

No. 22-

IN THE
Supreme Court of the United States

LARRY G. JUNKER,

Petitioner,

v.

MEDICAL COMPONENTS, INC., MARTECH
MEDICAL PRODUCTS, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Larry Junker brought a patent infringement action against Medcomp and Martech that was successfully tried to the District Court, finding Mr. Junker was the true and sole inventor, rejecting all other invalidity defenses and awarding damages. Before trial, the Court granted summary judgment on the defense of an on-sale bar in favor of Mr. Junker. In 2003 Mr. Junker had successfully litigated the same patent against James Eddings, among others, and a jury found Mr. Eddings had infringed the patent, had violated a non-disclosure agreement, and it awarded Mr. Junker damages, attorney's fees, and interest. Mr. Eddings had been engaged by Mr. Junker to do development work, yet he improperly "quoted" the sale of the product in 1999 in violation of the non-disclosure agreement and later infringed the patent. In the present case, this "quote" was found by the Court of Appeals to be an offer for sale, notwithstanding the inventor, Mr. Junker, had nothing to do with the offer. Yet his patent was invalidated.

The questions presented are:

May a price quotation invoke the on-sale bar when made by a third party who had no right to sell the invention and with no involvement by the patentee?

May a price quotation invoke the on-sale bar and be deemed an offer though it does not constitute a commercial offer for sale as understood by the relevant business community, thereby fundamentally undermining long-established federal contract law?

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RULE 29.6 STATEMENT

Larry Junker is an individual.

**PARTIES TO THE PROCEEDING
AND RELATED CASES**

The parties to this proceeding are listed on the front cover.

Related cases to this proceeding are

- *Larry G. Junker v. Medical Components, Inc., Martech Medical Products, Inc.*, No. 13-4606, in the United States Court District Court for the Eastern District of Pennsylvania, Judgment entered January 14, 2021.
- *Larry G. Junker v. Medical Components, Inc., Martech Medical Products, Inc.*, No. 2021-1649, in the United States Court of Appeals for the Federal Circuit, Judgment entered February 10, 2022.

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PETITION FOR A WRIT OF CERTIORARI

Larry G. Junker respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion on Motion for Summary Judgment granted in favor of Plaintiff on the on-sale bar defense (App. 28a-78a) may be found at *Junker v. Med. Components, Inc.*, No. 13-4606, 2019 U.S. Dist. LEXIS 1530 (E.D. Pa. Jan. 4, 2019)

The opinion denying Motion for Partial Reconsideration of the Motion for Summary Judgment, dated October 9, 2019, (App. 18a-27a) is unreported.

The opinion under review in this petition (App. 1a-17a) may be found at *Junker v. Med. Components, Inc.*, 25 F.4th 1027 (U.S. Fed. Cir. 2022). The denial of rehearing dated April 12, 2022 (App. 79a-80a) is unreported.

JURISDICTION

The Federal Circuit Court of Appeals issued its decision on February 10, 2022. App. 18a. The Court reversed a District Court finding of summary judgment and denied rehearing *en banc* on April 12, 2022. App. 1a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

35 U.S.C. 102 (PRE-AIA) CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT.

A person shall be entitled to a patent unless-

***(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.¹

INTRODUCTION

This Court in *Pfaff* and *Helsinn* has made clear that the statutory on-sale bar is intended to and was enacted to bar an inventor from exploiting his invention by offering it for sale more than one year before filing his patent. This statutory scheme is clearly distinguished from the invention being in the public domain for reasons such as being patented, described in a printed publication, or in public use. The statute itself indicates this may result in “loss of right” to patent—the right being one of the inventor. Yet, in no case does it imply or state that someone can steal an invention, secretly offer it for sale, and thereby deprive the true and only inventor his right to seek protection. Such an application of the on-sale bar is contrary to its purpose, and allows a faithless confidant to destroy an inventor’s patent rights unbeknownst to

1. 35 U.S.C. § 102 did not change under the American Invents Act (AIA) with respect to the on-sale bar and the same law should apply going forward.

the inventor, the USPTO, or any POSA relying on that patent; it allows the inventor to proceed with patenting and exploiting his invention, only to lose everything when that secret offer comes to light even, as here, decades later. This issue has never been before this Court and without correcting the Federal Circuit decision, inventors are subject to invalidation of their patents in this manner, contrary to the intent of the statute.

Further, the Federal Circuit's finding of an "offer" in this case is contrary to the statute and developed Federal Circuit law, as by its very terms it was deemed a quote, the recipient thought it was a quote, and, as is readily apparent, simple acceptance could not turn this standard multi-product price quotation into a binding contract. It turns contract law on its head, interfering with a party's right to determine whether they enter into a contract, and renders the current industry-wide practice of quoting prices into a potentially damaging act to one's patent rights and to one's business.

STATEMENT OF THE CASE

This case arises out of Medcomp's infringement of a design patent for a medical device. Defendants willfully infringed the patent and were ordered to pay damages. The underlying case presented a host of invalidity defenses including inventorship, prior art, inequitable conduct, and various claims of obviousness. All were denied after a bench trial. The only issue that the Federal Circuit ruled upon was the grant of summary judgment in favor of Mr. Junker on the on-sale bar. The District Court in a well-reasoned opinion, found the quote was just that: a quote. It was not capable of acceptance, but merely constituted preliminary negotiations.

Medcomp appealed several issues including infringement, on-sale bar, article of manufacture and willfulness.

The Federal Circuit reversed the grant of summary judgment and found the product had been put on sale by a third party, Mr. Eddings, more than one year before a patent was filed. This alleged offer for sale was found despite Mr. Eddings being bound by a non-disclosure agreement and in the face of a finding by a jury in previous litigation and the present suit that Mr. Junker was the first and sole inventor, and despite Mr. Eddings having violated the non-disclosure agreement and infringed the patent by later selling infringing product.

REASONS FOR GRANTING THE PETITION

This petition should be granted to resolve an issue of applicability of the *Pfaff* and *Helsinn* doctrine regarding the on-sale bar as it relates to actions by a third party conducted outside of the inventor's knowledge and control that invalidated his patent. A more unjust application of the statute can hardly be imagined and is contrary to the very purpose of the statute as articulated by this Court.

This petition should be granted to resolve a conflict between the Federal Circuit and the federal law of contracts regarding the distinction between a price quotation and a commercial offer for sale, and to avoid the commercial chaos that will ensue if price quotations are held to bind parties into contract against their intent. This will undermine contract law in all circuits given the national reach of the Federal Circuit.

INTRODUCTION AND STATEMENT OF ISSUES

Summary of argument

I. The on-sale bar is not applicable by the action of a thief who has no right to sell the invention.

The quotation at issue was proffered by an individual incapable of forming a contract to sell the invention. Mr. Eddings violated a non-disclosure agreement with Mr. Junker and then later infringed the patent. The on-sale bar should not invalidate a patent on the actions of an individual having no right to sell and in violation of a non-disclosure agreement. Under this ruling, one who has no business and no product to sell could make an “offer” unknown to the patentee, invalidating the patent of the inventor not lucky enough to file within a year of the unknown offer.

II. Contract law requires an offer to be susceptible to forming a firm contract and should not apply to quotations; anything else will create commercial chaos.

The Federal Circuit disregarded this Court’s well-established law of contracts that quotations are not offers for sale, finding the quotation was instead a firm offer, despite its very terms indicating it was precatory and not capable of forming a contract. Indeed, the at-issue letter characterized itself as a quote three times, and the recipient responded by requesting yet another quote. It is apparent on the face of the quotation that necessary commercial terms are indefinite, making simple acceptance impossible.

The Court introduced tremendous uncertainty into the business community, leaving it with little idea what must be done to test market interest with a quotation to potential customers without starting the one-year patent filing clock. Further, the Court's decision makes it impossible for the business community to know how they can offer price quotations to prospective buyers without finding themselves potentially bound in contract. This ruling upends commonly understood business norms, contract law, and well-established law regarding quotes as "offers" for sale.

ARGUMENT

I. The on-sale bar is not applicable to one who has no right to sell the invention.

The Federal Circuit previously found this alleged offeror was an infringer and had violated a non-disclosure agreement with the patentee. *Junker v. Eddings*, 396 F.3d 1359, 1368 (Fed. Cir. 2005). Its current application of the on-sale bar leads to the anomalous result that the very entity who stole the invention, infringed the patent, and violated the patentee's confidential disclosure, could invoke the on-sale bar with nothing more than a price quote. Mr. Eddings was quoting a product he was not legally entitled to sell. *Id.* He was merely judging market interest in Mr. Junker's invention, which he subsequently stole. The underlying bench trial also made clear Mr. Eddings violated a non-disclosure agreement by quoting the product in the first place. *See Junker v. Med. Components, Inc.*, No. 13-4606, 2021 U.S. Dist. LEXIS 7694 (E.D. Pa. Jan. 14, 2021). The public policy behind the on-sale bar is to prevent an inventor from exploiting his invention early,

not to convert on-sale to a public use defense by a thief and infringer.

The Court's decision is at odds with all notions of fairness and proper application of 35 USCS § 102(b) (pre-AIA) which is to prevent *inventors* from exploiting their invention without filing for a patent. *Ushakoff v. United States*, 164 Ct. Cl. 455, 327 F.2d 669 (1964). The Court cited *Pfaff v. Wells Elecs*, 525 U.S. 55, 67 (1998), yet disregarded the very purpose of on-sale doctrine, to prevent inventors from exploiting their inventions a year or more before filing. This doctrine is specific to the inventor and should not be invoked by an infringer or one who violates a non-disclosure agreement. Indeed, in *Pfaff*, the Court noted the purpose of the rule is, in part, so “[a]n inventor can both understand and control the timing of the first commercial marketing of his invention.” *Pfaff v. Wells Elecs*, 525 U.S. 55, 67 (1998). Here, Mr. Eddings, who was secretly quoting to third parties in violation of Mr. Junker's rights, had previously been found by the Federal Circuit to have made an “unauthorized use of the design Junker had developed.” *Junker, supra*, 396 F.3d at 1368. This denied Mr. Junker his due control of the first commercial market timing. This anomalous result merits re-evaluation by this Court.

Similarly, in *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628 (2019), this Court makes clear the doctrine is intended to prevent an inventor from exploiting his invention or having someone with his consent do so, and then file more than one year later. The original patent statute pertaining to this defense in 1836 stated a patent was barred if the invention was “on sale, with the consent and allowance of the patentee before his application for

a patent.”² Yet nothing in over 185 years has altered this basic equitable principle, and was essentially reaffirmed in this Court’s *Helsinn* decision:

“One such condition is the on-sale bar, which reflects Congress’ “reluctance **to allow an inventor** to remove existing knowledge from public use” by obtaining a patent covering that knowledge. *Pfaff, supra*, at 64; see also *Pennock v. Dialogue*, 2 Pet. 1, 19 (1829) (explaining that “it would materially retard the progress of science and the useful arts” **to allow an inventor** to “sell his invention publicly” and later “take out a patent” and “exclude the public from any farther use than what should be derived under it”).

Helsinn, supra, 139 S. Ct. at 633 (2019) (emphasis added).

Mr. Junker notes that the Federal Circuit in previous cases has held or stated in dicta that the actions of third parties may invoke the on-sale bar. See *Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353, 1355 (Fed. Cir. 2001) (collecting cases). But to the extent these prior rulings permit invocation of on-sale bar by a third party acting, as here, with an obligation to maintain the secrecy of the invention, and acting without the knowledge of the inventor, those holdings should be overturned.

As held in *Helsinn*, even the AIA did not change the law for on-sale bar to require it otherwise be available

2. The Patent Act of 1836 (Pub.L. 24–357, 5 Stat. 117, enacted July 4, 1836).

to the public. That the on-sale bar can be triggered by a third party is not questioned as such. Rather can it be triggered directly in violation of an obligation to keep it secret? An inventor should not have to rush to file his patent to protect himself from unknown dishonest acts of his development company.

It is minimal remedy to the inventor that he could sue the third party for breach of the NDA (which occurred here as well), to suffer not only the immediate damages at the time of that breach, but to lose all patent rights to future infringers.

This Federal Circuit decision is contrary to the intent of the on-sale bar and should be overturned.

II. The Court's decision conflicts with its precedent holding quotations are not offers for sale, and must be sufficient to form a binding contract by simple acceptance.

A. The Federal Circuit applies contract law as generally understood to create stability and consistency in its application of the on-sale doctrine.

In determining the 1/8/99 quotation letter constituted an offer, the Federal Circuit disregarded its own precedent and the Restatement. “We also have held that, to be true to *Pfaff* when assessing prong one of § 102(b), we must focus on those activities that would be understood to be commercial sales and offers for sale ‘**in the commercial community.**’” *Meds. Co. v. Hospira, Inc.*, 827 F.3d 1363, 1373 (Fed. Cir. 2016) (quoting *Grp. One, Ltd. v. Hallmark*

Cards, Inc., 254 F.3d 1041, 1047 (Fed. Cir. 2001) (emphasis added)). However, the Court did not assess how terms would be understood in the commercial community, instead substituting its own understanding.

Restatement § 26 states, “A manifestation of willingness to enter into a bargain is not an offer if the person to whom it is addressed knows or has reason to know that the person making it does not intend to conclude a bargain until he has made a further manifestation of assent.” Whether a party intends to create a binding offer contemplates the parties’ understanding and “usages of their community or line of business.” *See* Restatement § 26, cmt. a. (1981). In this case, the Court ignored the fact that Boston Scientific explicitly requested a “price quotation,” demonstrating their understanding that the response was not intended to conclude a bargain, but to provide information necessary to potentially make a purchase order.

The Court stated the fact Xentek (Eddings) was responding to a request “signals . . . a specific offer to Boston Scientific to take further action.” *Junker v. Med. Components, Inc.*, 25 F.4th at 1033. But this is not the standard for a commercial offer. Any negotiation necessarily solicits further action from the other party. The further action explicitly requested by the letter was “discussing your requirements in person.” The expressed intent is for negotiation, not conclusion.

In contemplating the parties’ intent, the Court observed that the term “quotation” was thrice included. *Id.* at 1035. This is critical because it denotes objectively and subjectively the letter is not an offer to be accepted,

but rather a quote. Eddings testified he sent the letter hoping to elicit a purchase order; Boston Scientific then asked for another “quote” in response. The Court failed to consider why both parties intentionally and repeatedly used “price quotation” terminology.

