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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

ADVANCED STEEL RECOVERY, LLC,
Plaintiff,
v.
X-BODY EQUIPMENT, INC. and
JEWELL ATTACHMENTS, LLC,
Defendants.

No. 2:12-cv-1004-GEB-DAD

**ORDER GRANTING DEFENDANTS'
MOTION FOR SUMMARY JUDGMENT**

AND RELATED COUNTERCLAIMS

Defendants move under Federal Rule of Civil Procedure ("Rule") 56 for summary judgment, or in the alternative, partial summary judgment, on each of Plaintiff's infringement claims concerning U.S. Patent No. 8,061,950 ("the '950 patent"). Defendants also move for summary judgment on their counterclaim in which they seek a declaration of non-infringement of U.S. Patent No. 7,744,330 ("the '330 patent"). Plaintiff opposes the motions.

I. LEGAL STANDARD

A party seeking summary judgment under Rule 56 bears the initial burden of demonstrating the absence of a genuine

1 issue of material fact for trial. Celotex Corp. v. Catrett, 477
2 U.S. 317, 323 (1986). "A fact is 'material' when, under the
3 governing substantive law, it could affect the outcome of the
4 case." Thrifty Oil Co. v. Bank of Am. Nat'l Trust & Sav. Ass'n,
5 322 F.3d 1039, 1046 (9th Cir. 2003) (quoting Anderson v. Liberty
6 Lobby, Inc., 477 U.S. 242, 248 (1986)). An issue of material fact
7 is "genuine" when "'the evidence is such that a reasonable jury
8 could return a verdict for the nonmoving party.'" Id. (quoting
9 Anderson, 477 U.S. at 248).

10 If the movant satisfies its "initial burden," "the
11 nonmoving party must set forth, by affidavit or as otherwise
12 provided in Rule 56, 'specific facts showing that there is a
13 genuine issue for trial.'" T.W. Elec. Serv., Inc. v. Pac. Elec.
14 Contractors Ass'n, 809 F.2d 626, 630 (9th Cir. 1987) (quoting
15 former Fed. R. Civ. P. 56(e)). "A party asserting that a fact
16 cannot be or is genuinely disputed must support the assertion by
17 citing to particular parts of material in the record . . . or
18 showing that the materials cited do not establish the absence or
19 presence of a genuine dispute, or that an adverse party cannot
20 produce admissible evidence to support the fact." Fed. R. Civ. P.
21 56(c)(1). Summary judgment "evidence must be viewed in the light
22 most favorable to the nonmoving party, and all reasonable
23 inferences must be drawn in favor of that party." Sec. & Exch.
24 Comm'n v. Todd, 642 F.3d 1207, 1215 (9th Cir. 2011) (citing
25 Johnson v. Paradise Valley Unified Sch. Dist., 251 F.3d 1222,
26 1227 (9th Cir. 2001)).

27 Further, Local Rule 260(b) prescribes:

28 Any party opposing a motion for summary

1 judgment or summary adjudication [must]
2 reproduce the itemized facts in the [moving
3 party's] Statement of Undisputed Facts and
4 admit those facts that are undisputed and
5 deny those that are disputed, including with
6 each denial a citation to the particular
7 portions of any pleading, affidavit,
8 deposition, interrogatory answer, admission,
9 or other document relied upon in support of
10 that denial.

11 If the nonmovant does not "specifically . . .
12 [controvert duly supported] facts identified in the [movant's]
13 statement of undisputed facts," the nonmovant "is deemed to have
14 admitted the validity of the facts contained in the [movant's]
15 statement." Beard v. Banks, 548 U.S. 521, 527 (2006).

16 Because a district court has no independent
17 duty "to scour the record in search of a
18 genuine issue of triable fact," and may "rely
19 on the nonmoving party to identify with
20 reasonable particularity the evidence that
21 precludes summary judgment," . . . the
22 district court . . . [is] under no obligation
23 to undertake a cumbersome review of the
24 record on the [nonmoving party's] behalf.

