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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION

RAYMOND CALUORI,  
Plaintiff,  
vs.  
ONE WORLD TECHNOLOGIES, INC.,  
ET AL.,  
Defendants.

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Case No. CV07-2035 CAS (VBKx)

**ORDER DENYING PLAINTIFF'S  
AND DEFENDANTS' CROSS  
MOTIONS FOR SUMMARY  
JUDGMENT AS TO  
INFRINGEMENT AND GRANTING  
DEFENDANT'S MOTION FOR  
SUMMARY JUDGMENT AS TO  
DAMAGES LIMITATION**

**I. INTRODUCTION**

Plaintiff Raymond Caluori (“plaintiff”) filed the instant action against defendants Ryobi Limited, Techtronic Industries, Co. Ltd, and Does 1 through 100 on March 3, 2007. On May 5, 2007, plaintiff filed its first amended complaint against defendants Ryobi North America, Ryobi Technologies Inc., Techtronic Industries North America, Ryobi Limited, Techtronic Industries Co. Ltd, and Does 1 through 100. On July 11, 2007, plaintiff filed its second amended complaint against One World Technologies, Inc (“OWT” or “defendant”), Ryobi Limited, Ryobi North America, Inc., and Does 1

1 through 100 alleging claims for (1) patent infringement and (2) willful infringement of  
2 patent.

3 This Court issued a Markman order interpreting the claims of the patent on  
4 November 12, 2010. Dkt. 116.

5 On July 22, 2011, the parties filed cross-motions for summary judgment regarding  
6 patent infringement and scope of damages. On August 11, 2011, the parties each filed  
7 oppositions to the other party's motion. On August 29, 2011, the parties' each filed  
8 replies. The parties' cross motions are presently before the Court and pertain to various  
9 matters addressed below.

## 10 **II. BACKGROUND**

11 This action arises from the alleged infringement of U.S. Patent 6,915,727, entitled  
12 "Angled Light Beam Rotary Saw Cut Alignment Device" ("the '727 patent").

13 On July 12, 2005, the United States Patent and Trademark Office issued the '727  
14 patent to Raymond Caluori in response to an application filed July 29, 2002, claiming  
15 priority to a provisional application filed July 31, 2001. '727 patent, col. 1, 5–10. The  
16 patent concerns a device that uses a battery powered light source to project light onto an  
17 object to be cut by a rotary saw in order to align the cut of the saw. Id. at col. 1, 10–15,  
18 31–32.

19 Plaintiff's second amended complaint contends that defendant deliberately copied  
20 plaintiff's patented device, known as the BladePoint, and that defendant promoted,  
21 marketed and sold an infringing device. Defendant responds by challenging the validity  
22 of plaintiff's patent and by arguing that defendant's device lacked the elements required  
23 for literal infringement. Furthermore, defendant argues that to the extent its device in  
24 fact infringed plaintiff's patent, plaintiff's damages should be limited due to plaintiff's  
25 failure to properly mark his device upon receiving the '727 patent.

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1 **III. LEGAL STANDARD**

2 **A. Summary Judgment**

3 Summary judgment is appropriate where “there is no genuine issue as to any  
4 material fact” and “the movant is entitled to a judgment as a matter of law.” Fed. R. Civ.  
5 P. 56(c). The moving party has the initial burden of identifying relevant portions of the  
6 record that demonstrate the absence of a fact or facts necessary for one or more essential  
7 elements of each cause of action upon which the moving party seeks judgment. See  
8 Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986).

9 If the moving party has sustained its burden, the nonmoving party must then  
10 identify specific facts, drawn from materials on file, that demonstrate that there is a  
11 dispute as to material facts on the elements that the moving party has contested. See  
12 Fed. R. Civ. P. 56(c). The nonmoving party must not simply rely on the pleadings and  
13 must do more than make “conclusory allegations [in] an affidavit.” Lujan v. Nat’l  
14 Wildlife Fed’n, 497 U.S. 871, 888 (1990). See also Celotex Corp., 477 U.S. at 324.  
15 Summary judgment must be granted for the moving party if the nonmoving party “fails  
16 to make a showing sufficient to establish the existence of an element essential to that  
17 party’s case, and on which that party will bear the burden of proof at trial.” Id. at 322.  
18 See also Abromson v. Am. Pac. Corp., 114 F.3d 898, 902 (9th Cir. 1997).

19 In light of the facts presented by the nonmoving party, along with any undisputed  
20 facts, the Court must decide whether the moving party is entitled to judgment as a matter  
21 of law. See T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass’n, 809 F.2d 626, 631  
22 & n.3 (9th Cir. 1987). When deciding a motion for summary judgment, “the inferences  
23 to be drawn from the underlying facts . . . must be viewed in the light most favorable to  
24 the party opposing the motion.” Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475  
25 U.S. 574, 587 (1986) (citation omitted); Valley Nat’l Bank of Ariz. v. A.E. Rouse & Co.,  
26 121 F.3d 1332, 1335 (9th Cir. 1997). Summary judgment for the moving party is proper  
27 when a rational trier of fact would not be able to find for the nonmoving party on the  
28 claims at issue. See Matsushita, 475 U.S. at 587.

1 **IV. DISCUSSION**

2 **A. Validity of the ‘727 patent**

3 **1. Anticipation of the ‘727 patent**

4 Defendant argues that the ‘727 patent is invalid because defendant’s December  
5 2000 prototype anticipated plaintiff’s BladePoint device. Def. Mot. 14–23.

