

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN WINDSHIELD WIPERS AND
COMPONENTS THEREOF**

Inv. No. 337-TA-928

Inv. No. 337-TA-937

(Consolidated)

**ORDER No. 25: DENYING COMPLAINANTS' MOTION FOR PARTIAL
SUMMARY DETERMINATION OF VALIDITY**

(June 11, 2015)

I. INTRODUCTION

On April 20, 2015, Complainants Valeo North America, Inc. and Delmex de Juarez S. de R.L. de C.V. (collectively, "Valeo") filed a motion for partial summary determination of validity of U.S. Patent Nos. 7,891,044 ("the '044 patent") and 7,937,798 ("the '798 patent") (collectively, "the asserted patents"). (Motion Docket No. 928-012.) On April 30, 2015, Respondents Trico Products Corporation and Trico Componentes SA de CV (collectively, "Trico") filed an opposition to Valeo's motion.¹

Valeo argues that the record warrants summary determination of validity under 35 U.S.C. § 112, ¶ 1 (lack of enablement and written description), § 102 (anticipation), and § 103 (obviousness). Trico responds that genuine issues of material fact exist in this investigation, thereby precluding summary determination.

For the reasons below, I find that genuine issues of material fact remain and, consequently, Valeo's motion for summary determination of validity is DENIED.

¹ Valeo's memorandum in support of Valeo's motion for partial summary determination and Trico's opposition thereto (as corrected on May 1, 2015), are hereinafter referred to, respectively, as "Valeo Br." and "Trico Opp'n Br."

PUBLIC VERSION

I. BACKGROUND

A. Procedural Background

Valeo filed a complaint against Trico on October 15, 2014 asserting a violation of section 337(a)(1)(B) by reason of infringement of one or more claims of U.S. Patent Nos. 7,891,044 (“the ’044 patent”) and 7,937,798 (“the ’798 patent”) (collectively, “the asserted patents”). On December 8, 2014, Trico filed a Response to Valeo’s Complaint and alleged, *inter alia*, that the patents are invalid for failure to comply with the requirements of 35 U.S.C. §§ 102, 103, and 112. *See* Trico’s Response to Complaint, USITC Inv. No. 337-TA-937, at 45-50 (Dec. 8, 2014).

Trico served its original invalidity contentions pursuant to Ground Rule 7.5 on March 20, 2015. Trico identified five prior art references in its original contentions, namely: (1) PCT Publication No. WO 02/040328 to Weber et al. (“Weber”); (2) Great Britain Patent No. 1546116 to Eckhard et al. (“Eckhard”); (3) German Patent No. DD 77904 to Hohnbaum et al. (“Hohnbaum”); (4) French Patent No. 2788027 to Jarasson (“Jarasson”); and (5) U.S. Patent No. 2,147,113 to Smulski (“Smulski”). *See* Trico’s Invalidity Contentions, served March 20, 2015, at 2-3 (attached as Exhibit CX-3 to Valeo Br.). In addition, Trico alleged that the claims of the asserted patents are invalid for lack enablement under 35 U.S.C. § 112, ¶ 1; indefiniteness² under 35 U.S.C. § 112, ¶ 2; anticipation by Weber under 35 U.S.C. § 102; and obviousness under 35 U.S.C. § 103 over Weber in view of Eckhard, Hohnbaum, Jarasson, or Smulski. *See id. passim*.

On April 23, 2015, I granted Trico’s motion to supplement its invalidity contentions to include additional contentions based on prior art references U.S. Patent No. 5,682,639 to Teindas (“Teindas”) and French Patent No. 2630070 to Raymond et al. (“Raymond”), as well as Valeo’s

² Valeo did not move for summary determination of validity in connection with Trico’s invalidity contentions based on indefiniteness under 35 U.S.C. § 112, ¶ 2. *See* Valeo Br. at 1 n.3.

