

**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. 23: GRANTING IN PART VALEO'S MOTION TO STRIKE  
PORTIONS OF THE INITIAL EXPERT REPORT OF  
GREGORY DAVIS**

(June 3, 2015)

**I. INTRODUCTION**

On May 6, 2015, Complainants Valeo North America, Inc. and Delmex de Juarez S. de R.L. de C.V. (collectively, "Valeo") filed a motion to strike portions of the initial expert report of Gregory Davis ("Davis Report"). (Motion Docket No. 928-014.) On May 18, 2015, Respondents Trico Products Corporation and Trico Componentes SA de CV (collectively, "Trico"), filed a response in opposition to Valeo's motion to strike.<sup>1</sup>

Valeo argues that the Davis Report includes new invalidity opinions against U.S. Patents 7,891,044 ("the '044 patent") and 7,937,798 ("the '798 patent") (collectively, "the asserted patents"), that were not previously disclosed in Trico's invalidity contentions, relating to: (1) new matter; (2) indefiniteness; (3) lack of written description; and (4) motivation to combine prior art references. In addition, Valeo argues that the Davis Report includes improper legal conclusions relating to public use and sale of the claimed invention. Trico counters that the invalidity arguments at issue were disclosed in its initial invalidity contentions and/or pursuant to Order No. 16 granting Trico's motion to supplement its invalidity contentions.

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<sup>1</sup> Valeo's memorandum in support of Valeo's motion to strike and Trico's opposition thereto, are hereinafter referred to, respectively, as "Valeo Br." and "Trico Opp'n Br."

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For the reasons below, Valeo's motion to strike is granted in part and denied in part.

**II. BACKGROUND**

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 was filed on May 12, 2010 and issued on May 10, 2011. The '798 patent issued from a continuation application to the patent application which issued as the '044 patent.<sup>2</sup>

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 published on May 23, 2002; (2) Great Britain Patent No. 1546116, issued May 16, 1979; (3) German Patent No. DD 77904, issued November 20, 1970; (4) French Patent No. 2788027, issued July 7, 2000; and (5) U.S. Patent No. 2,147,113, issued February 14, 1939. *See* Trico's Invalidity Contentions, served March 20, 2015 (attached as Exhibit CX-2C to Valeo Br.).

On April 23, 2015, I granted Trico's motion to supplement its invalidity contentions (Order No. 16) to include additional contentions based on prior art references U.S. Patent No. 5,682,639 and French Patent No. 2630070, as well as [

] *See* Trico's Memorandum in Support of Motion to Supplement Its Invalidity Contentions, filed April 10, 2015, at 3 (attached as Exhibit RX-2C to Trico Opp'n Br.).

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<sup>2</sup> The effective date of the asserted patents pre-dates the America Invents Act ("AIA") enacted by Congress on September 16, 2011. The pre-AIA version of the patent statute, 35 U.S.C. § 112, cited herein, applies to the asserted patents.

### III. DISCUSSION

#### A. New Matter Opinions

Valeo argues that the Davis Report includes newly disclosed opinions relating to new matter. Specifically, Valeo objects to the Davis Report's arguments that sixteen claim terms of the '798 patent cannot be found in the specification of the '044 patent, and as such, the claims of the '798 patent are not entitled to the November 21, 2003 priority date of the '044 patent, and are anticipated by, at least, U.S. Patent Application Publication No. 2006/0117515, which issued as the '044 patent. *See* Valeo Br. at 2-3 (citing ¶ 60 of the Davis Report). Trico counters that the "new matter" contentions were adequately disclosed in its original invalidity contentions, in connection with its invalidity arguments relating to lack of enablement under 35 U.S.C. § 112, ¶ 1 and indefiniteness under § 112, ¶ 2. *See* Trico Opp'n Br. at 4.

While I agree with Valeo that the Davis Report's "new matter" opinion was not specifically disclosed in Trico's invalidity contentions, Valeo was on notice of Trico's "new matter" arguments. Indeed, Trico's original invalidity contentions, at pages 4-5, state that "[i]nasmuch as the Asserted Patents are not entitled to claim this priority, such as because one or more Asserted Claims contains new matter, Respondents reserve the right to supplement these Invalidity Contentions with additional intervening prior art references."<sup>3</sup> *See* Trico's Invalidity Contentions, served March 20, 2015, at 4-5 (attached as CX-2C to Valeo Br.).

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<sup>3</sup> Trico argues that its original invalidity contentions disclose that "the ['798 patent] specification does not sufficiently describe what structure defines" one or more of the claim terms. However, such an argument relates to lack of enablement under § 112, ¶ 1, and is distinct from a "new matter" argument relating to a priority date issue. Similarly, Trico's original invalidity contentions disclosed that one or more claim terms of the '798 patent is "ambiguous such that its meaning is not reasonably certain to a person of ordinary skilled in the art," but such an argument relates to indefiniteness under § 112, ¶ 2, and is distinct from the "new matter" argument relating to a priority date issue.