The Court also disregarded industry practice and ordinary commercial meaning conflating “price quotation” with “price list”, evident by frequent use of the term “unsolicited price quotation.” A quotation is, by definition, provided in response to a request. A price list, on the other hand, is provided generally to the public, unsolicited. *See* Restatement § 26, cmts. a,b. The use of the term “price quotation” by both the perspective buyer and seller, as here, makes clear the parties understood these to be preliminary negotiations, not offers. This is the very purpose of price quotations, and why federal contract law recognizes they are not commercial offers for sale.

That commercial terms can be assembled from the various data provided by the letter does not evince an understanding that any specific combination of those terms is intended to be a commercial offer. However, the Federal Circuit inferred intent from the inclusion of a certain number of generic commercial terms, despite all other indicia of intent. By ruling intent can be inferred from the inclusion of necessary commercial terms alone, and ruling inclusion of those necessary commercial terms is all that is needed to invoke the on-sale bar, the Court effectively removed the requirement of clear and convincing evidence of intent to make an offer.

To learn merely quoting various price-for-quantity scenarios could result in a binding contract would be

a shocking reversal of accepted commercial practice and have a profound chilling effect on commercial communication. The Court's ruling gives businesses no guidance on how they can give pricing information to prospective buyers without unintentionally being bound in contract or subject to the on-sale bar as they can't even protect themselves by explicitly stating they are merely quoting prices. The Court implies that fewer terms might prevent conversion to an offer, but conveying fewer terms makes the quotation less useful. And what set of terms, exactly, puts one in danger? The Federal Circuit takes the quote-vs-offer decision out of the hands of those doing business and makes it a matter for courts to determine instead. And how should courts know when they're looking at an offer and when a quote? The ruling provides no guidance.

Creating a national law of contract by use of, among other sources, the Restatement, dictates adherence to its core principles. The Restatement indicates the word quote is "commonly understood as inviting an offer" (Restatement § 26, cmt. c). This should be sufficient for a finding that these were preliminary discussions. The Court disregarded this common sense understanding and, ignoring the facts, made new law. There must be uniform contract law at the Federal Circuit. Mercantile security requires unambiguous application of federal contract law, and this decision inserts doubt into any quotation including significant terms, even those calling themselves quotations.

B. The Federal Circuit misapplied its law of on-sale bar and quotations regarding “simple acceptance.”

The Court stated Boston Scientific could accomplish simple acceptance by responding “We’ll take 5,000 sets of the 4F-6F Medi-Tech Peelable Sheath.” *Junker v. Med. Components, Inc., supra*, 25 F.4th at 1034. However, this is not simple acceptance but a purchase order, itself the commercial offer for a sale. Despite taking great liberties with the facts to reach its preordained conclusion, the Court was unable to find an offer with all necessary commercial terms in the price quotation letter.

The Court’s attempts to distinguish *Merck & Cie v. Watson Lab’ys, Inc.*, 822 F.3d 1347 (Fed. Cir. 2016) and *Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359 (Fed. Cir. 2007) are inapposite and indeed each case conflicts with the Court’s ruling. In *Merck* there were significant ongoing discussions and details in the offer. It was made in response to a specific request by the buyer to “purchase two kilograms” of product and then offered price and delivery location of that exact amount. In *Merck*, it was the seller who was accepting by meeting the buyer’s purchase order (offer).

Cargill, similarly, included a letter responding to a request for a specific quantity of canola oil, and included the price and quantity under contract conditions. Again, *Cargill* was essentially meeting a buyer’s purchase order and as this Court found “powerful evidence of a sales transaction,” this indicates a more detailed discussion and not the preliminary negotiations involved here.

Under the Court's construct, Boston Scientific could have replied "I accept 10 million sets, in batches of 10,000, delivery FOB 30 days – here's a check," and Xentek would have been bound to deliver despite not having even designed the equipment to make the product and not having yet sought FDA approval to sell it. Obviously, no business would take such a risk. Hence a purchase order comes from the buyer in response to a quote, and the seller then has the opportunity to accept.

Unlike *Merck*, there is no quantity specified in the letter. The Court stated the letter makes multiple offers, but the letter merely states varying prices per unit when purchased at various exemplar quantities. Xentek (Eddings) didn't give the total price for 5,000 or 10,000 sets, as it would have had it intended to sell exactly 5,000 or 10,000 sets. Quoting a piece part price rather than a total price shows the quantity was indeterminate. In *Merck*, the buyer requested a price for a specific quantity it intended to purchase. In this case, Boston Scientific sought a quote in response to a Xentek sales pitch, and there is no evidence it ever even contemplated an actual purchase of Xentek's product, much less a specific quantity.

In both *Merck* and *Cargill*, the seller received what Xentek was hoping its price quotation would elicit: a purchase order, as is the normal course of business in industry. The Court should have recognized that their own precedent warranted a finding that Xentek's 1/8/99 letter was a quotation subject to additional negotiations, not a commercial offer.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

1a

**APPENDIX A — OPINION OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED FEBRUARY 10, 2022**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2021-1649

LARRY G. JUNKER,

Plaintiff-Appellee,

v.

MEDICAL COMPONENTS, INC., MARTECH
MEDICAL PRODUCTS, INC.,

Defendants-Appellants.

Appeal from the United States District Court for the
Eastern District of Pennsylvania in No. 2:13-cv-04606-
MSG, Judge Mitchell S. Goldberg.

February 10, 2022, Decided

Before DYK, REYNA, and STOLL, *Circuit Judges.*

STOLL, *Circuit Judge.*

Larry G. Junker, the named inventor of U.S. Design
Patent No. D450,839, sued Medical Components, Inc. and
Martech Medical Products, Inc. (collectively, “MedComp”)

Appendix A

for infringement of the sole claim of the D'839 patent. The parties filed cross-motions for summary judgment, debating whether a letter sent before the critical date was a commercial offer for sale of the claimed design, rendering the claim invalid under the on-sale bar, 35 U.S.C. § 102(b). The district court granted Mr. Junker's motion for summary judgment of no invalidity under the on-sale bar. The district court thereafter held a bench trial on several remaining issues in the case, including MedComp's remaining invalidity challenges, infringement, and damages. The court again ruled in Mr. Junker's favor. The court rejected each of MedComp's invalidity challenges, found that each of the accused products infringed the D'839 patent claim and that the infringement was willful, and awarded Mr. Junker \$1,247,910 in damages under 35 U.S.C. § 289, which allows recovery of an infringer's profits from sale of the infringing products.

MedComp appeals the district court's summary judgment of no invalidity under the on-sale bar, the judgment of infringement, and the damages award. For the reasons below, we agree with MedComp that the pre-critical date letter was a commercial offer for sale. Because there is no dispute that the claimed design was ready for patenting, we reverse the district court's summary judgment of no invalidity. We therefore do not reach the remaining issues on appeal.

*Appendix A***BACKGROUND****I**

The D’839 patent, at the heart of the dispute on appeal, is titled “Handle for Introducer Sheath,” and includes a single claim for “[t]he ornamental design for a handle for introducer sheath, as shown and described.” D’839 patent, claim. Figure 1 shows a perspective view of the claimed design (represented with solid lines):



Id. Fig. 1. Mr. Junker filed the application that led to the D’839 patent on February 7, 2000. Thus, the critical date for analyzing the on-sale bar under § 102(b)¹ is February 7, 1999, one year before the filing date.

1. Congress amended § 102 when it enacted the Leahy—Smith America Invents Act (AIA). Pub. L. No. 112-29, § 3(b)(1), 125 Stat. 284, 285-87 (2011). However, because the application that led to the D’839 patent was filed before March 16, 2013, the pre-AIA § 102 applies. *See id.* § 3(n)(1), 125 Stat. at 293.

*Appendix A***A**

Mr. Junker started working in the medical device industry in the 1970s. In the late 1970s, Mr. Junker started his own company for purchasing and reselling catheter kits. These kits typically included a needle, syringe, guidewire, and introducer sheath that were used for inserting a catheter into the vein of a patient. Mr. Junker's company also designed and manufactured some components in the kits, including the introducer sheath. In the mid-1980s, Mr. Junker began developing a new design for the introducer sheath based on his experience observing catheter-insertion procedures. Mr. Junker focused on the design for the introducer sheath's handle, eventually settling on a handle with large, rounded Mickey-Mouse-shaped ears that made it easier for doctors to grasp the introducer sheath during catheter-insertion procedures. The handle was designed such that the sheath could be peeled apart into two pieces when removing the sheath while leaving the catheter in place in the patient's body. These products are referred to as "peelable," "peel-away," or "tearaway" introducer sheaths.

Mr. Junker, however, did not have the proper machinery to manufacture the product. He began reaching out to other companies to handle the actual manufacture of his new design. Eventually, in 1998, Mr. Junker developed a business relationship with James Eddings, the founder of a medical device company called Galt Medical. At their first meeting in August 1998, Mr. Junker and Mr. Eddings entered into a non-disclosure agreement (Mr. Junker on behalf of his company and Mr. Eddings on behalf of

Appendix A

Galt), after which Mr. Junker told Mr. Eddings about his new design for the introducer sheath handle. The next month, in September 1998, Mr. Eddings informed Mr. Junker that Galt could manufacture Mr. Junker's product. Around this same time, Mr. Eddings also founded a new company, Xentek Medical, to develop, manufacture, and sell tearaway introducer sheath products.

Over the course of the next several months, Mr. Junker and Mr. Eddings continued to discuss Mr. Junker's new design. Mr. Eddings enlisted the help of an engineer, Richard Gillespie, to sketch out Mr. Junker's proposed design. After some back and forth, Mr. Gillespie provided Mr. Junker with a sketch of the design. This sketch, however, was lacking the handles with Mickey Mouse ears that Mr. Junker had envisioned. In a fax dated December 16, 1998, Mr. Junker relayed his critiques of the sketch to Mr. Eddings, noting the absence of larger, rounded portions on the handle and providing a rough sketch of his design as he had imagined it. Mr. Eddings asked Mr. Gillespie to modify the sketch accordingly. In January 1999, Mr. Eddings' company, Xentek, developed and provided to Mr. Junker a prototype of the product that included all of the features of his design, including (importantly) a handle with Mickey Mouse ears.

B

In early January 1999, Mr. Eddings, through Xentek, began communicating with Boston Scientific Corporation regarding a peelable introducer sheath product. In response to a request from Boston Scientific, on January 8,

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1999, Xentek sent Boston Scientific a letter detailing bulk pricing information for variously sized peelable introducer sheath products. The letter stated:

Thank you for the opportunity to provide this quotation for the Medi-Tech Peelable Sheath Set. When we first received this request for quotation we were under the mistaken impression that you wanted the exact configuration as the drawing that was provided which would have required extensive tooling expense. Subsequently, we have learned that this is not the case and are pleased to submit this quotation for a product of our design.

...

The principals of Xentek Medical have extensive experience in the design, development and manufacture of this type of medical device. If you should have any specific dimensional requirements this product could generally be tailored to your specifications.

J.A. 1572.

The January 8, 1999 letter also included a price chart (shown below), and specified that the “prices are for shipment in bulk, non-sterile, FOB [free on board] Athens, Texas on a net 30-day basis”:

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Size	ORDER QUANTITIES			
	5,000	10,000	25,000	50,000
4F-6F	\$4.45	\$4.25	\$4.05	\$3.95
7F-8F	4.70	4.50	4.30	4.20
11F	5.05	4.85	4.75	4.70

J.A. 1573. Mr. Eddings concluded the letter by noting his appreciation for “the opportunity to provide this quotation” and that he “look[ed] forward to discussing [Boston Scientific’s] requirements in person.” *Id.*

Mr. Eddings sent additional letters to Boston Scientific in January and February 1999.

II

In 2013, Mr. Junker sued MedComp, accusing four of MedComp’s products of infringing the claimed design. MedComp, in response, raised affirmative defenses of invalidity, unenforceability, and noninfringement and filed counterclaims seeking a declaratory judgment that the claimed design is invalid, unenforceable, and not infringed.

Following several years of discovery, in 2017, the parties filed cross-motions for summary judgment on several issues, including, as relevant here, invalidity under the onsale bar. The crux of the parties’ disagreement was whether the January 8, 1999 letter from Xentek to Boston Scientific—which was sent before the critical date—was a commercial offer for sale of a product embodying the claimed design. The district court held that it was not as a matter of law. *See Junker v. Med. Components, Inc.*,

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CIVIL ACTION No. 13-4606, 2019 U.S. Dist. LEXIS 1530, 2019 WL 109385, at *10 (E.D. Pa. Jan. 4, 2019). In so holding, the district court determined that the letter was a preliminary negotiation, not a definite offer. *Id.* The court specifically focused on the fact that the letter thrice uses the word “quotation” and concludes with an invitation to further discuss specific requirements. 2019 U.S. Dist. LEXIS 1530, [WL] at *9-10. The district court acknowledged that the letter included numerous, specific, commercial terms (such as payment terms, shipment terms, and delivery conditions), supporting a conclusion that the letter was a commercial offer for sale. The court ultimately determined, however, that the presence of these terms did not outweigh the other language in the letter suggesting that Xentek and Boston Scientific were engaged in preliminary negotiations. 2019 U.S. Dist. LEXIS 1530, [WL] at *10. The district court accordingly granted Mr. Junker’s motion for summary judgment of no invalidity under the on-sale bar.

The case then proceeded to trial on the remaining issues, namely MedComp’s remaining invalidity defenses, the questions of infringement and willfulness, and damages. As to invalidity, the district court determined that MedComp had failed to prove, by clear and convincing evidence, invalidity of the claimed design based on any of its various asserted theories. *Junker v. Med. Components, Inc.*, CIVIL ACTION No. 13-4606, 2021 U.S. Dist. LEXIS 7694, 2021 WL 131340, at *1 (E.D. Pa. Jan. 14, 2021). It also found that Mr. Junker had demonstrated, by a preponderance of the evidence, that each of the accused products infringed the claimed design, and that the

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infringement was willful. *Id.* The district court awarded Mr. Junker \$1,247,910 in disgorged profits under 35 U.S.C. § 289. *Id.* No enhanced damages were awarded in connection with the willfulness finding.

