

The Plaintiff filed a motion to amend the final infringement contentions (Dkt. 78) which includes an assertion that an additional product (FPH-ULP) infringes claim 29 of the '172 patent. The Court denied the Plaintiff's motion without prejudice due to the parties agreeing to defer the deadline for the final infringement contentions until after the Markman hearing. However after conferring with new counsel Mr. Sheerin, the Defendant believes that non-infringement contentions should be communicated to the Plaintiff prior to the Markman hearing since the Defendant's non-infringement contentions depend on the interpretation of the terms "first position" and "second position" recited in claim 29. That is, these terms need to be construed during the Markman hearing, and therefore the Defendant should communicate its non-infringement contentions to the Plaintiff prior to the Markman hearing. Since the Defendant will eventually be allowed to file non-infringement contentions in response to the Plaintiff's supplemental infringement contentions, the Court should grant the Defendant leave to amend prior to the Markman hearing.

During the conference with Mr. Sheerin on 07/15/2022 (and in the days following), Mr. Sheerin counseled the Defendant on two additional non-infringement arguments that should be asserted against the claims of the '337 patent. The Court should grant leave to amend the non-infringement contentions by including these two additional non-infringement arguments since this case is still early in the proceedings, and the defense to date has been relatively limited. That is, the Plaintiff has had to contend with a very limited number of non-infringement issues, and so adding two non-infringement arguments should not be considered unfairly prejudicial to the Plaintiff. Justice is best served by allowing the Defendant the opportunity to provide a comprehensive defense rather than punishing the Defendant for not strictly complying with the formal scheduling deadlines.

Finally, judicial efficiency weighs in favor of granting the Defendant leave to amend since excluding these non-infringement issues from the current proceeding means these issues will likely be raised during subsequent litigation against other defendants. Disposing of these additional non-infringement issues will aid all parties impacted by this case by helping the patent holder and other prospective defendants understand the validity and scope of the claims, thereby helping avoid unnecessary future litigation.

Accordingly, the Defendant asks this Court for leave to amend its non-infringement contentions with Defendant's Amended Final Non-Infringement Contentions included with this motion.

Dated: July 28, 2022

Respectfully Submitted,

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contentions regarding the '337 Patent are described below and supported by Exhibit 2.

'172 Patent: FPH-ULP

The Plaintiff disclosed a supplemental infringement contention (Dkt. 78) asserting Defendant's Instrumentality FPH-ULP infringes claim 29 of the '172 patent. Exhibit 1 is a claim chart that sets forth the non-infringement contentions on an element by element basis. In general, the non-infringement contentions depend on the correct legal interpretation of the terms "first position" and "second position" recited in claim 29. The Defendant contends the correct legal interpretation of the term "first position" is when the lever 22 is in the unlocked position as shown in FIG. 1 of the '172 patent, and the correct legal interpretation of the term "second position" is when the lever 22 is in the locked position as shown in FIG. 4 of the '172 patent.

Support for Defendant's interpretation of the terms "first position" and "second position" comes from the Plaintiff's amendment to claim 29 in order to overcome the Examiner's rejection based on the prior art. On page 10 of a Response to Office action filed on March 25, 2004, the Plaintiff asserted that claim 29 "has been amended to include the limitation of 'a handle portion of said lever where said handle portion extends beyond said first corner when in said *first position* and extends beyond and around said second corner when in said *second position*.' Support for this amendment may be found on page 8 of the specification." The following is the paragraph from page 8 of the specification that the Plaintiff is relying:

"Referring to FIGS. 8A-8E, the cam lever 22 comprises a shape that assists the convenient operation of the clamp 10. Existing clamps employ levers that are exclusively positioned to one of the lateral sides of the clamp. Camera bodies are typically positioned directly over these existing levers, which often makes them

difficult to reach when engaging or releasing the clamp. The cam lever 22, however, includes a handle portion 56 that extends from the yoke 58. The handle portion 56 is elongated and has a sufficient length to extend beyond, and curve around, a lateral corner 61 of the clamp 10 *when the cam lever is in the second, or locked position as seen in FIG. 4*. The cam lever also extends beyond the opposed later corner 62 *when the cam lever is in the first position as seen in FIG. 1*. The cam lever 22 is therefore easily accessible even though a camera body is secured to the clamp.”

