

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN ELECTRONIC DEVICES,
INCLUDING HANDHELD WIRELESS
COMMUNICATIONS DEVICES**

Inv. Nos. 337-TA-673
337-TA-667

**ORDER NO. 47C: DENYING COMPLAINANT SAXON INNOVATIONS, LLC'S
MOTION FOR SUMMARY DETERMINATION OF NO
UNENFORCEABILITY DUE TO INEQUITABLE CONDUCT &
NO INVALIDITY UNDER 35 U.S.C. § 102(e)**

**DENYING SAMSUNG RESPONDENTS' MOTION FOR
SUMMARY DETERMINATION OF UNENFORCEABILITY DUE
TO INEQUITABLE CONDUCT**

(October 14, 2009)

On August 25, 2009, complainant Saxon Innovations, LLC ("Saxon") filed a motion for summary determination that U.S. Patent No. 5,608,873 ("the '873 patent") is not unenforceable due to inequitable conduct and that the '873 patent is not invalid under 35 U.S.C. § 102(e). (Motion Docket No. 673-033.) On September 4, 2009, respondents Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLP (collectively, "Samsung") filed a response opposing the motion.

On August 25, 2009, Samsung filed a motion for summary determination that the '873 patent is unenforceable due to inequitable conduct. (Motion Docket No. 673-034.) On September 4, 2009, Saxon filed a response opposing the motion.

On September 4, 2009, the Commission Investigative Staff ("Staff") filed a combined response to the two motions. Staff does not support either motion for summary determination on the issue of inequitable conduct, but it supports Saxon's motion that the '873 patent is not invalid under 35 U.S.C. § 102(e).

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I. Applicable Law

A. Summary Determination

Commission Rule 210.18 governs summary determination, and states, *inter alia*, that:

The determination sought by the moving party 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 CFR § 210.18(b).

The evidence “must be viewed in the light most favorable to the party opposing the motion...with doubt resolved in favor of the nonmovant.” *Crown Operations Int’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002); *see also Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (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.”). “Issues of fact are genuine only if the evidence is such that a reasonable [fact finder] could return a verdict for the nonmoving party.” *Id.* at 1375 (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). 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). “Where an issue as to a material fact cannot be resolved without observation of the demeanor of witnesses in order to evaluate their credibility, summary judgment is not appropriate.” *Sandt Technology, Ltd. v. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1357 (Fed. Cir. 2001) (Dyk, C.J., concurring). “In other words, ‘[s]ummary judgment is authorized when it is quite clear what the truth is,’ [citations omitted], and the law requires judgment in favor of the movant based upon facts not in genuine dispute.” *Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc.*, 984 F.2d 1182, 1185 (Fed. Cir. 1993).

B. Invalidity Under 35 U.S.C. § 102(e)

Section 102(e) provides:

A person shall be entitled to a patent unless –

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...

35 U.S.C. § 102(e) (2008).

In discussing the meaning of the word “invention” in the Patent Act, the Supreme Court has stated that it refers to conception:

The primary meaning of the word “invention” in the Patent Act unquestionably refers to the inventor’s conception rather than to a physical embodiment of that idea. The statute does not contain any express requirement that an invention must be reduced to practice before it can be patented. Neither the statutory definition of the term in § 100 nor the basic conditions for obtaining a patent set forth in § 101 make any mention of “reduction to practice.” The statute’s only specific reference to that term is found in § 102(g), which sets forth the standard for resolving priority contests between two competing claimants to a patent.

Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 60-61 (1998). Courts have used the definition of “invention” disclosed in *Pfaff* in the context of § 102(e):

Section 102(e) of the Patent Act states that “a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent” may be regarded as prior art. 35 U.S.C. § 102(e); *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355 (Fed.Cir.2003). It is generally recognized that the date of invention is the date of conception and not the date of reduction to practice. *See Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 60, 119 S.Ct. 304, 142 L.Ed.2d 261 (1998) (“[t]he primary meaning of the word ‘invention’ in the Patent Act unquestionably refers to the inventor's conception rather than to a physical embodiment of that idea”).

Mahurkar v. C.R. Bard, Inc., 2004 WL 1982531, at *21 (N.D. Ill. Sept. 7, 2004); *see also*

Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc., 585 F. Supp. 2d 568, 575 (D.