MedComp appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION**I**

We begin and end with MedComp’s challenge to the district court’s summary judgment of no invalidity under the on-sale bar. We review the district court’s summary judgment under the law of the regional circuit, here the Third Circuit. *See SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1306 (Fed. Cir. 2019). “The Third Circuit reviews a grant of summary judgment de novo, applying the same standard as the district court.” *Id.* (citing *Gonzalez v. Sec’y of Dep’t of Homeland Sec.*, 678 F.3d 254, 257 (3d Cir. 2012)). Summary judgment is appropriate when, drawing all justifiable inferences in the nonmovant’s favor, there exists no genuine issue of material fact and the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

II

A patent claim is invalid under § 102(b) if “the invention was . . . on sale in this country, more than one

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year prior to the date of the application for patent in the United States.” Section 102(b)’s on-sale bar is triggered if, before the critical date, the claimed invention was both (1) the subject of a commercial offer for sale and (2) ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67-68, 119 S. Ct. 304, 142 L. Ed. 2d 261 (1998). “Whether the on-sale bar applies is a question of law based on underlying factual findings.” *Meds. Co. v. Hospira, Inc.*, 827 F.3d 1363, 1371 (Fed. Cir. 2016) (en banc). We review the ultimate determination of whether a claim is invalid under the on-sale bar de novo. *Id.*

The material facts here are not in dispute. The parties agree that the January 8, 1999 letter speaks for itself. They also agree that the products described in the letter embody the claimed design. And they agree that the claimed design was ready for patenting. The question before us is therefore a simple one: Whether the January 8, 1999 letter is a commercial offer for sale of the claimed design, or merely a quotation signaling the parties were engaged in preliminary negotiations. Because the facts are not disputed, we review the question of whether this particular communication constitutes a commercial offer for sale (a question of law) without deference. *See In re Kollar*, 286 F.3d 1326, 1329 (Fed. Cir. 2002); *see also, e.g., Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1049-52 (Fed. Cir. 2001). For the reasons below, we hold that the letter is a commercial offer for sale of the claimed design.

In making this determination, we look to the specific facts and circumstances presented in this case, “apply[ing] traditional contract law principles” along the way. *Merck*

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& Cie v. Watson Lab'ys, Inc., 822 F.3d 1347, 1351 (Fed. Cir. 2016) (quoting *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352 (Fed. Cir. 2002)). “Only an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under § 102(b).” *Id.* at 1351 (quoting *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1048 (Fed. Cir. 2001)). To help guide our determination of whether a given communication rises to the level of a commercial offer for sale, we often rely on resources such as the Uniform Commercial Code, Restatement (Second) of Contracts, and other similar treatises. *See, e.g., Meds. Co.*, 827 F.3d at 1375-76 (discussing Uniform Commercial Code); *Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*, 855 F.3d 1356, 1365 & n.5 (Fed. Cir. 2017) (citing favorably Williston on Contracts (4th ed. 2013), Restatement (Second) of Contracts (1981), and Corbin on Contracts (1999)), *aff'd*, 139 S. Ct. 628, 202 L. Ed. 2d 551 (2019). “In determining whether an offer [has been] made[,] relevant factors include the terms of any previous inquiry, the completeness of the terms of the suggested bargain, and the number of persons to whom a communication is addressed.” Restatement (Second) of Contracts § 26 cmt. c (1981).

With this background in mind, we turn to the language in the January 8, 1999 letter. As stated on the face of the letter, Xentek was directly responding to a “request for quotation” from Boston Scientific, and the letter was addressed to Boston Scientific alone. J.A. 1572. This signals that the letter was not an unsolicited price

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quotation or invitation to negotiate, but rather a specific offer to Boston Scientific to take further action. *See* Restatement (Second) of Contracts § 26 cmt. c (explaining that a relevant factor for determining whether an offer is made is “the number of persons to whom a communication is addressed”).

The letter also contains a number of necessary terms typical for a commercial contract. For instance, the letter specifies that the prices provided are for “shipment in bulk, non-sterile.” J.A. 1573. Thus, the letter provides specific delivery conditions—the product will be shipped in “bulk” and will be “non-sterile.” The letter further specifies that shipment will be “FOB Athens, Texas.” *Id.* FOB (which stands for free on board) is a standard commercial term used to allocate the risks and responsibilities of the buyer and seller with respect to delivery, payment, and loss of the product. *See Free on Board*, Black’s Law Dictionary (11th ed. 2019). The letter also provides a payment term, “net 30-day basis,” J.A. 1573, meaning that payment is due in full within 30 days of delivery.

Finally, and importantly, Xentek’s letter specifies multiple different purchase options for its peelable sheath products. For example, the letter offers 5,000 sets of size 4F-6F Medi-Tech Peelable Sheath at a price of \$4.45 per set and offers discounted prices if the purchase quantity is increased (e.g., the price per set decreases to \$4.25 for 10,000 sets of the same size sheath, \$4.05 for 25,000, and \$3.95 for 50,000). The letter also offers Boston Scientific the option to purchase two additional sizes of Xentek’s Medi-Tech Peelable Sheath Set—7F-8F and 11F—with

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similarly discounted pricing as the purchase quantity increases.

While the letter concludes with an invitation to further discuss Boston Scientific's specific requirements in person, "expressing a desire to do business in the future does not negate the commercial character of the transaction then under discussion." *Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359, 1370 (Fed. Cir. 2007). The completeness of the relevant commercial sale terms in the letter itself signals that this letter was not merely an invitation to further negotiate, but rather multiple offers for sale, any one or more of which Boston Scientific could have simply accepted to bind the parties in a contract.²

We have determined that communications with similarly complete and definite commercial terminology were commercial offers for sale within the meaning of § 102(b). For example, in *Merck*, we disagreed with the district court's determination that a certain fax did not rise to the level of a commercial offer for sale of the claimed invention. The fax specified a product, set forth the price of the product (\$25,000 per kilogram), the location for delivery (the buyer's research and development center), payment terms (net 60 days), and the amount to be purchased (two kilograms, with the option to purchase additional product). 822 F.3d at 1349. We explained

2. We also note that subsequent communications between Xentek and Boston Scientific after the critical date used the exact same commercial terms, providing some indication that these terms were definite, not in flux. *See, e.g.*, J.A. 1577 (February 16, 1999 letter from Xentek to Boston Scientific).

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that this was not just “an unsolicited price quote sent to numerous potential customers.” *Id.* at 1351 (citing Restatement (Second) of Contracts § 26 cmt. c). Rather, the “fax was sent in direct response to [the buyer’s] request to purchase two kilograms” of the product. *Id.* We also found it highly relevant that the fax “provid[ed] essential price, delivery, and payment terms.” *Id.* Because the fax “contained all the required elements to qualify as a commercial offer for sale,” we reversed the district court’s determination that the claims were not invalid under the on-sale bar. *Id.* at 1351, 1355.

In a similar vein, in *Cargill*, we agreed with the district court that the relevant letter was a commercial offer for sale. That letter was sent to confirm a request for a certain amount of canola oil. 476 F.3d at 1369. The letter “explicitly set[] forth an amount of oil to be delivered . . . , at a specified unit price, and under a standard contract designation, FOB (free on board).” *Id.* We explained that this was “powerful evidence of a sales transaction,” *id.*, and accordingly affirmed the district court’s summary judgment of invalidity under the on-sale bar.

Here, as in *Merck* and *Cargill*, the letter—which specifies multiple sized products for sale, different bulk pricing options available for each product, payment terms (net 30-day basis), and delivery terms and conditions (bulk shipment, non-sterile, FOB)—contains all the required elements to qualify as a commercial offer for sale. That is sufficient to invoke § 102(b)’s on-sale bar.

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Mr. Junker argues that the letter omits essential terms—which size product is being purchased and in what quantity—and, therefore, the letter is not an offer that could be made into a binding contract by simple acceptance. Appellee’s Br. 15. We are not persuaded. The standard Mr. Junker proposes—that the offer must specify the exact amount of product the buyer desires to qualify as an offer for sale—is too stringent. Under § 102(b), the question is merely whether there is an offer for sale. As explained above, the letter here offers for sale multiple sizes of products with tiered pricing depending on the number of sets desired. That there were multiple offers does not mean that there was no offer to be accepted. And that the letter does not specify the exact amount Boston Scientific desires likewise does not mean that there is no offer to be accepted. Rather, the letter comprises multiple different offers that Boston Scientific could have accepted by simply stating, for example, “We’ll take 5,000 sets of the 4F-6F Medi-Tech Peelable Sheath” or “10,000 sets of the 11F Medi-Tech Peelable Sheath.”

Mr. Junker also argues, as the district court determined, that the January 8, 1999, letter was merely a price quotation inviting further negotiations, not a definite offer. Appellee’s Br. 15-16, 19. To be sure, the fact that the letter uses the word “quote” three times is an important fact supporting the district court’s conclusion that the letter is a quotation, not a definite offer. *See* Restatement (Second) of Contracts § 26 cmt. c. (“[T]he word ‘quote’ is commonly understood as inviting an offer rather than as making one, even when directed to a particular customer.”). This fact makes the question

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before us closer than in either *Merck* or *Cargill*. “But just as the word ‘offer’ does not necessarily mean that an offer is intended, so the word ‘quote’ may be used in an offer.” Restatement (Second) of Contracts § 26 cmt. c. While the precise label used for a given communication is relevant, it is not controlling. Rather, the terms of the communication must be considered in their entirety to determine whether an offer was intended, or if it was merely an invitation for an offer or further negotiations. A quotation typically leaves many terms necessary to a contract—such as place of delivery, payment terms, and the like—unexpressed. Corbin on Contracts § 2.5, at 157 (2018); *accord* Restatement (Second) of Contracts § 26 cmt. c (explaining that a quote “may omit the quantity to be sold, time and place of delivery, terms of payment, and other terms”). Where, however, “the quotation . . . contains detailed terms,” as is the case here, “it may well be deemed an offer.” Corbin on Contracts § 2.5, at 161. For the reasons above, we conclude that the specificity and completeness of the commercial terms in the letter outweigh the three references to “quotation” and mention of possible future discussions. Taken as a whole, the overall language of the letter signals Xentek’s intent to make a commitment and invite Boston Scientific to act rather than merely negotiate.

CONCLUSION

We have considered the parties’ remaining arguments and find them unpersuasive. For the foregoing reasons, we agree with MedComp that the January 8, 1999 letter was a commercial offer for sale of the claimed design. Because

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the parties do not dispute that the invention was ready for patenting, we reverse the district court's summary judgment of no invalidity. The effect of our determination renders the sole claim of the D'839 patent invalid and we therefore need not reach MedComp's remaining arguments on appeal.

REVERSED

**APPENDIX B — ORDER OF THE UNITED
STATES DISTRICT COURT FOR THE EASTERN
DISTRICT OF PENNSYLVANIA, FILED
OCTOBER 9, 2019**

IN THE UNITED STATES DISTRICT COURT FOR
THE EASTERN DISTRICT OF PENNSYLVANIA

No. 13-4606

LARRY G. JUNKER,

Plaintiff,

v.

MEDICAL COMPONENTS, INC., *et al.*,

Defendants.

ORDER

AND NOW, this 8th day of October, 2019, upon consideration of Defendants’ “Motion for Partial Reconsideration” (Doc. No. 222), and Plaintiff’s response in opposition thereto, I find as follows:

I. FACTUAL AND PROCEDURAL BACKGROUND

1. On August 8, 2014, Plaintiff initiated this action for patent infringement, alleging that Defendants have made or sold products that infringe a design patent held by Plaintiff.¹

1. The facts of this case are set out in greater detail in my January 4, 2019 Memorandum Opinion on the parties’ cross-motions for summary judgment. (*See* Doc. No. 219.)

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2. On January 4, 2019, I issued a Memorandum Opinion and Order (the “Memorandum Opinion”) granting in part and denying in part the parties’ cross-motions for summary judgment on Plaintiff’s infringement claims and several of Defendants’ invalidity defenses.

3. One of those invalidity defenses on which both parties moved for summary judgment was the on-sale bar.

4. As stated in the Memorandum Opinion, a patent is invalid under the “on-sale bar” set out in 35 U.S.C. § 102(b), if, more than one year before the filing of the patent application with the Patent and Trademark Office (the “PTO”), two conditions are met: “(1) the claimed invention [was] the subject of a commercial offer for sale; and (2) the invention [was] ready for patenting.” *Hamilton Beach Brands, Inc. v. Sunbeam Prods., Inc.*, 726 F.3d 1370, 1375 (Fed. Cir. 2013).

5. Defendants argued that the on-sale bar applied because, in January 1999, Xentek Medical Inc. (“Xentek Medical”)² offered, in two separate letters, to sell a product embodying the patented design to a company called Boston Scientific.

6. I found that the January 1999 letters constituted preliminary negotiations, rather than definite offers, and

2. In August 1998, Plaintiff met with James Eddings, the owner of Galt Medical Corporation, to discuss the development and marketing of an “introducer sheath,” used in the medical insertion of catheters. Shortly thereafter, in September 1998, Eddings founded a new company called Xentek Medical Inc.

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did not trigger the on-sale bar. Accordingly, I granted Plaintiff's motion for summary judgment on this defense.

7. Defendants seek reconsideration of that decision. For the reasons set forth below, Defendants' motion will be denied.

II. LEGAL STANDARD

7. A motion for reconsideration or motion to alter or amend judgment is properly raised under Federal Rule of Civil Procedure 59(e). *Keifer v. Reinhart Foodservs., LLC*, 563 F. App'x 112, 114 (3d Cir. 2014). "The standard for obtaining relief under Rule 59(e) is difficult to meet." *Invista N. Am. S.A.R.L. v. M & G USA Corp.*, 35 F. Supp. 2d 583, 593 (D. Del. 2014). "The purpose of a motion for reconsideration . . . is to correct manifest errors of law or fact or to present newly discovered evidence." *Max's Seafood Cafe ex rel. Lou-Ann, Inc. v. Quinteros*, 176 F.3d 669, 677 (3d Cir. 1999) (quoting *Harsco Corp. v. Zlotnicki*, 779 F.2d 906, 909 (3d Cir. 1985)). A motion for reconsideration must rely upon one of the following grounds: "(1) an intervening change in controlling law; (2) the availability of new evidence that was not available when the court [rendered its decision]; or (3) the need to correct a clear error of law or fact or to prevent manifest injustice." *Id.* (citing *N. River Ins. Co. v. CIGNA Reinsurance Co.*, 52 F.3d 1194, 1218 (3d Cir. 1995)).