25 Simmons v. Navajo Cnty., Ariz., 609 F.3d 1011, 1017 (9th Cir.
26 2010) (quoting Keenan v. Allan, 91 F.3d 1275, 1279 (9th Cir.
27 1996)); see also Fed. R. Civ. P. 56(c)(3) ("The court need
28 consider only the cited materials, but it may consider other
materials in the record.").

II. UNCONTROVERTED FACTS

29 The following facts are uncontroverted in the summary
30 judgment record. Claim 1 in the '950 patent, upon which all other
31 claims except claim 9 in the '950 patent depend, discloses a

32 container packer system, which comprises[,
33 inter alia]:

34 a transfer base including proximate and
35 distal ends and a container packer guide;

1 a container packer including a proximate end,
2 a distal end with an opening, opposite
sidewalls, a floor and an interior;

3 said container packer being movable
4 longitudinally along said container packer
5 guide between a retracted position on said
6 transfer base and an extended position
extending at least partially from said
transfer base distal end;

7 a container packer drive connected to said
8 transfer base and said container packer and
9 adapted for moving said container packer
between its extended and retracted positions;
[and]

10

11 said container packer drive comprising a
12 container packer piston-and-cylinder unit
13 connected to said transfer base proximate end
and said container packer proximate
end

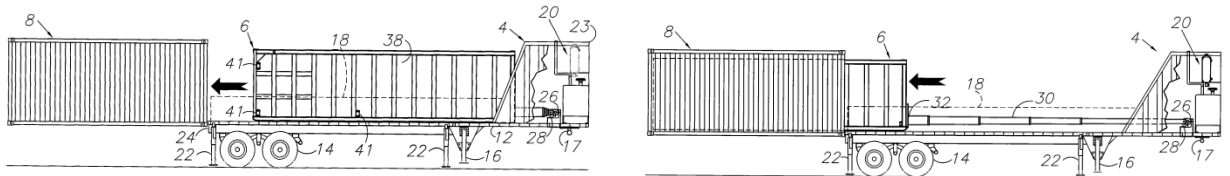
14 (Compl. Ex. A, '950 Patent col. 4:62-5:8, 5:24-26, , ECF No. 1-
15 1.) Claim 9 in the '950 patent also discloses: "said container
16 packer drive compris[es] a container packer piston-and-cylinder
17 unit connected to said transfer base proximate end." ('950 Patent
18 col. 6:34-37.)

19 The '950 patent is a "continuation of . . . [the '330
20 patent." ('950 patent p. 1.). The sole independent claim in the
21 '330 patent also discloses: "said container packer drive
22 compris[es] a container packer piston-and-cylinder unit connected
23 to said transfer base proximate end." (Def. X-Body Equipment,
24 LLC's Answer to Compl. & Countercls. Ex. B, '330 Patent col.
25 5:21-23, ECF No. 7.)

26 "Plaintiff . . . did not accuse the Acculoader of
27 infringement of the '330 patent in this case and did not identify
28 any claim of the '330 patent as infringed in response to an

1 interrogatory asking for a list of all allegedly infringed
 2 claims." (Pl.'s Resp. to Defs.' Stat. of Undisputed Facts ("Pl.'s
 3 Resp.") ¶ 9, ECF No. 65.)

4 The figures below depict "exemplary embodiments" of the
 5 '950 and '330 patent inventions. ('950 Patent col. 2:18; '330
 6 Patent col. 2:9.) Figure 1 "is a side elevational view of a
 7 container packer system . . . in a retracted position on a
 8 transfer base," and Figure 2 "is a side elevational view thereof,
 9 shown with the container packer extended partly into [a]
 10 transport container." ('950 Patent col. 2:20-25; '330 Patent col.
 11 2:11-16.) Reference number 4 designates the transfer base,
 12 reference number 6 designates the container packer, and reference
 13 number 30 designates the container packer piston-and-cylinder
 14 unit, which is shown connected to the transfer base proximate end
 15 at reference number 26 and to the container packer proximate end
 16 at reference number 32. ('950 Patent col. 3:28-33; '330 Patent
 17 col. 3:21-25.)



