

**IN THE UNITED STATES DISTRICT COURT FOR THE  
WESTERN DISTRICT OF OKLAHOMA**

FORUM US, INC., a Delaware	)	
corporation,	)	
	)	
Plaintiff,	)	
	)	
-vs-	)	Case No. CIV-17-0495-F
	)	
FLOW VALVE, LLC, an Oklahoma	)	
limited liability company,	)	
	)	
Defendant.	)	

**ORDER**

Plaintiff Forum US, Inc. (Forum) moves for partial summary judgment, arguing that claims 14-20 of United States Patent RE 45,878 are invalid as a matter of law under the original patent rule of 35 U.S.C. § 251. Doc. no. 42. Defendant Flow Valve, LLC (Flow Valve) has filed a response brief, objecting to the motion. Doc. no. 43. Forum filed a reply brief. Doc. no. 44.

**Standards**

Under Rule 56, Fed. R. Civ. P., summary judgment shall be granted if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. Celotex Corp. v. Catrett, 477 U.S. 317, 325 (1986). A genuine issue of material fact exists when “there is sufficient evidence favoring the non-moving party for a jury to return a verdict for that party.” Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986). In determining whether a genuine issue of a material fact exists, the evidence is to be taken in the light most favorable to the non-moving party. Adickes v. S.H. Kress & Co., 398 U.S. 144, 157 (1970). All reasonable inferences to be drawn from the undisputed facts are to be determined

in a light most favorable to the non-movant. United States v. Agri Services, Inc., 81 F.3d 1002, 1005 (10<sup>th</sup> Cir. 1996). Once the moving party has met its burden, the opposing party must come forward with specific evidence, not mere allegations or denials, demonstrating that there is a genuine issue for trial. Posey v. Skyline Corp., 702 F.2d 102, 105 (7<sup>th</sup> Cir. 1983).

A patent is presumed valid and the burden of proving invalidity rests on the party asserting such invalidity; at trial, the party asserting invalidity (here, Forum) must prove invalidity by clear and convincing evidence. *See*, Microsoft Corp. v. i4i Ltd. Partnership, 564 U.S. 91, 95 (2011) (35 U.S.C. § 282 requires an invalidity defense to be proved by clear and convincing evidence). The court keeps this heightened standard of proof in mind when evaluating Forum's motion for partial summary judgment. *See*, Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 254 (1986) (“[I]n ruling on a motion for summary judgment, the judge must view the evidence presented through the prism of the substantive evidentiary burden,” such as the “convincing clarity” requirement applicable in that case).

Determining whether a reissue patent violates 35 U.S.C. § 251 is a question of law which is reviewed *de novo*. AIA Engineering Ltd. v. Magotteaux Int'l S/A, 657 F.3d 1264, 1271 (Fed. Cir. 2011). This legal question may involve underlying factual questions. Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1479 (Fed. Cir. 1998). Accordingly, before Forum could be entitled to partial summary judgment in its favor, it must establish, under the standards of Rule 56, that any underlying fact issues are undisputed on this record, and that it is otherwise entitled to summary judgment as a matter of law.

#### Summary of the Parties' Arguments

In this action, Forum seeks (among other relief) a declaratory judgment determining that claims 14-20 of reissue patent 45,878 are invalid for various reasons, including failure to meet the requirements of 35 U.S.C. § 251, the statute

which is the source of the original patent rule that is the subject of this motion. *See*, doc. no. 21 (First Amended Complaint, “First Cause of Action – Declaratory Judgment of Patent Invalidity,” ¶¶ 22-26; and “Prayer For Relief,” ¶ 1). Claims 14-20 are the new claims which were added by the reissue patent, to the original patent claims 1-13. The motion asks the court to summarily determine that claims 14-20 are invalid as a matter of law for failure to comply with the original patent rule.