8. A motion for reconsideration is not an "opportunity for a party to relitigate already decided issues and should not be used 'to put forward additional arguments, which

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[the movant] could have made but neglected to make before judgment.” *Garzella v. Borough of Dunmore*, No. 05-1626, 2007 WL 1450416, at *2 (M.D. Pa. May 15, 2007) (quoting *Dodge v. Susquehanna Univ.*, 796 F. Supp. 829, 830 (M.D. Pa. 1992)). “Stated another way, a motion for reconsideration is *not properly grounded in a request for a district court to rethink a decision it has already made, rightly or wrongly.*” *Williams v. City of Pittsburgh*, 32 F. Supp. 2d 236, 238 (W.D. Pa. 1998) (emphasis added). “Because federal courts have a strong interest in the finality of judgments, motions for reconsideration should be granted sparingly.” *In re Asbestos Prods. Liab. Litig. (No. VI)*, 801 F. Supp. 2d 333, 334 (E.D. Pa. 2011) (quoting *Cont’l Cas. Co. v. Diversified Indus., Inc.*, 884 F. Supp. 937, 943 (E.D. Pa. 1995)).

III. DISCUSSION**A. Failure to Analyze Whether the Letter was a Legal Offer under the U.C.C. and Federal Circuit Criteria**

9. Defendants argue that, when assessing whether an offer was made, I committed legal error by not following “controlling Federal Circuit authority which holds that courts are to be guided by the [Uniform Commercial Code (“U.C.C.”)], and the federal and state courts interpreting the states’ individual versions of it.” (Defs.’ Motion at 6.) Defendants contend that, although I recited the correct standard for determining whether a communication constitutes an offer, I did not examine the January 1999 communications under the U.C.C. and considered

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only Comment C to § 26 of the Restatement (Second) of Contracts (the “Restatement”).³ I disagree for several reasons.

10. First, my Memorandum Opinion expressly recognized that the Federal Circuit looks to the U.C.C. to ascertain the law of contracts. (Doc. No. 219 at 21.) I also relied on Federal Circuit criteria set forth in *Group One Ltd. v. Hallmark Cards, Inc.*, which cited to both the U.C.C. and the Restatement in support of not applying the on-sale bar. 254 F.3d 1041, 1047-48 (Fed. Cir. 2001).

11. Moreover, the U.C.C. is merely a guide for determining whether a valid offer exists. *Id.* at 1048

3. In support of this argument, Defendants also contend that I declined to rely on deposition testimony offered by Plaintiff and Defendants regarding the parties’ intent to be bound or lack thereof. However, intent not expressed objectively and contemporaneously to the January 1999 letters does not control my analysis. *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1052 (Fed. Cir. 2001) (citing *Abbott Labs. v. Alpha Therapeutic Corp.*, 164 F.3d 385, 37 (7th Cir. 1999)) (“In order to be effective, an acceptance must *objectively* manifest the offeree’s assent . . . the parties’ objective, expressed intent—not their secret, subjective intent—controls whether a bargain has been struck.”). The parties’ post hoc statements cannot override the language of the letters themselves. *Merck & Cie v. Watson Labs., Inc.*, 822 F.3d 1346, 1354 (Fed. Cir. 2016); see *Linear Tech. Corp.*, 275 F.3d at 1051 (“[I]n any given circumstance, . . . what constitutes a definite offer, requires looking closely at the language of the proposal.” (internal quotation marks omitted)). Therefore, my finding that no legal offer had been made was appropriately based on the language in each letter, and not the parties post-hoc deposition testimony.

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("[T]he district court used the UCC as one of its guides in reaching its conclusion [W]e do [not] propose to offer rules or even binding guidance for making [] determinations [on whether a set of interactions between parties constitutes a commercial offer to sell]."). "[T]he UCC is a model code—it *does not itself have the force of law*" *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1048 (Fed. Cir. 2001) (emphasis added). In fact, the U.C.C. does not itself define "offer." *Id.* at 1050; *Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1307 (Fed. Cir. 2002). Therefore, courts will look to common law to determine whether a valid offer exists. *Linear Tech.*, 275 F.3d at 1050 (relying on the Restatement's definition of offer in its on-sale bar analysis); *Minnesota Mining*, 303 F.3d at 1307–08 (same).

12. Finally, although the U.C.C. is a source of guidance for whether an offer of sale was made, Federal Circuit precedent acknowledges that it is not the only appropriate source. *See, e.g., Group One, Ltd.*, 254 F.3d at 1047–48. The Federal Circuit has expressly relied on the Restatement, and cases interpreting it, to guide its determination of what constitutes an offer for sale. *See, e.g., Linear Tech.*, 275 F.3d at 1050 (relying on § 26 of the Restatement in finding that the communications at issue did not constitute a valid offer); *see also Minnesota Mining*, 303 F.3d at 1307 (same). Moreover, the Supreme Court of the United States has also cited the Restatement "with approval" in the commercial contract law context. *Group One, Ltd.*, 254 F.3d at 1048 (citing *Mobile Oil, Inc. v. United States*, 530 U.S.604, 606–10 (2000)).

*Appendix B***B. Failure to Consider that the Federal Circuit Does Not Require an “Offer” to Contain All Material Terms of a Contract**

14. Defendants also argue that I committed legal error by failing to consider that, under the U.C.C.’s Statute of Frauds and cases interpreting it, an offer for sale need not contain all of the material terms of a contract to be valid; it need only contain the quantity term. Plaintiff responds that this argument “conflates the question of whether a commercial offer of sale is made under contract and patent law with the question of whether a writing is sufficient to satisfy the statute of frauds where the existence of a contractual relationship is uncontested.” (Pl.’s Opp. at 5.) I agree. Defendants’ arguments based on the U.C.C. Statute of Frauds are misplaced. The question before me is not whether the January 1999 letters satisfy the Statute of Frauds—where the parties otherwise do not contest their intent to be bound—but rather whether the price quotations in these letters are sufficiently definite that another party could make a binding contract by simple acceptance. *See Hamilton Beach*, 726 F.3d at 1375.

15. Defendants further contend that courts have “routinely” concluded that price quotations create an offer, even where additional details, “such as timing and payment terms,” need to be worked out. (Defs.’ Motion at 9 (quoting *In re Method of Processing Ethanol Byproducts & Related Subsystems* (‘858) *Patent Litig.*, 303 F. Supp. 3d 791, 888 (S.D. Ind. 2014)).) Plaintiff responds that Defendants have misrepresented the facts of *In re Method of Processing Ethanol Byproducts* and that they

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are distinguishable from the facts of this case. I agree that *In re Method of Processing Ethanol Byproducts* is not relevant to my inquiry. In that case, there were contemporaneous communications between the parties, indicating that they believed the proposal at issue to be a commercial offer. *In re Method of Processing Ethanol Byproducts*, 303 F. Supp. 3d at 887–88. Moreover, it was undisputed that a “sale on approval” contract was common in the industry and recognized by the Federal Circuit as a source to help determine whether a communication is a commercial offer. *Id.* at 888.

C. Failure to Analyze the Letter Under the “Proper” Criteria

16. Finally, Defendants argue that I erred by giving “too much weight to the letter’s use of the term ‘quotation’ and its boilerplate language, and too little weight to the . . . clear and objective factors indicating that the letter was indeed a legal offer that would create a binding contract upon acceptance.” (Defs.’ Motion at 9.) I disagree.

17. I expressly considered each term included in the letters, but ultimately found that they were not persuasive in light of not only the lack of a definite quantity term and delivery time, but also language that I found to establish an invitation to further negotiations.⁴

4. (*See* Petruzzi Decl., Ex. 46 (“When we first received this request for quotation we were under the mistaken impression that you wanted the exact configuration of the drawing that was provided Subsequently, we have learned that this is not the case and are pleased to submit this quotation for a product of our

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18. Moreover, Defendants' argument is not that I, in fact, failed to consider the terms set out in the letters, but rather that I placed too much weight on certain terms and too little on others. Defendants' disagreement with the result of my decision does not rise to the level of a clear error of law or manifest injustice. *See Williams*, 32 F. Supp. 2d at 238. This type of argument is an inappropriate basis for reconsideration. *Id.* ("A motion for reconsideration is not properly grounded in a request for a district court to rethink a decision it has already made, rightly or wrongly.").

IV. CONCLUSION

19. For the foregoing reasons, I find no clear error of law or manifest injustice warranting reconsideration.

WHEREFORE, it is hereby **ORDERED** that Defendants' "Motion for Partial Reconsideration" (Doc. No. 222) is **DENIED**.

design. . . . The device we are proposing is in the final stages of development I appreciate the opportunity to provide this quotation and look forward to discussing your requirements in person."); (*see also* Petruzzi Decl., Ex. 47 ("I appreciate your continued interest in Xentek Medical. . . . Based on our discussions, Xentek Medical will prepare a quotation on the larger sizes of peelable sheath introducers. . . . In addition, you had indicated your interest in developing hemostatic peelable sheaths. . . . Therefore, I would like to have the opportunity to review your requirements and provide a project plan to complete this project."))

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BY THE COURT:

/s/ Mitchell S. Goldberg

MITCHELL S. GOLDBERG, J.

**APPENDIX C — MEMORANDUM OPINION OF
THE UNITED STATES DISTRICT COURT FOR
THE EASTERN DISTRICT OF PENNSYLVANIA,
FILED JANUARY 4, 2019**

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT
OF PENNSYLVANIA

CIVIL ACTION No. 13-4606

LARRY G. JUNKER,

Plaintiff,

v.

MEDICAL COMPONENTS, INC., *et al.*,

Defendants.

January 4, 2019, Decided;
January 4, 2019, Filed

MITCHELL S. GOLDBERG, J.

MEMORANDUM OPINION

This is an action for infringement of a design patent. Plaintiff, Larry Junker, is the owner of U.S. Design Patent Number D450,839, entitled “Handle for Introducer Sheath” (the “D’839 Patent”). Plaintiff contends that Defendants, Medical Components, Inc. and Martech Medical Products, Inc., have violated 35 U.S.C. § 271,

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et seq., by selling medical devices embodying Plaintiff's patented design. Defendants allege non-infringement and that the D'839 Patent is invalid.

Currently before me are the parties' cross-motions for summary judgment and *Daubert* motions. Both parties seek summary judgment on the infringement issue, as well as on certain invalidity defenses asserted by Defendants. For the reasons set out below, I conclude that there are disputed issues of material fact that preclude summary judgment in favor of either party on infringement, as well as on several asserted grounds of invalidity. As to those invalidity defenses for which there are no material facts in dispute, I conclude that Defendants have not, as a matter of law, met their burden of proving invalidity by clear and convincing evidence such that summary judgment is warranted. In short, most of the issues raised in these motions will have to be resolved through a trial.

I. FACTUAL & PROCEDURAL BACKGROUND

Many of the facts in this case are disputed, particularly those surrounding who invented the patented design. While the disputed facts are discussed in detail in Part III below, the following general facts are undisputed unless otherwise noted.

In August 1998, Plaintiff met with James Eddings, the owner of Galt Medical Corporation ("Galt Medical"), to discuss the development and marketing of an "introducer sheath," used in the medical insertion of catheters. Before this meeting, Plaintiff and Eddings executed a non-disclosure agreement. Shortly thereafter, in September

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1998, Eddings founded a new company, Xentek Medical Inc. (“Xentek Medical”). (Pl.’s SOF ¶ 2; Defs.’ SOF ¶ 2; Decl. of Larry G. Junker (hereinafter “Junker Decl.”) ¶ 6; Dep. of James Eddings (hereinafter “Eddings Dep.”) at 97:24-100:13; Decl. of James R. Eddings (hereinafter “Eddings Decl.”) ¶ 2.)

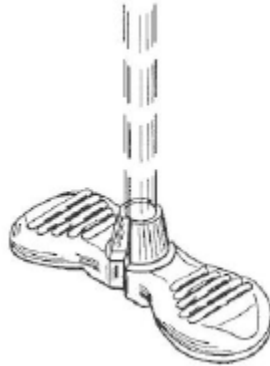
In November 1998, Plaintiff met with Eddings and one of Eddings’ associates, Richard Gillespie, to further discuss the development of an introducer sheath. Then, in December 1998, Plaintiff sent Eddings a fax about the design, noting that he “would really like to see longer (wider) handles,” and providing a sketch. Thereafter, Gillespie provided Plaintiff with drawings of a design. (Pl.’s SOF ¶¶ 6, 8, 10; Defs.’ SOF ¶¶ 6, 8, 10; Decl. of Richard Gillespie (hereinafter “Gillespie Decl.”) ¶ 6.)

On February 7, 2000, Plaintiff applied to the U.S. Patent and Trademark Office (“PTO”) for a design patent. On November 20, 2001, the PTO granted the application, issuing the patent at issue in this case, the D’839 Patent. The D’839 Patent lists Plaintiff as the sole inventor. (Pl.’s SOF ¶ 12; Defs.’ SOF ¶ 12; Decl. of James D. Petruzzi (“Petruzzi Decl.”), Ex. 15 at 1.)

The D’839 Patent contains a single claim: “The ornamental design for a handle for introducer sheath, as shown and described.” Included with the D’839 Patent are nine figures, which show the introducer sheath from different perspectives, including from the front, the side, above, and a cross-sectional view. Figure 1, shown below, is displayed on the first page of the D’839 Patent, and is illustrative of the overall design.

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The introducer is shown in solid lines. Broken lines illustrate the sheath itself, which is not part of the claimed design. The introducer has two Mickey Mouse ear shaped handles, referred to as “wings,” which are connected in the center by a cone-shaped “hub,” into which the sheath is inserted.

In January 2003, Plaintiff brought suit in the United States District Court for the Northern District of Texas, alleging that Eddings, Galt Medical, and Xentek Medical infringed the D’839 Patent. (This lawsuit is referred to hereinafter as “the Eddings Suit.”) Following a jury trial, the court entered judgment in favor of Plaintiff and against the Eddings Suit defendants. *See Junker v. Eddings*, No. 3:02-cv-0172, 2004 U.S. Dist. LEXIS 30874, 2004 WL 5552032 (N.D. Tex. Jan. 16, 2004). The jury concluded that the D’839 Patent was not invalid, and that the Eddings Suit defendants willfully infringed it. On appeal, the United States Court of Appeals for the Federal Circuit affirmed as to these issues. *See Junker v. Eddings*, 396 F.3d 1359 (Fed. Cir. 2005).¹ Following the conclusion of

1. The Federal Circuit reversed on the issue of attorneys’ fees, which is not relevant to the issues in this case.

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the Eddings Suit, the PTO re-examined the D'839 Patent and upheld its validity. (Pl.'s SOF ¶ 29, Defs.' SOF ¶ 29.)