6 A patent claim is invalid as anticipated “if each and every limitation is found  
7 either expressly or inherently in a single prior art reference.” Celeritas Techs. Ltd. v.  
8 Rockwell Int’l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). Although anticipation is a  
9 question of fact, it may be decided on summary judgment if the record reveals no  
10 genuine dispute of material fact. Telemac Cellular Corp. v. Topp Telecom, Inc., 247  
11 F.3d 1316, 1327 (Fed. Cir. 2001).

12 It is undisputed that in the fall of 2000, defendant set out to create its own laser  
13 alignment device for which it filed a patent application on May 18, 2001. Plaintiff’s  
14 Statement of Genuine Issues (“PSGI”) ¶¶ 24–32 (undisputed). David Peot, one of  
15 OWT’s engineers at the time, was named as the lead inventor on that patent, U.S. Patent  
16 No. 6,7555,107 (the “Peot patent”). Id. ¶ 33.

17 According to defendant, the laser device that is accused of infringement is the  
18 commercial embodiment of the Peot patent. DSUF ¶ 35; Declaration of Richard  
19 Marschall (“Marschall Decl.”), Ex. 22 (sample of accused device); Declaration of David  
20 Peot (“Peot Decl.”), ¶¶ 12–13, Ex. G (Peot patent, Figures 9, 10). Plaintiff disputes this,  
21 contending that unlike defendant’s accused device, the Peot patent did not include the  
22 raised support arms of claim 1 of the ‘727 patent. PGSI ¶ 35.

23 Defendant contends that in plaintiff’s interrogatory responses plaintiff identified  
24 the screw bosses in the cover as two of the alleged raised support arms in defendant’s  
25 accused device. DSUF ¶ 110; Marschall Decl. Ex. 19 (Caluori Dep. Ex. 26). Defendant  
26 also contends that plaintiff’s experts confirmed that the screw bosses in the cover alone  
27 constitute the “raised support arms” of claim 1. DSUF ¶ 111–13; Marschall Decl., Ex.  
28 10 (Lynch depo., 126:10–13); Marschall Decl., Ex. 11 (Carman depo., 92:12–93:9).

1 Plaintiff responds that in his response to defendant’s interrogatories regarding  
2 defendant’s accused device, plaintiff identified jointly the screw bosses in the cover and  
3 support arms extending above the base as the “raised support arms.” PSGI ¶ 110.  
4 Moreover, plaintiff contends that his expert, UCLA professor of mechanical and  
5 aerospace engineering Christopher Lynch, specifically denied that the screw bosses in  
6 the cover of defendant’s accused device alone constituted support arms. Id. ¶ 111;  
7 Supplemental Declaration of Erwin Adler (“Adler Supp Decl.”), Ex. II (Lynch depo. at  
8 114:15–116:11) Plaintiff also asserts that another expert, UCLA professor of  
9 mechanical & aerospace engineering Gregory Carman, similarly indicated in his  
10 deposition that the screw bosses in the cover of the accused device and the support arms  
11 in its base jointly formed the support arms that infringed the ‘727 patent. PSGI ¶ 111;  
12 Adler Supp. Decl., Ex. EE (Carman depo. at 88:19–91:10).

13 Defendant first argues that if the claims of the ‘727 patent are read broadly enough  
14 to cover defendant’s accused device, then the asserted claims are anticipated by  
15 defendant’s prototype under 35 U.S.C. § 102(a) or § 102(g)(2) because: (1) defendant’s  
16 prototype was conceived and reduced to practice in late 2000, prior to the earliest  
17 possible March 2001 conception of claim 1 of the ‘727 patent; (2) defendant’s prototype  
18 included all relevant elements of the accused device; and (3) plaintiff’s attempt to  
19 predate defendant’s conception with an alleged December 1999 prototype lacks claim  
20 elements and corroboration sufficient to establish plaintiff’s alleged 1999 conception.  
21 Def. Mot. at 14–15.<sup>1</sup>

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24 <sup>1</sup> On September 1, 2011, defendant filed an Ex Parte application to strike and  
25 exclude references to plaintiff’s alleged 1999 prototype. The application is based on upon  
26 plaintiff’s belated disclosure of the prototype, failure to properly disclose related witnesses,  
27 and refusal to produce the prototype for inspection. The Court finds these grounds  
28 insufficient for excluding the prototype. Moreover, even if the 1999 prototype were  
excluded, the Court would reach the same result as the Court’s determination is premised  
on the existence of a triable issue of fact regarding whether defendant’s Peot patent  
(continued...)

1 A prior invention containing all elements of the claimed invention will anticipate  
2 under 35 U.S.C. § 102(a) if the knowledge or use of the prior invention is accessible to  
3 the public. Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir.  
4 1998). Exposure to customers, as well as any non-secret use of the invention in its  
5 natural intended way, constitutes public use. Nordberg Inc. v. Telsmith, Inc., 881 F.  
6 Supp. 1252, 1283–84 (E.D. Wis. 1995). A prior invention containing all elements of the  
7 claimed invention will anticipate under 35 U.S.C. § 102(g)(2) if the prior invention was  
8 (1) reduced to practice first, or (2) conceived of first and then diligently reduced to  
9 practice. Mycogen Plant Sci., Inv. v. Monsanto Co., 243 F.3d 1345, 1353 (Fed. Cir.  
10 2001). However when the prior art was before the examiner during prosecution of the  
11 application, “there is a particularly heavy burden in establishing invalidity.” Impax  
12 Labs., Inc. v. Aventis Pharms., Inc., 468 F.3d 1366, 1378 (Fed. Cir. 2006).

13 It is undisputed that defendant developed a prototype laser device by December  
14 2000, and that defendant exposed its device to its customer, Sears. PSGI ¶ 102–104  
15 (undisputed). Whether defendant’s device constitutes prior art under 102(a) and/or  
16 102(g)(2) therefore turns on whether defendant’s device included all of the claim  
17 limitations of the ‘727 patent.

