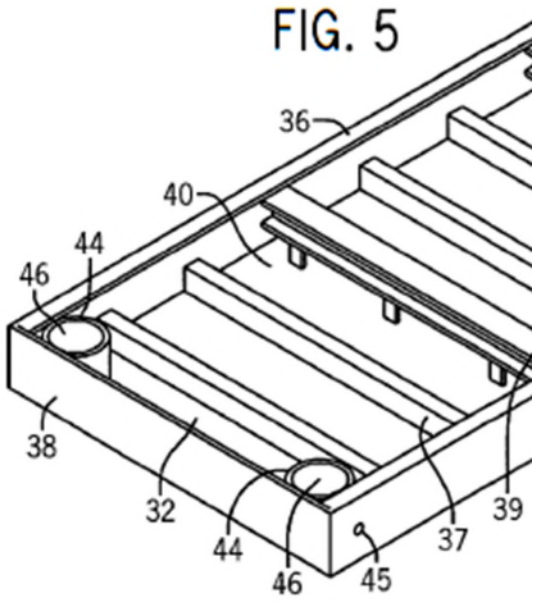
II. THE DISTRICT COURT CORRECTLY HELD THAT THE ACCUSED DOCKS DO NOT LITERALLY INFRINGE THE ASSERTED CLAIMS OF THE '554 PATENT

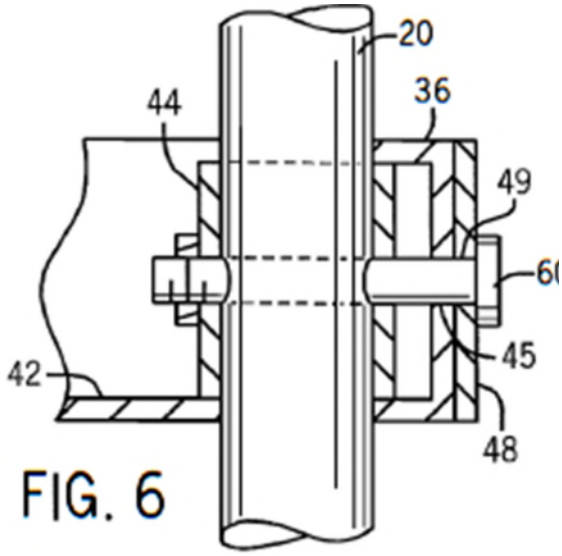
Based upon its detailed comparison of the asserted claims and the accused docks, the district court correctly determined that the accused docks do not literally infringe the asserted claims of the '554 patent. Literal infringement of a patent claim requires that the accused product contain every element or limitation recited in the claim. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991). If even a single limitation is not satisfied, there can be no infringement as a

matter of law. *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994); *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1178 (Fed. Cir. 1991). Because the accused docks do not satisfy the "aperture" limitation present in every asserted claim, they do not literally infringe.

A. THE ACCUSED DOCKS DO NOT LITERALLY INFRINGE BECAUSE THEY DO NOT MEET THE LIMITATION THAT REQUIRES THAT "EACH CYLINDRICAL RIM AND THAT PORTION OF THE SIDE WALL ADJACENT THE RIM HAS AN APERTURE"

Every asserted claim of the '554 Patent recites the "aperture" limitation, which requires that "each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener." The plain language of the claims requires that a single aperture extend through **both** the cylindrical rim **and** the adjacent side wall. The claims do not require an aperture in the cylindrical rim and another aperture in the sidewall, they require "an aperture" (singular) that extends through "the cylindrical rim and the portion of the side wall adjacent the rim." Appx57. The specification confirms that this is a single aperture for a single fastener, not two separate apertures for two fasteners: "A like **aperture 45** is formed into the sidewall 36 **and** rim 44 to allow dock elements 30 to be secured …." Appx56 at 2:43-45 (emphasis added). Figures 5 and 6 show a single aperture—labeled "45"—that extends through both the cylindrical rim (44) and the sidewall (36):





Appx55. This arrangement allows for a "single-fastener" connection mechanism, which Appellant himself described as "one of the important features" of his invention. Appx356-7 at pp. 168:24 to 170:2.[4]

The doctrine of claim differentiation does not change the plain meaning of the claims requiring a single aperture through both the cylindrical rims and the adjacent side wall. *See* Appellant's Brief at 28-29. Under that doctrine, "the presence of a dependent claim that adds a particular limitation raises a presumption

[4] The district court noted that Appellant disputed that the claims require that "a single aperture pass through the sidewall into the cylindrical rim," Appx249, but did not explicitly decide that issue. Appx249-50. Instead, the district court held that Appellant could not prove direct infringement even based on its own theory, because he could not identify an aperture in "that portion of the side wall adjacent to the cylindrical rim." *Id.*

that the limitation in question is not found in the independent claim." *Leibel-Flarsheim Co. v. Medrad*, 358 F.3d 898, 910 (Fed. Cir. 2004). The doctrine has no application in this case. Appellant cites the language of dependent claim 5 requiring a "dock assembly" where "the apertures of the **overlapping members**, the cylindrical rims and the side walls are collinear." But the scope of claim 5 is clearly distinct from that of claim 4; claim 4 does not require that the aperture in the **overlapping member** be collinear with the aperture that extends through the cylindrical rim and the adjacent side wall. Nothing in claim 5 suggests that the "aperture" limitation permits a hole in the cylindrical rim and a **separate** hole in the side wall.

The accused docks undisputedly do not incorporate a single aperture that extends through both the cylindrical rim and the adjacent side wall. Instead, as Appellant conceded, the accused docks require two fasteners—one to attach the dock to the pilings, and another to connect the dock segments. Appx249. The aperture for the first fastener is in the portion of the sleeve that extends above the deck of the dock; the apertures for the second are in the plates that form the "double-ear connection." This arrangement is depicted below:



Because the accused docks do not incorporate an aperture that extends through both the cylindrical rim and the adjacent side wall, the district court correctly granted summary judgment of no literal infringement.