Forum argues that claims 14-20 describe a workpiece supporting assembly without any requirement of a plurality of arbors.<sup>1</sup> Forum argues that for the reissue patent to be valid, the original patent rule requires that the specification of the original patent indicate, in an explicit and unequivocal manner, that the invention described therein can be practiced without a plurality of arbors.<sup>2</sup> Forum argues that the specification of the original patent does not do so because it does not explicitly and unequivocally indicate a workpiece supporting assembly without a plurality of arbors. Forum notes that the specification repeatedly refers to a plurality of arbors, including, for example, the following statement, found in the “description” portion of the original and reissue patents: “[T]he multiple arbors of the workpiece supporting assembly provides means for machining the ends of the unfinished elbow member 12 by a single set up and only a change from one arbor to one of the other arbors allows rapid and accurate machining of the workpiece in a machine turning machine.” Doc. no. 42-1, Col. 3, ll. 33-38 (original patent); doc. no. 42-2, Col.3, ll. 42-47 (reissue patent).

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<sup>1</sup> As shown in the figures in the original and reissue patents, the arbors extend from the workpiece supporting assembly and provide the means for attaching the workpiece supporting assembly to a lathe.

<sup>2</sup> As used in this order, “specification” embraces everything in a patent (visual and textual), aside from the claims. The line numbers in the reissue patent vary slightly from the line numbers in the original patent, but other than this, the original patent and the reissue patent are identical *except* for the fact that the reissue patent added claims 14-20. Thus, the specification of the original patent is reproduced in the specification of the reissue patent.

Flow Valve makes a variety of arguments in response to the motion. Flow Valve contends the issue presented by Forum's motion is one of fact as to which clear and convincing evidence is required at trial, and that genuine issues of material fact preclude summary judgment. Flow Valve argues the omission of arbors from the reissue claims does not render those claims invalid as a matter of law. Flow Valve argues that a patent may disclose multiple inventions, such as an invention with arbors and an invention without arbors. Flow Valve argues that the original patent's disclosure supports claims without arbors, as well as claims with arbors. Flow Valve argues that an artisan of ordinary skill would understand from the original patent that the arbors are an optional feature of the fixture. Flow Valve identifies evidence from its proposed expert, Terry Iafrate, for the proposition that an individual with ordinary skill in the art to which the patent relates, would understand, from the disclosures in the original patent, that the original patent supports claims to multiple inventions, specifically, a workpiece with arbors as well as a workpiece without arbors. Flow Valve argues that the relevant statute, 35 U.S.C. § 251, only requires that the claimed invention be disclosed in the original patent, and that the statute does not use the terms "explicit" and "unequivocal." Flow Valve argues that Forum's cases do not support summary judgment. Flow Valve argues that testimony from Mitchell McCarthy may not be considered. If McCarthy's testimony is considered, Flow Valve argues that his testimony is consistent with that of Iafrate and that it does not support summary judgment.

#### Initial Fact-Findings

Movant Forum presents six material facts, five of which are expressly admitted by Flow Valve and one of which, the sixth, Flow Valve purports to dispute. The five facts which are expressly undisputed are as follows.

1. Flow Valve's original patent, patent number 8,215,213, issued on July 10, 2012.

2. All of the claims of the original patent, claims 1-13, either directly or indirectly, have a limitation requiring “a plurality of arbors.”
3. On July 10, 2014, Flow Valve sought a reissue patent in place of the original patent, which issued on February 2, 2016, as RE 45,878, entitled “Workpiece Supporting Assembly.”
4. The Reissue Patent added claims 14-20 to the original claims 1-13 from the original patent.
5. Claims 14-20 do not have the limitation requiring “a plurality of arbors.”