21 **FIG. 1**

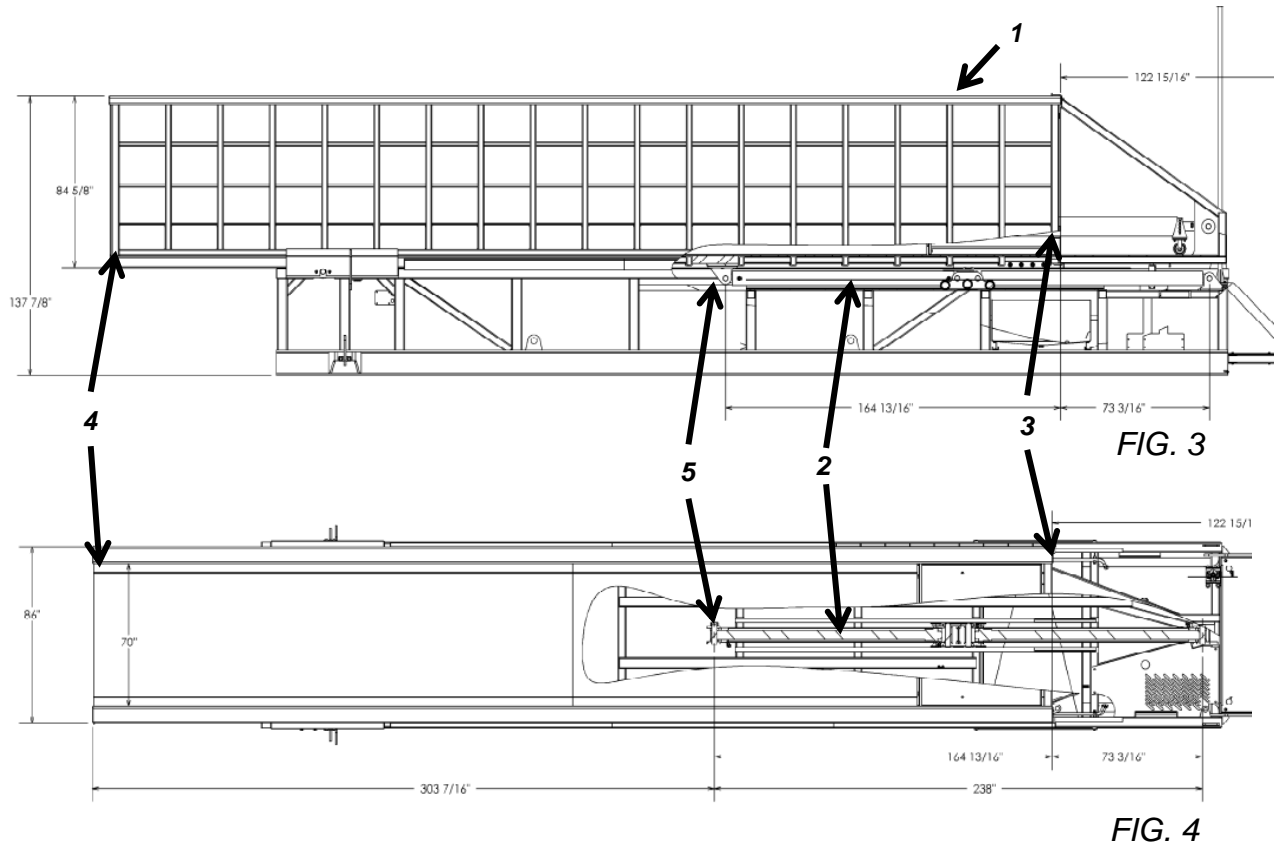
21 **FIG. 2**

22 ('950 Patent p. 2-3; '330 Patent p. 2-3.)