Del. 2008) (“The Supreme Court [in *Pfaff*] has explained that the use of the word ‘invention’ in

Section 102(e) refers to ‘conception’ and does not require a subsequent reduction to practice[.]”);

Lear Automotive Dearborn, Inc. v. Johnson Controls, Inc., 528 F. Supp. 2d 654, 676-677 (E.D. Mich. 2007) (“The Court is inclined to agree with Lear that the word ‘invention’ in § 102(e) should be construed in accordance with *Pfaff*’s interpretation of that very same word, albeit in the context of § 102(b) rather than § 102(e).”)

The Federal Circuit has explained that conception is “the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (quoting 1 *Robinson On Patents* 532 (1890)). “The test for conception is whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention; the inventor must prove his conception by corroborating evidence, preferably by showing contemporaneous disclosures.” *Univ. of Pittsburg of Commonwealth Sys. of Higher Educ. v. Hedrick*, 573 F.3d 1290, 1298 (Fed. Cir. 2009).

C. Inequitable Conduct

“Applicants for patents have a duty to prosecute patent applications in the Patent Office with candor, good faith, and honesty. A breach of this duty...constitutes inequitable conduct.” *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 999 (Fed. Cir. 2007) (citations omitted). In order to prove inequitable conduct, a party must establish that the patent applicant “(1) made an affirmative misrepresentation of material fact, failed to disclose material information, or submitted false material information, and (2) intended to deceive the U.S. Patent and Trademark Office (‘PTO’).” *Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359, 1363 (Fed. Cir. 2007). “Both elements of a conclusion of inequitable conduct, intent and materiality, are questions of fact and must be proven by clear and convincing evidence.” *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1345 (Fed. Cir. 2007). Once threshold levels of materiality and intent are met, a

court must weigh the facts and determine whether the applicant's actions amounted to inequitable conduct:

The nondisclosure or misrepresentation must meet threshold levels of both materiality and intent. Once the threshold levels of materiality and intent have been established, the trial court must weigh materiality and intent to determine whether the equities warrant a conclusion that inequitable conduct occurred. The more material the information misrepresented or withheld by the applicant, the less evidence of intent will be required in order to find inequitable conduct.

Honeywell, 488 F.3d at 999 (citations omitted); *see also Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (“[E]ven if a threshold level of both materiality and intent to deceive are proven by clear and convincing evidence, the court may still decline to render the patent unenforceable.”)

“Information is ‘material’ when there is a substantial likelihood that a reasonable examiner would have considered the information important in deciding whether to allow the application to issue as a patent.” *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1179 (Fed. Cir. 1995). A patent applicant, however, has no obligation to disclose a reference that is cumulative or less pertinent than those already before the examiner. *Id.*

“[T]he accused infringer must prove...that the material information was withheld with the specific intent to deceive the PTO.” *Star Scientific, Inc.*, 557 F.3d at 1366. Intent need not be proven by direct evidence. *Bruno Indep. Living Aids, Inc. v. Acorn Mobility Servs., Ltd.*, 394 F.3d 1348, 1354 (Fed. Cir. 2005). “Rather, in the absence of a credible explanation, intent to deceive is generally inferred from the facts and circumstances surrounding a knowing failure to disclose material information.” *Id.*

Because of the intensely factual nature of the inequitable conduct inquiry, the Federal Circuit has warned that a finding of inequitable conduct on summary judgment¹ should be rare:

¹ “Summary determination under Rule 210.18(b) is analogous to summary judgment under Fed. R. Civ. P. 56(c).” *Certain Endoscopic Probes For Use In Argon Plasma Coagulation Systems*, 337-TA-569, Order No. 20 (May 21, 2007).

Although the intent element of fraud or inequitable conduct may be proven by a showing of acts the natural consequences of which were presumably intended by the actor, this requires the factfinder to evaluate all the facts and circumstances in each case. Such an evaluation is rarely enabled in summary proceedings.

KangaROOS U.S.A., Inc. v. Caldor, Inc., 778 F.2d 1571, 1577 (Fed. Cir. 1985) (citation omitted); *see also Digital Control, Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1313 (Fed. Cir. 2006) (“Determining at summary judgment that a patent is unenforceable for inequitable conduct is permissible, but uncommon.”); *Burlington Indus., Inc. v. Dayco Corp.*, 849 F.2d 1418, 1422 (Fed. Cir. 1988) (“A *summary judgment* that a reputable attorney has been guilty of inequitable conduct, over his denials, ought to be, and can properly be, rare indeed.”); *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 1566 (Fed. Cir. 1987) (“If the facts of materiality or intent are reasonably disputed, the issue is not amenable to summary disposition.”)