PUBLIC VERSION

alleged public use and offers for sale of the claimed invention. *See* Order No. 16, Inv. No. 337-TA-928 (U.S.I.T.C. Apr. 23, 2015).³

B. The Asserted Patents

The asserted patents are related and share essentially the same specification. The '044 patent was filed on November 21, 2003 and issued on February 22, 2011. The '044 patent claims priority to German applications DE 102 54 978, filed November 26, 2002, and DE 103 23 997, filed May 27, 2003. The '798 patent was filed on May 12, 2010 and issued on May 10, 2011 from a continuation application to the patent application which issued as the '044 patent.⁴

The asserted patents disclose “a device and a method for releasably connecting a wiper blade to a drivable wiper arm.” *See* '044 patent at 1:8-9; '798 patent at 1:16-17. Figure 1 of the asserted patents shows an embodiment of the invention:

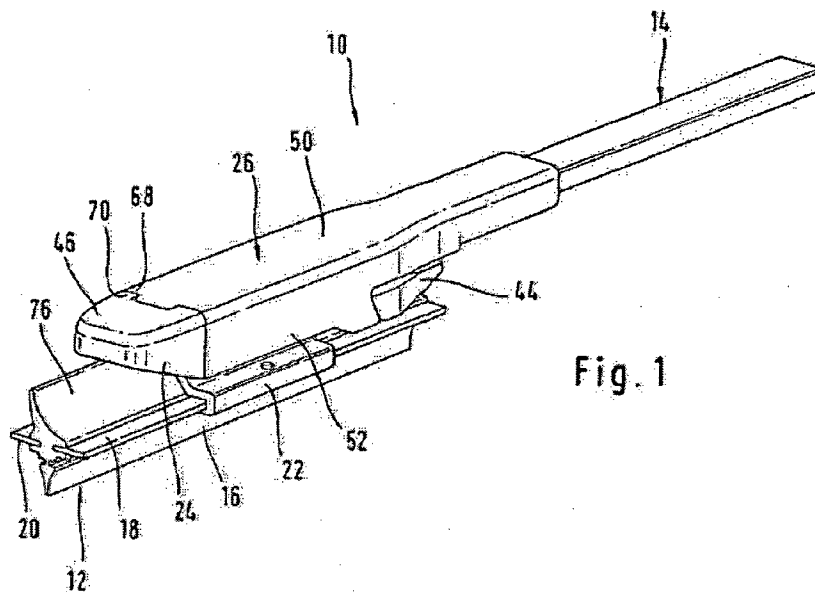


Fig. 1

³ Valeo’s motion for summary determination of validity was filed before Order No. 16 was issued, and does not address Trico’s additional invalidity contentions.

⁴ The effective date of the asserted patents pre-dates the America Invents Act (“AIA”) enacted by Congress on September 16, 2011. The pre-AIA versions of the patent statutes (35 U.S.C. § 1 *et seq.*) cited herein, apply to the asserted patents.

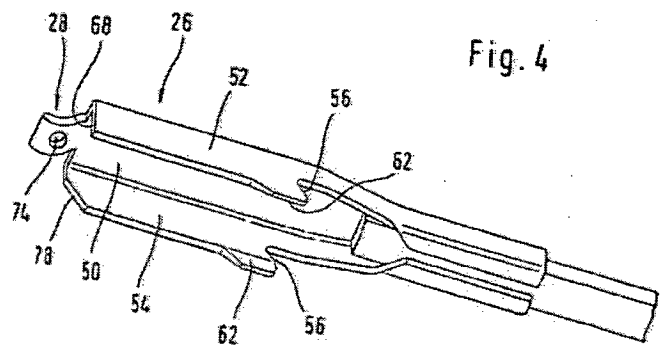
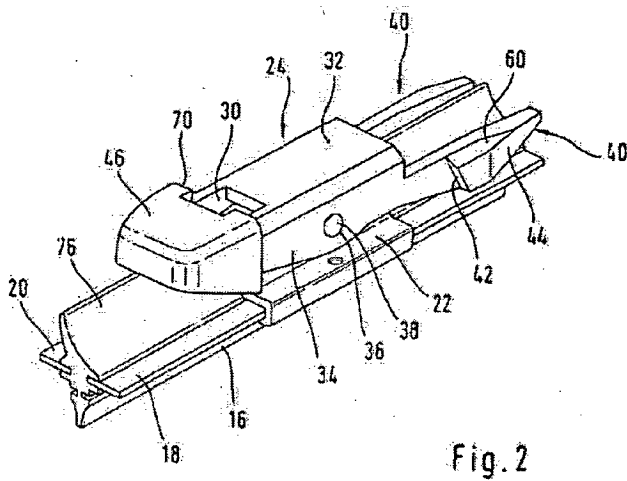
PUBLIC VERSION