23 The figures below depict Defendants' accused Acculoader
 24 product. Figure 3 is a side view of the product, and Figure 4 is
 25 a view from beneath the product. Reference number 1 designates
 26 the container packer,¹ reference number 2 designates the

27
 28 ¹ Defendants call this part of the Acculoader a "load sled." However, Plaintiff identified this item as a "container packer." (See Decl. of Robert

1 container packer piston-and-cylinder unit, reference number 3
2 designates the proximate-end of the sidewalls of the container
3 packer, and reference number 4 designates the distal end of the
4 sidewalls of the container packer. "The piston-and-cylinder
5 unit[] that move[s] the [container packer] of the Acculoader [is]
6 attached to the bottom of the [container packer]"² as depicted by
7 reference number 5 in the figures below. (Pl.'s Resp. ¶ 5.)



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21 (Decl. of Ronald Dennis in Supp. of Defs.' Mot. ("Dennis Decl.")
22 Ex. 1, Acculoader Design Drawings, ECF No. 56-5.)³

23 Hawkins in Supp. of Defs.' Mot. Ex. 3, Ex. 1, p. 2 (ECF pagination, p. 49),
24 ECF No. 56-3.) For consistency, this part of the Acculoader is referenced as
the "container packer."

25 ² Plaintiff asserts that this statement is disputed but has not
specifically controverted it and therefore "is deemed to have admitted the
26 validity of the facts contained" therein. *Banks*, 548 U.S. at 527.

27 ³ Plaintiff objects to consideration of the following paragraph from Mr.
Dennis's declaration, on the grounds that it lacks foundation, is "not the
28 best evidence," and is hearsay: "Attached as Exhibit 1 hereto is a true and
correct copy of design drawings for the Acculoader. The drawing accurately
depicts the design used by [Defendant] Jewell to manufacture the Acculoader as

1 [container packer] at all," which the two independent claims of
2 the '950 patent (claims 1 and 9) require, but instead is
3 connected "at a point on the bottom of the container packer far
4 from the proximate end." (Defs.' Mot. 7:15-16, 9:26-27, ECF No.
5 56 (emphasis added).) Plaintiff counters:

6 The term "proximate end" . . . should simply
7 mean the back half to the container
8 packer Thus, the claim element that
9 reads, "said container packer drive
10 comprising a piston-and-cylinder unit
11 connected to . . . said container packer
12 proximate end" means the piston-and-cylinder
13 is connected at the back half of the
14 container packer (i.e., the end opposite the
15 transport container).

16

17 The Acculoader therefore literally infringes
18 both claims 1 and 9 [in the '950 patent].

19 (Pl.'s Opp'n 11:7-11, ECF No. 62 (emphasis added).)

20 Claims 1 and 9 in the '950 patent require that the
21 described invention include a "container packer drive comprising
22 a container packer piston-and-cylinder unit connected to said
23 transfer base proximate end and said container packer proximate
24 end." ('950 Patent, col. 5:24-26, 6:33-37 (emphasis added).)

25 "We give claim terms their plain and ordinary meaning
26 unless the patentee acted as its own lexicographer or there was a
27 disavowal of claim scope." Braintree Labs., Inc. v. Novel Labs.,
28 Inc., 749 F.3d 1349, 1365 (Fed. Cir. 2014). Here, Plaintiff has
not shown that the patent itself contemplates a particular
definition of the term "proximate end." Further, Plaintiff
"waived any argument with respect to [the] term ['proximate end']
by failing to raise it during the claim construction phrase."
Cent. Admixture Pharm. Servs., Inc. v. Advanced Cardiac

1 Solutions, P.C., 482 F.3d 1347, 1356 (Fed. Cir. 2007). Therefore,
2 the plain and ordinary meaning of the term "proximate end"
3 applies.