B. THE ACCUSED DOCKS DO NOT LITERALLY INFRINGE BECAUSE THEY DO NOT MEET THE LIMITATION THAT REQUIRES AN APERTURE IN "THAT PORTION OF THE SIDE WALL ADJACENT THE RIM"

Even if the single aperture formed in "each cylindrical rim and that portion of the side wall adjacent the rim" required by the '554 Patent could be satisfied by

an aperture in the cylindrical rim and a separate aperture in the side wall, the accused docks still do not literally infringe the asserted claims because they do not incorporate an aperture in "that portion of the side wall adjacent the rim," as the district court held on summary judgment. Appx249-50.

The Appellant pointed to the apertures in the end plates that form the "double-ear" connection as satisfying the requirement of an aperture in the "portion of the side wall adjacent the rim."[5] However, as the district court held, these plates are not part of the "side wall;" they are distinct structures that serve distinct purposes. The '554 Patent distinguishes between the side walls of the patented dock, which together with the end walls and floor "form a cavity," and structures that **extend from** the side walls, such as the overlapping members. Appx56-57 (*Id.*). The "ears" of the double-ear connection of the accused docks are **not** a "portion of the side wall adjacent the rim;" they are not a portion of the side wall at all.[6] As the district court held,

> The weld plate, however, is not the same as the sidewall. The fact that it is welded onto the side wall itself signals

[5] Before summary judgment, Appellant and his expert were unable to identify **any** structure that allegedly satisfied constituted an aperture in the side wall. In his infringement contentions, the Appellant acknowledged that "[t]his aperture is not visualized [in the attached photographs]," Appx100, and Appellant's expert did not identify any aperture in the side wall in his expert report. Appx129.

[6] In fact, Appellant's expert initially identified the weld plate of the accused docks as an "overlapping member," rather than as the "side wall," and called the hole in that weld plate "an aperture formed in" the overlapping member. Appx128, 132.

> the fact that it is something other than the side wall. Most importantly, the patent itself claims features nearly identical to the accused docks' weld plate. The patent has a name for this feature: "overlapping member." . . . **Just as the overlapping member on the '554 patent dock does not constitute part of the sidewall, so also the weld plate on the accused dock does not**. It follows that the accused dock does not have an aperture in the portion of the sidewall adjacent the cylindrical rims.

Appx249-250 (emphasis added).[7]

The Appellant argues, citing Chisum, that "splitting one element into two or more elements often would not avoid infringement if function and results remained the same," Appellant's Brief at 27, but this cannot save his literal infringement claim. In fact, the Appellant's argument addresses infringement **under the doctrine of equivalents**, not literal infringement; the section of Chisum from which he quotes is entitled "Doctrine of Equivalents." 5B Donald S. Chisum, *Chisum on Patents*, § 18.04 (2016). *See also Eagle Comtronics, Inc. v. Arrow Commc'n Labs., Inc.*, 305 F.3d 1303, 1317 (Fed. Cir. 2002) ("when two elements of the accused device perform a single function of the patented invention . . . the doctrine of equivalents may still apply if the differences are insubstantial"). For the reasons set forth below, the doctrine of equivalents is unavailable to Appellant.

[7] Even if the "ears" of the double-ear connection could be considered a portion of the side wall, they do not satisfy the "aperture" limitation because they are not "adjacent the rims." The term "adjacent" cannot include portions that are arranged down the length of the dock structure in isolation from the rim and isolated by intervening members.

Plaintiff's attempts to stretch the terms "side wall" and "adjacent" beyond their plain and intended meaning in order to capture Cole's docks was not accepted by the district court. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, (Fed. Cir. 2004) ("[O]rdinary, simple English words whose meaning is clear and unquestionable," are construed to mean "exactly what they say."); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). The district court correctly found no literal infringement, because Cole's docks do not contain "an aperture in that portion of the side wall adjacent the rim." For the same reason, this Court should affirm the district court's decision of no literal infringement.

III. THE DISTRICT COURT CORRECTLY HELD THAT THE ACCUSED DOCKS DO NOT INFRINGE THE ASSERTED CLAIMS OF THE '554 PATENT UNDER THE DOCTRINE OF EQUIVALENTS

After the jury considered the doctrine of equivalents, the district court correctly held that the asserted equivalency ensnares the prior art. Patentability of the asserted claims was based solely on Kahr's unique connection mechanism, described in the "aperture" limitation. The accused docks do not use that connection mechanism, instead incorporating a "double-ear" connection that was undisputedly well-known in the art before the '554 Patent. The Appellant's

attempt to expand his right to exclude to cover the accused docks is barred because it ensnares the prior art.

"Infringement may be found under the doctrine of equivalents if an accused product performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same overall result as the claimed invention." *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 683 (Fed. Cir. 1990), *overruled on other grounds, Cardinal Chem. Co. v. Morton Intern., Inc.*, 113 S.Ct. 1967 (1993) (citations and quotations omitted). However, there are legal limitations on the doctrine of equivalents that bar a patentee from asserting the doctrine as to certain equivalents, including ensnarement and prosecution history estoppel.

Under ensnarement, even if a product is found to be an equivalent, "there can be no infringement if the asserted scope of equivalency of what is literally claimed would encompass the prior art." *Wilson Sporting Goods*, 904 F.2d at 683, *citing Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc). *See also Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1323 (Fed. Cir. 2009) (no infringement under the doctrine "even if a jury has found equivalence as to each claim element"); *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367 (Fed. Cir. 1999) ("Based on the fundamental principle that no one deserves an exclusive right to technology already in the

public domain, this court has consistently limited the doctrine of equivalents to prevent its application to ensnare the prior art."); *General Am. Transp. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 770-71 (Fed. Cir. 1996). This "ensnarement defense" is a matter of law typically decided on summary judgment or on a motion for judgment as a matter of law after a jury verdict. *DePuy*, 567 F.3d at 1324. *See also Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1363 (Fed. Cir. 2000); *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 981 (Fed. Cir. 1999).