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However, the “new matter” argument is moot because Dr. Davis admits that “[he] provided [his] invalidity analysis using the earliest effective U.S. filing date of Nov. 21, 2003 as the priority date for the ‘798 patent.” *See* Davis Report at ¶ 61 (attached as Exhibit RX7-1C to Trico Opp’n Br.). In addition, Trico may not rely on intervening prior art, including U.S. Patent Application Publication No. 2006/0117515, which issued as the ’044 patent, because Trico never disclosed such intervening prior art in its invalidity contentions.

Accordingly, Valeo’s motion to strike ¶ 60 of the Davis Report is granted, but only with respect to the portion which discusses intervening prior art, *i.e.*: “In this event, It is my opinion that the claims of the ‘798 Patent that are only entitled to the 2010 filing date are anticipated by, . . . , as well as on the basis of any other such activities prior to March 10, 2009.”

**B. Indefiniteness Opinions**

Valeo argues that the Davis Report includes new grounds of indefiniteness for claims 1, 4, and 7 of the ‘798 patent, based on the alleged ambiguity of the term “blade support element.” *See* Valeo Br. at 3 (citing ¶¶ 324, 376, 419 of the Davis Report). Trico counters that the indefiniteness contentions for the term “blade support element” were sufficiently disclosed in its original invalidity contentions, albeit in the section relating to lack of enablement under 35 U.S.C. § 112, ¶ 1. *See* Trico Opp’n Br. at 6.

I agree with Valeo that Trico’s indefiniteness contentions relating to the term “blade support element” in claims 1, 4, and 7 of the ’798 patent were not previously disclosed in Trico’s invalidity contentions. The only invalidity argument relating to the term “blade support element” appears on page 11 of Trico’s original invalidity contentions, in the section relating to lack of enablement under 35 U.S.C. § 112, ¶ 1, which states: “Regarding claim 1 [of the ’798 patent], the specification does not sufficiently describe what structure defines . . . the ‘blade support

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element.” Trico argues that this contention “supports multiple theories of invalidity for lack of enablement and lack of written description under § 112 ¶ 1, as well as indefiniteness under § 112 ¶ 2.” See Trico Opp’n Br. at 6. However, under Ground Rule 7.5.1, Trico was required to include in its invalidity contentions “[a]ny grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112 ¶ 2 or enablement or written description under 35 U.S.C. § 112 ¶ 1 of any of the asserted claims and an explanation of said grounds.”<sup>4</sup>

Trico’s invalidity contentions did include a section stating several grounds of invalidity for indefiniteness with respect to the ’798 patent, but the claim term “blade support element” was not identified as a basis for anyone of those grounds. See Trico’s Invalidity Contentions, served March 20, 2015, at 13-17 (attached as Exhibit CX-2C to Valeo Br.). Instead, the claim term “blade support element” was identified as a basis for lack of enablement of the asserted claims of the ’798 patent.<sup>5</sup> See Trico’s Invalidity Contentions, served March 20, 2015, at 11 (attached as Exhibit CX-2C to Valeo Br.). Indeed, the blade support element contention appears in the section of Trico’s invalidity contentions relating to lack of enablement, immediately follows the legal standard/conclusion for lack of enablement (*i.e.*, that the “Asserted Claims 1-12, 14, and 15 of the ’798 patent contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention”), and provides support therefor.

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<sup>4</sup> See *O2 Micro Intern. Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355, 1364 (Fed. Cir. 2006) (“[T]he [patent] local rules [are] . . . designed specifically to require parties to crystallize their theories of the case early in the litigation so as to prevent the shifting sands approach to claim construction.”) (citation omitted).

<sup>5</sup> Trico noted at page 2 of its Corrected Response in Opposition to Valeo’s Motion for Partial Summary Determination of Validity, filed May 1, 2015, that “Respondents 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.”

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Further, Trico's argument that the blade support element contention can support a ground of invalidity for indefiniteness is tenuous at best, and cannot provide notice to Valeo that Trico intended to assert invalidity for indefiniteness based on the "blade support element" claim term. *See Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof*, Inv. No. 337-TA-868, Order No. 85, 2013 WL 7150208, \*4 (U.S.I.T.C. Dec. 23, 2013) (granting motion to strike portions of expert report and finding that "[a party] is not required to piece together the [other party's] contentions by making inferences from the totality of all of its contention interrogatory responses").