Plaintiff brought this action on August 8, 2013, alleging that Defendants have made or sold four products that infringe the D'839 Patent. (These four products are referred to hereinafter as “the Accused Products”). The Accused Products are shown below, alongside the corresponding figures of the D'839 Patent:



2. As Defendants note, the Super Sheath and Super Sheath 2.0 are the same design, differing only in the material out of which the “dilator tube,” which is not part of the D'839 Patent’s design, is made. (See Defs.’ Mem. in Supp. 25.)

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Defendants answered and counterclaimed, contending that the D'839 Patent is invalid on various grounds, and that the Accused Products do not infringe. Following discovery, this matter proceeded to claim construction, where I construed the single claim of the D'839 Patent as follows:

The D'839 Patent claims the ornamental design of a handle for an introducer sheath, as shown in Figures 1-9. The broken lines in the Figures of the D'839 Patent represent unclaimed subject matter.

(Claim Construction Or., Doc. No. 192.) In reaching this construction, I rejected Defendants' proposal to set out a more detailed written description of the design. I also rejected Plaintiff's argument that the hub is functional and thus not part of the claimed design. Rather, I concluded that the hub contributes to the ornamentation of the overall design and is thus part of the claim.

Now, following claim construction, both parties have filed cross-motions for summary judgment. Both Plaintiff and Defendants contend that summary judgment in their favor on the issue of infringement is warranted. Plaintiff also moves for summary judgment on several of Defendants' asserted invalidity defenses, arguing that these defenses fail as a matter of law because Defendants have not met their burden of establishing them by clear and convincing evidence. Defendants, in turn, assert that summary judgment is appropriate on several grounds of invalidity, contending that no genuine dispute of material

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fact exists as to these defenses. Finally, Plaintiff contends that he is entitled to summary judgment on the issue of damages.

For the reasons that follow, I conclude that there are material facts in dispute that preclude summary judgment in favor of either party on infringement, as well as on several of the asserted grounds of invalidity. As to those invalidity defenses for which there are no material facts in dispute, I conclude that Defendants have not met their burden of proving invalidity by clear and convincing evidence.

II. LEGAL STANDARD FOR SUMMARY JUDGMENT

Summary judgment is appropriate where “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A party moving for summary judgment bears the initial burden of demonstrating that there are no genuine issues of material fact in dispute, and that judgment is appropriate as a matter of law. *Id.*; *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). However, once a properly supported motion for summary judgment has been made, the burden shifts to the non-moving party, who must set forth specific facts showing that there is a genuine issue of material fact for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

An issue is “genuine” if a reasonable jury could rule in favor of the non-moving party based on the evidence presented. *Kaucher v. Cnty. of Bucks*, 455 F.3d 418, 423

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(3d Cir. 2006). A factual dispute is “material” if it might affect the outcome of the suit under the appropriate governing law. *Id.* at 423. The non-moving party cannot avert summary judgment with speculation or conclusory allegations, but rather must cite to the record. *Ridgewood Bd. of Educ. v. N.E. for M.E.*, 172 F.3d 238, 252 (3d Cir. 1999); Fed. R. Civ. P. 56(c). On a motion for summary judgment, the court considers the evidence in the light most favorable to the non-moving party. *Anderson*, 477 U.S. at 256.

“The rule is no different where there are cross-motions for summary judgment,” because such cross-motions are “no more than a claim by each side that it alone is entitled to summary judgment, and the making of such inherently contradictory claims does not constitute an agreement that if one is rejected the other is necessarily justified or that the losing party waives judicial consideration and determination whether genuine issues of material fact exist.” *Lawrence v. City of Phila., Pa.*, 527 F.3d 299, 310 (3d Cir. 2008) (internal quotation marks omitted). Accordingly, while I will discuss together the overlapping issues raised by the parties’ cross-motions for summary judgment, I will bear in mind each party’s burden on summary judgment.

III. DISCUSSION OF CROSS-MOTIONS FOR SUMMARY JUDGMENT

A. Infringement

Plaintiff contends that he is entitled to summary judgment as to each of the Accused Products on the issue

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of infringement, because they all “appear substantially the same as [his] design.” (Pl.’s Mem. in Supp. 4.) Defendants respond that the Accused Products are so different from the design embodied by the D’839 Patent that “the ordinary observer would never be deceived into thinking that” the designs were the same, and thus I should deny Plaintiff summary judgment and instead grant summary judgment in their favor. (Defs.’ Mem. in Supp. 25.) I disagree with both Plaintiff and Defendants, and conclude that summary judgment in favor of neither party is appropriate.

“A design patent is infringed if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015) (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008)) (alterations and internal quotation marks omitted). In making this determination, differences between the patented design and the claimed design “must be evaluated in the context of the claimed design as a whole, and not in the context of separate elements in isolation.” *Id.* Thus, “[a]n element-by-element comparison, untethered from application of the ordinary observer inquiry to the overall design, is procedural error.” *Id.*; see also *Payless Shoesource, Inc. v. Reebok Int’l Ltd.*, 998 F.2d 985, 991 (Fed. Cir. 1993) (explaining that, because the “ultimate question requires determining whether the effect of the whole design is substantially the same[,] . . . minor

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differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement" (internal quotation marks and alterations omitted)).

Infringement is a question of fact, which the patent holder must prove by a preponderance of the evidence. *See Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 819 (Fed. Cir. 1992). Accordingly, summary judgment in favor of an alleged infringer is appropriate "where the claimed and the accused designs are 'sufficiently distinct' and 'plainly dissimilar,'" because, in such cases, "the patentee fails to meet its burden of proving infringement as a matter of law." *Ethicon Endo-Surgery, Inc.*, 796 F.3d at 1335. Thus, in *Ethicon*, the United States Court of Appeals for the Federal Circuit concluded that the district court had appropriately granted summary judgment in favor of the alleged infringer, where "there could be no genuine dispute that the claimed designs and the design of [the] accused [products] were plainly dissimilar because they simply did not look alike." *Id.*

Conversely, summary judgment in favor of the *patent holder* is appropriate only where there can be no genuine dispute that an ordinary observer, with knowledge of the prior art, would be deceived into thinking that the designs were the same. *See, e.g., Famosa, Corp. v. Gaiam, Inc.*, No. 11-cv-5703, 2012 U.S. Dist. LEXIS 22437, 2012 WL 573999, at *3 (S.D.N.Y. Feb. 22, 2012) (granting summary judgment to the patent holder on the issue of infringement and explaining that "not only are the designs substantially similar, they are nearly identical," such that "the accused product infringes the [design] patent as a matter of law").

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After careful examination of all pertinent products “in the context of the claimed design as a whole,” I conclude that this case presents neither of these scenarios in which summary judgment is appropriate. *Ethicon Endo-Surgery, Inc.*, 796 F.3d at 1335. Rather, a reasonable factfinder could find in favor of either party on the issue of infringement.

Reproduced again below is a side-by-side comparison of the Accused Products and the corresponding figures of the D’839 Patent:



Plaintiff emphasizes the ways in which the D’839 Patent and the Accused Products are very similar. Specifically, Plaintiff notes that each design contains

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Mickey Mouse ear shaped wings, and that these wings have an “upswept” configuration—or, in other words, are angled away from the insertion point of the sheath. Additionally, Plaintiff notes that, in both the D’839 Patent and the Accused Products, the top and bottom surfaces of the wings have similar configurations of “ribs”—which are the raised lines visible on the surfaces of the wings. Plaintiff notes that in both the D’839 Patent and each of the Accused Products, the ribs are equally-spaced, are oriented parallel to each other and perpendicular to the length of the wings, and generally conform to the shape of the wings by lengthening in the middle of each wing.

Defendants maintain that Plaintiff focuses too narrowly on the wings, ignoring the different hub designs. Defendants note that while the D’839 Patent calls for a tapered, cone-shaped hub, three of the Accused Products—Super Sheath, Super Sheath 2.0, and Super Sheath Valved 2.0—have a hub that is “stepped.” The different hub configurations are indicated by arrows below:



Super Sheath and Super Sheath 2.0



Figure 6 of the D’839 Patent



Super Sheath Valved 2.0



Super Sheath Valved

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Defendants also contend that the Accused Products differ from the D’839 Patent in that each of the Accused Products have a “locking mechanism” that is *external*, whereas the D’839 Patent’s locking mechanism is *internal*. The “locking mechanism” is the feature, located on the underside of the introducer that secures the sheath. Each of the locking mechanisms are indicated below by a rectangular box:



Super Sheath and Super Sheath 2.0



Figure 6 of the D’839 Patent



Super Sheath Valved 2.0



Super Sheath Valved

Defendants also maintain that there are significant differences in the wings of the D’839 Patent and those of the Accused Products. While there is an “upswept” appearance to the wings in each of the Accused Products, Defendants note that two of them—Super Sheath Valved and Super Sheath Valved 2.0—are swept up at a sharper angle. And while the other two products—Super Sheath and Super Sheath 2.0—are swept up at an angle closer to that shown in the figures of the D’839 Patent, Defendants note that their products have a more “angular construction.” In other words, the wings of Super Sheath

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and Super Sheath 2.0 appear to extend straight out before sweeping down at an angle, whereas the wings illustrated in the D'839 Patent appear to immediately curve downward from the hub. A side view is illustrative:



Defendants further note that Super Sheath Valved and Super Sheath Valved 2.0 each have “gussets”—which connect the upper portion of the hub with each of the wings. Arrows in the illustration below point to gussets in Super Sheath Valved and Super Sheath Valved 2.0, alongside the corresponding figure from the D'839 Patent, which lacks gussets.



Having considered the similarities and differences between the D'839 Patent and the Accused Products, I conclude that the designs are neither “plainly dissimilar” nor “nearly identical,” such that summary judgment in favor of either party on the issue of infringement would be appropriate.

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The Mickey Mouse ear shape of the wings, their upswept configuration, and the orientation of the ribs on the top and bottom surfaces, are all visually prominent features common to the D’839 Patent and each of the Accused Products. Accordingly, despite the differences pointed out by Defendants, I cannot conclude that the *overall* designs are so plainly dissimilar that no reasonable jury could conclude that the designs are substantially the same. See, e.g., *Amini Innovation Corp. v. Anthony California, Inc.*, 211 F. App’x 938, 941 (Fed. Cir. 2007) (reversing district court’s grant of summary judgment in favor of an alleged infringer of a design patent, and noting that, based on a “compari[son] [of] the overall visual appearance of [the accused and patented designs], we are not prepared to say that a jury could not reasonably conclude that [the] accused design is similar enough in ornamental appearance to [the patented] design that an ordinary observer would be likely to purchase one . . . thinking it was the other”); *Durdin v. Kuryakyn Holdings, Inc.*, 440 F. Supp. 2d 921, 933 (W.D. Wisc. 2006) (denying summary judgment in favor of an alleged infringer of a design patent, despite “observable differences between the [patented and accused] designs,” because “[j]urors, who are ordinary observers, could examine the designs and reasonably conclude that they are substantially similar”).

However, the differences pointed out by Defendants are visually significant enough that I also cannot conclude that the designs are “nearly identical.” *Famosa, Corp.*, 2012 U.S. Dist. LEXIS 22437, 2012 WL 573999, at *3. Therefore, I cannot conclude that no reasonable juror

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could find other than that the designs are substantially similar. Accordingly, both Plaintiff's and Defendants' motions for summary judgment will be denied as to the issue of infringement, and this issue will have to be decided by a factfinder.

B. *Invalidity*

In addition to seeking summary judgment on the issue of infringement, the parties have cross-moved for summary judgment on several grounds of invalidity raised by Defendants. Plaintiff argues that Defendants cannot meet their burden of proving these invalidity defenses by clear and convincing evidence. Defendants maintain that there is no genuine dispute of material fact as to several of these invalidity defenses, and that the D'839 Patent is invalid as a matter of law.

Like utility patents, design patents are presumed to be valid. *Ethicon Endo-Surgery, Inc.*, 796 F.3d at 1328. Accordingly, an alleged infringer "has the burden to prove invalidity of [a design patent] by clear and convincing evidence." *Id.* "Although an exact definition is elusive, clear and convincing evidence has been described as evidence that places in the ultimate factfinder an abiding conviction that the truth of its factual contentions are highly probable." *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1360 (Fed. Cir. 2007) (internal quotation marks and citations omitted).

With this standard in mind, I turn to whether a reasonable factfinder could find in favor of Defendants as

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to the invalidity defenses at issue in the parties' cross-motions for summary judgment. Seven such defenses are at issue here: (1) indefiniteness; (2) the on-sale bar; (3) inventorship; (4) inequitable conduct; (5) obviousness; (6) prosecution history estoppel; and (7) patent misuse. Plaintiff contends that Defendants cannot meet their burden as to any of these defenses, which thus fail as a matter of law. Defendants respond that, as to the first three defenses, there is no genuine dispute of material fact, and that they have established invalidity as a matter of law such that summary judgment in their favor is warranted. As to the last four defenses, Defendants contend that there are material facts in dispute, such that Plaintiff's motion for summary judgment should be denied. I address each of these seven invalidity defenses in turn.

1. Indefiniteness

Defendants contend that the D'839 Patent is invalid as indefinite, based on a number of alleged inconsistencies in the patent's figures. Both Plaintiff and Defendants seek summary judgment as to this issue.