With respect to ensnarement, consideration of the prior art is a critical component of the analysis. *We Care, Inc. v. Ultra-Mark Int'l Corp.*, 930 F.2d 1567, 1571 (Fed. Cir. 1991). "[S]ince prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim." *Id.* Analysis of the ensnarement defense typically consists of determining whether a hypothetical claim, based on the asserted claim but broad enough in scope to cover the accused products **literally**, could have been allowed over the prior art. *Wilson Sporting Goods*, 904 F.2d at 684. *See also Ultra-Tex*, 204 F.3d at 1364 ("[h]ypothetical claim analysis provides a practical methodology for determining whether a claim that has been 'broadened' under the doctrine of equivalents impermissibly ensnares the prior art in its newly expanded form"); *but see Gemalto S.A. v. HTC Corp.*, 754 F.3d 1364, 1374-75 (Fed. Cir. 2014) (affirming summary

judgment of non-infringement due to ensnarement based simply upon conclusion that alleged equivalent structure was used in the prior art). If the hypothetical claim would be anticipated or obvious in view of the prior art, "then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents." *Wilson Sporting Goods*, 904 F.2d at 684; *We Care*, 930 F.2d at 1571 (both anticipation and obviousness); *Key Mfg. Group*, 925 F.2d at 1449 (contrary to patentee's assertion, "no single prior art reference need include each element of the hypothetical claim"). The relevant date for purposes of this analysis is the date the application for the patent-in-suit was filed. *We Care*, 930 F.2d at 1571.

Additionally, prosecution history estoppel also limits the application of the doctrine of equivalents. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 US 722 (2002). When the patentee amends the claim to add claim language in response to an examiner's rejection, the doctrine of equivalents is presumptively unavailable for the added claim language. *Id.* at 727. The patentee bears the burden of overcoming this presumption by showing "that the amendment does not surrender the particular equivalent in question." *Id.* at 740. In general, a particular equivalent is not surrendered by amendment where (1) the equivalent was unforeseeable at the time of the application; (2) the rationale underlying the amendment bears no more than a tangential relationship to the equivalent; or (3)

there is some other reason the patentee could not reasonably have been expected to draft a claim encompassing the equivalent. *Id.* at 741-42. In those particular factual instances, the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence." *Id.* Prosecution history estoppel is a question of law for the Court. *Festo v. Shoketsu*, 344 F.3d 1359, 1367-68 (Fed. Cir. 2003) (en banc).

A. THE ASSERTED EQUIVALENT IS BARRED BY THE ENSNAREMENT DEFENSE

The undisputed evidence—based on the Appellant's own testimony and that of his expert witness—establishes unequivocally that the Plaintiff's doctrine of equivalents analysis with respect to the accused docks ensnares the prior art. As shown above, the only basis for patentability of the asserted claims of the '554 Patent is Kahr's unique connection mechanism, set forth in the "aperture" limitation. The examiner rejected all of the asserted claims as anticipated or obvious without the aperture limitation; when the Appellant amended the claims to add that limitation, the examiner allowed the claims. This is consistent with the testimony of the Appellant and his expert, who acknowledged that every limitation of the asserted claims save the "aperture" limitation was well-known and in use in the prior art before Appellant filed the application for the '554 Patent. *See* Appx355 (Kahr testimony); Appx397-398 (Wentland testimony); Appx661-667, 671-672, 677 (Wentland deposition); *see also* Appx561-70 (claim chart

summarizing Appellant's admissions with respect to every limitation of the hypothetical claims). The **only feature** of the asserted claims that the Appellant had never seen or built prior to his invention was the unique connection mechanism. Appx355 (Kahr testimony).

The accused docks do not use the connection mechanism of the '554 Patent. Instead, the accused docks incorporate an entirely different connection mechanism—the double-ear connection—that was **not new** and had been in use for years. The Appellant's expert himself confirmed that the double-ear connection used in the accused docks was well-known in the prior art before the '554 patent. *See* Appx666-666, 677 (Wentland deposition); Appx399 (Wentland testimony). Numerous prior art references from before the filing date of the '554 patent confirm that the double-ear connection was common and known in the art.

When the Plaintiff attempts to expand patent rights **beyond** docks with his unique connection mechanism—the only reason he obtained a patent in the first place—and to cover docks that use a common connection mechanism that was well-known in the art, he ensnares the prior art. Therefore, he cannot legally claim the accused docks infringe under the doctrine of equivalents. *See, e.g.*, *Ultra-Tex*, 204 F.3d 1360 (upholding district court determination of non-infringement because of ensnarement); *Marquip*, 198 F.3d 1363 (upholding summary judgment of non-infringement based, in part, on ensnarement); *Streamfeeder*, 175 F.3d 974

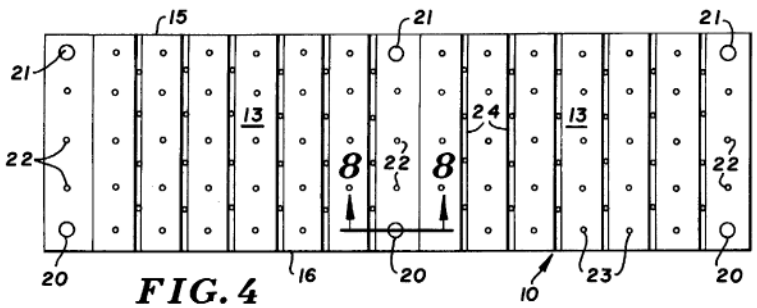
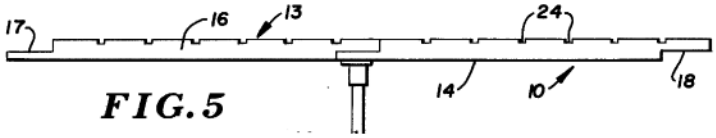
(reversing jury verdict of infringement, and denial of motion for JMOL, on grounds of ensnarement); *Wilson Sporting Goods*, 940 F.2d 677 (holding that district court should have granted motion for judgment as a matter of law on basis of ensnarement); *Key Mfg.*, 925 F.2d 1444 (reversing district court finding of infringement due to ensnarement). This is particularly true when, as here, the claim element missing from the accused product is precisely the basis for patentability. *General Am. Transp.*, 93 F.3d 766 (reversing district court holding of infringement). This analysis alone warrants affirming the district court's judgment of non-infringement as a matter of law, without the need to examine a hypothetical claim. *See Gemalto*, 754 F.3d 1364 (affirming summary judgment of non-infringement due to ensnarement without hypothetical claim analysis).