The asserted patents describe Figure 1 as follows:

FIG. 1 shows a device 10 according to the invention for releasably connecting a wiper blade 12, shown in part, to a drivable wiper arm 14 which is likewise shown in part. The wiper blade 12 has a wiper strip 16 which faces the windscreen to be wiped (not shown) and comprises two strip-like elongate support elements 18, 20, a slide element 22 which is connected to the support elements 18, 20, and a connecting element 24 which is arranged on the slide element 22 in a manner such that it can pivot. The connecting element 24 serves for connection to a coupling section 26 on the wiper arm 14.

'044 patent at 6:7-17; '798 patent at 5:65-6:8.

The connecting element 24 and the coupling section 26 (shown in a coupled or assembled position in Figure 1 above) are separately described in Figures 2 and 4 of the asserted patents, as reproduced below:



In addition, the asserted patents describe the assembly of the claimed device through a pivoting operation, as shown in Figures 5 and 6 below:

PUBLIC VERSION

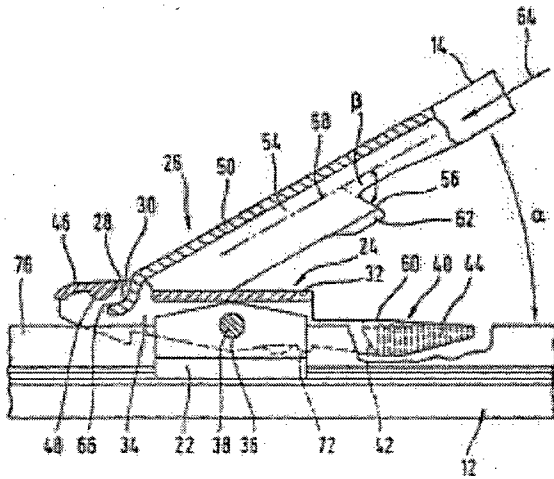


Fig. 5

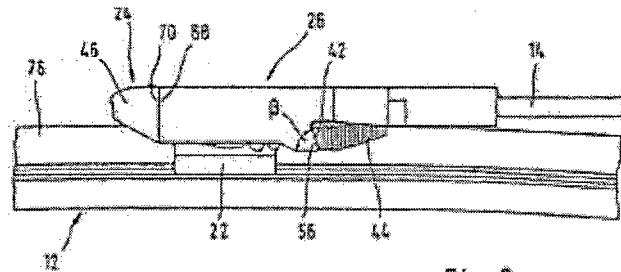


Fig. 6

The asserted patents further explain:

For assembly of the coupling section 26 to the connecting element 24, in order to reach a preassembly position which is shown in FIG. 5, the insertion section 28 is inserted into the seat 30 in a substantially rectilinear manner in the direction of the arrow 64. In this preassembly position, the longitudinal axis of the wiper arm 14 and the longitudinal axis of the connecting element 24 or of the wiper blade 12 enclose an angle α which may lie in the range from approximately 10 to 100°. In the example of embodiment shown in FIG. 5, the angle α has a value of approximately 40°. In order to reach the final assembly position, which is shown in FIG. 1 and FIG. 6, the wiper arm 14 and the connecting section 24 are pivoted onto one another about the contact area 66 in which the insertion section 28 bears against the region 48 of the seat 30. On account of the complementary design of the insertion section 28 and the region 48, the pivoting operation is carried out to a limited extent. Shortly prior to reaching the final assembly position, the bevelled sides 62 of the coupling section 26 and the correspondingly bevelled sides 60 of the locking tongues 40 meet one another in such a way that the locking tongues 40 are pivoted elastically in a direction facing one another. Upon reaching the final assembly position, the locking tongues 40 snap behind the locking edges 56 of the legs 52, 54 of the coupling section 26 in a direction facing away from one another. As a result, the coupling section 26 is permanently held on the connecting element 24 in the final assembly position. In the final assembly position, the coupling section 28 bears against the region 48 of the connecting element 24 over a large part of its surface. Furthermore, the end side 68 of the coupling section 26 which faces the head area 46 of the connecting

PUBLIC VERSION

element 26 bears against a bearing edge 70 of the connecting element which corresponds thereto.