Accordingly, the specification of the ‘172 patent provides a specific definition of the claimed first position (unlocked position) and the claimed second position (locked position). Further, prosecution history disavowal prevents the Plaintiff from broadening the meaning of the terms “first position” and “second position.” Claim 29 was allowed by the examiner only after the Plaintiff amended the claim to clarify that the handle of the lever extends beyond and around said second corner when in said *second position* (locked position) as shown in FIG. 4. The Plaintiff pointed to page 8 of the specification for the benefit of this amendment that supported the allowability contention: “The cam lever 22 is therefore easily accessible even though a camera body is secured to the clamp.” Having relied on this benefit to assert patentability, the Plaintiff cannot later assert a broader interpretation of the claim through prosecution history disavowal. Accordingly, the only reasonable interpretation of the term “first position” is the unlocked position as shown in FIG. 1, and the only reasonable interpretation of the term “second position” is the locked position as shown in FIG. 4 of the ‘172 patent. As shown in the claim chart of Exhibit 1, the Defendant’s Instrumentality FPH-ULP operates exactly opposite the invention recited in claim 29 of the ‘172 patent. That is, the Defendant’s handle portion extends beyond, and curves around,

a lateral corner the clamp *when the cam lever is in **the first, or unlocked position**, and the cam lever also extends beyond the opposed later corner *when the cam lever is in **the second, or locked position***. Accordingly, the Defendant's Instrumentality FPH-ULP does not infringe claim 29 of the '172 patent.*

'172 Patent: FBT-ASPL

The Defendant's previously disclosed non-infringement contentions regarding whether Defendant's Instrumentality FBT-ASPL infringes claim 29 of the '172 patent are further clarified here by again pointing out, as described above, that Plaintiff amended claim 29 in order to overcome the Examiner's rejection based on the prior art. For the same reasoning set forth above, the only reasonable interpretation of the term "first corner" is the exterior corner of the lever latching surface as shown in FIG. 1 of the '172 patent, and the only reasonable interpretation of the term "second corner" is the opposing exterior corner of the lever latching surface as shown in FIG. 4 of the '172 patent. The Plaintiff's contention of infringement based on the interior corners of one of the clamping surfaces is completely inconsistent with the Plaintiff's construction of claim 29 in order to overcome the rejection based on the prior art. Prosecution history disavowal precludes the Plaintiff from its overly broad, and completely unreasonable interpretation of the claim that it now asserts in its contention of infringement.

'337 Patent: FBT-ASPL

The Defendant's previously disclosed non-infringement contentions for Defendant's Instrumentality FBT-ASPL and the '337 patent are supplemented in these amended non-infringement contentions based on a means-plus-function interpretation of at least one element of

the claims, as well as based on the reverse doctrine of equivalence.

Means-Plus-Function

The following element is recited in both independent claims 1 and 25 of the '337 patent:

“said first clamp member and said second clamp member not releasable from said base by movement of said second member...”

Since this element is purely functional without the claims reciting any structure for performing the function, this element should be interpreted as a means-plus-function element under 35 U.S.C. § 112(f). Accordingly, Defendant's Instrumentality FBT-ASPL does not infringe the claims of the '337 patent because the Defendant's structure for performing the above function cannot be considered an equivalent structure (under 35 U.S.C. § 112(f)) to that disclosed in the '337 patent (see claim chart in Exhibit 2).

Reverse Doctrine of Equivalence

Regardless as to whether the above function recited in the claims of the '337 patent should be construed as means-plus-function under 35 U.S.C. § 112(f), the Defendant's structure performs the above function in a substantially different way, and therefore under the reverse doctrine of equivalence the Defendant's Instrumentality FBT-ASPL does not infringe the claims of the '337 patent.

Dated: July 28, 2022

Respectfully Submitted,

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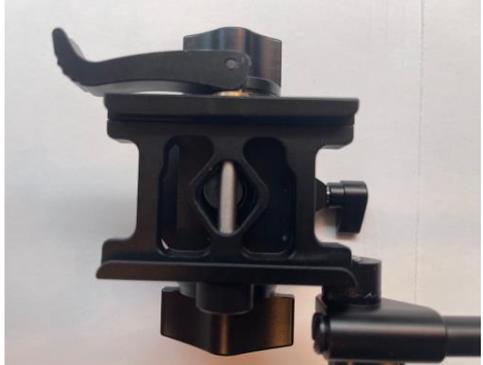
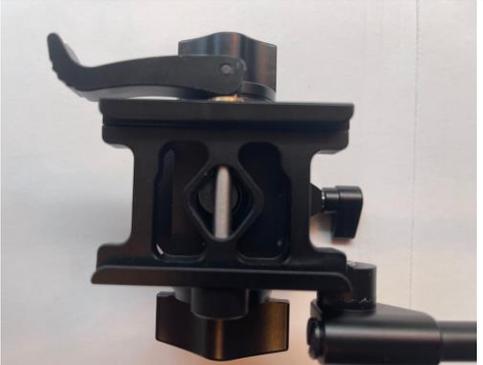
8711 E Pinnacle Peak Rd., Suite 289

