2014-1175, -1177

In The
United States Court of Appeals
For The Federal Circuit

SHIELDMARK, INC.,

Plaintiff – Appellant,

v.

INSITE SOLUTIONS, LLC,

Defendant – Appellee.

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO IN NO. 1:12-CV-00223-DCN AND NO. 1:13-CV-00572-DCN, JUDGE DONALD C. NUGENT.

REPLY BRIEF OF APPELLANT

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ARGUMENT

I. THE DISTRICT COURT ERRED IN CONSTRUING CLAIM 2'S REFERENCE TO A "DOUBLE-SIDED ADHESIVE LAYER" TO REQUIRE "A LAYER OF NON-ADHESIVE MATERIAL WITH ADHESIVE ON BOTH SIDES."

In its Brief, InSite argues that the district court correctly concluded that a "double sided adhesive layer" could not possibly consist of an adhesive alone, but must also include some other intermediate material to which adhesive is applied. As set forth in detail in ShieldMark's primary brief, there are no facts contained in the record which support the factual finding that a layer of "adhesive" cannot have multiple "sides." Both InSite and the district court ignored the fact that the inventor had similarly articulated the concept of "a layer of adhesive with two sides" in Claim 1, by claiming "a layer of pressure sensitive adhesive comprising a first side and an opposed second side." Despite the unambiguous intentions of the inventor, the district court nevertheless concluded that "[t]here has been no showing that there is any differentiation between a single sided and double sided adhesive" and that "it appears from the evidence and arguments presented that 'adhesive' is generally a term for an adhesive material that is sticky throughout without regard to shape or surface configuration." (JA, pp. 165-166). If the district court had followed this reasoning to its logical conclusion, it should have adopted ShieldMark's proposed construction of "a layer with adhesive on both

sides." However, the district court and InSite changed course and erroneously elected to re-write the claim term to include an additional layer of non-adhesive.

It is apparent from InSite's Brief that both InSite and the district court mistakenly limited the element "double sided adhesive layer" to a single example from the patent specification, specifically the "double sided carpet tape (Product #591B) from International Tape Co." (JA, p. 89; see also JA, pp. 136-137, 164, 166). InSite explicitly argues that the claim should be limited to this particular embodiment so that the "'double sided adhesive layer' is 'a layer of non-adhesive material [such as cloth in the product specification] with adhesive on both sides.'" (InSite's Brief at p. 19). InSite's position is contrary to law. While it is true that a court may limit the meaning of a claim term if the patentee clearly sets forth the definition in the written description, the description of the preferred embodiment is only one example of the claimed invention that is consistent with the ordinary meaning of the claim terms not a limitation. See, e.g., *Johnson Worldwide Assocs.*, *Inc. v. Zebco Corp.*, 175 F.3d 985, 990, 50 USPQ2d 1607, 1608–09 (Fed. Cir. 1998). Claim terms take on their ordinary and accustomed meanings unless the patentee demonstrates an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic evidence using words or expressions of manifest exclusion or restriction, representing clear disavowal of claim scope. *Teleflex*, *Inc. v. Ficosa*

North America Corp., 299 F.3d 1313, 1327, 63 USPQ2d 1374, 1382 (Fed. Cir. 2002). Although this Court has recognized that "there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification" *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186–87 (Fed. Cir. 1998), it is improper to read a limitation from the specification into the claims. *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 345 F.3d 1318, 1327 (Fed. Cir. 2003); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1343 (Fed. Cir. 2001).

Here, the written description contains no "words or expressions of manifest exclusion or restriction, representing clear disavowal of claim scope" and this Court should reject and reverse the district court's conclusion that the term "double sided adhesive layer" should be defined as limited to "a layer of non-adhesive material with adhesive on both sides" and instead adopt the plain meaning or the construction offered by ShieldMark, "a layer with adhesive on both sides". The specification does not define "double sided adhesive layer" restrictively, nor is there anything in the specification that supports the district court's conclusion that the term must include an intermediate layer of non-adhesive.