1. The District Court Correctly Held That the Hypothetical Claims are Obvious in View of the Berquist Patent in Combination with Either the Dock Manual or the Appellant's Admissions

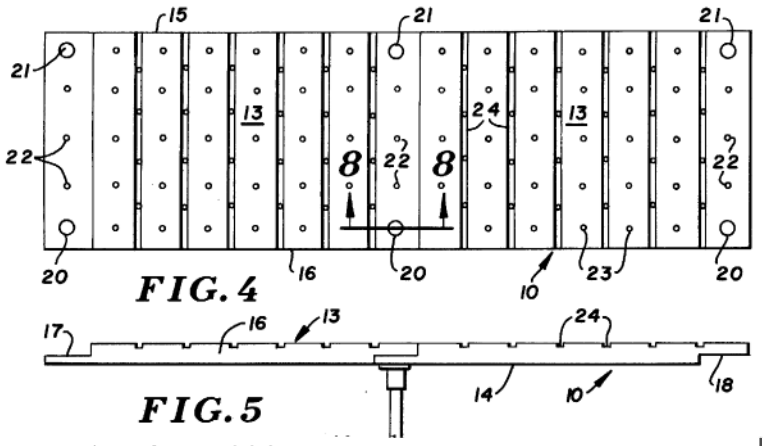
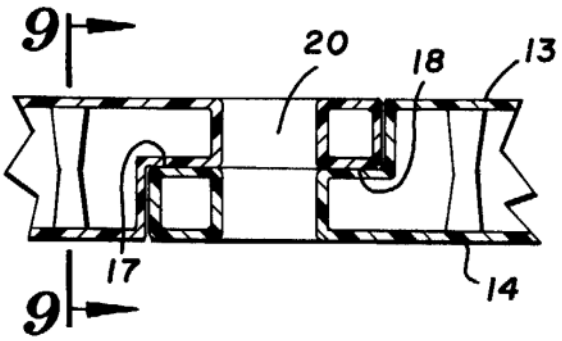
The district court made detailed findings supporting its conclusion that the hypothetical claims are unpatentable as obvious in view of the Berquist reference in combination with either Burns (the Dock Manual) or the Appellant's admissions. Appx9-20. This conclusion is unsurprising: the examiner cited the Berquist patent in rejecting every original claim of the '554 Patent application as unpatentable. Appx705-706. It was only after the Appellant amended the claims to add the "aperture" limitation that the examiner allowed the claims over Berquist.

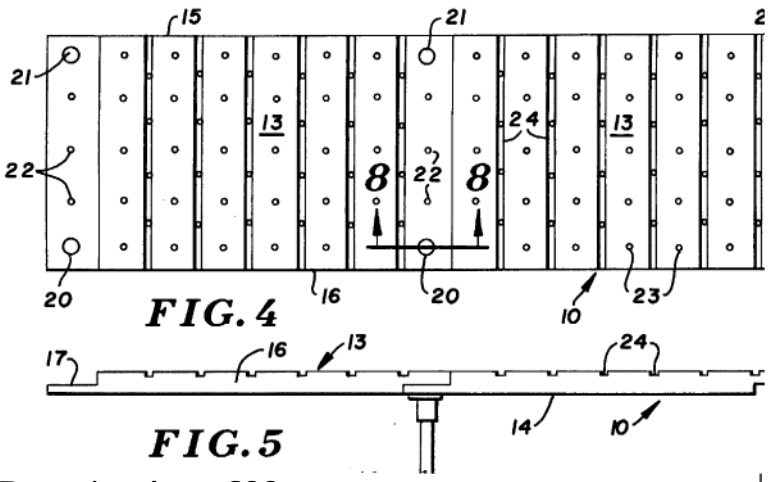
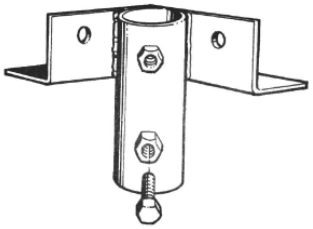
Appx725-31. However, the accused docks do not incorporate the "aperture" limitation, instead using a "double-ear connection" that was undisputedly well-known in the prior art before the '554 Patent.

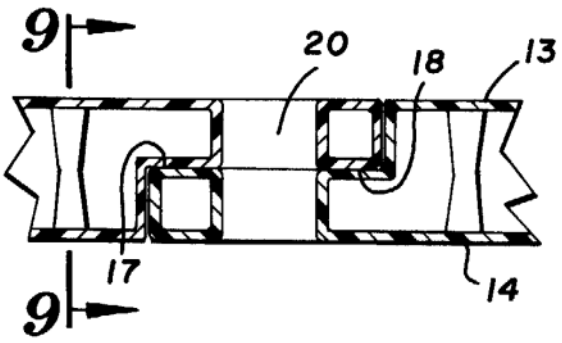
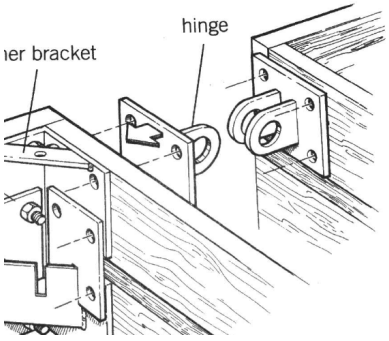
The district court reviewed the prior art and made detailed factual findings regarding the disclosure of each of the elements of the hypothetical claims. Appx9-20. The district court's conclusions are amply supported by the evidence, as set forth in Appellees' claim chart, Appx819-35, set forth in part below.

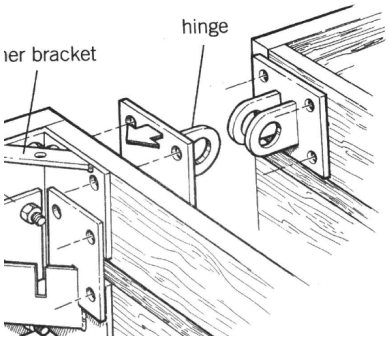
Hypothetical Claim: 1[8]	**Berquist, Burns, and Testimony**
1. A dock structure for use with vertical pilings, the structure comprising:	 FIG. 4  FIG. 5 *Berquist. Appx698* *See also*, "dock Structure 10." Appx705.