4 "[I]t is entirely appropriate for the district court to
5 look to dictionaries . . . for context—to aid in arriving at
6 the plain meaning of a claim term." Helmsderfer v. Bobrick
7 Washroom Equip., Inc., 527 F.3d 1379, 1382 (Fed. Cir. 2008).
8 Webster's Third New International Dictionary defines the term
9 "end" as "the extreme or last part lengthwise" and provides,
10 inter alia, these examples: the "[end] of a rope" and "the rear
11 [end] of an automobile." Webster's Third New International
12 Dictionary 747, definition 1(c)(2) (1986). Therefore, the plain
13 and ordinary meaning of "proximate end" does not include
14 Plaintiff's proffered definition of "back half." (Pl.'s Opp'n
15 11:11.)

16 The container packer piston-and-cylinder unit is
17 connected to the Acculoader container packer 164.81 inches from
18 the proximate end of the sidewalls of the container packer or
19 35.2% down the length of the sidewalls. (Acculoader Design
20 Drawings.) This connection point is not at the proximate end.
21 Therefore, Plaintiff has shown that the Acculoader does not
22 literally infringe the '950 patent.

23 **2. Infringement of '950 Patent by Doctrine of**
24 **Equivalents**

25 Plaintiff argues:

26 [I]f the element "said container packer drive
27 comprising a piston-and-cylinder unit
28 connected to . . . said container packer
proximate end" is not literally present in
the Acculoader, . . . the Acculoader has an

1 equivalent. Any difference between *where* the
2 packer [piston-and-]cylinder of the accused
3 Acculoader connects to Defendants' container
4 packer . . . and where the packer [piston-
and-]cylinder of claims 1 and 9 connects to
the container packer . . . is insubstantial.

5 (Pl.'s Opp'n 13:1-6.) Defendants counter that the Acculoader
6 cannot infringe the '950 patent under the doctrine of equivalents
7 since "allowing the doctrine of equivalents to encompass
8 attachment at some other location entirely would improperly
9 vitiate the point of attachment requirement." (Defs.' Reply 7:19-
10 21, ECF No. 67.)

11 "Under [the] doctrine [of equivalents], a product or
12 process that does not literally infringe upon the express terms
13 of a patent claim may nonetheless be found to infringe if there
14 is 'equivalence' between the elements of the accused product or
15 process and the claimed elements of the patented invention."
16 Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21
17 (1997). "[E]quivalence [must] be assessed on an limitation-by-
18 limitation basis, as opposed to from the perspective of the
19 invention as a whole." Freedman Seating Co. v. Am. Seating Co.,
20 420 F.3d 1350, 1358 (Fed. Cir. 2005). Further, "[t]he doctrine of
21 equivalents cannot be used to erase 'meaningful structural and
22 functional limitations of the claim on which the public is
23 entitled to rely in avoiding infringement.'" Conopco, Inc. v. May
24 Dep't Stores Co., 46 F.3d 1556, 1562 (Fed. Cir. 1994) (quoting
25 Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935 (Fed.
26 Cir. 1987) (en banc)).

27 The claim element at issue is the following: a
28 "container packer drive comprising a container packer piston-and-

1 cylinder unit connected to said transfer base proximate end and
2 said container packer proximate end." ('950 Patent, col. 5:24-26,
3 6:33-37 (emphasis added).) The limitation described therein is a
4 connection between two particular places, one of which is the
5 "container packer proximate end." Id. The limitation is, in
6 essence, locational.