'044 patent at 7:11-41; '798 patent at 7:1-32.

II. LEGAL STANDARDS

A. Summary Determination - Generally

Summary determination motions are governed by Commission Rule 210.18 which states that:

. . . . The determination sought by the moving party shall be rendered if the pleadings and any depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a summary determination as a matter of law.

19 C.F.R. § 210.18(b).

The standards for summary judgment in district courts apply to summary determinations at the U.S. International Trade Commission. *See Amgen Inc. v. International Trade Comm'n*, 565 F.3d 846, 849 (Fed. Cir. 2009) (citing *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 1476 (Fed. Cir. 1997)).

“The summary judgment movant has the initial responsibility of identifying the legal basis of its motion, and of pointing to those portions of the record that it believes demonstrate the absence of a genuine issue of material fact.” *Novartis Corp. v. Ben Venue Laboratories, Inc.*, 271 F.3d 1043, 1046 (Fed. Cir. 2001) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986)). When the ultimate burden of proof rests with the nonmoving party, as in this case, the moving party seeking summary judgment may meet its initial responsibility by showing that the evidence on file fails to establish a material issue of fact essential to the non-moving party’s case. *See id.* (citations omitted). “Once the movant has made this showing, the burden shifts to the nonmovant to designate specific facts showing that there is a genuine issue for trial.” *Id.*

PUBLIC VERSION

(citing *Celotex*, 477 U.S. at 324). “[I]n deciding a motion for summary judgment, ‘the evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor.’” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. at 255).

B. Summary Determination of Validity

“Because a patent is presumed to be valid, the evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence.” *Liebel-Flarsheim*, 481 F.3d at 1377 (citations omitted). “[A] moving party seeking to invalidate a patent at summary judgment must submit [] clear and convincing evidence of invalidity so that no reasonable jury could find otherwise.” *Eli Lilly and Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001). “Alternatively, a moving party seeking to have a patent held *not* invalid at summary judgment must show that the nonmoving party, who bears the burden of proof at trial, failed to produce clear and convincing evidence on an essential element of a defense upon which a reasonable jury could invalidate the patent.” *Id.* (emphasis added). While the clear and convincing evidence standard applies on summary judgment, a non-moving party is not required to demonstrate invalidity by clear and convincing evidence to defeat a motion for summary judgment of validity. *See Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1364 (Fed. Cir. 2005) (“[T]his record, although not clearly and convincingly demonstrating obviousness, was sufficient to create a genuine issue of material fact as to whether one of skill in the art would have been motivated to combine [the prior art references].”). Rather, the non-moving party need only show the existence of a genuine issue of material fact to defeat such motion. *See Freedman Seating*, 420 F.3d at 1363. *See also Duramed Pharmaceuticals, Inc. v. Watson Laboratories, Inc.*:

PUBLIC VERSION

The district court also appears to have applied an incorrect evidentiary standard on summary judgment, incorrectly placing the burden of proof on the nonmoving party, Watson, to show clear and convincing evidence of invalidity as a matter of law. In this case, Duramed moved for summary judgment of nonobviousness, and thus the burden rested with Duramed to show that Watson had failed to come forth with clear and convincing evidence of an essential element of its *prima facie* case of obviousness. Although the ultimate evidentiary burden of showing clear and convincing evidence does not change on summary judgment, Watson could defeat summary judgment by showing a genuine issue of material fact, which, if believed by the finder of fact, could provide clear and convincing evidence of a motivation to combine the prior art references.

413 Fed. Appx. 289, 295 (Fed. Cir. 2011) (nonprecedential).

III. DISCUSSION

A. Written Description Under 35 U.S.C. § 112, ¶ 1

Valeo's motion for partial summary determination that the asserted patents satisfy the written description requirement under 35 U.S.C. § 112, ¶ 1, is moot in view of Order No. 23 in this investigation. Indeed, Order No. 23 precludes Trico from asserting invalidity based on lack of written description because Trico's Invalidity Contentions did not disclose such ground of invalidity. *See* Order No. 23, Inv. No. 337-TA-928, at 6-7 (U.S.I.T.C. June 3, 2015).