II. Saxon’s Motion – No Invalidity

Saxon moves for summary determination that the ‘873 patent is not invalid under 35 U.S.C. § 102(e) because the ‘873 patent disclosure pre-dates the filing dates of U.S. Patent No. 5,771,394 (“the ‘394 patent”), U.S. Patent No. 5,630,165 (“the ‘165 patent”), and U.S. Patent No. 5,771,393 (“the ‘393 patent”). Saxon relies on an invention disclosure form from Advanced Micro Devices, Inc. (“AMD”) where the inventors of the ‘873 patent allegedly disclosed the details of the invention found in the ‘873 patent. The invention disclosure form is dated July 17, 1992, which pre-dates the earliest priority dates for the ‘394 patent, the ‘165 patent, and the ‘393 patent. The ‘394 patent, the ‘165 patent, and the ‘393 patent all claim priority back to U.S. Patent Application No. 07/983,477, which was filed on December 3, 1992.

Saxon claims that Samsung’s expert, Dr. Steven Melvin, admits that the invention disclosure form establishes an invention date pre-dating the priority date for the ‘394 patent, the ‘165 patent, and the ‘393 patent. Saxon further claims that Dr. Melvin acknowledged that the invention disclosure form disclosed each and every element of claims 1 and 13 of the ‘873

patent. Based on the invention disclosure form and the testimony of Dr. Melvin, Saxon moves for summary determination that the '873 patent is not invalid under 35 U.S.C. § 102(e) based on the '394 patent, the '165 patent, or the '393 patent.

Samsung opposes the motion. Samsung argues that Saxon has failed to meet its burden in demonstrating an earlier conception date for the '873 patent. Samsung raises three independent arguments for denying Saxon's motion: (1) the inventors' invention disclosure form is insufficient evidence to corroborate the earlier invention date; (2) Brett Stewart's signature on the invention disclosure form did not serve to corroborate the earlier invention date; and (3) Saxon has failed to establish diligence in reducing the invention to practice. Samsung further claims that Saxon mischaracterizes Dr. Melvin's testimony, as Dr. Melvin never admitted that the '873 patent was entitled to an earlier invention date.

Staff supports Saxon's motion. Staff claims that the invention disclosure form clearly demonstrates that the '873 patent is entitled to a July 17, 1992 invention date. Staff argues that the form adequately corroborates the testimony of both inventors. Staff claims that Dr. Melvin agreed that all of the limitations found in claims 1 and 13 of the '873 patent are found in the invention disclosure form.

I find that there are genuine issues of material fact that preclude summary determination regarding Saxon's argument that the '873 patent is not invalid under 35 U.S.C. § 102(e). The '873 patent was filed on July 3, 1996, and was a continuation of an application filed on August 30, 1993. The '394 patent, the '165 patent, and the '393 patent all claim priority to the same patent application, filed on December 3, 1992. For purposes of this motion, the parties do not dispute whether or not the patents at issue are entitled to the claimed priority dates. Thus the relevant inquiry is whether Saxon can demonstrate conception prior to December 3, 1992.

Saxon relies on the invention disclosure form attached to its motion. (*See* Ex. 13 to Saxon Mot.) This internal AMD form was completed by the named inventors of the '873 patent

and is dated July 17, 1992. Included with the form is a six-page memo that describes the alleged invention. Each inventor signed the form, and two witnesses signed the form as well. The witnesses initialed each page of the memo.

Saxon further relies on the testimony of Dr. Melvin, Samsung's expert. Saxon claims Dr. Melvin admitted the following: (1) the invention disclosure form establishes a date of invention pre-dating the December 3, 1992 filing date; and (2) the invention disclosure form discloses each and every element of claims 1 and 13 of the '873 patent.