7 The Acculoader is connected at a different location: a
8 point closer to the middle of the container packer sidewalls than
9 the proximate end of those sidewalls. No reasonable jury could
10 find this connection point to be equivalent to the "container
11 packer proximate end." Id.; see Sage Prods., Inc. v. Devon
12 Indus., Inc., 126 F.3d 1420, 1422-26 (Fed. Cir. 1997) (holding
13 that a slot in a medical waste disposal container near the top
14 but within the container body could not be equivalent to a "slot
15 at the top of the container body" as disclosed in the patent);
16 see also Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149
17 F.3d 1309, 1318-19 (Fed. Cir. 1998) (holding that "no reasonable
18 jury could [] f[i]nd" infringement by the doctrine of equivalents
19 where claim limitations "tie[] [patented product structures] to
20 [] specific place[s]," and the accused product's analogous
21 structures were "not even close" to those places). Therefore,
22 Defendants are entitled to prevail on their non-infringement
23 summary judgment motion on all claims in the '950 patent.

24 **3. Plaintiff's 56(d) Request**

25 However, Plaintiff requests that "if the present record
26 does not support denial of [Plaintiff's motion for] summary
27 judgment," on all claims in the '950 patent, "the Court [should]
28 postpone a decision on this motion [under Rule 56(d)] until . . .

1 further discovery is taken." (Pl.'s Opp'n 4:4-6.) Specifically,
2 Plaintiff's counsel avers:

3 [E]xpert discovery has yet to take place.
4 . . . [Plaintiff] expects its expert(s) to
5 explain how any limitations that may not be
6 met literally are met under the doctrine of
7 equivalents.

8

9 [Plaintiff] has not been given an opportunity
10 during this litigation, particularly with an
11 expert present, to conduct a detailed
12 inspection of the Acculoader.
13 . . . Permitting [Plaintiff] a pre-ruling
14 inspection of the Acculoader, with a
15 technical expert, would allow [Plaintiff] to
16 assess the veracity of Defendants' alleged
17 undisputed facts [concerning the design of
18 the Acculoader], the untested averments in
19 Defendants' declarations, as well as the
20 substantiality, or lack thereof, of any
21 difference in design between the Acculoader
22 and the claims of the '950 [p]atent.

23 (Rule 56(d) Decl. of Mark D. Nielsen ¶¶ 8, 24, ECF No. 62-5.)

24 Defendants counter that the 56(d) request should be
25 denied since Plaintiffs' "Rule 56(d) declaration never states
26 that [Plaintiff] has any basis for disputing the main position of
27 the piston-and-cylinder." (Defs.' Reply 19:3-4.)

28 Rule 56(d) prescribes: "If a nonmovant shows by
affidavit or declaration that, for specified reasons, it cannot
present facts essential to justify its opposition, the court may
. . . defer considering the motion or deny it."

"To prevail under . . . Rule [56(d)], [a] part[y]
opposing a motion for summary judgment must make '(a) a timely
application which (b) specifically identifies (c) relevant
information, (d) where there is some basis for believing that the
information sought actually exists.'" Emp'rs Teamsters Local Nos.

1 175 & 505 Pension Trust Fund v. Clorox Co., 353 F.3d 1125, 1129
2 (9th Cir. 2004) (quoting VISA Int'l Serv. Ass'n v. Bankcard
3 Holder of Am., 784 F.2d 1472, 1475 (9th Cir. 1986)). "The burden
4 is on the party seeking additional discovery to proffer
5 sufficient facts to show that the evidence sought exists, and
6 that it would prevent summary judgment." Id. at 1129-30 (quoting
7 Chance v. Pac-Tel Teletrac, Inc., 242 F.3d 1151, 1161 n.6 (9th
8 Cir. 2001)).

9 Here, Defendant has not proffered sufficient facts
10 showing that expert discovery would demonstrate the Acculoader's
11 container packer piston-and-cylinder unit is connected to the
12 container packer at a location that is equivalent to the
13 proximate end of the container packer. Therefore, Defendant has
14 not shown that expert discovery "would . . . prevent summary
15 judgment." Clorox, 353 F.3d at 1129-30. Further, Plaintiff has
16 not shown "there is some basis for believing" that an inspection
17 of the Acculoader would reveal a difference in the design of the
18 Acculoader from the design described in Defendants' evidence. Id.
19 at 1129. Therefore, Plaintiff's request for a postponement under
20 Rule 56(d) is denied.