18 The parties’ main dispute regarding whether defendant’s December 2000  
19 prototype included each and every claim limitation of the ‘727 patent appears to be  
20 whether the prototype included the “raised support arms” of claim 1.

21 Defendant contends that its accused device is the commercial embodiment of its  
22 December 2000 prototype, and argues that plaintiff therefore cannot consistently assert  
23 in his infringement case that the structure in the accused device meets the “raised  
24 support arms” claim limitation while at the same time asserting in his validity case that  
25 the structure in the defendant’s prototypes does not meet the “raised support arms”  
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27 <sup>1</sup>(...continued)  
28 included all of the claim limitations of the ‘727 patent.

1 limitation. Def. Mot. at 18–19. Relying on Smithkline Beecham Corp. v. Apotex Corp.,  
2 403 F.3d 1331, 1341 (Fed. Cir. 2005), defendant argues that “that which would literally  
3 infringe if later in time anticipates if earlier.” Def. Mot. at 19.

4 Plaintiff responds that defendant’s December 2000 prototype was before the  
5 Patent and Trademark Office examiner when the PTO decided to issue the ‘727 patent to  
6 plaintiff, and therefore that defendant bears a particularly heavy burden in establishing  
7 invalidity. Pl. Opp. at 21 (citing Impax Labs., 468 F.3d at 1378). Moreover, plaintiff  
8 points to his interrogatory response and the conclusions of his experts, Gregory Carman  
9 and Christopher Lynch, to support the proposition that defendant did not add projections  
10 extending from the base of its device until late 2001, which combined and connected  
11 with the screw bosses in the cover of the device to constitute the support arms that  
12 allegedly infringed the ‘727 patent. Id. at 25–26.

13 The circumstances of this case do not warrant a finding as a matter of law that the  
14 defendant’s December 2000 prototype included all claim limitations of the ‘727 patent.  
15 Unlike in Smithkline Beecham, where the practice of the prior art necessarily created the  
16 substance sought to be patented, in this case, to the extent defendant’s December 2000  
17 prototype did not contain raised support arms, the use of that device would not infringe  
18 the ‘727 patent. The conclusions of plaintiff’s experts Lynch and Carman as well as the  
19 fact that the PTO awarded plaintiff the ‘727 patent when defendant’s prototype was  
20 before the examiner, constitute sufficient evidence for a rational jury to determine that  
21 defendant’s prototype did not contain each and every claim limitation of the ‘727 patent.

22 On the other hand, the conflicting evidence provided by defendant could permit a  
23 rational jury to determine that defendant’s prototype contained all claim limitations of  
24 the ‘727 patent and therefore anticipated plaintiff’s invention. Accordingly, summary  
25 judgment for plaintiff is also inappropriate.

26 In light of the Court’s determination that a triable issue of fact exists as to whether  
27 defendant’s December 2000 prototype included each and every claim limitation of the  
28 ‘727 patent, the Court finds that it is unnecessary to reach defendant’s arguments that

1 plaintiff cannot provide adequate corroboration that his conception date was December  
2 1999 or that plaintiff's December 1999 device did not include all claim limitations of the  
3 '727 patent.

## 4                   **2.     Statutory bar 102(b)**

5           Defendant next argues that plaintiff's 1999 prototype invalidates the '727 patent  
6 under 35 U.S.C. § 102(b), the statutory bar to patentability for a patentee's device in  
7 public use in this country more than one year prior to filing. Def. Mot. 23.

8           A patentee's own claimed invention will anticipate under § 102(b) where the  
9 claimed invention was in public use in this country more than one year prior to his date  
10 of filing for a patent. 35 U.S.C. 102(b); see e.g., Clock Springs, L.P. v. Wrapmaster,  
11 Inc., 560 F.3d 1317, 1325 (Fed. Cir. 2009).

12           The parties dispute the extent to which plaintiff's alleged 1999 prototype was in  
13 use in this country more than one year prior to plaintiff's July 31, 2001 provisional  
14 patent application.

15           It is undisputed that plaintiff testified that he showed his alleged prototype to his  
16 whole family around December 25, 1999. PSGI ¶ 141. According to defendant,  
17 plaintiff also testified that other people observed the prototype in operation at trade  
18 shows between February and March of 2000. DSUF ¶ 142; Marschall Decl., Ex. 3  
19 (Caluori 3/20/2011 depo., 320:21–321:6). Plaintiff contends that other people did not  
20 observe the prototype in operation between February and March 2000, but rather that  
21 plaintiff demonstrated a different version of the device than what is taught by the '727  
22 patent. PSGI ¶ 142.

23           Relying on Clock Springs, defendant argues that plaintiff's testimony that he  
24 showed his alleged prototype to his family in December of 1999 and that other people  
25 observed the prototype in operation between February and March of 2000 invalidates  
26 plaintiff's July 31, 2001 patent application as a matter of law. Def. Mot. at 23.

