

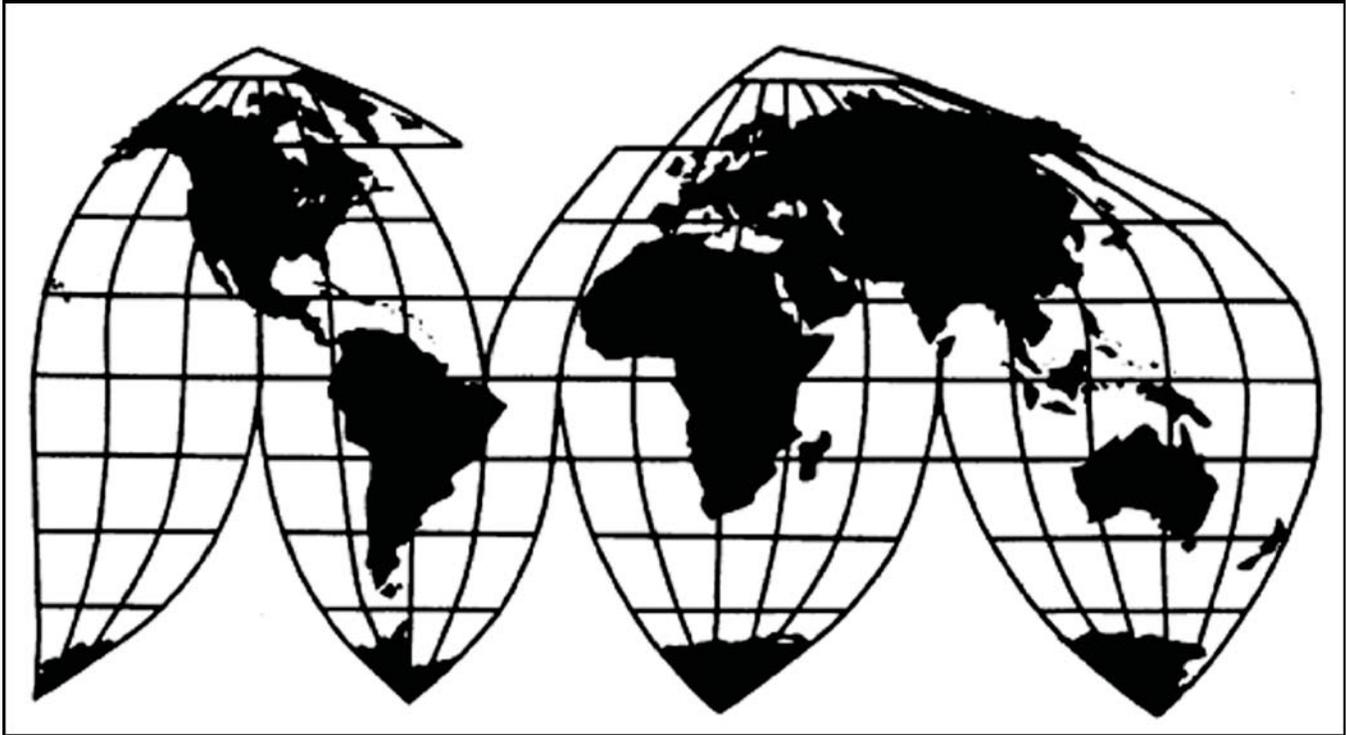
In the Matter of
**Certain Self-Cleaning Litter Boxes and
Components Thereof**

Investigation No. 337-TA-625

Publication 4259

October 2011

U.S. International Trade Commission



Washington, DC 20436

U.S. International Trade Commission

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U.S. International Trade Commission

Washington, DC 20436
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In the Matter of

Certain Self-Cleaning Litter Boxes and Components Thereof

Investigation No. 337-TA-625



UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Investigation No. 337-TA-625

**NOTICE OF COMMISSION FINAL DETERMINATION OF VIOLATION OF
SECTION 337; ISSUANCE OF LIMITED EXCLUSION ORDER AND CEASE AND
DESIST ORDERS; TERMINATION OF INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined that there is a violation section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337) by respondents Lucky Litter, L.L.C. of Chicago, Illinois and OurPet's Company of Fairport Harbor, Ohio in the above-captioned investigation. The Commission has issued a limited exclusion order, issued cease and desist orders against the two respondents, and terminated the investigation.

FOR FURTHER INFORMATION CONTACT: Mark B. Rees, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW, Washington, DC 20436, telephone (202) 205-3116. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, SW, Washington, DC 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <http://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on December 28, 2007, based on the complaint of Applica Consumer Products, Inc. of Miramar, Florida ("Applica") and Waters Research Company of West Dundee, Illinois ("Waters"). 72 *Fed. Reg.* 73884 (Dec. 28, 2007); 73 *Fed. Reg.* 13566 (Mar. 13, 2008). The complaint alleges violations of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the importation into the United States, the sale for importation, and the sale within the United States after importation of

certain self-cleaning litter boxes and components thereof by reason of infringement of U.S. Patent No. RE36,847 (“the ‘847 patent”). The respondents are Lucky Litter, L.L.C. of Chicago, Illinois (“Lucky Litter”) and OurPet’s Company of Fairport Harbor, Ohio (“OurPet’s”).

On December 1, 2008, the presiding administrative law judge (“ALJ”) issued his final initial determination (“ID”), finding that a violation of section 337 has occurred in the importation, sale for importation, or sale after importation of certain self-cleaning litter boxes and components thereof by reason of infringement of claim 33 of the ‘847 patent. His final ID also included his recommendation on remedy and bonding. Respondents Lucky Litter and OurPet’s, complainants Applica and Waters, and the Commission investigative attorney (“IA”) filed petitions (or contingent petitions) for review on December 16, 2008. All parties filed responses to the petitions on December 24, 2008. Complainants also filed a motion to strike on December 23, 2008, to which Lucky Litter and the IA filed oppositions on January 5, 2009.

The Commission determined to review certain issues of claim construction, as well as invalidity due to anticipation, invalidity due to obviousness, and direct and contributory infringement on February 9, 2009. *74 Fed. Reg. 7263* (Feb. 13, 2009). Per its notice, the Commission also determined to grant Complainants’ motion to strike, and set a schedule for the filing of written submissions on the issues under review, including certain questions posed by the Commission, and on remedy, the public interest, and bonding. The parties have briefed, with initial and reply submissions, the issues under review and the issues of remedy, the public interest, and bonding.

On review, the Commission has determined to (1) affirm the ALJ’s construction of “comb drive” (asserted claims 8, 13, 31-33), “comb drive means” (asserted claims 27, 41-42), “drive means” (asserted claims 24-25), and “mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position” (asserted claim 33); (2) modify the ALJ’s construction of “discharge position adjacent the discharge end wall” (asserted claims 8, 13) to “not distant, nearby,” thereby deleting the synonyms “adjoining, contiguous, abutting, and coterminus;” and (3) construe “coupled to” in the limitation “comb . . . coupled to the comb drive” (asserted claims 31-33) as “coupled or connected, directly or indirectly;” (4) affirm the ALJ’s finding of violation of § 337 as to Respondent Lucky Litter; (5) affirm the ALJ’s finding that the accused Lucky Litter products infringe claim 33 of the ‘847 patent; (6) affirm the ALJ’s finding of violation of § 337 as to Respondent OurPet’s; (7) affirm the ALJ’s finding that the accused OurPet’s products infringe claim 33 of the ‘847 patent; (8) affirm the ALJ’s finding that infringed claim 33 is not invalid due to anticipation or obviousness; and (9) affirm the ID on any other findings under review except insofar as they are inconsistent with the opinion of the Commission.

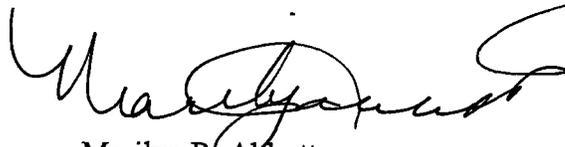
The Commission determined that the appropriate form of relief in this investigation is (1) a limited exclusion order prohibiting the unlicensed entry of self-cleaning litter boxes and components thereof, including cartridges, covered by claim 33 of U.S. Patent No. Re. 36,847 that

are manufactured abroad by or on behalf of, or imported by or on behalf of, Lucky Litter and OurPet's; and (2) cease and desist orders against Lucky Litter and OurPet's.

The Commission further determined that the public interest factors enumerated in section 337(d)(1) (19 U.S.C. § 1337(d)(1)) do not preclude issuance of the limited exclusion order. Finally, the Commission determined that the bond under the limited exclusion order during the Presidential review period shall be in the amount of 100 percent of the entered value of the imported articles. The Commission's orders were delivered to the President and the United States Trade Representative on the day of their issuance.

The Commission has therefore terminated this investigation. The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and sections 210.16(c) and 210.41-.42, 210.50 of the Commission's Rules of Practice and Procedure (19 CFR § 210.16(c) and § 210.41-.42, 210.50).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', is written over a faint, illegible background.

Marilyn R. Abbott
Secretary to the Commission

Issued: April 8, 2009S

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Inv. No. 337-TA-625

LIMITED EXCLUSION ORDER

The Commission has determined that there is a violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the unlawful importation, sale for importation, or sale after importation by Respondents Lucky Litter, LLC of Chicago Illinois (“Lucky Litter”) and OurPet’s Company of Fairport, Ohio (“OurPet’s”) of certain self-cleaning litter boxes and components thereof, including cartridges, by reason of infringement of claim 33 of U.S. Patent No. Re. 36,847. Having reviewed the record in this investigation, including the written submissions of the parties, the Commission has made its determination on the issues of remedy, the public interest, and bonding. The Commission has determined that the appropriate form of relief is a limited exclusion order prohibiting the unlicensed entry of infringing self-cleaning litter boxes and components thereof, including cartridges, manufactured by or on behalf of, or imported by or on behalf of Lucky Litter or OurPet’s or any of their affiliated companies, parents, subsidiaries, licensees, or other related business entities, or their successors or assigns. The Commission has also determined that the appropriate form of relief includes cease and desist orders against Lucky Litter and OurPet’s.

The Commission has determined that the public interest factors enumerated in 19 U.S.C. § 1337(d) and (f) do not preclude issuance of the limited exclusion order or cease and desist

orders. Finally, the Commission has determined that the bond during the Presidential review period shall be in the amount of 100 percent of the entered value of the self-cleaning litter boxes and components thereof, including cartridges, that are subject to this order.

Accordingly, the Commission hereby **ORDERS THAT**:

1. Self-cleaning litter boxes and components thereof, including cartridges, covered by claim 33 of U.S. Patent No. Re. 36,847 that are manufactured abroad by or on behalf of, or imported by or on behalf of Lucky Litter and OurPet's, or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns are excluded from entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, for the remaining term of the patent, except under license of the patent owner or as provided by law.

2. Notwithstanding paragraph 1 of this Order, the aforesaid imported self-cleaning litter boxes and components thereof, including cartridges, are entitled to entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, under bond in the amount of 100 percent of entered value of such articles, from the day after this Order is received by the United States Trade Representative as delegated by the President, 70 *Fed. Reg.* 43251 (July 21, 2005), until such time as the United States Trade Representative notifies the Commission that this action is approved or disapproved but, in any event, not later than sixty (60) days after the date of receipt of this action.

3. At the discretion of U.S. Customs and Border Protection ("CBP") and pursuant to procedures it establishes, persons seeking to import self-cleaning litter boxes or components thereof, including cartridges, that are potentially subject to this Order may be required to certify

that they are familiar with the terms of this Order, that they have made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry under paragraphs 1 through 7 of this Order. At its discretion, Customs may require persons who have provided the certification described in this paragraph to furnish such records or analyses as are necessary to substantiate the certification.

4. In accordance with 19 U.S.C. § 1337(l), the provisions of this Order shall not apply to self-cleaning litter boxes and components thereof, including cartridges, that are imported by and for the use of the United States, or imported for, and to be used for, the United States with the authorization or consent of the Government.

5. The Commission may modify this Order in accordance with the procedures described in Rule 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

6. The Commission Secretary shall serve copies of this Order upon each party of record in this investigation and upon the Department of Health and Human Services, the Department of Justice, the Federal Trade Commission, and Customs and Border Protection.

7. Notice of this Order shall be published in the *Federal Register*.

By Order of the Commission.


Marilyn R. Abbott
Secretary to the Commission

Issued: April 8, 2009

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Inv. No. 337-TA-625

ORDER TO CEASE AND DESIST

IT IS HEREBY ORDERED THAT OurPet's Company of 1300 East Street, Fairport Harbor, Ohio 44077 cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, offering for sale, transferring (except for exportation), and soliciting U.S. agents or distributors for, self-cleaning litter boxes and components thereof, including cartridges, that are covered by claim 33 of U.S. Patent No. Re. 36,847, in violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337.

I.

Definitions

As used in this Order:

(A) "Commission" shall mean the United States International Trade Commission.

(B) "Complainants" shall mean Applica Consumer Products, Inc., of Miramar, Florida, and Waters Research Company of West Dundee, Illinois.

(C) "Respondent" means OurPet's Company of 1300 East Street, Fairport Harbor, Ohio 44077.

(D) "Person" shall mean an individual, or any non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) "United States" shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms "import" and "importation" refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term "covered products" shall mean self-cleaning litter boxes and components thereof, including cartridges, that are covered by claim 33 of the '847 patent.

II.

Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them, insofar as they are engaging in conduct prohibited by Section III, *infra*, for, with, or otherwise on behalf of Respondent.

III.

Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by the Order. For the remaining term of the patent, Respondent shall not:

(A) import or sell for importation into the United States covered products;

(B) market, distribute, offer for sale, sell, or otherwise transfer (except for exportation), in

the United States imported covered products;

(C) advertise imported covered products;

(D) solicit U.S. agents or distributors for imported covered products; or

(E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV.

Conduct Permitted

Notwithstanding any other provision of this Order, specific conduct otherwise prohibited by the terms of this Order shall be permitted if, in a written instrument, the owner of U.S. Patent No. Re. 36,847 licenses or authorizes such specific conduct, or such specific conduct is related to the importation or sale of covered products by or for the United States.

V.

Reporting

For purposes of this reporting requirement, the reporting periods shall commence on July 1 of each year and shall end on the subsequent June 30. However, the first report required under this section shall cover the period from the date of issuance of this Order through June 30, 2009. This reporting requirement shall continue in force until such time as Respondent will have truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission the quantity in units and the value in dollars of covered products that Respondent have imported or sold in the United States after importation during the reporting

period and the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI.

Record Keeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purpose of determining or securing compliance with this Order and for no other purpose, and subject to any privilege recognized by the federal courts of the United States, duly authorized representatives of the Commission, upon reasonable written notice by the Commission or its staff, shall be permitted access and the right to inspect and copy in Respondent's principal offices during office hours, and in the presence of counsel or other representatives if Respondent so choose, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, both in detail and in summary form as are required to be retained by subparagraph VI(A) of this Order.

VII.

Service of Cease and Desist Order

Respondent is ordered and directed to:

(A) Serve, within fifteen (15) days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen (15) days after the succession of any persons referred to in subparagraph VII (A) of this Order, a copy of the Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the date of expiration of U.S. Patent No Re. 36,847.

VIII.

Confidentiality

Any request for confidential treatment of information obtained by the Commission pursuant to Sections V and VI of this Order should be in accordance with Commission Rule 201.6, 19 C.F.R. § 201.6. For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX.

Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.75, including an action for civil penalties in accordance with section 337(f) of the Tariff Act of 1930, 19 U.S.C. § 1337(f), and any other action as the Commission may deem appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if Respondent fails to provide adequate or timely information.

X.

Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

XI.

Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty (60) day period in which this Order is under review by the United States Trade Representative as delegated by the President, 70 *Fed Reg* 43251 (July 21, 2005), subject to Respondent posting a bond of in the amount of 100 percent of entered value of the covered products. This bond provision does not apply to conduct that is otherwise permitted by Section IV of this Order. Covered products imported on or after the date of issuance of this order are subject to the entry bond as set forth in the limited exclusion order issued by the Commission, and are not subject to

this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainants in connection with the issuance of temporary exclusion orders. *See* Commission Rule 210.68, 19 C.F.R. § 210.68. The bond and any accompanying documentation is to be provided to and approved by the Commission prior to the commencement of conduct which is otherwise prohibited by Section III of this Order.

The bond is to be forfeited in the event that the United States Trade Representative approves, or does not disapprove within the review period, this Order, unless the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or unless Respondent exports the products subject to this bond or destroy them and provides certification to that effect satisfactory to the Commission.

The bond is to be released in the event the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved, or not disapproved, by the United States Trade Representative, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By Order of the Commission.



Marilyn R. Abbott
Secretary to the Commission

Issued: April 8, 2009

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Inv. No. 337-TA-625

ORDER TO CEASE AND DESIST

IT IS HEREBY ORDERED THAT Lucky Litter LLC of 2 N. Riverside Plaza, Suite 1433, Chicago, Illinois 60606 cease and desist from conducting any of the following activities in the United States: importing, selling, marketing, advertising, distributing, offering for sale, transferring (except for exportation), and soliciting U.S. agents or distributors for, self-cleaning litter boxes and components thereof, including cartridges, that are covered by claim 33 of U.S. Patent No. Re. 36,847, in violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337.

I.

Definitions

As used in this Order:

(A) "Commission" shall mean the United States International Trade Commission.

(B) "Complainants" shall mean Applica Consumer Products, Inc., of Miramar, Florida, and Waters Research Company of West Dundee, Illinois.

(C) "Respondent" means Lucky Litter LLC of 2 N. Riverside Plaza, Suite 1433, Chicago, Illinois 60606.

(D) "Person" shall mean an individual, or any non-governmental partnership, firm,

association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, successors, or assigns.

(E) "United States" shall mean the fifty States, the District of Columbia, and Puerto Rico.

(F) The terms "import" and "importation" refer to importation for entry for consumption under the Customs laws of the United States.

(G) The term "covered products" shall mean self-cleaning litter boxes and components thereof, including cartridges, that are covered by claim 33 of the '847 patent.

II.

Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them, insofar as they are engaging in conduct prohibited by Section III, *infra*, for, with, or otherwise on behalf of Respondent.

III.

Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by the Order. For the remaining term of the patent, Respondent shall not:

(A) import or sell for importation into the United States covered products;

(B) market, distribute, offer for sale, sell, or otherwise transfer (except for exportation), in the United States imported covered products;

- (C) advertise imported covered products;
- (D) solicit U.S. agents or distributors for imported covered products; or
- (E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV.

Conduct Permitted

Notwithstanding any other provision of this Order, specific conduct otherwise prohibited by the terms of this Order shall be permitted if, in a written instrument, the owner of U.S. Patent No. Re. 36,847 licenses or authorizes such specific conduct, or such specific conduct is related to the importation or sale of covered products by or for the United States.

V.

Reporting

For purposes of this reporting requirement, the reporting periods shall commence on July 1 of each year and shall end on the subsequent June 30. However, the first report required under this section shall cover the period from the date of issuance of this Order through June 30, 2009. This reporting requirement shall continue in force until such time as Respondent will have truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission the quantity in units and the value in dollars of covered products that Respondent have imported or sold in the United States after importation during the reporting period and the quantity in units and value in dollars of reported covered products that remain in

inventory in the United States at the end of the reporting period.

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI.

Record Keeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purpose of determining or securing compliance with this Order and for no other purpose, and subject to any privilege recognized by the federal courts of the United States, duly authorized representatives of the Commission, upon reasonable written notice by the Commission or its staff, shall be permitted access and the right to inspect and copy in Respondent's principal offices during office hours, and in the presence of counsel or other representatives if Respondent so choose, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, both in detail and in summary form as are required to be retained by subparagraph VI(A) of this Order.

VII.

Service of Cease and Desist Order

Respondent is ordered and directed to:

(A) Serve, within fifteen (15) days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States;

(B) Serve, within fifteen (15) days after the succession of any persons referred to in subparagraph VII (A) of this Order, a copy of the Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the date of expiration of U.S. Patent No Re. 36,847.

VIII.

Confidentiality

Any request for confidential treatment of information obtained by the Commission pursuant to Sections V and VI of this Order should be in accordance with Commission Rule 201.6, 19 C.F.R. § 201.6. For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX.

Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.75, including an action for civil penalties in accordance with section 337(f) of the Tariff Act of 1930, 19 U.S.C. § 1337(f), and

any other action as the Commission may deem appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if Respondent fails to provide adequate or timely information.

X.

Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

XI.

Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty (60) day period in which this Order is under review by the United States Trade Representative as delegated by the President, 70 *Fed Reg* 43251 (July 21, 2005), subject to Respondent posting a bond of in the amount of 100 percent of entered value of the covered products. This bond provision does not apply to conduct that is otherwise permitted by Section IV of this Order. Covered products imported on or after the date of issuance of this order are subject to the entry bond as set forth in the limited exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainants in connection with the issuance of temporary exclusion orders. *See* Commission Rule 210.68, 19 C.F.R. § 210.68. The bond and any accompanying documentation is to be provided to and approved by the Commission prior to

the commencement of conduct which is otherwise prohibited by Section III of this Order.

The bond is to be forfeited in the event that the United States Trade Representative approves, or does not disapprove within the review period, this Order, unless the U.S. Court of Appeals for the Federal Circuit, in a final judgment, reverses any Commission final determination and order as to Respondent on appeal, or unless Respondent exports the products subject to this bond or destroy them and provides certification to that effect satisfactory to the Commission.

The bond is to be released in the event the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved, or not disapproved, by the United States Trade Representative, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By Order of the Commission.

A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', with a large, sweeping flourish extending to the right.

Marilyn R. Abbott
Secretary to the Commission

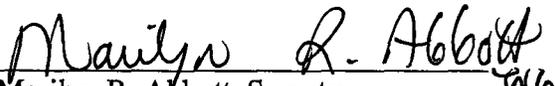
Issued: April 8, 2009

**CERTAIN SELF-CLEANING LITTER BOXES AND
COMPONENTS THEREOF**

337-TA-625

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION FINAL DETERMINATION OF VIOLATION OF SECTION 337; ISSUANCE OF LIMITED EXCLUSION ORDER AND CEASE AND DESIST ORDERS; TERMINATION OF INVESTIGATION** has been served by hand upon the Commission Investigative Attorney, Vu Q. Bui, Esq., and the following parties as indicated, on April 8, 2009.


Marilyn R. Abbott, Secretary *MA*
U.S. International Trade Commission
500 E Street, SW
Washington, DC 20436

**COUNSEL FOR COMPLAINANTS APPLICA
INCORPORATED, APPLICA CONSUMER
PRODUCTS, INCORPORATED AND WATERS
RESEARCH COMPANY:**

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KING & SPALDING LLP
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**ON BEHALF OF COMPLAINANT WATERS
RESEARCH COMPANY:**

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**United States International Trade Commission
Washington, D.C. 20436**

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Investigation No. 337-TA-625

COMMISSION OPINION

On April 7, 2009, the Commission issued notice of its final determination of violation of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) (“section 337”), entry of a limited exclusion order and cease and desist orders, and termination of this investigation. This opinion sets forth the reasons for the Commission’s determination on the issues it determined to review, and on remedy, the public interest, and bonding.

With the modifications discussed below, the Commission has determined to affirm on review the findings of the presiding administrative law judge (“ALJ”) in his final initial determination (“ID”) concerning violation of section 337 by Respondents Lucky Litter, L.L.C. (“Lucky Litter”) and OurPet’s Company (“OurPet’s”), the infringement of claim 33 of U.S. Patent No. RE36,847 (“the ‘847 patent”) by both Respondents, contributory infringement by Lucky Litter, and the validity of the challenged claims of the ‘847 patent.

The Commission has also determined that the appropriate remedial relief, which is consistent with the public interest, is a limited exclusion order, cease and desist orders against Lucky Litter and OurPet’s, and a bond during the Presidential review period in the amount of 100 percent of the entered value of the covered products.

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I. BACKGROUND

The Commission instituted this investigation on December 28, 2007, based on the complaint of Applica Consumer Products, Inc. (“Applica”) and Waters Research Company (“Waters”), alleging violations of section 337 in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain self-cleaning litter boxes and components thereof by reason of infringement of various claims of the ‘847 patent. *72 Fed. Reg.* 73884 (Dec. 28, 2007); *see 73 Fed. Reg.* 13566 (Mar. 13, 2008) (amending notice). The complaint named Lucky Litter and OurPet’s as respondents, as well as Dorskocil Manufacturing Co., Inc., which was later terminated from the investigation by settlement in an unreviewed ID (Order 50). *See* Commission Notice of September 15, 2008.¹

Technology and Patent at Issue

The technology at issue concerns self-cleaning cat litter boxes. The ‘847 patent, entitled “Automated Self-Cleaning Litter Box For Cats,” is directed to improved self-cleaning cat litter boxes and describes a litter box including a comb or rake. JX-1 at 1:59-62. A motor drives the comb or rake through the litter to move any cat waste into a waste receptacle. JX-1 at 5:36-57. Various claims (there are 48 in all, 17 of which are independent and 31 dependent) add

¹ Other pre-hearing IDs summarily determined the issues of the economic prong of the domestic industry requirement under section 337, the importation requirement under section 337, and the defense of derivation under 35 U.S.C. § 102(f) (Orders 28, 30, and 35, respectively, each decided in Complainants’ favor). The first of these was reviewed and modified to include an order (Order 34) the ALJ had subsequently issued to clarify the reasoning of his original order; the latter two were not reviewed. *See* Commission Notices of August 8 (two notices) & 19, 2008.

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limitations such as a sensor for detecting a cat, track members for guiding the comb, and devices for changing between manual operation mode and automated operation mode.

The '847 patent describes its improvements over the prior art self-cleaning litter boxes as an improved drive for the rake or comb that can be made responsive to the entry and exit of the cat from the litter box; an improved waste receptacle; and alarms that signal insufficient litter supply or that the waste receptacle is full. JX-1 at 1:33-39.

The '847 patent issued on September 5, 2000, as a reissue of U.S. Patent No. 5,477,812, which had issued on December 26, 1995. Michael Waters is the named inventor and the patent is assigned to his company, Waters, the complainant in this investigation along with the patent's exclusive licensee, Applica.

Products at Issue

Complainant Applica markets and sells a line of self-cleaning litter boxes under the brand name Littermaid®, including the Littermaid® LM Basic 500 and Elite models that the ALJ found, and no party disputes, practice the invention.

The accused products are automated self-cleaning litter boxes. Lucky Litter markets and sells a line of self-cleaning litter boxes under the brand name "ScoopFree." OurPet's markets and sells a line of self-cleaning litter boxes under the brand name "SmartScoop."

Final ID

On December 1, 2008, the ALJ issued his final ID in which he determined that a violation of section 337 has occurred in the importation, sale for importation, or sale after importation of certain self-cleaning litter boxes and components thereof. He found that the ScoopFree and

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SmartScoop products infringe claim 33 of the '847 patent, and further that the importation and sale of component cartridges by Lucky Litter constitute contributory infringement under 35 U.S.C. § 271(c). He found that the other claims asserted against Lucky Litter (claims 27, 33, and 41-42) and OurPet's (claims 8, 13, 24-25, 27, and 31-32) were not infringed, and that the allegation of induced infringement against Lucky Litter and OurPet's was not proven. Rejecting Respondents' affirmative defenses, the ALJ also found that the asserted claims of the '847 patent are not invalid, and that the patent is enforceable.

Commission Review

Lucky Litter and OurPet's, Applica and Waters, and the Commission investigative attorney ("IA") filed petitions (or contingent petitions) for review. Lucky Litter and OurPet's sought review and reversal of the ID's finding of infringement and, on a contingent basis, requested that the Commission find additional bases to support an ultimate finding of no violation of section 337 based on certain of their affirmative defenses.

The IA agreed with Respondents (although at times on different grounds) that the ID warranted review and reversal and that there were multiple additional bases upon which the Commission should make an ultimate finding of no violation of section 337.

Applica and Waters argued that if the Commission elected to review the ID, it should also review several additional grounds not relied on in the ID that support the ultimate finding that Respondents violated section 337. Complainants also filed a motion to strike a declaration submitted with Lucky Litter's petition and any related text in that petition, which Lucky Litter and the IA opposed.

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On February 9, 2009, the Commission determined to review the ID in part. 74 *Fed. Reg.* 7263 (Feb. 13, 2009). The Commission determined to review the ID's construction of the following terms: "comb drive" (asserted claims 8, 13, 31-33); "comb drive means" (asserted claims 27, 41-42); "drive means" (asserted claims 24-25); "discharge position adjacent the discharge end wall" (asserted claims 8, 13); "comb . . . coupled to the comb drive" (asserted claims 31-33); and "mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position" (asserted claim 33).² The Commission determined to review the following corresponding issues: direct and contributory infringement; invalidity due to anticipation; and invalidity due to obviousness.³ The Commission also determined to grant Complainants' motion to strike, and set a schedule for the filing of written submissions on the issues under review, including certain questions posed by the Commission,⁴ and on remedy, the

² The Commission thus declined to review the other petitioned claim constructions, including to "means for selecting" or "mode selector means," "manual operation mode," "automatic operation mode" (claim 27), "automatic operation position" (claim 33), "motor mounted on the carriage" (claims 8, 13), "comb path," "track member defining comb path" (claim 8), and "moving means" (claim 24).

³ The Commission thus declined to review other petitioned issues such as the ALJ's rejection of the affirmative defenses of best mode and inequitable conduct. The ALJ's findings and determinations that were not reviewed became the Commission's final determinations under Commission rule 210.42(h).

⁴ The Commission asked the following questions:

- (1) Did the ALJ err in finding that the specification of the '847 patent contains no disavowal that limits the claimed comb drive? If the patentee disavowed certain drives, what is the correct scope of the disavowal? Does it include, for example, worm drives of any configuration, or only the drive disclosed in the Carlisi prior art reference, which has a "worm" along the side of the litter box that turns and

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thereby drives the rake or comb on its path in the litter box?

- (2) What are the differences or similarities in the patent's use of "comb drive" in asserted claim 8, "comb drive means" in asserted claim 27, and "comb drive" in asserted claim 33?
- (3) Is there a difference in function between the "guide" wheels and "guide" pins referenced in the specification in connection with figures 1-3 of the '847 patent and the "drive" wheels and "drive" pins referenced in claim 10?
- (4) What result should the Commission reach on infringement if it were to find that the '847 patent disavows all worm drives or that it disavows only the Carlisi drive?
- (5) What result should the Commission reach on infringement if it were to find that the synonyms for "adjacent" cited in the ID at 143-44 incorrectly narrow the limitation "discharge position adjacent the discharge end wall" in asserted claim 8?
- (6) Is the limitation "comb . . . coupled to the comb drive" in asserted claims 31-33 met in OurPet's SmartScoop under a broader construction that includes, as Complainants argue, an "indirect" connection? Should the infringement analysis that follows from the correct construction of this limitation be different in claim 31 than it is in claim 33? Did the ID err in finding claim 33 infringed on the one hand and, on the other, that the same limitation is not met for purposes of claim 31?
- (7) How does a finding of disavowal of all worm drives, or the Carlisi drive, impact the consideration of obviousness under § 103 and anticipation under § 102? Do the broader constructions of "discharge position adjacent the discharge end wall" and "comb . . . coupled to the comb drive" advocated by Complainants impact either validity analysis?
- (8) Did the ID err in finding that the Strickland prior art reference does not disclose a "mode selector switch" to one of ordinary skill in the art?
- (9) Please describe and analyze the intrinsic evidence of record that is pertinent to the construction of "mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position" of claim 33. Please identify

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public interest, and bonding. The parties have filed their submissions and reply submissions. No comments were received from others regarding the public interest, remedy or bonding.

IV. DISCUSSION

1. Standard of Review

When, as here, the Commission determines to review an initial determination, its review is conducted *de novo*. *Certain Polyethylene Terephthalate Yarn and Prods. Containing Same*, Inv. No. 337-TA-457, Comm'n Op. at 9 (June 18, 2002). Upon review, the "Commission has 'all the powers which it would have in making the initial determination,' except where the issues are limited on notice or by rule." *Certain Flash Memory Circuits and Prods. Containing Same*, Inv. No. 337-TA-382, USITC Pub. 3046, Comm'n Op. at 9-10 (July 1997) (quoting *Certain Acid-Washed Denim Garments and Accessories*, Inv. No. 337-TA-324, Comm'n Op. at 5 (Nov. 1992)). Commission practice in this regard is consistent with the Administrative Procedure Act. *Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices and Prods. Containing Same*, Inv. No. 337-TA-395, Comm'n Op. at 6 (Dec. 11, 2000) (*EPROM*); *see also* 5 U.S.C. § 557(b).

Upon review, "the Commission may affirm, reverse, modify, set aside or remand for further proceedings, in whole or in part, the initial determination of the administrative law judge.

record evidence of whether each accused device contains a "mode selector switch" which is "moveable between a manual operation position . . . and an automatic operation position." In addition, please address the relevance of *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261 (Fed. Cir. 1999), to the claim construction, infringement and invalidity analyses of the "mode selector switch" limitation.

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The Commission may also make any findings or conclusions that in its judgment are proper based on the record in the proceeding.” 19 C.F.R. § 210.45. This rule reflects the fact that the Commission is not an appellate court, but is the body responsible for making the final agency decision. On appeal, only the Commission’s final decision is at issue. *See EPROM* at 6, *citing Fischer & Porter Co. v. Int’l Trade Comm’n*, 831 F.2d 1574, 1576-77 (Fed. Cir. 1987).

2. Claim Construction

As set forth below, we modify the ALJ’s construction of “discharge position adjacent the discharge end wall” (asserted claims 8, 13), supply a construction of “comb . . . coupled to the comb drive” (asserted claims 31-33), and otherwise affirm the claim construction under review.

A. “comb drive”

The term appears in asserted claims 8, 13, and 31-33. The ALJ adopted the following construction: “a motor and gear train for driving the comb.” ID at 14. In reaching this conclusion, the ALJ found that the patent specification contains no disavowal that limits the claimed comb drive. He found that the reference in the specification to “worm drives” (JX-1 col. 8:9-12 (“The gear drive connecting motor 55 to shaft 41 is not subject to fouling by the litter, which often includes powdery material that is likely to interfere with operation of other drive mechanisms such as a worm drive.”)), read in the context of the entire patent, is “clearly secondary and equivocal at best.” ID at 20.

Complainants argue that the ALJ’s claim construction was correct and that the ALJ did not err in finding that the specification contains no disavowal that limits the claimed comb drive. *See, e.g.*, Complainants’ Br. at 29, 32-69.

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Respondents argue that the ALJ erred in finding no disavowal of the claimed “comb drive.” In their view, the disavowal extends not simply to any type of worm drive, but to any drive other than as identified in the preferred embodiment of the patent. Thus they argue that the correct construction of “comb drive” is a reversible electric motor mounted on and connected in driving relationship to the shaft through a gear train as found in the preferred embodiment. *See, e.g.,* Respondents’ Br. at 6-13; Respondents’ Resp. Br. at 9, 11-15.

The IA contends that the ALJ erred in finding no disavowal of worm drives. In his view, “comb drive” covers a motor and gear train, but not worm drives because they were disavowed in the specification. In his view, the disavowal covers all worm drives because that is what the patent specifically identified as not being part of the invention. *See, e.g.,* OUII Br. at 13-15.

We affirm the ALJ’s claim construction of “comb drive.” The claim language indicates that the “comb drive” is the structure for driving the comb, not all of the structure involved in moving and guiding the comb. Based on the claim language, the ALJ correctly tied the definition to the basic structure that performs a general drive function, at a minimum the motor in combination with a gear train. The ALJ properly declined to read limitations from the specification into the use of the term comb drive. ID at 15-16.

The more difficult question is whether the ALJ erred in finding no disavowal of the claimed comb drive in the specification. This is the first question the Commission put to the parties in its notice of review. The parties’ positions fall into three categories: no disavowal (Complainants), a disavowal of any drive (including all worm drives) other than that in the preferred embodiment (Respondents), and a disavowal of all worm drives (OUII). No party

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contends that there is a disavowal limited to the Carlisi drive, noted as prior art in the '847 patent, or gear drives subject to fouling by litter during operation.

Upon review, we conclude that the ALJ committed no error and affirm the finding of no disavowal. As the ALJ properly determined, claim scope cannot be disavowed unless the disavowal is clear and unequivocal. *See Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1310 (Fed. Cir. 2007). “[W]ords or expressions of manifest exclusion or ‘explicit’ disclaimer in the specification are necessary to disavow claim scope.” *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005). *See also Home Diagnostics, Inc. v. Lifescan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) (“Absent a clear disavowal or contrary definition in the specification or the prosecution history, the patentee is entitled to the full scope of its claim language.”).

The cornerstone of the argument for disavowal is the following language found in the specification discussing drawings that depict a certain kind of gear train. The specification states:

The gear drive connecting motor 55 to shaft 41 is not subject to fouling by the litter, which often includes powdery material that is likely to interfere with operation of other drive mechanisms such as a worm drive.

JX-1 at 8:9-12. The language is directed to the preferred embodiment and so finding this sentence to be a disavowal would limit the scope of the “comb drive” to the preferred gear drive. The plain language of the sentence compares the preferred gear drive to all other drive mechanisms, with the worm drive identified as one example. The evidence in the record, however, is that many types of drive mechanisms were known to persons of ordinary skill in the

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art at the time of the invention, including many different kinds of worm drives. Tr. at 322-24; CDX-372. Any alleged disavowal articulated by this sentence would therefore encompass all of these “other drive mechanisms.” As a result, the only drive mechanism that is not an “other” drive mechanism within the scope of the purported disavowal would be the preferred gear drive.