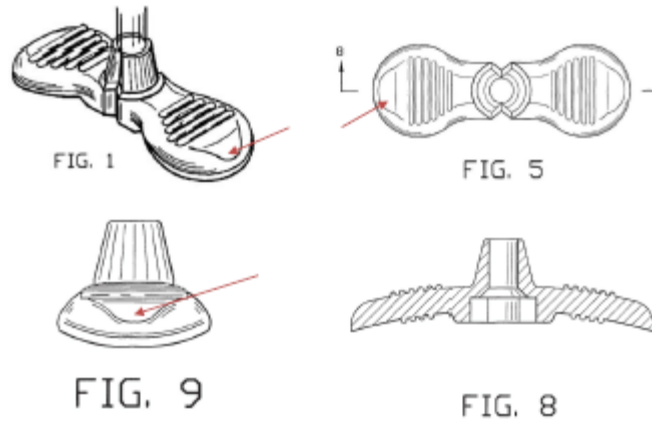
A design patent is invalid as indefinite under 35 U.S.C. § 112 "if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure." *In re Maatita*, 900 F.3d 1369, 1377 (Fed. Cir. 2018). The visual disclosure of a design patent may fail to inform an ordinary observer of the scope of the claim where the patent includes "multiple, internally inconsistent drawings." *Id.* However, such inconsistencies

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do not render the patent indefinite where “they do not preclude the overall understanding of the drawing as a whole.” *Id.* (internal quotation marks omitted). Rather, inconsistencies render the patent invalid only where they “are of such magnitude that the drawings, taken as a whole, fail to inform, with reasonable certainty, those skilled in the art about the overall appearance of the design.” *Deckers Outdoor Corp. v. Romeo & Juliette, Inc.*, 2016 U.S. Dist. LEXIS 166153, 2016 WL 7017219, at *4 (C.D. Cal. Dec. 1, 2016). This is a question of law to be decided by the court. *See Amgen Inc. v. F. Hoffmann-La Roche, Ltd.*, 580 F.3d 1340, 1371 (Fed. Cir. 2009).

Defendants argue that the D’839 Patent is indefinite in light of four inconsistencies in its figures: (1) the presence of a “scallop” on each wing; (2) the location of a facet, or “step,” in the hub; (3) the angle of the “proximal boss;” and (4) the number of ribs—five or six. For the reasons discussed below, I conclude that these four purported inconsistencies, considered individually or together, do not render the D’839 Patent indefinite.

First, Defendants argue that it is unclear whether the D’839 Patent calls for each wing to have a “scallop”—that is, an indentation or depression in the surface of the wing. Defendants contend that this feature is present in Figures 1, 2, 3, 4, 5, and 9, as indicated by the arrows below, but absent from Figure 8, which shows a cross-sectional view:

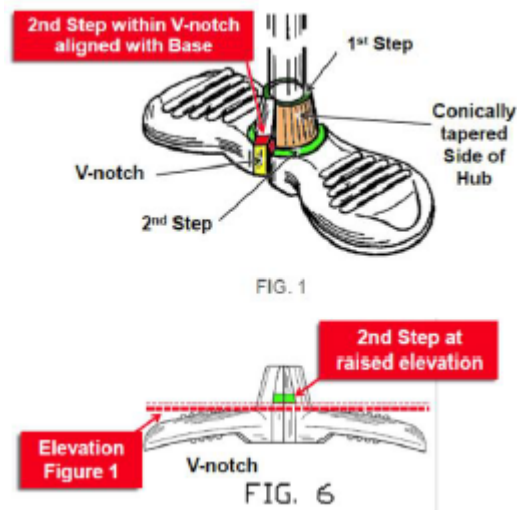
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Plaintiff responds that the patented design includes no such “scallop,” and that the curved line present in Figures 1, 5, and 9 above is merely “a drawing convention to show the transition from the upper surface of the [wing] to the rounded end.” (Pl.’s Opp’n 7.)

Defendants have not provided evidence that the curved line represents a scallop feature rather than merely the downward curvature of the wing. Defendants’ expert, Richard Meyst, does not explain his conclusion that the curved line represents a scallop. (*See* Expert Report of Richard Meyst (hereinafter “Meyst Report”) ¶ 103.) Accordingly, Defendants have not established that a scallop feature is even present in the figures that they point to. And even if such a feature is present, it is not clear that the omission of the feature from the side and cross-sectional views is an omission of such magnitude that it renders the *overall* appearance of the design uncertain.

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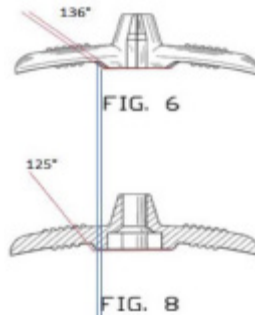
Second, Defendants contend that the D'839 Patent is inconsistent as to the location of a facet, or “second step”, within the V-shaped “notch” on the hub. Defendants contend that Figures 1, 2, and 5 illustrate the second step at the base of the hub, but that Figures 3 and 6 show the second step at a higher elevation. Defendants’ brief includes the following illustrations in support of their position:



Plaintiff responds that the difference in the location of the second step is minor and does not significantly affect the overall visual impression, as it is “barely visible on an actual product” embodying the design. (Pl.’s Opp’n 6.) I agree with Plaintiff that this inconsistency—to the extent that it is, in fact, an inconsistency, and not merely the result of a difference in perspective between the figures—is minor, and thus does not render the overall visual impression of the design uncertain.

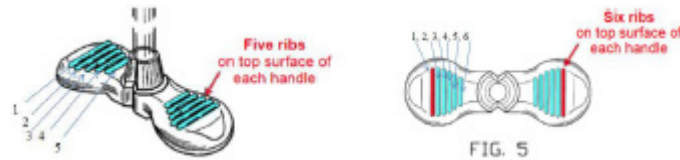
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Third, Defendants contend that the figures of the D'839 Patent inconsistently depict the “angle of the proximal boss,” which is the angle between the base of the underside of the introducer, and the surface that is rising toward the wings. Defendants maintain that Figure 6 (the side view) shows the angle to be about 136 degrees, whereas Figure 8 (the cross-sectional view) shows the angle to be about 125 degrees. Defendants’ brief supports this contention with the illustration below.



Plaintiff responds that this difference in angle is minor and “only discernable when magnifying the drawings well beyond the actual size of the item.” (Pl.’s Opp’n 6.) I agree with Plaintiff that a eleven-degree variation in this angle makes little, if any, difference to the overall visual impression of the design, and thus does not render the design uncertain.

Fourth and finally, Defendants point to the exact number of ribs on the top surface of the wings. While Figures 1 and 2 show five ribs, Figures 3 through 6, and 8, show six ribs. Defendants’ brief provides the following illustrations:

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Plaintiff responds that whether there are five or six ribs is not significant. What matters, Plaintiff argues, is the orientation of the ribs on the surface. Specifically, Plaintiff notes that the ribs are equally spaced, run parallel to each other and perpendicular to the length of the wings, and generally conform to the shape of the wings, getting shorter as the wing curves in towards the hub. I agree with Plaintiff that the precise number of ribs—five or six—does not significantly affect the overall visual impression of the design.

In sum, considered separately or together, the inconsistencies identified by Defendants—to the extent that they are, in fact, inconsistent—do not render the D’839 Patent indefinite, because they do not prevent an ordinary observer from determining the overall visual impression of the design. *See Deckers Outdoor Corp.*, 2016 U.S. Dist. LEXIS 166153, 2016 WL 7017219, at *4 (concluding that a design patent for a boot was not indefinite where “the Court [was] not ‘clearly’ convinced that the discrepancies [in the patent figures] [were] of such magnitude that a boot designer and manufacturer could not determine with reasonable certainty the overall appearance of the boot”). Accordingly, as to indefiniteness, Plaintiff’s motion for summary judgment will be granted, and Defendants’ motion denied.

*Appendix C***2. On-Sale Bar**

Defendants next contend that the D'839 Patent is invalid because a product embodying the patented design was offered for sale more than one year before Plaintiff applied for the patent. Plaintiff responds that the product was not offered for sale before that date. Both parties seek summary judgment as to this issue.

A patent is invalid under the “on-sale bar” set out in 35 U.S.C. § 102(b), if, more than one year before the filing of the patent application with the PTO, two conditions are met: “(1) the claimed invention [was] the subject of a commercial offer for sale; and (2) the invention [was] ready for patenting.” *Hamilton Beach Brands, Inc. v. Sunbeam Prods., Inc.*, 726 F.3d 1370, 1375 (Fed. Cir. 2013). To be “the subject of a commercial offer for sale,” the patented design need not have been actually sold. *Id.* Rather, an *offer* to sell “is sufficient so long as it is sufficiently definite that another party could make a binding contract by simple acceptance.” *Id.* (internal quotation marks omitted).

Plaintiff filed his patent application on February 7, 2000. Thus, the critical date for purposes of the on-sale bar is February 7, 1999. If a product embodying the claimed design was offered for sale before that date, then the D'839 Patent is invalid.

Here, Defendants argue that the on-sale bar applies because, in January 1999, Eddings offered to sell a product embodying the patented design to a company called Boston Scientific. As evidence, Defendants offer two

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letters that Eddings sent to Boston Scientific on behalf of his company, Xentek Medical, during that month: one on January 8, 1999, and one on January 25, 1999. Plaintiff responds that neither letter constitutes a sufficiently definite offer to trigger the on-sale bar.

Whether a communication constitutes a sufficiently definite offer is a question of law, governed not by a specific state's law of contracts, but rather by the case law of the Federal Circuit interpreting "the law of contracts as generally understood." *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1047 (Fed. Cir. 2001). In ascertaining the law of contracts, the Federal Circuit looks primarily to the Uniform Commercial Code and the Restatement of Contracts. *See id.* at 1047-48.

Section 26 of the Restatement (Second) of Contracts distinguishes communications that are definite offers from those that are merely "preliminary negotiations." The latter consists of communications in which "the person to whom [the communication] is addressed knows or has reason to know that the person making it does not intend to conclude a bargain until he has made a further manifestation of assent." Restatement (Second) of Contracts § 26 (1981). Such communications include price quotations, which the commentary to the Restatement describes as follows:

c. Quotation of price. A "quotation" of price is usually a statement of price per unit of quantity; it may omit the quantity to be sold, time and place of delivery, terms of payment,

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and other terms. It is sometimes associated with a price list or circular, but the word “quote” is commonly understood as inviting an offer rather than as making one, even when directed to a particular customer. But just as the word “offer” does not necessarily mean that an offer is intended, so the word “quote” may be used in an offer. In determining whether an offer is made relevant factors include the terms of any previous inquiry, the completeness of the terms of the suggested bargain, and the number of persons to whom a communication is addressed.

Restatement (Second) of Contracts § 26 cmt. c (1981).

Applying these principles to the two letters that Eddings sent to Boston Scientific in January 1999, it is clear that they constitute preliminary negotiations, rather than definite offers to sell.

First, both letters use the word “quotation” and not the word “offer.” The January 8 letter uses the word three times: “Thank you for the opportunity to provide this *quotation* for the Medi-Tech Peelable Sheath Set. . . . When we first received this request for *quotation* we were under the mistaken impression that you wanted the exact configuration of the drawing that was provided Subsequently, we have learned that this is not the case and are pleased to submit this *quotation* for a product of our design.” (Petruzzi Decl., Ex. 46 (emphasis added.)) The January 25 letter likewise uses the term “quotation”:

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“Based on our discussions, Xentek Medical will prepare a *quotation* on the larger sizes of peelable sheath introducers.” (Petruzzi Decl., Ex. 47 (emphasis added.))

While use of the term “quotation” rather than “offer” is not, by itself, dispositive, other language in both the January 8 and January 25 letters suggests an invitation to further negotiations rather than an offer for immediate acceptance. The January 8 letter concludes: “I appreciate the opportunity to provide this quotation and *look forward to discussing your requirements in person.*” (Petruzzi Decl., Ex. 46 (emphasis added.)) Likewise, Eddings closes the January 25 letter by noting that he “would like to have the opportunity to review your requirements and provide a project plan to complete this project.” (Petruzzi Decl., Ex. 47 (emphasis added.)). Courts have held similar language to constitute preliminary negotiations rather than definite offers. *See, e.g., Goss Int’l Americas, Inc. v. Graphic Mgmt. Assocs., Inc.*, 739 F. Supp. 2d 1089, 1121 (N.D. Ill. 2010) (holding that certain “budgetary proposals” were preliminary negotiations that did not trigger the on-sale bar where the proposals “thanked the [recipient] ‘for the opportunity to submit this information as we look forward to working very closely with you on this project’”).

Defendants emphasize that the January 8 letter included several specific terms, including a payment term (“on a net 30-day basis”), a shipment term (“FOB Athens, Texas”),³ and a delivery conditions term (“non-sterile”),

3. “FOB” stands for “free on board,” which is “a mercantile-contract term allocating the rights and duties of the buyer and the seller of goods with respect to delivery, payment, and risk of loss,

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in addition to providing four choices of unit quantities and their corresponding per-unit prices. While the inclusion of these terms does cut in favor of interpreting the January 8 letter as a definite offer, this consideration is ultimately outweighed by the other language discussed above, as well as by the fact that another key term, a specific delivery time, was left unspecified. *See, e.g., Goss Int'l Americas, Inc.*, 739 F. Supp. 2d at 1121-1122 (holding that a document did not constitute an offer despite the inclusion of “some terms” where other terms, including “specific time of delivery” and “a firm price term” were “left open-ended and subject to change”).

Because the January 8 and January 25 letters constitute preliminary negotiations, rather than definite offers, they do not trigger the on-sale bar and thus do not render the D’839 Patent invalid. Accordingly, Plaintiff’s motion for summary judgment as to this issue will be granted and Defendants’ motion denied.

3. Inventorship

Defendants next contend that the D’839 Patent is invalid because Plaintiff is not the sole inventor of the claimed design and that the design was invented, at least in part, by Gillespie. Plaintiff responds that he is the sole inventor of the design, and that Defendants cannot meet

whereby the seller must clear the goods for export, and the buyer must arrange for transportation.” *Black’s Law Dictionary* 737 (9th ed. 2009).

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their burden of proving otherwise.⁴ Both Plaintiff and Defendants seek summary judgment on this issue.

As with utility patents, a design patent may only issue to a person who “invents” the design. 35 U.S.C. § 171. Thus, the “naming of the correct inventor or inventors [is] a condition of patentability; failure to name them renders

4. In addition to arguing that Defendants’ inventorship defense fails on the merits, Plaintiff contends that the defense fails for two procedural reasons. First, Plaintiff contends that inventorship issues “are not in this case” because they were stricken from Defendants’ Third Amended Answer. (Pl.’s Opp’n 15; *see also* Pl.’s Mem. in Supp. 26 n.12.) While I did strike a *footnote* that related to inventorship from Defendants’ Third Amended Answer because Defendants had added the footnote without leave to do so, I did not disturb the *body* of Defendants’ Third Affirmative Defense within their Third Amended Answer, which asserts invalidity on multiple grounds, including “the requirements set forth in 35 U.S.C. § . . . 102,” which includes inventorship. Plaintiff did not challenge the legal sufficiency of the Third Affirmative Defense. Accordingly, Plaintiff is incorrect that inventorship issues “are not in the case.”

