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**IN THE UNITED STATES DISTRICT COURT
DISTRICT OF UTAH**

<p>Really Right Stuff, LLC</p> <p style="text-align: right;">Plaintiff,</p> <p style="text-align: center;">v.</p> <p>Field Optics Research, Inc.</p> <p style="text-align: right;">Defendant.</p>	<p style="text-align: center;">DEFENDANT’S REPLY TO PLAINTIFF’S RESPONSE TO MOTION FOR PARTIAL SUMMARY JUDGEMENT UNDER LPR 6.2</p> <p>CASE NO: 2:20-cv-00345-DBB</p> <p>Judge: David B. Barlow</p> <p>Magistrate Judge: Dustin B. Pead</p>
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Defendant Field Optics Research, Inc. (“Field Optics Research”) files this reply to Plaintiff’s response (Dkt. 118) to Defendant’s motion for partial summary judgement (Dkt. 115).

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I. INTRODUCTION

The Defendant filed their opening claim construction brief together with a motion for partial summary judgement pursuant to LPR 6.2. The Plaintiff filed a response to the Defendant's motion for partial summary judgement which includes new theories of infringement not previously asserted.

II. BACKGROUND

The Plaintiff asserts claim 29 of the '172 patent and claims 1, 7, 11, 18, 25, 26, 30, 35 and 42 of the '337 patent against various products produced currently or in the past by the Defendant. Of the asserted claims, only claim 29 of the '172 patent and claims 1 and 25 of the '337 patent are independent. As will be shown below, Defendant does not infringe any of these claims, and therefore does not infringe any of the claims dependent upon them.

The text of claim 29 in the '172 patent (emphasis added):

29. An apparatus for engaging photographic equipment to a support, said apparatus comprising:

(a) a member defining a channel having a first side wall capable of lateral movement with respect to a second side wall;

(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

(c) 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.

The text of claim 1 of the '337 patent (emphasis added):

1. An integrated panoramic device comprising:

(a) a base having a lower surface suitable for supporting said base;

(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;

(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;

(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

(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.

The text of claim 25 of the '337 patent (emphasis added):

25. An integrated panoramic device comprising:

(a) a base having a lower surface suitable for supporting said base;

(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;

(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;

(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;

(e) wherein said second member is engaged with said base and wherein said second member includes a knob attached thereto.

The italicized terms in the above claims have been submitted for claim construction and are summarized in the tables below:

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Patent no. Claim no.	Term	Plaintiff's Definition	Defendant's definition
10,585,337 – Claim 1(d) and 25(d)	“said first clamp member and said second clamp member not releasable from said base by movement of said second member”	Plain meaning	Construed under 35 USC § 112, sixth paragraph, “Means-plus-function”: <u>Function</u> : retaining the first clamp member and the second clamp member to the base. <u>Structure in Spec</u> : the plug 22 and retaining member 24 shown in FIG. 1 of ‘337 patent. See also col. 2, lines 61-64, of ‘337 patent.
10,585,337 – Claim 1(d) and 25(d)	“not releasable”	Plain meaning or alternatively “not easily removed and replaced”	Not intended for release

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Patent no. Claim no.	Term	Plaintiff's Definition	Defendant's definition
6,773,172 – Claim 29(b)	“side”	Plain meaning or Alternatively “a lateral surface”	A flat outer surface of an object
6,773,172 – Claim 29(c)	“around”	Plain meaning	Wrap-around
6,773,172 – Claim 29(c)	“handle portion”	Plain meaning	End portion of lever
6,773,172 – Claim 29(c)	“first position”	Plain meaning	Unlocked position of the clamp
6,773,172 – Claim 29(c)	“second position”	Plain meaning	Locked position of the clamp

III. STATEMENT OF UNDISPUTED FACTS

The Initial Accused Products utilize similar structures to each other in relation to the Asserted Patents, even to the point that the Defendant's FBT-ASPL and FBT-ASFPL products were used to illustrate all of Initial Plaintiff's Infringement Contentions.

Plaintiff submitted a second set of infringement contentions relating the Defendant's FPH-ULP product which does not share such commonality.