Samsung's first two arguments in opposition center on whether or not the invention disclosure form sufficiently corroborates the claim that the '873 patent is entitled to a July 17, 1992 invention date. "Whether or not corroboration exists is a question of fact[.]" *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1171 (Fed. Cir. 2006). Samsung states that the alleged corroborating evidence comes only from interested parties, thus calling into question the reliability of such evidence. I find that Samsung has raised a genuine issue of material fact regarding the sufficiency of the corroborating evidence that precludes a finding at this time that the '873 patent is entitled to an invention date of July 17, 1992.

In addition, I find that there is a genuine dispute of material fact regarding whether or not the invention disclosure form adequately discloses the claimed subject matter of the '873 patent. In its brief, Saxon makes no effort to compare the claims from the '873 patent to the disclosure in the form. Saxon and Staff only point to Dr. Melvin's deposition testimony, where he testified that under Samsung's proposed claim constructions, the subject matter of claims 1 and 13 are disclosed in the invention disclosure form. (*See Ex. 7 to Staff's Resp. at 143:3-14.*) Samsung nevertheless disputes the assertion that Dr. Melvin admitted that the substance of claims 1 and 13 are disclosed in the invention disclosure form. (*See Samsung's Response to Saxon's Statement of Material Undisputed Facts at ¶ 27.*)

While Saxon and Staff claim that Dr. Melvin admitted that claims 1 and 13 are disclosed in the invention disclosure form, there is no assertion by Saxon or Staff that the invention disclosure form discloses the substance of any other claims in the '873 patent. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1137 (Fed. Cir. 1985) (stating that “it is well settled that each claim of a patent...is to be treated as a complete and independent invention.”) (quoting *Bourns, Inc. v. United States*, 537 F.2d 486, 493 (Ct. Cl. 1976)). Because this issue was not addressed by any party in the briefing, it remains an unresolved factual question that precludes a finding at this time that all of the asserted claims of the '873 patent, or all of the claims of the '873 patent, are entitled to a July 17, 1992 invention date.

Samsung's third argument regarding diligence is inconsistent with the law of § 102(e). As described *supra*, the phrase “before the invention by the applicant for patent” in § 102(e) refers to conception alone, and not the issues associated with § 102(g) (i.e. reduction to practice and diligence). *Power Integrations*, 585 F. Supp. 2d at 575; *Lear Automotive*, 528 F. Supp. 2d at 676-677. Thus, the diligence of the inventors and/or their attorneys is irrelevant to the § 102(e) inquiry.

III. Saxon's Motion – No Inequitable Conduct

Saxon additionally moves for summary determination that the '873 patent is not unenforceable due to inequitable conduct. Saxon argues that Samsung's responsive pleading is insufficient to sustain a claim of inequitable conduct under Fed. R. Civ. P. 9(b) and the Federal Circuit's recent decision in *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312 (Fed. Cir. 2009).

In this investigation, Samsung asserts that AMD and its attorney, { } committed fraud on the Patent Office in obtaining the '873 patent. Specifically, Samsung claims that while { } was prosecuting the application that lead to the '873 patent, he was

{ }

also prosecuting the application that lead to the '394 patent. The '394 patent was also originally owned by AMD, and Samsung alleges that the two patents are virtually identical in substance. Saxon argues that Samsung has failed to offer any evidence that would demonstrate that {

} withheld material information from the Patent Office. Saxon asserts that there is no evidence to support an inference that { } had an intent to deceive the Patent Office.

Samsung opposes the motion. Samsung argues that the evidence demonstrates that the '873 patent was procured through inequitable conduct. Samsung details the who, what, when, why, and how regarding its inequitable conduct allegations. Samsung states that at the very least, there is a genuine factual dispute that precludes summary determination.

Staff opposes Saxon's motion. Staff argues that Samsung has sufficiently pleaded its inequitable conduct defense under Fed. R. Civ. P. 9(b).

I find that there are genuine issues of material fact that preclude summary determination. Saxon first questions the sufficiency of Samsung's inequitable conduct pleading, claiming that it is entitled to summary determination because Samsung's pleading fails to meet the standard set in Fed. R. Civ. P. 9(b). This argument is now moot in light of Order No. 39C, in which I granted-in-part Samsung's motion to amend its response to add sufficient detail regarding its inequitable conduct claim. Because I have already found, in Order No. 39C, that Samsung's second amended response complies with Fed. R. Civ. P. 9(b), Saxon is not entitled to summary determination.