InSite fails to adequately distinguish *Tandon Corp. v. U.S. International Trade Commission*, 831 F.2d 1017 (Fed. Cir. 1987) and incorrectly argues that "the claim terms are consistent with the patent specification and claims, and no

declarations to the contrary were made by applicant." (InSite's Brief at p. 20). The plain language of the claim, "double sided adhesive layer," is sufficient without the addition of the "non-adhesive layer" advocated by InSite and adopted by the trial court. The "double sided adhesive layer" is simply an adhesive layer which is sticky on both sides, *i.e.*, double sided, and does not require the new element of a "layer of non-adhesive material." Nothing more needs to be said other than that the layer has two adhesive sides. The district court erred in importing the additional element of a non-adhesive material into the "double sided adhesive layer" of Claim 2. Nothing in the '480 Patent supports the district court's import of a "non-adhesive material" into the claim. To the contrary, every aspect of the '480 Patent is consistent with construction of the "double sided adhesive layer" as "a layer with adhesive on both sides," as argued by ShieldMark. As the plain language of the '480 Patent demonstrates, the claim term "double sided adhesive layer" means a layer that is sticky on both sides and no more. There was no basis to import a "layer of non-adhesive material" between the two sticky sides as an extraneous limitation on Claim 2 of the '480 Patent. Accordingly, the district court's construction of Claim 2 should be reversed.

II. THE DISTRICT COURT ERRED IN DETERMINING THAT SHIELDMARK COULD NOT ESTABLISH INFRINGEMENT OF THE "DOUBLE SIDED ADHESIVE LAYER" CLAIM LIMITATION OF CLAIM 2 THROUGH APPLICATION OF THE DOCTRINE OF EQUIVALENTS.

A. The District Court Erred By Concluding That Claim Vitiation Is An Exception to the Doctrine of Equivalents.

InSite argues in its Brief that "vitiation" prevents ShieldMark from asserting that its layer of adhesive is equivalent to a layer of non-adhesive between two additional adhesive layers. However, vitiation cannot bar the application of the doctrine of equivalents because, when properly considered, vitiation itself requires analysis of the doctrine of equivalents. InSite cannot dispute that its argument has been previously rejected by this Court in *Deere & Co. v. Bush Hog*, *LLC*, 703 F.3d 1349, 1356 (Fed. Cir. 2012) and *Brilliant Instruments*, *Inc. v. GuideTech*, *LLC*, 707 F.3d 1342, 1347 (Fed. Cir. 2013). As this Court clearly explained, "[t]he proper inquiry for the court is to apply the doctrine of equivalents, asking whether an asserted equivalent represents an insubstantial difference from the claimed element, or whether the substitute element matches the function, way, and result of the claimed element." *Brilliant*, 707 F.3d at 1347 (quoting *Deere*, 703 F.3d at 1356). This Court went on to note that the proper inquiry for a district court is to apply the doctrine of equivalents in the form of the "insubstantial differences" or "function, way, result" tests and that vitiation should not be used to avoid this analysis. Applying this test, InSite's layer of adhesive is equivalent to a layer of

non-adhesive between two additional adhesive layers under the doctrine of equivalents. Therefore, under *Greene* and *Brilliant*, ShieldMark is not foreclosed from asserting infringement under the doctrine of equivalents and the proper inquiry is to apply the "insubstantial differences" and "function, way, result" tests.

InSite does not address any of these substantive issues regarding the doctrine of equivalents analysis in its Brief. Rather, it simply argues that the construed requirement of a "layer of non-adhesive" would be "vitiated" if its layer of adhesive could be contained within the doctrine of equivalents because a layer of non-adhesive between two additional adhesive layers is the "antithesis" of a layer of adhesive. In other words, InSite merely asserts that an application of the doctrine of equivalents to InSite's layer of adhesive would vitiate the construed requirement of a "layer of non-adhesive" because InSite's products do not literally satisfy that limitation. Although this Court has previously held that a claim limitation may, in certain cases, exclude its opposite from equivalence, the facts in this case do not support the application of this precedent. InSite cannot seriously argue that a layer of non-adhesive between two additional adhesive layers is the "antithesis" of a layer of adhesive in the same way as "before" cannot be equivalent to "after" or "mounted" cannot be equivalent to "unmounted" or a "minority" cannot be equivalent to a claim requiring "a majority." See, *Planet Bingo, LLC v. Gametech Int'l, Inc.*, 472 F.3d 1338, 1345 (Fed. Cir. 2006); *Asyst*

Technologies, *Inc. v. Emtrak*, *Inc.*, 402 F.3d 1188, 1195 (Fed. Cir. 2005); *Moore U.S.A.*, *Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000).