[8] The claim chart for hypothetical claim 1 is provided here for exemplary purposes. Charts for asserted claims 2-4, 6, and 7 are provided at Appx826-35.

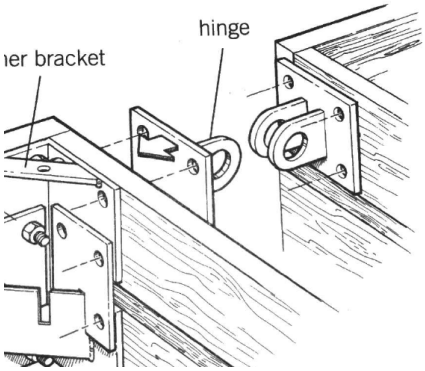
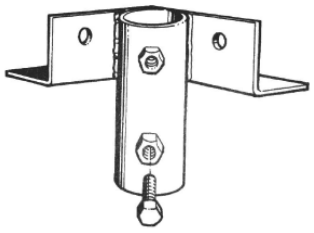
a first end and a second end, a pair of opposing side walls, a pair of opposing end walls, one end wall disposed at each end of the structure, and a floor;	 FIG. 4 FIG. 5 *Berquist.* Appx698. *See also,* "first and second ends, a pair of opposing sidewalls 15, 16, and a floor 14." Appx705.
wherein the side walls, the end walls and the floor form a cavity;	 FIG. 8 *Berquist.* Appx698. *See also,* "wherein the end walls, the sidewalls, and the floor form a cavity." Appx705.

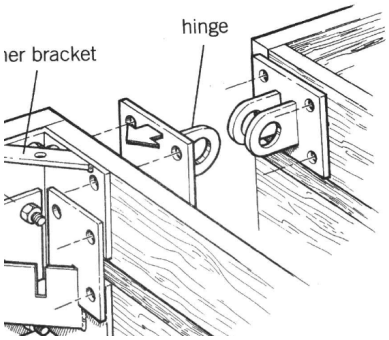
a pair of cylindrical rims disposed at the first end of the structure, each rim forming a vertically-disposed cylindrical opening in the floor and each opening being functionally adapted to receive a piling through it; ~~and~~	 FIG. 4 FIG. 5 *Berquist.* Appx698 *See also*, "a pair of cylindrical rims 20, 21." Appx705. ***OR***  *Burns* at 48 (Appx685). **OR** "Q. And those docks that were built before your invention also incorporated **sleeves** to receive the pilings, correct? A. That's correct." Appx601 at 162:9-11 (Kahr testimony).

a pair of overlapping members formed at the second end of the structure; and	 FIG.8 *Berquist.* Appx698. *See also*, "and overlapping members 17. The overlapping member including a top and a bottom surface that would be considered a pair of overlapping members as broadly recited." Appx705. **OR**  *Burns* at 81 (Appx692) (showing one side of dock, where other side includes identical connection). **OR** "Q. You've seen that **<u>double-ear</u>** connection before you saw Mr. Kahr's and Mr. Cole's docks, correct? A. Correct." Appx635 at 337:12-15 (Wentland testimony).

	"Q. Okay. Prior to seeing Mr. Kahr's docks, had you seen docks that incorporated a connection mechanism like that in the accused docks, or **two plates that were either bolted or pinned together**? A. Other than the accused docks, have I seen this anywhere else, is what you're asking me? This sort of a connection? Q. Yes, that's right. A. **Absolutely.** Q. Okay. Have you seen it for years? A. Yes." Appx665 at 67:6-16 (Wentland deposition). "Q. Do you think this type of a connector for a dock that's not a floating dock is appropriate? A. **Absolutely.** Q. Okay. There's no reason you can't translate it from a floating dock to a standing dock, right? A. No there's none . . . ." Appx666 at 68:9-15 . "A. No. I'm sorry. When we get into floating docks, which could be 150, 160 foot long in a marina, there would be segments of floating dock sections that would be put in place, and they would be connected in that fashion. Q. In the fashion of the connection in the accused docks? A. With that **double-ear** connection." Appx677 at 79:4-9.
an extended end plate at the first end;	 *Burns* at 81 (Appx692) (showing one side of dock, where other side includes identical connection). **OR**

	"Q. You've seen that **double-ear** connection before you saw Mr. Kahr's and Mr. Cole's docks, correct? A. Correct." Appx635 at 337:12-15 (Wentland testimony). "Q. Okay. Prior to seeing Mr. Kahr's docks, had you seen docks that incorporated a connection mechanism like that in the accused docks, or **two plates that were either bolted or pinned together**? A. Other than the accused docks, have I seen this anywhere else, is what you're asking me? This sort of a connection? Q. Yes, that's right. A. **Absolutely.** Q. Okay. Have you seen it for years? A. Yes." Appx665 at 67:6-16 (Wentland deposition). "Q. Do you think this type of a connector for a dock that's not a floating dock is appropriate? A. **Absolutely.** Q. Okay. There's no reason you can't translate it from a floating dock to a standing dock, right? A. No there's none . . . ." Appx666 at 68:9-15 . "A. No. I'm sorry. When we get into floating docks, which could be 150, 160 foot long in a marina, there would be segments of floating dock sections that would be put in place, and they would be connected in that fashion. Q. In the fashion of the connection in the accused docks? A. With that **double-ear** connection." Appx677 at 79:4-9.

wherein each overlapping member has an aperture formed in it for receiving a fastener; and	 *Burns* at 81 (Appx692) (showing one side of dock, where other side includes identical connection). OR "Q. Okay. Prior to seeing Mr. Kahr's docks, had you seen docks that incorporated a connection mechanism like that in the accused docks, or two plates that were either **bolted or pinned together**? A. Other than the accused docks, have I seen this anywhere else, is what you're asking me? This sort of a connection? Q. Yes, that's right. A. Absolutely. Q. Okay. Have you seen it for years? A. Yes." Appx665 at 67:6-16 (Wentland deposition).
wherein each cylindrical rim ~~and that portion of the side wall adjacent the rim~~ and the extended end plate has an aperture formed in it for receiving a fastener.	**APERTURE IN RIM**  *Burns* at 48 (Appx685) (showing cylindrical rim and alternative bracket) **APERTURE IN EXTENDED END PLATE**



Burns at 81 (Appx692) (showing one side of dock, where other side includes identical connection).