On its face, therefore, the sentence would not act as a disavowal that is limited to worm drives or to the Carlisi drive because the sentence literally precludes the possibility, and it cannot act as a disavowal of all other drives because that would improperly limit the claimed “comb drive” to the preferred embodiment. The Federal Circuit has repeatedly warned against restricting claims to the preferred embodiment. *See, e.g., Ventana Med. Sys., Inc. v. Biogenex Labs., Inc.*, 473 F.3d 1173, 1181 (Fed. Cir. 2006); *Johnson Worldwide Assoc., Inc. v. Zebco*, 175 F.3d 985, 992 (Fed. Cir. 1999). Even in the *Honeywell* case cited by Respondents in which a disavowal was found, the Court pointed out that the disavowal did not restrict the claims to the preferred embodiment.⁵ *Honeywell Int’l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1320 (Fed. Cir. 2006).

The sentence concerning gear drives instead describes an advantage of the preferred gear

⁵ *ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, ___ F.3d ___, 2009 WL 635630 (Fed. Cir. 2009), cited to us by Respondents on March 27, 2009, is not to the contrary. First, the case does not involve an alleged disavowal. Second, the specification of the patent at issue “repeatedly and uniformly” described the claim term “spike” as a “pointed instrument for the purpose of piecing a seal inside the valve.” The Court affirmed the district court’s construction of spike to be “an elongated structure having a pointed tip for piercing the seal, which tip may be sharp or slightly rounded.” *Id.* at *2-*4. The ‘847 patent specification, on the other hand, nowhere “repeatedly” or “uniformly” describes “comb drive” as a structure that excludes all other drive mechanisms including a worm drive. In fact, it does not even state this a single time.

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drive over other known drive mechanisms, including worm drives. It conveys that the preferred gear drive is not subject to fouling by litter, whereas litter may interfere with the operation of other drive mechanisms, such as worm drives. However, such a statement merely illustrates this embodiment's identification as the preferred embodiment, and does not clearly disavow all gear drives other than that in the preferred embodiment. *Cf. Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d at 1371 (“[a] patentee typically claims broadly enough to cover less preferred embodiments as well as more preferred embodiments, precisely to block competitors from marketing less than optimal versions of the claimed invention”); *id.* at 1374 (while four-bladed razors are a less preferred embodiment they are not excluded from the claim scope despite consistent reference to a three-bladed razor and criticism of other razor blade configurations with more than two blades); *N. Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281, 1292-93 (Fed. Cir. 2000) (while patent expressed a clear preference for reducing or eliminating “ion bombardment,” references to “ion bombardment” tended to evidence inclusion of that technique rather than exclusion).

In addition, the preferred gear drive sentence does not specifically identify the Carlisi prior art, or any other prior art reference for that matter. Nor does it even refer to the “comb drive,” which is the limitation whose scope is at issue. *Cf. Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1303 (Fed. Cir. 2007) (rejecting an invitation to limit a claim term based on a “discussion of the ‘present invention’” where the actual claim term was not specifically referenced).

Finally, Respondents' attempt to link the preferred gear drive sentence in the specification

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with other references in the patent to improvements of the “present invention” over the prior art is too attenuated and the statements cited too general to demonstrate the patentee’s manifest exclusion of certain gear drives. For example, the third paragraph in the background identifies improvements of the “present invention” over the prior art as follows:

The present invention provides effective improvement for the rake drive of the Carlisi device so that movement of the comb or rake through the litter can be made responsive to entry and exit of the cat from the litter box. . . . The invention also provides for improvements in the disposal receptacle, which may also serve as a container for new litter supply. Alarms are also provided for an insufficient litter supply and a full disposal receptacle.

JX-1 at col. 1:47-56. There is no mention in these statements of a disavowal of certain gear drives and, where Carlisi is specifically called out, it is in reference to the ‘847 patent invention’s responsiveness to cat exit, not the type of gears utilized in its drive system.

Similarly, the summary section contains four paragraphs identifying objects of the invention. The first, the “principal” object, is identified as an improved drive that is “directly responsive to the exit of a cat from the litter box.” JX-1 at col. 1:59-62. The second paragraph refers to the improvement that the drive does not operate on a periodical basis so that there is no substantial possibility that the comb mechanism will carry out a cleaning operation while a cat is present in the litter box. JX-1 at col. 1:63-2:2. The third paragraph states as follows:

Another object of the present invention is to provide a new and improved drive for an automated self-cleaning cat litter box that is simple and economical in construction and that can afford an extended operating life, requiring little or no attention apart from battery replacement.

JX-1 at col. 2:3-7.

While this language tracks language that appears in connection with the preferred gear

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drive sentence appearing later in the specification, it fails to support a disclaimer. JX-1 at col. 8:14-17. To the contrary, its generality and lack of any criticism of the gear drive used in Carlisi or any other prior art undermines Respondents' argument that the sentence that later refers to the gear drive of the preferred embodiment was intended to limit the invention to the preferred embodiment and operate as a complete surrender of known drive mechanisms. There is similarly no support for finding that the specification supports a more limited disclaimer that operates to exclude all worm drives, as the IA contends. The most that the preferred gear drive sentence could be read for is that the claimed comb drive excludes gear drives that are exposed to fouling by litter. Fouling by litter, after all, is the criticism in the preferred gear drive sentence, and glossing over it robs the provision of meaning.

We determine that the ALJ applied the proper legal standard and correctly concluded that there is no disavowal. Accordingly, we affirm his construction of the term "comb drive."

B. "comb drive means"

The term appears in asserted claim 27, 41 and 42. The ALJ adopted the following construction: the function is "driving the comb between the storage position and the discharge position;" the structure is "a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41" plus any equivalents of that structure. ID at 23.

Complainants argue that this term should be construed the same as "comb drive" – a motor and a gear train. They contend that the term is not a means-plus-function limitation under § 112, ¶ 6. They argue that even if § 112, ¶ 6 were to apply, the proper construction would be

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essentially the same, the motor and gear train plus equivalents thereof. *See, e.g.*, Complainants' Br. at 70-77.

Respondents contend that this is a means-plus-function limitation under § 112, ¶ 6 that is properly interpreted by looking to the specification. In their view, it should be construed as a reversible motor mounted on and connected in driving relationship to the shaft and gear train, plus, at a minimum, guide wheels and guide pins. *See, e.g.*, Respondents' Br. at 16-18; Respondents' Resp. Br. at 9-10, 16-21. The IA goes further, contending that this means-plus-function limitation also requires as part of the construction the tracks with apertures, and the guide wheels and pins. *See, e.g.*, OUII Br. at 14.

We conclude that the ALJ properly construed the disputed limitation as a means-plus-function claim under 35 U.S.C. § 112, ¶6. The patentee's use of the word "means," as the ALJ held, creates a presumption that the element is a means-plus-function element under § 112, ¶6. *See, e.g., Enviroco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed. Cir. 2000). We agree with the ALJ that Complainants have not rebutted that presumption. *See, e.g., Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997). The claim language does not identify sufficient structure to overcome the presumption. Complainants' own expert admitted as much on cross-examination, stating in relation to defining "comb drive" that it is necessary to look at the specification to understand it. *See* Tr. at 285 (Q. "So is it necessary to look at the specification to understand what the comb drive is?" A. "To me that is necessary, for one of ordinary skill in the art, they would have to look back at the spec to understand the ambiguity here to correct that."). Moreover, Complainants' argument that the term "comb drive

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means” should be equated with “comb drive” ignores the patentee’s use of very different terminology and his purposeful functional claiming. The patentee refers to comb drive “means” no fewer than three times in claim 27.

Construction of a limitation in means-plus-function form, as found here, requires the court to identify first the function of the means-plus-function limitation and, second, the corresponding structure in the specification necessary to perform that function. *See, e.g., BBA Nonwoven Simpsonville, Inc. v. Superior Nonwovens, LLC*, 303 F.3d 1332, 1343-44 (Fed. Cir. 2002). In the event the court is unable to elucidate a corresponding structure from the specification or claim in a means-plus-function format, that claim fails for indefiniteness. *See, e.g., Aristocrat Techs. Austl. PTY Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1338 (Fed. Cir. 2008).

The ALJ properly identified the function here: “driving the comb between the storage position and the discharge position.” JX-1 at 13:28-29. Turning to what is specifically disclosed in the specification, which the statutory doctrine requires, the ALJ found that the corresponding structure is all elements or equivalents of the following description: “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41.”⁶ ID at 23. Had the patentee not wished to include this

⁶ Specifically, the specification states that:

The improved self-cleaning cat litter box 20, FIGS. 1-3, includes a comb drive that comprises a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 that supports comb 43; the final gear 57 of the gear train that connects motor 55 to shaft 41 is the only gear that appears in the drawings, FIGS. 1-3.

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structure within the claim limitations, he could have elected not to use the functional claiming. Instead, he elected to claim by function. We therefore find that Complainants' allegation of error is not demonstrated.

We also find that the ALJ's claim construction is not too broad for failure to include the various additional items the Respondents and IA propose. All are referred to in the specification, but were rejected by the ALJ as improperly importing limitations into the claim because they are unnecessary to drive the comb. He finds that they are part of the guidance system and provide no driving force to the comb. ID at 23; *see also id.* at 15-16 (differentiating between the two functions). That finding appears well-supported by the claim language and specification language, as well as expert testimony the ALJ appears to have credited at least in part, differentiating between drive and guide functions in the specified system. We note, however, that the patent itself uses "drive" or "guide" to refer to the wheels with pins that travel on the track. In un-asserted claim 10, the wheels are referred to as "drive wheels," and the pins are referred to as "drive pins." JX-1 at 10:56-57, 59-60.⁷ The parties were asked to comment on whether these wheels performed different functions.⁸ We agree with Complainants that even if

JX-1 at 3:31-36. Per the specification, the shaft is clearly included in the corresponding structure for performing the identified function of driving the comb between a storage position and discharge position.

⁷ The abstract also refers to "drive wheels": "In the improved construction the comb path refers includes multi-perforate track members on opposite sides of the litter chamber; those tracks are engaged by rotatable drive wheels connected to the comb."

⁸ Complainants responded that the drive wheels and guide wheels are presumed to have different functions, but identified none. They also argued that, in any event, there is no evidence that the guide wheels or "drive wheels" supply driving force. *See, e.g.,* Complainants' Br. at 77-

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the terms are used interchangeably in parts of the patent, there is no evidence that these guide wheels or “drive wheels” supply driving force. The ALJ, in our view, properly declined to include in the “comb drive means” limitation the guide wheels or “drive wheels.”

We therefore affirm the ALJ’s construction of “comb drive means.”

C. “drive means”

The term appears in asserted claims 24-25. Applying 35 U.S.C. § 112, ¶6, the ALJ adopted the following construction: the function is “driving the moving means between the storage position and the discharge position;” the structure is “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure. ID at 25-26.

Complainants argue that the ALJ properly found that this was a means-plus-function limitation under § 112, ¶ 6, but that he improperly read in limitations from the preferred embodiment. The correct construction, they contend, is a motor and gear train plus equivalents thereof. *See, e.g.*, Complainants’ Br. at 80-81. Respondents argue that the ALJ’s definition should be affirmed. *See, e.g.*, Respondents’ Br. at 115. The IA argued that the term should be construed similarly to the IA’s proposed construction of comb drive means, and therefore is erroneous for the same reasons. *See, e.g.*, OUII Pet. at 19.

No party contests that the ALJ correctly construed this limitation as a means-plus-

80. Respondents argued that there is no difference in function between the referenced guide and drive wheels. They also argue that the patent does not distinguish between the drive and guide systems in that components are shared for both functions. *See, e.g.*, Respondents’ Br. at 18-22. The IA argued the guide wheels and drive wheels appear co-extensive. OUII Br. at 15.

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function limitation under § 112 , ¶ 6. No party argues that the ALJ mis-identified the function for the driving means, which tracks the function identified for the “comb drive means” limitation. Complainants and the IA also similarly argue that the correct construction of the structure should be the same as with the “comb drive means” limitation. We find no error in the ALJ’s identification of the function for the driving means, nor in his determination that the structure in the specification that corresponds to this function is, similar to his construction with respect to “comb drive means,” the same reversible electric motor mounted on and connected in driving relationship to the shaft and the gear train that connects the motor to the shaft, plus any equivalents. We therefore affirm the ALJ’s construction.

D. “discharge position adjacent the discharge end wall”

The ALJ adopted a dictionary definition to construe the term “adjacent,” stating as follows in quoting from the definition found in the Webster’s New Collegiate Dictionary (1979 ed.): “‘not distant: NEARBY,’ with synonyms being ‘ADJOINING, CONTIGUOUS, ABUTTING, AND COTERMINUS’.” ID at 143-44.

Complainants argue that the term “discharge position adjacent the discharge end wall” means a discharge position for the comb that is not distant from the adjacent end wall, thus eliminating the synonyms to which they object. In their view, when properly construed this limitation is met in the OurPet’s product. *See, e.g.*, Complainants’ Br. at 81-86; 159-61; Complainants’ Resp. Br. at 48-50, 91-101.

Respondents argue that the term was properly construed and means that the final position of the comb upon discharge of the litter is not distant or is nearby the wall at the opposite end of

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the litter box from the storage end wall and toward which the comb is driven on its way to the comb discharge position. They contend that the ALJ did not apply the synonyms in reaching his fully supported conclusion that this limitation is not met in the OurPet's product. They further contend that there is no infringement under any reasonable construction of "adjacent." *See, e.g.*, Respondents' Br. at 24-28; Respondents' Resp. Br. at 10, 103-08.

The IA takes the same position as Respondents, stating that the ALJ's findings of no literal infringement and no infringement under a doctrine of equivalents should be affirmed. *See, e.g.*, OUII Br. at 16-18.

We determine to revise the ALJ's claim construction to strike the synonyms. As set forth in our infringement discussion below, however, we affirm the ALJ's finding of non-infringement because his factual findings are well-supported even under this new construction, which is the construction it appears he applied in any event, notwithstanding his initial reference to the objectionable synonyms.

The difference between "nearby" and, for example, "adjoining," may in theory be significant, and the context provided by the '847 patent seems to point to a definition that does not include the cited synonyms. For example, the specification qualifies the term "adjacent" with a restrictive modifier when it describes an abutting, adjoining, or contiguous relationship between components. Thus, when the specification refers to the preferred embodiment's waste receptacle 68 at the discharge end of the litter box, it states that the receptacle is "positioned *immediately adjacent* the discharge end 28 of the litter box." JX-1 at 3:62-66 (emphasis supplied). Similarly, in describing the position of the comb 43 when the return movement is

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finished in the preferred embodiment, the specification states: “When comb 43 has finished its movement back to the point *closely adjacent* to storage end wall 25, its two main guide wheels 52 and 53 encounter the steeply inclined upward extensions 36 and 37 of tracks 32 and 33.” JX-1 at 6:39-42 (emphasis supplied). In both examples, the use of the restrictive modifier describes structures in abutting, adjoining, or contiguous relationship. JX-1 at Figures 2-3. This shows, as Complainants’ argue, that “adjacent” without a restrictive modifier, as used in the claim language, is intended to describe more broadly the positional relationship of the subject structures than the cited synonyms imply, and that the ordinary meaning of “nearby or not distant” is correct. *Cf. Free Motion Fitness, Inc. v. Cybex Int’l Inc.*, 423 F.3d 1343, 1349 (Fed. Cir. 2005) (finding patent specification at issue “most consistent with defining adjacent to mean ‘not distant’” rather than a more restrictive definition).

On the other hand, Complainants go too far in arguing that “fixed switch actuation pin 62,” identified in figures 1-3, is described as “adjacent” the comb storage end. The patent describes two pins that help the carriage to stop as it traverses back and forth across the litter pan:

A first switch actuation pin 61 is located *adjacent* the comb storage end 29 of litter box 20. A similar fixed switch actuation pin 62 is positioned *at* the other end, the discharge end 28, of litter box 20.

JX-1 at col. 3:46-49 (emphasis supplied). The first pin 61 is described as “adjacent,” whereas the second pin 62 is described as “at” the discharge end, where the comb ultimately comes to deposit the waste it has scooped. Therefore, “adjacent” is not used to describe the location of fixed actuation pin 62. The plain fact is that pin 61, which is described as “adjacent” the comb storage end is directly next to storage end 29. Pin 62, on the other hand, is located toward the far end,

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but not immediately next to the far end wall and, in this location, is not described as “adjacent.” Respondents go so far as to suggest that this location is therefore not “adjacent” the discharge end wall. The most that can be said is that because pin 62 is not described in the patent as “adjacent” to anything, its position relative to the rear portion of the carriage when the carriage is in the discharge position has no direct bearing on the factual question of whether or not the SmartScoop comb is adjacent the discharge end wall.

For these reasons, we revise the ALJ’s construction to delete the referenced synonyms. The correct construction of the term “adjacent” in the limitation “discharge position adjacent the discharge end wall” is “not distant: nearby.”

E. “comb . . . coupled to the comb drive”

This term appears in asserted claims 31-33. One of the grounds on which the ALJ found that the SmartScoop does not infringe independent claim 31 and dependent claim 32 is that it does not contain a comb “coupled to a comb drive.” ID at 165, 167, 168. The ALJ found that while the comb in the SmartScoop is connected to the comb drive, it is only “indirectly” connected. He describes it as being “three steps removed” because it takes three steps to assemble the components parts of the comb drive element, the carriage, and the comb. ID at 167. Although claim 33 contains the same limitation, the ALJ found that the SmartScoop infringed claim 33. ID at 175.

Complainants argue the ALJ erred in his claim construction. They contend that “comb . . . coupled to the comb drive” means any comb that is connected, directly or indirectly, to the comb drive. A construction of “coupled to” that limits the claim language to combs that are only

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directly connected to the comb drive is contrary to the ordinary meaning of that phrase, and excludes the preferred embodiment disclosed in the '847 patent. *See, e.g.*, Complainants' Br. at 86-88. They contend the SmartScoop meets this limitation if properly construed. They also argue that the ALJ erred in failing to perform the same infringement analysis for 33 as he did for claim 31 (and dependent claim 32). *See, e.g.*, Complainants' Br. at 21-22, 121-26.

Respondents argue that the term was properly construed by the ALJ to the extent he used the ordinary meaning of the word "coupled." They contend that the limitation is not met under any reasonable construction of the term "coupled," even when considering that "coupled" could include an indirect connection. In their view, the ALJ erred in failing to apply the same infringement analysis to claim 33 that he applied to claim 31 (and dependent claim 32) to find the SmartScoop products did not infringe claim 33. *See, e.g.*, Respondents' Br. at 29-35; Respondents' Resp. Br. at 10, 31-32, 73, 75-76.

The IA concurs with the others that the ALJ erred in not performing the same infringement analysis for claims 31-33. He argues that Complainants' proposed construction is too broad such that it unfairly reads on the accused devices. In his view, the ALJ correctly applied claims 31 and 32 to the accused products to find that they do not read on the accused device. *See, e.g.*, OUII Br. at 18-19.

The only point on which the parties agree is that the same infringement analysis should apply regarding the "comb . . . coupled to the comb drive" limitation that appears in each of claims 31, 32, and 33. These claims refer to "a comb extending between two opposed sidewalls and being coupled to the comb drive" JX-1 at 13:66-67 (claim 31 and 32) & 14:15-16

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(claim 33). The ID's findings that the OurPet's product infringes claim 33 and yet does not meet this limitation in claim 31 and 32 are inconsistent. The parties have not attempted to harmonize these findings, and we see no justification or support for doing so. In terms of the ID's inconsistent analyses, therefore, we agree with the parties that there was error.

We also agree with Complainants that a construction of "coupled to" that limits the claim language to combs that are only *directly* connected to the comb drive is contrary to the ordinary meaning of "coupled to," and would exclude the preferred embodiment disclosed in the patent. The claim language does not say "directly coupled to." Instead, the '847 patent uses the broad and general term "couple." The ordinary meaning of this term is not limited to "directly coupled" and instead extends to a direct or indirect connection, a point Respondents and the IA appear to concede. *See, e.g., The American Heritage College Dictionary* (3d ed.) at 318 ("to link together; connect"). This is consistent with how the Commission and courts have construed the ordinary meaning of "coupled to" in other cases. *See, e.g., Certain Power Supply Controllers and Prods. Containing Same*, Inv. No. 337-TA-541, unreviewed Final Initial and Recommended Determinations, at 30 (July 18, 2006) (Luckern, J.) (finding that "one of ordinary skill in the art would construe the claim phrase 'couple' to mean that a direct or indirect connection exists in order to be able to perform specific activities or actions."); *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d at 992 ("the unmodified term 'coupled' generically describes a connection"); *Silicon Graphics, Inc. v. nVidia Corp.*, 58 F. Supp. 2d 331, 346 (D.Del. 1999) (finding that the ordinary meaning of the term "couple" is "coupled or connected, directly or indirectly").

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The specification confirms that “coupled to” has its ordinary meaning in the claims at issue and extends to indirect connections. In the preferred embodiment of the ‘847 patent, the comb is indirectly coupled to the comb drive through the hangers 42 and shaft 41. JX-1 at Fig. 2. Specifically, the final gear 57 is connected to the shaft 41, JX-1 at 3:34-36, which is connected to hangers 42, JX-1 at 3:6-9, which are connected to comb 43. JX-1 at 3:9. If a direct connection were required, the preferred embodiment would be excluded from the claim. *See Pfizer, Inc. v. Teva Pharmaceuticals, USA, Inc.*, 429 F.3d 1364, 1374 (Fed. Cir. 2005) (a construction that excludes a preferred embodiment is “rarely, if ever, correct.”).

A construction of “coupled to” that covers both direct and indirect connections of the comb and comb drive is therefore consistent with both the well-established ordinary meaning of “coupled to” and the ‘847 patent specification. The correct construction of the claim term is, accordingly, “coupled or connected, directly or indirectly.”

The ID, on the other hand, contains no formal construction and its reasoning suggests that the ALJ applied a narrower understanding of the claim term to claims 31 and 32. Specifically, the ID states that, “[b]ecause the comb is indirectly connected to the comb drive and is three steps removed from a direct connection to the comb drive itself, I find that it is not coupled to the comb drive.” ID at 167. The ID effectively supplied a claim construction that requires a direct connection. We reject this construction as erroneous and find that the correct construction of the limitation is “coupled or connected, directly or indirectly.” We also find error in the ID’s failure to apply the same analysis of the “coupled to” limitation in claims 31-32 and claim 33.

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F. “mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position”

The ALJ adopted the following construction: “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.” ID at 44.⁹ In reaching this construction, he rejected the narrower construction proposed by the Respondents and the IA, *i.e.*, that each of the switch positions must be stationary so that the switch remains in that position while in the selected mode. He cites and discusses *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261 (Fed. Cir. 1999) in his analysis. ID at 45-46.

Complainants argue that the ALJ’s claim construction regarding the switch element of claim 33 is correct and that he properly applied his construction to make his finding that claim 33 is infringed by the accused products. In Complainants’ view, the ALJ’s reliance in part on *Overhead Door* to support his analysis was reasonable and warranted. *See, e.g.*, Complainants’ Br. at 25-28, 88-113, 126-156.

Respondents argue that the mode selector switch must have two discrete and spatially separated positions, one for manual operation and one for automatic operation. They contend that the ALJ erred in declining to limit the switch of claim 33 to a switch having two distinct

⁹ With respect to the term “manual operation position,” the ALJ adopted the following construction: “a position of the mode selector switch where combing is initiated in response to human-based input.” ID at 47. With respect to the term “automatic operation position,” the ALJ adopted the following construction: “a position of the mode selector switch where combing is initiated in response to a cat exit.” ID at 48. We did not determine to review the ALJ’s construction of either term.

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spatial positions. Applying the correct claim construction, they contend, results in the conclusion that none of the accused devices meets the mode selector switch limitation because their switches are not moveable between two positions. They argue that the ALJ improperly relied on the *Overhead Door* case in his claim construction and infringement analyses. *See, e.g.*, Respondents' Br. at 50-64; Respondents' Resp. Br. at 10, 34-35, 76-81.

The IA contends that the plain language of the "mode selector switch" element requires that the switch be spatially changeable with one location of the switch relating to manual operation and the second location relating to automatic operation. He argues that it was error for the ALJ to adopt a broader construction of the switch element not requiring this spatial movement, and further that the *Overhead Door* case is distinguishable and should not have been relied on by the ALJ. *See, e.g.*, OUII Br. at 22-23.

We find that the ALJ's claim construction is correct. The intrinsic evidence, not *Overhead Door*, supplies the claim construction.

The ALJ properly rejected Respondents' and the IA's effort to read limitations into the claim that exclude push button or momentary switches, or that require the switch to remain in a stationary, set position during a combing operation. At the time of the invention, many types of switches were well-known, including push button switches. *See, e.g.*, Tr. at 268, 463-64; CX-893C at Q. 365; CX-894C at Q. 210-11. In fact, Mr. Waters used a push button switch (which he referred to as a "momentary switch" in his testimony) in the prototype that served as the basis for the '847 patent. Tr. at 567-69; CX-894C at Q. 211. A push button or momentary switch moves to one position to initiate a manual operation and then immediately returns to the other position.

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See RX-233C at Q. 60. It is not a switch with a stationary position.

Reading the plain language of the claim, the ALJ correctly found that it does not include “any limitation requiring the switch positions to be stationary.” ID at 44. The language “switch” being “moveable between” manual and automatic positions, literally requires nothing more than that the switch be moveable between two positions, one for “manual operation” and the other for “automatic operation.” The plain language of the claim therefore does not indicate that a push button switch is excluded, or that a switch must remain stationary for the combing operation.

Nor does the specification of the ‘847 patent redefine the terms to exclude a push button or momentary switch. *See* ID at 45 (ALJ noting that the specification does not limit the claim to require the switch position to be stationary). *See also* ID at 46 (“The intrinsic evidence does not demonstrate the patentee’s intent to deviate from the plain language of the claims.”). The specification contains *no* language restricting the structure of the “mode select switch.” *See, e.g.*, Fig. 5 at item 91 (block diagram of preferred embodiment representing actual structure and information flow; item 91 represents “mode select switch”).

Instead, the specification makes clear that the “switch . . . moveable between” claim language refers to the position of the switch upon initiation or actuation of a manual or automatic operation, not its position during a combing operation. The ‘847 patent specification contains numerous references indicating that the switch is for actuating or initiating an operation. *See, e.g.*, JX-1 at 5:27-35 (referring to “actuation of a self-cleaning operation”); 7:14-16 (referring to “actuation of a self-cleaning operation”); 7:20-24 (referring to “initiation” of comb litter procedure when switch is set for manual mode). The switch could not be required to remain in a

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set, stationary position throughout an entire cleaning operation when the intrinsic evidence demonstrates that the focus of the claim is on the position of the switch when combing is initiated.

No part of the specification supports Respondents' proffered claim construction. Relying upon figure 7 and its accompanying description, Respondents originally argued that the specification requires that the invention, when in the manual operation position, comb on a cyclical basis. As the ALJ found, however, the '847 patent is clear that manual operation includes the initiation of a single operation comb litter operation and is not limited to cycling of the comb. ID at 35-36. The ALJ found that Respondents had misread the cited passage, and that in the context of the description of Figure 7, it actually shows that "manual mode" can be a single comb litter operation. ID at 36. Respondents point to the same provision of the specification they had misread in an effort to limit the "manual operation position" to cyclical raking, and offer a variation on the argument. They contend on review that the specification says the switch is "set" and "that the manual mode may be 'maintained.'" Respondents' Br. at 54, *referring to JX-1* at 7:14-29. From this they conclude that for a switch to be set, it must have a stationary position. *Id.* The contention is unpersuasive. As the Respondents appear to recognize, at most the provision discloses that a manual mode "may be maintained." What this means is that the manual mode may, *or may not*, be maintained. ID at 35. Manual mode is not maintained, for example, when a single litter operation is initiated. In that case, the mode selector switch is "set" for manual mode when it is moved to the position that causes initiation of a manual cleaning operation. In the case of a push button or momentary switch, for example, moving the switch to

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the down position “sets” the initiation of a manual cleaning operation, even though the switch then returns to the up position. Respondents’ construction is therefore untenable under a proper reading of the specification.

Neither the claim language nor the specification therefore requires each switch position to be stationary or fails to encompass a push button or momentary switch. Moreover, the prosecution history the Respondents cite, as the ALJ concludes, “merely re-states the claim language found in claim 33 and does not add any further limitation to the claim.” ID at 126. *Cf.* JX-1 at 14:22-28 with JX-2 at 375-76. As the ALJ found, the fact that “switch” and “moveable” are underlined in the cited prosecution history does not indicate that push button switches are excluded, or that the switch must remain in a stationary position during the combing operation.

Citing *Overhead Door* as supportive of this claim construction is not improper. In that case, the Federal Circuit addressed the issue of whether a push-button, momentary switch literally met claim language that required “a switch moveable between program and operate positions” *Id.* at 1265, 1273-74. The Court held that the district court correctly construed this element as a “moveable[] switch connected to the microprocessor having at least two positions.” *Id.* at 1273-74. Similar to Respondents here, the accused infringer argued that its momentary switch “does not have an operate position, the program position is not stationary, and the switch does not permit the user to select the ‘operate’ mode.” *Id.* at 1274. The Court rejected this contention, affirming a finding that the subject “two-position, spring-loaded, push-button switch” satisfied the “switch moveable between” limitation. *Id.* *Overhead Door* is therefore consistent with the ALJ’s construction based on the record in this case, although it clearly does

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not dictate the result reached.

Accordingly, we affirm the ALJ's construction of "mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position," to mean "a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions."¹⁰

3. Infringement

For the reasons set forth below, we affirm the ALJ's finding that the Lucky Litter and OurPet's products infringe claim 33 based on, *inter alia*, the additional ground that "the comb . . . coupled to the comb drive" limitation reads on the accused products. We affirm the finding against Lucky Litter of contributory infringement. And we affirm, with the modifications identified, the findings that other asserted claims were not infringed.

A. Claim 33

Independent claim 33 provides as follows:

A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb drive coupled to the housing;

a comb extending between two opposed sidewalls and being

¹⁰ On review, the parties have advanced arguments regarding the correct construction of other claim terms that we determined not to review, such as "automatic operation position" in claim 33 and "motor mounted on the carriage" in claims 8 and 13. While these and other challenges are preserved by the parties' petitions for review, the parties have presented no basis for us to reconsider our determination not to review these claim terms.

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coupled to the comb drive and movable between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position wherein an operator causes the comb to move toward the discharge position and an automatic operation position wherein the comb moves toward the discharge position automatically upon the occurrence of a predetermined event.

JX-1 at 14:10-28.

Complainants argue that the ALJ's findings that Lucky Litter and OurPet's infringe claim 33 should be affirmed. Turning to the disputed claim terms, they contend that the accused devices have a "comb drive" and a "comb . . . coupled to the comb drive," and also have all components of the "mode selector switch" element of claim 33. *See, e.g.*, Complainants' Br. at 115-56.

Respondents seek a reversal of the ALJ's findings of infringement of claim 33. They argue that claim 33 is not infringed by the SmartScoop or Lucky Litter ScoopFree devices. They contend that neither device contains a "comb drive" under the correct construction of the term. They also argue that the ALJ properly found that OurPet's Smartscoop does not contain a "comb . . . coupled to the comb drive" for purposes of claim 31 and the same finding should apply to claim 33. Finally, they argue that neither the SmartScoop nor ScoopFree devices has a "mode selector switch . . . being moveable between a manual operation position and an automatic operation position." *See, e.g.*, Respondents' Br. at 22-24, 28-35, 50-51, 56-60, 62-64;

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Respondents' Resp. Br. at 73-81.

The IA argues that the ALJ's findings that Lucky Litter and OurPet's infringe claim 33 should be reversed. He argues that under the correct construction of "comb drive" and of the "mode selector switch" limitation, the accused products do not infringe claim 33. He also argues that the OurPet's device does not contain a "comb . . . coupled to the comb drive" under the term's correct construction. *See, e.g.*, OUII Br. at 16, 18-19; OUII Pet. at 17, 33, 40.

We determine that the findings of infringement of claim 33 by the ScoopFree and SmartScoop products should be affirmed based on a finding that the "comb . . . coupled to the comb drive" element is present in the accused devices.

First, we have affirmed the ALJ's construction of the "comb drive" element of claim 33, including his rejection of Respondents' and the IA's arguments that certain drives were disavowed by the patentee in the '847 patent. The accused devices indisputably contain a comb drive under the construction we affirm – a motor and gear train for driving the comb. Moreover, we note that we would reach the same finding on infringement even if the specification were construed to effect a disavowal. As noted in our claim construction analysis, if, contrary to our construction, the preferred gear drive sentence constituted a disavowal, it would be of gear drives exposed to fouling by litter only. However, the facts clearly show, and we therefore find, alternatively, that the comb drives in the Lucky Litter and the OurPets' products – the motors or their gear trains – are *not* subject to fouling by litter. *See, e.g.*, Tr. at 736-37, 816; RX197C Q. 53 (Lucky Litter products); JX-10C at 70-71 (OurPet's products). The design of the comb drives in these products eliminates exposure to, much less fouling by, litter. Thus, even if, contrary to our

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finding, the patentee disavowed certain comb drives, the scope of the disavowal would not extend to the accused products. Accordingly, the comb drive limitation of claim 33 is met in the accused devices.

Second, we have found that the ALJ erred in failing to consider the “comb . . . coupled to the comb drive” element in his analysis of whether the SmartScoop devices infringe claim 33. Applying the correct claim construction to the record on infringement leads us to make the factual finding that this claim element is present in the SmartScoop. The comb drive is contained in the motor unit housing. CPX-49. (CDX-70 includes a color photo that shows the inside of the motor unit housing with the cover removed.) The motor unit housing is connected to the carriage, CPX-37, which in the SmartScoop also holds the waste unit. The carriage is connected to the comb. CPX-38.

In assembling the product, the motor unit housing is mounted on the litter box. CX-137/RX-140 at 6-7. After the motor unit housing is mounted on the litter box, the carriage is then assembled and connects to the motor unit housing. *Id.* at 8. Latches engage between the motor unit housing and the carriage, which partially sits on the motor unit housing. *Id.* The comb is then assembled with and connected to the carriage. *Id.*

Therefore, the comb drive is connected to the comb through the motor unit housing and the carriage. While this connection is indirect in that the comb is, as the ALJ found, “three steps removed” from the comb drive, the comb drive and comb are no less “coupled to” each other within the ordinary meaning of the term. In fact, they are not unlike the preferred embodiment, which presents this coupling at two removes, inserting a shaft and hangers between the comb and

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comb drive. Adding an additional remove between the comb and comb drive does not break the requisite link to show “coupled to.” The connection between the comb and comb drive in the SmartScoop products, albeit involving several steps and thus indirect, is plain and clear, and without it, the comb would not rotate or move at all. The comb drive of the SmartScoop drives the comb of that product by way of the clear connection between the two structures. We find that these structures are “coupled to” one another and, therefore, find that the “comb . . . coupled to the comb drive” limitation is present in the SmartScoop products.

Lucky Litter has not argued that its device does not meet the “comb . . . coupled to the comb drive” limitation, and the evidence is clear that it does. The ScoopFree comb is coupled to the comb drive as follows: the comb drive is connected to the lead screw, the lead screw is connected to a nut, and the nut is connected to the comb. *See* RX-11-13, 16-17; CDX-35. *See also* RX-233C at Q. 40 (describing the connection between the ScoopFree comb drive and one of the lead screws), 41 (describing the connection between the lead screws and the nuts), 43, 51 (describing the connection between the nuts and the rake) (“A rake subassembly is attached to the two nuts in the lead screw drive . . . When the motor is operated, the worm gear transmission turns the lead screws. When the lead screws turn, the nuts and rake subassembly move linearly along the mechanism subassembly.”); CX-893C at Q. 345 (“The coupling between the comb and comb drive as represented in this demonstrative is through the nut follower, the lead screw, pulley and belt components as part of the cat litter box.”). Thus, we find that this element is present in both the Lucky Litter and SmartScoop devices.

Third, we have affirmed the ALJ’s construction of the “mode selector switch” limitation.

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Based on the construction he adopted, we affirm his findings of fact determining that the claim limitation is met. With respect to the Lucky Litter ScoopFree products, the ALJ reasonably concluded that the switch is “moveable between” the “manual operation position” and the “automatic operation position.” The switch is a cycle button and an example of one is marked as CPX-28. It must be physically held in the “down” position to make contact, and as soon as it is released, it returns to the “up” position. ID at 125; RX233C at Q. 60. The ALJ reasonably determined that in the “up” position, which is the default position, the cycle button is in automatic operation mode. ID at 125. There was no dispute that in this mode the ScoopFree products comb in response to a cat exit. ID at 127; CPX-12 at 1; Tr. at 464-65; RX-233C at Q. 59. The evidence showed that when the ScoopFree product is powered on, it is configured for automatic operation. ID at 125; RX-233C at Q. 61. When a user presses the cycle button to its “down” position, the unit is put into manual mode, where combing is initiated in response to human-based input. The ALJ reasonably determined that this is the manual operation position. ID at 125; CX-893C at Qs. 366-74. This position causes the unit to cycle once, following which it returns to an automatic mode. ID at 117. Based on these well-supported underlying findings, the ALJ reasonably concluded, therefore, that the cycle button in the Lucky Litter product is a switch that is “moveable between” the “manual operation position” and the “automatic operation position.” Expert testimony further supported this conclusion. CX-893C at Q. 368.