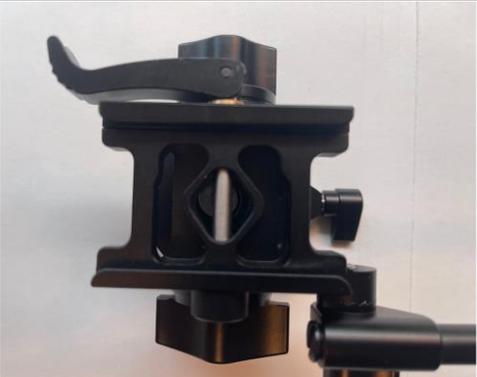
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FOR Products			
The Plaintiff disclosed supplemental infringement contentions asserting Defendant's Instrumentality FPH-ULP infringes claim 29 of US 6,773,172.			
FPH-ULP			
#	Claims	Image	Reasoning
<u>29</u>	An apparatus for engaging photographic equipment to a support, said apparatus comprising:		Met.

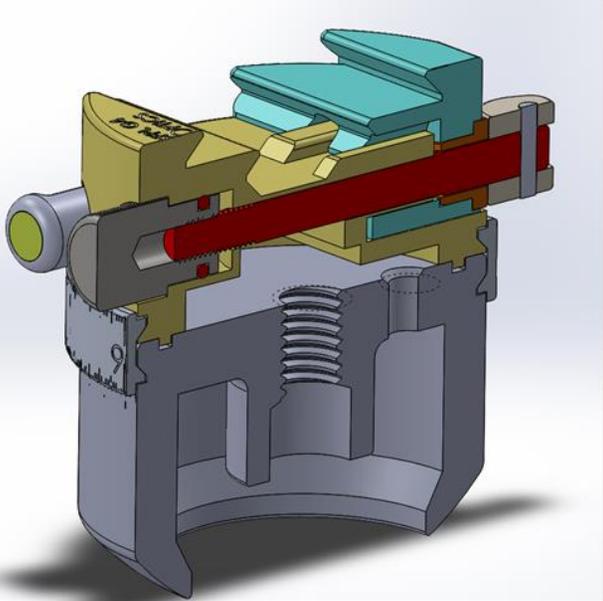
<p>(a) a member defining a channel having a first side wall capable of lateral movement with respect to a second side wall;</p>		<p>Met.</p>
<p>(b) a lever capable of causing said lateral movement and movable between a first position and a second position, said lever engaged on a side of said member, said side defining opposed first and second corners; and</p>		<p>Met.</p>
<p>(c) a handle portion of said lever where said handle portion extends beyond said first corner when in said first position</p>		<p>Met. Note: When the handle portion is in the first position the clamp is in the unlocked state as shown in the figure. The prosecution history of the '172 patent estops the Plaintiff from an interpretation other than that the recited "first position" corresponds to the unlocked state of the clamp.</p>

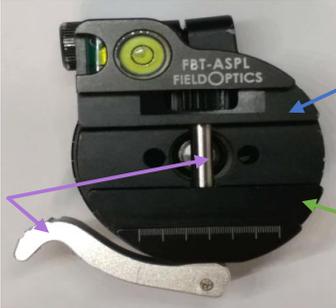
<p>(c) continued: and extends beyond and around said second corner when in said second position.</p>		<p>Not met. When the handle portion is in the second position the clamp is in the locked state as shown in the figure. The prosecution history of the '172 patent estops the Plaintiff from an interpretation other than that the recited "second position" corresponds to the locked state of the clamp. Accordingly, when the clamp is in the locked state as shown in the image, the handle portion does not extend around said second corner.</p>
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FOR Products	
Field Optics Research products shown below are equivalent in most relevant aspects with respect to the 10,585,337 patent, with one exception for the ASFPL family of products. Therefore this chart is made for products inclusively and is illustrated with the FBT-ASPL and FBT-ASFPL only.	
FBT5436C-ASFPL	
FBT-ASPL	  
FBT5646C-ASFPL/S	 

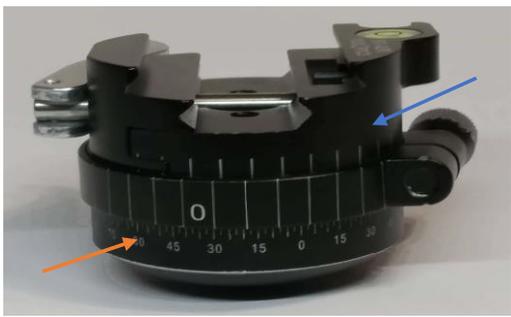
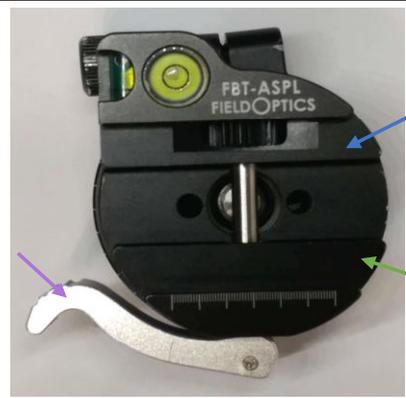
<p>FBT-ASFPL</p>	
<p>FBT5436C-ASFPL/S</p>	