Second, Plaintiff contends that Defendants’ inventorship defense is precluded by the doctrine of collateral estoppel, noting that inventorship of the D’839 Patent was at issue in the Eddings Suit, in which another district court upheld the validity of the patent. However, because Defendants were not parties to the Eddings Suit, nor in privity with any of the parties to the Eddings Suit, the outcome of the Eddings Suit may not be used as collateral estoppel against them in this case. *See Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1091 (Fed. Cir. 1987) (holding that a patent holder could not use the outcome of a previous case, in which the patent-in-suit’s validity was upheld, as collateral estoppel against an alleged infringer, because the alleged infringer was not a party to the previous case).

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a patent invalid.” *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998).

“An inventor under the patent laws is the person or persons who conceived the patented invention.” *Hoop v. Hoop*, 279 F.3d 1004, 1007 (Fed. Cir. 2002) (internal quotation marks omitted). A person conceives of an invention when he “form[s] in [his] mind . . . a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Id.* In turn, “[a]n idea is sufficiently ‘definite and permanent’ when ‘only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.’” *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998).

While a “conceived invention must include every feature of the subject matter claimed in the patent,” an invention may be conceived by “co-inventors,” each of whom need only “perform . . . a part of the task which produces the invention.” *Ethicon, Inc.*, 135 F.3d at 1460. However, a person does not become a co-inventor “by merely assisting the actual inventor after conception of the claimed design.” *Id.* Thus, in the design patent context, a person does not become a co-inventor by “merely refin[ing] and perfect[ing]” the inventor’s sketch of the design. *See Hoop*, 279 F.3d 1004, 1008 (granting a preliminary injunction to patent holders in an infringement action, notwithstanding the alleged infringers’ claim to have invented the claimed design, where the alleged infringers had merely been hired by the patent holders “to create detailed drawings and three-dimensional models for a

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patent application” based on the sketches provided by the patent holders).

“While inventorship is a question of law, it is based on underlying facts.” *Safco Prods. Co. v. Welcom Prods.*, 799 F. Supp. 2d 967, 978 (D. Minn. 2011) (internal quotation marks and alterations omitted) (quoting *Univ. of Pittsburgh of the Commonwealth Sys. of Higher Educ. v. Hedrick*, 573 F.3d 1290, 1297 (Fed. Cir. 2009)). Here, as discussed below, Plaintiff’s account of the facts surrounding the invention of the patented design diverges substantially from the accounts of Eddings and Gillespie. Because the material facts surrounding who invented the claimed design are in dispute, summary judgment in favor of either Plaintiff or Defendants on the issue of inventorship is not appropriate.

a. Plaintiff’s Account

Plaintiff maintains that he, and he alone, invented the design embodied by the D’839 Patent. In support of his position, he has submitted a declaration stating that, in 1998, he “conceived a new introducer handle design involving a two[-]part Mickey Mouse eared handle, with an upswept configuration, having ribs on the top and bottom of the handle,” which ribs “were oriented on the two surfaces and generally conformed to the outer periphery of the rounded handles.” (Junker Decl. ¶ 5.) Plaintiff declares that he “disclosed all of the details” of this design to Eddings during a meeting in August 1998, conducted under a non-disclosure agreement, believing that Eddings’ company, Galt Medical, “would be capable of

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making [his] device.” (*Id.* ¶¶ 6-7.) Thereafter, according to Plaintiff’s declaration, Galt Medical prepared “a prototype drawing of [Plaintiff’s] new design,” as well as a three-dimensional model, though this model “did not include the rounded Mickey Mouse ears.” (*Id.*)

After receiving this model, Plaintiff sent a fax to Eddings advising that he “would really like to see larger (wider) handles,” because “[t]he prospective customers seemed to like this design.” (Junker Decl. ¶ 9; Petruzzi Decl., Ex. 12.) According to Plaintiff, Gillespie then integrated the “large rounded ear Mickey Mouse” handles into subsequent drawings, which Gillespie prepared and shared with Plaintiff. (Junker Decl. ¶ 11.)

Plaintiff contends that “[o]ver the next year and [a] half, [Eddings’ company] Xentek [Medical] proceeded to refine the CAD [computer-aided design] drawings for the manufacture of a device which included the ornamental handle.” (Junker Decl. ¶ 12.) Plaintiff maintains that Gillespie provided him copies of these CAD drawings, because these drawings were “developed for [Plaintiff], at [Plaintiff’s] direction.” (*Id.* ¶ 13.) Plaintiff declares that he then provided these drawings to his “patent attorney and . . . draftsman,” who used them to create the drawings that Plaintiff ultimately submitted to the PTO with his application for what became the D’839 Patent. (*Id.*)

**b. Eddings and Gillespie’s Account,
Relied on by Defendants**

The accounts of Eddings and Gillespie, on which Defendants rely, substantially diverge from Plaintiff’s

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account. Gillespie provided a declaration stating, contrary to Plaintiff's declaration, that he never "serve[d] as a draftsman for the purpose of documenting . . . any ideas originating from [Plaintiff]." (Gillespie Decl. ¶ 4.) Rather, Gillespie declares, he and Eddings created the design for an introducer, to which Plaintiff only contributed "a suggestion . . . that the tear-away introducer sheath hub exhibit 'a wider, more bulbous profile' if viewed from the long axis of the component." (*Id.*) Gillespie admits that he "provided copies of drawings" of this design to Plaintiff, but declares that he "had no knowledge that [Plaintiff] intended to use these drawings to support an application to be filed with the [PTO]." (*Id.* ¶ 6.)

Gillespie declares that he conceived of several of the design elements embodied in the D'839 Patent. Specifically, he declares that he conceived of "the backswept wing shape of the handles," as a means of "provid[ing] the holder of the handle more leverage." He also declares that he invented "[t]he rearward-extending face of the hub," and the "rectangular lines near the center of the hub." (Gillespie Decl. ¶¶ 7-9.)

Like Gillespie, Eddings declares that he and Gillespie designed an introducer "without any contribution from [Plaintiff] except to make the handles bigger." (Eddings Dep. at 108:5-14.) Indeed, when Eddings was asked in his deposition what contribution Plaintiff made to the design illustrated in Figures 5 through 7 of the D'839 Patent, Eddings responded "absolutely none," stressing that "[t]hese were my drawings." (*Id.* at 136:13-21.)

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In light of these widely diverging accounts of the circumstances surrounding the invention of the patented design, summary judgment in favor of either party would be inappropriate. *See, e.g., Safco Prods. Co.*, 799 F. Supp. 2d at 986-991 (denying cross-motions for summary judgment on the issue of inventorship of a design patent where the witness' testimony "paint[ed] two vastly different—and quite irreconcilable—factual pictures"). A reasonable jury could credit Eddings and Gillespie's account of what occurred in late 1998, and conclude that Plaintiff was not the sole inventor of the patented design. However, a reasonable jury could also conclude—as a jury did in the previous Eddings Suit—that there is not clear and convincing evidence that someone other than Plaintiff was an inventor of the design. Accordingly, both Plaintiff's and Defendants' motions for summary judgment as to inventorship will be denied.

4. Obviousness

Defendants also contend that the D'839 Patent is invalid because it is obvious in light of the prior art. While Defendants do not move for summary judgment as to this defense, conceding that there are material facts in dispute, Plaintiff does move for summary judgment as to this issue, contending that the defense fails as a matter of law.

A design patent is invalid for obviousness under 35 U.S.C. § 103 if "the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved." *Apple, Inc. v. Samsung Elecs.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). To conclude that this

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standard is met, the court must “find a single reference [in the prior art] . . . the design characteristics of which are basically the same as the claimed design.” *Id.* While “other references may be used to modify [this primary reference] to create a design that has the same overall visual appearance as the claimed design,” the “secondary references may only be used to modify the primary reference if they are so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* at 1330.

“Obviousness is a question of law . . . , based on underlying factual questions” *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). “The underlying factual inquiries include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness.” *Id.* Accordingly, summary judgment is appropriate only “when the factual inquiries into obviousness present no genuine issue of material facts.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991).

In support of their asserted obviousness defense, Defendants identify as a primary reference a utility patent obtained by Gillespie, U.S. Patent Number 6,336,914 (the “Gillespie Patent”), as modified by three other secondary references in the prior art: (1) U.S. Patent Number 5,885,217 (the “Gisselberg Patent”); (2) U.S. Patent Number 5,762,630 (the “Bley Patent”); and (3) U.S. Patent

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Number 4,772,266 (the “Groshong Patent”). Plaintiff maintains that Defendants’ argument “that [the Gillespie Patent] is a primary reference is completely undercut by the patent office having already determined it is non-enabling art and not anticipatory in the reexamination.” (Pl.’s Mem. in Supp. 21.)

Plaintiff is correct that where the PTO has reexamined the patent-in-suit, and rejected the prior art references that the alleged infringer contends invalidate the patent, the alleged infringer “has the added burden of overcoming the deference due to the PTO.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1304 (3d Cir. 2008). However, even in such a case, the PTO’s decision is not binding on the court, which must still determine whether the patent is invalid as obvious. And here, Defendants have pointed to two patents in the prior art—the Groshong Patent and the Gisselberg Patent—that the PTO does not appear to have considered.⁵ Importantly, Plaintiff does not address these two patents in his briefing, nor does Plaintiff’s expert, Peter Bressler, address these prior art references in his expert report. Rather, both merely parrot the PTO’s decision.

Accordingly, Plaintiff has not met his initial burden in moving for summary judgment of demonstrating that there is no genuine dispute of material fact regarding Defendants’ obviousness defense. Both the scope and

5. Defendants contend that the Bley Patent was not before the PTO. (Defs.’ Opp’n 12.) But the PTO’s reexamination decision shows that it considered and rejected the Bley Patent as a secondary reference in its obviousness analysis. (Def.’s Mot., Ex. 7 at ¶ 11.)

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content of the prior art and the differences between the claimed invention and the prior art, appear to be in genuine dispute. Plaintiff's motion for summary judgment as to obviousness will therefore be denied.

5. Inequitable Conduct

Defendants also contend that the D'839 Patent is invalid due to inequitable conduct on the part of Plaintiff. Defendants do not move for summary judgment as to this defense, but Plaintiff does, contending that the defense fails as a matter of law.⁶

To render a patent unenforceable based on the patentee's inequitable conduct during the application process, an alleged infringer must prove "by clear and convincing evidence that the patent applicant made misrepresentations or omissions material to patentability, that he did so with the specific intent to mislead or deceive the PTO, and that deceptive intent was the single most reasonable inference to be drawn from the evidence." *Ohio Willow Wood Co. v. Alps S., LLC*, 813 F.3d 1350, 1357 (Fed. Cir. 2016). If an alleged infringer proves such an intentional and material misrepresentation by clear and convincing evidence, then the court must "balance

6. Plaintiff also moves for summary judgment as to Defendants' Fifth Affirmative Defense, which lists a number of equitable defenses including "unclean hands." Because an inequitable conduct defense is broader in scope and includes a defense of "unclean hands," the analysis as to inequitable conduct below applies equally to Defendants' unclean hands defense. *See Therasense, Inc. v. Becton, Dickinson, & Co.*, 649 F.3d 1276, 1287 (Fed. Cir. 2011).

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the substance of those . . . proven facts and all the equities in the case to determine whether the severe penalty of unenforceability should be imposed.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1367 (Fed. Cir. 2008). But a court must first determine whether an intentional and material misrepresentation was made, and may not enter summary judgment on this issue where there are material facts in dispute.

The parties’ arguments as to inequitable conduct mirror those as to inventorship discussed in Part III.B.3, above. Defendants maintain that Plaintiff was not the inventor of the design embodied by the D’839 Patent and that, accordingly, a reasonable factfinder could conclude that Plaintiff intentionally misled the PTO when he applied for a patent using drawings created by Gillespie without naming Gillespie as an inventor. Plaintiff responds that he and he alone invented the patented design and that, accordingly, he did not make any misrepresentation to the PTO by failing to name Gillespie.

Because who invented the design embodied in the D’839 Patent remains in genuine dispute, Plaintiff’s motion for summary judgment as to inequitable conduct will be denied.

6. Prosecution History Estoppel

Plaintiff also seeks summary judgment on Defendants’ Sixth Affirmative Defense, prosecution history estoppel, which Plaintiff contends lacks any factual support.

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Prosecution history estoppel is a “rule of patent construction” that requires the claims of a patent be interpreted consistent with the prosecution proceedings before the PTO. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733, 122 S. Ct. 1831, 152 L. Ed. 2d 944 (2002). Thus, when a patentee narrows the scope of his patent during the prosecution proceedings in an effort to avoid invalidity, he may not then turn around and claim the previously conceded scope in an action for patent infringement. *See id.* (explaining that a patentee’s narrowing of the claim scope to avoid a finding of invalidity by the PTO acts “as a concession that the invention as patented does not reach as far as the original claim”).

Here, however, Defendants have not identified any position that Plaintiff took before the PTO to narrow the scope of the patented design in order to avoid invalidity. Defendants contend that Plaintiff “fail[ed] to amend the drawings of his patent application so the drawings only cover the ‘Mickey Mouse’ shape of the illustrated design,” and that this estops him from “trying to now argue that the claim covers less than what is shown in solid line[s] in the drawings.” (Defs.’ Opp’n 25). But even if a failure to amend a patent constitutes grounds for applying prosecution history estoppel, I have already construed the D’839 Patent as including not only the Mickey Mouse ear shape of the wings, but everything illustrated in solid lines, including the hub. Thus, it is not clear what further relief Defendants seek through an assertion of a prosecution history estoppel defense.

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Defendants also contend that Plaintiff “abandoned [a] reissue application that attempted to amend the [s]pecification of the [D’839 Patent]” and that this “estops [Plaintiff] from trying to recapture what he previously gave up in that reexamination proceeding and his related reissue proceeding,” specifically a “priority [date] prior to the filing date of the [D’839 Patent] (February 7, 2000).” (Defs.’ Opp’n 25.). However, Defendants cite no case in which prosecution history estoppel doctrine has been applied to the abandonment of a reissue application, nor any case in which the doctrine has been applied to estop a patent holder from claiming an earlier priority date.

Because Defendants have not articulated any basis for the application of prosecution history estoppel, Plaintiff’s motion for summary judgment as to this defense will be granted.