Similarly, with respect to the OurPet’s SmartScoop device, the ALJ reasonably concluded that it “possesses a switch that is moveable between a manual operation position and an automatic operation position” ID at 175. An example of this switch is marked as CPX-27.

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In the SmartScoop, this button is referred to as the “power” switch. The evidence showed that the button on the SmartScoop called the “power” switch is the mode selector switch. ID at 174. As the ID found, when pressed a first time, this switch causes the SmartScoop to go into a manual operation mode in which a cleaning cycle occurs in response to the human input of pressing the momentary switch. ID at 174-75; JX-19C at 90, 75-76. Immediately upon completing the connection calling for a manual cleaning cycle, the switch returns to its “up” position and allows the SmartScoop processor to assume an automatic operation mode, in which it waits for an infrared sensor to inform it that a cat has exited the litter box. ID at 174-75; JX-8C at 37, 88; JX-19C at 103-05; JX-10C at 157-58. At that point, the SmartScoop automatically initiates a delay of 10-15 minutes, after which the cleaning cycle is initiated. ID at 175; CPX-40 at 4; JX-19C at 179. Once the SmartScoop is in automatic operation mode, one need only press the switch twice – first, to put it into its “waiting” mode, and a second time to put it into the manual operation mode. ID at 174-75; JX-19C at 125-26, 179; JX-8C at 59-62, 89-90. Thus, the switch can be moved from its “up” automatic operation position to a “down” manual operation position by pressing it twice.

Based on his well-supported underlying findings, the ALJ reasonably concluded, therefore, that the cycle button in the OurPet’s product is a switch that is “moveable between” the “manual operation position” and the “automatic operation position.” Expert testimony further supported his conclusion. CX-893 at Qs. 803-05.

OurPets contends, however, that its products really have only one mode for cleaning a box – “the comb cycles through the box in response to the push of a button by a user and then

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waits to move again following the entry and exit of an object,” Respondents’ Resp. Br. at 78, but this conflates the two modes of operation into one. Manual mode of operation is literally where combing is initiated in response to human-based input – an operator pressing the switch down. Automatic operation mode is literally where combing is in response to cat exit, which is what takes place once the comb has swept through the litter – the device waits to sweep again upon sensing the arrival and departure of a cat. The record thus supports the ALJ’s conclusion. We therefore affirm the ALJ’s findings that the “mode selector switch” limitation of claim 33 is met in the Lucky Litter and OurPet’s products.

Based on our infringement analysis with respect to the disputed claim terms in claim 33 under review, “comb drive,” “comb . . . coupled to the comb drive,” and the “mode selector switch” set out above, we conclude that each of these elements is present in the accused products. Except as discussed above, the parties have failed to demonstrate error in the ALJ’s ultimate findings that the Lucky Litter and OurPet’s products infringe claim 33. Our review of the record satisfies us that Complainants have met their burden of proving infringement. We therefore affirm the ALJ’s ultimate findings that both the OurPet’s SmartScoop and Lucky Litter ScoopFree automatic litter boxes infringe claim 33 of the ‘847 patent.

B. Contributory Infringement

The ALJ found that Lucky Litter engaged in contributory infringement of the ‘847 patent under 35 U.S.C. § 271(c) through the importation and sale of replacement cartridges that are combined with the frame of the ScoopFree self-cleaning litter box. ID at 130-33.

Lucky Litter argues that the Commission should reverse the ALJ’s determination that

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Lucky Litter's importation and sale of ScoopFree disposable cartridges constitutes contributory infringement. Lucky Litter argues first that it may not be held liable for contributory infringement because its ScoopFree devices do not directly infringe the '847 patent. Lucky Litter further argues that the finding that its disposable litter cartridges have no substantial non-infringing uses is clearly erroneous. *See, e.g.*, Respondent's Br. at 64-66; Respondents' Resp. Br. at 94-96. Complainants argue that there was no error and the finding of contributory infringement should be affirmed. *See, e.g.*, Complainants' Br. at 171-77.

In light of our determination to affirm the finding of direct infringement of claim 33 by Lucky Litter, Lucky Litter's first argument lacks merit. *See, e.g., Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774 (Fed. Cir. 1993) ("Liability for . . . contributory infringement is dependent upon the existence of direct infringement."). We also reject Lucky Litter's second argument.

The ALJ reasonably found that Lucky Litter's planned future use of cartridges in the ScoopFree Slide, a manual litter box, did not qualify as a substantial non-infringing use. ID at 132. Lucky Litter has not pointed to any evidence of an actual use of replacement cartridges in the ScoopFree Slide by anyone, instead arguing that the evidence showed that the ScoopFree Slide "would be on the market by the end of the year." Respondents therefore have no record evidence of actual use of the replacement cartridge with the ScoopFree Slide. Absent evidence of actual use that qualifies as a substantial non-infringing use, the ALJ reasonably rejected Respondents' allegation that the proposed ScoopFree Slide is a substantial non-infringing use. *See Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1379 (Fed. Cir. 1991) (upholding a finding of non-substantial use where there was a lack of "any actual uses" that were

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non-infringing). The ALJ gave full consideration to Lucky Litter's other allegations regarding purported non-infringing uses and rejected those allegations based on his reasonable weighing of the evidence and credibility determinations. ID at 132-33. We affirm his finding of contributory infringement by Lucky Litter.

C. Other Infringement Findings

1. Claims 31-32

Complainants asserted claim 31 against OurPet's, and the ALJ found that the claim was not infringed, in part because the "comb . . . coupled to the comb drive" limitation was not met in OurPet's device. He also found that the OurPet's device did not meet the limitation of a "comb drive including a drive motor mounted on the carriage" in claim 31, ID at 164-67, which claim construction and infringement finding are not under review. The ALJ further found that because the SmartScoop products do not infringe claim 31, they do not infringe dependent claim 32. ID at 168.

Based on our determination on review that SmartScoop meets the "comb . . . coupled to the comb drive" limitation, as discussed in connection with claim 33, this limitation does not serve as a basis for finding non-infringement by OurPet's of claims 31 and 32. We nevertheless affirm the ALJ's findings of non-infringement of claims 31 and 32 because they are supported by the unreviewed finding that SmartScoop does not meet the limitation "comb drive including a drive motor mounted on the carriage."

2. Claims 8 and 13

The ALJ found that claims 8 and 13, which Complainants asserted against OurPet's, were

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also not infringed. He found that the elements in claim 8 of a “discharge position adjacent the discharge end wall” and of a “reversible motor . . . mounted on the carriage” were not present in the SmartScoop, and it followed that dependent claim 13 was also not infringed. ID at 141-48. We have revised the ALJ’s construction of the “discharge position adjacent the discharge end wall” limitation to eliminate the synonyms he cited that unduly narrow the term “adjacent.”

With respect to this limitation, the ALJ considered whether it was met against the record evidence and concluded that it was not. First he found that the term discharge position clearly refers to the final position of the comb upon discharge of the litter. The next movement contemplated in the patent is “. . . back to the storage position.” ID at 143 *quoting* JX-1 at 10:27. Relying on RX-138.8, he found that the position of the “comb” in the accused product terminates its movement in a discharge position “that is not fairly described as ‘nearby’ when one considers the relationship of the comb in its ‘discharge position’ (*i.e.*, vertical and removed from the discharge end wall) and the overall confines of the comb path and relative distances available between ‘the storage position at the storage end wall’ and the ‘discharge position’ at the ‘discharge end wall.’” ID at 143-44.

This is a reasonable conclusion based on the record evidence, which shows that the SmartScoop comb actually rotates away from the discharge wall through more than 180 degrees to a vertical discharge position at which point the clumps carried out of the litter by the comb are deposited in a waste receptacle that is located behind the comb. In its discharge position, the comb on the SmartScoop is virtually parallel to the discharge end wall at a distance more than equal to the length of the comb tines. *See, e.g.*, RX-138.8; RX-231 at Qs. 61-64. Based on this

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evidence, the ALJ was not persuaded there was infringement under the doctrine of equivalents either, concluding that in an invention of this type and size, the difference in the manner of achieving the result is not “insubstantial.” ID at 145.

The ALJ thus refused to stretch the ordinary meaning of the word “adjacent” to include a position that he reasonably concluded was much farther from the discharge end wall than is naturally implied by definitions of “not distant” and “nearby.” While he initially cited synonyms for “adjacent,” he did not refer to them in his application of the facts to the claim construction. His fact-finding and the conclusions he reached are sound and apply equally if the synonyms are stricken from the cited definition. When the SmartScoop comb is in its discharge position it is sufficiently distant the discharge end wall so as not to be “adjacent” within the meaning of the claim limitation. We therefore find that under the broader construction we have adopted, this element is not present in the SmartScoop products for the reasons the ALJ articulated. We affirm the ALJ’s findings that Complainants failed to prove infringement of claims 8 and 13.

4. Validity

A. Anticipation

Respondents argue that if “comb drive” is broadly construed, then claim 33 is anticipated by the Carlisi prior art reference. *See, e.g.*, Respondents’ Br. at 35-36; Respondents’ Resp. Br. at 61-65. The IA agrees. *See, e.g.*, OUII Br. at 19-21. Complainants contend that claim 33 is not anticipated by Carlisi and that the ID correctly found that Respondents failed to prove that Carlisi discloses a “mode selector switch” and an “automatic operation mode.” *See, e.g.*, Complainants’ Br. at 180-85.

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As set forth below, claim 33 is not anticipated by Carlisi as the ALJ reasonably concluded. First, the ID applied the correct legal standard and properly found that because Carlisi was before the patent examiner during prosecution, Respondents had the added burden of overcoming the presumption that the USPTO properly did its job in allowing the '847 patent to issue. ID at 64, 66. *See American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984). Second, with the exception of “comb . . . coupled to the comb drive,” we have affirmed the claim construction applied by the ALJ in claim 33. The ID’s conclusion did not turn on this element, however, and all parties agree that it does not impact the anticipation analysis. Finally, the ID is supported by the twin findings that Respondents failed to demonstrate that Carlisi discloses the “mode selector switch” and the “automatic operation position.” ID at 72-73 (discussed more fully below).

The ID does not fully explain the rationale for these twin findings, however, and instead simply incorporates by reference the analysis performed under claim 27. ID at 73. With respect to claim 27, the ID found that Respondents failed to demonstrate that Carlisi discloses the “mode selector means” and the “automatic operation mode,” which is not the same language found in claim 33.¹¹ Respondents contend that the ALJ improperly conflated the anticipation analysis of two claims with different limitations. The twin findings are well-supported and we therefore reject the challenge.

The ID construed automatic operation mode in claim 27 as “a mode of operation where

¹¹ The ID also found that the “comb drive means” element of claim 27 is not disclosed in Carlisi. ID at 68.

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combing is initiated in response to cat exit.” ID at 37. Similarly, the ID construed “automatic operation position” as “a position of the mode selector switch where combing is initiated in response to cat exit.” ID at 48. Both of these constructions are based on the construction of “automatic operation” that refers to combing in response to cat exit. In his analysis under claim 27, the ALJ correctly found, based on the record evidence, that “[n]othing in the [Carlisi] patent describes or discloses a mode of operation where combing is initiated in response to a cat exit.” ID at 69. Because the evidence shows that Carlisi does not disclose a self-cleaning operation in response to cat exit, Carlisi therefore does not disclose “an automatic operation mode” as required by claim 27 or an “automatic operation position” as required by claim 33.

With respect to “mode selector means” in claim 27, the ID construed the term under § 112, ¶6 to require a switch for selecting between manual operation mode and automatic operation mode plus a microprocessor programmed to perform a particular algorithm. ID at 30. The ID construed “mode selector switch” in claim 33 to mean “a switch that is operatively connected to the comb and is moveable between the manual and automatic operation positions.” ID at 44. In his claim 27 analysis, the ALJ found that in Carlisi there is no “explicit mention of any switch and microprocessor combination that allows for the selection between modes and no indication that the on/off switch and the timer are connected in any way.” ID at 69. He also found that Carlisi does not inherently “disclose the ‘mode selector means.’” As he stated, “[t]here is no indication in Carlisi that when the on/off switch is turned off, it puts the litter box into a mode where a rake is driven [] periodically by a timer.” ID at 70.

The ID’s incorporation by reference of the claim 27 analysis into its claim 33 analysis

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goes to this narrower point regarding the Carlisi switch. As the ALJ found, Carlisi discloses an on/off switch; it also discloses combing periodically through the use of a timer. ID at 69. On this record, however, it is not apparent that Carlisi discloses a switch for selecting between a manual operation and an automatic operation, and Respondents therefore failed to meet their burden of proving that all elements of claim 33 were disclosed in the prior art reference.

For these reasons, we affirm the finding that claim 33 is not anticipated by Carlisi.

B. Obviousness

Respondents argued below that claims 8, 13, 24-25, 27, 31-33, and 41-42 are invalid under 35 U.S.C. § 103(a) based on claim-specific combinations of prior art references (Carlisi combined with one or more of Strickland or Johnson and, in the case of claim 13, Kakuta) which they allege rendered each element of those asserted claims obvious. The IA concurred with Respondents if, he indicated, the ALJ were to adopt broader claim constructions for these claims than the IA proposed. ID at 79-81; 84-85; 88-89; 89-91; 92-95; 97-98.

The ALJ adopted the broader claim constructions but found the defense unavailing. First, he determined the qualifications of a person of ordinary skill in the art. He found that such a person would have an undergraduate degree in mechanical engineering or equivalent experience and that, due to their educational background or experience, they would have some knowledge of the sensor motor systems, switch hardware, circuitry, control logic, microcontrollers, and computer programming. ID at 78. He then found that none of the asserted claims is rendered obvious to a person of ordinary skill in the art by the combinations of prior art references asserted. ID at 82-84 (claim 8); 84-88 (claim 13); 88-89; (claims 24-25); 89-92 (claim 27), 92-94

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(claims 31-32), 94-97 (claim 33), 97-99 (claims 41-42). Finally, he found that the commercial success of the Littermaid® products support a finding of non-obviousness as a secondary consideration. ID at 103-07.

Respondents and the IA argue that under the claim constructions adopted by the ALJ, the asserted claims are invalid as obvious. *See, e.g.*, Respondents' Resp. Br. at 34, 65-72 (claim 33 obvious if comb drive broadly construed), 90-92 (claims 27, 41, 42 invalid under broad construction of comb drive means), 96-101 (claims 8, 24, 25, 31, and 32 obvious in light of Carlisi and Johnson), 101-03 (claim 13 obvious in light of Carlisi, Johnson and Kakuta); OUII Br. at 19-21. Complainants contend that Respondents failed to meet their heavy burden to prove that any of the asserted claims of the '847 patent would have been obvious to a person of ordinary skill in the art and that, accordingly, the ID should be affirmed. *See, e.g.*, Complainants' Br. at 198-204 (failure to prove claims 8, 24, 25, 31 and 32 obvious in light of Carlisi and Johnson); 204-07 (failure to prove claim 13 obvious in light of Carlisi, Johnson and Kakuta); 208-22 (failure to prove claims 27 and 33 obvious in light of Carlisi and Strickland); 222-23 (failure to prove claims 41-42 would have been obvious); 223-43 (objective evidence of non-obviousness).

We affirm the ID's findings that the asserted claims of the '847 patent are not obvious. The ALJ applied the proper legal standards and, upon reviewing the evidence, assessing witness' credibility and demeanor, and appropriately discounting testimony, correctly concluded that Respondents' evidence failed to satisfy the burden of proof by clear and convincing evidence. The ALJ took into consideration the entire record and his findings on each claim and as regards

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the secondary considerations are well-supported. The closest call in our view concerns claim 33, the single claim found infringed, which we discuss below.

Respondents argue that claim 33 would have been obvious in 1994 (the original application for patent was filed on January 15, 1995), based on the combination of Carlisi and Strickland. They contend that Carlisi discloses all of the elements of claim 33 except for the “mode selector switch” limitation. They contend that Strickland discloses the missing “mode selector switch” limitation. Strickland concerns a “cat waste disposal system.” RX-6. Instead of using a comb to rake clumps to a waste container, Strickland employs a conveyor belt to send used litter into a waste receptacle, which may be operated either by a timer or by a pressure sensor for sensing the presence of the cat. RX-6 at 3:23-26, 4:63-5:2. Strickland also teaches “a manual actuating means 55 provided in timer 54 to open and close the base 32 and move the belt surface 14 as desired by the operator.” RX-6 at 3:20-23. Respondents claim that this “manual actuation means” is the “mode selector switch” of claim 33 and that claim 33 would have been obvious in 1994 by combining these two references.

The ALJ considered the evidence and concluded that Respondents failed to prove that Strickland discloses a “mode selector switch” that is moveable between a manual operation position and an automatic operation position. ID at 95. He had already concluded in his anticipation analysis that Carlisi does not disclose such a switch. ID at 73. Since neither of these two references disclosed the “mode selector switch” element of claim 33, he concluded that Respondents failed to carry their burden of proof of obviousness for claim 33. ID at 97.

Respondents contend the ALJ erred in finding that Strickland does not disclose the “mode

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selector switch” element of claim 33. We find that the ALJ did not err in finding insufficient proof that Strickland discloses the “mode selector switch” element, and that the evidence fully supports his conclusion that claim 33 is not obvious in light of Carlisi and Strickland. First, the U.S. Patent and Trademark Office examined both of these references – Carlisi and Strickland – before it issued claim 33. The PTO ultimately concluded that the “mode selector switch” of claim 33 (and the “mode selector means” of claim 27) was missing from the Carlisi/Strickland combination. *See* JX-2 at 393, 396 (overcoming rejection of claim 33 based on “mode selector switch”). Because these references were examined, the ALJ correctly determined that Respondents bear the added burden of overcoming the deference due to the PTO. ID at 96; *see, e.g., Pharmastem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1366 (Fed. Cir. 2007) (“When the party asserting invalidity relies on references that were considered during examination or reexamination, that party ‘bears the added burden of overcoming the deference that is due to a qualified government agency presumed to have done its job.’”).

Second, as the ALJ found, Strickland does not even use the word “switch.” Beyond the one sentence reference to “manual actuation means,” Strickland contains no discussion or explanation of “manual actuation means.” ID at 96. As the ALJ properly concluded, the term “manual actuation means” is “vague, and the specification does nothing to clarify what structure this term encompasses.” ID at 96. Strickland thus contains no specific reference to a switch – a term which is known to refer to a variety of structures – and only a general reference to “manual actuating means.” The ALJ was correct to point out the vagueness of the disclosure, and it fully supported his conclusion that Strickland does not supply the “mode selector switch” element of

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claim 33 of the '847 patent.

Third, Respondents presented no evidence, much less clear and convincing evidence, that Strickland discloses a “mode selector switch” moveable between a manual operation position and an automatic operation position, which is the claim element alleged to be disclosed. The ALJ was correct to highlight this separate point – not only does the Strickland reference fail to mention a switch, it fails to mention a switch moveable between these two positions, which is integral to this element in claim 33. ID at 96. The specific claimed function of the “mode selector switch” in claim 33 is its being moveable between a manual operation position and an automatic operation position.

Due to the lack of any evidence of the Strickland “manual actuation means” performing the claimed function of being moveable between such positions, the ALJ properly found that one of ordinary skill in the art would not necessarily understand that the “manual actuation means” of Strickland encompassed the “mode selector switch” of claim 33 of the '847 patent. ID at 96. As the ALJ reasonably pointed out, “[w]hile it is possible that the ‘manual actuating means’ of Strickland could be a switch, such speculation does not amount to clear and convincing evidence supporting the assertion of invalidity.” ID at 96. The ALJ’s statements reflect his careful assessment of the record against the heightened burden of proof imposed on Respondents in trying to prove invalidity.

Moreover, Complainant’s expert, Dr. Wood, reviewed these same references and he also concluded that a person of ordinary skill in the art would not understand Strickland, or the combination of Carlisi and Strickland, to disclose the “mode selector switch” element of claim

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33. He also determined that the Strickland waste management system is fundamentally different from the Carlisi system in that Carlisi seeks to filter waste from litter and reuse the litter over an extended period of time, whereas the Strickland system dumps cat waste and litter together while continually replenishing a measured quantity of cat litter. CX-934C at Qs. 145, 150, 154-57, 174, 176; JX-2 at 375-76. Because the systems are so different, he opined that a person of ordinary skill in the art would not make the leaps necessary to combine the Carlisi and Strickland references so as to create an operable comb-based self-cleaning litter box system that includes the mode selector switch and associate manual operation and automatic operation, as disclosed in claim 33. CX-934C at Qs. 147, 157, 174, 176. According to him, the combination of Carlisi and Strickland would result in an inoperable system. He specifically testified that a person of ordinary skill in the art would not readily combine the teachings of Strickland's "manual actuating means" with Carlisi:

Simply taking the 'manual actuating means' of Strickland and attempting to apply it to the 'automatic moving means' of Carlisi would not work from a common sense point of view. It is not possible to simply take the manual means and associated circuitry from Strickland and stick them within the Carlisi system. These systems will not match up or align in any way and will not operate either mechanically or electrically.

CX-934C at Q. 146.

While the ALJ did not reach this level of analysis, content as he was that Strickland failed to disclose the "mode selector switch" of claim 33, the record clearly demonstrates further affirmative support for his conclusion that Respondents failed to prove that claim 33 is invalid as obvious in light of Carlisi and Strickland.

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The ALJ's finding on secondary considerations also supports his rejection of Respondents' validity defense and conclusion that the invention would not have been obvious in 1994. *See Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs, Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008) (These objective indicia "may often be the most probative and cogent evidence of nonobviousness in the record."). The ALJ credited Complainants' evidence and found that the commercial success of the Littermaid® product indicated that the '847 patent would not have been obvious in 1994. ID at 104-05. Complainants also demonstrated the requisite nexus between commercial success and the patented product by showing that they (1) market a commercially successful product, and (2) the patent in question claims that product. The ALJ found that since 2001, Littermaid sales have exceeded \$[] million annually, and the annual average during the last seven years has been over \$[] million. ID at 104.

Contrary to Respondents' assertions, we are not persuaded that the ALJ ignored the factual record or took an improperly limited view of the prior art references. Respondents disagree with the result the ALJ reached, but fail to demonstrate a sound basis for disturbing it. For example, they point out that during prosecution the PTO examiner himself indicated that he thought Strickland discloses a "switch," but they ignore that he ultimately concluded that Strickland does not disclose the "mode selector switch" element. We are also satisfied that the ALJ gave full consideration to Respondents' expert's testimony regarding switches, as the ALJ directly quoted from it elsewhere in his ID. *See* ID at 91. Their argument that Complainant's expert testified in Respondent's favor also does not bear close scrutiny. *See, e.g.*, CX-934C at Qs. 146-47. In short, the ALJ was correct when he determined that Strickland does not clearly disclose a mode

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selector switch and that Respondents failed to establish that claim 33 is obvious in light of Carlisi and Strickland.

The ALJ's findings regarding the validity of other claims reflect the ALJ's proper consideration of the record evidence, findings of fact, and application of law to fact. Because we have not changed any claim construction that would impact the validity analyses and the findings are well-supported, we affirm the ALJ's findings that none of the asserted claims are invalid as obvious under § 103.

5. Remedy, the Public Interest, and Bonding

The ALJ recommended that the Commission issue a general exclusion order under 19 U.S.C. § 1337(d)(2)(A)-(B). In his view, a general exclusion order is necessary (1) to prevent circumvention of an exclusion order limited to products of the named Respondents (the statutory subparagraph A requirement), and (2) because there is a widespread pattern of unauthorized use within the United States and it is difficult to identify the source of the infringing product (the statutory subparagraph B requirement). ID at 199-200. The ALJ also recommended the issuance of cease and desist orders against Respondents under 19 U.S.C. § 1337(f)(1). ID at 204. Finally, he recommended a bond in the amount of 100 percent of the entered value of any infringing self-cleaning litter boxes and components thereof during the period of Presidential review. ID 208.

Complainants argue that the Commission should adopt the ALJ's recommendation to issue a general exclusion order, and that such an order is warranted under subparagraphs A and B

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of 19 U.S.C. § 1337(d)(2). Complainants' Remedy Br. at 4-20.¹² They further argue that the ALJ correctly determined that cease and desist orders are appropriate. *Id.* at 20-21. They further contend that they would receive insufficient relief if the exclusion and cease and desist orders permitted Lucky Litter to continue infringing the '847 patent by supplying replacement cartridges. *Id.* at 21-26. In their view, the proposed general exclusion order and cease and desist orders are consistent with the public interest. *Id.* at 26-28. They also argue that the Commission should adopt the ALJ's bond recommendation (100 percent). *Id.* at 28-31.

Respondents and the IA argue that the recommendation for a general exclusion order is unsupported and should not be adopted. They contend that neither statutory criterion for a general exclusion order (subparagraphs A or B) is met on the evidence in the record. *See, e.g.*, Respondents' Br. at 74-78; OUII Br. at 25-27. In their view, the appropriate relief is a limited exclusion order, but they differ on its terms.

Respondents contend that the LEO should be tailored to cover only products that include a mode selector switch and infringe claim 33, which they argue would therefore except new products that they claim to be importing since the final ID issued in this investigation. They argue that these new products have modified switches that are not "moveable between a manual operation position and an automatic operation position," and that these products are therefore non-infringing. They propose including a provision in the LEO that requires them to certify that

¹² They argue that if the Commission does not issue a general exclusion order, it should issue a limited exclusion order directed to all infringing self-cleaning litter boxes and components thereof, including cartridges, that are manufactured by or for Respondents. *Id.* at 20.

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the imported products meet the exception. Respondents' Br. at 66-71 & Exh. A (Decl. of Alan Cook).

Respondents further contend that the limited order should not cover replacement cartridges because barring such importation will deprive consumers of the ability to use non-infringing products, including their new ScoopFree Slide, which is not automated and which they say they started shipping in December 2008, and their new SX-1, SX-E, and SX-2 automatic litter boxes, which they argue have been re-designed to remove the functionality of the cycle button and will start shipping in January 2009. *Id.* at 69-71 & Exh. A. Respondents argue that covering the replacement cartridges would also be against the public interest because it would deny owners of the accused products access to such products and therefore the use of their litter boxes. *Id.* at 71-72. Finally, they argue that the bond during the period of Presidential review should be set at three percent. *Id.* at 78-81.

The IA opposes including in the LEO or cease and desist orders Respondents' additional limiting language regarding the switch limitation of claim 33, but he is otherwise essentially in accord with their positions. OUII Br. at 24-28. Including replacement cartridges in any order would be against the public interest, in his view. *Id.* at 28-30. He calculates an even lower bond rate of 2.66 percent based on a royalty agreement. *Id.* at 30-31.

Analysis

The Commission has "broad discretion in selecting the form, scope and extent of the remedy." *Viscofan, S.A. v. United States Int'l Trade Comm'n*, 787 F.2d 544, 548 (Fed. Cir. 1986). A limited exclusion order is the usual remedy when a violation of Section 337 is found.

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The statute provides that, “[i]f the Commission determines, as a result of an investigation under this section, that there is a violation of this section, it shall direct that the articles concerned, imported by any person violating the provisions of this section, be excluded from entry into the United States” 19 U.S.C. § 1337(d)(1).

A general exclusion order, conversely, is available only when complainants meet the heightened requirements of Section 337(d)(2), which provides as follows.

The authority of the Commission to order an exclusion from entry of articles shall be limited to persons determined by the Commission to be violating this section unless the Commission determines that--

(A) a general exclusion from entry of articles is necessary to prevent circumvention of an exclusion order limited to products of named persons; or

(B) there is a pattern of violation of this section and it is difficult to identify the source of infringing products.

19 U.S.C. § 1337(d)(2).

In addition to, or in lieu of, issuing a limited or general exclusion order, the Commission may issue a cease and desist order directing any person violating, or believed to be violating, Section 337 to cease and desist from engaging in the unfair methods or acts involved. *Id.* at § 1337(f)(1).

Exclusion Order

We disagree with the ALJ’s recommendation in light of our conclusion that the record fails to demonstrate that either section 337(d)(2)(A) or (B) is satisfied. We address subparagraph B first because the ALJ emphasized “widespread importation of the infringing products by foreign manufacturers” and the fact that “the offending products do not bear any identifying data

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showing their manufacturer, making it difficult to identify their origin.” ID at 199.

In this case, there is no evidence of importation by any foreign manufacturers, and subparagraph B is clearly not met. Originally there were three Respondents in this investigation, one of which settled with Complainants early in the proceeding. All three are importers of the accused products; Complainants also import their products that practice the invention. During the investigation, in which they participated fully, Respondents identified a specific and limited number of manufacturers of their self-cleaning litter boxes. CX-204 at 5-6; CX-269C.

What the ALJ identifies as “widespread importation of infringing products” refers exclusively to Respondents’ infringing products. The volume and value of this infringing activity is significant – the ALJ states that over 200,000 units of infringing self-cleaning litter boxes and components thereof with a value of more than \$15,000,000 have been sold for importation, imported, and/or sold after importation.¹³ ID at 199. However, the only evidence in the record of infringing imports is of Respondents’ products. That is, Respondents accounted for all of the infringing imported products. Complainants have failed to identify a single act of importation that is unrelated to one of the Respondents. Under the circumstances, this is not the sort of “pattern of violation of this section” that paragraph B contemplates, particularly when further considered in light of the second part of paragraph B – “and it is difficult to identify the source of infringing products.”

In the ALJ’s view, the lack of a mark on the product or its packaging identifying the

¹³ Complainants say the numbers are higher. Complainant’s Remedy Reply Br. at 9 (citing 230,000 units of Respondents’ infringing litter boxes and [] replacement cartridges).

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manufacturer is significant, but we disagree with this application of the statutory provision. The statute requires that the “source” of the infringing products be difficult to identify, and that is not the case here. It is undisputed that all of these imported products are the Respondents’. In fact, each Respondent is clearly identified on its products and the products’ packaging.¹⁴ We therefore do not find that subparagraph B is met.

We also find insufficient evidence to support the requisite risk of circumvention under subparagraph A to warrant a general exclusion order. The ALJ states that there are numerous producers in China who could make litter boxes, and further states that business conditions in the United States, such as demand conditions and distribution networks, support a finding that subparagraph A is met. ID at 199. Respondents and the IA argue that such statements are guesswork, which we find unnecessary to reach. The fatal shortcoming is the lack of correlative intent or likelihood of infringement by Respondents’ manufacturers or any other foreign manufacturers – the indicia of evidence that would warrant a general exclusion order. The existence of an opportunity to make infringing products is simply not enough to satisfy the requirements of subparagraph A.

The closest Complainants get to making a case that a general exclusion order is necessary is with respect to evidence that Lucky Litter has arrangements with three purchasers whereby the purchasers take possession and title of the product in China and arrange for its importation into the United States themselves, without Lucky Litter’s involvement. *See* CX-118 Q. 19 at 15. Lucky Litter, in these sales, is therefore not the importer. We note that these transactions

¹⁴ We note that Complainants’ products also do not identify the name of the foreign manufacturer.

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constitute only part of Lucky Litter's sales, *see, e.g.*, CX-805C, Tr. at 775-76, and there is also no proof on this record that OurPet's has similar arrangements.

We find that the evidence does not support finding that a general exclusion order is necessary under subparagraph A. Even if Lucky Litter is completely removed from importing in these transactions, Commission limited exclusion orders are meant to reach covered products that are "manufactured by or on behalf of" or "imported by or on behalf of" the named person (here Lucky Litter). Such language in a Commission limited exclusion order is broad enough to bar the infringing imports of Lucky Litter products that are imported directly by certain customers of Lucky Litter. Moreover, the standard Commission cease and order contains language in its proscriptions that would be broad enough to bar this type of conduct by Respondents, as recognized by the IA and Respondents. Such orders are subject to enforcement by penalty, against the named company as well as its principals, officers, employees, agents, and others, pursuant to section 337(f)(1). Individuals involved in proscribed conduct may even be held personally liable for penalties.

There is, therefore, no incentive to violate the Commission cease and desist orders or limited exclusion orders and these two types of orders constitute appropriate remedies given the violation. Accordingly, we find that the record does not demonstrate that "a general exclusion from entry of articles is necessary to prevent circumvention of an exclusion order limited to products of named persons" under section 337(d)(2)(A).

We therefore determine to issue a limited exclusion order against the Respondents. We agree with Complainants, however, that the alternative recommendation of the ALJ that the

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limited order specify model numbers is not appropriate. The Commission does not identify specific model numbers in its orders because “[a]n exclusion or cease and desist order which specifically lists the models to which it applies merely invites an unscrupulous respondent to change the model number to circumvent the order.” *Certain Cellular Radiotelephones and Subassemblies and Component Parts Thereof*, Inv. No. 337-TA-297, USITC Pub. 2361 (Feb. 1991), Comm’n Op. on Remedy, the Public Interest and Respondents’ Bonding at 5 (Aug. 29, 1989). Moreover, any recitation of model numbers would place an additional burden on Customs, which the Commission has generally sought to avoid. *See, e.g., Certain Integrated Circuit Telecommunication Chips and Products Containing Same*, Inv. No. 337-TA-337, Comm’n Op. on the Issues Under Review and Remedy, the Public Interest, and Bonding at 32-34 (Aug. 1993).

We also reject Respondents’ request that the exclusion order carve out an exception for their recent “new designs” and new products because the Commission has regulatory safeguards in place to prevent the enforcement of an exclusion order against products that do not violate section 337. If Respondents believe that their new products do not violate section 337 and they want to avoid potential liability for civil penalties, they may avail themselves of the procedures of Commission Rule 210.79, 19 C.F.R. § 210.79, which provides that a party may request an advisory opinion as to whether its product is subject to the order.¹⁵ In the framework of such a proceeding, unlike here, the record could be developed to determine whether the subject products

¹⁵ In addition, Respondents may request a ruling from U.S. Customs and Border Protection that their new designs are not covered by the Commission order. 19 C.F.R. § 177.1, *et seq.*

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infringe. We also find that the need for the certification provision requested by Respondents is mooted by our determination that the order not carve out an exception for any new litter box designs.

We agree with Complainants that components including replacement cartridges should be covered by the limited exclusion order (and the cease and desist orders). Respondents and the IA argue that the inclusion of replacement cartridges is improper and would be against the public interest. We disagree. The statute clearly contemplates such inclusion because Lucky Litter cartridges were specifically found to infringe the '847 patent. Because the replacement cartridges were found to independently infringe under the doctrine of contributory infringement, their sale and importation violate section 337 and should be included in the scope of any remedy issued. *See* 19 U.S.C. § 1337(d)(1) (“[i]f the Commission determines, as a result of an investigation under this section, that there is a violation of this section, it shall direct that the articles concerned, imported by any person violating the provisions of this section, be excluded from entry into the United States . . .”). Complainants’ statutory relief would be vitiated, and Lucky Litter would be authorized to simply continue its infringement, if the orders permitted Lucky Litter to continue infringing the ‘847 patent by supplying replacement cartridges.¹⁶

Finally, based on new designs that Respondents have developed after the ALJ issued his final ID, we find that there is no legitimate basis upon which to include an exemption for complete litter boxes or cartridges. Lucky Litter advocates exclusion of all cartridges from coverage of the limited order on the basis that new products are non-infringing. However, these

¹⁶ We address in the relevant section below the issue of whether the public interest favors the inclusion of replacement cartridges in any remedial order.

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products have not been adjudicated and the remedy phase of this investigation does not establish a procedure for re-trying the violation case or conducting a new trial to make new infringement determinations. These products are not even before the Commission.

Cease and Desist Orders

Neither Lucky Litter nor OurPet's disputes that the record supports issuing cease and desist orders against them in the event a violation is found, and we determine that such orders are appropriate in this investigation. For the reasons articulated with respect to the limited exclusion order, we also find that the products covered by the cease and desist orders are litter boxes and components, including the cartridges.

Public Interest

When issuing an exclusion order or a cease and desist order, the Commission considers whether the statutory "public interest" factors preclude the contemplated relief. The statutory public interest factors are "the public health and welfare, competitive conditions in the United States economy, the protection of like or directly competitive articles in the United States, and United States consumers" 19 U.S.C. §§ 1337(d)(1), (f)(1).

We do not find that the public interest in the unfettered access to Lucky Litter replacement cartridges trumps the public interest that we have held "favors the protection of U.S. intellectual property rights by excluding infringing imports." *Certain Two-Handle Centerset Faucets and Escutcheons, and Components Thereof*, Inv. No. 337-TA-422, USITC Pub. 3332, Comm'n Op. at 9 (July 2000); S. Rep. No. 100-71, at 128 (1987) ("The owner of intellectual property has been granted a temporary statutory right to exclude others from making, using or

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selling the protected property The importation of any infringing merchandise derogates from the statutory right, diminishes the value of the intellectual property, and thus indirectly harms the public interest.”).