OR

APERTURE IN RIM

"Q. Before your invention docks were built where pilings went through the deck and were **attached to the deck** with a - - to the dock **with a pin**, correct? A. That's correct." Appx601 at 162:5-8 (Kahr testimony).

"Q. And you're aware also that before Mr. Kahr designed his docks there were docks that used **pins to hold the dock to the pilings**, correct? A. Correct." Appx631 at 333:20-23 (Wentland testimony).

"Q. The **use of a pin to pin the dock segment to the piling**, had you seen that before you saw the plaintiff's docks and the accused docks? A. Yes." Appx667 at 69:21-24 (Wentland deposition).

"Q . . . If you look on the pilings that are on the near side of this dock, there's one that's right behind the platform there. Do you see that? A. Yes. Q. An in there it appears to be connecting the piling to the dock as some sort of a fastener, like a pin or a nail or something like that. Do you see that? A. Yes. Q. Had you seen designs like this prior to, say, 2010 when - - A. Yes. Q. Was

	that a common design in dock design? A . . . This is – In a wood design this is a common design, wood pilings, cross-members for strength and stability of those pilings, bolts because this is wood rather than welded through. This what I would consider a permanent structure." Appx671-72 at 73:14-74:8 (Wentland deposition). "Q. At the very least, you saw it before? A. Yeah, I don't deny this photo. It seems like it's thought out and well built." Appx672 at 74:5-7 (Wentland deposition). "Q. Okay. And you had also seen in the prior art docks that were **connected to the pilings** with some sort of **a fastener, a bolt, a nail, a pin**, correct? A. Yes. Q. Okay. A. And I said very, very few of those that I've seen. Q. But the number - - irrelevant of the number, you saw them in the prior art? A. Yes." Appx677 at 79:10-18 (Wentland deposition). **APERTURE IN EXTENDED END PLATE** "Q. Okay. Prior to seeing Mr. Kahr's docks, had you seen docks that incorporated a connection mechanism like that in the accused docks, or **two plates that were either bolted or pinned together**? A. Other than the accused docks, have I seen this anywhere else, is what you're asking me? This sort of a connection? Q. Yes, that's right. A. **Absolutely.** Q. Okay. Have you seen it for years? A. Yes." Appx665 at 67:6-16 (Wentland deposition.

Because Berquist was the primary reference relied upon by the examiner to reject the original claims, this analysis is straightforward. The only elements of the

now-asserted claims that the examiner **did not find** in the prior art were the "aperture" elements—the precise elements that are missing from the accused docks. Appx705-706. The patentee—the Appellant—did not dispute the examiner's findings. Appx725-731. Thus, the only element from the hypothetical claims that Berquist does not disclose is the specific double-ear connection mechanism used in the accused docks. "[W]hen a patent claims a structure already known in the prior art that is altered by the **mere substitution of one element for another known in the field**, the combination must do more than yield a predictable result." *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007) (emphasis added).

The evidence that the double-ear connection was known in the art before the '554 Patent is overwhelming. As shown above, and in detail in the claims chart at Appx572-579, both Appellant's expert and the Dock Manual confirm that the double-ear connection was well-known in the art. Appellant cannot reasonably dispute that the connection mechanism used in the accused docks—the alleged equivalent of the missing "aperture in the side wall"—was well-known in the prior art long before the application for the '554 Patent was filed. In combination, these elements do nothing more than yield predicable results, and one of ordinary skill in the art would have combined these "familiar elements according to known methods" to "yield predictable results." *KSR*, 550 U.S. at 415. The hypothetical

claims are all obvious, therefore, in light of a combination of Berquist and the double-ear connection disclosed in the Dock Manual and confirmed by the Plaintiff's admissions. This alone warrants affirming the district court's judgment of non-infringement as a matter of law.

2. The Hypothetical Claims are also Unpatentable as Anticipated or Rendered Obvious by the Dock Manual by Burns

Additionally, the evidence establishes that the hypothetical claims are unpatentable as anticipated by Burns, Max, *The Dock Manual*, Canada, Storey Books, 1999 ("the Dock Manual"). Appx678-693 (Dock Manual). Appellees set forth in detail the evidence that Burns discloses every limitation of the hypothetical claims. *See* Appx572-79 (claims charts). Burns discloses segmented docks that form a box with end walls and side walls. Appx684. It further discloses the use of concrete forms, which may form a "floor," as that term was construed by the district court. Appx690-91, Appx693. Burns also discloses the use of cylindrical rims for the piles, with pins through an aperture in the cylindrical rim to hold the dock to the pile. Appx684-85. It discloses the use of "overlapping members," and also discloses the specific double-ear connection mechanism used in the accused docks. Appx692. Regarding dependent claims 2 and 6, the Dock Manual further discloses the use of reinforcing members: "Steel reinforcement should be placed before the concrete is poured." Appx693; *see also* Appx691.

The district court agreed that Burns discloses every limitation of the hypothetical claims. Appx19. The district court nevertheless held that Burns does not anticipate because it does not disclose all of the elements in a single embodiment. Appx13. Although anticipation requires that all elements of the claims must be disclosed "as arranged in the claim," *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008), this does not mean that the claim must be disclosed word-for-word. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). Nor is there a requirement that the reference teach the "actual performance" of combining the disclosed elements. *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1383 (Fed. Cir. 2015). It is sufficient if a person of ordinary skill in the art "would at once envision" the claimed arrangement or combination. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1341 (Fed. Cir. 2016). "[A] reference may still anticipate if that reference teaches that the disclosed components or functionalities may be combined and one of skill in the art would be able to implement the combination." *Id.* at 1344.