Contrary to InSite's argument, "[a] claim element is not vitiated merely because it does not literally exist in the accused product." *Abbott Labs. v. Andrx Pharms.*, *Inc.*, 473 F.3d 1196, 1212 (Fed. Cir. 2007). If it were, a patentee could never assert infringement under the doctrine of equivalents. See, *DePuy Spine*, *Inc. v. Medtronic Sofamor Danek*, *Inc.*, 469 F.3d 1005, 1018 (Fed. Cir. 2006) (explaining that the vitiation doctrine does not foreclose application of the doctrine of equivalents "whenever a claim limitation does not literally read on an element of an accused device" because "such an interpretation . . . would swallow the doctrine of equivalents entirely"). This is true because in every case where the doctrine of equivalents applies, the accused product or method does not literally meet at least one claim element. See, e.g., *Ethicon Endo-Surgery*, *Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317 (Fed. Cir. 1998) ("[A]ny analysis of infringement under the doctrine of equivalents necessarily deals with subject matter that is 'beyond,' 'ignored' by, and not included in the literal scope of a claim.").

The law "forbids not only exact copies of an invention, but [also] products that go to the heart of an invention but avoid [ ] the literal language of the [patent's] claim[s] by making a noncritical change." *Markman v. Westview Instruments*, *Inc.*, 517 U.S. 370, 373 (1996) (internal quotation marks and citation

omitted). Here, the "heart" of the invention in Claim 2 is the specific combination of thickness, hardness and peel adhesion of the polymer tape, not the nature of the adhesive used to secure that tape to a floor. In the Reasons for Allowance, the Patent Examiner acknowledged the significance of these particular characteristics and noted "the uniquely distinct features of a substrate that include a polymer layer having a Shore A Hardness of 92 to 100 and an uniform thickness of about 0.020" to 0.065", an adhesive layer attached to the polymer layer, wherein the adhesive has a peel adhesion greater than 2.0 lb/in width when peeled at 90 degree angle." (R. 42-3, Case No. 1:12-cv-00223, PageID#: 1007). The accused products blatantly copy these distinctive features and merely provide an insignificant alternative mechanism for adhering the polymer tape to the floor. ShieldMark offered substantial evidence, including testimony from its expert, Dr. Serra, that a single layer of adhesive is functionally equivalent to a layer of non-adhesive with adhesive on each side. (JA, p. 276). A jury could therefore reasonably conclude that a single layer of adhesive is not substantially different from a layer of non-adhesive with adhesive on each side, and this theory of equivalence would not "entirely vitiate a particular claim element." *Id*. at 39, 117 S. Ct. at 1053 n. 8.

The dispute of fact that exists here is precisely the type of factual dispute that this Court has previously relied upon in rejecting similar "vitiation" arguments and allowing the doctrine of equivalents issue to proceed to the jury. See, e.g.,

Cordis Corp. v. Boston Scientific Corp., 561 F.3d 1319, 1329-30 (Fed. Cir. 2009) (agreeing with the district court that vitiation did not bar application of the doctrine of equivalents where the term "corners" was construed to mean "a place where two surfaces meet to form an angle"); *DePuy Spine*, 469 F.3d at 1018-20 (reversing the district court's grant of summary judgment of non-infringement for at least the reason that "[Plaintiff's] expert presented particularized declarations demonstrating its theory that a specific element of the accused device . . . was insubstantially different from the corresponding . . . limitation" of an asserted claim); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 845, 849-50 (Fed. Cir. 2006) (rejecting vitiation argument that a "dome" could not be equivalent to a "plate" after the district court construed "plate" to mean "a structural element of relatively uniform thickness and flatness which may also have some moderate curvature to it"); *Metso Minerals, Inc. v. Powerscreen Int'l Dist. Ltd.*, No. 06-cv-1446, 2011 WL 6223047, at *14 (E.D.N.Y. Dec. 8, 2011) (finding the vitiation doctrine inapplicable and rejecting "the Defendants' argument that there is a binary difference between conveyors that extend beyond the chassis and those that do not"). Under these circumstances, the vitiation doctrine does not apply and a reasonable jury could find that a single layer of adhesive is not substantially different from a layer of non-adhesive with adhesive on each side and this theory of equivalence would not "entirely vitiate a particular claim element." *Id.* at 39, 117 S. Ct. at 1053 n. 8. This

Court should reverse the decision of the district court granting summary judgment and remand for further consideration of that issue.

B. The District Court Erred In Failing to Apply the Doctrine of Equivalents and the "Function-Way-Result" Test to Determine Whether a Genuine Issue of Fact Existed Regarding Whether InSite's Product Infringed on Claim 2 of the '480 Patent.