Moreover, in this case, we are not dealing with public health and safety concerns. Nor are we persuaded of any significant harm to U.S. consumers. The record shows that Lucky Litter’s self-cleaning litter boxes cost between \$45 and \$175, and its replacement cartridges cost approximately \$15. The Commission has issued exclusion order and cease and desist orders against products and their components that were far more expensive. *See, e.g., Certain Hardware Logic Emulation Systems and Components Thereof*, Inv. No. 337-TA-383, USITC Pub. 3089, Comm’n Op. on Remedy, the Public Interest, and Bonding (Mar. 31, 1998). Meanwhile, Complainants are fully able to meet demand for automated litter boxes. In addition, there is also a supplier of permanent cartridges that are compatible with the ScoopFree product. *See www.foreverlittertrays.com*. We recognize that the contemplated relief regarding cartridges may have a negative effect on U.S. consumers; specifically, it may make it more difficult for current owners of the accused Lucky Litter litter boxes to find compatible cartridges if the accused cartridges are subject to exclusion. We find, however, that the effect on consumers is not so great that the order should not issue with respect to the cartridges. Under these circumstances, we conclude that the public interest is not inconsistent with, and indeed supports, the issuance of a limited exclusion order and cease and desist orders covering self-cleaning litter boxes and components thereof, including cartridges.

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Bonding

The ALJ reasonably determined on this record that a calculation based on price comparisons was impractical, and that relying on the royalty rate in the Applica agreement was inappropriate because the agreement contained mixed terms, including a significant lump sum payment that Respondents and the IA ignore. Accordingly, we adopt the ALJ's recommendation of 100 percent for the Presidential review-period bond.

IV. CONCLUSION

For the above-stated reasons, the Commission has determined to (1) affirm the ALJ's construction of "comb drive" (asserted claims 8, 13, 31-33), "comb drive means" (asserted claims 27, 41-42), "drive means" (asserted claims 24-25), and "mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position" (asserted claim 33); (2) modify the ALJ's construction of "discharge position adjacent the discharge end wall" (asserted claims 8, 13) to "not distant, nearby," thereby deleting the synonyms "adjoining, contiguous, abutting, and coterminus;" and (3) construe "coupled to" in the limitation "comb . . . coupled to the comb drive" (asserted claims 31-33) as "coupled or connected, directly or indirectly;" (4) affirm the ALJ's finding of violation of § 337 as to Respondent Lucky Litter; (5) affirm the ALJ's finding that the accused Lucky Litter products infringe claim 33 of the '847 patent; (6) affirm the ALJ's finding of violation of § 337 as to Respondent OurPet's; (7) affirm the ALJ's finding that the accused OurPet's products infringe claim 33 of the '847 patent; (8) affirm the ALJ's finding that infringed claim 33 is not invalid

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due to anticipation or obviousness; (9) affirm the ID on any other findings under review except insofar as they are inconsistent with the opinion of the Commission; and (10) issue a limited exclusion order and cease and desist orders against Respondents, in the form prescribed above, and set the bond rate for the Presidential review period at 100 percent.

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott". The signature is fluid and cursive, with the first name being the most prominent.

Marilyn R. Abbott
Secretary to the Commission

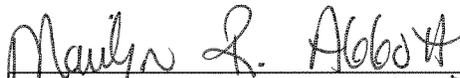
Issued: April 28, 2009

**CERTAIN SELF-CLEANING LITTER BOXES AND
COMPONENTS THEREOF**

337-TA-625

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **COMMISSION OPINION** has been served by hand upon the Commission Investigative Attorney, Vu Q. Bui, Esq., and the following parties as indicated, on April 28, 2009.


Marilyn R. Abbott, Secretary *JNC*
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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SELF-CLEANING LITTER
BOXES AND COMPONENTS THEREOF**

Investigation No. 337-TA-625

**NOTICE OF COMMISSION DETERMINATION TO REVIEW A FINAL INITIAL
DETERMINATION IN PART; GRANT A MOTION TO STRIKE; AND SET A
SCHEDULE FOR FILING WRITTEN SUBMISSIONS ON THE ISSUES UNDER
REVIEW AND ON REMEDY, THE PUBLIC INTEREST, AND BONDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review in part the final initial determination (“ID”) issued by the presiding administrative law judge (“ALJ”) on December 1, 2008, in the above-captioned investigation, and has granted Complainants’ motion to strike.

FOR FURTHER INFORMATION CONTACT: Mark B. Rees, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW, Washington, D.C. 20436, telephone (202) 205-3116. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, SW, Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <http://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on December 28, 2007, based on the complaint of Applica Consumer Products, Inc. of Miramar, Florida (“Applica”) and Waters Research Company of West Dundee, Illinois (“Waters”). 72 *Fed. Reg.* 73884 (Dec. 28, 2007); 73 *Fed. Reg.* 13566 (Mar. 13, 2008). The complaint alleges violations of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain self-cleaning litter boxes and components thereof by reason of infringement of U.S.

Patent No. RE36,847 (“the ‘847 patent”). The respondents are Lucky Litter, L.L.C. of Chicago, Illinois (“Lucky Litter”) and OurPet’s Company of Fairport Harbor, Ohio (“OurPet’s”).

On December 1, 2008, the ALJ issued his final ID, finding that a violation of section 337 has occurred in the importation, sale for importation, or sale after importation of certain self-cleaning litter boxes and components thereof by reason of infringement of claim 33 of the ‘847 patent. His final ID also included his recommendation on remedy and bonding. Respondents Lucky Litter and OurPet’s, complainants Applica and Waters, and the Commission investigative attorney (“IA”) filed petitions (or contingent petitions) for review on December 16, 2008. All parties filed responses to the petitions on December 24, 2008. Complainants also filed a motion to strike on December 23, 2008, to which Lucky Litter and the IA filed oppositions on January 5, 2009.

Having examined the record in this investigation, including the ALJ’s final ID, the petitions for review, and the responses thereto, the Commission has determined to review the following issues: the construction of “comb drive” (asserted claims 8, 13, 31-33), “comb drive means” (asserted claims 27, 41-42), “drive means” (asserted claims 24-25), “discharge position adjacent the discharge end wall” (asserted claims 8, 13), “comb . . . coupled to the comb drive” (asserted claims 31-33), and “mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position” (asserted claim 33); invalidity due to anticipation; invalidity due to obviousness; and direct and contributory infringement.

On review, the Commission requests briefing on the above-listed issues based on the evidentiary record. The Commission is particularly interested in responses to the following questions:

- (1) Did the ALJ err in finding that the specification of the ‘847 patent contains no disavowal that limits the claimed comb drive? If the patentee disavowed certain drives, what is the correct scope of the disavowal? Does it include, for example, worm drives of any configuration, or only the drive disclosed in the Carlisi prior art reference, which has a “worm” along the side of the litter box that turns and thereby drives the rake or comb on its path in the litter box?
- (2) What are the differences or similarities in the patent’s use of “comb drive” in asserted claim 8, “comb drive means” in asserted claim 27, and “comb drive” in asserted claim 33?
- (3) Is there a difference in function between the “guide” wheels and “guide” pins referenced in the specification in connection with figures 1-3 of the ‘847 patent and the “drive” wheels and “drive” pins referenced in claim 10?
- (4) What result should the Commission reach on infringement if it were to find that the ‘847 patent disavows all worm drives or that it disavows only the Carlisi drive?

- (5) What result should the Commission reach on infringement if it were to find that the synonyms for “adjacent” cited in the ID at 143-44 incorrectly narrow the limitation “discharge position adjacent the discharge end wall” in asserted claim 8?
- (6) Is the limitation “comb . . . coupled to the comb drive” in asserted claims 31-33 met in OurPet’s SmartScoop under a broader construction that includes, as Complainants argue, an “indirect” connection? Should the infringement analysis that follows from the correct construction of this limitation be different in claim 31 than it is in claim 33? Did the ID err in finding claim 33 infringed on the one hand and, on the other, that the same limitation is not met for purposes of claim 31?
- (7) How does a finding of disavowal of all worm drives, or the Carlisi drive, impact the consideration of obviousness under § 103 and anticipation under § 102? Do the broader constructions of “discharge position adjacent the discharge end wall” and “comb . . . coupled to the comb drive” advocated by Complainants impact either validity analysis?
- (8) Did the ID err in finding that the Strickland prior art reference does not disclose a “mode selector switch” to one of ordinary skill in the art?
- (9) Please describe and analyze the intrinsic evidence of record that is pertinent to the construction of “mode selector switch . . . moveable between a manual operation position . . . and an automatic operation position” of claim 33. Please identify record evidence of whether each accused device contains a “mode selector switch” which is “moveable between a manual operation position . . . and an automatic operation position.” In addition, please address the relevance of *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261 (Fed. Cir. 1999), to the claim construction, infringement and invalidity analyses of the “mode selector switch” limitation.

The Commission has also granted Complainants’ motion to strike the Declaration of Alan J. Cook that was submitted by Lucky Litter along with its petition for review. The declaration and its exhibits are not part of the record on violation in this investigation. References to such information in Lucky Litter’s petition for review are also therefore stricken. This action is taken without prejudice to Lucky Litter submitting any information contained in the declaration and exhibits that is relevant to the remedy and bonding issues in this investigation at the appropriate time.

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease and desist orders that could result in respondents being required to cease and desist from engaging in unfair acts in the importation and sale of such

articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or are likely to do so. For background, see *In the Matter of Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843 (Dec. 1994) (Commission Opinion).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the President has 60 days to approve or disapprove the Commission's action. During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed.

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues under review. The submissions should be concise and thoroughly referenced to the record in this investigation. Parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should address the recommended determination by the ALJ on remedy and bonding. Complainants and the Commission investigative attorney are also requested to submit proposed remedial orders for the Commission's consideration. Complainant is further requested to provide the expiration date of the '847 patent and state the HTSUS number under which the accused articles are imported. The written submissions and proposed remedial orders must be filed no later than the close of business on February 20, 2009. Reply submissions must be filed no later than the close of business on February 27, 2009. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document and 12 true copies thereof on or before the deadlines stated above with the Office of the Secretary. Any person desiring to submit a document (or portion thereof) to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. See section 201.6 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 201.6.

Documents for which confidential treatment by the Commission is sought will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and in sections 210.42-.46 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.42-.46).

By order of the Commission.

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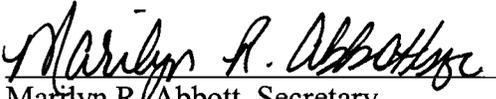
Marilyn R. Abbott
Secretary to the Commission

Issued: February 9, 2009

CERTAIN SELF-CLEANING LITTER BOXES AND COMPONENTS THEREOF	337-TA-625
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PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION DETERMINATION TO REVIEW A FINAL INITIAL DETERMINATION IN PART; GRANT A MOTION TO STRIKE; AND SET A SCHEDULE FOR FILING WRITTEN SUBMISSIONS ON THE ISSUES UNDER REVIEW AND ON REMEDY, THE PUBLIC INTEREST, AND BONDING** hand upon the Commission Investigative Attorney, Vu Q. Bui, Esq., and the following parties as indicated, on February 10, 2009.


 Marilyn R. Abbott, Secretary
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PUBLIC VERSION

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN SELF-CLEANING LITTER BOXES
AND COMPONENTS THEREOF**

Investigation No. 337-TA-625

**INITIAL DETERMINATION ON VIOLATION OF SECTION 337 AND
RECOMMENDED DETERMINATION ON REMEDY AND BOND**

Administrative Law Judge Robert K. Rogers, Jr.

(December 1, 2008)

Appearances:

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B.C. Boren, Esq.; Steve Schortgen, Esq. of Baker Botts L.L.P. of Dallas, Texas

F. David Foster, Esq.; James B. Altman, Esq. of Miller & Chevalier Chartered of
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PUBLIC VERSION

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For the Commission Investigative Staff:

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PUBLIC VERSION

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Pursuant to the Notice of Investigation and Rule 210.42 of the Rules of Practice and Procedure of the United States International Trade Commission, this is the Administrative Law Judge's Final Initial Determination in the matter of Certain Self-Cleaning Litter Boxes and Components Thereof, Investigation No. 337-TA-625.

The Administrative Law Judge hereby determines that a violation of Section 337 of the Tariff Act of 1930, as amended, has been found in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain self-cleaning litter boxes and components thereof, in connection with U.S. Patent No. RE 36,847. Furthermore, the Administrative Law Judge hereby determines that a domestic industry in the United States exists that practices U.S. Patent No. RE 36,847.

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The following abbreviations may be used in this Initial Determination:

CDX	Complainants' demonstrative exhibit
CFF	Complainants' proposed findings of fact
AIB	Applica initial post-hearing brief
WIB	Waters initial post-hearing brief
CORFF	Complainants' objections to Respondents' proposed findings of fact
COSFF	Complainants' objections to Staff's proposed findings of fact
CPX	Complainants' physical exhibit
ARB	Applica reply post-hearing brief
WRB	Waters reply post-hearing brief
CX	Complainants' exhibit
Dep.	Deposition
JSUF	Joint Statement of Undisputed Facts
JX	Joint Exhibit
RDX	Respondents' demonstrative exhibit
RFF	Respondents' proposed findings of fact
LIB	Lucky Litter initial post-hearing brief
OIB	OurPet's initial post-hearing brief
ROCF	Respondents' objections to Complainants' proposed findings of fact
ROSFF	Respondents' objections to Staff's proposed findings of fact
RPX	Respondents' physical exhibit
LRB	Lucky Litter reply post-hearing brief
ORB	OurPet's reply post-hearing brief
RRX	Respondents' rebuttal exhibit
RX	Respondents' exhibit
SFF	Staff's proposed findings of fact
SIB	Staff's initial post-hearing brief
SOCFF	Staff's objections to Complainants' proposed findings of fact
SORFF	Staff's objections to Respondents' proposed findings of fact
SRB	Staff's reply post-hearing brief
Tr.	Transcript

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I. BACKGROUND

A. Procedural History

On December 21, 2007, the Commission issued a notice of investigation, which was published in the *Federal Register* on December 28, 2007. The notice states that, pursuant to subsection (b) of section 337 of the Tariff Act of 1930, as amended, the Commission instituted this investigation to determine:

[W]hether there is a violation of subsection (a)(1)(B) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain self-cleaning litter boxes or components thereof by reason of infringement of one or more of claims 8, 13, 24-25, 27, 31-33, 36-37, 41-42, and 46-48 of U.S. Patent No. RE 36,847, and whether an industry in the United States exists as required by subsection (a)(2) of section 337.

72 Fed. Reg. 73884 (2007).

The complainants are Applica Consumer Products, Inc. of Miramar, Florida (“Applica”); and Waters Research Company of West Dundee, Illinois (“WRC”) (collectively “Complainants”). The respondents were: Lucky Litter, LLC of Chicago, Illinois (“Lucky Litter”); Doscocil Manufacturing Co., Inc. of Arlington, Texas (“Doscocil”); and OurPet’s Company of Fairport Harbor, Ohio (“OurPet’s”) (collectively “Respondents”). The Commission Investigative Staff (“Staff”) of the Office of Unfair Import Investigations is also a party in this investigation.

The complaint accuses Respondents’ products of infringing various claims of U.S. Patent No. RE 36,847 (“the ‘847 patent”). The complaint further alleges that there exists a domestic industry with respect to the ‘847 patent. Complainants seek, among other things, a general exclusion order of the infringing self-cleaning litter boxes and components thereof.

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The investigation was originally assigned to Administrative Law Judge Essex. On July 7, 2008, Chief Administrative Law Judge Luckern permanently reassigned the investigation to me.

On July 1, 2008, Applica filed a motion for summary determination that it satisfied the economic prong of the domestic industry requirement. On July 21, 2008, I issued Order No. 28, an initial determination granting the motion. Pursuant to a request from Staff, I issued Order No. 34, clarifying Order No. 28. On August 8, 2008, the Commission issued a notice of decision to review and modify the initial determination. The Commission modified the initial determination to include the clarifying order, Order No. 34.

On July 1, 2008, Applica filed a motion for summary determination that it has satisfied the importation requirement of 19 U.S.C. § 1337(a)(1)(B). On July 23, 2008, I issued Order No. 30, an initial determination granting Applica's motion based on the stipulations that Applica entered into with the Respondents. On August 8, 2008, the Commission issued a notice of decision not to review the initial determination.

On July 3, 2008, Complainants filed a motion for summary determination of no anticipation. On July 31, 2008, I issued Order No. 35, an initial determination granting in part Complainants' motion. I found that Complainants were entitled to summary determination as to OurPet's invalidity defense under 35 U.S.C. § 102(f). On August 19, 2008, the Commission issued a notice of decision not to review the initial determination.

On August 21, 2008, Dorskocil filed a motion to terminate on the basis of a consent order. On August 25, 2008, I issued Order No. 50, an initial determination terminating the investigation as to Dorskocil. On September 15, 2008, the Commission issued a notice of decision not to review the initial determination and issued the consent order.

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I denied all other motions for summary determination filed by Complainants and Respondents.

An evidentiary hearing was conducted before me from August 26-29, 2008. Applica, WRC, Lucky Litter, OurPet's, and Staff participated in the hearing. In support of their case-in-chief and rebuttal case, Complainants called the following witnesses:

- Michael A. Waters (Inventor of the '847 patent);
- Terry L. Polistina (President and Chief Executive Officer of Applica);
- John M. Silvestri (President and General Manager of the Pet Products Division at Applica);
- Lisa R. Carstarphen (Vice President, General Counsel and Corporate Secretary at Applica); and
- Dr. Kristin Wood (Complainants' expert witness).

In support of their case-in-chief and rebuttal case, Respondents¹ called the following witnesses:

- Alan J. Cook (President and Chief Executive Officer of Lucky Litter);
- Kristin W. Grube (President of Kestrel Design, Inc.);
- Dr. Jonathan Cagan (Lucky Litter's expert witness);
- Dr. Steve Tsengas (President of OurPet's);
- Michael P. O'Toole (Mechanical Engineer at Nottingham Spirk Design Associates, Inc.);
- Dr. James G. Rice (OurPet's expert witness); and
- Mark J. Thronson² (Partner at Dickstein Shapiro LLP).

¹ For the remainder of the Initial Determination, "Respondents" will refer to only Lucky Litter and OurPet's, as the investigation with respect to Dostkocil was terminated prior to the evidentiary hearing.

² Mr. Thronson was called as an adverse witness.

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In addition, various deposition transcripts were received into evidence in lieu of direct witness statements or live testimony.

After the hearing, post-hearing briefs and reply briefs, together with proposed findings of fact, conclusions of law and rebuttals to the same, were filed on September 15, 2008 and September 26, 2008, respectively.

B. The Parties

1. Waters Research Company

Complainant WRC is an Illinois corporation with its principal place of business at 213 West Main Street, West Dundee, Illinois. (Complaint at ¶ 8.) WRC is the owner of the '847 patent. (See CX-894C at ¶¶ 215-248; CX-897C at ¶ 17; JX-1; JX-2.) {

}

2. Applica Consumer Products, Inc.

Complainant Applica is a Florida corporation with its principal place of business at 3633 Flamingo Road, Miramar, Florida. (Complaint at ¶ 10.) {

}

3. Doskocil Manufacturing Company, Inc.

Respondent Doskocil is a Texas corporation with its principal place of business at 4209 Barnett Blvd., Arlington, Texas. (Resp. to Complaint at ¶ 15.)

4. Lucky Litter LLC

Respondent Lucky Litter is an Illinois limited liability company with its principal place of business at 2 N Riverside Plaza, Chicago, Illinois. (Resp. to Complaint at ¶ 14.)

³ Windmere Corporation later became Applica. (CX-897C at ¶ 36.)

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5. OurPet's Company

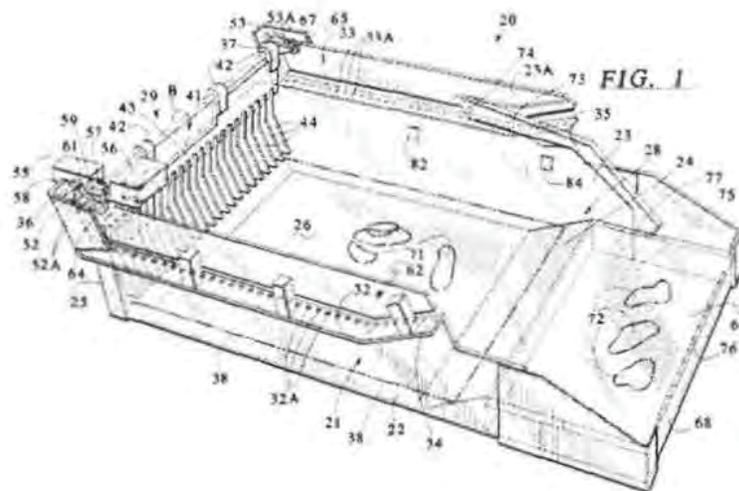
Respondent OurPet's is a Colorado corporation with its principal place of business at 1300 East Street, Harbor, Ohio. (Resp. to Complaint at ¶ 16.)

C. Overview Of The Technology & Patent At Issue

At issue in this investigation is a patent involving self-cleaning litter boxes. The '847 patent is entitled "Automated Self-Cleaning Litter Box For Cats" which was issued on September 5, 2000, based on Application No. 08/997,879 filed on December 24, 1997. (JX-1.) The '847 patent is a reissue of U.S. Patent No. 5,477,812, which was issued on December 26, 1995, based on Application No. 08/371,782 filed on January 12, 1995. (JX-3.) The named inventor of the '847 patent is Michael A. Waters and the patent was assigned to WRC. (JX-1.) The '847 patent has a total of 48 claims. (*Id.*)

The patent describes a litter box including a comb or rake. (JX-1 at 1:59-62.) A motor drives the comb or rake through the litter to move any cat waste into a waste receptacle. (*Id.* at 5:36-57.) The specification discloses a preferred embodiment, which is a litter box equipped with sensors to determine when the cat enters and leaves the box. (*Id.* at 4:25-37.) After the sensors indicate that the cat has left the litter box, the comb or rake is energized after a set delay period. (*Id.* at 5:36-57.) The delay period is included to ensure that the comb or rake is not driven while the cat is in the box. (*Id.* at 5:26-35.) Below is Figure 1 from the specification, depicting an embodiment of the litter box:

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The claims of the '847 patent asserted against the Respondents in this investigation are: 8, 13, 24-25, 27, 31-33, and 41-42. Claims 8, 24, 27, 31, and 33 are independent claims.

D. Products At Issue

The products at issue in this investigation are automated self-cleaning litter boxes. Applica markets and sells a line of self-cleaning litter boxes under the brand name LitterMaid®. (CX-895C at ¶¶ 11-13.)

Lucky Litter markets and sells a line of self-cleaning litter boxes under the brand name "ScoopFree." (RX-197C at ¶¶ 6-7.)

OurPet's markets and sells a line of self-cleaning litter boxes under the brand name "SmartScoop." (RX-230 at ¶¶ 17-18.)

II. JURISDICTION & IMPORTATION

A. Subject Matter Jurisdiction

The complaint alleges that Respondents have violated Subsection 337(a)(1)(B) in the importation and sale of products that infringe the asserted patent. Respondents admitted that they have imported and sold the accused products. (See Order No. 30.) Thus, I find that the Commission has subject matter jurisdiction over this investigation under Section 337 of the

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Tariff Act of 1930. *See Amgen, Inc. v. U.S. Int'l Trade Comm'n*, 902 F.2d 1532, 1536 (Fed. Cir. 1990).

B. Personal Jurisdiction

Respondents Doskocil, Lucky Litter, and OurPet's all responded to the complaint and notice of investigation, and participated in the investigation. Doskocil stipulated to personal jurisdiction as part of the consent order entered in this investigation. (*See* Order No. 50.) Lucky Litter and OurPet's both made an appearance at the hearing and submitted post-hearing briefs. Thus, I find that all three respondents submitted to the personal jurisdiction of the Commission. *See Certain Miniature Hacksaws*, Inv. No. 337-TA-237, Initial Determination, 1986 WL 379287 (October 15, 1986).

C. In Rem Jurisdiction

The Commission has *in rem* jurisdiction over the products at issue by virtue of Respondents' admission that the accused products have been imported into the United States. *See Sealed Air Corp. v. United States Int'l Trade Comm'n*, 645 F.2d 976, 985-986 (C.C.P.A. 1981).

III. CLAIM CONSTRUCTION

A. Applicable Law

"An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996) (citation omitted). Claim construction "is a matter of law exclusively for the court." *Id.* at 970-71. "The construction of claims is simply a way of elaborating the normally terse claim

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language in order to understand and explain, but not to change, the scope of the claims.”

Embrex, Inc. v. Serv. Eng'g Corp., 216 F.3d 1343, 1347 (Fed. Cir. 2000). “[O]nly those [claim] terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Claim construction focuses on the intrinsic evidence, which consists of the claims themselves, the specification, and the prosecution history. *See generally Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). The Federal Circuit in *Phillips* explained that in construing terms, courts must analyze each of these components to determine the “ordinary and customary meaning of a claim term,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1313.

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Id.* at 1312 (citations omitted). “Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms.” *Id.* at 1314. For example, “the context in which a term is used in the asserted claim can be highly instructive,” and “[o]ther claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term.” *Id.*

“[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* (citation omitted). “The longstanding difficulty is the contrasting nature of the axioms that (a) a claim must be read in view of the specification and (b) a court may not read a limitation into a claim from the specification.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381

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F.3d 1111, 1117 (Fed. Cir. 2004). The Federal Circuit has explained that there are certain instances when the specification may limit the meaning of the claim language:

[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive.

Phillips, 415 F.3d at 1316.

In addition to the claims and the specification, the prosecution history should be examined if in evidence. "The prosecution history...consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent. Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent." *Id.* at 1317 (citation omitted). "[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.*

If the intrinsic evidence does not establish the meaning of a claim, then extrinsic evidence may be considered. Extrinsic evidence consists of all evidence external to the patent and the prosecution history, including dictionaries, inventor testimony, expert testimony and learned treatises. *Id.* at 1317. Extrinsic evidence is generally viewed "as less reliable than the patent and its prosecution history in determining how to read claim terms[.]" *Id.* at 1318. "The court may receive extrinsic evidence to educate itself about the invention and the relevant technology, but the court may not use extrinsic evidence to arrive at a claim construction that is clearly at odds

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with the construction mandated by the intrinsic evidence.” *Elkay Mfg. Co. v. Ebc Co.*, 192 F.3d 973, 977 (Fed. Cir. 1999).

B. Disputed Claim Terms

1. “pan-shaped housing”

The term “pan-shaped housing” appears in asserted claims 8, 24, 27, 31, and 33.

Complainants’ Position: Complainants contend that “pan-shaped housing” should be given its “plain and ordinary meaning,” which they describe as “a pan-shaped area that defines the litter chamber that ‘houses’ or holds the cat litter.” (AIB at 7.) Complainants point to four places at which the preferred embodiment of the ‘847 patent refers to the “housing” or “pan-shaped housing” as the portion of the litter box that defines the litter chamber to be filled with cat litter. (*Id.* at 7-8.) Complainants argue that Lucky Litter’s proposed construction departs from the plain and ordinary meaning when it adds the description that it “supports the mechanical components of the comb drive.” (*Id.* at 8.)

Respondent Lucky Litter’s Position: Lucky Litter contends that “pan-shaped housing” is “a housing with four walls and a bottom that is upwardly open to be filled to a given level with cat litter that supports the mechanical components of the comb drive.” (LIB at 44.) Lucky Litter points to portions of the specification that describe the workings of the preferred embodiment and argues that the definition should include the description “to support the comb drive mechanism that moves through the litter box.” (*Id.* at 44-45.) Lucky Litter points to the preferred embodiment that it asserts, “discloses that the pan-shaped housing serves two purposes” and adds, “[o]ne is explicitly recited in the claim language: it defines an ‘upwardly open litter chamber to be filled to a given fill level with cat litter.’ RFF 520. The other is to

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support the comb drive mechanism that moves the comb through the litter box. RFF 521.” (*Id.* at 44.)⁴

Respondent OurPet’s Position: OurPet’s takes no position on the definition of “pan shaped housing.”

Commission Investigative Staff’s Position: Staff states that “the plain language should control,” and that Lucky Litter’s proposal adds limitations directed at the support for mechanical components of the comb drive, which “moves too far” from the plain language. (SIB at 12.)

Construction to be applied: “a housing with four walls and a bottom that is upwardly open and which defines the litter chamber.”

In my view the plain and ordinary meaning of this term describes the structure. Lucky Litter’s proposed language regarding support of the mechanical components of the comb drive is beyond the scope of the plain and ordinary meaning of “housing”.

As stated, *supra*, claim construction focuses on the intrinsic evidence, which consists of the claims themselves, the specification, and the prosecution history. *See generally Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). If the intrinsic evidence does not establish the meaning of a claim, then extrinsic evidence may be considered. Extrinsic evidence, however, is generally viewed “as less reliable than the patent and its prosecution history in determining how to read claim terms[.]” *Id.* at 1318. Moreover, “conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court.” *Id.*; *see also Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1361 (Fed. Cir. 2005) (stating that “expert testimony at odds with the intrinsic evidence must be disregarded.”)

⁴ The references to which Lucky Litter alludes are Respondents’ proposed findings of fact based upon the extrinsic evidence of direct testimony by its expert witness Dr. Jonathan Cagan. (RX-236C at ¶ 39.)

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Mr. Cagan's testimony extends well beyond the horizon of a reasonable construction of the term "housing" and attempts to incorporate inferred purposes into the definition of the structure. Having observed his testimony on cross-examination and his explanations of changes in his testimony from his previous deposition testimony, I find that his credibility is diminished sufficiently that his attempt to assist in construing the claim terms of the patent at issue is unhelpful. (Tr. at 446:4-451:25) Lucky Litter's argument based on Mr. Cagan's testimony on this point suffers as a result.

2. "comb drive"

The term "comb drive" appears in asserted claims 8, 31, and 33.

Complainants' Position: Complainants argue that "comb drive" is defined using its plain and ordinary meaning, which they assert is "a motor and gear train." (AIB at 9.) They argue that the words are limited to the structure that drives the comb, not all of the structure involved in moving the comb. They refer to the portion of the specification that reveals "a comb drive that comprises a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41" and that references "the gear train that connects motor 55 to shaft 41," the final gear of which is the only gear that appears in the drawings. (AIB at 10 (citing JX-1 at 3:31-36).)

Respondent Lucky Litter's Position: Lucky Litter argues that the term "comb drive" "includes all of the components necessary to mechanically move the comb. At minimum, 'comb drive' includes 'a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41' and a 'gear train.'" (LIB at 38.) Lucky Litter asserts that the term "comb drive" does not include a worm drive. (*Id.*)

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In addition to the “minimum” described, *supra*, Lucky Litter paraphrases portions of the description of the preferred embodiment that teach the specific structure and function of the comb, carriage and comb drive, including the guide wheels. Lucky Litter argues that the guide wheels, pins, track apertures and tracks all, working together, are necessary to cause the comb to move. Lucky Litter asserts that the “comb drive” must include these additional elements.

To support its position that the term excludes worm drives, Lucky Litter points to portions of the Summary of Invention and a portion of the description of preferred embodiment in the '847 patent. The argument is that a stated object of the present invention is to provide a new and improved drive that is simple and economical in construction and that can afford an extended operating life, requiring little or no attention apart from battery replacement. (LIB at 42.) The '847 patent, according to Lucky Litter, has “disavowed” worm drives as part of the invention. The language to which Lucky Litter refers is a paragraph in the description of the preferred embodiment that says in relevant part:

The gear drive connecting motor 55 to shaft 41 is not subject to fouling by the litter, which often includes powdery material that is likely to interfere with operation of other drive mechanisms such as a worm drive.

(LIB at 42.)

Lucky Litter cites *SciMed Life Sys., Inv. v. Adv. Cardiovascular Sys.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001), in which the court stated “[w]here the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.” Lucky Litter also relies upon *Honeywell Int'l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312 (Fed. Cir. 2006) in which the Federal Circuit reversed the district court’s claim construction, finding that “based on the

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disclosure in the written description, which demeaned the properties of carbon filters, we conclude that the patentee thereby disavowed carbon filters from the scope of the '879 patent's claims." *Id.* at 1319.

Respondent OurPet's Position: OurPet's proposes that the term be construed as "motor and gear train, explicitly excluding worm drive."

Alluding to the same language of the description of preferred embodiment as that used by Lucky Litter and quoted, *supra*, OurPet's argues that the inventor did not intend for the "comb drive" to include "worm drive" and that he specifically disclaimed that inclusion. OurPet's argues that the disclaimer is aimed at U.S. Patent No. 5,048,465 by Carlisi ("Carlisi"), which is discussed in the Background of the Invention section of the '847 Patent. OurPet's says that Carlisi explicitly employs a "worm drive" or "worm gear assembly" that utilizes a worm gear and a worm. (OIB at 33.)

Commission Investigative Staff's Position: Staff argues that the term should be construed as asserted by Lucky Litter and OurPet's.

Construction to be applied: "a motor and gear train for driving the comb."

I find that the term "comb drive" should be given its plain and ordinary meaning. I find, too, that the language upon which Respondents and Staff rely to assert a "disavowal" of worm drives does not amount to a "clear and unequivocal" disclaimer or disavowal of worm drives.

In the absence of an express intent to impart a novel meaning to claim terms, there is a heavy presumption that an inventor's claim terms take on their ordinary meaning from the standpoint of a person of ordinary skill in the relevant art. *Teleflex Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

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In *Phillips*, the court treated the question of the extent to which one should resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims. 415 F.3d at 1312. The first point of interest is the language of the claim terms themselves, which are generally given their ordinary and customary meaning. The ordinary and customary meaning of a claim term is the meaning that term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective date of the patent application. *Id.* at 1313.

Claims, however, do not stand alone. They are part of "a fully integrated written instrument," consisting principally of a specification that concludes with the claims. *Markman*, 52 F.3d at 978. For that reason, claims "must be read in view of the specifications, of which they are a part." *Id.* at 979. The court in *Phillips* added at page 1315, "the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term."

The difficulty, however, is in walking the "fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." *Id.* at 1323 (citation omitted).

In order to avoid the trap of reading a limitation into the claim from the specification, I will limit this definition by its own terms to the mechanism necessary to "drive" the comb. The additional mechanism used to "guide" the comb along its path is not part of the "drive" mechanism. Hence, the guide wheels, pins, track apertures and tracks are not included in the definition given to the term "comb drive" as used in the patent, because while they assist in the proper movement of the comb from the storage position to the discharge position, they do not

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provide the moving force necessary to “drive” the comb. That function is provided by the motor in combination with the gear train.

One way to overcome the presumption that that an inventor’s claim terms take on their ordinary meaning from the standpoint of a person of ordinary skill in the relevant art is to show that, in the specification, the inventor has disavowed or disclaimed the scope of coverage by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. *Id.* at 1319. The question in this case is whether or not the language cited by Respondents and Staff amounts to such a clear disavowal of claim scope.

In *SafeTCare Mfg., Inc., v. Tele-Made, Inc.*, 497 F.3d 1262 (Fed. Cir. 2007), the court found disavowal when a patent described an electric motor and associated structure that exerted a “pushing” force against lift dogs in a hospital bed, rather than exerting a “pulling” force. In that case, the Background section of the patent described prior art as having “electric motors [that] are known to apply a pulling force” on structural members attached to the bed frame. In the Summary of Invention, the inventor distinguished prior art by disclosing that its invention uses motors that apply pushing forces against lift dogs, which are attached to the movable deck sections. *Id.* at 1269-1270. The court quoted three specific instances in the Summary of Invention that reiterated this: “The electric motors apply pushing forces against the lift dogs to cause the front end frame ... to be lifted relative to the floor.” ... “The third and fourth electric motors apply pushing forces against the lift dogs ...” ... “The pushing (as opposed to pulling) forces applied by the electric motors raise the frame and the mattress support deck sections avoid possible injury to a patient in the event that one of the motors should break.” *Id.* at 1270. In the detailed description, the patentee made similar statements emphasizing pushing force being exerted rather than pulling force. At one point, the specification said, “[t]his is in contrast to

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conventional bed frames in which lift motors exert a pulling force against the frame to cause the frame to be lifted and a mattress to be elevated.” The court in *SafeTCare* stated, “[i]n this case, the written description repeatedly emphasized that the motor of the patented invention applies a pushing force, not a pulling force, against the lift dog. The inventor makes clear that this attribute of the invention is important in distinguishing the invention over the prior art.” *Id.* at 1270.

Similarly, in *SciMed*, one of the cases cited by Lucky Litter, the court found disavowal when, at various points, the common specifications of three patents indicated that the claimed invention used “coaxial rather than side-by-side lumens.” 242 F.3d at 1342-45. The common specification and the abstract were consistent in that regard. Also, in discussing the disadvantages of certain prior art structures, the written description of each of the patents explained that the prior art catheters suffered from “several disadvantages,” the first of which was the dual (i.e. side-by-side) lumens, saying, “[t]ypically, such catheters have larger than necessary shaft sizes and are stiffer in their distal regions than would be desired...” Third, in several places, the Summary of Invention described “the present invention” as having “a longitudinally extending annular inflation lumen.” The court stated, “the characterization of the coaxial configuration as part of the “present invention” is strong evidence that the claims should not be read to encompass the opposite structure.” *Id.* at 1343. The court found the “most compelling” portion of the specification to be the passage in the section entitled “Catheter Intermediate Sleeve Section” in which the inflation lumen is described as annular in structure after which the patents recite: “[t]he intermediate sleeve structure defined above is the basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein...” *Id.* at 1343 (emphasis in original). The court said this language defines SciMed’s

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invention in a way that excludes the dual, or side-by-side, lumen arrangement. It said, “[t]he words ‘all embodiments of the present invention’ are broad and unequivocal. It is difficult to imagine how the patents could have been clearer in making the point that the coaxial lumen configuration was a necessary element of every variant of the claimed invention.” *Id.* at 1344. This was found to be a clear case of disclaimer of subject matter that could otherwise have been found to fall within the scope of the claim language.