27           In light of the conflicting evidence, the Court finds that summary judgment should  
28 not be entered in favor of either party. First, with respect to the "other people" whom



1 defendant contends viewed plaintiff's December 1999 prototype in operation at trade  
2 shows from February to March 2000, a triable issue of fact exists as to which model  
3 plaintiff exhibited. Plaintiff has denied that he showed the December 1999 prototype,  
4 and a rational jury could determine that plaintiff showed a different model. As to  
5 plaintiff's testimony that he showed his device to his family on December 25, 1999, such  
6 demonstration is not the type of "public use" that necessarily invalidates the patent under  
7 35 U.S.C. § 102(b). The facts of this case are more similar to those in Moleculon  
8 Research Corp. v. CBS, Inc. (793 F.2d 1261) (Fed. Cir. 1986), abrogated on other  
9 grounds by Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) than to  
10 those in Clock Springs. In Clock Springs, the Federal Circuit held that § 102(b) was  
11 applicable because the patentee's demonstration of his method for repairing damaged  
12 high-pressure gas pipes prior to the critical date was open to the public under conditions  
13 such that viewers were under no limitation, restriction, or obligation of confidentiality.  
14 560 F.3d 1317, 1325. By contrast, in Moleculon Research Corp., even though an  
15 inventor showed a working prototype of his invention to friends, the Federal Circuit held  
16 that based on the personal relationships and surrounding circumstances, the district court  
17 was correct in holding that the inventor at all times retained control over the invention's  
18 use and the distribution of information concerning it. 793 F.2d at 1266. In this case,  
19 even if plaintiff showed a working prototype of his device to his family prior more than  
20 one year prior to filing for the '727 patent, plaintiff's relationship with his family could  
21 have been such that plaintiff retained control over the prototype's use and the  
22 distribution of information concerning it. See also Norderg Inc. v. Telsmith, Inc., 881 F.  
23 Supp. 1252, 1293 (E.D. Wis. 1995), aff'd, 82 F.3d 394 (Fed. Cir. 1996) (acknowledging  
24 that a confidentiality agreement may be implied from the surrounding circumstances and  
25 the relationships of the parties). Accordingly, the Court finds that the circumstances of  
26 this case do not mandate the granting of summary judgment in favor of defendant under  
27 35 U.S.C. § 102(b).

1                   **3. Plaintiff’s failure to list John Sandor, Richard Albrecht, Carlos**  
2                   **Barberis, and James Baird as coinventors**

3           Defendant next argues that the ‘727 patent is invalid because plaintiff failed to list  
4 all proper inventors. Def. Mot., 23–28.

5           Pursuant to 35 U.S.C. § 102(f), a person is not entitled to a patent if “he did not  
6 himself invent the subject matter sought to be patented.” 35 U.S.C. § 102(f). Thus,  
7 section 102(f) “makes the naming of the correct inventor or inventors a condition of  
8 patentability; failure to name them renders a patent invalid.” Pannu v. Iolab Corp., 155  
9 F.3d 1344, 1349–50 (Fed. Cir. 1998). Nonjoinder must be proved by clear and  
10 convincing evidence for a patent to be rendered invalid. Id. at 1349.

11           The parties dispute the extent to which four people – John Sandor, Richard  
12 Albrecht, Carlos Barberis, and James Baird – contributed to the invention of plaintiff’s  
13 BladePoint device.

14           Defendant contends that plaintiff learned that the laser alignment devices he sold  
15 were experiencing a “flexing” problem when users secured the device against a saw with  
16 a nut and bolt such that the internal parts were crushed or thrown out of alignment.  
17 DSUF ¶ 14–16; Marschall Decl., Ex. 2 (Caluori 6/24/2010 Depo., 111:9–112:15,  
18 123:13–19). In an attempt to combat the flexing problem, defendant asserts plaintiff  
19 contacted John Sandor, a mechanical engineer. Marschall Decl., Ex. 6 (Sandor depo.,  
20 34:2–36:3, 96:5–14). Defendant contends that Sandor proposed a new design that would  
21 “scallop” out areas of the central hub for batteries and the laser to be located. Sandor  
22 depo. at 96:5–97:14. Defendant asserts that Sandor’s graphic rendering of the scallop  
23 design which he provided to plaintiff was the first drawing resembling the “raised  
24 support arms” claimed in the ‘727 patent. Caluori 6/24/2010 depo. at 149:16–18.

25           According to plaintiff, he learned of the flexing issue before December 25, 1999,  
26 and built a prototype of a device to solve that problem without Sandor’s input. PSGI ¶  
27 14; Adler Supp Decl., Ex. BB (Caluori depo. at 257:15–258:3). Plaintiff points to  
28 Sandor’s deposition testimony to support his assertion that Sandor never developed any

1 solutions to the flexing problem, but merely implemented plaintiff's concepts. PSGI ¶  
2 41; Sandor depo. at 41:19–24.

3 Defendant next contends that plaintiff reached out to Richard Albrecht, an optical  
4 engineer, for design assistance so that the laser within plaintiff's device could be  
5 adjustable. DSUF ¶ 21; Marschall Decl., Ex. 4 (Caluori 7/12/2011 depo., 453:18–20,  
6 455:2–21), Ex. 8 (Albrecht depo., 23:18–27:23, 42:19–24). Defendant contends that  
7 Albrecht's designs appear as Figures 4–6 and 9A–9C in the '727 patent. DSUF ¶ 22.

8 According to plaintiff, Albrecht's design was a rendering of a concept developed  
9 by Caluori and Albrecht's drawings were mere later iterations of Caluori's concept.  
10 PSGI ¶ 22; Caluori depo. at 456:9–460:25.

11 Defendant next contends that an electrical engineer, Carlos Barberis, substantially  
12 contributed to the conception of independent claim 17. DSUF ¶ 168; Marschall Decl.,  
13 Ex 2 (Caluori 6/24/2011 depo. at 96:15–97:17), Ex. 7 (Baberis depo., 25:12–26:10).  
14 Specifically, defendant asserts that Barberis was the first to recognize that plaintiff's  
15 BladePoint device failed due to overheating, and suggested that plaintiff heat sink the  
16 laser module by linking it to the device's metal housing using a mechanical link such as  
17 a heat conductive epoxy. DSUF ¶ 169. Defendant contends that plaintiff was unaware  
18 of the importance of using a heat conductive material to tie the laser to the housing. *Id.* ¶  
19 169.