21 **B. '330 Patent**

22 Defendants argue they are entitled to summary judgment
23 on their declaratory judgment claim of non-infringement of the
24 '330 patent since "[t]he '330 patent has only one independent
25 claim," which, like the '950 patent, "requires 'said container
26 packer drive comprising a container packer piston-and-cylinder
27 unit [be] connected to said transfer base proximate end and said
28 container packer proximate end.'" (Defs.' Mot. 15:22-24 (quoting

1 '330 Patent col. 5:21-23.) Plaintiff counters: "Defendants'
2 declaratory relief claims directed to the '330 [p]atent should be
3 dismissed for lack of subject matter jurisdiction. . . . Here, as
4 Defendants admit in their Statement of Undisputed Facts,
5 [Plaintiff] did not accuse, and has not accused, the Acculoader
6 of infringing the '330 [p]atent." (Pl.'s Opp'n 15:20-21, 16:2-3.)

7 "The threshold question for declaratory judgment
8 jurisdiction is 'whether the facts alleged, under all the
9 circumstances, show that there is a substantial controversy,
10 between parties having adverse legal interests, of sufficient
11 immediacy and reality to warrant the issuance of a declaratory
12 judgment.'" Microsoft Corp. v. Datatarn, Inc., Nos. 2013-1184 &
13 2013-1185, 2014 WL 1760882, at *2 (Fed. Cir. May 5, 2014)
14 (quoting MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 127,
15 127 S.Ct. 764, 166 L.Ed.2d 604 (2007)). "[R]elated litigation
16 involving the same technology and the same parties is relevant in
17 determining whether a justiciable declaratory judgment
18 controversy exists on other related patents." Teva Pharms. USA,
19 Inc. v. Novartis Pharms. Corp., 482 F.3d 1330, 1344 (9th Cir.
20 2007).

21 Here, the '950 patent is part of the same patent family
22 as the '330 patent since it is continuation of the '330 patent
23 application. Further, the '950 and '330 patents contains several
24 identical claim elements, including the limitation that "said
25 container packer drive compris[es] a container packer piston-and-
26 cylinder unit connected to said transfer base proximate end and
27 said container packer proximate end." ('950 patent col. 5:24-26;
28 '330 patent col. 5:21-23.) Therefore, subject-matter jurisdiction

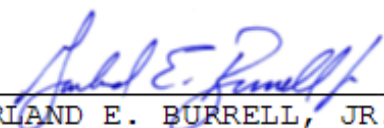
1 exists over Defendants' counterclaim. See Seaboard. Int'l, Inc.
2 v. Cameron Int'l Corp., No. 1:13-cv-281-MLH-SKO, 2013 WL 3936889,
3 at *9 (E.D. Cal. July 30, 2013) (holding that subject-matter
4 jurisdiction existed over a declaratory judgment counterclaim
5 where the asserted patents and counterclaim patents, which
6 plaintiff had "never asserted or demanded royalties for,"
7 "contain[ed] claims that [were] nearly identical," and the
8 patents were "part of the same patent family as they [were] all
9 derived from applications related to [a] parent application").

10 Since the '330 patent's sole independent claim contains
11 the same limitation as the '950 patent concerning connection
12 between the container packer piston-and-cylinder unit and the
13 container packer proximate end, Defendants are entitled to
14 summary judgment on their declaratory judgment claim of non-
15 infringement of the '330 patent for the same reasons discussed
16 above in sections III.A.1 & III.A.2 of this order.

17 **IV. CONCLUSION**

18 For the stated reasons, Defendants' motion for summary
19 judgment is granted.

20 Dated: August 8, 2014

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23 _____
24 GARIAND E. BURRELL, JR.
25 Senior United States District Judge
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