In the other case cited by *Lucky Litter*, *Honeywell*, the court found a clear disavowal of carbon filters in a fuel filter system designed for use in motor vehicles having electronic fuel injection systems (“EFI”s). 452 F.3d at 1318. The case involved an application for a moldable polymeric material with “conductive filler material” to avoid breakdown of the polymeric material and resultant “arcing” and leakage of the fuel filters. The written description in that patent described stainless steel as an ideal “conductive filler material” for this invention and set forth several reasons why – contrasting stainless steel with electrically conductive carbon fibers, for which it listed less desirable characteristics. While the court in *Honeywell* upheld the district court’s ruling of non-infringement, it reversed a finding that the patent did not disavow carbon fibers in the invention. It pointed out that the written description, on four occasions, referred to the fuel filters as “this invention” or “the present invention.” It found that the written description’s detailed discussion of the prior art problem addressed by the patented invention, viz., leakage of non-metal fuel filters in EFI systems, supports a conclusion that the fuel filter is not a preferred embodiment, but an *only embodiment*. The court pointed to four places in the written description that “demeaned” the properties of carbon filters for various reasons. *Id.* at 1319-20. The court concluded that, “... the patentee informed its readers specifically why carbon filters would not be suitable as ‘electrically conductive fibers’ in the claimed invention.

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If the written description could talk, it would say, ‘Do not use carbon filters.’ There is no other way to interpret the written description’s listing of all the reasons that metal fibers are better than carbon fibers for use in the claimed invention ...” *Id.* at 1320.

Contrasted to *SafeTCare* and *SciMed* is *Paice LLC, v. Toyota Motor Corp.*, 504 F.3d 1293 (Fed. Cir. 2007), in which the technology was drive trains for hybrid electric vehicles. In this case, the court considered the effects of criticism and disavowal, alluding to, among others, *SciMed* in which, the court said, it had been led “to the inescapable conclusion” that the “separate limitation was literally limited in scope to the coaxial configuration.” *Id.* at 1308. One of the issues in *Paice* was criticism of prior art in the form of two patents (Nos. 3,566,717 and 3,732,751 issued to “Berman” and assigned to “TRW” (hereinafter “Berman/TRW”)). The patent at issue in *Paice* pointed to disadvantages of the Berman/TRW design, as follows:

The present invention relates to such a parallel hybrid vehicle, but addresses certain substantial deficiencies of the Berman et al design. For example, Berman et al show two separate electric motor/generators powered by the internal combustion engine to charge batteries and to drive the vehicle forward in traffic. This arrangement is a source of additional complexity, cost and difficulty, as *two separate modes of engine control are required, and the operator must control the transition between the several modes of operation.* Further the gear train shown by Berman et al *appears to be quite complex and difficult to manufacture economically.*

Id. (emphasis in original.)

Toyota argued in *Paice* that the foregoing amounted to criticism and disavowal of Berman/TRW which eliminated Paice’s ability to argue the doctrine of equivalents.

The court discussed *SciMed, Gaus v. Conair Corp.*, 363 F.3d 1284 (Fed. Cir. 2004), and *Dawn Equip. Co. v. Ky. Farms, Inc.*, 140 F.3d 1009 (Fed. Cir. 1998) and found that the primary disadvantage discussed in the quoted language was the control system which relied upon a human operator to select the mode of operation. The court said, “Paice overcame this

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disadvantage by using a microprocessor to determine the most appropriate mode of operation ...” and “Toyota’s drive trains use a microprocessor in the same manner as [the asserted] patent ...” *Id.* at 1309-10. The court found that the discussion of the Berman/TRW design’s disadvantages did not preclude the application of the doctrine of equivalents to Toyota’s accused transaxle units.

More relevant to the case at issue, however, is the court’s comment regarding the gear train, in which it said, “To be sure, the written description of the ‘970 patent does point out that the Berman/TRW ‘gear train ... appears to be quite complex and difficult to manufacture economically.’ Col 3, II, 26-27. However, to the extent Paice drew a distinction between its design and the Berman/TRW design, the distinction is clearly secondary and equivocal at best.” *Paice*, 504 F.3d at 1310.

In this case, I find that the reference in the specification of the preferred embodiment to “worm drives” is clearly secondary and equivocal at best. The Abstract of the ‘847 patent describes an improved automated self-cleaning litter box for cats and states in relevant part,

The improvement includes a sensor for sensing the presence of a cat in the litter chamber, a photo-electric sensor is preferred, but an *infra* red, weight, or even an audible sensor can be used. A delay device actuates the comb drive a predetermined time interval after the sensor ceases to sense the presence of a cat in the litter chamber. In the improved construction the comb path includes multi-perforate track members on opposite sides of the litter chamber; those tracks are engaged by rotatable drive wheels connected to the comb. The comb drive includes a reversible electric motor, mounted on the same carriage as the comb...

The Abstract does not mention or criticize worm drives.

The Background of the Invention portion of the ‘847 patent describes the state of the art related to cat litter boxes and discusses aspects of U.S. Patent No. 5,048,465 (“Carlisi”). It states, “The present invention provides effective improvement for the rake drive of the Carlisi device so that movement of the comb or rake through the litter can be made responsive to entry

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and exit of the cat from the litter box.” (JX-1 at 1:47-50.) In the Summary of the Invention section, the patent at issue describes as its principal object “to provide a new and improved drive for a rake or comb employed to remove litter from a cat litter box, a drive that is directly responsive to the exit of a cat from the litter box.” (*Id.* at 1:59-62.) It describes “[a]nother object of the invention” as providing a new and improved drive for the cat litter box that “does not operate on a periodical basis so that there is no substantial possibility that the comb mechanism will carry out a cleaning operation while a cat is present in the litter box.” (*Id.* at 1:66-2:2.) Third in the list of “objects” of the “present invention” is:

... to provide a new and improved drive for an automated self-cleaning cat litter box that is simple and economical in construction and that can afford an extended operating life, requiring little or no attention apart from battery replacement.

(*Id.* at 2:3-7.)

This phrasing is also found later in the same paragraph of the preferred embodiment asserted by Respondents and Staff to be the clear and unequivocal language of disavowal in this case. The sole comment alleged to be a disavowal says:

The gear drive connecting motor 55 to shaft 41 is not subject to fouling by the litter, which often includes powdery material that is likely to interfere with operation of other drive mechanisms such as a worm drive.

(*Id.* at 8:9-12.)

Based on the foregoing and applying the logic and analysis of the cases cited, *supra*, to the facts here, I must find that the reference in the preferred embodiment to worm drives is at best “secondary and equivocal” and does not amount to a clear and unequivocal disavowal of worm drives. The ‘847 patent contains neither repeated emphasis of the gear drive over a worm drive (similar to *SafeTCare*) nor clear statements that the specific gear drive contained in the preferred embodiment disclaims worm drives in the “present invention” or “for all embodiments

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of the present invention contemplated and disclosed herein...” (evident in *SciMed*). Finally, the reference in *Paice* that was found equivocal and not a disavowal is, in fact, stronger and clearer than the ‘847 patent’s sole reference to worm drives.

3. “comb drive means”

The term “comb drive means” appears in asserted claim 27.

Complainants’ Position: Complainants argue that “comb drive means” has the same meaning as “comb drive” found in claims 8, 31, and 33. (AIB at 18-20.) Alternatively, Complainants argue that if the term is construed pursuant to 35 U.S.C. § 112, ¶ 6, the function is “driving the comb between a storage position and a discharge position” and the disclosed structure is “a motor and gear train.” (*Id.* at 20.)

Respondent Lucky Litter’s Position: Lucky Litter argues that “comb drive means” should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (LIB at 40.) Lucky Litter argues that the function is “driving the comb between a storage position and a discharge position” and the disclosed structure is “a motor and gear train, rotatable shaft, guide wheels, guide pins, tracks, and track apertures.” (*Id.* at 41.)

Respondent OurPet’s Position: OurPet’s argues that “comb drive means” should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (OIB at 29.) OurPet’s argues that the function is “driving the comb that remains in a substantially erect or vertical position between a position near the end wall where the comb is stored a comb position adjacent to the wall that is adjacent to the waste receptacle” and the disclosed structure is a “reversible electric motor mounted on and connected in a driving relationship to the shaft that supports the comb” and “[a] first main guide wheel is affixed to the near end of shaft.” (*Id.*)

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Commission Investigative Staff's Position: Staff agrees with the construction offered by Lucky Litter. (SIB at 24.)

Construction to be applied: the function is “driving the comb between the storage position and the discharge position”; the structure revealed in the specification is “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure.

The claim is stated in classic means plus function terms, and the proper construction is pursuant to 35 U.S.C. § 112, ¶ 6. The scope of the claim limitation must be defined by the structure disclosed in the specification plus any equivalents of that structure.

In this case, the claim and specification clearly teach that the function is driving the comb between the storage position and discharge position. The structure revealed is a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41. (JX-1 at 3:31-36.) The additional language urged by Lucky Litter and Staff, “rotatable shaft, guide wheels, guide pins, tracks, and track apertures” are a part of the guidance system and provide no driving force to the comb.

Respondent OurPet’s proposed construction of the function in this term is well beyond that required by the clear teaching of the claim and specification. OurPet’s proposed structure not only includes guidance mechanism that provides no “drive” to the comb; but it adds superfluous language describing a proposed function of the shaft on which the motor is mounted.

4. “moving means”

The term “moving means” appears in asserted claim 24.

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Complainants' Position: Complainants argue that “moving means” should be construed to mean “a device, like a ‘comb’ or equivalent structure, that projects into the litter, engages clumps, and moves them toward a discharge position.” (AIB at 42.)

Respondent Lucky Litter's Position: Lucky Litter has taken no position on construction of the term “moving means.”

Respondent OurPet's Position: OurPet's argues that the term is not subject to interpretation, thus rendering claims 24 indefinite. (OIB at 41.)

Commission Investigative Staff's Position: Staff agrees with the argument of OurPet's. (SIB at 25.)

Construction to be applied: the function is “engaging clumps in the litter and moving them toward the discharge position;” the structure revealed is a “comb” plus any equivalents of that structure.

This claim is stated in means plus function terms and requires construction pursuant to 35 U.S.C. § 112, ¶ 6. Claim 24 makes clear that the “moving means” is “disposed in the pan-shaped housing,” is supported by the carriage, and that the “moving means” projects down into the litter chamber to a level below the fill level “while the moving means engages clumps in the litter and moves such clumps toward the discharge position.” (JX-1 at 12:59-68.)

As discussed, *supra*, the scope of the claim limitation must be defined by the structure disclosed in the specification plus any equivalents of that structure. In the absence of structure disclosed in the specification to perform the relevant functions, the claim limitation would lack specificity, rendering the claim as a whole invalid for indefiniteness pursuant to 35 U.S.C. § 112, ¶ 2. *Aristocrat Techs. Australia PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1331 (Fed. Cir. 2008); *In Re Donaldson*, 16 F.3d 1189, 1195 (Fed. Cir. 1994).

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The specification describes the structure of “moving means” with crystal clarity, when it says, “As the comb moves across the litter box ... tines 44 engage any clumps 71 present in the litter ... Comb 43 carries those clumps toward the discharge position 28 at the far end of box 20, the right hand end of the litter box as seen in FIGS. 1 and 2.” (JX-1 at 5:64 – 6:2.)

5. “drive means”

The term “drive means” appears in asserted claim 24. The parties agree that “drive means” should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (AIB at 20; OIB at 30; SIB at 25.)

Complainants’ Position: Complainants argue that the function is “driving the moving means between a storage position and a discharge position” and the disclosed structure is a reversible electric motor and gear train and equivalents thereof. (AIB at 20.)

Respondent Lucky Litter’s Position: Lucky Litter has taken no position on construction of the term “drive means.”

Respondent OurPet’s Position: OurPet’s argues that the function is “driving the comb that remains in a substantial erect or vertical position between a position near the end wall where the comb is stored and a comb position adjacent to the wall that is adjacent to the waste receptacle” and the disclosed structure is “a reversible electric motor mounted on and connected in a driving relationship to the shaft that supports the comb” and “[a] first main guide wheel is affixed to the near end of shaft.” (OIB at 30.)

Commission Investigative Staff’s Position: Staff does not offer a proposed function, but argues that the disclosed structure is “the electric motor 55, mounted on shaft 41, a guide wheel 52, guide pins 52A, track 32, track apertures 32A.” (SIB at 25-26.)

Construction to be applied: the function is “driving the moving means between the storage position and the discharge position”; the structure revealed in the specification is “a

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reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure.

The arguments related to construction of this term are virtually identical to those set forth regarding the term “comb drive means,” *supra*. I reiterate, the claim clearly teaches that the function is driving the comb between the storage position and discharge position, and the structure revealed in the specification is a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41. (JX-1 at 3:31-36.) The additional language urged by Lucky Litter and Staff, “rotatable shaft, guide wheels, guide pins, tracks, and track apertures” are a part of the guidance system and provide no driving force to the comb.

Respondent OurPet’s proposed construction of the function in this term is well beyond that required by the clear teaching of the claim and specification. The proposed structure not only includes guidance mechanism that provides no “drive” to the comb; but it adds superfluous language describing a proposed function of the shaft on which the motor is mounted.

6. “discharge end wall”

The term “discharge end wall” appears in asserted claim 8.

Complainants’ Position: Complainants assert that the term “discharge end wall” should be given its “plain and ordinary meaning,” which they argue is “the wall at the other end of the litter box from the storage end wall that the comb is driven toward on its way to the comb discharge position.” (AIB at 40.)

Respondent Lucky Litter’s Position: Lucky Litter has taken no position on construction of the term “discharge end wall.”

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Respondent OurPet's Position: OurPet's has offered no position on construction of the term "discharge end wall."⁵

Commission Investigative Staff's Position: Staff argues that the term should be given its plain and ordinary meaning, and takes no exception to the Complainants' assertion regarding that "plain and ordinary meaning".

Construction to be applied: "the wall at the opposite end of the litter box from the storage end wall and toward which the comb is driven on its way to the comb discharge position." (JX-1 at 2:39-41; 10:17-19.)

7. "carriage"

The term "carriage" appears in asserted claims 8, 24, and 31.

Complainants' Position: Complainants argue that "carriage" should be given its ordinary meaning, which they assert is "a 'carriage' or carrier for the comb." (AIB at 38.)

Respondent Lucky Litter's Position: Lucky Litter has taken no position on construction of the term "carriage."

Respondent OurPet's Position: OurPet's argues that "carriage" means "motor, gear train, battery case, and batteries carried by a rotatable shaft." (OIB at 39.) OurPet's supports its construction by arguing that the specification expressly defines "carriage" when it states that "[m]otor 55 and the gear train represented by gear 57, as well as battery case 56, are supported by shaft 41; in conjunction with the shaft, they constitute the carriage for the comb 43 in litter box 20." (JX-1 at 3:38-41.)

⁵ While Respondent OurPet's offers no construction for this term, at page 30 of its brief it refers to "a ... position between a position near the end wall where the comb is stored and a comb position adjacent to the wall that is adjacent to the waste receptacle."

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Commission Investigative Staff's Position: Staff argues that “carriage” means “the structural element that ‘carries’ the comb through the self-cleaning litter box.” (SIB at 15.)

Construction to be applied: “the structural element that supports and carries the comb through the self-cleaning litter box.”

In each of claims 8, 24, and 31, the claim language makes clear that the carriage is a structural element that supports the comb. For example, claim 8 requires “a carriage supporting the comb[.]” (JX-1 at 10:37.) The specification is consistent with the claim language, as it depicts the carriage as a structure that supports the comb and carries it through the self-cleaning litter box. (*See, e.g.*, JX-1 at 5:48-50; Figs. 1-3.) Therefore, I find that the proper definition for “carriage” is “the structural element that supports and carries the comb through the self-cleaning litter box.”

OurPet’s argues for a much narrower construction that would require that the carriage be made up of certain parts such as the motor, gear train, battery case, and batteries. (OIB at 40.) OurPet’s bases this argument on a passage from the specification which describes the preferred embodiment. This language from the specification merely explains what constitutes the carriage in the particular preferred embodiment and does not give any indication that “carriage” should be so limited throughout the patent. *Phillips*, 415 F.3d at 1323 (“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”)

The claim language in claims 8 and 31 also contradicts the construction proposed by OurPet’s. Claims 8 and 31 include an additional limitation of a motor mounted on the carriage. Including the motor as part of the construction of carriage would render the additional limitation superfluous.

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8. “mode selector means”

The term “mode selector means” appears in asserted claim 27.

Complainants’ Position: Complainants argue that this term should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (AIB at 33.) Complainants assert that the claimed function is “selecting between at least manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” (*Id.*) Complainants assert that the disclosed structure is a switch and equivalents thereof, because the specification discloses that a switch is used to select between modes. (*Id.*) Complainants argue that Respondents’ attempt to limit the type of switch that may be used is inappropriate, as the specification does not require a specific type of switch. (*Id.* at 34-35.)

Respondent Lucky Litter’s Position: Lucky Litter argues that this term should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (LIB at 45.) Lucky Litter asserts that the claimed function is “selecting between at least manual operation mode and an automatic operation mode.” (*Id.*) Lucky Litter asserts that the disclosed structure is a switch that has two different positions; one for manual mode and the other for automatic mode. (*Id.*) Lucky Litter explains that the claim language dictates a construction that includes a switch “with at least two spatial positions such that it permits the user to select between two modes of operation.” (LIB at 45.) Thus, Lucky Litter argues that because the claim language requires a switch to select “between” two modes, the switch must have two different stationary positions.

Respondent OurPet’s Position: OurPet’s argues that this term should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (OIB at 34.) OurPet’s asserts that the claimed function is “selecting between at least a manual operation mode for said comb drive means and an automatic

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operation mode for said comb drive means.” (*Id.*) OurPet’s asserts that the disclosed structure is a mode select switch. (*Id.*)

Commission Investigative Staff’s Position: Staff argues that this term should be construed pursuant to 35 U.S.C. § 112, ¶ 6. (SIB at 16.) Staff asserts that the claimed function is “selecting between a manual operation and an automatic operation mode.” (*Id.* at 18.) Staff asserts that the disclosed structure is “the microprocessor control 96, the control’s algorithm described at col. 7:20-26 and Fig. 7 (items 113 and 114), and switch 91.” (*Id.*)

Construction to be applied: The function is “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” The disclosed structure is “a switch and a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 and accompanying text” plus any equivalents of that structure.

The parties all agree that this term should be construed pursuant to 35 U.S.C. § 112, ¶ 6. Further, the parties agree in substance regarding the claimed function. The parties’ dispute centers on the disclosed structure.

I find that the structure required to perform the function of selecting between at least the two modes of operation is a switch in combination with a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in the specification. The private parties seek to limit the structure to a switch, but a “switch” does not adequately identify the structure necessary to perform the function of selecting between the modes. Therefore, I find that the structure must include a microprocessor programmed to perform the algorithm of switching between the modes.

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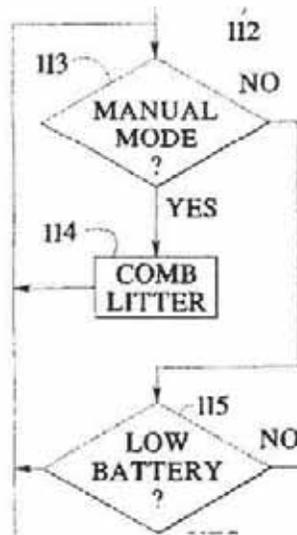
A microprocessor itself is not sufficient structure under 35 U.S.C. § 112, ¶ 6. As the Federal Circuit explained:

In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.

WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348-49 (Fed. Cir. 1999); *see also Aristocrat Techs. Australia PTY Ltd.*, 521 F.3d at 1333 (“In cases involving a computer-implemented invention in which the inventor has invoked means-plus-function claiming, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.”)

Thus, the structure must be limited to a microprocessor programmed to perform the algorithm disclosed in the specification. *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1249 (Fed. Cir. 2005) (“[T]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.”); *WMS Gaming*, 184 F.3d at 1348-49 (same). In reviewing the specification, I find that there is only a single algorithm for selecting between the manual and automatic modes, and the algorithm is depicted as part of Figure 7. Specifically, subroutine stage 113 of Figure 7 is where the microprocessor selects between a manual and automatic mode based on the mode select switch 91: “[i]n the next subroutine stage 113, the micro controller checks to determine whether the mode select switch 91 of FIG. 5 is set for manual mode.” (JX-1 at 7:20-22.) Subroutine stage 113 is depicted in Figure 7:

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As Figure 7 and accompanying description make clear, if the output of subroutine stage 113 is “NO,” then the litter box continues in automatic mode, with combing occurring only after cat exit plus a delay. (See JX-1 at 7:30-64; Fig. 7.)

Therefore, I find that the function is “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means” and the disclosed structure is a switch and a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 and accompanying text.

Lucky Litter’s proposed construction seeks to limit the structure to a switch that has two different stationary positions. (LIB at 45.) Lucky Litter states that “[a]lthough the specification does not describe the structure of the switch, the claim language indicates that the switch is one with at least two spatial positions such that it permits the user to select between two modes of operation.” (LIB at 45.)

I decline to further limit the switch as Lucky Litter advocates. Lucky Litter is attempting to limit the claim to require a switch that stays in one position when the litter box is in manual mode and stays in a second position when the litter box is in automatic mode. The fact that the

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claim language requires the mode selector means to select between two modes does not limit the switch to the type of switch contemplated by Lucky Litter.

Further, there is no support for such a limitation in either the specification or prosecution history. As Lucky Litter already conceded, the specification does not limit the type of switch that can be used. (LIB at 45.) Lucky Litter points to a passage in the prosecution history in claiming that the patentee's statements during prosecution require that the claimed mode selector means have two different positions. (*Id.*) This passage fails to support Lucky Litter's argument, as the discussion identified in the prosecution history relates to claim 33 and not claim 27. (*See* JX-2 at 375.) Claim 33 includes different claim language ("mode selector switch...being moveable between...") that will be addressed *infra*.

9. **"manual operation mode"**

The term "manual operation mode" appears in asserted claim 27.

Complainants' Position: Complainants argue that "manual operation mode" means "a mode of operation where combing is initiated in response to human-based input." (AIB at 21.) Complainants assert that the intrinsic and extrinsic evidence demonstrates that one of skill in the art would understand manual operation "as simply a human causing the comb to move through the litter, for instance, by pushing a switch." (*Id.*) Complainants claim that Respondents' construction that is unnecessarily limiting and inconsistent with the patent. (*Id.* at 22-24.)

Respondents' Position: Lucky Litter and OurPet's argue that "manual operation mode" means a mode in which self-cleaning of the litter box is continued on a cyclical basis. (LIB at 46; OIB at 38.) Respondents focus on a single sentence in the specification and claim that this sentence defines the "manual operation mode." (LIB at 46; OIB at 38.) The sentence in the

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specification that the Respondents rely on states that “[s]o long as the manual mode is maintained, self-cleaning of the litter box is continued on a cyclical basis.” (JX-1 at 7:24-26.)

Commission Investigative Staff’s Position: Staff argues that “manual operation mode” should be construed as part of the means-plus-function claim language found in claim 27. (SIB at 21.) Staff therefore argues that “manual operation mode” means “self-cleaning of the litter box continued on a cyclical basis.” (*Id.*) Alternatively, Staff agrees with Complainants’ proposed construction if the term is not construed as part of the means plus function analysis. (*Id.*)

Construction to be applied: “a mode of operation where combing is initiated in response to human-based input”.

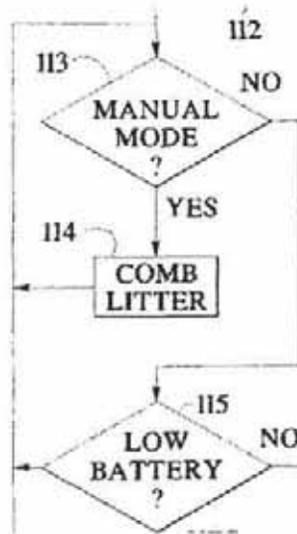
The term “manual operation mode” appears in the phrase “mode selector means for selecting between at least a manual operation mode for said comb drive means...” (JX-1 at 13:36-37.) The specification describes the “manual operation mode” when explaining the flow chart depicted in Figure 7:

In the next subroutine stage 113, the micro controller checks to determine whether the mode select switch 91 of FIG. 5 is set for manual mode. If it is, a comb litter procedure is initiated in step 114 and there is a feedback output back to subroutine stage 113. So long as the manual mode is maintained, self-cleaning of the litter box is continued on a cyclical basis. This may be desirable when the person using litter box 20 wants to make sure that all clumps have been removed from the litter in the box so that the liter can be replaced.

(JX-1 at 7:20-29.) The ordinary meaning of “manual” as evidenced by a dictionary definition is “of, relating to, or involving the hands <~ dexterity>.” WEBSTER’S NEW COLLEGIATE DICTIONARY, (1979 ed.) pp. 694-95. Based on the above intrinsic and extrinsic evidence, I find that “manual operation mode” is “a mode of operation where combing is initiated in response to human-based input.”

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Respondents fail to correctly understand the meaning of the statement “[s]o long as the manual mode is maintained, self-cleaning of the litter box is continued on a cyclical basis.” (JX-1 at 7:24-26.) The statement comes as part of the explanation of the flow chart in Figure 7. The flow chart has a subroutine stage 113 for “Manual Mode.” This subroutine stage 113 from Figure 7 is again depicted below:



If the “Manual Mode” is “YES,” the litter is combed and the microprocessor repeats the step of checking to see if the “Manual Mode” is activated. (See JX-1 at Fig. 7.) If the “Manual Mode” is “NO,” the microprocessor routine continues to the next stage, which is checking to see if the battery power is low. (*Id.*)

In the sentence on which Respondents focus, the specification explains that if the manual mode is maintained, the comb will run in a cyclical fashion. The key word is “maintained,” and Respondents fail to acknowledge it. As Figure 7 makes clear, if the manual mode is only selected a single time, the comb will only cycle a single time. If the manual mode is “maintained,” the comb will continually cycle. The specification even provides an example of when a user would want to “maintain” the manual mode: “[t]his may be desirable when the person using litter box 20 wants to make sure that all clumps have been removed from the litter

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in the box so that the liter can be replaced.” (JX-1 at 7:26-29.) Therefore, this passage in the specification does not define or limit “manual operation mode” as alleged by Respondents.

Staff argues that because “manual operation mode” appears in the phrase beginning with the term “mode selector means,” it should be construed as part of the means-plus-function element. I do not concur.

The term “mode selector means” is a means-plus-function term because it describes a structure in terms of its function. 35 U.S.C. § 112, ¶ 6 (2008). The specific function of the “mode selector means” is “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” Thus the structure in the specification that limits this means-plus-function term is only the structure necessary to select between the modes. **The definition of “manual operation mode” is not part of this means-plus-function analysis.** The “manual operation mode” is merely one of the modes between which the microprocessor selects in performing the solution to the disclosed algorithm.

Both “manual operation mode” and “automatic operation mode” have their own definitions wholly apart from the construction of “mode selector means.” Following Staff’s logic would improperly limit the “mode” terms to the preferred embodiment. Staff’s proposed construction also results from the misapprehension of the specification and the proper application of the word “maintained” as discussed *supra*.

10. “automatic operation mode”

The term “automatic operation mode” appears in asserted claim 27.

Complainants’ Position: Complainants argue that “automatic operation mode” means “a mode of operation where combing is initiated in response to cat-based input plus a time delay.” (AIB at 25.) Complainants argue that the specification “effectively defines” the term

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“automatic” to mean combing in response to cat-based input plus a time delay. (AIB at 25.)

Complainants therefore claim that statements in the specification require the adoption of a narrow definition for otherwise broad claim language.

Respondents’ Position: Lucky Litter and OurPet’s argue that “automatic operation mode” is a mode where “the rake is self-acting under pre-determined conditions, such as timer or sensor.” (OIB at 39; *see also* LIB at 46.) The Respondents seek a construction that adopts the alleged ordinary meaning of “automatic,” such that combing is initiated upon the occurrence of some pre-determined condition. The pre-determined condition, according to Respondents, could be set by a timer or sensor. (*See, e.g.*, LIB at 46.) Respondents claim that the specification should not be used to limit this claim term. Lucky Litter cites to prior art patents considered by the examiner during prosecution as evidence of the meaning of “automatic.” (*Id.* at 46-47.)

Commission Investigative Staff’s Position: Staff argues that “automatic operation mode” should be construed as part of the means-plus-function claim language found in claim 27. (SIB at 22.) Staff therefore argues that “automatic operation mode” means “self-cleaning of the litter box based on cat presence and subsequent cat absence delay.” (*Id.*) Alternatively, Staff argues that “automatic operation mode” means “a mode that is triggered by some external event whether it be a timer, a cat sensor, a weight sensor, or some other trigger that would cause the comb to operate.” (*Id.*)

Construction to be applied: “a mode of operation where combing is initiated in response to a cat exit.”

The term “automatic operation mode” appears in the phrase “mode selector means for selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” (JX-1 at 13:36-39.)

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I find that a proper reading of the entire patent leads to a narrow meaning of “automatic operation mode.” In the claim language, there is nothing to indicate any limitation based on cat exit. But in this instance claim construction requires looking at more than just the claim language. The specification must be reviewed to determine the correct meaning of the claim terms. *See Phillips*, 415 F.3d at 1315-17. Here, the specification indicates the purpose of the invention and distinguishes the invention over the most pertinent prior art.

The specification clearly and unambiguously states that the “present invention” requires combing in response to the exit of the cat from the litter box. In the Background of the Invention, the prior art Carlisi patent is distinguished:

The self-cleaning cat litter box disclosed in the Carlisi patent utilizes a rake or comb that is normally maintained in a storage position at one end of the litter chamber. This comb is moved through the litter, periodically, from the rake storage end of the chamber to the opposite end, which constitutes a discharge end for the chamber. At the discharge end of the chamber the rake moves up out of the litter and discharges any clumps collected by the comb into a disposal receptacle. **The present invention provides effective improvement for the rake drive of the Carlisi device so that movement of the comb or rake through the litter can be made responsive to entry and exit of the cat from the litter box.** Cats are no more constant in their elimination habits than human beings; periodic cleaning may be inappropriate.

(JX-1 at 1:39-56 (emphasis added).) In the Summary of the Invention, there are additional statements defining the “present invention:”

It is a principal object of the **present invention**, therefore, to provide a new and improved drive for a rake or comb employed to remove litter from a cat litter box, a drive that is **directly responsive to the exit of a cat** from the litter box.

(*Id.* at 1:59-62 (emphasis added).)

Another object of the invention is to provide a new and improved drive for a self-cleaning cat litter box that is capable of remaining in, operation for extended periods of time without attention from the cat owner and **that does not operate on a periodical basis so that there is no substantial possibility that the comb mechanism will carry out a cleaning operation while a cat is present in the litter box.**

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(*Id.* at 1:63-2:2 (emphasis added).)

These passages demonstrate that the inventor acknowledged that Carlisi disclosed periodic cleaning. The passages further demonstrate that the inventor was now trying to improve on the invention disclosed in Carlisi. Thus, the specification explicitly distinguishes Carlisi and notes that the “present invention” provides an improvement over Carlisi because combing is activated in response to the exit of the cat from the litter box, and not on a periodic basis. Additionally, the specification explains why periodic cleaning is undesirable, stating that the periodic cleaning may occur when a cat is in the litter box. (JX-1 at 1:51-52; 1:63-2:2.)

The combination of emphasizing the importance of the responsive cleaning feature of the “present invention” as well as distinguishing the invention over Carlisi based on this feature amounts to a clear and unambiguous disavowal of periodic combing and requires that the claims be limited to combing in response to cat exit. *SafeTCare Mfg., Inc.*, 497 F.3d at 1269-70 and *Honeywell Int’l, Inc.*, 452 F.3d at 1318, *supra*; see also *Verizon Services Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”) Based on the foregoing, I find that “automatic operation mode” means “a mode of operation where combing is initiated in response to a cat exit.”

Complainants correctly argue that the specification limits the claim term, but their proposed construction is too limiting. Complainants’ proposed construction requires a time delay between when the cat leaves the litter box and when the comb begins combing. (AIB at 25-31.) I find that this would be inappropriate, as there is no mention of the delay in the specification as being a necessary feature of the “present invention.” The delay is not mentioned in distinguishing the invention from Carlisi or in explaining the objects of the invention. The

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discussion of delay only appears in the specification during description of the preferred embodiment. (See, e.g., JX-1 at 5:19-42; 7:65-8:5.) Importing such a delay limitation into the claim from the preferred embodiment would be improper. *Phillips*, 415 F.3d at 1323.

Additionally, other claims include limitations relating to the delay feature. (See, e.g., claims 1 and 13.) In *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-972 (Fed. Cir. 1999) the court explained that claim differentiation is “based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope.” There, the court found that claim differentiation supported a construction of “series of threads” that was broader than the specialized interrupted threads disclosed in the preferred embodiment because a dependent claim added the feature of interrupted threads to the independent claim including the “series of threads” limitation. *Id.*

Complainants claim that the specification’s statement that the litter box “does not operate on a periodical basis so that there is no substantial possibility that the comb mechanism will carry out a cleaning operation while a cat is present in the litter box” is a “clear indication” that there is a delay before raking. (AIB at 27.) To the contrary, this statement is only clear in stating that the invention does not utilize combing on a periodic basis. There is nothing in this statement that clearly requires a delay after the cat leaves the box. This statement therefore cannot serve to import the delay limitation into the claims.

Respondents point to prior art patents cited during prosecution to show that those patents define “automatic” consistently with Respondents’ construction. (AIB at 46-47.) While prior art cited during the patent prosecution is part of the intrinsic record, it cannot overcome the clear statements made by the inventor in the specification. The cited prior art may provide a helpful tool for discerning the ordinary meaning of a term as understood by one of skill in the art, but the

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inventor may alter that meaning through statements made in the specification and/or prosecution history. See *Teleflex, Inc.*, 299 F.3d at 1325-1326. That is what occurred when the inventor disavowed periodic cleaning and limited the invention to cleaning in response to cat exit.

Respondents point to the prosecution history to support their construction. Specifically, Respondents argue that the examiner's characterization of U.S. Patent No. 4,844,011 to Strickland ("Strickland") as disclosing automatic operation demonstrates that Complainants' understood "automatic" to have its ordinary meaning. Respondents make this argument because, according to them, "Applica did not dispute the Examiner's statement." (LRB at 33.)

There are at least two reasons why Respondents' assertion is incorrect. First, the examiner's statement cited on page 33 of Lucky Litter's reply brief does not define "automatic." The examiner simply contends that Strickland discloses "a litter box in which cleaning thereof can be automatically preformed [*sic*]." (JX-2 at 384.) This does nothing to define automatic in the context of the '847 patent.

Second, assuming *arguendo* that the examiner's statement defined "automatic," the applicant's silence in response to the statement cannot serve to limit the applicant to a definition provided by the examiner. *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373-74 (Fed. Cir. 2003) ("An applicant's silence in response to an examiner's characterization of a claim does not reflect the applicant's clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on grounds unrelated to the examiner's unrebutted characterization.") Claim 27 was ultimately allowed for reasons unrelated to the examiner's statements regarding the term "automatic." It was allowed after the applicant added the phrase "for said comb drive means" to distinguish Strickland. (JX-2 at 393.) Because

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Strickland used a conveyor belt system and not a combing system, the added claim language apparently overcame the examiner's rejection. (*Id.*)

Respondents argue that dependent claim 41 precludes the construction that I have adopted based on the doctrine of claim differentiation. Claim 41 states:

The litter box of claim 27 further comprising a sensor system for determining whether a cat is in the litter chamber.

(JX-1 at 15:33-34.) Respondents argue that if “automatic operation mode” is construed to mean a mode of cleaning where combing is initiated in response to cat exit, then the litter box of claim 27 must already include a sensor system. (LIB at 48.)

Lucky Litter provides the response to its own argument in footnote three of its opening brief. (*See id.*) While the doctrine of claim differentiation creates a presumption that dependent claims are narrower in scope than the independent claim they depend on, the presumption is rebuttable. *Regents of the Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1375 (Fed. Cir. 2008) (finding that statements made during prosecution overcame the presumption of claim differentiation). Specifically, the “presumption is not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history.” *Seachange Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005); and *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1368 (Fed. Cir. 2000). In *Seachange*, two claims were nearly identical except that one claim explicitly required a point-to-point data interconnection while the other did not. 413 F.3d at 1369. The court nevertheless found that statements made during prosecution limited the claims and overcame the presumption of claim differentiation. *Id.* at 1369-1375. Thus the prosecution history mandated that both claims be construed to require a point-to-point interconnection. *Id.*

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Here, the statements in the specification overcome any presumption raised by claim 41. The above-quoted statements from the Background and Summary sections clearly define the purpose of the “present invention” by distinguishing Carlisi and explaining the importance of driving the comb based on the exit of the cat from the litter box. These strong and unequivocal statements are exactly the type of statements that can overcome a presumption created by the doctrine of claim differentiation.