Accordingly, Valeo's motion to strike is GRANTED with respect to ¶¶ 324, 376, 419 of the Davis Report.

**C. Lack of Written Description Opinions**

Valeo argues that the Davis Report includes new grounds of invalidity for lack of written description. *See* Valeo Br. at 4 (citing ¶¶ 4, 48, 60, 102, 111, 266, 290 of the Davis Report). Trico counters that the lack of written description contentions were sufficiently disclosed in its original invalidity contentions, albeit in the section relating to lack of enablement under 35 U.S.C. § 112, ¶ 1. *See* Trico Opp'n Br. at 7-10.

I agree with Valeo that Trico's invalidity contentions do not provide notice of invalidity for lack of written description. Trico was required, under Ground Rule 7.5.1, to include in its invalidity contentions "[a]ny grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112 ¶ 2 or enablement or written description under 35 U.S.C. § 112 ¶ 1 of any of the asserted claims and an explanation of said grounds." Trico challenged the sufficiency of the disclosures of the '044 patent and '798 patent but only in connection with a lack of enablement theory of invalidity. *See* Trico's Invalidity Contentions, served March 20, 2015,

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at 5-6, 11-13 (attached as Exhibit CX-2C to Valeo Br.). Trico's invalidity contentions nowhere disclosed a separate ground of invalidity based on lack of written description as required under Ground Rule 7.5.1. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340 (Fed. Cir. 2010) (en banc) ("We now reaffirm that § 112, first paragraph, contains a written description requirement separate from enablement . . .").

Nevertheless, I will not strike ¶¶ 4, 48, 60, 102, 111, 266, 290 of the Davis Report to the extent they address the lack of enablement ground of invalidity which was properly disclosed in Trico's invalidity contentions. *See, e.g., Certain Audio Digital-to-Analog Converters and Products Containing Same*, Final Initial and Recommended Determinations, Inv. No. 337-TA-499, 2004 WL 3121325, \*33, \*56 (U.S.I.T.C. Nov. 15, 2004) (analyzing respondents' claims of lack of "enabling written description" or "enabling disclosure" under the statutory enablement requirement).

Accordingly, Valeo's motion to strike is DENIED with respect to ¶¶ 4, 48, 60,<sup>6</sup> 102, 111, 266, 290 of the Davis Report, to the extent explained above. Nevertheless, Trico may not use these very same paragraphs to support any allegation of a lack of written description.

**D. Motivation to Combine Prior Art References**

Valeo argues that Trico's initial invalidity contentions fail to adequately disclose how or why a person having ordinary skill in the art would combine and/or modify the references cited therein. *See Valeo Br.* at 4-7 (citing ¶¶ 105-6, 126, 131-2, 134, 139, 153, 155-6, 158, 165, 167-8, 170, 177, 179-80, 182, 186, 188-9, 191, 202, 204-5, 207, 215, 217, 224, 227-9, 237, 239, 247, 250, 254, 256, 260, 262, 275, 278-9, 281, 298, 300, 311, 313-6, 319, 320, 339, 343, 345, 349,

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<sup>6</sup> As discussed, *supra* pp. 3-4, Valeo's motion to strike ¶ 60 of the Davis Report is granted, but only with respect to the portion which discusses intervening prior art, *i.e.*: "In this event, It is my opinion that the claims of the '798 Patent that are only entitled to the 2010 filing date are anticipated by, . . ., as well as on the basis of any other such activities prior to March 10, 2009."

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362, 364, 372, 374, 385, 387, 400, 402, 411, 413, 427, 430, 440, 442, 450, 454, 472, 476, 487, 489, 499, 501, 505-7 of the Davis Report). Trico counters that its invalidity contentions comply with Ground Rule 7.5.1 and provide a “generalized discussion” of motivation to combine. See Trico Opp’n Br. at 10-14.

I agree with Trico that its invalidity contentions comply with Ground Rule 7.5.1 and provide sufficient notice to Valeo. Parties are not expected to disclose a full explanation of the motivation to combine prior art references in their invalidity contentions. See *Certain Integrated Circuit Devices and Products Containing the Same*, Inv. No. 337-TA-873, Order No. 43, 2014 WL 984661, \*2 (U.S.I.T.C. Feb. 10, 2014) (denying complainant’s motion to strike expert report where “the discussion of motivation to combine in [the expert’s] report provide[d] a reference-specific application of the generalized discussion of motivation to combine found in the supplemental contentions”). See also *Fujifilm Corporation v. Motorola Mobility LLC*, Docket No. 12-cv-3587, 2015 WL 757575, \*32 (N.D. Cal. 2015) (declining to strike portion of expert report where plaintiff failed to “show[] that the undisclosed motivations to combine it seeks to strike constitute new invalidity theories, as opposed to more specific articulations of previously disclosed ones”); *Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof*, Inv. No. 337-TA-868, Order No. 83, 2013 WL 6858001, \*3 (U.S.I.T.C. Dec. 18, 2013) (“Contentions are not a portrait of trial.”) (quotation omitted).