20 Plaintiff points to Barberis' deposition testimony to support his contention that he  
21 knew he needed a heat-sink to dissipate heat and that Barberis understood that the  
22 manufacturer of the laser diodes had recommended plaintiff use a heat sink. PSGI ¶  
23 170; Adler Supp. Decl., Ex. T (Barberis depo., 19:14–20:1, 24:23–25:4).

24 Finally, defendant contends that plaintiff's former business partner, James Baird,  
25 was the inventor of virtually every element in the '727 patent other than the raised  
26 support arms of claim 1, the heat conductive material of claim 17, and the adjustability  
27 of claim 34. DSUF ¶ 175; Marschall Decl., Ex. 2 (Caluori 6/24/2010 depo. at  
28 24:2–31:3), Ex. 5 (Baird 3/18/2011 depo., 16:13–24, 17:5–19:10).

1 According to plaintiff, Baird admitted in his deposition testimony that he invented  
2 none of the independent claims of the ‘727 patent. PSGI ¶ 175; Adler Supp Decl., Ex V  
3 (Baird 2005 depo., 72:1–14, 73:7, 73:14–15); Adler Supp Decl., Ex W (Baird 2011  
4 depo. at 47:13–48:13).

5 Defendant argues that three engineers Sandor, Albrecht, Barberis, and plaintiff’s  
6 former business partner Baird all made substantial contributions to the ‘727 patent such  
7 that plaintiff’s patent application should have been denied. Def. Mot. at 24–28.

8 Plaintiff responds by arguing that Sandor, Albrecht, Barberis, and Baird were not  
9 coinventors within the meaning of 35 U.S.C. 102 §(f). Pl. Opp. at 28–30. Specifically,  
10 plaintiff argues that he would not lose his rights to a patent even if Sandor, Albrecht, or  
11 Barberis did explain controlling scientific principles or how to incorporate a product into  
12 plaintiff’s device. *Id.* at 28 (citing Hess v. Advanced Cardiovascular SYS., 106 F.3d  
13 976, 981 (Fed. Cir. 1997); C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352  
14 (Fed. Cir. 1998) (“[A]n inventor may use the services, ideas and aid of others in the  
15 process of perfecting his invention without losing his right to a patent.”)). Moreover,  
16 plaintiff argues that none of the three engineers claimed he invented any element of the  
17 BladePoint device. *Id.* With respect to Baird, plaintiff argues that Baird has not  
18 provided sufficient corroborating evidence to support his claim that he invented the  
19 BladePoint device. *Id.* at 29 (citing Fina Oil and Chem. Co v. Ewen, 123 F.3d 1466,  
20 1474 (Fed. Cir. 1997) (“Every putative inventor must nonetheless provide corroborating  
21 evidence of any asserted contributions to the conception of the invention.”)). Plaintiff  
22 points to Baird’s contradictory testimony in a 2005 deposition as well as his ignorance of  
23 how the BladePoint functions shown by his testimony that the heat-conductive epoxy  
24 would increase rather than decrease the heat in the device. *Id.*; Baird depo. at  
25 47:13–48:13.

26 The circumstances of this case do not warrant a finding that the ‘727 patent is  
27 invalid as a matter of law due to the plaintiff’s failure to join all inventing parties. The  
28 Court finds there is a material issue of disputed fact as to whether one or more of

1 Sandor, Albrecht, Barberis, and Baird were coinventors such as to invalidate that patent.

2 **B. Infringement of the ‘727 patent**

3 Defendant next argues that its accused device did not infringe the ‘727 patent as a  
4 matter of law such that defendant is entitled to summary judgment. Def. Mot. at 6–12.

5 As the patent owner, plaintiff bears the burden of proving infringement. CVI/Beta  
6 Ventures, Inc. v. Tura LP, 112 F.3d 1146, 1161 (Fed. Cir. 1997). “Thus, the motion of  
7 an accused infringer for judgment on the ground of non-infringement of a patent may be  
8 granted where the patentee’s proof is deficient in meeting an essential part of the legal  
9 standard for infringement.” Johnston v. IVAC Corp., 885 F.2d 1574, 1577 (Fed. Cir.  
10 1989). “Literal infringement of a claim requires that every limitation recited in the claim  
11 appear in the accused device, *i.e.*, that the properly construed claim reads on the accused  
12 device exactly.” Cortland Line Co. v. Orvis Co., 203 F.3d 1351, 1358 (Fed. Cir. 2000).  
13 There can be no literal infringement if the accused device lacks even one of the elements  
14 of an asserted patent claim. Microstrategy Inc. v. Bus. Objects, S.A., 429 F.3d 1344,  
15 1352 (Fed. Cir. 2005).

16 It is undisputed that defendant’s accused device is a laser alignment device that is  
17 positioned on the shaft of a miter saw and generates a visible laser line on a work  
18 surface. PSGI ¶ 56 (undisputed). Defendant’s device includes a rigid cast-steel base  
19 disk and a plastic cover dome. Id. ¶ 58. A laser diode and circuit board are attached to  
20 the base disk on the side facing away from the blade. Id. ¶ 59. The cover dome of  
21 defendant’s device includes three batteries, and mates with the base disk. Id. ¶ 60. Once  
22 the cover dome and the disk are mated, they are secured to each other by inserting  
23 screws into the screw holes on the blade abutting side of the base disk and into the screw  
24 bosses of the cover dome. Id. ¶ 61. The parties dispute whether defendant’s accused  
25 device literally infringes claim 1 of the ‘727 patent.