In addition, there are genuine issues of material fact regarding both the materiality and the intent prongs of the inequitable conduct inquiry. While "a misstatement or omission may be material even if disclosure of that misstatement or omission would not have rendered the invention unpatentable," I find that a determination of whether or not the '394 patent is prior art is an important factual issue that is relevant to the materiality determination. *Digital Control*,

437 F.3d at 1318. Because I have found *supra* that there are factual disputes that preclude summary determination on the issue of whether or not the ‘394 patent is prior art under 35 U.S.C. § 102(e), I find that there is a genuine issue of material fact regarding the materiality prong.

In addition, I find that there is a genuine issue of material fact regarding intent to deceive. Intent to deceive focuses on the state of mind of the persons involved, and is thus a highly factual matter not well suited for resolution by summary determination. *See Copelands’ Enter., Inc. v. CNV, Inc.*, 945 F.2d 1563, 1567 (Fed. Cir. 1991) (“As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment.”); *KangaROOS*, 778 F.2d at 1576 (“Intent to mislead or deceive is a factual issue that, if contested, is not readily determined within the confines of Fed.R.Civ.Proc. 56.”)

Saxon and { } deny that there was any intent on the part of { } to deceive the Patent Office. Samsung claims that the facts, examined as a whole, demonstrate that { } had the intent to deceive the Patent Office by failing to disclose the ‘394 patent prosecution. It is clear from the briefing that the parties vigorously dispute the facts surrounding the intent prong. Because the issue of intent is such a highly factual matter that is dependent on the state of mind of the individuals involved, I find that summary determination of no inequitable conduct is not appropriate in this case.³

IV. Samsung’s Motion

Samsung moves for summary determination of unenforceability due to inequitable conduct. Samsung claims that while { } was prosecuting the application that lead to the ‘873 patent, he was also prosecuting the application that lead to the ‘394 patent. The ‘394

³ Ground Rule 3.3 requires that when filing a motion for summary determination, the moving party must include a statement of material undisputed facts. The rule specifies that “[t]he statement shall consist of short numbered paragraphs with specific references to supporting declarations, affidavits or other materials.” A majority of the paragraphs in Saxon’s statement do not include any reference to supporting evidence. (*See generally* Saxon’s Statement of Material Undisputed Facts.) This is a clear violation of Ground Rule 3.3, and serves as an additional basis to deny Saxon’s motion.

patent was also originally owned by AMD, and Samsung alleges that the two patents are virtually identical in substance. Samsung asserts that { } even made similar amendments to the claim language in both cases.

According to Samsung, { } intentionally failed to disclose the prosecution of the '394 patent to the examiner handling the prosecution of the '873 patent. Samsung claims that if the examiner in the '873 patent prosecution was aware of the '394 patent prosecution, he would have issued rejections based on anticipation, obviousness, and/or obviousness-type double patenting.

In addition, Samsung argues that had the examiner of been aware of the '394 patent prosecution, there would have been an inventorship problem. The '873 patent and the '394 patent each list different sets of inventors.⁴ Yet, according to Samsung, the two patents claim the same inventive concept. Samsung claims that this would have lead to an inventorship conflict that would have prevented both patents from issuing in their current form. For these reasons, Samsung argues that the application leading to the '394 patent and its corresponding prosecution documents were material to the patentability of the '873 patent.

Regarding the intent prong of the inequitable conduct inquiry, Samsung argues that { } course of conduct demonstrates that he intentionally withheld the '394 patent prosecution from the examiner. Samsung claims that as the prosecution of the two patents proceeded, { } amended the claims to make the patent applications more and more similar to each other. Samsung asserts that { } used information from the '394 patent prosecution for his benefit in the '873 patent prosecution. Samsung claims that while { } is well aware of the duty of disclosure explained in the MPEP, he could provide no explanation for his non-disclosures.

⁴ The '873 patent lists Ryan Feemster and David Dettmer as the inventors. The '394 patent lists Saf Asghar and Brett Stewart as the inventors.

Finally, Samsung addresses Saxon's assertion that the '394 patent is not prior art to the '873 patent. Samsung disagrees with this assertion, but states that even if it is true, it does not diminish the materiality of the '394 patent prosecution.

