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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES

Inv. No. 337-TA-636

ORDER NO. 22: DENYING RESPONDENTS' MOTION FOR SUMMARY DETERMINATION OF (i) INVALIDITY OF CLAIMS 1, 10 AND 27 OF THE '737 PATENT; (ii) NON-INFRINGEMENT OF THE ASSERTED CLAIMS OF THE '737 PATENT; (iii) NON-INFRINGEMENT OF THE ASSERTED CLAIMS OF THE '338 PATENT

(February 23, 2009)

On November 26, 2008, Respondents VIM Technologies, Ltd., Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed Service & Supplies, Inc., Recognition Systems, Inc., and Spicers Paper, Inc. moved for summary determination that (i) claims 1 and 27 of U.S. Patent No. 5,339,737 (the "737 patent") are invalid as anticipated by a prior art reference entitled "Direct Method of Producing Waterless Offset Plates by Controlled Laser Beam" by Nechiporenko et al. (the "Nechiporenko" reference); (ii) claim 10 of the '737 patent is invalid as obvious over the Nechiporenko reference in combination with U.S. Patent No. 4,132,168 (the "168 patent"); (iii) the accused lithographic printing plates ("Accused Plates") in this Investigation do not infringe claims 1, 10 and 27 of the '737 patent; and (iv) the Accused Plates do not infringe claims 20, 21 and 23 of U.S. Patent No. 5,487,338 (the "338 patent"). (Motion Docket No. 636-014.)

On December 11, 2008, Complainant Presstek, Inc. ("Presstek") opposed Respondents'

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motion, arguing that Respondents ignore the plain meaning of the claims and insert new claim limitations in both patents at issue. (Presstek Resp., at 34-38; 43-46.) Further, Presstek argued, *inter alia*, that there are disputed issues of fact relating to whether the polysiloxane layer and metal substrate disclosed in Nechiporenko exhibit different affinities for ink (*see* Carlson Decl., at ¶¶108-112); whether the polysiloxane layer disclosed in Nechiporenko is formed of a material not subject to ablative absorption of imaging infrared radiation (*see* Carlson Decl., at ¶¶97-107); whether the aluminum substrate disclosed in Nechiporenko reflects imaging radiation (*see* Carlson Decl., at ¶¶74-83); whether the sublayer disclosed in Nechiporenko is partially transmissive of infrared radiation (*see* Carlson Decl., at ¶¶ 39-73); whether the substrate of the Accused Plates comprises a material that reflects imaging infrared radiation (*see* Comack Decl., Ex. C, at 18; Ex. D, at 80:8-14; Carlson Decl., at ¶127); and whether the MMO layer of the Accused Plates fully ablates as a result of the initial incident imaging radiation before the minimal transmitted radiation reaches the substrate (*see* Carlson Decl., at ¶¶122-134).

On December 11, 2008, the Commission Investigative Staff (“Staff”) filed a response opposing summary determination in favor of Respondents. According to Staff, material questions of fact remain with respect to the materials Nechiporenko disclosed and whether the Nechiporenko reference is sufficiently enabling to permit one of ordinary skill in the art to recreate the Bakelite sublayer. (Staff Resp., at 8-11.) As a result, Staff argued, summary determination with respect to whether the ‘737 patent is invalid as anticipated or obvious would be inappropriate. (*Id.*) Furthermore, Staff argued that Respondents, in asserting noninfringement, relied on disputed claim terms requiring construction. Staff also identified a

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disputed question of fact as to whether the second layer of the Accused Plates is fully ablated by the initial incident imaging radiation before the radiation reaches the substrate of the Accused Plates. (*Id.*, at 12-13.) Finally, Staff argued that Respondents' motion with respect to the '338 patent should be denied because there are disputed claim limitations, such as the number of layers claimed in the claimed invention, and material questions of fact relating to (i) whether the top layer of the Accused Plates is fully transmissive to infrared radiation and (ii) whether an ablative layer is required in order for a printing member to be sufficiently operative and imageable by laser discharge. (*Id.*, at 13-14.)

Pursuant to Commission Rule 210.18, summary determination "shall be rendered if 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). *See also DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1322 (Fed. Cir. 2001); *Wenger Mfg., Inc. v. Coating Machinery Systems, Inc.*, 239 F.3d 1225, 1231 (Fed. Cir. 2001). "When ruling on a motion for summary judgment, all of the nonmovant's evidence is to be credited, and all justifiable inferences are to be drawn in the nonmovant's favor." *Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (Fed. Cir. 2001). The trier of fact should "assure itself that there is no reasonable version of the facts, on the summary judgment record, whereby the nonmovant could prevail, recognizing that the purpose of summary judgment is not to deprive a litigant of a fair hearing, but to avoid an unnecessary trial." *EMI Group North America, Inc. v. Intel Corp.*, 157 F.3d 887, 891 (Fed. Cir. 1998). "[A] moving party seeking to invalidate a patent at summary

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judgment must submit such clear and convincing evidence of facts underlying invalidity that no reasonable jury could find otherwise.” *SRAM Corp. v. AD-II Engineering, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006). This burden of showing invalidity by clear and convincing evidence is “especially difficult” when, as is the present case, Respondents attempt to rely on prior art that was before the patent examiner during reexamination. *Glaxo Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1348 (Fed. Cir. 2004) (citing *Al- Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1323 (Fed.Cir. 1999)).¹

Based on a review of the motion papers and responses thereto, the Administrative Law Judge finds that summary determination is not appropriate. The Administrative Law Judge finds that genuine material issues of fact remain, and that good cause does not exist to grant the motion in lieu of a trial of all issues on the merits.

Accordingly, the Administrative Law Judge DENIES Motion No. 636-014.

Within seven days of the date of this document, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties’ submissions may be made by facsimile and/or hard copy by the aforementioned date.


Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information. The parties’ submissions

¹ See also *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 961 (Fed. Cir. 1986); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1555 (Fed Cir. 1985); *American Hoist & Derrick Co. v. Sowa & Sons*,

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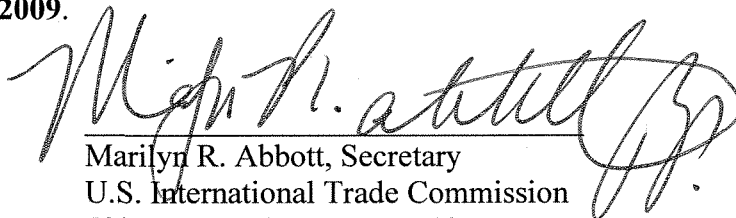
concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.


E. James Gildea
Administrative Law Judge

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached has been served by hand upon, the Commission Investigative Attorney, **Aarti J. Shah, Esq.**, and the following parties as indicated on March 09, 2009.


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