"Infringement, either literal or under the doctrine of equivalents, is a question of fact." *Brilliant Instruments*, *Inc. v. GuideTech*, *LLC*, 707 F.3d 1342, 1344 (Fed. Cir. 2013). ShieldMark clearly established an issue of fact regarding whether InSite's product contained an equivalent of the "double sided adhesive layer" claimed in Claim 2 of ShieldMark's product. A reasonable jury could decide that the two were equivalents, and that a tape will stick to both the floor and the polymer layer, irrespective of whether the tape contains a layer of adhesive, sticky on both sides, and whether the tape includes a "non-adhesive material" with adhesives on both sides. It was for the jury to decide whether a "non-adhesive material" sandwiched between layers of adhesive was an insubstantial difference from the "double sided adhesive layer" referenced in the '480 Patent.

The district court incorrectly stated that "there is no evidence to suggest that a single layer adhesive would have worked in the same 'way' as a double-sided adhesive in the Plaintiff's product." (R. 92, Case No. 1:12-cv-00223, PageID#: 1764 n. 3). To the contrary, Dr. Serra's opinion specifically states that the method

of securing the tape to the floor used by the InSite product is substantially equivalent to the '480 Patent's method of attaching the tape to the floor, a fact which was ignored by both InSite and the district court. (JA, pp. 373-374). The evidence and expert opinion presented to the district court was significant evidence that the adhesive layer of the InSite product performed with the same "function-way-result" as the "double sided adhesive layer" of the '480 Patent and a finder of fact could certainly have concluded that the doctrine of equivalents was satisfied. On summary judgment, courts must "credit all of the non-movant's evidence and draw all justifiable inferences in its favor." *Brilliant Instruments, Inc.*, 707 F.3d at 1344. The district court did not do this. Genuine issues of fact existed, and summary judgment was improper.

III. THE DISTRICT COURT ERRED IN CONCLUDING THAT NO GENUINE ISSUES OF MATERIAL FACT EXISTED WITH REGARD TO WHETHER THE DEFENDANT'S PRODUCT WAS OF A "SUBSTANTIALLY UNIFORM THICKNESS" AS REQUIRED BY CLAIM 5 OF THE '480 PATENT AND CLAIMS 1 THROUGH 3 OF THE '292 PATENT.

InSite argues that the recess, steps, radius and taper in the accused products are both structurally and functionally significant and references the district court's erroneous determination that, in InSite's words, there was "an absolute dearth of evidence advanced by ShieldMark to challenge the presence of significant steps in accused products." (InSite's Brief at p. 34). Both InSite and the district court refused to acknowledge ShieldMark's evidence to the contrary, including expert

testimony that the recess, steps, radius and taper features were not structurally or functionally significant. The district court incorrectly stated that ShieldMark had provided no evidence whatsoever regarding the thickness of the InSite product vis-à-vis the steps (R. 92, Case No. 1:12-cv-00223, PageID #:1770) ("[p]laintiff has presented no evidence that would suggest that the steps and tapering are not significant") and inappropriately rejected Dr. Serra's opinion that, based on his expert testing and analysis, the InSite accused product was without "significant deviations, protrusions or steps" thereby reading on the construed claim. (JA, pp. 370-371). On summary judgment, courts must "credit all of the non-movant's evidence and draw all justifiable inferences in its favor." *Brilliant Instruments, Inc.*, 707 F.3d at 1344. The district court did not do this. Rather than credit Dr. Serra's expert opinion and allow the jury to decide if the variation in the thickness caused by the steps was "significant," the district court became the fact finder and decided that as a matter of fact the steps were "significant."

InSite argues that ShieldMark's expert "inexplicably addressed the steps in terms of their area and weight." (InSite's Brief at p. 34). But Dr. Serra explained at length his rationale and analysis of area and weight to assess the significance of the edge features in the accused products. He testified during his deposition that based on his "forty years of experience in the adhesive industry… measuring thickness can be very difficult at times, so whenever there's a dispute about

thickness, then we go to weight because weight, there's no question about weight." (JA, pp. 290 - 291). For this reason, Dr. Serra calculated that the step features "account for less than 1% of the overall weight of the polymer: roughly 0.039% for a four-inch wide tape." (JA, p. 371). To confirm his calculations based on weight, Dr. Serra then performed a first approximation of the accused polymer based on area. Here he calculated that the steps featured in the InSite product "account for less than 1% of the overall area of the polymer layer: roughly 0.57% for a four-inch wide tape" and roughly 1.16% of the area of the polymer layer for the two-inch product. (*Id.*) Based on the similarity of his findings on weight and area, Dr. Serra concluded that "[a] variation of a single percentage point or less for area and weight is not a 'significant deviation, protrusion or step' in my opinion." (*Id.*).