B. Enablement Under 35 U.S.C. § 112, ¶ 1

1. Legal Standard

A patent must contain an enabling disclosure. *See* 35 U.S.C. § 112, ¶ 1, which provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

PUBLIC VERSION

“To be enabling, a patent’s specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.” *Streck, Inc. v. Research & Diagnostic Systems, Inc.*, 665 F.3d 1269, 1288 (Fed. Cir. 2012) (citation omitted). “Whether the subject matter of a patent claim satisfies the enablement requirement of 35 U.S.C. § 112, ¶ 1, is a question of law based on underlying facts, and, because a patent is presumed to be valid, the evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence.” *AK Steel Corp. v. Sollac and Ugine*, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003) (citations omitted).

2. The '044 Patent

Valeo argues that the '044 patent provides a sufficient description to enable one of ordinary skill in the art to make and use the inventions described by the asserted claims. *See* Valeo Br. at 7 (citing ¶ 13 of Declaration of Dr. David L. Trumper, attached as Exhibit CX-7 to Valeo Br., hereinafter “Trumper Decl.”). Trico responds that certain terms of the '044 patent are inconsistent or otherwise contrary to the express teaching of the patents. Specifically, Trico argues that there is a contradiction between a “releasable” connection and a “permanent” connection. *See* Trico Opp’n Br. at 8-10 (citing ¶ 111 of the Initial Expert Report of Dr. Gregory Davis, attached as Exhibit RX-1C to Trico Opp’n Br, hereinafter “Davis Report”). In addition, Trico argues that the interaction of the seat/insertion section and the securing sections of the connecting element and the coupling section, prevent the connecting element from pivoting with respect to the coupling section when the device is assembled. *See id.* at 12-14 (citing ¶¶ 266-267 and 290-291 of the Davis Report).

PUBLIC VERSION

Drawing all inferences in Trico's favor, I find that genuine issues of material fact remain and, consequently, summary determination of enablement under 35 U.S.C. § 112, ¶ 1, is not warranted with respect to the '044 patent.⁵

3. The '798 Patent

Valeo's motion for summary determination that the asserted claims of the '798 patent are enabled under 35 U.S.C. § 112, ¶ 1, is moot in view of Trico's representation that "[they] have narrowed their invalidity contentions and no longer assert that the '798 Patent is invalid for failing to meet the enablement requirement of § 112, ¶ 1." *See* Trico Opp'n Br. at 2.

C. Anticipation Under 35 U.S.C. § 102

1. Legal Standard for Anticipation

"A prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently, to anticipate." *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001) (citing *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). "Although anticipation is a question of fact, it still may be decided on summary judgment if the record reveals no genuine dispute of material fact." *Id.*

2. The '044 Patent

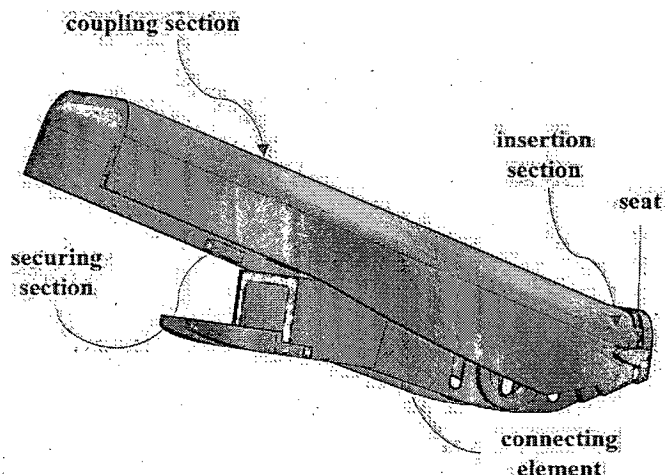
Valeo argues that summary determination of validity under § 102 (anticipation) is appropriate because "Weber fails to teach a connecting element structure that can be pivoted into its final assembly position. Instead, it teaches a connecting element structure that is linearly inserted into the end of a wiper arm in order to reach a final assembly position." Valeo Br. at 9. Trico responds that Valeo ignores the full scope of the teachings of Weber. *See* Trico Opp'n Br. at 16. In particular, Trico relies on ¶¶ 120-121 of the Davis Report, which state that:

⁵ Although I reserve my ruling on lack of enablement until I hear live testimony, I find Trico's arguments on this issue not very persuasive.