Burns meets this anticipation standard. Although the disclosures of the limitations of the hypothetical claims are primarily in three different sections of the book, rather than a single "embodiment," that is entirely due to the nature of the book. The Dock Manual is intended to give the reader the tools to design and build a dock. As the district court noted, Burns "describes various methods of designing,

building, and maintaining a dock. A builder can pick and choose any combination of features to create the structure." Appx19. Burns satisfies the test for anticipation. The individual chapters are not the "multiple, distinct teachings" criticized by this Court in *Net MoneyIN*. *See* 545 F.3d at 1371 ("it is not enough that the prior art reference … includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention"). Unlike the prior art reference in that case, Burns does not disclose "two mutually exclusive" embodiments. *Id.* at 1363 n.1. Nor do Appellees treat the hypothetical claims or the prior art reference as a "catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims …." *See Lindemann Machinenfabrik GMBH v. American Hoist & Derrick Co.*, 703 F.2d 1452, 1459 (Fed. Cir. 1984). Burns simply separates the discussions of general dock types, materials, and hardware. Naturally, all of those elements are combined to build docks.

At the very least, the Burns reference establishes beyond question that the hypothetical claims are unpatentable as obvious. As the district court correctly identified, Burns "does disclose every limitation of the hypothetical claim," and further "describes various methods of designing, building, and maintaining a dock" such that "[a] builder can pick and choose any combination of features to create the structure." Appx. 19 (Decision and Order). In combination, these elements do nothing more than yield predicable results, and one of ordinary skill in the art

would have combined these "familiar elements according to known methods" to "yield predictable results." *KSR*, 550 U.S. at 415. Accordingly, the hypothetical claims are also unpatentable as obvious in view of the Dock Manual.

B. THE APPELLANT HAS NOT MET HIS BURDEN OF PROVING THAT THE HYPOTHETICAL CLAIMS ARE PATENTABLE OVER THE PRIOR ART

1. The Hypothetical Claims Analyzed by the District Court Were Proper

In their motion for judgment as a matter of law based on the ensnarement defense, the Appellees proposed hypothetical claims based on the asserted claims of the '554 Patent, but broad enough to cover the alleged equivalent structures in the accused docks. Appx542-43. The Appellant did not challenge Appellees' proposed hypothetical claims, nor did he offer his own proposed hypothetical claims. Appx755-63. The district court adopted the Appellees' proposed hypothetical claims and used them in its ensnarement defense analysis. Appx9-20.

Now, for the first time on appeal,[9] Appellant challenges the district court's hypothetical claims as "improper." Appellant's Brief at 36-38. However, Appellant does not explain any way in which the alleged errors affected the district court's patentability analysis. Notably, the Appellees did not offer alternative hypothetical claims that are allegedly patentable over the prior art. *Id.* Instead, Appellees simply argue that "a proper hypothetical claim requires no broadening or

[9] By failing to raise this argument below, Appellant waived the argument.

narrowing amendment," suggesting that the district court should have conducted its analysis using the actual asserted claims of the '554 Patent. Appellant's Brief at 37-38. This is nothing more than a restatement of the Appellant's appeal of the district court's summary judgment of no literal infringement, and should be rejected by this Court.

The district court properly adopted hypothetical claims based on the asserted claims of the '554 Patent, with the scope broadened to cover the alleged equivalent structures of the accused docks. As the district court found, the hypothetical claims are unpatentable in light of the prior art.

2. The District Court Properly Analyzed the Patentability of the Hypothetical Claims by Addressing All of the Limitations

The Appellant's allegation that the district court erred by focusing on the "double-ear connection" mechanism of the accused docks, "to the exclusion of all other elements of the '554 patent claims," Appellant's Brief at 32-33, is patently incorrect. The district court conducted a detailed and thorough analysis of the hypothetical claims, addressing each and every one of the limitations of those claims. Appx9-20. Based on that analysis, the district court concluded that the hypothetical claims are unpatentable over the prior art. *Id.*

Notably, although it is his burden to prove that the hypothetical claims are patentable over the prior art, the Appellant does not cite a single alleged error in the district court's analysis or factual findings, nor does he cite a single limitation

of the hypothetical claims that cannot be found in the prior art references cited by the district court. In the absence of such evidence, the Appellant has not met his burden of proving that the hypothetical claims are patentable over the prior art.

3. The District Court Properly Found That a Person of Skill in the Art Would Have Reason to Combine the Teachings of the Cited Prior Art References

Although the Appellant argues that an obviousness determination requires that "one of skill in the art would have reason to combine the references in a manner that would lead to the claims," Appellant's Brief at 34, he ignores the district court's discussion of this issue. As the district court noted, the Burns reference "describes various methods of designing, building, and maintaining a dock. A builder can pick and choose any combination of features to create the structure. Defendants contend that every element discussed in the book in relation to the accused docks does what it has always done and yields predictable results. This is sufficient to meet Defendants' production burden." Appx19. Even Appellant's own expert testified that it would be appropriate to combine the double-ear connection mechanism of the accused docks with the permanent docks like those disclosed in the '554 Patent or the Berquist reference:

> Q: Do you think this type of a [double-ear] connector for a dock that's not a floating dock is appropriate?
>
> Mr. Wentland: Absolutely.
>
> Q: Okay. There's no reason you can't translate it from a floating dock to a standing dock, right?

Mr. Wentland: No, there's none ….

Appx666 at 68:9-15.

The Appellant has done nothing to overcome the district court's conclusion of obviousness. Appellant does not argue that the hypothetical claims use known elements in a novel way, or to achieve a novel result. Nor does Appellant argue that the cited prior art references teach away from each other, that they will not work for their intended purpose if combined, or that another reasons bars a combination of their teachings. In short, the Appellant has failed to meet his burden of showing that the hypothetical claims are patentable over the prior art.