IV. LEGAL STANDARD

After claim construction, infringement is determined by comparing the claims to the allegedly infringing device to determine whether all of the elements and limitations of the claim are found in the accused device. *Teleflex, Inc. v. Ficosa N. Am. Corp.* 299 F.3d 1313, 1323 (Fed Cir, 2002) Such infringement may be literal or by the use of a substantial equivalent. *Id.* The Court in the Eastern District of Michigan case of *Webasto Thermo & Comfort N. Am., Inc. v. Bestop, Inc.*, Case No. 16-cv-13456, 2-4 (E.D. Mich. Jul. 12, 2019) provides an overview of the legal standard for summary judgement:

Summary judgment is appropriate where the moving party demonstrates that there is no genuine dispute as to any material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). "A fact is 'material' for purposes of a motion for summary judgment where proof of that fact 'would have [the] effect of establishing or refuting one of the essential elements of a cause of action or defense asserted by the parties.'" *Dekarske v. Fed. Exp. Corp.*, 294 F.R.D. 68, 77 (E.D. Mich. 2013) (quoting *Kendall v. Hoover Co.*, 751 F.2d 171, 174 (6th Cir. 1984). A dispute is genuine "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986).

"In deciding a motion for summary judgment, the court must draw all reasonable inferences in favor of the nonmoving party." *Perry v. Jaguar of Troy*, 353 F.3d 510, 513 (6th Cir. 2003)(citing *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986)). At the same time, the non-movant must produce enough evidence to allow a reasonable jury to find in his or her favor by a preponderance of the evidence, *Anderson*, 477 U.S. at 252 and "[t]he 'mere possibility' of a factual dispute does not suffice to create a triable case." *Combs v. Int'l Ins. Co.*, 354 F.3d 568, 576 (6th Cir. 2004)(quoting *Gregg v. Allen-Bradley Co.*, 801 F.2d 859, 863 (6th Cir. 1986)). Instead, "the non-moving party must be able to show sufficient probative evidence [that] would permit a finding in [his] favor on more than mere speculation, conjecture, or fantasy." *Arendale v. City of Memphis*, 519 F.3d 587, 601 (6th Cir. 2008)(quoting *Lewis v. Philip Morris Inc.*, 355 F.3d 515, 533 (6th Cir. 2004) "The test is whether the party bearing the burden of proof has presented a jury question as to each element in the case. The plaintiff must present more than a mere scintilla of the evidence. To support his or her position, he or she must present evidence on which the trier of fact could find for the plaintiff." *Davis v. McCourt*, 226 F.3d 506, 511 (6th Cir. 2000) (internal quotation marks and citations omitted). That evidence must be capable of presentation in a form that would be admissible at trial. See *Alexander v. CareSource*, 576 F.3d 551, 558-59 (6th Cir. 2009).

The non-moving party may not rest upon the mere allegations or denials of his pleadings, but the response, by affidavits or as otherwise provided in Rule 56, must set forth specific facts which demonstrate that there is a genuine issue for trial. Fed. R. Civ. P. 56(e) "When the moving party has carried its burden under Rule 56(c), its opponent must do more than simply show that there is some metaphysical doubt as to the material facts. .

. . . Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no genuine issue for trial." *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586-587 (1986).

Webasto Thermo & Comfort N. Am., Inc. v. Bestop, Inc., Case No. 16-cv-13456, 2-4 (E.D. Mich. Jul. 12, 2019).

V. ARGUMENT

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Referring to the representative figure of the Defendant's accused instrumentalities taken from the Plaintiff's Response to Defendant's Motion for Partial Summary Judgment (Dkt 118-1, Exhibit 3):



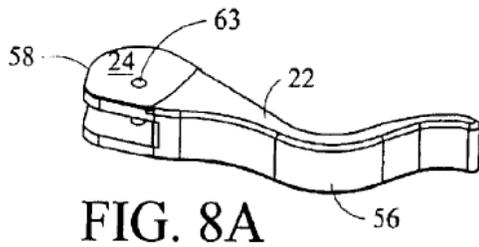
FBT-ASPL: Locked Position

The Plaintiff asserts a new theory of infringement by now asserting the "second corner" recited in claim 1 of the '172 patent reads on the corner identified in the above figure. Since this new theory of infringement is being asserted without the Plaintiff requesting leave to amend their infringement