Respondents fail to address how the statements in the specification square with their proposed construction. Under Respondents’ proposed construction – “the rake is self-acting under pre-determined conditions, such as timer or sensor” – periodic cleaning based on a timer would be covered under “automatic operation mode.” This construction cannot stand in view of the specification, as the specification clearly and unequivocally disavows the invention performing periodic cleaning (i.e. cleaning based on a timer). (*See, e.g.*, JX-1 at 1:63-2:2 “Another object of the invention is to provide a new and improved drive for a self-cleaning cat litter box...that does not operate on a periodical basis...”)

As with “manual operation mode,” Staff attempts to tie “automatic operation mode” to the means-plus-function term “mode selector means.” For all of the reasons described *supra*, this is an incorrect extension of the application of 35 U.S.C. § 112, ¶ 6. The structure in the specification that limits “mode selector means” is the structure necessary to select between the modes. The definition of “automatic operation mode” is not part of the means-plus-function analysis.

11. “mode selector switch”

The term “mode selector switch” appears in asserted claim 33.

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Complainants' Position: Complainants argue that a “mode selector switch” is “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.” (AIB at 36.) Complainants assert that this term should be given its plain and ordinary meaning, and should not be limited to a switch that maintains stationary positions. (*Id.*)

Respondent Lucky Litter's Position: Lucky Litter argues that a “mode selector switch” is “a switch that has two separate positions: a manual operation position as its first position and an automatic operation position as its second position.” (LIB at 48.)

Respondent OurPet's Position: OurPet's argues that a “mode selector switch” is “[a] switch moveable between two positions.” (OIB at 36.) In arguing its proposed construction, OurPet's claims that the “mode selector switch” claim element “requires that the switch be spatially changeable with one location of the switch relating to manual operation and the second location of the switch relating to automatic operation.” (*Id.*)

Commission Investigative Staff's Position: Staff does not offer a construction, but it argues that the plain language of claim 33 “requires that the [mode selector] switch be spatially changeable with one location of the switch relating to manual operation and the second location of the switch relating to automatic operation.” (SIB at 26.)

Construction to be applied: “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.”

The term “mode selector switch” appears in claim 33 in the phrase “a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position...and an automatic operation position...” (JX-1 at 14:22-28.) The dispute between the parties centers on whether the “mode selector switch” must have two stationary

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positions. Respondents and Staff argue that each of the switch positions must be stationary so that the switch remains in that position while in the selected mode. With this construction, Respondents and Staff seek to exclude switches such as a momentary switch, which does not remain in a “down” position after pushed.

I decline to limit the term as advocated by Respondents and Staff. The claims do not include any limitation requiring the switch positions to be stationary. The specification does not clearly limit the claim to require the switch positions to be stationary. What the specification describes is an embodiment where a switch may be “set.” (*See, e.g.*, JX-1 at 7:14-44.) While this may imply that the switch of the preferred embodiment has two fixed positions (such as a light switch), there is nothing in this embodiment that requires limiting the claim. Adding the limitation suggested by Respondents and Staff would improperly import a limitation to the claim from the specification. *Phillips*, 415 F.3d at 1323.

What the claim language does require is that the switch be moveable between two positions. In *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1273-74 (Fed. Cir. 1999), the Federal Circuit analyzed claim language similar to the language found in claim 33 and found that the claim language did not require the switch positions to be stationary.

In *Overhead Door*, the patent-in-suit related to a garage door operator that allowed for the use of multiple transmitters with different coded signals. One of the claims at issue included the following element: “a switch moveable between program and operate positions connected to said microprocessor to place said microprocessor in the operate or program mode.” *Id.* at 1265. The Federal Circuit affirmed the district court’s claim construction, which was a “moveable[] switch connected to the microprocessor having at least two positions.” *Id.* at 1273. In affirming

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the construction, the court explicitly stated that “neither the claim language nor the specification requires each switch position to be stationary and completely user-selected.” *Id.* at 1273-74.

Applying the construction for the “switch moveable” element, the court found that the momentary switch of the accused device literally met the claim limitation:

Applying the trial court’s correct claim construction to the accused device, this court affirms the district court’s finding that the Intellicode’s two-position, spring-loaded, push-button switch satisfies the “switch moveable” limitation. In affirming, this court understands that the accused switch returns to a stationary position when the user releases the push-button. The parties do not dispute that the program/operate switch of the Intellicode is “a mechanical, two position, user-operated switch.” Overhead Door urges, however, that its momentary switch does not have an operate position, the program position is not stationary, and the switch does not permit the user to select the “operate” mode. This court finds this argument unpersuasive. The Intellicode two-position switch is “a mechanical switch movable between an operate and program position at least momentarily and is connected to the microprocessor.” Thus, this court affirms the district court’s summary judgment ruling insofar as it rested on the finding that the Intellicode literally meets the “switch moveable” requirement.

Id. at 1274.

The intrinsic evidence does not demonstrate the patentee’s intent to deviate from the plain language of the claims. Therefore, I find that the proper construction of “mode selector switch” is “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.”

12. “manual operation position”

The term “manual operation position” appears in asserted claim 33.

Complainants’ Position: For the same reasons as articulated for the term “manual operation mode,” Complainants argue that “manual operation position” means “a position of the switch where combing is initiated in response to human-based input.” (AIB at 25.)

Respondents’ Position: For the same reasons as articulated for the term “manual operation mode,” Lucky Litter and OurPet’s argue that “manual operation position” means a

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position in which self-cleaning of the litter box is continued on a cyclical basis. (LIB at 48; ORB at 34.)

Commission Investigative Staff's Position: Staff does not offer a construction for “manual operation position.”

Construction to be applied: “a position of the mode selector switch where combing is initiated in response to human-based input.”

The term “manual operation position” appears in claim 33 in the phrase “a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position wherein an operator causes the comb to move toward the discharge position...” (JX-1 at 14:21-24.) The parties present the same arguments for “manual operation position” as they do for “manual operation mode.” Based on the foregoing discussion of “manual operation mode,” I find that the correct construction of “manual operation position” is “a position of the mode selector switch where combing is initiated in response to human-based input.”⁶

13. “automatic operation position”

The term “automatic operation position” appears in asserted claim 33.

Complainants' Position: For the same reasons as articulated for the term “automatic operation mode,” Complainants argue that “automatic operation position” means “a position of the switch where combing is initiated in response to a cat-based input plus a time delay.” (AIB at 32.)

Respondent Lucky Litter's Position: For the same reasons as articulated for the term “automatic operation mode,” Lucky Litter argues that “automatic operation position” means that

⁶ The inclusion of the claim language “wherein an operator causes the comb to move toward the discharge position” in claim 33 presents additional intrinsic evidence to support my adopted construction for “manual operation position.”

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“the rake is self-acting under pre-determined conditions such as a timer or sensor.” (LIB at 46, 48.)

Respondent OurPet’s Position: For the same reasons as articulated for the term “automatic operation mode,” OurPet’s argues that “automatic operation position” means “[a] physical location of the switch corresponding to the rake self-acting under pre-determined conditions, such as timer or sensor.” (ORB at 37.)

Commission Investigative Staff’s Position: Staff does not offer a construction for “automatic operation position.”

Construction to be applied: “a position of the mode selector switch where combing is initiated in response to a cat exit.”

The term “automatic operation position” appears in claim 33 in the phrase “a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position...and an automatic operation position wherein the comb moves toward the discharge position automatically upon the occurrence of a predetermined event.” (JX-1 at 14:21-27.) The parties present the same arguments for “automatic operation position” as they do for “automatic operation mode.” Based on the foregoing discussion of “automatic operation mode,” I find that the correct construction of “automatic operation position” is “a position of the mode selector switch where combing is initiated in response to a cat exit.”

IV. INVALIDITY

It is Respondents’ burden to prove invalidity, and the burden of proof never shifts to the patentee to prove validity. *Scanner Techs. Corp. v. ICOS Vision Sys. Corp. N.V.*, 528 F.3d 1365, 1380 (Fed. Cir. 2008). “Under the patent statutes, a patent enjoys a presumption of validity, *see*

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35 U.S.C. § 282, which can be overcome only through facts supported by clear and convincing evidence[.]” *SRAM Corp. v. AD-II Eng’g, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006).

A. Best Mode

1. Applicable Law

The best mode requirement is found in 35 U.S.C. § 112, ¶ 1, which states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and **shall set forth the best mode contemplated by the inventor of carrying out his invention.**

(Emphasis added.)

The statutory language requires a written description of the invention and contains two additional mandates regarding the content of the specification. The first is generally called the “enablement” requirement, which instructs that a patent specification must disclose an invention in such a manner as will enable one skilled in the art to make and utilize it. The second mandate, relevant here, requires the inventor to disclose the best mode *contemplated by him*, as of the time he files the application, of carrying out his invention.

“The purpose of the best mode requirement is to restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of the inventions they have in fact conceived.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1330 (Fed. Cir. 2002).

A holding of invalidity for failure to disclose the best mode requires clear and convincing evidence that the inventor both knew of and concealed a better mode of carrying out the claimed invention than was set forth in the specification. *Transco Prods., Inc. v. Performance*

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Contracting, Inc., 38 F.3d 551, 560 (Fed. Cir. 1994) (citing *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1578 (Fed.Cir.1991).)

The clear and convincing evidence standard placed on the party asserting the invalidity defense requires a level of proof beyond the preponderance of the evidence. Although not susceptible to precise definition, “clear and convincing” evidence has been described as evidence which produces in the mind of the trier of fact “an abiding conviction that the truth of [the] factual contentions are ‘highly probable’.” *Price v. Symsek*, 988 F.2d 1187, 1191 (Fed. Cir. 1993) (citing *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed.Cir.1988).)

2. Positions of the Parties

Respondent Lucky Litter’s Position: Respondent Lucky Litter argues that the ‘847 patent is invalid because its inventor failed to disclose the best mode. Lucky Litter asserts that, prior to filing his patent application, the patentee, Mr. Waters, knew that the bottom of the pan must be made of a “releasing material” (e.g. polypropylene or Teflon) to avoid problems with clumps sticking to the bottom of the pan or to the rake. Lucky Litter contends that he failed to disclose this information in the specification. (LIB at 10, 14.)

Lucky Litter points to Mr. Waters’ deposition testimony in which he said that as of June 21, 1994, he knew that “selection of the wrong material for the base pan would have caused the clumps to stick to the bottom, and then you’d have insufficient power to drive the rake through.” He testified that he knew it had to be a releasing material “like a polypropylene versus a Teflon.” (LIB at 12 (citing Tr. at 580:2-583:18, 585:3-14).)⁷

Lucky Litter argues that, Mr. Waters testimony at the hearing that he had not understood the need for a releasing material until after he had filed his patent application on January 12,

⁷ In their briefs the parties frequently cite their own proposed Findings of Fact by number. For clarity and easier reference to actual evidence, I will instead refer throughout this Initial Determination to the underlying evidence they cite in their proposed Findings of Fact.

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1995, was impeached by a mechanical drawing {
} (LIB at 11 (citing CX-937C; Tr. at 691:17-24).)

Lucky Litter asserts that Mr. Waters identified {
} (Tr. at 628:20-629:6, 684:9-16.) They
allege that Mr. Waters identified {
} as the material for the rake of his
automatic litter box in August 1994 (SX-2C; Tr. at 635:24-636:24.) and assert that the “use of
the same material for the base pan and the rake is consistent with Mr. Waters’ belief {

} (LIB at 11 (citing Tr. at 634:16-635:1, 635:2-11, 635:12-16; CPX-50, CX-872C)
(emphasis in original).)

Lucky Litter says that Mr. Waters used the same material for the pan and the rake in his
plastic prototype {
} and his production prototype {
} (*Id.*) Lucky Litter argues that these facts show that “Mr. Waters identified
{
} as a material with release-type properties suitable for
use in the base pan of his automatic litter box prior to January 12, 1995.” (*Id.*)

Lucky Litter points out that Mr. Waters recanted his deposition testimony three days after
Respondents advised Mr. Waters’ counsel that they would move for summary determination that
the patent was invalid for failure to disclose the best mode. At that point, Mr. Waters submitted
an “errata sheet” in which he changed a “yes” answer to a “no” answer. (Tr. at 575:25-576:15).
Lucky Litter argues that the reason given for the change was “specious.” (LIB at 12.)

Lucky Litter argues that actual disclosure of the best mode is required regardless of
whether or not a person with ordinary skill in the art could practice the best mode absent that

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disclosure. (*Id.* at 14.) Lucky Litter admits that “one need not disclose production or routine details;” but argues that “the release-type base pan contemplated by Mr. Waters is neither a production detail nor a routine detail.” (*Id.* at 14-15.)

Lucky Litter takes the position that the release-type base pan is not a routine detail, because Mr. Waters did not recognize the need for the material until after he tested the invention with live cats. (LIB at 15 (citing *Herr-Voss v. Delta Brands, Inc.*, 1996 WL 651688, at *5 (Fed. Cir. 1996) (unpublished decision)).) Lucky Litter also says that it is unlikely that Mr. Waters would have believed withholding his “know how” could prevent foreign manufacturers from stealing his invention if the base pan material was simply a routine detail. (*Id.* (citing Tr. at 593:8-14, 600:4-601:15).)

Lucky Litter also asserts that Mr. Waters failed to disclose the need to make the rake of a release-type material which was known to him prior to filing the application for the ‘847 patent. (LIB at 16 (citing Tr. at 279:22-280:17; 601:6-15, 637:21-638:2; CX-893C at ¶ 24).) Lucky Litter alleges he knew of the need for { } for the rake in August 1994. (*Id.* (citing Tr. at 628:20-629:6; 635:24-636:24; 637:21-638:2; SX-2C).) Lucky Litter alleges he failed to disclose this superior mode in the ‘847 patent. (JX-1; SX-1C; SX-2C.)

Respondent OurPet’s Position: OurPet’s argues the same points as Lucky Litter. OurPet’s emphasizes Mr. Waters’ testimony that it was typical for the pan and rake to be made of the same material. (Tr. at 635:2-11.) OurPet’s asserts that Exhibits SX-1C and SX-2C show that in fall 1994, Mr. Waters had production and manufacturing documents identifying the material for the rake as { } (Tr. at 683:12-684:16; 691:17-24; CX-937C; SX-1C; SX-2C.) The material for the pan was a { } subject to Mr. Waters’ final approval. (Tr. at 637:21-638:2; SX-1C; SX-2C.)

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OurPet's also points out Mr. Waters' attempt to change the substance of his deposition testimony.

OurPet's asserts that the patent is invalid, because Mr. Waters subjectively knew, yet failed to disclose a preference that the bottom of the litter box should be made of a polypropylene "releasing material." (JX-1; Tr. at 580:2-583:18, 585:3-14, 587:12-17, 1236:11-1237:8.)

OurPet's argues three cases for the position that failure to disclose best mode related to materials render a patent invalid. First, OurPet's cites *Dana Corp. v. IPC Ltd. P'ship*, 860 F.2d 415 (Fed. Cir. 1988) in which the court invalidated a patent on a valve seal for use in an internal combustion engine for failure to disclose the best mode that included a fluoride surface treatment that was "necessary to satisfactory performance of [the] seal." Second, OurPet's points to *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923 (Fed. Cir. 1990) wherein the court invalidated a patent for failure to disclose a particular type of perlite for use in a grommet, where the inventor cited "expanded perlite which has been treated with a silicone compound to render it water-insensitive" when the inventor knew that a particular perlite, which was not disclosed in the specification, offered numerous advantages in his invention. Third, OurPet's invokes *Great Northern Corp. v. Henry Molded Products, Inc.*, 94 F.3d 1569 (Fed. Cir. 1996), where a patent was invalidated because the specification did not disclose diamond indentations that were crucial to producing a usable version of the claimed invention.

Complainants' Position: Complainants begin by emphasizing that a respondent who asserts a patent is invalid for failing to meet the best mode requirement must establish by clear and convincing evidence that the inventor both knew of and concealed a better mode of carrying

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out the claimed invention than was set forth in the patent specification. (WIB at 3 (citing *Transco Prods, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 560 (Fed. Cir. 1994)).)

Complainants also point out that the issue of disclosure of the alleged need to construct the rake of a release-type material is raised for the first time in this case in the post-hearing briefs of Staff and Respondents. (WRB at 3 (citing LIB at 16, OIB at 7).) In fact, they argue, Staff has raised for the first time six features it argues Waters should have disclosed in his patent. (SIB at 33-34.) Complainants argue that the newly raised issues should not be considered, as they are raised late in violation of Ground Rule 8(f).⁸ They also point to Ground Rule 11.1 which states:

The post-trial brief shall discuss the issues and evidence tried within the framework of the general issues determined by the Commission's Notice of Investigation, the general outline of the briefs as set forth in Appendix A, and **those issues that are included in the pre-trial brief and any permitted amendments thereto. All other issues shall be deemed waived.**

(WRB at 4 (emphasis in original).)

Complainants argue that the best mode analysis requires two inquiries. (WIB at 3.) The first inquiry is subjective and asks whether, at the time the patent application was filed, the inventor had a mode of practicing the claimed invention that he considered to be better than any other. *Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1144 (Fed. Cir. 1997). If the inventor had a best mode in mind, then one asks whether the specification adequately discloses the inventor's best mode so that those having ordinary skill in the art can practice the

⁸ Ground Rule 8(f) reads in relevant part: "Each party who desires to participate in the final hearing in this investigation ... must file a pre-hearing statement with the Office of the Secretary on or before the date ordered in the procedural schedule. Said pre-hearing statement should contain the following information ... : (f) A statement of the issues to be considered at the hearing that sets forth with particularity a party's contentions on each of the proposed issues, including citations to legal authorities in support thereof. **Any contentions not set forth in detail as required herein shall be deemed abandoned, or withdrawn, except for contentions of which a party is not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-hearing statements.** Pursuant to this requirement, each of the parties and Staff shall take a position on the issues it is asserting no later than the filing of its pre-hearing statement. With respect to alleged infringement of every asserted claim of a U.S. patent – including, if applicable, any allegations of direct infringement, literal infringement and infringement through equivalents (if applicable) – the party should take a position as to each claim in issue with respect to why each accused product does or does not so infringe and state in detail its basis." (Emphasis added.)

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invention. *Id.* Complainants assert that focusing on what a person of ordinary skill in the art knows and would understand from reading the patent specification is essential to assessing the second factual inquiry. (WIB at 4-5 (citing *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927 (Fed. Cir. 1990)).)

Complainants argue that, according to *Young Dental Mfg.*, the duty to disclose does not apply to routine details, because by definition they are readily apparent without disclosure. (WIB at 5.)

Complainants assert that “while he experienced some sticking of clumps to the bottom of his plastic non-production prototype, Mr. Waters addressed the issue by increasing the size of the motor, not by altering the pan’s chemical composition.” (WIB at 5 (citing Tr. at 598:24-25).) Complainants assert that Mr. Waters did not confront the issue of the base pan’s releasing qualities until he tested his production prototype with real cats. (*Id.* at 2 (citing Tr. at 683:22-684:8).)

Complainants argue that at the time the patent application was filed, Mr. Waters believed the litter box could be operated successfully using bottom materials that did not have good release properties and that, in fact, he believed that a special material was not required. (CX-894C at ¶¶ 143-144, 148; Tr. at 589:14-22.)

Complainants explain that the September 2, 1994 base pan specification supplied to the mold manufacturer states that the pan was to be made of { } There was { } (WIB at 6-7 (citing Tr. at 691:17-25; CX-937).) A polypropylene copolymer was specified to increase the base pan’s rigidity; it was not related to any releasing property. (*Id.* (citing Tr. at 700:25-702:2).) They assert that Mr. Waters did not initially specify any particular polypropylene copolymer for the manufacture of the base pan. (*Id.* (citing Tr. at

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709:19-20, 630:16-17).) Mr. Waters first received sample parts from the molds in February 1995, which he eventually assembled into the production prototype, with the last parts arriving at the end of that month. (*Id.* (citing Tr. at 630:1-8).) At the end of February 1995, the base pan did not yet have { } (*Id.* (citing Tr. at 630:9-17).) In late February 1995, for the first time, Mr. Waters had in his possession all of the components necessary to assemble the production prototype, and he then tested it with cats. During the live test, Mr. Waters noticed that significant clumps would adhere to the base pan bottom. This was a new phenomenon, unlike the pre-production prototype, which did not experience any significant adherence. (*Id.* (citing Tr. at 683:18-684:1, 628:21-25, 684:4-8, 20-22, 688:16-24).) Mr. Waters' solution, which he first considered in late February 1995 when he observed the results of the live cat testing, was to { } (*Id.* (citing Tr. at 628:21-629:6; 684:9-16).)

Complainants argue that Mr. Waters was not required to disclose the bottom material for the base pan in any event, because materials with good release properties were well known at the time. (WIB at 9 (citing CX-934C at ¶¶ 442-443; RX-5 at 2:41-45; CX-923; CX-924; CX-925; CX-926).) Complainants point to the testimony of Dr. Wood to support the proposition that materials like polyethylene or polypropylene were typical to use for cat litter pans at the time of the invention, and they were well-known to a person of ordinary skill in the art by January 1995. (*Id.* (citing CX 934C at ¶¶ 442-444; RX-5 at 2:41-45; CX-923; CX-924; CX-925; CX-926; CX-894C at ¶¶157-158).)

Complainants assert that the releasing material to be used for the base pan did not have to be disclosed, because the alleged mode is not a specific element of the claimed invention and is, therefore, unclaimed subject matter. (WIB at 10 (citing *Bayer AG v. Shein Pharm., Inc.*, 301 F.3d 1306, 1315 (Fed. Cir. 2002); *Teleflex Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1331

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(Fed. Cir. 2002); *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1531-1532 (Fed. Cir. 1991)).) They argue, “[a]n inventor need not disclose a mode for obtaining unclaimed subject matter unless the subject matter is novel and essential for carrying out the best mode of the invention.” (*Id.* (quoting *Eli Lilly & Co. v. Barr Labs, Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001)).)

Complainants also argue that the alleged mode is not novel and essential to the operation of the claimed invention. They say the evidence established that a person of ordinary skill in the art would have been well aware of the problem of clumps sticking to the bottom of the pan, that the material used to form the bottom of the pan could effect whether clumps stuck to the bottom, and the materials used for the bottom of the pan to which clumps were less likely to stick. (*Id.* at 11 (citing CX-934C at ¶¶ 442-445; RX-5 at 2:41-45; CX-923; CX-924; CX-925; CX-926).)

Commission Investigative Staff’s Position: Staff argues that the inventor violated the best mode requirement, because he knew of – but failed to disclose - the use of a specific type of slick plastic necessary to work the invention. They cite Mr. Waters’ deposition testimony, a video of which was played at the hearing, to support this argument. (SIB at 33 (citing Tr. at 580-583, 585-587).)⁹

In addition, Staff argues that the evidence shows a clear and unmistakable pattern of withholding many aspects of the invention from the patent specification, which supports the finding of a best mode violation. They allege the following were known to the inventor but not disclosed in the patent application: (1) increased motor power was necessary to handle heavy clumps of litter and litter sticking to the base (SIB at 33-34 (citing CX-894C at ¶¶ 29, 47, 53, 105, 151)); (2) the delay of the rake cycle following the cat’s exit from the box was critical to allow the cat litter clumps to harden sufficiently. (*Id.* (citing CX-894C at 47, 151, 155, 214)); (3) a structure for selecting a mode operation. (*Id.* (citing CX-894C at ¶¶ 89, 221)); (4) the angle of

⁹ Staff did not cite to specific line numbers in its brief.

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the rake tines was material to successful removal of cat waste. (*Id.* (citing CX-894C at ¶ 153)); (5) a sensor for determining a cat's presence. (*Id.* (citing CX-894C at ¶¶ 86-87)); and (6) the type of cat litter was important. (*Id.* (citing Tr. at 581-583).)

Staff points to the testimony of Mr. Waters at the hearing to support their arguments. (Tr at 570-71, 572, 593; RX-54; CX-894 at ¶¶ 160-172, 583-84; RX-872; RX-880; SX-2C.)

3. Discussion and Conclusion

I find that the Respondents and Staff have not met the burden to provide clear and convincing evidence that at the time of the application for patent, Mr. Waters both knew of and concealed a better mode of carrying out the claimed invention than was set forth in the specification.

The best mode requirement is not satisfied by reference to the level of skill in the art, but entails a comparison of the facts known to the inventor regarding the invention at the time the application was filed and the disclosure in the specification. *Dana Corp.*, 860 F.2d at 419. In expressing this requirement, 35 U.S.C. § 112 ¶ 1 states explicitly that disclosure must be made of the best mode "contemplated by the inventor." This requirement is separate and distinct from the enablement requirement set forth in the first part of 35 U.S.C. § 112, ¶ 1. Accordingly, an argument that the best mode requirement may be met *solely* by reference to what was known in the prior art is incorrect. *Id.*

The Federal Circuit has recognized two exceptions to the foregoing rule that are relevant here. First, the extent of information that an inventor must disclose depends on the scope of the claimed invention. Accordingly, an inventor need not disclose a mode for obtaining unclaimed subject matter unless the subject matter is novel and essential for carrying out the best mode of

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the invention. *Eli Lilly*, 251 F.3d at 963; *Engel*, 946 F.2d at 1531; *Applied Med. Resources Corp.*, 147 F.3d at 1377.

Second, under the rubric of “production details” the Federal Circuit has recognized a subgroup to which it refers as “routine details.” The Federal Circuit has exempted “production details” from the best mode requirement, reasoning that they are “commercial considerations that do not relate to the quality or nature of the invention, such as equipment on hand or prior relationships with suppliers.” *Young*, 112 F.3d at 1144. This is in contrast to “routine details,” which are recognized by the Federal Circuit as details that do relate to the quality or nature of the invention. *Id.* Nevertheless, they need not be disclosed because they are apparent to one of ordinary skill in the art. *Id.*

With the foregoing in mind, I review the evidence. It is true that Mr. Waters testified in his deposition that he knew about clumping and the need for a releasing type material (i.e. polypropylene) prior to January 12, 1995, the date of the application at issue in this investigation.¹⁰ Subsequently, he changed his testimony to indicate that, while he did know about the clumping problem, he did not know about the need for a releasing type material prior to that date. (Tr. at 580:2-581:9, 587:9-17, 589:7-590:12.) In his direct testimony, Mr. Waters said that on or before January 12, 1995 he knew of materials with good releasing properties that were in common use for litter boxes, and said that most boxes were made from polypropylene or polyethylene. (CX-894C at Qs. 157-158.) Mr. Waters’ credibility suffers as a result of the conflicts in his testimony. Nevertheless, to meet a clear and convincing standard which produces an abiding conviction that the facts are highly likely to be as alleged by Respondents and Staff, more is needed here.

¹⁰ The ‘847 patent was issued on September 5, 2000, based on Application No. 08/997,879 filed on December 24, 1997; but it is a reissue of U.S. Patent No. 5,477,812, which was issued on December 26, 1995, based on Application No. 08/371,782 filed on January 12, 1995. Hence, the relevant application date is January 12, 1995.

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The evidence establishes that by April 21, 1995, Waters placed an order with {
 } showing both the rake and pan of the litter box to be { } (CX-
872C.) Mr. Waters testified at the hearing that, by August 26, 1994, he had specified
{

} (Tr. at 635:24-637:4, 637:21-638:2, 702:10-17, 705:1-8.) Mr. Waters
admitted that on September 2, 1994, he specified polypropylene copolymer as the material for
the pan. (CX-937C; Tr. at 697:3-16, 702:18-703:1.)

Mr. Waters testified, however, that the “copolymer” is another polypropylene polymer
and the reason for using a copolymer is to increase rigidity, rather than to eliminate sticking. (Tr.
at 700:5-701:11.) Mr. Waters testified that the problem of the clumps sticking to the pan became
an issue when the first commercial version of the product was used by cats. It had not happened
in the original prototype used for the patent application. (Tr. at 683:12-684:22.)

Mr. Waters testified that he ordered the molds in { } (Tr. at 634:9-11.)
He testified that he did not get a part to see how it worked until { } (Tr. at 683:12-
684:22.) Mr. Waters referred to Exhibit CX-880C, which he identified as an invoice from
{ } for having a hot bushing added to the mold for the base pan, and a { }
progress payment for a first sample out of the tool. That document was dated February 8, 1995,
and Mr. Waters testified he had not tested any other materials for the litter pan by that date,
except for the materials in his first three prototypes. (CX-894C at ¶¶ 167-172.)

Complainants’ expert, Dr. Wood, testified that, *inter alia*, the essence of the invention
included the time delay to allow clumps to not stick. (CX-893C at ¶ 24; Tr. at 279:22-280:17.)
This is not, however, indicated anywhere in the patent, and the issue of clumps sticking is not

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discussed therein. It appears that Dr. Wood was in error in this regard, based upon the content of the '847 patent. (*See generally* JX-1.)

Dr. Wood also testified that the prior art revealed the use of plastic, including polypropylene and polyethylene, as a preferred material for litter boxes and that its use was generally known in the industry. (CX-934C at ¶¶ 442-445.) Dr. Wood's testimony concerning the use of plastics in the prior art is supported by the following patents that are part of the prior art to the '847 patent: CX-923 at 3:44-48 (U.S. Pat. No. 4,505,226, stating that the pan is "molded out of polypropylene plastic or a suitable synthetic polymer or any suitable non-corroding impact-resistant material."); CX-924 at 3:49-54 (U.S. Pat. No. 4,602,593, stating that the tray member is "a resilient yet flexible plastic material..."); and CX-925 at 2:67-3:3 (U.S. Pat. No. 4,869,206, stating that the sides, top, and bottom are preferably "constructed of polyurethane or polypropylene plastic. These materials are inert, resistant to staining, and can be repeatedly cleaned by steam cleaning..."). The prior art references show that plastic, including polypropylene, was used for reasons other than "releasing" qualities, and those references support Dr. Wood's testimony.

I am convinced that the use of polypropylene to construct animal litter box pans was a routine detail that was within the general knowledge of one with ordinary skill in the art when the application was filed on January 12, 1995. The addition of { } in order to improve its "releasing" qualities was, however, an innovation unique to the LitterMaid® product that was developed after the filing of the patent application.

Regarding the subjective test of Mr. Waters' belief regarding the best mode of practicing his invention, I find that the record lacks clear and convincing evidence that, on or before January 12, 1995, Mr. Waters had formed a belief regarding the use of { } to the

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materials for the pan as a best mode for his invention. While Mr. Waters' testimony is somewhat murky regarding what he knew and believed and when he knew it, there is no clear evidence that supports a conclusion that, on or before January 12, 1995, the application date, he had arrived at a belief regarding the use of { } in the pan material to enhance its releasing properties.

The evidence does establish that Mr. Waters had decided prior to the application date to use a particular material in the pan (i.e. polypropylene with copolymer); but I am convinced that the use of that material, { } was a matter of routine detail well known to a person of ordinary skill in the art. This is based on Dr. Wood's testimony and the supporting exhibits showing the use of polypropylene in inventions making up a part of the prior art of the '847 patent.

Finally, I concur that the use of the polypropylene copolymer was not part of the claimed invention. Nowhere in the patent claims (JX-1) is there reference to "releasing properties" of the pan. Inasmuch as the evidence shows that the polypropylene, { } did not possess the requisite "releasing properties" to accomplish what Respondents allege is the best mode of the invention, it cannot be said that it is "novel and essential for carrying out the best mode of the invention." It was merely a durable and non-corroding impact-resistant material appropriate for use in manufacture of the invention. As such it was not required to be disclosed in the specification as part of the "claimed" invention.

In addition to the issue of disclosure of the material to be used in the pan, Respondents and the Staff have raised several other issues of alleged nondisclosure by the inventor. Specifically, Respondents and Staff argue that the patent is invalid for failure to disclose best mode, because Mr. Waters did not disclose the use { } in the

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materials for constructing the rake. (Tr. at 279:22-280:17; 601:6-15, 628:20-629:6, 635:24-636:24, 637:21-638:2; CX-893C at ¶ 24; SX-2C.)

None of the evidence cited by Lucky Litter supports the conclusion that Mr. Waters determined prior to the application that the best mode required use { } to the materials for the rake. Dr. Wood's cited testimony, in both his direct statement and on cross-examination, relates to the need to include a delay in the timing of the comb drive to allow the clumps to reach a consistency that would allow effective cleaning of the litter box. Mr. Waters' cited testimony only indicates that he had a "hunch" in { } that { } He testified that he did not have a chance to "try" that solution until { } when he had a production prototype.

The Staff raises other best mode arguments, asserting that the patent is invalid for failure to disclose: (1) increased motor power was necessary to handle heavy clumps of litter and litter sticking to the base (SIB at 33-34 (citing CX-894C at ¶¶ 29, 47, 53, 105, 151)); (2) the delay of the rake cycle following the cat's exit from the box was critical to allow the cat litter clumps to harden sufficiently. (*Id.* (citing CX-894C at 47, 151, 155, 214)); (3) a structure for selecting a mode operation. (*Id.* (citing CX-894C at ¶¶ 89, 221)); (4) the angle of the rake tines was material to successful removal of cat waste. (*Id.* (citing CX-894C at ¶ 153)); (5) a sensor for determining a cat's presence. (*Id.* (citing CX-894C at ¶¶ 86-87)); and (6) the type of cat litter was important. (*Id.* (citing Tr. at 581-583).)

Complainants have argued that the issue of the material included in the rake raised by Respondents and Staff and the remaining six issues raised by Staff are improperly raised in the post-hearing briefs for the first time and should be deemed waived pursuant to Ground Rules 8(f) and 11.1.

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I note that all of the exhibits cited by the Respondents and Staff (SX-2C, CX-893C, CX-894C) were provided to them prior to the deadline set in this case for filing pre-trial briefs. It is evident that the issues treated in those documents should have been raised in the parties' pre-trial statements and briefs. There is no showing in the post-hearing initial or reply briefs that the contentions raised in those briefs were things of which the parties' were not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-hearing statements. Therefore, I find that those contentions and issues were waived by the parties' and are improperly included in their post-hearing briefs.

Based on all of the foregoing, I find that the Respondents and Staff have failed to meet the test set forth in *Young*, 112 F.3d at 1144. Therefore, I find that the '847 patent is not invalid for failure to disclose the best mode.

B. Anticipation

I. Applicable Law

"A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference." *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003).

"When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job[.]" *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984).

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2. **Claim 27**

Respondent Lucky Litter asserts that Carlisi anticipates claim 27 pursuant to 35 U.S.C. §§ 102(a), (b).

Respondent Lucky Litter's Position: Lucky Litter asserts that Carlisi discloses all of the claim elements in claim 27. (LIB at 18-21 (citing JX-2 at 293; RX-198 at ¶¶ 67-69, 79; RX-5 at 2:64-3:4, Tr. at 242:14-243:6).) Lucky Litter argues that Carlisi inherently discloses the “mode selector means” limitation found in claim 27. (*Id.* at 21.) As explained by Lucky Litter, “[t]he Carlisi patent expressly discloses an on/off switch that can be used to run the rake manually when it is turned on, and puts the patent into an automatic operation mode (run by a timer) when it is turned off.” (*Id.* (citing Tr. at 237:7-18, 467:9-468:10; RX-198 at ¶ 69 ; RX-5 at 3:51-53).)

In its analysis, Lucky Litter applies Complainants' constructions for all terms except “automatic operation.” (*Id.* at 19.) For “automatic operation,” Lucky Litter uses its asserted “plain meaning.” (*Id.*)

Respondent OurPet's Position: OurPet's agrees with and adopts Lucky Litter's argument regarding anticipation. (OIB at 10.)

Complainants' Position: Complainants argue that Carlisi does not anticipate claim 27. Complainants allege that there is no “pan-shaped housing” disclosed in Carlisi because the element that Lucky Litter identifies as the “pan-shaped housing” does not hold the litter. (WIB at 33 (citing Tr. at 421:12-22; CX-934C at ¶¶ 126-127).) Complainants allege that there is no “mode selector means” disclosed in Carlisi because it is not clear that there is a switch that can be used to select between different modes of operation. (*Id.* (citing Tr. at 423:4-18, 425:4-8; JX-4 at 119-125, 210-215, 217-219; RX-198 at ¶ 67).) Complainants allege that there is no

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“automatic operation mode” disclosed in Carlisi because the comb does not operate in response to a cat entry and exit plus a delay. (*Id.* at 33-34 (citing Tr. at 425:9-14; RX-198 at ¶ 76).)

Commission Investigative Staff’s Position: Staff argues that if “Complainants’ proposed constructions for claims 27 and 33 are adopted in substantial part,” Carlisi anticipates claim 27. (SIB at 38.) Staff argues that Complainants only dispute that Carlisi does not disclose an “automatic operation mode.” (*Id.* at 38-39.) Staff argues that if “mode selector means” is construed to cover “any switch,” and “automatic operation mode” is given a broad construction, then Carlisi anticipates claim 27. (*Id.* at 39.)

