

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN POLYIMIDE FILMS,
PRODUCTS CONTAINING SAME,
AND RELATED METHODS**

Inv. No. 337-TA-772

**ORDER NO. 24: DENYING RESPONDENTS' MOTION FOR SUMMARY
DETERMINATION OF INVALIDITY OF CLAIMS 1, 2, 6-10, & 12-
14 OF U.S. PATENT NO. 7,691,961**

(January 26, 2012)

On January 12, 2012, respondents SKC Kolon PI, Inc. and SKC, Inc. (collectively "SKC") filed a motion for summary determination that claims 1, 2, 6-10 and 12-14 of U.S. Patent No. 7,691,961 ("the '961 patent") are invalid as anticipated by prior art (the "Motion"). (Motion Docket No. 772-025.) On January 23, 2012, complainant Kaneka Corporation ("Kaneka") filed a response opposing the motion.

SKC asserts that the asserted claims of the '961 patent at issue herein are invalid in light of prior art polyimide films manufactured and sold by E.I. DuPont de Nemours and Company ("DuPont") in the United States more than one year prior to the earliest priority date asserted by Kaneka for the '961 patent. SKC says that Kaneka contends that the inventors of the '961 patent conceived of the inventions claimed therein "in early 2003" and reduced the inventions to practice "in or about the Summer of 2003." (Citing Kaneka's Third Supplemental Responses to SKC's First Set of Interrogatories (Nos. 1-83, dated November 11, 2011 at 14 and 20).)

SKC alleges that the undisputed facts show that DuPont made and sold polyimide films in the United States that anticipate the claims of the '961 patent at issue prior to any alleged invention by Kaneka. SKC states that DuPont Kapton® film products include the Kapton® 200 HN and 200FPC. SKC continues that DuPont provided samples of the Kapton® 200HN and 200FPC that are representative of those films manufactured prior to September 27, 2001. SKC contends that said films meet each claimed feature set forth in claims 1, 2, 6-10 and 12-14, as those claims are construed by Kaneka.

SKC states that the claims at issue cover polyimide films that have certain measurable physical properties. SKC avers that a sample of the Kapton® 200HN produced by DuPont was submitted to "Intertek" for independent testing using a protocol provided by SKC and based on the '961 patent. SKC says that Intertek prepared a report of the testing results on December 19, 2011.

SKC states that two samples of Kapton® 200FPC were tested by SKC using a protocol based on the '961 patent. SKC continues that two reports were generated based on SKC's testing results, dated December 22, 2011 and December 30, 2011.

SKC says that Dr. Edwin Thomas, SKC's expert, submitted an expert witness report on December 2011, as well as errata pages to his report on December 30, 2011. SKC states the Dr. Thomas opined in his report that the Kapton® 200HN anticipates claims 1, 2 and 6-8 of the '961 patent, and the Kapton® 200FPC anticipates claims 9, 10 and 12-14 of the '961 patent.

SKC's supporting memorandum asserts that there is no genuine dispute of fact that each and every element of claims 1, 2, 6-8, 9, 10, and 12-14 of the '061 patent is anticipated by DuPont's Kapton® 200HN or 200FPC films. SKC concludes that the documents and declaration provided by DuPont indisputably show that both the Kapton® 200HN and 200FPC films were

manufactured and sold in the United States as early as the mid-1980's and mid-1990's. SKC's memorandum includes claim charts summarizing how SKC contends that the test results show that the Kapton® 200HN and 200FPC films anticipate the claims at issue herein.

Kaneka opposes the Motion as premature, because claim construction has not occurred in this case and because there are genuine issues of material fact in dispute.

Kaneka begins by asserting that SKC has made an untimely effort to introduce evidence, and Kaneka ties that assertion to SKC's motion for leave to take a third party deposition after close of fact discovery. (Motion Docket No. 772-021¹)

Kaneka next contends that a finding of anticipation requires that prior art meet "each element of the claim, properly construed." (Citing *Zenith Elecs. Corp. v. PDI Commc'n Sys., Inc.*, 522 F.3d 1348, 1363 (Fed. Cir. 2008) (emphasis added by Kaneka).) Kaneka notes that the parties in the instant case dispute construction of the claim term "a polyimide film produced by a continuous process," which is present in claims 1 and 9. Kaneka alleges that SKC's use of Kaneka's constructions "leaves Kaneka no opportunity to dispute facts alleged in the declaration against those properly construed terms." Kaneka complains that SKC has rejected the construction it now applies in its Motion.

Kaneka finally argues that there are genuine issues of material fact in dispute and provides a detailed review of its challenge to the methods and results of the testing of the DuPont films upon which SKC bases its assertion that the claims at issue are invalid as anticipated. Kaneka says that SKC's molecular orientation axis tests used unreliable methods by: (1) using the wrong equipment to conduct the tests and incorrectly using visible light rather than

¹ In Order No. 23, I denied SKC's motion as unnecessary and lacking a showing of good cause for the delay in holding the deposition. I did not rule in Order No. 23 that the underlying documentary and physical evidence was inadmissible at hearing, and Order No. 23 does not impact on SKC's ability to subpoena a DuPont witness at the hearing on this matter. (See Ground Rules 8.1 through 8.4, 9.3, and 10.5.1 through 10.5.4.)

microwave measurements; (2) failing to follow the protocol established by its own expert witness to conduct the testing; and (3) using a single MOA sample to calculate multiple Coefficient of linear expansion (“CLE”) and tear propagation resistance (“TPR”) values. Based upon its challenges to the methods and results of testing, Kaneka argues that there is a genuine issue of material fact in dispute. (See Kaneka’s memorandum opposing the Motion, pages 5-9, and supporting exhibits)

I. Applicable Law

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).