### Discussion

The court begins its discussion with the sixth proposed fact presented in support of Forum’s motion. There, Forum contends:

6. The specification of the original patent does not indicate in an explicit and unequivocal manner that the invention described therein can be practiced without a plurality of arbors.<sup>3</sup>

Implicit in this sixth fact is Forum’s contention of law that, for a reissue patent to be valid, the original patent must indicate, in an explicit and unequivocal manner, the invention described in the reissue patent. Flow Valve appears to take issue with

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<sup>3</sup> For this contention, Forum cites excerpts from the deposition of McCarthy (prosecuting counsel for the reissue patent), found at doc. no. 42-3, pp. 36-37 and 40-46. Flow Valve contends the court should not consider McCarthy’s testimony because McCarthy was not qualified as an expert in any technical field, because his testimony as a lawyer is inadmissible, and because he was not designated under Rule 30(b)(6), Fed. R. Civ. P. Flow Valve also notes that McCarthy’s testimony was given in a prior action between these parties, and that the reissue patent did not exist when the deposition was taken. Without determining the propriety of considering McCarthy’s testimony, the court presumes, *arguendo*, that it should not consider that testimony at this stage, and it does not do so. That said, with or without consideration of that testimony, the result would be the same. Moreover, ignoring McCarthy’s testimony does not leave Forum’s sixth fact untethered to the record because the face of the original patent, standing alone, supports the sixth fact. *See* discussion n. 4, *supra*.

this proposition, arguing that the relevant statute, § 251, does not include the terms “explicit” or “unequivocal.” That argument, however, does not account for court decisions interpreting the statute, which are discussed later in this order.

Also pertinent to the sixth fact, the court observes that Flow Valve does not directly challenge Forum’s contention that the specification of the original patent does not indicate, in an explicit and unequivocal manner, that the invention described there can be practiced without a plurality of arbors.<sup>4</sup> Flow Valve argues that no passage in the original patent identifies arbors as critical to the inventions it discloses, but that is not quite the same thing. Iafrate’s affidavit, offered by Flow Valve, does not contend that the original patent teaches a fixture without arbors in an explicit and unequivocal manner. Rather, Iafrate’s affidavit discusses what a worker of ordinary skill *would* understand, or *would* know, or *would* appreciate. Doc. no. 43-1.

In short, Flow Valve purports to dispute the original patent’s lack of an explicit and unequivocal indication of an invention without a plurality of arbors *not*

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<sup>4</sup> Flow Valve cannot challenge Forum’s contention in this regard because it is clear, from the face of the original patent, that the original fails to explicitly and unequivocally disclose an invention without arbors, including for the following reasons.

- The original patent’s abstract, and its summary, both refer to a plurality of arbors.
- The original patent’s figures show two arbors.
- The original patent’s description refers to a first arbor and a second arbor.
- The original patent’s description explains the purpose of multiple arbors. (Previously quoted in this order, the description indicates that “[T]he multiple arbors of the workpiece supporting assembly provides means for machining the ends of the unfinished elbow member by a single setup....”)
- The original patent’s claims (1 – 13) include several express references to a plurality of arbors, and the other original claims refer indirectly to a plurality of arbors (by, for example, citing claims which expressly refer to a plurality of arbors).
- Nothing in the original patent refers to an invention without a plurality of arbors or an invention with no arbors.

by challenging this contention (Forum's sixth fact) head-on, but by proposing a different proposition, *i.e.* that an individual with ordinary skill in the art would understand, from the original patent, that it supports claims for an invention consisting of a fixture with arbors as well as a fixture with no arbors.

Accordingly, it is necessary to sort out, in the context of the original patent rule, the relationship between the two principles relied on by the parties: 1) Forum's reliance on a requirement that, for the reissue patent to be valid, the specification of the original patent must explicitly and unequivocally disclose a fixture with arbors and without arbors; and Flow Valve's reliance on evidence (taken as true at this stage) that an individual ordinarily skilled in the art would understand, from the disclosure of the original patent, that it supports claims with arbors as well as claims without arbors. Antares Pharma, Inc. v. Medac Pharma Inc., 771 F.3d 1354 (Fed. Cir. 2014), addresses the relationship between these positions. But before reaching that issue, it is helpful to address the original patent rule, and its source in § 251, more generally.