26 Defendant argues that its device did not infringe the ‘727 patent because its device  
27 did not contain each and every element of the ‘727 patent. Def. Mot. at 8. Specifically,  
28 defendant argues that its accused device did not have a structural housing in the shape of

1 a “partially hollow cylinder,” that the device lacked “raised support arms radiating from  
2 the central portion,” and that the device did not contain “pockets” defined by raised  
3 support arms. Id. at 8–12.<sup>2</sup>

4 **1. “Essentially a partially hollow cylinder”**

5 Claim 1 of the ‘727 patent requires that the device’s structural housing is  
6 “essentially a partially hollow cylinder.” ‘727 patent at col. 5, 11. 24–29. In the  
7 Markman order of November 12, 2010, this Court construed the term “partially hollow  
8 cylinder” to have its plain meaning. PSGI ¶ 65 (undisputed); Dkt. 116, 10. The Court  
9 did not construe the meaning of the term “essentially.”

10 Defendant asserts that the structural housing shown in figures of the ‘727 patent  
11 depict what plaintiff meant by the term “cylinder.” DSUF ¶ 67; Marschall Decl., Ex. 17  
12 (Caluori depo., Ex. 14 (the ‘727 patent, Figures 1A, 2)). Defendant asserts that  
13 plaintiff’s expert, Gregory Carman, testified in his deposition that defendant’s accused  
14 device is not a cylinder even when the base disk and cover dome are considered together.  
15 DSUF ¶ 73; Marschall Decl., Ex. 11 (Carman depo., 57:10–17, 57:21–58).

16 According to plaintiff, the structural housing in the figures of the ‘727 patent are  
17 merely exploded views of one embodiment of the cut alignment device. PSGI ¶ 67.  
18 Further, plaintiff asserts that when Carman testified about the meaning of the word  
19 “cylinder,” it was based solely on his understanding of the dictionary definition of that  
20 term. Id. ¶ 70; Adler Supp. Decl., Ex. EE (Carman depo. at 55:9–61:5). Moreover,  
21 plaintiff contends that Carman did not consider whether defendant’s accused device was  
22 “essentially” a cylinder or give an opinion on that subject. PSGI ¶ 70.

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25 <sup>2</sup> At oral argument, counsel for defendant argued that OWT’s accused device lacked  
26 a “raised inner central portion.” Specifically, counsel argued plaintiff improperly relied  
27 on a combination of multiple structures in OWT’s device—one in the cover and one in the  
28 base—to meet this claim limitation. The Court finds this argument unavailing as plaintiff’s  
expert, Gregory Carman, identified a “raised inner central portion” in *both* the top cover  
and the base washer. Carman Decl., Ex. A, p. 6, Figures 2 and 3.

1 Defendant argues that its accused device is not a “cylinder” within the meaning  
2 the Court applied to the term in the Markman order. Specifically, defendant argues that  
3 because the Court interpreted a “partially hollow cylinder” to have its plain meaning,  
4 defendant’s device does not infringe as a matter of law because the structural housing of  
5 its device is not exactly a “cylinder” under the ordinary understanding of the word. Id.  
6 at 9–10.

7 Plaintiff responds that while the Court interpreted the word “cylinder” to have its  
8 ordinary meaning, the Court did not construe the word “essentially,” a modifier to the  
9 claim limitation. Pl. Opp. at 27. Plaintiff argues that when “essentially” is given its  
10 ordinary meaning—emphasizing the basic, fundamental or intrinsic nature of a person,  
11 thing, or situation—the structural housing of defendant’s accused device includes the  
12 “partially hollow cylinder” claim limitation. Id.

13 The Court finds that when given its ordinary meaning, the modifier “essentially”  
14 would allow a rational jury to determine that defendant’s accused device includes a  
15 “partially hollow cylinder.” Moreover, the Court finds that Gregory Carman has not  
16 conceded that his deposition testimony was meant to cover a device that was  
17 “essentially” a cylinder. Accordingly, summary judgment for either party is  
18 inappropriate.

19 **2. “Raised support arms radiating from the central portion”**

20 Claim 1 also requires “at least two spaced support arms radiating from the central  
21 portion.” ‘727 patent at col. 5, 11. 24–29. In the Markman order this Court construed  
22 “raised support arms” as “projections that extend above the inner bottom surface of the  
23 structural housing and maintain the integrity of the housing and protect the components  
24 in the housing so that they are not crushed when the device is secured on an arbor.”  
25 PSGI ¶ 76 (undisputed); Dkt. 116 at 11.

26 Defendant argues that the Court’s construction of “raised support arms radiating  
27 from the central portion” precludes a finding that defendant’s device infringes as a  
28 matter of law. Def. Mot. at 10. Defendant contends that in his interrogatory response,

1 plaintiff identified the screw bosses of the cover and the screw holes and ridges of the  
2 base disk as the “raised support arms” in defendant’s accused device. DSUF ¶ 77;  
3 Marschall Decl. Ex. 19 (Caluori depo., Ex. 26). Relying on the reports of Paul Wright, a  
4 professor of mechanical engineering at the University of California Berkeley, defendant  
5 contends that the screw bosses of the cover and the screw holes and ridges of the base  
6 disk are not raised support arms because they do not extend above the inner bottom  
7 surface of the structural housing, do not radiate from a single raised central portion, and  
8 do not maintain the integrity of the housing or protect the components within the device.  
9 Def. Mot. at 11; DSUF ¶ 78–82; Declaration of Paul Wright (“Wright Decl.”), Ex. B  
10 (Rebuttal Expert Report, 1, 16). Further, defendant asserts that none of these structures  
11 define the load path between the bolt of the miter saw and the blade. DSUF ¶ 83; Wright  
12 Decl., Ex. B. Rather, defendant asserts that the load path extends from the related bolt  
13 through the central hub of the cast-steel base disk, but at no time includes any portion of  
14 the nylon cover dome. Def. Mot. at 11–12; DSUF ¶ 84; Wright Decl., Ex. B.