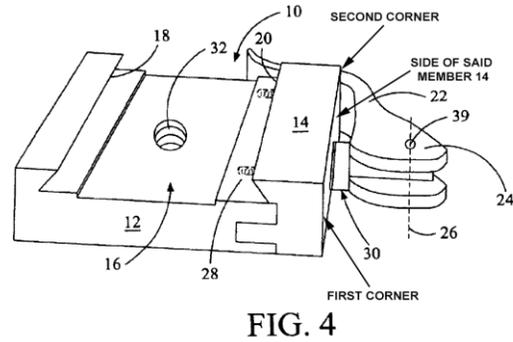
contentions under LPR 3.4, this theory of infringement should be stricken from the record.¹

Even if the Plaintiff is allowed to assert this new theory of infringement without amending their infringement contentions, no reasonable jury would find the recited “handle portion” of the “lever” would extend around this proposed “second corner.” The Plaintiff asserts the “handle portion” of the “lever” may “be the part of the lever extending from the yoke to the tip.” (Dkt. 118, p. 8). However, construing the claim in this manner would render the recited “handle portion of the lever” meaningless since according to the Plaintiff the “handle portion” may be the entire lever. Clearly by calling out a “handle portion of the lever” the patentee intended the handle portion to be something less than the entire lever. The Defendant’s construction of “handle portion” as the “end portion of the lever” is consistent with the ‘172 patent specification as asserted in Defendant’s claim construction brief, as well as consistent with the examiner’s interpretation of the term in allowing the claim over the prior art. (Office Action mailed on 08/20/2003; Joint Appendix p. 51). Referring again to FIG. 8A and 4 of the ‘172 patent specification, the “handle portion 56” of the lever is the end portion of the lever which extends around (wraps-around) the second corner (Joint Appendix p. 19; col. 5, line 58 to col. 6, line 20):

¹ “The purpose of these disclosures is 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.” *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1364 (Fed. Cir. 2006) (quoting *Atmel Corp. v. Info. Storage Devices, Inc.*, No. C 95–1987 FMS, 1998 WL 775115, at *2 (N.D. Cal. 1998)).



**FIG. 8A of '172 patent
(Joint Appendix p. 12)**



**FIG. 4 of '172 patent
(Joint Appendix p. 8)**

When the “handle portion of the lever” is appropriately construed as the “end portion of the lever,” clearly the end portion of the lever of the FBT-ASPL does not extend around the “second corner” as asserted in the Plaintiff’s new theory of infringement.

The Plaintiff’s final infringement contentions as well as their new theory of infringement regarding the FBT-ASPL instrumentality are so unreasonable as to be intentionally harassing. No reasonable jury would consider the FBT-ASPL to be even remotely similar to the invention disclosed in the ‘172 patent, and therefore no reasonable jury would conclude the Defendant has misappropriated any patent right the Plaintiff may hold.

Below are figures of the Defendant’s accused instrumentality FPH-ULP taken from the Plaintiff’s amended final infringement contentions (Dkt. 78):



FPH-ULP: Unlocked Position



FPH-ULP: Locked Position

The above figures clearly show that the Defendant's FPH-ULP product operates in a manner opposite that recited in claim 29 of the '172 patent (i.e., opposite as shown in the above FIG. 1 and FIG. 4 of the '172 patent). That is, when the FPH-ULP is in the second, locked position as shown above, the handle portion of the lever does not wrap around the second corner as recited in claim 29(c) of the '172 patent.

In response to this argument, the Plaintiff asserts a new theory of infringement by now asserting that when the FPH-ULP is in the locked position as shown above, the handle portion of the lever actually extends around the corner of the clamp. The Plaintiff relies on the following new figure not included in their infringement contentions:



FPH-ULP: Locked Position

Since this new theory of infringement is being asserted without the Plaintiff requesting leave to amend their infringement contentions under LPR 3.4, this theory of infringement should be

stricken from the record.²

Even if the Plaintiff is allowed to assert this new theory of infringement without amending their infringement contentions, no reasonable jury would find the handle portion of the lever of the FPH-ULP extends around the corner, and certainly would not find that the handle portion wraps-around the corner as shown in the above FIG. 4 of the '172 patent.