PUBLIC VERSION

Although Weber is silent with regard to the specific angle range between the coupling section and the connecting element during assembly, one of ordinary skill in the art would necessarily understand that any real world application involves certain amount of variability and maintaining a perfect 0° angle, especially during assembly would be nearly impossible to attain.

One such possible mode of assembly utilizing the Weber connecting element 252 involves inserting the insertion section in a substantially rectilinear manner into the seat in order to reach a preassembly position in which the longitudinal axis of the wiper arm and the longitudinal axis of the connecting element enclose an angle in the range of at least 10° . . .



See Davis Report at ¶¶ 120-122.

Drawing all inferences in Trico's favor, I find that genuine issues of material fact remain and, consequently, summary determination of validity under 35 U.S.C. § 102 (anticipation) is not warranted with respect to the '044 patent.

3. The '798 Patent

With respect to the '798 patent, in addition to the "pivoting" argument addressed above in section III(B)(2), *supra* pp. 10-11, Valeo further argues that "Weber does not teach a 'front portion defining part of an opening on an outer top surface of said front portion . . . wherein said outer top surface of said front portion is raised relative to said mid-portion,' as recited in claim

PUBLIC VERSION

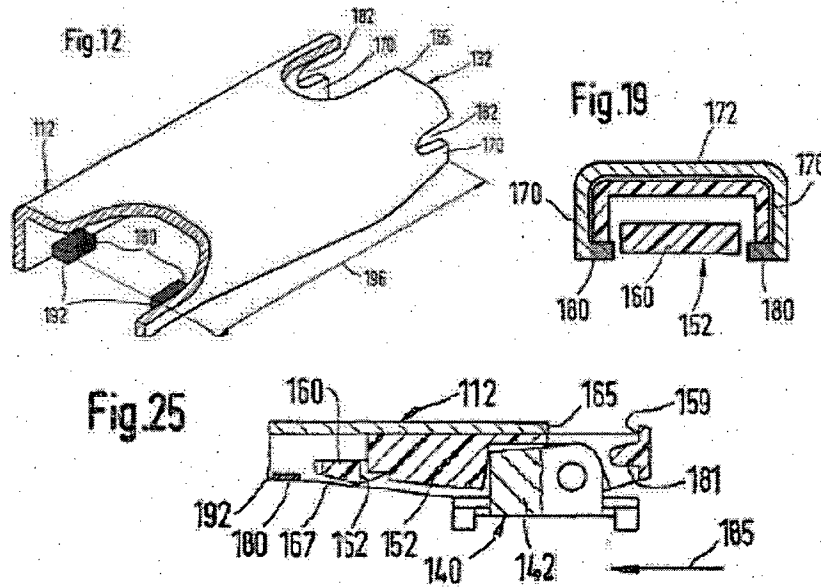
invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *see also PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

“Underpinning [the] legal [obviousness] issue are factual questions relating to the scope and content of the prior art, the differences between the prior art and the claimed invention, the level of ordinary skill in the art, and any relevant secondary considerations, such as commercial success, long-felt need, and the failure of others.” *Id.* Summary judgment is appropriate when “the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors.” *See KSR*, 550 U.S. at 427.

