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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

Integrated Technology Corporation, et al.,) No. CV-06-02182-PHX-ROS
Plaintiffs,	
vs.	
Rudolph Technologies, Inc., et al.,	
Defendants.	

ORDER

Defendant Rudolph Technologies has moved for clarification or reconsideration of a portion of the Court’s ruling on the summary judgment motions. The parties have also filed a number of motions in limine. This Order addresses all pending motions.

I. Neither Clarification Nor Reconsideration Is Merited

Integrated Technology moved for summary judgment on a variety of grounds. One ground was that “Rudolph’s asserted Tokyo Cathode Lab machine and associated Japanese patent publication are not prior art for purposes of 35 U.S.C. §§102 and 103.” (Doc. 238 at 2, 24). In opposing that motion, Rudolph chose to focus on the date the machine was offered for sale. (Doc. 251 at 17). In resolving the issue, the Court found the “only evidence offered by Rudolph to establish that the [Tokyo Cathode Lab machine] was shown or offered for sale in 1991 is the testimony of Michael McNair, the Director of Sales at Rucker & Kolls, a probe card manufacturer.” That evidence was insufficient as a matter of law to establish the Tokyo

1 Cathode Lab machine was offered for sale in 1991. Thus, Integrated Technology’s motion
2 for summary judgment on this ground was granted.

3 Rudolph now seeks either clarification or reconsideration of this ruling. Rudolph
4 seeks clarification that it is not precluded from “presenting the various publications and
5 patent applications” based on the Tokyo Cathode Lab machine “as prior art under any of
6 [the] numerous other sections of the Patent Code.” (Doc. 291 at 2). Alternatively, Rudolph
7 seeks reconsideration of the ruling because of “material new documents that were not
8 available to Rudolph until after briefing on the summary judgment motions had been
9 completed.” (Doc. 291 at 2).

10 **A. Rudolph’s Proposed Clarification Is Directly Contrary to the Court’s**
11 **Ruling**

12 The Court granted Integrated’s motion for summary judgment that “Rudolph’s
13 asserted Tokyo Cathode Lab machine and associated Japanese patent publication are not
14 prior art for purposes of 35 U.S.C. §§102 and 103.” Rudolph requests “clarification” that the
15 Court’s ruling does not prohibit the use of the Japanese evidence as prior art. In other words,
16 Rudolph seeks a “clarification” directly contrary to the Court’s ruling. Rather than a
17 clarification, Rudolph is actually seeking reconsideration. Thus, the request for clarification
18 will be denied.

19 **B. Rudolph Has Not Established Reconsideration Is Appropriate**

20 Rudolph seeks reconsideration based on evidence it allegedly obtained only after the
21 summary judgment briefing was complete. Rudolph believes this evidence supports its
22 argument that the Tokyo Cathode Lab machine was offered for sale prior to 1991. The new
23 evidence, however, was available long before the Court ruled on the summary judgment
24 motions. In fact, some of the “new” evidence was in Rudolph’s possession for *years* prior
25 to the summary judgment briefing. While Rudolph did obtain some of this evidence after the
26 briefing was complete, Rudolph did not seek to supplement its filings. This decision is
27 inexplicable given Rudolph’s current belief the new evidence is “conclusive evidence” that
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1 the Tokyo Cathode Lab machine was on sale in 1991.¹ The Court will not allow Rudolph
2 to rely on evidence it should have brought to the Court’s attention long ago.² *See Javetz v.*
3 *Board of Control, Grand Valley State Univ.*, 903 F. Supp. 1181, 1192 (W.D. Mich. 1995)
4 (finding party should have supplemented summary judgment filings with evidence allegedly
5 located after initial briefing but before court ruling). The request for reconsideration will be
6 denied.

7 **II. Motions in Limine**

8 **A. Motion to Exclude Damages Due to Lack of Proof of Marking (Doc.** 9 **296)**

10 Rudolph seeks to exclude any evidence of damages Integrated suffered prior to the
11 filing of the complaint because Integrated allegedly did not properly mark its products with
12 the patent number. The motion will be denied.

13 The patent marking statute prevents a patent owner from recovering any pre-litigation
14 damages if it did not properly mark its products with the patent number. 35 U.S.C. § 287(a).
15 The purpose of requiring patent owners mark their products is to “place the world on notice
16 of the existence of the patent.” *Am. Med. Sys., Inc. v. Med. Eng’g Corp.*, 6 F.3d 1523, 1538
17 (Fed. Cir. 1993). Rudolph argues Integrated never produced evidence establishing it
18 properly marked its products. As detailed in Integrated’s response, however, there is ample
19 evidence that Integrated marked its products. Ultimately, the issue of proper marking is an
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22 ¹ Rudolph argues it would be “manifest injustice” to prevent it from relying on this
23 new evidence. In support of this claim, Rudolph argues the “Court [has] already concluded
24 [the Japanese art] would be invalidating prior art.” (Doc. 291 at 13). This is a clear
25 misreading of the Court’s ruling. For purposes of addressing the “on-sale bar” argument, the
Court *assumed* the Japanese art would qualify as prior art. The Court has never found the
Japanese art actually qualifies as prior art.

26 ² At the very least, Rudolph should have alerted the Court to the possibility of this new
27 evidence by way of a Rule 56(f) motion. *See Goggin Warehousing, LLC v. Morin*, 2009 WL
28 2996405, at *3 (E.D. Tenn.) (party should have filed a “Rule 56(f) motion asking the Court
to withhold judgment until after” the additional evidence was available).

1 issue of fact. *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111 (Fed. Cir. 1996). The motion
2 will be denied.