Nevertheless, the district court discounted Dr. Serra's opinions and analysis on the ground that "Dr. Serra's report does not address the significance of the steps and tapering of the accused product relative to the overall thickness of the product." (R. 92, Case No. 1:12-cv-00223, PageID #:1769). This is wholly incorrect because Dr. Serra clearly opined that 95 % of InSite polymer layer was of "substantially uniform thickness" and a single percentage point or less for area and weight is not a 'significant deviation, protrusion or step' in my opinion." (JA, pp, 369, 370-371).

The district court clearly viewed functional significance as dispositive and noted that Dr. Serra "did not address functional significance in his report." (R. 92, Case No. 1:12-cv-00223, PageID #:1769). Dr. Serra did not address the functional significance of the steps in his report because function was irrelevant to the claim limitation he was addressing; specifically, Dr. Serra was assessing whether the accused products met the thickness element claimed, construed as "include a largely, but not necessarily wholly, uniform distance between the upper surface and the lower surface without significant deviations, protrusions, or steps, between 0.020″ and 0.065″". (JA, p. 370). Even so, Dr. Serra did testify in his deposition that the "step" in the accused products would not ultimately function as argued by defendant, preventing the adhesive from oozing out underneath the edge. (JA, p. 334) ("while [the edge] may retard it or slow [the spread of adhesive], with time it's going to ooze because [the adhesive is] pressure sensitive."). In other words, Dr. Serra actually considered, rejected and contradicted the idea that the edge features prevent ooze. (*Id.*).

The district court's evaluation of the record the summary judgment standard. "The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor." *Anderson v. Liberty Lobby*, *Inc.*, 477 U.S. 242, 255 (1986). The district court erred on both prongs of this standard when it ignored evidence of plaintiff's expert Dr. Serra that "more than 95% of the Superior

Mark product includes a polymer layer with a thickness literally in the claimed range . . . ." (JA, p. 370). The remaining tapered "edge feature" comprised the remaining 5% of the accused product and constituted less than 1 % of its overall weight and area – deemed more reliable by ShieldMark's expert. (JA, pp. 370-371). This contradicts the district court's claim that ShieldMark offered no evidence "relative to the thickness of the product." (R. 92, Case No. 1:12-cv-00223, PageID #: 1770). This Court should reverse the decision of the district court granting summary judgment and remand for further consideration of that issue.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

The district court's decision on Claims 2 and 5 of the '480 Patent were dispositive of all claims in the case. The district court's erroneous construction of the term "double sided adhesive" in Claim 2 of the '480 Patent to mean to "a layer of non-adhesive material with adhesive on both sides led to the district court's erroneous ruling that InSite's product did not literally infringe on this claim limitation. Since the district court's claim construction required a "layer of non-adhesive material" – a characteristic absent from InSite's product, the district court's claim erroneous construction essentially granted summary judgment for InSite on the issue of literal infringement.

The district court compounded this error by finding that the concept of claim vitiation precluded ShieldMark from arguing that the doctrine of equivalents established that InSite's product this claim limitation of the '480 Patent. Without this erroneous application of the doctrine of claim vitiation, issues of fact would have precluded the district court from granting summary judgment in InSite's favor on the application of the doctrine of equivalents.

Finally, with respect to Claim 5, the district court erred in granting summary judgment to InSite on the issue of whether the polymer layer of InSite's product was of a "substantially uniform thickness" as set forth in both claim 5 of the '480 Patent and claim 1 of the '292 Patent. ShieldMark presented expert testimony and analysis that 95 % of the InSite product was of a "substantially uniform thickness" within the range specified in the '480 Patent. ShieldMark also presented expert testimony that the InSite product's "step feature" accounted for less than 1% of the overall weight and less than 1% of the overall area of the polymer layer in support of the expert opinion that the "step feature" was not a "significant deviation, protrusion or step". Although these were factual issues, the district court, in the face of conflicting evidence, resolved the disputed facts and granted summary judgment for InSite.

For the reasons set forth more fully hereinabove, the judgment of the district court should be reversed, and the cases remanded for further proceedings.

Respectfully submitted,

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CERTIFICATE OF FILING AND SERVICE

I hereby certify that on this 27th day of May, 2014, I caused this Reply Brief of Appellant to be filed electronically with the Clerk of the Court using the CM/ECF System, which will send notice of such filing to the following registered CM/ECF users:

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Upon acceptance by the Clerk of the Court of the electronically filed document, the required number of copies of the Reply Brief of Appellant will be hand filed at the Office of the Clerk, United States Court of Appeals for the Federal Circuit in accordance with the Federal Circuit Rules.

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Dated: May 27, 2014

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