Accordingly, Valeo’s motion to strike is DENIED with respect to ¶¶ 105-6, 126, 131-2, 134, 139, 153, 155-6, 158, 165, 167-8, 170, 177, 179-80, 182, 186, 188-9, 191, 202, 204-5, 207, 215, 217, 224, 227-9, 237, 239, 247, 250, 254, 256, 260, 262, 275, 278-9, 281, 298, 300, 311, 313-6, 319, 320, 339, 343, 345, 349, 362, 364, 372, 374, 385, 387, 400, 402, 411, 413, 427, 430, 440, 442, 450, 454, 472, 476, 487, 489, 499, 501, 505-7 of the Davis Report.



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**E. Public Use and Sale of the Claimed Invention**

Valeo argues that the opinions disclosed in Section V(A) of the Davis Report relating to Trico's public use and on-sale defenses are akin to patent law testimony and are not the proper subject matter of expert testimony. *See* Valeo Br. at 7-12 (citing Section V(A) of the Davis report). Trico counters that the Davis Report reasonably presents technical opinions and conclusions of one having ordinary skill in the art reviewing the documents and facts produced during discovery. *See* Trico Opp'n Br. at 14-16.

I agree with Trico that the Davis Report's opinions on public use and sale of the claimed invention are permissible. Courts have permitted experts to review documentary evidence to support technical opinions on public use and on-sale defenses. *See, e.g., Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1365 (Fed. Cir. 2012) (“[Plaintiff’s] expert testified that, based on his reading of [the patient’s] operative notes and pictures of his treatment, the system used on [the patient] was not the system disclosed in the prior art publications. [Plaintiff’s] expert also testified that the prior art public use did not have a seal capable of maintaining negative pressure because [the patient’s] skin had several sump drains that freely let air flow.”) (citations omitted); *Accenture Global Services GmbH v. Guidewire Software Inc.*, 691 F. Supp. 2d 577, 587 (D. Del. 2010) (“[Defendant’s expert] provided a supplemental expert report . . . providing details regarding the on-sale bar defense, including the identification of many (but not all) documents cited in defendant's summary judgment motion.”).

In addition, to the extent Valeo takes issue with the reliability of the opinions expressed in Section V(A) of the Davis Report, I find that those arguments go to the weight of the opinions rather than their admissibility. Valeo's concerns thereon can be adequately addressed during the cross examination of Dr. Davis. *See, e.g., Certain Windshield Wipers and Components Thereof*,

*Public Version*

Inv. No. 337-TA-902, Order No. 20, 2014 WL 3519085, \*\*4-5 (U.S.I.T.C. June 20, 2014) (declining to strike expert testimony “about the histories of the inventions claimed in the Asserted Patents and of [respondent’s] development of the Accused Products” where such testimony is expert’s “understanding upon which he based his opinions,” and holding that “the ALJ can assign the appropriate weight to the testimony”); *Certain Light-Emitting Diodes and Products Containing Same*, Inv. No. 337-TA-785, Order No. 35, 2012 WL 3066902, \*3 (U.S.I.T.C. July 5, 2012) (denying motion to preclude allegedly unreliable testimony).

Accordingly, Valeo’s motion to strike is DENIED with respect to Section V(A) of the Davis Report.

**IV. CONCLUSION**

Valeo’s motion to strike portions of the initial expert report of Gregory Davis is GRANTED with respect to:

- ¶ 60 of the Davis Report, but only with respect to the portion which discusses intervening prior art, *i.e.*: “In this event, It is my opinion that the claims of the ‘798 Patent that are only entitled to the 2010 filing date are anticipated by, . . . , as well as on the basis of any other such activities prior to March 10, 2009.”

- ¶¶ 324, 376, 419 of the Davis Report, which relate to the indefiniteness arguments based on the “blade support element” claim term.

Valeo’s motion to strike is otherwise DENIED.<sup>7</sup>

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<sup>7</sup> As discussed, *supra* pp. 6-7, Trico may not rely on ¶¶ 4, 48, 60, 102, 111, 266, 290 of the Davis Report to support a ground of invalidity for lack of written description.

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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.<sup>8</sup>

**SO ORDERED.**



Thomas B. Pender  
Administrative Law Judge

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<sup>8</sup> 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. 23** have been served upon, **The Office of Unfair Import Investigations** and the following parties on

JUN 11 2015



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
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