The Plaintiff further asserts that even if the end portion of the lever is not found to wrap-around the corner, it is still a question of fact whether the design of the lever on the FPH-ULP infringes the '172 patent under the doctrine of equivalents. The Plaintiff asserts the following argument (Dkt 118, p. 11):

“The intent of the claim limitation requiring the handle portion of the lever to extend beyond and around the corner is to improve access to the lever when a camera or other equipment is mounted. Joint Appendix, at 14 ('172 Patent 6:9-23). The lever on the FPH-ULP achieves the same result by performing substantially the same function in substantially the same way: the handle of the lever extends beyond the corner and curves to improve access while equipment is engaged in the clamp.”

However, this argument fails as a matter of law under the doctrine of prosecution history estoppel which prevents a patentee from using the doctrine of equivalents to recapture subject matter surrendered during prosecution from the literal scope of a claim.³ It is well settled that amendments made in response to prior art rejections can result in prosecution history estoppel.⁴ An applicant cannot amend the claims in response to an examiner's rejection and then use the doctrine of equivalents to try to obtain the very same subject matter that was given up to obtain

² “The purpose of these disclosures is 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.” *O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1364 (Fed. Cir. 2006) (quoting *Atmel Corp. v. Info. Storage Devices, Inc.*, No. C 95–1987 FMS, 1998 WL 775115, at *2 (N.D. Cal. 1998)).

³ See *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 950 at n.6 (Fed. Cir. 1993)

⁴ *Hughes Aircraft Co. v. U.S.*, 717 F.2d 1351, 1362 (Fed. Cir. 1983); *Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42 (1935)

the patent.⁵ In this case, the Plaintiff amended claim 29 to recite that the handle portion of the lever extends beyond *and around* the second corner in order to overcome a rejection based on the prior art. Even the Plaintiff admitted in their responsive construction brief (Dkt. 117, p. 10-11) that the “applicant disclaimed all levers where the handle portion extends beyond – but not around – the second corner.” Accordingly, the Plaintiff cannot now use the doctrine of equivalence to assert infringement based on the handle portion of the FPH-ULP lever curving away from (and not around) the second corner.

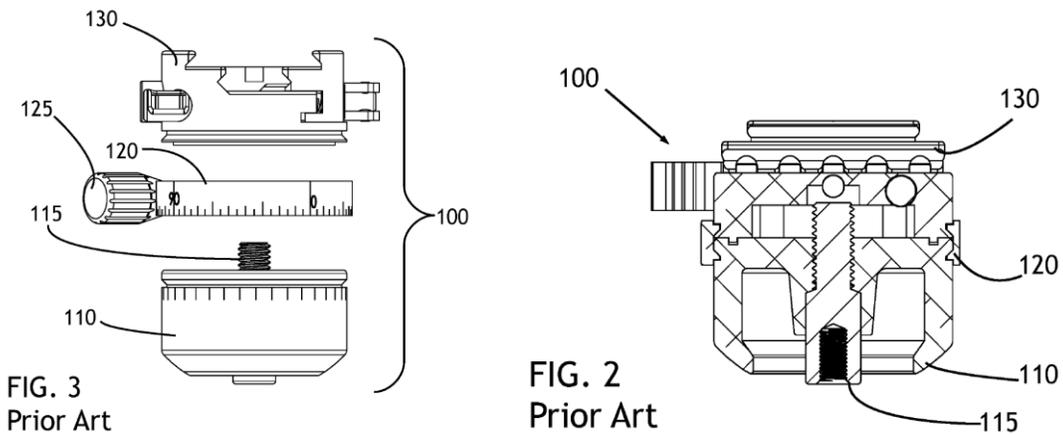
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In the above claims 1(d) and 25(d) of the ‘337 patent, assuming the phrase “said first clamp member and said second clamp member not releasable from said base by movement of said second member” is construed under 35 USC § 112, sixth paragraph, the Defendant’s accused instrumentalities do not include the corresponding structure (or equivalents thereof under 35 USC § 112, sixth paragraph). The corresponding structure for performing the function disclosed in the ‘337 patent specification is shown in FIG. 1 (JA, p. 107) as the plug 22 and the retaining member 24 which are described at col. 2, lines 61-64 (JA, p. 119): “A retaining member 24 is secured to the plug 22 in such a manner to maintain the panning base and the body 12 together with the desired ability to freely rotate.” (See FIG. 1 of the ‘337 patent; JA p. 107). Defendant’s FBT-ASPL and the like do not include the plug 22 or retaining member 24 (or equivalent thereof) and therefore do not infringe the claims. The Plaintiff does not contest this assertion in their response