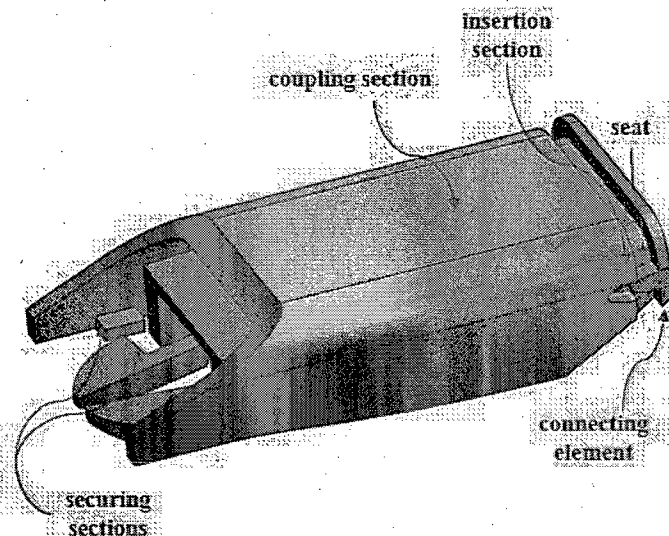
2. The '044 Patent

Valeo argues that “[s]ummary determination of validity under § 103 (non-obviousness) is appropriate because there is no reason why one of ordinary skill in the art would modify Weber’s connecting element so that it can be pivoted to a final assembly position, and even if such a reason existed (which it does not), one of ordinary skill in the art would not have had a reasonable expectation of success in making such a modification.” *See Valeo Br.* at 9-11 (citing *Trumper Decl.* at ¶¶ 34-35). Specifically, Valeo argues that “[i]t is not possible to pivot [Weber’s] connecting element into the final assembly projection because, among other reasons, the tab-like projections would mechanically interfere with the top surface of the connecting element, preventing any pivotal movement.” *See id.* at 10.

PUBLIC VERSION



Trico disagrees and argues that “the presence of the projections 180 would not prevent pivoting.” See Trico Opp’n Br. at 19-20 (citing Davis Report at ¶¶ 122-123). Specifically, Dr. Davis opines at ¶ 123, that “[a]s the securing sections of the coupling section engage the securing sections of the connecting element, the securing sections of the connecting element are deflected inwards, allowing the coupling section to complete the pivot action and reach the final assembly position.” See Davis Report at ¶ 123.

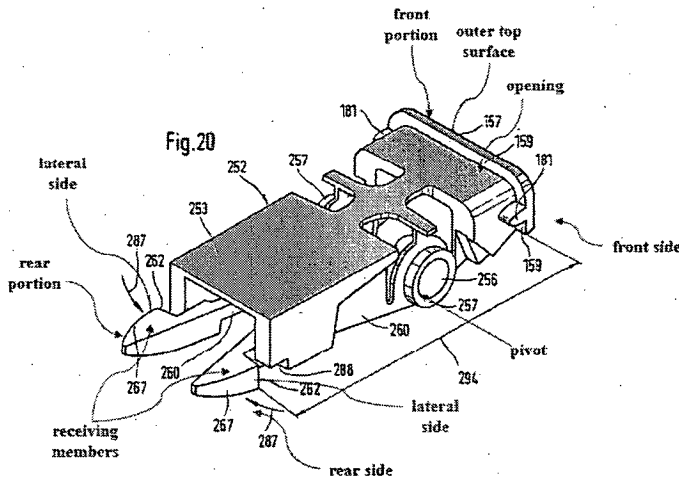


PUBLIC VERSION

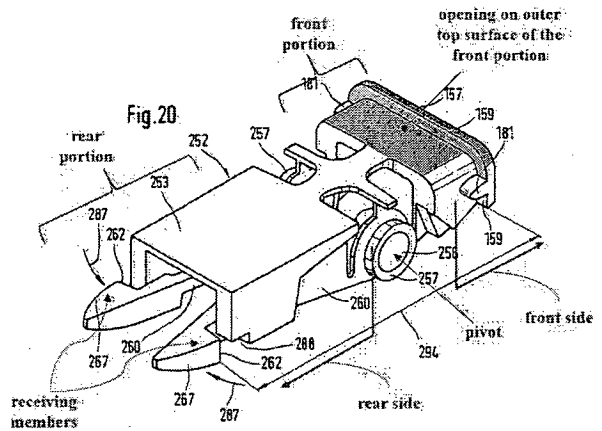
Drawing all inferences in Trico’s favor, I find that genuine issues of material fact remain and, consequently, summary determination of validity under 35 U.S.C. § 103 (non-obviousness) is not warranted with respect to the ’044 patent.