4. Secondary Considerations Do Not Warrant A Finding That the Hypothetical Claims are Not Obvious

Appellant suggests, without further explanation, that the hypothetical claims may be patentable in light of "evidence of secondary considerations presented at trial." Appellant's Brief at 38. However, the Appellant does not cite any such evidence of alleged secondary considerations. *Id.* In fact, no evidence of secondary considerations of the **hypothetical claims** was or could have been presented at trial. The Appellees' ensnarement defense was not presented to the jury, nor was there any discussion of the hypothetical claims at trial. Thus, secondary considerations do not warrant a finding that the hypothetical claims are not obvious.

5. The Validity of the Asserted Claims of the '554 Patent is Irrelevant

Finally, Appellant repeatedly argues that the district court erred by ignoring the testimony of Appellant and his expert that the invention claimed in the '554 Patent was "unique." *See, for example,* Appellant's Brief at 35 ("Defendants cannot ignore the testimony of Kahr and Wentland that the combination of elements for the '554 patent was unique"), 38-39, 40. This is irrelevant to the analysis of the patentability of the **hypothetical claims**, and betrays a fundamental misunderstanding of the ensnarement defense. The validity of the claims of the '554 Patent does not affect the ensnarement defense. *See*, *e.g.*, *DePuy*, 567 F.3d at 1323 (the "ensnarement inquiry … has no bearing on the validity of the actual claims").

C. THE DISTRICT COURT'S DECISION OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS MAY BE INDEPENDENTLY AFFIRMED BECAUSE PROSECUTION HISTORY ESTOPPEL BARS KAHR FROM ASSERTING INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

Even if this Court finds that the asserted equivalency is not ensnared by the prior art, the asserted equivalency is also barred by prosecution history estoppel. During prosecution, Appellant amended the claims to require "wherein each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener," because the only unique feature of the claimed dock was the single-fastener connection mechanism. Appx725-731.

The Appellant alleges that the limitation, "wherein each cylindrical rim and that portion of the side wall adjacent the rim has an aperture formed in it for receiving a fastener" can be met by the doctrine of equivalents. During prosecution, the Appellant added this precise language to the independent claims because the connection mechanism provided by the apertures was the only novel and allowable element. *See* Appx725-731. Appellant added this language to the independent claims because it was originally in dependent claims found to be allowable by the examiner. *Id.* Such amendments create prosecution history estoppel and presumptively bar the application of the doctrine of equivalents. *See Honeywell Int'l Inc. v. Hamilton Sunstrand Corp.*, 370 F.3d 1131, 1144 (Fed. Cir. 2004) (en banc) ("[T]he surrendered subject matter is defined by the cancellation of the independent claims that do not include a particular limitation and the rewriting into independent form of dependent claims that do include that limitation. Equivalents are presumptively not available with respect to that added limitation.").

The Appellant argued on summary judgment that the amendment bears no more than a "tangential" relationship to the asserted equivalent, and suggested that the amendment was made "to specify the height adjustment feature of the Kahr invention." However, the Appellant's purported rationale for the amendment is entirely absent from the prosecution history of the '554 patent and from the claims,

and appears to be an after-the-fact rationalization. Nowhere do the asserted claims recite a dock having an adjustable height, nor did Appellant so characterize the amendment during prosecution. *See* Appx725-731. Even if Appellant's actual intent was to distinguish his dock over the prior art as having an adjustable height, "the inquiry into whether a patentee can rebut the *Festo* presumption under the 'tangential' criterion focuses on the patentee's **objectively apparent reason for the narrowing amendment**." *Cross Med. Prods., Inc. v. Medtronic, Inc.*, 480 F.3d 1335, 1342 (Fed. Cir. 2007) (emphasis added). Such objective reasoning "should be discernible from the prosecution history of record, if the public notice function of a patent and its prosecution history is to have significance." *Id.* (quoting *Festo*, 344 F.3d at 1369). "If the prosecution history reveals **no reason** for the narrowing amendment, **the presumption is not rebutted**." *Honeywell*, 523 F.3d at 1316 (emphasis added).

In the remarks section of the Office Action Response, the only express reason given for amending the independent claims to include the language was "the Examiner having indicated that claims 2, 6, 7 and 11-15 would be allowable if rewritten in independent form." Appx705-706. The prosecution history thus provides **no reason** for the narrowing amendment, and the presumption of prosecution history estoppel with respect to the asserted equivalent **is not rebutted**. *See Energy Transp. Group, Inc. v. William Demant Holdings A/S*, 697

F.3d 1342, 1359 (Fed. Cir. 2012) ("The prosecution history in this case shows that the claim limitation at issue was added in response to a rejection of closely related claims, and provides no other explanation for the limitation. . . . This court requires a **strong showing**—not present on this record—to satisfy the 'very narrow' exception to prosecution history estoppel for amendments only tangentially related to the equivalent in question." (emphasis added) (quoting *Cross Med. Prods.*, 480 F.3d at 1342).

The Appellant has not satisfied the "very narrow" tangential exception to prosecution history estoppel. The Appellant's purported reasoning for amending the claim language to exclude the asserted equivalent is based on an ex post facto and unsupported rationalization. There is no objective evidence in the prosecution history supporting this alleged reason for the amendment, or any other reason for the amendment beyond restricting the claims to Appellant's unique connection mechanism. Accordingly, even if this Court finds that the asserted equivalent is not ensnared by the prior art, this Court should find that the prosecution history estoppel bars the Appellant from asserting the double-ear connection mechanism as an equivalent, and affirm the district court's judgment on that ground.

CONCLUSION AND RELIEF SOUGHT

For the foregoing reasons, this Court should affirm the district court's summary judgment of no literal infringement, and the district court's judgment of non-infringement under the doctrine of equivalents as a matter of law.

Respectfully submitted,

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CERTIFICATE OF FILING AND SERVICE

I hereby certify that, on this 17th day of April, 2017, I electronically filed the foregoing Brief of Appellees with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered users.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be deposited with Federal Express for delivery to the Clerk, United States Court of Appeals for the Federal Circuit, 717 Madison Place, N.W., Washington, D.C., 20439.

Dated: April 17, 2017

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Fed. R. App. P,. 32(a)(7)(B) because it contains 12,819 nwords, excluding the parts of the brief exempted by Fed. R. App. P. 32 (a)(7)(B)(iii). This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman.

Dated: April 17, 2017

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