15 Plaintiff responds that defendant’s device has “raised support arms” such that the  
16 device infringes the ‘727 patent. Pl. Mot. at 18–20. Plaintiff contends that he identified  
17 the support arms extending above the base which radiate from the hub as well as the  
18 screw bosses in the cover collectively as the “raised support arms” in defendant’s device.  
19 PGSI ¶ 77; Carman Decl. Ex. A, 6–7; Lynch Decl. Ex. A, 13, 18–19; Adler Supp. Decl.,  
20 Ex. Y (Caluori responses to interrogatories, Ex. A). Plaintiff points to the declarations  
21 of his experts to support the proposition that support arms extend above the surface of  
22 the base and radiate from the hub of defendant’s accused device. Pl. Mot. at 18–19.  
23 PSGI ¶ 78. Plaintiff further argues that the support arms extending above the base, when  
24 mated with the screw bosses, define a load path which protects the components within  
25 defendant’s accused device. Pl. Mot. at 19; PSGI ¶ 83.

26 The evidence before the Court precludes a finding as a matter of law that  
27 defendant’s accused device does or does not include the “raised support arms” of claim 1  
28 of the ‘727 patent. A jury considering the competing reports of Paul Wright and



1 Gregory Carman could determine rationally that defendant’s accused device either has or  
2 does not have “raised support arms.” Accordingly, the Court finds that a triable issue of  
3 fact exists such that summary judgment in favor of either party is inappropriate.

4 **3. “Pockets” defined by raised support arms**

5 Claim 1 of the ‘727 patent also requires that the support arms define two or more  
6 pockets in which the battery power source and the light source are located. ‘727 patent  
7 at col. 5, 11. 27–29. This Court defined the term “pockets” to mean “compartments.”  
8 Dkt. 116 at 11.

9 Defendant argues that its accused device does not include pockets within the  
10 meaning of the term as construed by the Court. Def. Mot. at 12; DSUF ¶ 93; Wright  
11 Decl., Ex. B (Rebuttal Expert Report at 17). Specifically, relying on the report of Paul  
12 Wright, defendant argues that the areas in defendant’s device plaintiff asserts are pockets  
13 cannot be considered compartments for the batteries and light source. Def. Mot. at 12;  
14 DSUF ¶ 94; Wright Decl. Ex. B (Rebuttal Expert Report at 17). Defendant contends that  
15 these areas are the same as those disclosed in the Peot patent. Def. Mot. at 12; DSUF ¶  
16 95; Wright Decl., Ex. A (Opening Expert Report, 17).

17 Plaintiff cites the declaration of his expert, Gregory Carman, to support his  
18 assertion that the support arms extending above the base which radiate from the hub of  
19 defendant’s accused device define two pockets. Pl. Mot. at 20; PSGI ¶ 93; Carman  
20 Decl., Ex. A at 6–7. Specifically plaintiff contends that as depicted in Carman’s report,  
21 when the base washer of the defendant’s accused device mates with the top cover, two  
22 raised support arms form two general pocket regions in the base washer in which the  
23 batteries and laser diode are located. Pl. Mot. at 20–21; PSGI ¶ 93.

24 The evidence before the Court precludes a finding as a matter of law that  
25 defendant’s accused device does or does not include the “pockets” of claim 1 of the ‘727  
26 patent. A jury considering the competing reports of Paul Wright and Gregory Carman  
27 could determine rationally that defendant’s accused device either has or does not have  
28 “pockets.” Accordingly, the Court finds that a triable issue of fact exists such that

1 summary judgment in favor of either party is inappropriate.

2 **C. Damages for infringement between plaintiff’s receipt of the ‘727 patent**  
3 **and filing of the instant action.**

4 Defendant next argues that even if defendant did infringe the ‘727 patent, plaintiff  
5 is not entitled to claim damages for any infringement between the issuance of the ‘727  
6 patent and plaintiff’s filing of the complaint in this case due to plaintiff’s failure to mark  
7 his product with the ‘727 patent number. Def. Mot. at 28.

8 A patentee may only recover damages for patent infringement that occurs after the  
9 patentee provides notice to an accused infringer under 35 U.S.C. § 287(a). Am. Med.  
10 Sys., Inc. v. Med. Eng’g Corp., 6 F.3d 1523, 1537 (Fed. Cir. 1993). The notice required  
11 by § 287(a) may take two forms: (1) constructive notice or (2) actual notice. Id.  
12 Constructive notice is satisfied only after a patentee “consistent[ly] and continuos[ly]”  
13 fixes the word “patent” or “pat.” and the patent number to a patented product or, if it is  
14 not possible to mark the product, the product’s packaging. See id. at 1534, 1537. To  
15 constitute constructive notice, a patentee must “consistently mark [] substantially all of its  
16 patented products [] and . . . no longer distribut[e] unmarked products.” Id. at 1538. This  
17 requirement is subject to a limited *de minimis* exception. Id. at 1536. The actual notice  
18 provision requires that a patentee affirmatively communicate the “specific charge of  
19 infringement by a specific accused product or device.” Amsted Indus., Inc. v. Buckeye  
20 Steel Castings Co., 24 F.3d 178, 187 (Fed. Cir. 1994). Without such communication, the  
21 filing of an infringement action qualifies as de facto actual notice. Id. at 184.