Title 35 U.S.C. § 251(a), entitled "Reissue of defective patents," provides as follows.

Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. § 251(a) (emphasis added).

In Antares, the Federal Circuit reaffirmed the original patent requirement (also referred to in this order as “the original patent rule”) which is derived from § 251, then found that the reissue claims asserted in that case violated the rule. *Id.* at 1357-58.<sup>5</sup> In reaching that conclusion, the court explained the consequence of waiting until after a patent had issued to seek to broaden claims (as occurred here), as follows.

The delay in seeking to broaden the claims is not without cost. By waiting until after the patent is issued, the applicant becomes subject to two additional requirements relevant here: first, the claims must not violate the recapture rule; second, the claims must satisfy the statutory original patent requirement of 35 U.S.C. § 251.

*Id.* at 1358 (emphasis added, footnote omitted).

Antares observes that the original patent requirement is well-established, having been recognized in the reissue statute and in longstanding Supreme Court jurisprudence. *Id.* at 1358. In that regard, Antares reviews various Supreme Court decisions, including what it calls “[t]he Supreme Court’s definitive explanation of the original patent requirement [which] appears in U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 62 S. Ct. 839, 86 L. Ed. 1105 (1942).” *Id.* at 1359. As described in Antares, in Industrial Chemicals, the Supreme Court found that the reissue patent was invalid for failing to satisfy the same invention requirement. *Id.*, citing Industrial Chemicals at 680-81. Per Antares, Industrial Chemicals ”explained that a reissue claim is for the same invention if the original patent specification fully describes the claimed inventions, but not if the broader claims are [ ] merely suggested or indicated in the original specification. [I]t

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<sup>5</sup> In Antares, the original claims, 1-22, covered a needle-assisted jet-injector system for injecting medicine, in which a needle punctures the skin before forcefully expelling the medicine. Plaintiff had obtained a reissue patent in which claims 23-27 were not limited to jet-injection devices and which focused, instead, on safety features for any injection devices. Antares at 1356.



is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.” *Id.*, citing Industrial Chemicals at 676, full citations and interior quotations omitted.

Antares states that although the Supreme Court’s articulation of the same invention test in Industrial Chemicals was in the context of 35 U.S.C. § 64, which had slightly different language from the current reissue statute, 35 U.S.C. § 251, the 1952 amendments did not change the substance of the same invention statute. Antares at 1360.<sup>6</sup> As set out in Antares, after the 1952 amendments, the courts continued to view Industrial Chemicals as articulating the applicable test. *Id.* As one example, Antares cites McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381 (10<sup>th</sup> Cir. 1965), a decision which reiterates the Industrial Chemicals rule that “[i]t is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification;” rather, the invention described in the reissue patent “must be ‘explicitly disclosed and taught’ in the specification.” Antares at 1360-61 (quoting McCullough at 389).

Finally, addressing the competing principles asserted by the parties in this case, Antares explains as follows. “[T]he Industrial Chemicals standard is analogous to the written description requirement [of 35 U.S.C. § 112], which...requires that the patent description clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.” Antares at 1362, interior quotations and citations omitted. Antares then states: “Whether or not the written description requirement of §112 is satisfied here, Industrial Chemicals made clear that, for § 251, it is not enough that an invention might have been claimed in the original

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<sup>6</sup> Flow Valve argues that Industrial Chemicals involved a patent reissued prior to the 1952 amendments and that it is unclear whether Industrial Chemicals would have been decided the same way today. Flow Valve also makes other arguments regarding the inapplicability of Industrial Chemicals. The court rejects these arguments. As explained in the text of this order, Antares makes clear the ongoing importance of Industrial Chemicals.