⁵ See *Hilgraeve Corp. v. McAfee Assoc., Inc.*, 224 F.3d 1349 (Fed. Cir. 2000); *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 819 (Fed. Cir. 1999); *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313 (Fed. Cir. 1999); *Chemical Eng’g Corp. v. Essef Indus., Inc.*, 795 F.2d 1565 (Fed. Cir. 1986)

to the Defendant’s partial motion for summary judgement (Dkt. 118, p. 13), and therefore concedes that construing the term “not releasable” under 35 USC § 112, sixth paragraph, means the Defendant’s FBT-ASPL and the like do not infringe the claims.

In the above claims 1(d) and 25(d) of the ‘337 patent, assuming the phrase “not releasable” is construed as “not intended for release” the Defendant’s accused instrumentalities do not infringe this element. With the Defendant’s accused instrumentalities, the “second element” recited in the claims corresponds to a restraining band used to enable/disable rotation of the clamp body relative to the base, and when the restraining band is sufficiently loosened, it allows the release of the clamp body from the base. The following figures are taken from U.S. Patent Application Publication No. US 2022/0268399 (Exhibit 1) which illustrate the Defendant’s accused instrumentalities FBT-ASPL and the like:



Referring to paragraph [0022] of the ‘399 patent publication:

“With reference to FIGS. 1-3, a prior art ball head 100 features a base 110 supporting a clamp 130. Base 110 interfaces with a tripod or some other support bolt 115. A band 120 circumscribes the top edge of the base 110 and the bottom edge of the clamp 130. Both components feature a V-shaped groove circumscribing the bottom edge of clamp 130 and the top edge of base 110. Band 120 has two annular inner edges,

one at its top and one at its bottom, which then interface with the V-shaped grooves. A tightening-means, such as bolt 125, is used to tighten or loosen band 120 and allow or arrest rotation of the clamp 130. *If sufficiently loosened, the band 120 will allow the removal of clamp 130 from the system.* Otherwise, the interface of the annular inner edges and the V-shaped grooves will secure the clamp 130 to the base 110.”

Accordingly, the Defendant’s accused instrumentalities FBT-ASPL and the like do not infringe the claims since by sufficiently loosening the restraining band 120 (the “second element” recited in the claims) the *intent is to release the clamp body 130 from the base 110.*

The Plaintiff asserts that loosening the restraining band of the FBT-ASPL (even when fully loosened) does not itself release the clamp members from the base (Dkt. 118, p. 14). Even assuming *arguendo* this is true, with the FBT-ASPL loosening the restraining band is the *only* way to remove the clamp members from the base. That is, with the FBT-ASPL there is an intent to remove the clamp members from the base by sufficiently loosening the restraining band, whereas with the ‘337 patent, there is no intent to release the clamp members from the base by movement of the second member. Accordingly, when “not releasable” is construed as “not intended for release,” no reasonable jury would find that the FBT-ASPL and the like infringe the claims.

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VI. CONCLUSION

As detailed above, Defendant unequivocally does not infringe any of the asserted claims in either the '172 or '337 patents. The elements needed for infringement are not present in any of Defendant's Accused products and no reasonable jury could find their existence. For these reasons, Defendant requests the Court grant Defendant's Motion for Partial Summary Judgement.

Dated this 13th day of December, 2022

Respectfully Submitted,

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