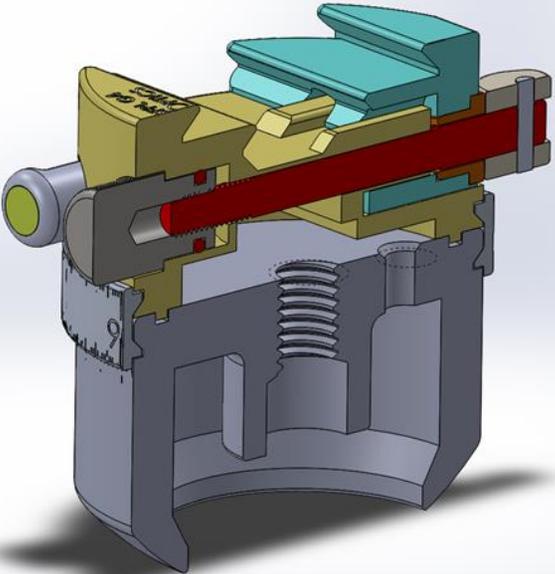
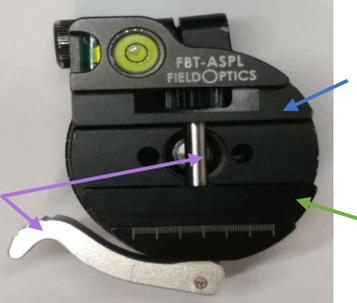
#	Claims	Images	Reasoning
1	An integrated panoramic device comprising:		Met.
	(a) a base having a lower surface suitable for supporting said base;		Met.
	(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;		Met.

<p>(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;</p>		<p>Met.</p>
<p>(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, said first clamp member and said second clamp member not releasable from said base by movement of said second member, said first clamp member rotatable through 360 degrees with respect to said base; and</p>		<p>Not met. First, all of the main structural components (the base, the band, and the clamp) are releasable from each other. Alternatively, the figure shows a cross-section of Defendant's clamp. When the highlighted element is construed as a means-plus-function element, the structure in the figure for performing the function is part of the restraining band that engages a groove of the upper clamping component and a groove in the base. This structure is not equivalent (under 35 U.S.C. § 112 (pre-AIA), sixth paragraph) to the structure disclosed in the '337 patent for performing the function. Alternatively, the Defendant's structure performs the function in a substantially different way, and therefore the Defendant's structure does not infringe under the reverse doctrine of equivalence.</p>

<p>(e) wherein said first member is engaged with said first clamp member, wherein said first member passes through a portion of said second clamp member.</p>		<p>Met.</p>
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#	Claims	Images	Reasoning
<p><u>25</u></p>	<p>An integrated panoramic device comprising:</p>		<p>Met.</p>
	<p>(a) a base having a lower surface suitable for supporting said base;</p>		<p>Met.</p>

<p>(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;</p>		<p>Met.</p>
<p>(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;</p>		<p>Met.</p>

<p>(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, said first clamp member and said second clamp member not releasable from said base by movement of said second member, said first clamp member rotatable through 360 degrees with respect to said base; and</p>		<p>Not met. First, all of the main structural components (the base, the band, and the clamp) are releasable from each other. Alternatively, the figure shows a cross-section of Defendant's clamp. When the highlighted element is construed as a means-plus-function element, the structure in the figure for performing the function is part of the restraining band that engages a groove of the upper clamping component and a groove in the base. This structure is not equivalent (under 35 U.S.C. § 112 (pre-AIA), sixth paragraph) to the structure disclosed in the '337 patent for performing the function. Alternatively, the Defendant's structure performs the function in a substantially different way, and therefore the Defendant's structure does not infringe under the reverse doctrine of equivalence.</p>
<p>(e) wherein said second member is engaged with said base and wherein said second member includes a knob attached thereto.</p>		<p>Met.</p>

CERTIFICATE OF SERVICE

I hereby certify that a copy of these DEFENDANT'S MOTION FOR LEAVE TO AMEND NON-INFRINGEMENT CONTENTIONS has been served on the Plaintiff through its attorneys as listed below on July 28, 2022 via email, to:

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