patent because it was suggested or indicated in the specification. Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Id.* at 1362 (interior quotations and citations omitted; emphasis added). Thus, according to the Federal Circuit’s understanding of Industrial Chemicals as set out in Antares, no matter what a person of ordinary skill in the art would recognize, the specification of the original patent must clearly and unequivocally disclose the newly claimed invention in order to satisfy the original patent rule.<sup>7</sup>

In short, Iafrate’s declaration, relied on by Flow Valve in an attempt to dispute Forum’s sixth fact, does not create a genuine issue of *material* fact regarding the contention posited in the sixth fact by Forum, which is that the specification of the original patent does not explicitly and unequivocally indicate that the invention described therein can be practiced without a plurality of arbors. The court finds that Forum’s sixth fact is undisputed on this record.

As stated in Antares, the invention described in the reissue patent “must be ‘explicitly disclosed and taught’ in the specification.” Antares at 1360-61 (quoting McCullough at 389). Because it is undisputed that the specification of the original patent does not comply with this requirement, claims 14-20 of the reissue patent violate the original patent rule and the reissue patent is invalid.

Antares is consistent with this result. For example, Antares notes that every one of the original claims contained the jet-injection limitation, but that the asserted claims were focused on particular safety features and did not contain the jet-injection

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<sup>7</sup> Consistent with this understanding, Antares’ discussion of In re Amos, 953 F.2d 613 (Fed. Cir. 1991), makes clear that although the original patent requirement is analogous to the written description requirement, the standards for judging whether those requirements are satisfied are not the same. Antares, at 1362, n.8 (discussing Amos; stating that the standards, while analogous, are not the same; distinguishing another case which suggested that one test was dispositive of the other and noting the other case had not taken Industrial Chemicals into consideration).

limitation. *Id.* at 362. A similar situation exists here, as all of the original claims refer directly or indirectly to a plurality of arbors and none of the original claims refers to a fixture without a plurality of arbors. Furthermore, as previously mentioned, Antares contrasts its facts with the facts of In re Amos, 953 F.2d 613 (Fed. Cir. 1991), a case which (unlike Antares) upheld the reissue patent. Antares at 1363. The facts of the present case are likewise distinguishable from those of Amos. In Amos, the reissue patent sought to add a computer-controlled embodiment. As described in Antares, Amos upheld the reissue patent because “the exact embodiment claimed on reissue was expressly disclosed in the specification.” *Id.*<sup>8</sup>

In summary, a reissue patent is invalid if it does not explicitly and unequivocally indicate the new invention sought to be covered in the reissue patent. Here, the specification of the original patent does not indicate, in an explicit and unequivocal manner, that the invention described therein can be practiced without a plurality of arbors. Despite this fact, a workpiece supporting assembly without a plurality of arbors is what is claimed by the reissue patent, in claims 14-20. In these circumstances, claims 14-20 are necessarily invalid under the original patent rule.

#### Conclusion


After careful consideration, the court determines and declares that claims 14-20 of United States Reissue Patent RE 45,878 are invalid as a matter of law under

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<sup>8</sup> Per Antares, the specification in Amos expressly disclosed that rollers, as they approached the end of the table, could be “raised either mechanically by the roller cams or electronically by the computer controlling the router.” *Id.* at 1363, quoting Amos at 614. The original claims had only covered the manual embodiment, but on reissue the applicant sought to add the computer-controlled embodiment. *Id.* at 1363.

the original patent rule of 35 U.S.C. § 251, and that the reissue patent is therefore invalid. Forum's motion for partial summary judgment is **GRANTED**.<sup>9</sup>

IT IS SO ORDERED this 21<sup>st</sup> day of February, 2018.

  
STEPHEN P. FRIOT  
UNITED STATES DISTRICT JUDGE

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<sup>9</sup> Forum's reply brief states that a ruling in its favor will make it appropriate for the court to dismiss any other claims and enter judgment. If the parties agree in this regard, they may file a joint notice proposing a procedure by which to close this action and enter judgment. Otherwise, this action will remain pending, with the existing deadlines in place.