3. The ’798 Patent

With respect to the ’798 patent, in addition to the “pivoting” argument addressed above in section III(D)(2), *supra* p. 13, Valeo further argues that “Eckhard, Hohnbaum, Jarasson, and Smulski fail to account for the shortcoming of Weber, namely the lack of an opening on an outer top surface of the front portion that is raised relative to the mid-portion.” *See* Valeo Br. at 16 (citing Trumper Decl. at ¶¶ 34-35). However, as discussed *supra* pp. 13-14, the parties disagree as to what constitutes the “front portion” in Weber’s device. While Valeo argues that Weber’s “‘front portion’ is a rim on the very end of the connector” (*see* Valeo Br. at 15) and does not include an opening, Trico’s expert opines that the “front portion” extends beyond the end wall (157) and includes an opening (*see* Davis Report at ¶ 468).



Valeo Br. at 15



Davis Report at ¶ 468

Drawing all inferences in Trico’s favor, I find that genuine issues of material fact remain and, consequently, summary determination of validity under 35 U.S.C. § 103 (non-obviousness) is not warranted with respect to the ’798 patent.

PUBLIC VERSION

IV. CONCLUSION

Accordingly, for the reasons discussed above, Valeo's motion for summary determination of validity of the asserted patents is hereby DENIED.

Within 7 days of the date of this order, the parties shall jointly submit: (1) a proposed public version of this order with any proposed redactions bracketed in red; and (2) a written justification for any proposed redactions specifically explaining why the piece of information sought to be redacted is confidential and why disclosure of the information would be likely to cause substantial harm or likely to have the effect of impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions.⁶

SO ORDERED.



Thomas B. Pender
Administrative Law Judge

⁶ Under Commission Rules 210.5 and 201.6(a), confidential business information includes:

information which concerns or relates to the trade secrets, processes, operations, style of works, or apparatus, or to the production, sales, shipments, purchases, transfers, identification of customers, inventories, or amount or source of any income, profits, losses, or expenditures of any person, firm, partnership, corporation, or other organization, or other information of commercial value, the disclosure of which is likely to have the effect of either impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions, or causing substantial harm to the competitive position of the person, firm, partnership, corporation, or other organization from which the information was obtained, unless the Commission is required by law to disclose such information.

See 19 C.F.R. § 201.6(a). Thus, to constitute confidential business information the disclosure of the information sought to be designated confidential must *likely have the effect of* either: (1) impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions; or (2) *causing substantial harm* to the competitive position of the person, firm, partnership, corporation, or other organization from which the information was obtained.

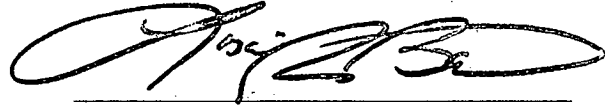
**IN THE MATTER OF CERTAIN WINDSHIELD WIPERS
AND COMPONENTS THEREOF**

**337-TA-928
337-TA-937
(Consolidated)**

CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **PUBLIC ORDER NO. 25** have been served upon, **The Office of Unfair Import Investigations** and the following parties on

JUN 15 2015
JUN 19 2015



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, S.W., Room 112A
Washington, DC 20436

**FOR COMPLAINANTS VALEO NORTH AMERICA, INC. & DELMEX de JUAREZ S.
de R.L. de C.V.:**

Eric W. Schweibenz, Esq.
**OBLON, McCLELLAND,
MAIER & NEUSTADT, LLP**
1940 Duke Street
Alexandria, VA 22314

Via Hand Delivery
 Via Express Delivery
 Via First Class Mail
 Other: _____

**FOR RESPONDENTS FEDERAL-MOGUL
CORPORATION, FEDERAL-MOGUL VEHICLE
COMPONENT SOLUTIONS, INC., & FEDERAL-MOGUL
S.A.:**

Paul C. Goulet, Esq.
WINSTON & STRAWN LLP
1700 K Street, N.W.
Washington, DC 20006

Via Hand Delivery
 Via Express Delivery
 Via First Class Mail
 Other: _____

**FOR RESPONDENT TRICO PRODUCTS CORPORATION, TRICO PRODUCTS &
TRICO COMPONENTS SA de CV:**

Scott M. Daniels, Esq.
**WESTERMAN, HATTORI, DANIELS
& ADRIAN, LLP**
1250 Connecticut Avenue, N.W., Suite 700
Washington, DC 20036

Via Hand Delivery
 Via Express Delivery
 Via First Class Mail
 Other: _____