22 The parties do not dispute that plaintiff began selling a commercial embodiment  
23 of the ‘727 patent during the pendency of the application for that patent and also sold a  
24 number of these devices after the ‘727 patent issued on July 12, 2005. PSGI ¶ 180  
25 (undisputed). It is also undisputed that plaintiff did not physically mark his product with  
26 the ‘727 patent number, and that at no time prior to filing this lawsuit did plaintiff accuse  
27 defendant of infringing the ‘727 patent. Id. ¶ 183–84. The parties do not dispute that  
28 plaintiff sold 11,227 of the devices incorporating the features claimed in the ‘727 patent

1 before the patent issued. Defendant’s Statement of Genuine Disputes of Material Fact  
2 (“DSGMF”) ¶ 31 (undisputed). It is also undisputed that plaintiff sold at least 62  
3 devices embodying the features of the ‘727 patent after the patent issued. Pl. Mot. at 28.

4 Defendant contends that plaintiff’s product could have been marked with the ‘727  
5 patent number because defendant marks its products with a patent number, and plaintiff  
6 placed “patent pending” notices on his product. DSUF ¶ 182; Marschall Decl., Ex. 44  
7 (Peot depo., Ex. 20), Ex. 4 (Caluori 7/12/2011 depo., 468:24–469:1).

8 According to plaintiff, once the ‘727 patent issued, it was not commercially  
9 feasible to tool up dyes and then, stamp the remaining 62 devices in his inventory with  
10 the patent number. PGSI ¶ 182.

11 Defendant argues that while 35 U.S.C. § 287(a) does not require a patentee to  
12 mark every product, the *de minimis* exception to constructive notice requires that a  
13 patentee begin marking a patented product and thereafter leave only a few products  
14 unmarked. Def. Mot. at 29 (citing Am. Med. Sys., Inc., 6 F.3d at 1536; Hazeltine Corp.  
15 v. Radio Corp. of Am., 20 F.Supp. 668, 671–72 (S.D.N.Y. 1937)). Defendant argues  
16 that unlike American Medical Systems, Inc., where the Federal Circuit allowed a  
17 patentee to collect damages where the patentee had consistently marked nearly all of the  
18 patented product, plaintiff never marked his BladePoint device. Id. Further, defendant  
19 argues that even if plaintiff included the ‘727 patent number on paper inserts sent with  
20 his products as plaintiff claims, marking a paper insert is insufficient as a matter of law  
21 as the product itself must be marked when possible. Id. at 30 (citing Belden Techs., Inc.  
22 v. Superior Essex Commc’ns. LP, 733 F. Supp. 2d 517, 534, 536 (D. Del. 2010);  
23 Metrologic Instruments, Inc. v. PSC, Inc., No 99-4876, 2004 U.S. Dist. Lexis 24949, at  
24 \*59–60 (D.N.J. Dec 13, 2004)). Defendant points to its own marking of laser alignment  
25 devices and to plaintiff’s marking of “patent pending” on the BladePoint devices as  
26 proof that plaintiff was indeed capable of marking his products before distribution. Id.

27 Plaintiff argues that § 287(a) does not apply where the patentee has no products to  
28 mark. Pl. Mot. at 26. Plaintiff relies principally on Wine Ry. Appliance Co. v.

1 Enterprise Ry. Equipment Co., 297 U.S. 387, 398 (1936), in which the Supreme Court  
2 interpreted a previous version of the marking statute not to require a patentee to give  
3 actual notice to an infringer before damages could be recovered if the patentee  
4 manufactured no products. Id. Plaintiff argues that he is entitled to full royalties  
5 because he lacked sufficient funds to mark his remaining inventory after he stopped  
6 producing BladePoint devices before the ‘727 patent issued. Id. at 27. Additionally,  
7 plaintiff argues that the Federal Circuit allows patentees to recover full royalties where  
8 the patentee has marked substantially all of its patented products under the *de minimis*  
9 doctrine. Id. at 28 (citing Am. Med. Sys., Inc., 6 F.3d at 1537). Plaintiff argues that  
10 because he sold over 11,000 devices before the patent issued and only 62 devices after  
11 issuance, he is entitled to the benefits of the doctrine. Id.

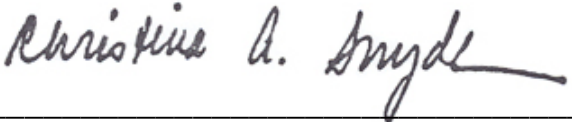
12 The Court finds that the facts of this case are distinguishable from those of the  
13 cases on which plaintiff relies. First, unlike in Wine Railway, where the patentee had  
14 neither manufactured nor sold any article under the patent, in this case plaintiff had both  
15 manufactured and sold the BladePoint device under the ‘727 patent. While it may have  
16 been financially burdensome for plaintiff to mark his remaining inventory after the ‘727  
17 patent was issued, it was not literally impossible as in Wine Railway. Next, in contrast  
18 to American Medical Systems, where the patentee had marked substantially all of its  
19 products with the patent number, here plaintiff marked none of his products with the  
20 ‘727 patent number. That plaintiff sold nearly all of his devices prior to the issuance of  
21 the patent does not excuse plaintiff’s failure to mark his remaining devices after  
22 issuance. Plaintiff is not entitled the *de minimis* doctrine based on the facts in this case.  
23 Accordingly, the Court GRANTS defendant’s motion for partial summary judgment on  
24 the issue of damages.

1           **IV. CONCLUSION**

2           In accordance with the foregoing, the Court DENIES both parties' motions for  
3 summary judgment regarding infringement, and GRANTS defendant's motion for  
4 summary judgment regarding the limitation on plaintiff's damages.

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6           IT IS SO ORDERED.

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9 Dated: September 16, 2011



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10           CHRISTINA A. SNYDER

11           UNITED STATES DISTRICT JUDGE  
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