Saxon opposes the motion. Saxon argues that the '394 patent application is not prior art to the '873 patent application under 35 U.S.C. § 102(e) because the invention disclosed in the '873 patent was invented prior to the invention disclosed in the '394 patent. Saxon claims that this fact was acknowledged by Samsung's technical expert. Saxon argues that because the '394 patent was not prior art, it was not material to the patentability of the '873 patent. While Saxon acknowledges that non-prior art may be material in some circumstances, Saxon characterizes those circumstances as "exceptional" and claims that such circumstances were not present in this situation.

Saxon further argues that the claims of the '873 patent application and the claims of the '394 patent application were never similar, thus leading to the conclusion that there would have been no double patenting issues. Saxon asserts that Samsung wrongly focuses on the similarity between the specifications of the two applications, but this is not the relevant inquiry for purposes of double patenting.

Saxon argues that there is no evidence of intent. Saxon reviews the relevant correspondence and asserts that it does not demonstrate that { } intended to deceive the examiner by withholding disclosure of the '394 patent prosecution. Saxon claims that the evidence demonstrates { } good faith. Saxon notes that { } reminded AMD of the duty of disclosure in correspondence. Saxon also notes that { } forwent the issuance of a patent to ensure that the examiner had a chance to review additional material prior art before the patent issued. Saxon claims that this is not the behavior of a man trying to deceive the Patent Office.

Staff argues that the ‘394 patent prosecution was clearly material to the patentability of the ‘873 patent, for all of the reasons asserted by Samsung. Staff claims that the subject matter in the two patent applications was similar enough to support a provisional double patenting rejection. Staff lists a number of facts relating to the materiality of the ‘394 patent prosecution that it believes should be deemed established pursuant to 19 CFR § 210.18(e).

Despite Staff’s position that the ‘394 patent prosecution was material to the patentability of the ‘873 patent, it does not support Samsung’s motion. Staff claims that there is a genuine factual dispute regarding whether or not { } intended to deceive the Patent Office. Staff states that a determination of intent to deceive requires an evaluation of witnesses’ credibility and the plausibility of the explanations offered for their conduct. Staff is of the view that such judgment calls are better made after hearing from the witnesses at trial. Staff claims that the issue of intent to deceive is not ripe for summary determination.

I find that there is a genuine issue of disputed material fact regarding intent to deceive that precludes summary determination. Intent to deceive focuses on the state of mind of the persons involved, and is thus a highly factual matter not suited for resolution by summary determination. *See Copelands’ Enter.*, 945 F.2d at 1567 (“As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment.”); *KangaROOS*, 778 F.2d at 1576 (“Intent to mislead or deceive is a factual issue that, if contested, is not readily determined within the confines of Fed.R.Civ.Proc. 56.”)

Samsung claims that the facts, examined as a whole, demonstrate that { } had the intent to deceive the Patent Office by failing to disclose the ‘394 patent prosecution. Saxon and Mr. McNamara deny that there was any intent on the part of { } to deceive the Patent Office.⁵ It is clear from the briefing that the parties vigorously dispute the

⁵ Samsung filed a motion to strike { } declaration that is attached to Saxon’s opposition. I will address this motion in a separate order. For purposes of my decision, I find it unnecessary to rely on {

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facts surrounding the intent prong. Because the issue of intent is such a highly factual matter that is dependent on the state of mind of the individuals involved, I find that summary determination of inequitable conduct is not appropriate.

ORDER

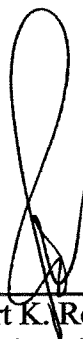
Motion No. 673-033 is hereby DENIED.

Motion No. 673-034 is hereby DENIED.

Within seven (7) days of the date of this Order, 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 concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.



Robert K. Rogers, Jr.
Administrative Law Judge

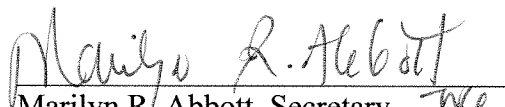
} declaration, as his deposition testimony makes clear that he disputes the assertion that he intended to deceive the Patent Office. (Ex. 17 to Saxon's Mot.)

**CERTAIN ELECTRONIC DEVICES,
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COMMUNICATIONS DEVICES**

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337-TA-667

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Lisa A. Murray, Esq.**, Commission Investigative Attorney, and the following parties via first class mail and air mail where necessary on November 17, 2009


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