7. Patent Misuse

Plaintiff also seeks summary judgment as to Defendants’ Seventh Affirmative Defense, patent misuse. As with prosecution history estoppel, Plaintiff contends that there is no factual support for the defense.

Patent misuse applies where a patent holder has “impermissibly broadened the physical or temporal scope of the patent grant with anticompetitive effect.” *Windsurfing Int’l Inc. v. AMF, Inc.*, 782 F.2d 995, 1002 (Fed. Cir. 1986) (internal quotation marks omitted). For example, an accused infringer may invoke the doctrine where the patent holder has imposed “restrictive

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conditions on licenses” of the patented product, such as a tying arrangement that requires a would-be licensee to purchase an additional, unneeded product from the patent holder. *See Princo Corp. v. Int’l Trade Comm’n*, 616 F.3d 1318, 1328 (Fed. Cir. 2010). “What patent misuse is about, in short, is patent leverage, i.e., the use of the patent power to impose overbroad conditions on the use of the patent in suit that are not within the reach of the monopoly granted by the Government.” *Id.* at 1331 (internal quotation marks omitted).

Defendants do not contend that Plaintiff has leveraged the D’839 Patent to impose additional conditions on a would-be licensee or purchaser. Rather, Defendants contend that Plaintiff has committed patent misuse by “asserting a claim of patent infringement based on an impermissibly broadened scope of what the claim of the patent covers,” and did so “knowing [that] he was not the inventor of the claimed design.” (Defs.’ Opp’n 25.) However, Defendants cite no case in which the doctrine has been applied to render a patent unenforceable merely because the patent holder has brought an action for patent infringement that he knows to be meritless. And the United States Court of Appeals for the Federal Circuit has rejected similar uses of the patent misuse doctrine, explaining that the doctrine “has largely been confined to a handful of specific [anticompetitive] actions,” and warning against expansion of the doctrine into “an open-ended pitfall.” *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1373 (Fed. Cir. 1998) (holding that a “jury instruction on patent misuse” was overbroad, where it “focused primarily on the charge that [the patent holder] was attempting to enforce the patents against goods known not to be infringing”).

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Because Defendants have not identified any facts supporting a claim for patent misuse, Plaintiff's motion for summary judgment as to this defense will be granted.

C. Damages

Plaintiff also moves for summary judgment on the issue of damages, raising two damages-related arguments. First, Plaintiff contends that one measure of damages, the amount of Defendants' profits from sales of the Accused Products, is undisputed. Second, Plaintiff argues that Defendants' Fourth Affirmative Defense—in which Defendants contend that Plaintiff's damages are limited due to Plaintiff's failure to mark patented products—fails as a matter of law. For the reasons discussed below, Plaintiff's motion for summary judgment on the issue of damages will be denied.

First, I need not decide whether the amount of Defendants' profits is in genuine dispute, because a trial is required on the remaining issues of infringement and invalidity. This trial could result in a finding of non-infringement or invalidity, thus obviating any need to determine damages. Accordingly, Plaintiff's motion for summary judgment as to Defendants' profits will be denied.⁷

7. For the same reason, Plaintiff's motion will be denied as to his additional argument that he is entitled to damages of at least \$250 per unit, pursuant to 35 U.S.C. § 289.

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In his second argument, Plaintiff contends that Defendants' Fourth Affirmative Defense, in which Defendants posit that Plaintiff's damages for any infringement are limited because he failed to mark his patented products, fails as matter of law. For the reasons discussed below, Plaintiff's motion for summary judgment as to this issue will also be denied.

A patent holder that prevails in an action for patent infringement may generally recover damages for infringement extending back to six years before the filing of the complaint. 35 U.S.C. § 286. However, the patent marking statute, § 287, further limits damages where the patent holder fails to comply with certain marking requirements. Specifically, § 287 provides:

Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.," together with the number of the patent *In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice.*

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35 U.S.C. § 287(a) (emphasis added). Thus, under § 287, a patent holder that fails to mark his patented articles may only recover damages for infringement occurring after the alleged infringer received actual notice of infringement. And this limitation also applies where the patent holder's *licensees* have failed to mark the patented articles, because "the statute extends to persons making or selling any patented article for or under the patentee." *Arctic Cat Inc. v. Bombardier Rec. Prods.*, 876 F.3d 1350, 1366 (Fed. Cir. 2017).

Although Defendants have raised § 287 as an "affirmative defense," it is not, in fact, an affirmative defense on which they, as the alleged infringers, bear the burden of proof. *See Arctic Cat Inc.*, 876 F.3d at 1366 ("Section 287 is . . . a limitation on damages, and not an affirmative defense."). Rather, it is the Plaintiff, as the *patent holder*, that bears the burden of proving compliance with § 287 by a preponderance of the evidence. *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998). An alleged infringer bears only "an initial burden of production to articulate the products it believes are unmarked 'patented articles.'" *Arctic Cat Inc.*, 876 F.3d at 1368.

Defendants contend that § 287 limits the damages Plaintiff may recover, because Plaintiff licensed his patented design to at least one third party, C.R. Bard, Inc. ("C.R. Bard"), which did not mark the products for which it obtained the license. In support of their position, Defendants note that C.R. Bard and Plaintiff entered into a "Patent License and Settlement Agreement" in

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November 2006, under which Plaintiff granted C.R. Bard a license for products embodying the patented design.

Plaintiff responds that § 287 does not apply to the products covered by this agreement, because the agreement “was merely a litigation settlement . . . for prior sales . . . , not an ongoing license where the licensee would be manufacturing and selling product that even could be marked.” (Pl.’s Reply in Supp. 10.) Indeed, Plaintiff contends, the units covered by the agreement “were units Galt [Medical] manufactured,” that had “already [been] produced [by Galt Medical] and resold by [C.R.] Bard.” (*Id.*)

In support of Plaintiff’s position that the only products licensed were ones that C.R. Bard had already sold, and were thus incapable of being marked, Plaintiff points to the agreement itself, which provides a license for the following products:

. . . any introducer . . . sold to [C.R. Bard] by Galt Medical Corp., Xentek Medical Inc. and/or James R. Eddings which was accused in [a patent infringement suit brought by Plaintiff against C.R. Bard] of infringing the [D’839] Patent, namely the particular introducer sheath that C.R. Bard purchased from Galt [Medical] for which sales information was provided in the [suit]. Nothing herein shall be construed as licensing any third party under the [D’839] Patent for any products sold by Galt Medical Products, Inc. that were not first sold to [C.R. Bard].

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(Supp. J.A., Doc. No. 111-4, at SJM0001522.)

While this language from the agreement makes clear that the license extended only to products that Galt Medical, Xentek Medical, or Eddings sold to C.R. Bard, it does not make clear—as Plaintiff contends—that any licensed products had already been resold by C.R. Bard and were thus incapable of being marked.

Plaintiff further argues that this settlement was entered into “at a time when Galt [Medical] and [C.R.] Bard were already under a Court Order not to sell further product.” (Pl.’s Reply in Supp. 10.) However, Plaintiff points to nothing in the record that makes clear that C.R. Bard did not, in fact, sell any products embodying the design of the D’839 Patent after entering into the licensing agreement with Plaintiff.

Because Plaintiff bears the burden of proof as to compliance with the marking statute, and because the record as to this issue is not fully developed, Plaintiff’s motion for summary judgment will be denied.

IV. DAUBERT MOTIONS

In addition to cross-motions for summary judgment, both parties have filed motions to exclude the testimony of expert witnesses retained by the opposing party, pursuant to *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 113 S. Ct. 2786, 125 L. Ed. 2d 469 (1993). It is not clear from these motions whether the parties seek to exclude these experts’ opinions from consideration in the

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cross-motions for summary judgment, at trial, or both. Accordingly, where these experts' opinions are necessary to my decision on the cross-motions for summary judgment, I will consider them below. Where they are not, I will deny them without prejudice to raise prior to trial.

Plaintiff seeks to exclude three of Defendants' experts: Richard Meyst, Gerald Mossinghoff, and Dana Trexler Smith.⁸ Defendants seek to exclude Plaintiff's expert, Peter Bressler. Both Plaintiff's and Defendants' *Daubert* motions will be denied, in part without prejudice and in part with prejudice.

A. Legal Standard

Federal Rule of Evidence 702 governs the admissibility of expert testimony, and provides:

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if: (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles

8. Plaintiff also moved to exclude a fourth defense expert, Timothy Schweikert, based on Defendants' failure to produce his expert report. However, because Defendants have responded that they do not intend to call Schweikert as a witness, Plaintiff's motion as to him will be denied as moot.

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and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case.

Rule 702 thus “embodies a trilogy of restrictions on expert testimony: qualification, reliability and fit.” *Schneider ex rel. Estate of Schneider v. Fried*, 320 F.3d 396, 404 (3d Cir. 2003) (quoting *In re Paoli R.R. Yard PCB Litig.*, 35 F.3d 717, 741-43 (3d Cir. 1997)). In evaluating whether an expert opinion is admissible, a district court acts as a gatekeeper, excluding opinion testimony that does not meet these requirements. *Id.* However, “the court’s role as a gatekeeper is not intended to serve as a replacement for the adversary system,” because, “[a]s the Supreme Court noted in *Daubert*, vigorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence.” *Crowley v. Chait*, 322 F. Supp. 2d 530, 536 (D. Del. 2004) (internal quotation marks and alterations omitted).

The burden is on the party offering the evidence to establish admissibility by a preponderance of the evidence. *Padillas v. Stork-Gamco, Inc.*, 186 F.3d 412, 418 (3d Cir. 1999).

With these principles in mind, I will address Plaintiff’s and Defendants’ *Daubert* motions in turn.

*Appendix C***B. Plaintiff's Motion**

Plaintiff seeks to exclude the testimony of three of Defendants' experts: Richard Meyst, Gerald Mossinghoff, and Dana Trexler Smith.

1. Richard Meyst

Meyst, a designer and engineer, provides opinions on both infringement and invalidity. Plaintiff contends that Meyst's testimony should be excluded because he "uses the wrong claim construction" of the D'839 Patent. (Pl.'s *Daubert* Mot. 4.) In support of this contention, Plaintiff notes that Meyst "attempts to put in words each detail in the drawings of the [D'839 Patent]." (*Id.*) However, the mere fact that Meyst provides a written description of the elements of the D'839 Patent does not contradict my claim construction. Indeed, Meyst's report appears to apply my claim construction, as it notes that "the scope of the claim . . . includes those elements shown in solid lines in figures 1-9." (Meyst Report ¶ 58.) Accordingly, Plaintiff's *Daubert* motion will be denied as to this issue.

Plaintiff also contends that Meyst's opinion that the D'839 Patent is indefinite should be excluded. Because I have concluded as a matter of law that the D'839 Patent is not indefinite, and will grant summary judgment in Plaintiff's favor as to indefiniteness, Plaintiff's *Daubert* motion as to this issue will be denied as moot.

Plaintiff next contends that Meyst's opinions on inventorship should be excluded because inventorship

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issues are not in the case. Because I rejected that argument in denying Plaintiff's motion for summary judgment as to inventorship, Plaintiff's *Daubert* motion as to this issue will also be denied.

Plaintiff further contends that Meyst's opinion on infringement should be excluded because it is improperly based on "witness statements of interested parties," referring to Meyst's reliance on "statements . . . provided to [him] from purchasers of the tearaway introducer sheaths." (Pl.'s *Daubert* Mot. 5 (citing Meyst Report ¶ 130.)) Because I have not relied on Meyst's opinions on infringement in deciding the instant cross-motions for summary judgment, as to this argument Plaintiff's motion will be denied without prejudice to raise prior to trial.

Finally, Plaintiff contends that Meyst's opinion regarding the "value" of the D'839 Patent and "the potential design around to avoid infringement" should be excluded because Plaintiff is entitled to damages in the amount of Defendants' profits. (Pl.'s *Daubert* Mot. 7.) As with infringement, I have not relied on Meyst's opinions as to damages in deciding the instant cross-motions for summary judgment. Accordingly, as to this argument, Plaintiff's *Daubert* motion will be denied without prejudice to raise prior to trial.

2. Gerald Mossinghoff & Dana Trexler Smith

Mossinghoff, a patent attorney and former PTO commissioner, provides opinions on inventorship, indefiniteness, and inequitable conduct. Smith, a forensic

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accountant, provides opinions on damages. Because I have not relied on these experts' opinions in deciding the instant cross-motions for summary judgment, Plaintiff's *Daubert* motion as to these experts will be denied without prejudice to raise prior to trial.

C. Defendants' Motion

Defendants seek to exclude the testimony of Peter Bressler, an industrial designer who offers opinions on obviousness and infringement. Defendants argue that Bressler's testimony as to infringement should be excluded because he "failed to consider all the ornamental features of all figures of the design patent, which is contrary to the Court's claim construction ruling." (Defs.' *Daubert* Mot. 1.) Because I have not relied on Bressler's opinion on infringement in deciding the instant cross-motions for summary judgment, Defendants' *Daubert* motion will be denied without prejudice to raise prior to trial.

V. CONCLUSION

For the reasons discussed above, Plaintiff's motion for summary judgment will be granted in part and denied in part. Specifically, Plaintiff's motion will be granted as to the invalidity defenses of indefiniteness, the on-sale bar, prosecution history estoppel, and patent misuse. In all other respects, Plaintiff's motion will be denied.

Defendants' motion for summary judgment will be denied in its entirety.

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And both Plaintiff's and Defendants' *Daubert* motions will be denied—in part with prejudice, and in part without prejudice, as set out above.

An appropriate Order follows.

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**APPENDIX D — DENIAL OF REHEARING OF
THE UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT, FILED APRIL 12, 2022**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2021-1649

LARRY G. JUNKER,

Plaintiff-Appellee,

v.

MEDICAL COMPONENTS, INC., MARTECH
MEDICAL PRODUCTS, INC.,

Defendants-Appellants.

Appeal from the United States District Court for the
Eastern District of Pennsylvania in No. 2:13-cv-04606-
MSG, Judge Mitchell S. Goldberg.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before MOORE, *Chief Judge*, NEWMAN, LOURIE, DYK,
PROST, REYNA, TARANTO, CHEN, HUGHES, STOLL,
CUNNINGHAM, and STARK, *Circuit Judges*.

PER CURIAM.

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O R D E R

Larry G. Junker filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue April 19, 2022.

FOR THE COURT

April 12, 2022
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court