

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN WINDSHIELD WIPERS AND
COMPONENTS THEREOF

Inv. 337-TA-902

**ORDER NO. 9: GRANTING IN PART TRICO PRODUCTS CORPORATION'S
MOTION TO STRIKE FEDERAL-MOGUL CORPORATION AND
FEDERAL-MOGUL S.A.'S INVALIDITY CONTENTIONS AND
PRECLUDE ANY ADVANCEMENT OF THE CONTENTIONS
THEREIN**

(May 5, 2014)

On March 18, 2014, complainant Trico Products Corporation ("Trico") filed a motion to strike the invalidity contentions of respondents Federal-Mogul Corporation and Federal-Mogul S.A. (collectively "Federal-Mogul") as untimely. (Motion Docket No. 902-004.)¹

On March 27, 2014, Federal-Mogul filed a response opposing the motion. On that same day, the Commission Investigative Staff filed a response supporting the motion.

There appears to be no dispute as to the factual timeline of Federal-Mogul's production of invalidity contentions. Rather, the dispute is whether the production of Federal-Mogul's invalidity contentions was timely and justified.

BACKGROUND

The undisputed timeline is as follows:

<u>DATE</u>	<u>EVENT</u>
December 6, 2013	Trico propounds Interrogatory Nos. 20 and 21 seeking "each theory of invalidity under 35 U.S.C. §§ 101, 102 and 103," including an

¹ Trico refiled the motion on March 26, 2014 in order to correct Exhibit 3, which had the incorrect exhibit attached in the original motion.

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	element by element claim chart detailing the alleged invalidity and identifying supporting documents
December 18, 2013	Federal-Mogul responds to Interrogatory Nos. 20 and 21 objecting to them as premature and referring to a district court complaint filed by Federal-Mogul against Trico in Michigan
February 10, 2014	Trico raises Federal-Mogul's failure to respond to Interrogatory Nos. 20 and 21
February 24, 2014	Federal-Mogul files Notice of Prior Art
February 25, 2014	Trico sends Interrogatory No. 37 seeking an element by element, claim by claim analysis of the references listed in Federal-Mogul's Notice of Prior Art
February 27, 2014	Cut-off date for responses to contention interrogatories
March 7, 2014	(1) Last day of fact discovery (2) Federal-Mogul responds to Interrogatory No. 20 and produces extensive claim charts ²

Trico argues that Federal-Mogul's invalidity contentions that were produced for the first time after the close of fact discovery should be stricken and that Federal-Mogul should be precluded from advancing the contentions stated therein. Trico argues that Federal-Mogul deliberately withheld its contentions without any legal or factual basis and that its decision to withhold the contentions was tactical. Trico asserts that, despite Federal-Mogul's arguments to the contrary, Trico's infringement contentions are irrelevant to Federal-Mogul's obligation to produce its invalidity contentions. Trico further argues it has been prejudiced by Federal-Mogul's untimely disclosure because it has been unable to conduct any fact discovery on the prior art disclosed in the untimely produced contentions and it had deprived Trico of the full time to review and address Federal-Mogul's contentions. Trico further argues that Federal-Mogul did

² There appears to be a slight disagreement as to whether these claim charts were produced on March 7, 2014 or on March 10, 2014. Federal-Mogul explains that due to an email issue, it was unaware that Trico did not receive the detailed claim charts on March 7, 2014. Federal-Mogul explains that it immediately sent the claim charts to Trico once it realized the error. As will be explained in more detail below, this discrepancy is irrelevant to the ALJ's analysis and decision on this motion.

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not timely respond to its contentions as its responses were produced after the deadline for responses to contention interrogatories (even if before the 10 day deadline for responding to interrogatories). Trico further notes that the said responses did not even contain invalidity contentions and that the actual contentions were not produced until March 2014. Consequently, Trico seeks to strike Federal-Mogul's invalidity contentions that were first produced in March 2014 and any supplements thereto.

Staff agrees that Federal-Mogul's invalidity contentions that were produced after the February 27, 2014 deadline should be stricken. Staff argues that Federal-Mogul was aware of the deadline and has failed to show any good cause for its late production of claim charts. Staff notes that even with the more specific Interrogatory No. 37 propounded on February 25, 2014, Federal-Mogul was still obligated to respond to Interrogatory Nos. 20 and 21 before the February 27, 2014 deadline.