3 **B. Motion to Preclude Integrated From Arguing Infringement Under the**
4 **Doctrine of Equivalents (Doc. 297)**

5 Rudolph seeks to preclude Integrated from arguing infringement of the ‘894 patent
6 under the doctrine of equivalents. Rudolph believes Integrated should be precluded from
7 making this argument based on prosecution history estoppel.³ Rudolph moved for summary
8 judgment on this same argument. The Court denied that motion. Rudolph has presented no
9 basis to reconsider that ruling. Thus, the jury will be allowed to decide whether Rudolph
10 infringed under the doctrine of equivalents.⁴

11 **C. Motion to Exclude Testimony by Dr. Brian Chapman (Doc. 304)**

12 Rudolph seeks to prevent Integrated’s expert Dr. Brian Chapman from testifying
13 regarding: 1) “infringement of the ‘894 patent under the doctrine of equivalents,” and 2)
14 “indirect infringement of the ‘894 patent.” (Doc. 304 at 4). Rudolph argues Dr. Chapman’s
15 opinions are conclusory and insufficient, but Rudolph does not explain the precise failings
16 of Dr. Chapman’s detailed expert report. The Court will not sift through Dr. Chapman’s
17 report to identify failings that Rudolph did not point out with specificity. The motion will
18 be denied.

19 **D. Motion to Exclude Evidence of the ‘894 Reexamination (Doc. 305)**

20 Integrated seeks to prevent Rudolph from introducing any evidence regarding the
21 Patent Office’s reexamination of the ‘894 patent. Evidence of the Patent Office’s actions is
22 relevant, at the very least, to the issue of willfulness. *Lucent Tech., Inc. v. Gateway, Inc.*,

23
24 ³ At issue is whether a probe tip touching a window versus not touching the window
25 is a trivial difference.

26 ⁴ In responding to this motion, Integrated sought an order precluding Rudolph from
27 “introducing evidence regarding prosecution history estoppel at trial.” The Court’s summary
28 judgment ruling cannot be read to prevent Rudolph from making this argument at trial. Thus,
Integrated’s motion will be denied.

1 2007 WL 6955272 (S.D. Cal.) (finding Patent Office actions relevant to wilfulness inquiry).

2 Thus, the motion will be denied.

3 **E. Motion to Exclude Evidence Related to Rudolph’s ‘128 Patent (Doc.**
4 **306)**

5 Rudolph recently obtained U.S. Patent No. 7,634,128. That patent involves Rudolph’s
6 “one touch” method for its probe card inspection system. Integrated plans on arguing
7 Rudolph’s “one touch” method is an insubstantial difference such that Rudolph’s machines
8 using this system still infringe Integrated’s patents. Integrated seeks to prevent Rudolph
9 from introducing any evidence regarding the ‘128 patent. Integrated argues the Federal
10 Circuit has ruled that a later-acquired patent can be introduced only if it accurately describes
11 the operation of the accused infringing devices and if the earlier patents were cited during
12 the prosecution of the later patent. But if Rudolph is able to establish the ‘128 patent
13 describes its products, that evidence is relevant to infringement.⁵ And the Federal Circuit has
14 not established a clear rule that the later-acquired patent must cite the previous patents for
15 the later patent to be used. Thus, the motion will be denied.

16 **F. Motion to Exclude Expert Edward McDonough (Doc. 332)**

17 Rudolph seeks to preclude Edward McDonough, Integrated’s damages expert, from
18 offering expert testimony on the issue of lost profits. Rudolph argues McDonough’s opinion
19 “is based on speculation and conjecture.” (Doc. 332 at 1). Integrated responds that
20 Rudolph’s own documents contradict the facts presented in the motion.

21 To recover lost profits, Integrated must show “(1) demand for the patented product,
22 (2) absence of acceptable noninfringing substitutes, (3) manufacturing and marketing
23 capability to exploit the demand, and (4) the amount of profit that would have been made.”

24
25 ⁵ The Federal Circuit has observed that when “a device that incorporates the
26 purported equivalent is in fact the subject a separate patent, a finding of equivalency, while
27 perhaps not necessarily legally foreclosed, is at least considerably more difficult to make
28 out.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 493 F.3d 1368, 1379
(Fed. Cir. 2007). Of course, if Rudolph is not able to establish that the ‘128 patent describes
its products, the patent will be irrelevant.

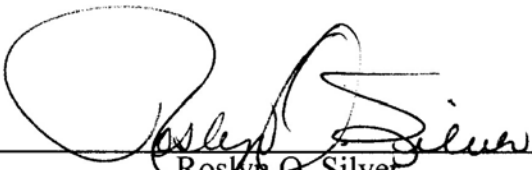
1 *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1329 (Fed. Cir. 2009).
2 Rudolph argues McDonough failed to perform the necessary analysis under each of these
3 requirements. For example, Rudolph argues McDonough did not consider noninfringing
4 alternatives produced by companies such as Beijert Engineering. But Rudolph's own
5 documents report that Integrated and Rudolph were the only "viable" producers of probe card
6 systems. (Doc. 332 at 6). The Court will not exclude McDonough based on his decision to
7 accept Rudolph's own statements as true. Moreover, Rudolph's expert on lost profits used
8 the same methodology McDonough used.⁶ Thus, rather than reflect true concern with the
9 methodology used by McDonough, Rudolph's motion reflects its disagreement with
10 McDonough's conclusions. The motion will be denied.

11 Accordingly,

12 **IT IS ORDERED** the Motion for Clarification or Reconsideration (Doc. 291) and
13 Motions in Limine (Doc. 296, 297, 304, 305, 306, 310, 332) are **DENIED**. This order shall
14 not be sealed.

15 DATED this 1st day of September, 2010.

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Roslyn O. Silver
United States District Judge

⁶ Rudolph's own expert reported he did not know the number of sales that went to companies other than Rudolph and Integrated. (Doc. 334 at 4).