It is SKC’s burden to prove invalidity, and the burden of proof never shifts to Kaneka to prove validity. *Scanner Techs. Corp. v. ICOS Vision Sys. Corp. N.V.*, 528 F.3d 1365, 1380 (Fed. Cir. 2008). “Under the patent statutes, a patent enjoys a presumption of validity, *see* 35 U.S.C. § 282, which can be overcome only through facts supported by clear and convincing evidence[.]” *SRAM Corp. v. AD-II Eng’g, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006).

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).

“A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). “Anticipation is a question of fact.” *SRAM Corp.*, 456 F.3d at 1357.

II. Analysis

A. Claims 1, 2 & 6-8

Independent claim 1 recites:

A polyimide film produced by a continuous process, wherein a coefficient of linear expansion a in a direction of the molecular orientation axis and a coefficient of linear expansion b in a direction perpendicular to the molecular orientation axis are measured in the temperature range of 100°

C. to 200° C., a coefficient of linear expansion ratio A represented by equation (1):

$$A=1+\{(b-a)/(b+a)\} \times 2 \quad (1)$$

is in the range of 1.13 to 3.00 across the entire width.

(Ex. 1 to Mot. at 37:2-11.)

Kaneka's attack on the methods and results of testing clearly involves the calculation of the molecular orientation axis (MOA) and the coefficient of linear expansion in both the direction of the MOA and in a direction perpendicular to the MOA, all of which are required in claim 1. Whether or not the alleged DuPont prior art is found to anticipate claim 1 will require evaluation of the evidence regarding the methods and results of the testing performed to determine those measurements in the DuPont products. I find that a genuine issue of material fact in dispute exists regarding whether or not these measurements were correctly determined for the DuPont films and whether or not the results accurately reflect that the DuPont films meet each and every element of claim 1 of the '961 patent.

Claims 2, 6, 7² and 8 depend from claim 1. Because I find that there is a genuine issue of material fact that precludes summary determination of anticipation of claim 1, it follows that there is a genuine issue of material fact regarding whether or not the DuPont films anticipate claims 2, 6, 7 and 8.

In addition, Kaneka's challenge to the methods and results of measurements of the coefficient of linear expansion raises genuine issues of material facts in dispute for claim 2, because claim 2 contains an element that requires that the difference between the maximum A_{MAX} and the minimum A_{MIN} of the coefficient of linear expansion ratio A is 0.30 or less. In addition to meeting all of the requirements of claim 1, the DuPont films must meet this

² Claim 7 depends from claim 1 via claim 6.

additional requirement of claim 2 in order to anticipate claim 2. A genuine issue of material fact in dispute exists regarding whether or not these measurements were correctly determined for the DuPont films and whether or not the results accurately reflect that the DuPont films practice each and every element of claim 2 of the '961 patent.

B. Claim 9-10 & 12-14

Independent claim 9 recites:

A polyimide film produced by a continuous process, wherein when a tear propagation resistance c in a direction of the molecular orientation axis and a tear propagation resistance d in a direction perpendicular to the molecular orientation axis are measured, the tear propagation resistance ratio d/c is in the range of 1.01 to 1.20 and the difference between the maximum and the minimum of the tear propagation resistance ratio d/c is 0.10 or less across the entire width.

(Ex. 1 to Mot. at 37:35-38:2.)

Kaneka's challenge to the methods and results of testing the DuPont films to determine whether or not they meet the required measurements of CLE and MOA are also material when considering the issue of anticipation of claim 9. In addition, Kaneka's challenge to the methods and results of measurement regarding TPR are material to the issue of anticipation of claim 9 by the DuPont films. I find that a genuine issue of material fact in dispute exists regarding whether or not these measurements were correctly determined for the DuPont films and whether or not the results accurately reflect that the DuPont films practice each and every element of claim 9 of the '961 patent.

Claims 10, 12, 13³ and 14 depend from claim 9. Because I find that there is a genuine issue of material fact that precludes summary determination of anticipation of claim 9, it follows that there is a genuine issue of material fact regarding whether or not the DuPont films anticipate claims 10, 12, 13 and 14.

³ Claim 13 depends from claim 9 via claim 12.


In addition, Kaneka's challenge to the methods and results of measuring the MOA are material to determining whether or not the DuPont films anticipate that claim, because claim 10 requires that the difference between the maximum and the minimum of the MOA of the polyimide film is 40° or less across the entire width. A genuine issue of material fact in dispute exists regarding whether or not these measurements were correctly determined for the DuPont films and whether or not the results accurately reflect that the DuPont films meet each and every element of claim 10 of the '961 patent.

Because there are genuine issues of material fact in dispute for each and every claim at issue, it is not necessary for me to consider the remaining opposing arguments raised by Kaneka.

ORDER

Motion No. 772-025 is hereby DENIED.

SO ORDERED.



Robert K. Rogers, Jr.
Administrative Law Judge

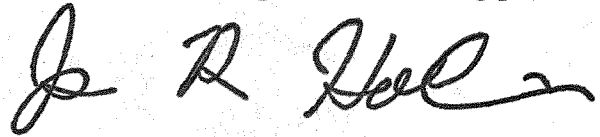
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PUBLIC CERTIFICATE OF SERVICE

I, James R. Holbein, hereby certify that the attached **ORDER** was served upon the following parties via first class mail delivery on

JAN 26 2012



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PUBLIC CERTIFICATE OF SERVICE PAGE 2

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