The ALJ agrees with Trico and Staff and finds that Federal-Mogul has failed to provide any good cause for its late production of responsive invalidity claim charts. Consequently, the ALJ hereby strikes any invalidity contentions produced for the first time after the February 27, 2014 deadline. The ALJ further notes, to the extent that there is any confusion, Federal-Mogul's experts are also precluded from testifying or providing any opinion as to these references.

Federal-Mogul's explanation as to why it did not timely produce its invalidity claim charts is simply that since Federal-Mogul did not receive Trico's infringement charts, it could not provide invalidity claim charts. The ALJ finds such an explanation unpersuasive. First, Federal-Mogul has failed to explain how Trico's infringement contentions have any significant tie to Federal-Mogul's invalidity contentions. The ALJ is unaware of any such tie and Federal-

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Mogul fails to explain such a tie except to state in a conclusory fashion that they “needed” the contentions in order to adequately provide invalidity contentions.

Second, even assuming that the tenuous relationship exists (*e.g.*, to the extent that the infringement contentions may implicate claim construction), that still fails to justify the delay. Federal-Mogul could have easily set forth its invalidity contentions based on its own claim construction and provided supplemental claim charts to the extent that Trico’s infringement contentions effected and/or changes Federal-Mogul’s invalidity contentions. Indeed, parties in Section 337 regularly produce invalidity contentions on the same day that infringement contentions are produced without the benefit of having seen infringement contentions.

Moreover, the ALJ notes that none of the references cited by Federal-Mogul were “newly discovered” references that would warrant a late production. Indeed, Federal-Mogul’s invalidity contentions relate to several that were cited in the prosecution of the patents.

As for Federal-Mogul’s response to Trico’s February 25, 2014 interrogatories, the ALJ hereby strikes those as well to the extent that they were not previously disclosed in response to Interrogatory Nos. 20 and 21. While they were timely produced in response to the February 25, 2014 interrogatory, Federal-Mogul cannot skirt its obligation to timely respond to the December invalidity contention interrogatory by now claiming to timely respond to the later produced interrogatory. In other words, had Federal-Mogul timely responded to Interrogatory Nos. 20 and 21 with its invalidity contentions, then the more specific response to February Interrogatory No. 37, would be permitted since they would likely have been identical if not substantially similar.

The ALJ finds that waiting for Trico’s infringement contentions fails to constitute any good cause as to why Federal-Mogul failed to timely respond to Trico’s December Interrogatory Nos. 20 and 21 seeking invalidity contentions. Moreover, while experts certainly play a role in

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fleshing out invalidity arguments, expert reports have never been the first instance in which invalidity arguments are set forth—especially in circumstances such as these when contention interrogatories are propounded and all of the parties have agreed to a cut-off date for responses to said contention interrogatories. Federal-Mogul cannot seek to salvage its invalidity case through expert discovery.

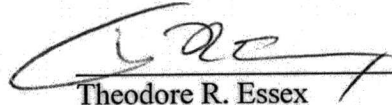
The ALJ notes, however, that Federal-Mogul did timely respond to Interrogatory Nos. 20 and 21 by referring Trico to the Federal-Mogul complaint filed in the Eastern District of Michigan. To the extent that any of the further detailed contentions produced after March 7, 2014 relate specifically to any references set forth in that complaint, the ALJ will allow those. However, if the prior art reference and/or argument was not specifically referenced in the complaint, then it will be stricken from this proceeding.

For the reasons set forth above, the ALJ hereby GRANTS IN PART Motion No. 902-004. Federal-Mogul's responses to any contention interrogatories produced after March 7, 2014 that were not specifically and explicitly discussed and referenced in Federal-Mogul's complaint filed in the Eastern District of Michigan are hereby stricken. The ALJ notes that this extends to any expert testimony as well.

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. Any party seeking to have any portion of this document deleted from the public version thereof shall also submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information. The parties' submissions may be made by facsimile and/or hard copy by the

aforementioned date. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED



Theodore R. Essex
Administrative Law Judge

**CERTAIN WINDSHIELD WIPERS
AND COMPONENTS THEREOF**

Inv. No. 337-TA-902

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER 9** has been served by hand upon the Commission Investigative Attorney, Monisha Deka, Esq., and the following parties as indicated, on **June** 3, **2014**.



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