Discussion and Conclusion: As stated *supra*, the Background section of the specification discusses Carlisi and identifies the invention’s improvements over Carlisi. (JX-1 at 1:39-56.) The examiner relied on Carlisi, in combination with other references, to reject the claims during prosecution. (*See, e.g.*, JX-2 at 293.) Because Carlisi was before the examiner during prosecution, Lucky Litter has the added burden of overcoming the presumption that the USPTO properly did its job in allowing the ‘847 patent to issue. *Am. Hoist & Derrick Co.*, 725 F.2d at 1359.

Carlisi discloses a litter box with a rake that can either be moved manually or with the use of a motor:

The present invention can be used in a manual fashion where the rake member is moved manually, in which case, both carriers should be of a passive design. Alternatively, both carriers may be of the driven design for extra power.

(RX-5 at 3:19-23.)

In explaining how the rake can be driven using a motor, Carlisi describes activating the motor either by an on/off switch, or by the use of some pre-determined condition, such as a timer mechanism:

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An on/off switch 92 is provided for actuation of the cleaning process. Alternatively or additionally, the process may be started by some pre-determined conditions. Preferably, the process may be started by means of a timer mechanism 93 designed to start the cleaning process daily at a time in which the cat would not normally be using the kitty litter box.

(*Id.* at 3:50-56.)

Carlisi explains the benefits of the timer mechanism:

As can be seen from the above process, if the kitty litter box cleaning mechanism is on a timer, it is unnecessary for the cat owner to visit the kitty litter box for an extended period of time. Ideally, no trip will be needed until such time as the kitty litter itself needs to be changed, at which point pan 32 can be lifted out of the housing and the used kitty litter dumped.

(*Id.* at 4:31-37.)

I find that Carlisi discloses a “pan-shaped housing.” I construed the term to mean “a housing with four walls and a bottom that is upwardly open and which defines the litter chamber.” Complainants argue that this claim element is missing from Carlisi because Dr. Cagan only identified the housing 16 in Carlisi as the “pan-shaped housing.” (WIB at 33.) Complainants claim that the litter holding pan 32, and not the housing 16, holds the litter. (*Id.*)

I find that the housing 16 in combination with the litter holding pan 32 forms the “pan-shaped housing.” Carlisi describes the housing 16 and litter holding pan 32 in the specification:

The kitty litter box 10 features a housing 16. The housing has two side walls 18 and 20, a front wall 22 and rear wall 24. The housing features a dividing wall 26 between the two compartments 28 and 30.

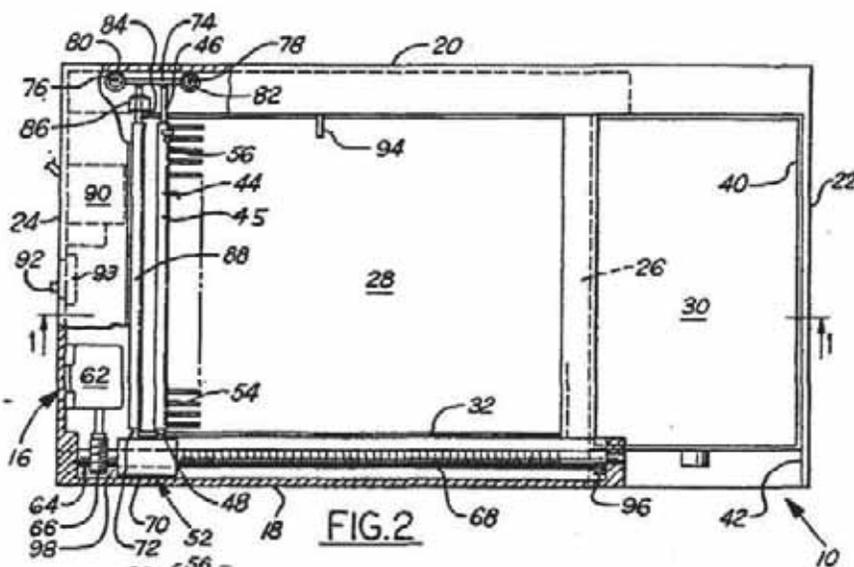
The first compartment 28 of the housing is defined by rear wall 16, dividing wall 26 and the side walls and allows for placement within it of a kitty litter holding pan or holder 32. This pan is preferably of a water-proof durable plastic-type material. The pan, when placed within housing 28, is filled to suitable level with clean kitty litter 14 to allow a place in which the cat can relieve itself. The pan is of such a size to extend from side wall to side wall. The front end of the pan has a lip 34 designed to overhang dividing wall 26 and has a ramp 36 extending rearwardly from the lip having an arcuate cross-section as will be defined more fully below. The rear end of the pan should be shaped to provide for a motor

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compartment 38 and may be a mirror image of the front end to allow the pan to be reversible.

(RX-5 at 2:37-55; *see also* Figs. 1-2, 8.) This passage and the accompanying figures make clear that the combination of the housing 16 and litter holding pan 32 constitutes “a housing with four walls and a bottom that is upwardly open and which defines the litter chamber.”

I find that Carlisi does not disclose the “comb drive means” in claim 27. I construed the means-plus-function term to require the following structure: “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41.” Carlisi does not disclose this structure because the motor in Carlisi is not mounted on the shaft that supports the rake. In Carlisi, the motor is located behind the shaft that supports the rake, as can be seen from Figure 2 of Carlisi, where the item marked 62 is the motor:



(RX-5 at Fig. 2.) As Figure 2 demonstrates, Carlisi utilizes a worm drive system and the motor is not mounted on the shaft. (*Id.* at 3:29-34; 3:59-4:4.)

I find that Carlisi does not disclose an “automatic operation mode” in claim 27. I construed the term to mean “a mode of operation where combing is initiated in response to a cat

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exit.” As shown above, Carlisi only discloses combing initiated by “some pre-determined conditions.” The pre-determined condition specifically described by Carlisi is a timer mechanism that initiates combing periodically. Nothing in the patent describes or discloses a mode of operation where combing is initiated in response to a cat exit. This is consistent with the discussion in the specification of the ‘847 patent of moving away from cat litter boxes (such as the one disclosed in Carlisi) that comb periodically. (See JX-1 at 1:39-56, 1:63-2:2.)

I find that Carlisi does not disclose the “mode selector means” in claim 27. I construed this means-plus-function term to require the structure of a switch and a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 and accompanying text.

There is no indication that Carlisi discloses a microprocessor programmed to perform an algorithm such as is disclosed in the ‘847 patent specification. This alone is enough to find that Carlisi does not anticipate claim 27. Additionally, there is no disclosure of a switch used to select between modes as required by the fourth element of claim 27.

Carlisi discloses an on/off switch that can be used to activate the raking process. (RX-5 at 3:50-56.) In addition to the on/off switch, Carlisi discloses combing periodically through the use of a timer. (*Id.*) There is no explicit mention of any switch and microprocessor combination that allows for the selection between modes and no indication that the on/off switch and the timer are connected in any way.

Lucky Litter argues that the on/off switch in Carlisi inherently functions as a mode selector switch. Lucky Litter states:

The Carlisi patent expressly discloses an on/off switch that can be used to run the rake manually when it is turned on, and puts the patent into an automatic operation mode (run by a timer) when it is turned off. RFF 259-261. Accordingly, having expressly disclosed the switch, the manual mode, and the

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automatic mode, the on/off switch in the Carlisi patent necessarily functions as a mode selector switch as claimed in the '847 patent.

(LIB at 21.)

Dr. Cagan makes a similar argument, but is less forceful than Lucky Litter. Dr. Cagan testified that “one skilled in the art **could** interpret [Carlisi] to mean that if the [on/off] switch were turned on by the user, it would actuate the cleaning process, and if the switch were turned off, the cleaning process would be started through a predetermined condition, such as the timer.”

(RX-198 at ¶ 69 (emphasis added).)

I find that Carlisi does not inherently disclose the “mode selector means.” There is no indication in Carlisi that when the on/off switch is turned off, it puts the litter box into a mode where the rake is driven by periodically by a timer. This may be the case, but it may also be the case that there is an additional switch (or some other structure) necessary to activate the timer. Carlisi is simply silent on this issue.

Lucky Litter states that Carlisi necessarily discloses this element, but Dr. Cagan’s testimony only states that Carlisi **could** disclose a “mode selector means.” This is further emphasized by Dr. Cagan’s testimony on cross examination, where he only stated that Carlisi “could” disclose a “mode selector means:”

Q. And the -- well, let me back up. I will ask, before we get into the prosecution history, I will just ask this question. Isn't it correct that Carlisi does not disclose the mode selector means for switching between the manual operation mode and the automatic operation mode, correct?

A. Well, actually I disagree with that. It depends on how one reads this. And if I look on column 3, lines 49 through, let's see, that whole paragraph, through 57, it discloses an on/off switch. And when one reads this, it is not written as clearly as maybe one would hope, but it actually became clear to me after reading this several times that power is already into the unit and it is in its automatic mode. So the on/off switch actually then initiates manual cleaning of the process.

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Therefore, it has a mode selector means or switch that would actually, depending on how “automatic” and “manual” are construed, **it could read that it does actually have a mode selector means.**

Q. That's your testimony?

A. And I thought about it quite a bit since then, and **I actually think it could read that it does disclose it.**

(Tr. at 423:2-424:15 (emphasis added).) Lucky Litter's argument is therefore undercut by its expert's equivocal statements that Carlisi **could** disclose a “mode selector means.”

In *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991), the patent involved a ribbed bottom for a plastic container. The defendant argued that a prior art patent anticipated the claims at issue because even though it did not explicitly disclose hollow ribs (as required by the claims), it disclosed that the ribs were formed by injection blow molding. *Id.* at 1268. The defendant argued that ribs formed by injection blow molding are inherently hollow. *Id.* In explaining inherency, the Federal Circuit stated:

Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient...If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Id. at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)).

The court vacated the district court's grant of summary judgment because it found that whether injection blow molding *necessarily* produces hollow ribs was a disputed factual issue.

Id. at 1269. In the case before me, the evidence submitted by Lucky Litter demonstrates a *possibility* that the switch required by the “mode selector means” *could be* disclosed in Carlisi,

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but fails to establish that the required switch *is necessarily* disclosed. Therefore, I find that Carlisi does not inherently disclose the “mode selector means.”

3. Claim 33

Respondent Lucky Litter asserts that Carlisi anticipates claim 33 pursuant to 35 U.S.C. §§ 102(a), (b).

Respondent Lucky Litter’s Position: Lucky Litter asserts that Carlisi discloses all of the claim elements in claim 33. (LIB at 18-21 (citing JX-2 at 293; RX-198 at ¶¶ 67-69, 79; RX-5 at 2:64-3:4, Tr. at 242:14-243:6).) Lucky Litter argues that Carlisi inherently discloses the “mode selector switch” limitation found in claim 33. (*Id.* at 21.) As explained by Lucky Litter, “[t]he Carlisi patent expressly discloses an on/off switch that can be used to run the rake manually when it is turned on, and puts the patent into an automatic operation mode (run by a timer) when it is turned off.” (*Id.* (citing Tr. at 237:7-18, 467:9-468:10; RX-198 at ¶ 69 ; RX-5 at 3:51-53).)

In its analysis, Lucky Litter applies Complainants’ constructions for all terms except “automatic operation.” (*Id.* at 19.) For “automatic operation,” Lucky Litter uses its asserted “plain meaning.” (*Id.*)

Respondent OurPet’s Position: OurPet’s agrees with and adopts Lucky Litter’s argument regarding anticipation. (OIB at 10.)

Complainants’ Position: Complainants argue that Carlisi does not anticipate claim 33. Complainants allege that there is no “pan-shaped housing” disclosed in Carlisi because the element that Lucky Litter identifies as the “pan-shaped housing” does not hold the litter. (WIB at 33 (citing Tr. at 421:12-22; CX-934C at ¶¶ 126-127).) Complainants allege that there is no “mode selector switch” disclosed in Carlisi because it is not clear that there is a switch that can

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be used to select between different modes of operation. (*Id.* (citing Tr. at 423:4-18, 425:4-8; JX-4 at 119-125, 210-215, 217-219; RX-198 at ¶ 67).) Complainants allege that there is no “automatic operation position” disclosed in Carlisi because the comb does not operate in response to a cat entry and exit plus a delay. (*Id.* at 33-34 (citing Tr. at 425:9-14; RX-198 at ¶ 76).)

Commission Investigative Staff’s Position: Staff argues that if “Complainants’ proposed constructions for claims 27 and 33 are adopted in substantial part,” Carlisi anticipates claim 33. (SIB at 38.) Staff argues that Complainants only dispute that Carlisi does not disclose an “automatic operation position.” (*Id.* at 38-39.) Staff argues that under a broad construction of “automatic operation position,” Carlisi anticipates claim 33. (*Id.* at 39.)

Discussion and Conclusion: For the reasons discussed *supra*, regarding claim 27, I find that Carlisi does not disclose the “mode selector switch” or “automatic operation position” elements of claim 33. Therefore, I find that Carlisi does not anticipate claim 33.

C. Obviousness

1. Applicable Law

Section 103 of the Patent Act states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103(a) (2008).

“Obviousness is a question of law based on underlying questions of fact.” *Scanner Techs. Corp. v. ICOS Vision Sys. Corp. N.V.*, 528 F.3d 1365, 1379 (Fed. Cir. 2008). The

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underlying factual determinations include: “(1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective indicia of non-obviousness.” *Id.* (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)). These factual determinations are often referred to as the “*Graham* factors.”

“When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job[.]” *Am. Hoist & Derrick Co.*, 725 F.2d at 1359.

In *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court rejected the Federal Circuit’s rigid application of the teaching-suggestion-motivation test used to determine whether a motivation to combine references existed. The Court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 1741. The Court described a more flexible analysis:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue...As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR, 127 S.Ct. at 1740-41.

2. Level of Ordinary Skill in the Art

Respondent Lucky Litter’s Position: Lucky Litter argues that a person of ordinary skill in the art would have a bachelor’s degree in mechanical engineering or equivalent experience,

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and a familiarity with control systems, including software programming and electronic design. (LIB at 4 (citing RX-198 at ¶¶ 53-54).) Lucky Litter points to the prior art, such as Carlisi, Kakuta and Loctin, as evidence that one of skill in the art would have knowledge of electro-mechanical litter boxes. (*Id.* at 5 (citing JX-1; JX-2 at 293; RX-198 at ¶¶ 67-69, 79; RX-5 at 2:64-3:4, 3:50-53; Tr. at 237:7-18, 237:24-238:9, 423:2-24, 467:9-468:10, 988:17-989:12, 1185:22-25, 1186:1-6; RX-6 at 3:13-16; RX-178 at 7:48-52, 8:20-26; RX-82 at 4:1-40).) Lucky Litter argues that a person of ordinary skill in the art would need to know how to implement the block diagram in Figure 5 of the '847 patent, thus requiring a certain level of knowledge of electrical circuits and computer programming. (*Id.* at 6 (citing Tr. at 224:20-225:2).) Lucky Litter also claims that Mr. Waters' testimony supports its argument. Mr. Waters testified that Jeffery Gibbons, an electrical engineer employed by Mr. Waters, put together the circuit board and programmed the microprocessor used in Mr. Waters' prototype litter box. (*Id.* at 7 (citing Tr. at 597:14-598:2; CX-894C at ¶ 57).) Lucky Litter relies on the opinion of its expert Dr. Cagan as support for its argument. (LRB at 15-17 (citing RX-198 at ¶¶ 53-54, Tr. at 224:20-226:4, 238:25-239:13, 288:22-290:3, 302:15-303:4).)

Respondent OurPet's Position: OurPet's argues that the level of ordinary skill in the art is an undergraduate degree in mechanical engineering or equivalent experience in electrotechnical design work. (OIB at 3.) OurPet's asserts that one of ordinary skill would have extensive knowledge of gears and drive mechanisms as well as the electronics knowledge to implement the flowchart from Figure 7 of the '847 patent. (*Id.* (citing Tr. at 225:3-226:24; CDX-372).)

Complainants' Position: Complainants argue that the level of ordinary skill in the art is a bachelor's degree in mechanical engineering or equivalent experience in the practice of

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engineering in the field. (WIB at 42-43 (citing CX-934C at ¶¶ 179, 182).) Complainants rely on their expert's opinion and the educational background of Mr. Waters as support for their position. (*Id.* at 42-44 (citing CX-934C at ¶¶ 179, 182; CX-894C at ¶ 21).) Dr. Wood testified that a person with a degree in mechanical engineering in the timeframe of 1994 would have some knowledge in the following areas: sensor systems, switch hardware, circuitry, control logic, microcontrollers, and computer programming. (Tr. at 218:10-223:4.) Complainants argue that Lucky Litter's position is incorrect because Lucky Litter's expert based his opinion on the qualifications of Kristin Grube, one of the developers of the ScoopFree products. Because development of the ScoopFree products did not begin until 2002, Complainants argue that Dr. Cagan's opinion fails to take into account the correct timeframe. (*Id.* at 44 (citing Tr. at 418:20-24, 419:12-15, 800:13-21; RX-197C at ¶ 19).) Complainants also argue that Lucky Litter's elevated level of skill would disqualify the inventor as one of ordinary skill in the art. (*Id.*)

Commission Investigative Staff's Position: Staff agrees with Lucky Litter that a person of ordinary skill in the art is a person with a bachelor's degree in mechanical engineering and a familiarity with control systems, including software programming and electronic design. (SRB at 16.) Staff argues that this level of skill is necessary in light of the fact that the invention requires the use of a microprocessor to control the litter box. (*Id.* at 16-17.)

Discussion and Conclusion: In determining the level of ordinary skill in the art, factors that may be considered include: "(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

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“These factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art.” *Id.*

The parties are all in agreement that one of ordinary skill in the art would at least have a bachelor’s degree in mechanical engineering or equivalent experience. (WIB at 42; LIB at 4; OIB at 3; SRB at 16.) The dispute centers on the extent of any further knowledge required to be one of ordinary skill in the art. Complainants believe that a degree in mechanical engineering or equivalent is sufficient while Respondents and Staff seek to add the requirement that one of ordinary skill in the art have additional knowledge of control systems, electrical design, and computer programming.

One of the factors to consider is the education level and experience of the inventor. Mr. Waters testified that he graduated high school in 1971 and attended college for “about 4 years,” but does not indicate what subjects he studied in college or whether he graduated. (CX-894C at ¶ 3.) Mr. Waters testified about the engineering projects on which he worked prior to 1994, and those projects evidence a background in electromechanical design and control systems. (*Id.* at ¶ 8 (listing such projects as “[m]old temperature control units for the plastics industry” and “[i]ndustrial robot controls”).) Therefore, while the extent of Mr. Waters’ educational background is unclear, it is clear that he has had experience in the fields of electromechanical design and control systems.

Two other important factors here are the type of problems encountered in the art and prior art solutions to those problems. Looking at Carlisi, which is the most pertinent piece of prior art, a problem to be solved was reducing the amount of human upkeep and effort necessary for the use of the litter box. (*See* RX-5 at 4:31-41.) Carlisi’s solution to this problem was to incorporate a timer mechanism in the litter box to activate the comb at a predetermined time.

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(*Id.*) Implementation of this timer mechanism would necessarily require some knowledge of electrical design and control systems.

While Complainants' expert Dr. Wood opined that the level of skill in the art should be limited to a degree in mechanical engineering or equivalent experience, he testified on cross examination regarding what a person with such a degree would know. Dr. Wood testified that a person with a degree in mechanical engineering in the timeframe of 1994 would have some knowledge in the following areas: sensor systems, switch hardware, circuitry, control logic, microcontrollers, and computer programming. (Tr. at 218:10-223:4.)

Based on the foregoing evidence, along with the opinions of Respondents' experts (*see* RX-198 at ¶ 54, RX-201 at ¶ 19), I find that the parties' positions are basically in agreement on the issue of level of skill in the art. They all confirm that a person of ordinary skill in the art would possess a bachelor's degree in mechanical engineering or equivalent experience. Respondents and Staff chose to highlight that the person of ordinary skill would have a familiarity with control systems and software programming, and Dr. Wood testified that a person with a degree in mechanical engineering would have some knowledge in those areas.

Thus, I find that one of ordinary skill in the art would be a person with an undergraduate degree in mechanical engineering or equivalent experience. Due to the person's educational background or experience, he or she would have some knowledge of the following: sensor systems, switch hardware, circuitry, control logic, microcontrollers, and computer programming.

3. Claim 8¹¹

Respondent OurPet's asserts that the combination of Carlisi and U.S. Pat. No. 4,067,297 to Johnson ("Johnson") renders claim 8 obvious pursuant to 35 U.S.C. § 103(a).

¹¹ I will discuss the scope and content of the prior art and the differences between the claimed invention and the prior art on a claim-by-claim basis.

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Respondent OurPet's Position: OurPet's asserts that Johnson and Carlisi disclose all of the elements of claim 8. OurPet's claims that Carlisi discloses all of the elements of claim 8 except for the "drive motor...mounted on the carriage" limitation. (OIB at 15.) OurPet's states that Complainants' expert Dr. Wood agreed with that assertion. (*Id.* (citing Tr. at 1144:8-18).) OurPet's argues that Johnson discloses the missing "drive motor...mounted on the carriage" limitation. (*Id.* at 17-19 (citing RX-72 at 2:11-15, Fig. 2).)

OurPet's argues that one of ordinary skill in the art would combine Carlisi and Johnson. (OIB at 19-21 (citing RX-201 at ¶ 47-48).) OurPet's states that the advantage of mounting the motor on the carriage is that it reduces the amount of machinery subject to fouling by the litter and also reduces the number of parts and inefficiencies associated with long gear trains. (*Id.* at 19 (citing Tr. at 1247-1248).) OurPet's claims that the '847 patent identifies the motivation to combine the references when it explains the fouling problems associated with worm drives. (*Id.* at 20 (citing JX-1 at 8:9-12).)

In its reply brief, OurPet's asserts that Complainants apply the overly rigid TSM test for obviousness that was rejected by the Supreme Court in *KSR*. OurPet's argues that one of skill in the art would have been able to modify Carlisi based on the teachings of Johnson to develop a fully working litter box with a motor mounted on the carriage. (ORB at 15-19 (citing RX-72; Tr. at 287:2-290:3, 304:2-23, 323:14-326:14, 1126:10-1141:8, 1170:22-1171:15).) OurPet's asserts that Complainants' expert has selectively defined the knowledge of one of skill in the art throughout this investigation to fit Complainants' case. (*Id.*) Based on Dr. Wood's opinions about the knowledge possessed by one of skill in the art with respect to the issues of best mode and disclaimer of worm drives, OurPet's argues that it follows that one of skill in the art would have the knowledge to modify Carlisi based on Johnson to make an operable litter box. (*Id.*)

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Complainants' Position: Complainants argue that claim 8 is not rendered obvious by the combination of Carlisi and Johnson. (WIB at 45.) Complainants claim that there is no reason to combine Carlisi and Johnson. Complainants claim that Johnson does not involve cat litter boxes or animal toilets and is of a much larger scale than the litter box of Carlisi. (*Id.* at 45-46 (citing CX-934C at ¶ 49; CX-284; RX-72 at 1:8-9, Fig. 7).) Complainants further argue that Carlisi already discloses a way to protect the motor from fouling, and that by combining Carlisi and Johnson, the fouling problem would be increased as opposed to decreased. (*Id.* at 47 (citing RX-5 at 3:24-28).)

Complainants also argue that the combination of Johnson and Carlisi would not work. (*Id.* at 48.) Complainants rely on Dr. Wood's testimony that mounting the motor on the carriage of Carlisi would render the worm drive system of Carlisi inoperable. (*Id.* at 48-49 (citing CX-934C at ¶¶ 51-52, 82, 107).) Dr. Wood testified that one of skill in the art would need to go outside of Carlisi and Johnson to make the combined system operable, and this would require knowledge that was beyond what one of skill in the art possessed at the time of invention. (*Id.* at 49 (citing CX-934C at ¶ 51).)

Complainants offer evidence of secondary considerations of non-obviousness, which will be discussed in detail *infra*. (WIB at 56-69.) Complainants assert that this "abundant" objective evidence confirms that the '847 patent claims are not obvious. (*Id.*)

In reviewing OurPet's obviousness argument, Complainants contend that OurPet's failed to apply the correct legal test taught in *Graham v. John Deere*. (WRB at 34-38.) Complainants also contend that the obviousness case of OurPet's is built on attorney argument and not evidence. (*Id.* at 32-34.)

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Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi and Johnson renders claim 8 obvious. (SIB at 38.) Staff claims that "the two prior art patents are in the same field of endeavor, and...the combination would have been readily apparent to a person skilled in the art." (*Id.*)

Discussion and Conclusion: I find that Claim 8 is not rendered obvious by the combination of Carlisi and Johnson.

Johnson discloses a circular barn enclosure with a motorized arm to clean large animal (e.g. porcine) waste. The motorized arm rotates around a pivot post in the center of the circle and pushes the animal waste to a trench along the outer rim of the circle:

The present invention comprises an animal enclosure in which the necessary cleaning function is performed cyclically and automatically, the unwanted materials being delivered not at the center but at the periphery of the enclosure so that human entrance to the area inhabited by animals is required only for such emergencies as the tending of ailing animals. This is accomplished by designing the enclosure to be circular, surrounding it with a trench and restraining fence, and operating a cleaning apparatus pivotally about the center of the enclosure to scrape material from the surface and carry it to the trench, for further transport to a common loading area.

(RX-72 at 1:19-31.) While the claims of Johnson are not explicitly limited to use with any specific animal, the Background of the Invention notes that "[t]his invention relates to the field of animal husbandry, and particularly to swine production on a commercial scale." (*Id.* at 1:5-7.)

The arm is driven around the circular barn area by a motor mounted on top of the arm. The motor drives a drive wheel on the outer edge of the arm:

Apparatus 30 includes an arm 31 which extends generally radially from center 22, where it is pivotally connected by a fitting 32 with a hollow pivot post 33. A scraper 34 and a conveyor 35 are carried by arm 31, the former contacting surface 20 as the apparatus is carried around pivot 33 by a drive wheel 36 which is a part of a power unit 37 at the outer end of arm 31. (*Id.* at 2:8-15.)

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The system is designed to operate while animals are in the circular enclosure. The arm moves slowly, and if the animals come in contact with a trip wire attached to the arm, the motor de-energizes and the arm stops. (*Id.* at 3:18-31.) The trip wire may also be electrified to prod the animals to move. (*Id.* at 3:32-39.)

OurPet's points to the power unit 37 mounted on the arm 31 as the "motor means mounted on the carriage." According to OurPet's, Johnson in combination with Carlisi therefore renders claim 8 obvious.

I find that it would not have been obvious to combine Carlisi and Johnson. Johnson relates to a large barn system used to clean the waste of animals such as pigs. The scope of Johnson compared to Carlisi alone counsels against a finding that one of ordinary skill in the art would even look to Johnson when designing a self-cleaning cat litter box. The enclosure of Johnson is circular, not rectangular, and the arm in Johnson moves in a circular direction, not in a linear fashion as in Carlisi. The arm in Johnson is designed to be used while the animals are still in the enclosure, while the rake in Carlisi is designed to be used only after the cat has left the litter box. Johnson uses a single-direction motor while Carlisi uses a reversible motor. In sum, I do not concur with OurPet's position that Johnson is in the same field of endeavor as Carlisi and the '847 patent. While all three patents relate to disposal of animal waste, the similarities end there. (*See* CX-934C at ¶¶ 49-50, 55-57.)

In asserting that a motivation existed to combine Carlisi and Johnson, OurPet's claims that such motivation comes from the statement in the '847 patent regarding the possibility of worm drives being fouled by litter. (OIB at 20-21.) The point of examining whether a motivation to combine exists is to prevent an improper hindsight analysis. *KSR*, 127 S.Ct. at 1742 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and

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must be cautious of arguments reliant upon *ex post* reasoning.”) Thus the motivation to combine cannot come from the actual patent that OurPet’s is attempting to invalidate; it must come from a time prior to the ‘847 patent. Otherwise the ‘847 patent would be used as a roadmap to combine obviousness references. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

In *Ruiz*, the court explained that:

Without this important requirement [referring to the language “as a whole” in § 103], an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Id. Even under the flexible analysis required by *KSR*, OurPet’s cannot use the specification of the ‘847 patent as the reason to combine references.

Beyond a single passage in the ‘847 patent specification, OurPet’s has not shown that the alleged litter fouling problem was known to those of ordinary skill in the art at the time of invention. OurPet’s expert, Dr. Rice, testified that the reason to combine Carlisi and Johnson was to solve the problem of litter and waste material interfering with the worm drive. (RX-201 at ¶ 48.) I find that this testimony does not provide an adequate reason to combine Carlisi and Johnson, as it merely re-states OurPet’s argument regarding the specification of the ‘847 patent without an explicit mention of the portion of the ‘847 patent where the problem is identified.

OurPet’s provides no other argument or evidence regarding why one of ordinary skill in the art would choose to combine Carlisi and Johnson. With no credible evidence explaining why one of ordinary skill in the art would choose to combine Carlisi and Johnson, OurPet’s cannot meet its burden to prove that claim 8 is obvious. *Innogenetics, N.V. v. Abbott Labs*, 512 F.3d 1363, 1373-74 (Fed. Cir. 2008).

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In *Innogenetics*, the court affirmed the district court's exclusion of an expert witness's vague and conclusory obviousness testimony regarding motivation to combine. 512 F.3d at 1373-74. Besides that testimony, there was no evidence in the record of a reason to combine the obviousness references. The court explained that, even after *KSR*, "[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention." *Id.* at 1374 n. 3.

4. Claim 13

Claim 13 is dependent on claim 8. It adds the following two limitations:

a cat exit sensor for sensing exit of a cat from the litter chamber; and

delay means, connected to the sensor and to the reversible motor, for actuating the comb drive motor to drive the comb from the storage position to the discharge position at a predetermined time interval subsequent to sensing of exit of a cat from the litter chamber.

Respondent OurPet's asserts that the combination of Carlisi, Johnson, and at least one of the following references: (1) U.S. Pat. No. 5,279,258 to Kakuta ("Kakuta"); (2) U.S. Pat. No. 4,574,735 to Hohenstein ("Hohenstein"); (3) U.S. Pat. No. 4,729,342 to Loctin ("Loctin"); (4) U.S. Pat. No. 4,844,011 to Strickland ("Strickland"); or (5) U.S. Pat. No. 5,107,797 to LaRoche ("LaRoche") renders claim 13 obvious pursuant to 35 U.S.C. § 103(a).

Respondent OurPet's Position: As discussed *supra*, OurPet's asserts that Johnson and Carlisi disclose all of the elements of claim 8. OurPet's argues that each of the four identified references independently discloses the additional claim limitations added by claim 13, and that the combinations proposed by OurPet's would be obvious to one of ordinary skill in the art. (OIB at 21-25; ORB at 19-21 (citing RX-178 at 7:48-52, 8:20-26; Tr. at 988:17-989:12; JX-1 at 1:47-50; RX-73 at 2:13-18, 3-4; RX-82 at 4:1-40; RX-6 at 3:8-22).)

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Complainants' Position: Complainants assert that OurPet's obviousness arguments for claim 13 regarding Hohenstein, Loctin, and Strickland¹² were waived when they were not included in OurPet's pre-hearing statement. (WRB at 32.) Complainants argue that Kakuta does not teach the elements of claim 13 because Kakuta does not disclose any delay after sensing the exit of the cat. (WIB at 49-50; WRB at 41 (citing Tr. at 948:16-21, 953:9-954:7, 994:23-997:25; CX-934C at ¶¶ 62, 64-67, 88, 91, 113; RX-178 at 2:60-65).) Complainants also assert that Kakuta teaches away from use in a dusty litter environment. (WIB at 50-51; WRB at 41 (citing CX-934C at ¶¶ 69-70, 117; RX-178 at 1:32-42, 3:14-19).)

Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi, Johnson, and Kakuta renders claim 13 obvious. (SIB at 38.) Staff claims that "Kakuta teaches a sensor for use with animals and that it would have been readily apparent to a person skilled in the art to use such a sensor with Carlisi and Johnson." (*Id.*)

Discussion and Conclusion: I find that Claim 13 is not rendered obvious by the combination of Carlisi, Johnson, and Kakuta.

As an initial matter, I find that OurPet's has waived all arguments regarding Hohenstein, Loctin, Strickland, and LaRoche with respect to claim 13 because these references were not disclosed as obviousness references for claim 13 in OurPet's pre-hearing statement. (*See* Ground Rule 8(f).) Therefore, my analysis will focus only on the combination of Carlisi, Johnson, and Kakuta.

Claim 13 depends on claim 8. I have already found that the combination of Carlisi and Johnson does not render claim 8 obvious. It therefore follows that claim 13 is not obvious. *In re*

¹² OurPet's did not raise LaRoche until its responsive brief, and thus Complainants did not have a chance to discuss this reference. Like Hohenstein, Loctin, and Strickland, LaRoche was not raised in OurPet's pre-hearing brief in the context of claim 13.

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Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious...”)

Even if claim 8 was found to be obvious, the combination of Carlisi, Johnson, and Kakuta would not render claim 13 obvious. Kakuta discloses an automated cat toilet. In the preferred embodiment, it discloses a sensor system to sense how long the cat remains on the cat toilet. The purpose of this system is to determine whether or not excretion has taken place. The toilet will energize the motors to remove waste only after the cat remains on the cat toilet for at least the predetermined amount of time (3.8 seconds in the preferred embodiment) and then exits. This is explained in the following passage from the specification:

The output of the sensor output detecting circuit 59 is also connected with the input of a minimum resident time detecting circuit 67 which meters the time considered normal for a pet to eliminate. Minimum resident time detecting circuit 67 comprises a non-trigger type one-shot multivibrator 67a. It supplies an H-level signal at a preset time after the pet steps on platform 12. This required time means a duration of time which is assumed to be from when the pet steps on the platform until the pet steps off the platform 12 for reasons other than elimination of waste. In this embodiment, this required time is set up as 3.8 seconds. When the pet stays on platform 12 more than 3.8 seconds, minimum resident time detecting circuit 67 judges that the pet completed excretory function. However, this time can be set according to any time estimated as necessary for excretion.

(RX-178 at 8:10-26.)

I find that Kakuta does not disclose “delay means...for actuating the comb drive motor...at a predetermined time interval subsequent to sensing of exit of a cat from the litter chamber.” The claim language clearly requires the delay means to create a predetermined delay in between the time the cat exits the litter box and the time the motor is actuated. In Kakuta, the motor is actuated immediately after the cat steps off of the cat toilet, assuming the cat has stayed on the toilet for at least the predetermined amount of time. (RX-178 at 2:60-65, 8:10-26, CX-934C at ¶¶ 63, 65.) The sensor system described above only relates to determining whether or

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not the motor needs to be actuated. There is no delay after sensing the cat exit the cat toilet in Kakuta. (CX-934C at ¶ 64.)

OurPet's expert Dr. Rice concurs with this analysis. In discussing Figure 12 from Kakuta, he agreed that the cat stepping off of the toilet (assuming the cat had been on the toilet for at least the predetermined time) and the actuation of the motor are simultaneous events:

Q. We see this line which indicates when the cat steps off the litter box.

A. Yes.

Q. And that's the first line, the top line A. That corresponds in time, in fact, at the very same time or simultaneously with output line N, which is when the motor starts to roll the paper, doesn't it?

A. Yes.

Q. So you agree with me that those are simultaneous events?

A. Yes.

(Tr. at 953:21-954:7.)

I also find that Kakuta teaches away from use in a cat litter environment. In discussing the advantages of the invention over prior art litter boxes, Kakuta lists as an advantage the fact that the cat's paws do not come in contact with used litter, making the toilet more sanitary:

The pet's paws are not in contact with used litter, so the advantage of indoors hygiene is maintained, and the recurring presence of a clean portion of the waste-receiving member gives a sanitary appearance to the pet toilet in any room.

(RX-178 at 3:14-18.) The fact that Kakuta teaches away from use in the cat litter environment found in the invention of Carlisi and the '847 patent, further supports a finding that claim 13 is nonobvious. *KSR*, 127 S.Ct. at 1740 (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious). Because Kakuta does not teach

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the limitations of claim 13, the combination of Carlisi, Johnson, and Kakuta do not render claim 13 obvious.

5. Claim 24

Respondent OurPet's asserts that the combination of Carlisi and Johnson renders claim 24 obvious pursuant to 35 U.S.C. § 103(a).

Respondent OurPet's Position: OurPet's arguments regarding claim 8 were written in a manner to apply also to claim 24. Those arguments will, therefore, not be repeated here. The arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 24.

Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claim 24. Those arguments will, therefore, not be repeated here. The arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 24.

Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi and Johnson renders claim 24 obvious. (SIB at 38.) Staff claims that "the two prior art patents are in the same field of endeavor, and...the combination would have been readily apparent to a person skilled in the art." (*Id.*)

Discussion and Conclusion: Claim 24 is not rendered obvious by the combination of Carlisi and Johnson for the reasons discussed *supra* with respect to claim 8.

6. Claim 25

Claim 25 is dependent on claim 24. It adds the following limitation: "the motor means includes a reversible drive motor." Respondent OurPet's asserts that the combination of

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Carlisi and Johnson renders claim 25 obvious pursuant to 35 U.S.C. § 103(a).

Respondent OurPet's Position: OurPet's arguments regarding claim 8 were written in a manner to apply also to claim 25. Those arguments will, therefore, not be repeated here. The arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 25. OurPet's further argues that Carlisi discloses the reversible motor limitation of claim 25. (OIB at 21 (citing RX-5 at 3:29-30, 4:19-20).)

Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claim 25. Those arguments will, therefore, not be repeated here. The arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 25.

Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi and Johnson renders claim 25 obvious. (SIB at 38.)

Discussion and Conclusion: Claim 25 is not rendered obvious by the combination of Carlisi and Johnson for all of the reasons described *supra* in the discussion of claims 8 and 24.

7. Claim 27

Respondents assert that the combination of Carlisi and U.S. Pat. No. 4,844,011 to Strickland ("Strickland") renders claim 27 obvious pursuant to 35 U.S.C. § 103(a).

Respondent Lucky Litter's Position: Lucky Litter asserts that Carlisi and Strickland disclose all of the elements of claim 27. Lucky Litter claims that Carlisi discloses all of the elements of claim 27 except for the "mode selector means" limitation. (LIB at 26-27 (citing RX-5; JX-2 at 293, RX-198 at ¶¶ 67-69, 79; Tr. at 242:14-243:6).) Lucky Litter argues that

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Strickland discloses the missing “mode selector means” limitation. (*Id.* at 27 (citing RX-198 at ¶ 69).)

Lucky Litter argues that one of ordinary skill in the art would combine Carlisi and Strickland. (LIB at 28-31 (citing RX-54C; RX-198 at ¶ 71; RX-183 at 4:28-52; RX-185 at 10:23-37; RX-179 at 3:63-4:14; RX-180 at 4:51-64; RX-181 at 3:48-51; Tr. at 1172:11-24, 1181:14-19).) Lucky Litter claims that “one of ordinary skill in the art could close the small logical gap between the prior art and the claims at issue by pursuing known options within his or her technical grasp.” (*Id.* at 29.) Lucky Litter argues that because using switches to change between modes was so well known in the prior art, one of ordinary skill in the art would have the knowledge needed to add the switch disclosed in Strickland to the litter box disclosed in Carlisi. (*Id.* at 29-30.)

Respondent OurPet’s Position: OurPet’s agrees with and adopts Lucky Litter’s argument regarding claim 27. (OIB at 25.)

Complainants’ Position: Complainants argue that claim 27 is not rendered obvious by the combination of Carlisi and Strickland. (WIB at 53.) Complainants highlight the fact that the examiner considered both Carlisi and Strickland during prosecution and found that claim 27 was patentable in light of these references. (*Id.* (citing CX-934C at ¶¶ 148-153; JX-2 at 293, 375-76, 384-85, 393, 396).)

Complainants argue that Carlisi does not disclose a pan-shaped housing because the housing 16 in Carlisi does not hold cat litter. (*Id.* (citing Tr. at 421:12-16; CX-934C at ¶¶ 126-27; RX-198 at ¶ 79).) Complainants assert that neither Strickland nor Carlisi disclose the “automatic operation mode” because neither patent teaches a mode of operation where combing is initiated in response to cat-based input plus a time delay. (*Id.* at 54.)

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Complainants offer evidence of secondary considerations of non-obviousness, which will be discussed in detail *infra*. (WIB at 56-69.) Complainants assert that this “abundant” objective evidence confirms that the ‘847 patent claims are not obvious. (*Id.*)

Commission Investigative Staff’s Position: Staff argues that the combination of Carlisi and either Strickland or Kakuta renders claim 27 obvious. (SIB at 38.)

Discussion and Conclusion: Claim 27 is not rendered obvious by the combination of Carlisi and Strickland.

For all of the reasons discussed in the anticipation analysis *supra*, Carlisi does not disclose the “comb drive means” of claim 27. I find that the combination of Carlisi and Strickland also does not disclose the “comb drive means” of claim 27 because Strickland relates to a system involving a conveyor belt and not a comb.

Additionally, I find that neither reference discloses a “mode selector means.” I have found *supra* that Carlisi does not disclose a “mode selector means.” Strickland discloses a cat waste disposal system that includes a conveyor belt. (*See generally* RX-6.) Litter is dropped onto the surface of a conveyor belt. (*Id.* at 2:57-3:2, 4:42-54.) The cat excretes on the litter, and then the belt turns to dump the used litter into waste bag. (*Id.* at 4:55-5:6.)

Lucky Litter relies on Dr. Cagan’s analysis in stating that Strickland discloses a “mode selector means.” Dr. Cagan stated:

In addition, as the examiner stated, and as illustrated on RDX 5, Strickland discloses a mode selector means 54 for selecting between automatic actuation and manual actuation of the device. This is found in Strickland at column 3, lines 20-23. Strickland also discloses that the system may be operated automatically either by a timer or by a pressure sensitive means at column 3, lines 13-19. One skilled in the art would understand that such a switch could readily be included in Carlisi.

(RX-198C at ¶ 69.)

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Strickland discloses that the system may be operated through either a timer or a pressure sensor:

Though the use of an intermittent timer 54 is preferred to operate the system, a pressure sensitive means 56 positioned below belt surface 14 may be used by itself or in combination with the timer 54. The pressure sensitive means 56 may independently actuate the opening of base 32 and timely move the belt surface 14 after actuated by the pet.

(RX-6 at 3:13-19.)

If the pressure sensitive means 56 is used, the exit of the pet would then command the motor 76 to rotate the belt 58 to dump the amount of litter 42 into the chute 86, as discussed above. If the timer is used, the used litter will remain until the timer actuates the motor 76 to dump the used litter into the chute 86.

(*Id.* at 4:64-5:2.) The system may also include a “manual actuating means” provided in the timer to allow an operator to control the litter flow and waste disposal. (*Id.* at 3:20-23.)

I find that Strickland does not disclose the structure of a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 of the ‘847 patent and accompanying text. There is no indication in Strickland that the invention includes a microprocessor, much less a microprocessor programmed to perform the algorithm disclosed in the ‘847 patent specification.

Because the combination of Carlisi and Strickland does not disclose all of the elements of claim 27, claim 27 is not rendered obvious by such a combination.

8. Claim 31

Respondent OurPet’s asserts that the combination of Carlisi and Johnson renders claim 31 obvious pursuant to 35 U.S.C. § 103(a).

Respondent OurPet’s Position: OurPet’s arguments regarding claim 8 were written in a manner to apply also to claim 31. Those arguments will, therefore, not be repeated here. The

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arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 31.

Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claim 31. Those arguments will, therefore, not be repeated here. The arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 31.

Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi and Johnson renders claim 31 obvious. (SIB at 38.)

Discussion and Conclusion: Claim 31 is not rendered obvious by the combination of Carlisi and Johnson for all of the reasons described *supra* in the discussion of claim 8.

9. Claim 32

Claim 32 is dependent on claim 31. It adds the following limitation: "the drive motor is reversible." Respondent OurPet's asserts that the combination of Carlisi and Johnson renders claim 32 obvious pursuant to 35 U.S.C. § 103(a).

Respondent OurPet's Position: OurPet's arguments regarding claim 8 were written in a manner to apply also to claim 32. Those arguments will, therefore, not be repeated here. The arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 32. OurPet's further argues that Carlisi discloses the reversible motor limitation of claim 32. (OIB at 21 (citing RX-5 at 3:29-30, 4:19-20).)

Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claim 32. Those arguments will, therefore, not be repeated here. The

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arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 32.

Commission Investigative Staff's Position: Staff argues that, assuming Complainants' proposed claim constructions are adopted, the combination of Carlisi and Johnson renders claim 32 obvious. (SIB at 38.)

Discussion and Conclusion: Claim 32 is not rendered obvious by the combination of Carlisi and Johnson for all of the reasons described *supra* in the discussion of claims 8 and 31.

10. Claim 33

Respondents assert that the combination of Carlisi, U.S. Pat. No. 4,844,011 and Strickland ("Strickland") renders claim 33 obvious pursuant to 35 U.S.C. § 103(a).

Respondent Lucky Litter's Position: Lucky Litter asserts that Carlisi and Strickland disclose all of the elements of claim 33. Lucky Litter claims that Carlisi discloses all of the elements of claim 33 except for the "mode selector switch" limitation. (LIB at 26-27 (citing RX-5; JX-2 at 293, RX-198 at ¶¶ 67-69, 79; Tr. at 242:14-243:6).) Lucky Litter argues that Strickland discloses the missing "mode selector switch" limitation. (*Id.* at 27 (citing RX-198 at ¶ 69).)

Lucky Litter argues that one of ordinary skill in the art would combine Carlisi and Strickland. (LIB at 28-31 (citing RX-54C; RX-198 at ¶ 71; RX-183 at 4:28-52; RX-185 at 10:23-37; RX-179 at 3:63-4:14; RX-180 at 4:51-64; RX-181 at 3:48-51; Tr. at 1172:11-24, 1181:14-19).) Lucky Litter claims that "one of ordinary skill in the art could close the small logical gap between the prior art and the claims at issue by pursuing known options within his or her technical grasp." (*Id.* at 29.) Lucky Litter argues that because using switches to change between modes was so well known in the prior art, one of ordinary skill in the art would have the

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knowledge needed to add the switch disclosed in Strickland to the litter box disclosed in Carlisi. (*Id.* at 29-30.)

Respondent OurPet's Position: OurPet's agrees with and adopts Lucky Litter's argument regarding claim 33. (OIB at 25.)

Complainants' Position: Complainants argue that claim 33 is not rendered obvious by the combination of Carlisi and Strickland. (WIB at 53.) Complainants highlight the fact that the examiner considered both Carlisi and Strickland during prosecution and found that claim 33 was patentable in light of these references. (*Id.* (citing CX-934C at ¶¶ 148-153; JX-2 at 293, 375-76, 384-85, 393, 396).)

Complainants argue that Carlisi does not disclose a pan-shaped housing because the housing 16 in Carlisi does not hold cat litter. (*Id.* (citing Tr. at 421:12-16; CX-934C at ¶¶ 126-27; RX-198 at ¶ 79).) Complainants assert that neither Strickland nor Carlisi disclose the "automatic operation position" because neither patent teaches a mode of operation where combing is initiated in response to cat-based input plus a time delay. (*Id.* at 54.)

Complainants offer evidence of secondary considerations of non-obviousness, which will be discussed in detail *infra*. (WIB at 56-69.) Complainants assert that this "abundant" objective evidence confirms that the '847 patent claims are not obvious. (*Id.*)

Commission Investigative Staff's Position: Staff argues that the combination of Carlisi and either Strickland or Kakuta renders claim 33 obvious. (SIB at 38.)

Discussion and Conclusion: I find that Claim 33 is not rendered obvious by the combination of Carlisi and Strickland.

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I note that the examiner already considered the same combination of Carlisi and Strickland during prosecution. (JX-2 at 382.) Thus, Respondents have the added burden of overcoming the deference due to the USPTO.

Respondents claim that Strickland discloses “a mode selector switch...the switch being moveable between a manual operation position...and an automatic operation position...” What Strickland discloses is a “manual actuation means.” It is briefly described in the specification: “[a]dditionally, the present invention may include a manual actuating means 55 provided in timer 54 to open and close the base 32 and move the belt surface 14 as desired by the operator.” (RX-6 at 3:20-23.)

Respondents claim that this “manual actuation means” is the “mode selector switch” of claim 33 because it allows a user to operate the cat waste disposal system manually. The record lacks clear and convincing evidence that the “manual actuation means” of Strickland is a “mode selector switch” that is moveable between a manual operation position and an automatic operation position.

Strickland provides no further discussion or explanation beyond the above-quoted sentence regarding the “manual actuation means.” The term “manual actuation means” is vague, and the specification does nothing to clarify what structure this term encompasses. There is no mention of a switch, and no mention of a switch that is moveable between two positions. While it is possible that the “manual actuation means” of Strickland could be a switch, such speculation does not amount to clear and convincing evidence supporting the assertion of invalidity.

I find that one of ordinary skill in the art would not necessarily know that the “manual actuation means” of Strickland encompassed a switch, as Respondents fail to identify any evidence to support such a finding. Respondents’ experts are silent on this issue, and

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Respondents make no argument that the “mode selector switch” was somehow inherently present. Because Strickland does not disclose the “mode selector switch” of claim 33, Respondents have failed to meet the clear and convincing evidence burden required to prove that claim 33 is obvious in light of Carlisi and Strickland.

11. Claim 41

Claim 41 depends from claim 27. It adds the following limitation: “a sensor system for determining whether a cat is in the litter chamber.” Respondents assert that each of the combinations of (1) Carlisi and Strickland; (2) Carlisi, Strickland, and Kakuta; or (3) Carlisi, Strickland, and Loctin renders claim 41 obvious pursuant to 35 U.S.C. § 103(a).

Respondent Lucky Litter’s Position: As discussed *supra*, Lucky Litter asserts that Carlisi and Strickland disclose all of the elements of claim 27, and there is a reason to combine Carlisi and Strickland. Lucky Litter argues that “[n]ot only do the Strickland, Loctin, and Kakuta references disclose sensors, but one of ordinary skill in the art also would have been familiar with sensors in general.” (LIB at 31 (citing Tr. at 1170:22-1171:15, 1174:13-15, 1181:20-25, 1182:11-25, 1185:22-25).)

Respondent OurPet’s Position: OurPet’s agrees with and adopts Lucky Litter’s argument regarding claim 41. (OIB at 25.)

Complainants’ Position: Complainants argue that Respondents have failed to put forth evidence of obviousness to overcome the USPTO and the evidence put forward by Dr. Wood. (WIB at 55.) Complainants also assert that claim 41 is not obvious because it depends on claim 27, which Complainants argue is not obvious. (*Id.* at 56.)

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Commission Investigative Staff's Position: Staff argues that the combination of Carlisi and Kakuta or the combination of Carlisi, Strickland, and Kakuta renders claim 41 obvious. (SIB at 38.)

Discussion and Conclusion: I find that Claim 41 is not rendered obvious by any of the combinations asserted by Respondents for all of the reasons described *supra* in the discussion of claim 27.

12. Claim 42

Claim 42 depends from claim 41. It adds the following limitation: "said sensor system includes a source of radiation and a radiation detector." Respondents assert that each of the combinations of (1) Carlisi, Strickland, and Kakuta; or (2) Carlisi, Strickland, and Loctin renders claim 42 obvious pursuant to 35 U.S.C. § 103(a).

Respondent Lucky Litter's Position: As discussed *supra*, Lucky Litter asserts that Carlisi and Strickland disclose all of the elements of claim 27, and there is a reason to combine Carlisi and Strickland. Lucky Litter argues that Loctin and Kakuta disclose *infrared* sensors. (LIB at 28 (citing JX-1; RX-178 at 7:48-52, 8:20-26, Tr. at 988:17-989:12, 1185:22-25; RX-82 at 4:1-40).)

Respondent OurPet's Position: OurPet's agrees with and adopts Lucky Litter's argument regarding claim 42. (OIB at 25.)

Complainants' Position: Complainants argue that Respondents have failed to put forth evidence of obviousness to overcome the USPTO and the evidence put forward by Dr. Wood. (WIB at 55.) Complainants also assert that claim 42 is not obvious because it depends on claim 27, which Complainants argue is not obvious. (*Id.* at 56.)

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Commission Investigative Staff's Position: Staff argues that the combination of Carlisi, Strickland and Kakuta renders claim 42 obvious. (SIB at 38.)

Discussion and Conclusion: Claim 41 is not rendered obvious by any of the combinations asserted by Respondents for all of the reasons described *supra* in the discussion of claims 27 and 41.

13. Objective Indicia of Non-Obviousness

Complainants offer evidence of objective indicia of non-obviousness (also commonly called “secondary considerations”) to rebut Respondents’ arguments that the ‘847 is obvious in light of the prior art.

Complainants’ Position: Complainants assert that there is “abundant” evidence of secondary considerations. (WIB at 56.)

First, Complainants assert that Applica’s patented LitterMaid® products have been a huge commercial success. Complainants claim that LitterMaid® is one of the most profitable product lines for Applica. LitterMaid® “has had sustained sales averaging nearly \$30 million a year for eight years straight, and has had overall sales near \$280 million.” (*Id.* at 58 (citing CX-895C at ¶¶ 152, 155; CX-934C at ¶¶ 208-210; CDX-322C; CX-552C; CX-542C; CX-559C; CX-560C; CX-562C; CX-568C).) Complainants assert that this success is due to the innovative features of the patented product, and not advertising. Complainants claim that any advertising done by Applica merely made consumers aware of the product, but that people bought the products due to their innovative features. (*Id.* at 59 (citing Tr. at 200:7-201:8).) Complainants offer a graph demonstrating that product sales increased even after Applica reduced its advertising expenditures. (CDX-403.)

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Second, Complainants assert that there is “overwhelming” evidence that the patented LitterMaid® products have been praised in the industry. (*Id.* at 60.) Complainants cite to evidence that retailers were excited about the LitterMaid® product and agreed to carry it in their stores without any track record of similar products. (*Id.* (citing CX-895C at ¶ 108; CX-894C at ¶¶ 251-252).) Applica paid {

} Complainants also cite Lucky Litter’s development documents, which acknowledged the LitterMaid® as a “proven design concept” and a “market leader.” (*Id.* at 61 (citing CX-934C at ¶¶ 393, 395, 423-424; CX-86C at 1; CX-537C at 2; CX-221C; JX-20C at 42:18-43:19; CX-220C at 11; Tr. at 814:2-6; JX-12C at 221:1-5; CX-768C at 1).)

Third, Complainants state that Applica has paid nearly \$14.5 million in license royalties to WRC to license the ‘847 patent. (*Id.* at 61 (citing CX-895C at ¶ 104).) Complainants argue that this evidence of licensing and substantial royalties proves that the invention was not obvious.

Fourth, Complainants assert that numerous publications, including other patents, described the need in the market for an automatic self-cleaning litter box. Complainants claim that the LitterMaid® products met this long felt but unresolved need. (*Id.* at 62 (citing CX-934C at ¶¶ 384-87; CX-715 at 1:18-21; CX-922 at 1:54-2:20; CX-540 at 1; CX-553C).)

Fifth, Complainants claim that there is evidence of the failure of others to design a self-cleaning litter box. Complainants note that Mr. Waters failed on his first attempt, and that Lucky Litter’s initial development efforts failed as well. (*Id.* at 62-63 (citing CX-894C at ¶¶ 24-25, 115; JX-12C at 149:6-11, 149:19-21).)

Sixth, Complainants argue that Mr. Waters achieved unexpected superior results with his invention. Specifically, Complainants assert that “[t]he need to delay before raking the litter in

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response to cat use was an unexpected/unpredictable result for Mr. Waters' product that he did not discover until he actually tested his prototype with cats." (*Id.* at 64 (citing CX-894C at ¶ 47).)

Seventh, Complainants assert that there is strong evidence that Respondents copied the claimed invention. Complainants claim that Respondents' development documents show that Respondents examined the LitterMaid® products during the development process. Complainants highlight the fact that Lucky Litter referred to its design as a "better LitterMaid®" and reviewed the '847 patent during development of the ScoopFree products. (*Id.* at 66-67 (citing Tr. at 802:12-15, 807:15-808:2, 819:22-820:2; CX-213C; CX-214C; JX-25C at 66:24-67:4; CX-818C; JX-20C at 22:3-13; JX-24C at 64:8-67:4; CX-814; JX-12C at 169:1-7).) Complainants further highlight the fact that OurPets disassembled LitterMaid® products during the design process and sent two LitterMaid® products to Hong Kong for an examination of the electrical components. (*Id.* at 68 (citing JX-18C at 224:2-10; JX-10C at 33:9-13, 142:18-143:3, 190:13-19, 191:7-21, 192:14-193:7; CX-128C; JX-8C at 124:7-125:6; CX-178C; Tr. at 878:9-21, 1072:25-1073:25, 1254:15-1258:6; CX-177C; CX-174C at 1; CX-131C; JX-11C at 95:25-96:2, 103:10-22, 104:9-13, 104:17-23, 105:11-106:1, 106:10-16; CX-129C; JX-15C at 53:24-54:19; CX-336C; JX-9C at 111:2-20, 121:18-122:6; CX-934C at ¶ 414).)

Respondent Lucky Litter's Position: Lucky Litter asserts that the secondary considerations cannot overcome the strong showing of obviousness. (LIB at 31.) With regard to Complainants' claim of commercial success, Lucky Litter argues that the success was the result of a national advertising campaign that included the use of Garfield the cat and nationally televised infomercials. (*Id.* at 32 (citing Tr. at 188:5-8, 191:14-22, 194:12-25, 838:8-17; CX-607C; CDX-221C).) Lucky Litter also argues that Dr. Wood's opinion on commercial success is

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flawed because he did not factor out Applica's distribution network or perform a claim-by-claim analysis. (*Id.* at 32-33 (citing Tr. at 1164:11-18).)

With regard to Complainants' claim of copying, Lucky Litter denies that it copied the LitterMaid® products. (*Id.* at 33.) Lucky Litter asserts that it invested ten man-years into the development of the ScoopFree products. Lucky Litter acknowledges that it reviewed the LitterMaid® products, but did so as a part of a benchmarking analysis, which Lucky Litter claims is a normal part of any product development process. (*Id.* (citing Tr. at 814:12-16, 825:9-14, 828:20-22, 838:18-840:19, 841:2-10, 1221:24-1222:4, 1228:24-1229:9; RX-198 at ¶¶ 24-26).) Lucky Litter claims that it found the flaws of the LitterMaid® products and attempted to introduce an improved automated cat litter box. (*Id.* at 34; LRB at 20-21 (citing CX-751C at 1-2; Tr. at 832:8-833:8; 834:1-17; JX-24C at 93:25-95:6; RX-236C at ¶ 40; RX-13; RX-14; RX-15).) With regard to Complainants' claim of long felt but unresolved need, Lucky Litter argues that other automatic self-cleaning litter boxes were on the market and there were multiple prior art patents for automatic self-cleaning litter boxes. (LRB at 21.)

Respondent OurPet's Position: OurPet's asserts that the secondary considerations cannot overcome the strong showing of obviousness. (ORB at 21-25.) With regard to Complainants' claim of commercial success, OurPet's argues that Complainants' evidence is not persuasive because the LitterMaid® was the first automatic self-cleaning litter box on the market. (*Id.* at 21-22.) Because the LitterMaid® was competing against conventional litter boxes and not other automatic self-cleaning litter boxes, OurPet's asserts that the evidence of commercial success is misleading. (*Id.*) OurPet's also echoes Lucky Litter's argument that the commercial success was driven by Applica's advertising efforts. (*Id.* at 22-23 (citing CX-894C at ¶¶ 249-51, 256-57).)

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With regard to long felt need, OurPet's argues that Complainants' evidence is very general in nature and does not show a long felt need for a litter box including the patented features. (*Id.* at 23-24 (citing CX-553C; CX-540; JX-1 at 10:24-41).) OurPet's argues that Respondents have not failed to produce a self-cleaning litter box, as they have each brought a self-cleaning litter box to market. (*Id.* at 24 (citing CX-934C at ¶ 389; CX-587C at 1).)

OurPet's asserts that Complainants have failed to point to any particular feature of the claims that has been copied by OurPet's. (*Id.*) OurPet's argues that the evidence regarding licensing is not persuasive {

}(*Id.* at 25.)

Commission Investigative Staff's Position: Staff argues that "[t]he evidence does not show secondary considerations that would overcome the strong obviousness determination." (SIB at 38.) Staff provides no further discussion on this issue.

Discussion and Conclusion: Reviewing the evidence of secondary considerations is an important step in the obviousness analysis. As explained by the Federal Circuit:

It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included. Thus evidence rising out of the so-called "secondary considerations" must always when present be considered en route to a determination of obviousness. Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (Fed. Cir. 1983) (citations omitted).

While I have already found that Respondents failed to make out a clear and convincing case of obviousness for any of the asserted claims, I will address the alleged evidence of secondary considerations raised by Complainants.

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I find that the commercial success of the LitterMaid® products supports a finding of non-obviousness. “When a patentee can demonstrate commercial success, usually shown by significant sales in a relevant market, and that the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997). If the patentee makes such a showing, the burden shifts to the challenger to prove that the commercial success is due to something other than the patented invention, such as advertising. *Id.*

Complainants have shown significant sales of the LitterMaid® products in the market from 1996 to 2007. (CX-895C at ¶¶ 114-152.) Since 2001, LitterMaid® sales have exceeded \$28 million annually, and the annual average during the last seven years has been {

} (*Id.* at ¶¶ 156-57.) As discussed *infra* in connection with the domestic industry requirement, I find that the LitterMaid® products practice at least one claim of the ‘847 patent. Complainants are therefore entitled to a presumption that the commercial success is due to the patented invention.

Respondents attempt to rebut the presumption by stating that advertising is the driving factor behind the LitterMaid® sales. While Applica conducted a national advertising campaign to promote the LitterMaid® products, I do not find that this advertising overcomes the presumption of commercial success due to the patented invention. The evidence demonstrates that early in the LitterMaid® product’s existence, Applica invested in a substantial amount of advertising to get the word out about its product. (Tr. at 200:7-20.) After the initial advertising campaign, Applica’s advertising expenditures decreased while sales increased. (*Id.* at 201:5-20; CDX-403.) This demonstrates that the heavy initial advertising was geared towards building

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product recognition, and that the later increased sales of the products were not necessarily driven by advertising. Respondents have no response for this and therefore cannot overcome the presumption that the commercial success of the LitterMaid® products was due to the patented invention.

I do not find that any of the other secondary considerations raised by Complainants are supportive of a finding of non-obviousness. The testimony from Complainants' witnesses that others in the industry were excited about the LitterMaid® is unsupported hearsay that does not serve as evidence of praise by others. The fact that the '847 patent has been cited and mentioned by other patents is not evidence of praise by others. The point of mentioning prior art in the Background section of a patent is not to praise it, but to explain the state of the prior art and how the current invention differs from and/or improves on the prior art. While OurPet's and Lucky Litter acknowledged that the LitterMaid® was a proven design concept during development of their respective products, both companies set out to build products that were better than the LitterMaid®. This fact negates any probative value of the Respondents' comments during product development.

I do not find that Applica's license from WRC supports a finding of non-obviousness. As OurPet's notes, the license came as part of { } and thus was not a true independent, arms-length transaction between two competitors. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898 (Fed. Cir. 1985) (noting that licensing programs "are not infallible guides to patentability" because there are many other reasons that entities enter into licenses besides the "unobviousness of the licensed subject matter"). Further, this is the only license offered as evidence by Complainants, and it does not demonstrate an extensive licensing practice.

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Complainants have not demonstrated a long felt but unresolved need. Complainants point to a number of patents and articles, claiming that these publications demonstrate that there was a long felt but unresolved need in the industry for an automated self-cleaning litter box. (WIB at 62.) I find that none of these publications demonstrate that the need was long felt or that the need was unresolved. The closest case is U.S. Pat. No. 5,267,530, which states that “[n]o mechanical device for cleaning cat litter boxes has gained widespread acceptance.” (CX-715 at 1:25-27.) This does not evidence a long felt but unresolved need. It merely demonstrates that no self-cleaning cat litter box has gained widespread acceptance. One could argue that the comment actually demonstrates a lack of the posited need. In addition: (1) the patent describes the invention, which is a self-cleaning litter box; and (2) the statement does not describe a need for a self-cleaning litter box such as the one built by Mr. Waters and covered by the claims of the ‘847 patent.

Complainants have not shown failure of others. The only evidence to which they point is the fact that Mr. Waters failed on his first attempt and that Respondents did not succeed on their early attempts. Evidence of Mr. Waters’ failure is not relevant here, because the issue is failure of *others*, and Mr. Waters is the inventor. Complainants then ignore the fact that both Lucky Litter and OurPet’s eventually succeeded in building automated self-cleaning litter boxes. It is to be expected in the design process that the early iterations of a product design will not work perfectly, or not work at all. Also, these alleged failures occurred after the ‘847 patent issued, and thus cannot demonstrate the non-obviousness of the ‘847 patent claims.

Complainants have not shown unexpected results. Mr. Waters set out to design an automated litter box that utilized a sensor system where combing would occur upon the cat exiting the litter box plus a delay. He did just that. Realizing that it is a good idea to delay

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before cleaning to give the cat time to leave the area of the litter box does not qualify as an unexpected result that supports a finding of non-obviousness.

Complainants have not demonstrated copying. In describing the secondary consideration of copying, the Federal Circuit stated:

Not every competing product that arguably fails [*sic*] within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product.

Iron Grip Barbell Co. v. USA Sports, Inc., 392 F.3d 1317, 1325 (Fed. Cir. 2004).

Complainants offer evidence in the form of memoranda and e-mails from the parties involved in designing both the Lucky Litter and OurPet's products. Complainants claim that these documents show that Respondents examined the LitterMaid® products during the development process and then copied them.

I find that this evidence proves otherwise. While it is true that both Respondents examined the LitterMaid® during the development process, this is an expected step. LitterMaid® was likely the biggest competition for Respondents' products, and examination of the competition does not necessarily signal copying. The evidence shows that both Respondents devoted substantial time and expense during the development process, and set out to both design around the LitterMaid® make a product that was superior to the LitterMaid®. (See RX-153-C; RX-160C; RX-161C; RX-162C; RX-232C at ¶¶ 21, 29, 50-54; Tr. at 841:2-10.) This evidence contradicts the assertion that Respondents simply copied the LitterMaid® design instead of doing the work themselves.

V. INFRINGEMENT

A. Applicable Law

Complainants must prove either literal infringement or infringement under the doctrine of equivalents. Infringement must be proven by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988).

Literal infringement is a question of fact. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1332 (Fed. Cir. 2008). Literal infringement requires the patentee to prove that the accused device contains each and every limitation of the asserted claim(s). *Frank's Casing Crew & Rental Tools, Inc. v. Weatherford Int'l, Inc.*, 389 F.3d 1370, 1378 (Fed. Cir. 2004).

As for the doctrine of equivalents:

Infringement under the doctrine of equivalents may be found when the accused device contains an “insubstantial” change from the claimed invention. Whether equivalency exists may be determined based on the “insubstantial differences” test or based on the “triple identity” test, namely, whether the element of the accused device “performs substantially the same function in substantially the same way to obtain the same result.” The essential inquiry is whether “the accused product or process contain elements identical or equivalent to each claimed element of the patented invention[.]”

TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc., 529 F.3d 1364, 1376-77 (Fed. Cir. 2008)

(citations omitted).

Thus, if an element is missing or not satisfied, infringement cannot be found under the doctrine of equivalents as a matter of law. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538-39 (Fed. Cir. 1991). Determining infringement under the doctrine of equivalents “requires an intensely factual inquiry.” *Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1381 (Fed. Cir. 2000).

B. Lucky Litter

1. Claim 27

Claim 27 recites:

27. A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb disposed in the litter chamber;

comb drive means for driving the comb between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level while the comb moves toward the discharge position so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

mode selector means for selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.

(JX-1 at 13:24-39.)

Complainants' Position: Complainants argue that Lucky Litter's ScoopFree products directly infringe claim 27. (AIB at 45.)

Complainants assert that the ScoopFree products have a "pan-shaped housing" as required by claim 27. Complainants assert that "[t]he ScoopFree Product forms a self-cleaning litter box when the frame of the ScoopFree Product is combined with the litter carriage...When so combined, it is clear and uncontroverted that the ScoopFree Product forms a pan-shaped area that holds the litter. (*Id.* at 46-57 (citing CX-893C at ¶¶ 96, 101-02; JX-25C at 137:6-15; Tr. at 815:7-20).) Complainants assert that the structure that constitutes the "pan-shaped housing" does not need to be unitary. (*Id.* at 48.)

Complainants assert that the ScoopFree products include "a comb disposed in the litter chamber." (*See* CX-893C at ¶¶ 117-19; CDX-32.)

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Complainants assert that the ScoopFree products include the third element of claim 27 requiring “comb drive means for driving the comb...” Complainants state that when the term “is given its plain and ordinary meaning, which is ‘motor and gear train,’ the evidence is undisputed that the ScoopFree Products include a ‘comb drive.’” (AIB at 49 (citing Tr. at 320:24-322:1, 736:12-19; CX-893C at ¶¶ 36-37, 124, 126; CDX-370; JX-1 at 3:31-41, Figs. 1-3; RX-233C at ¶ 43; JX-25C at 190:19-191:2; CX-236C).) Complainants further state that even if the term “comb drive means” is construed under 35 U.S.C. § 112, ¶ 6, the ScoopFree products still include this claim element. (*Id.* at 50.) Complainants claim that the evidence is undisputed that the ScoopFree products perform the function of driving the comb from the storage position to the discharge position. (*Id.* (citing CX-893C at ¶¶ 149, 150, 155).) Complainants further claim that the required structure is a motor and gear train (including worm drives), and the ScoopFree products “use the same or an equivalent structure to drive the comb.” (*Id.* (citing CX-893C at ¶¶ 144, 150).) In their reply brief, Complainants assert that even if the ‘847 patent disavows worm drives, the ScoopFree products still infringe because they contain a lead screw drive, and not a worm drive. (ARB at 19 (citing Tr. at 736:12-19, 762:24-763:9; CX-209 at 6).)

Complainants assert that the ScoopFree products include the “mode selector means” of claim 27. Complainants claim that the structure required by the claim language is a switch, and the cycle button on the ScoopFree products is the switch that selects between a manual operation mode and an automatic operation mode. (AIB at 53 (citing JX-5C at 27:12-28:2, 131:4-11, 154:9-14, 178:24-179:10, 183:19-22, 192:18-23; CX-33C; CX-38C; RX-233C at ¶ 27; JX-12C at 366:18-22; CX-261C; Tr. at 304:10-23, 464:5-9, 464:14-466:4, 810:6-14; CPX-12C; JX-25C at 212:24-213:13; CX-893C at ¶ 227).) Complainants state that when the ScoopFree is in the automatic operation mode, an operator can select a manual operation mode by pushing the cycle

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switch down. (*Id.* at 54 (citing Tr. at 819:2-6; JX-5C at 169:23-170:6; RX-233C at ¶ 61; JX-12C at ¶ 405:10-12).) Complainants argue that Lucky Litter cannot avoid infringement due to the fact that the cycle button does not have two stationary positions for manual and automatic operation. (*Id.* at 55.) Complainants rely on the Federal Circuit’s decision in *Overhead Door*, 194 F.3d at 1273-74 for support. (*Id.*)

Complainants assert that the ScoopFree products include a “manual operation mode” as required by claim 27. Complainants state that “[t]he evidence is uncontroverted that the ScoopFree Products allow the operator to manually cycle the rake through the litter one time.” (AIB at 51 (citing Tr. at 734:4-15, 819:2-6; JX-5C at 169:23-170:6; RX-233C at ¶ 61; JX-12C at 405:10-12; JX-25C at 175:2-7; RX-236C at ¶ 32).) Complainants argue that Lucky Litter’s non-infringement argument is based on a faulty claim construction requiring cyclical combing. (*Id.*)

Respondent Lucky Litter’s Position: Lucky Litter argues that it does not infringe claim 27. (LIB at 48.) Specifically, Lucky Litter asserts that its ScoopFree products do not meet the following claim limitations: “pan-shaped housing,” “comb drive means,” “mode selector means,” and “manual operation mode.” (*Id.* at 49-51.)

Lucky Litter states that the ScoopFree device has no “pan-shaped housing” because it “consists of a U-shaped plastic housing, which is affixed to a mechanical subassembly, both of which have no bottoms.” (LIB at 50 (citing RX-236C at ¶ 40; RX-13; RX-14; RX-15).) Because the housing has no bottom, Lucky Litter argues that it does not define “an upwardly open litter chamber to be filled to a given fill level with cat litter” as required by claim 27. (*Id.*)

With regard to the “comb drive means” limitation, Lucky Litter argues, for all of the reasons discussed *supra*, that the claim does not cover the lead screw drive used in the ScoopFree product. (LIB at 49.) Lucky Litter states that the differences between a “worm

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drive” and its lead screw drive are “mere semantics.” (*Id.*) Lucky Litter claims that “the long ‘worm 68’ shown in the Carlisi patent may also be described as a ‘lead screw.’” (*Id.* (citing JX-1 at 3:38-41, 6:12-26, Fig. 2).)

With regard to the “mode selector means” limitation, Lucky Litter states that “[t]he ScoopFree products do not have a mode select switch that has a separate position for manual operation and another position for automatic operation.” (LIB at 49.) Lucky Litter asserts that it does not infringe claim 33 because “the [cycle] button does not have one position that is exclusively for automatic operation and another position that is exclusively for manual operation.” (*Id.* (citing RX-233C at ¶ 60; Tr. at 228:22-229:22, 476:22-477:11).)

Lucky Litter’s argument regarding the “manual operation mode” limitation is based on its proposed claim construction. Lucky Litter therefore argues that the ScoopFree device does not have a “manual operation mode” because it does not place the litter box in a mode in which “self-cleaning is continued on a cyclical basis.” (LIB at 50 (citing RX-233C at ¶ 65; RX-236C at ¶ 32-33).)

Commission Investigative Staff’s Position: Staff argues that the evidence does not show that Lucky Litter infringes claim 27. (SIB at 45.) Staff claims that the evidence does not show that the “comb drive means” limitation is met because “Complainants provide only a truncated analysis based on a faulty claim construction.” (*Id.* at 46-47 (citing CX-893C at ¶¶ 137-138, 150).) With respect to “mode selector means,” Staff argues that “Complainants offer no competent testimony showing that the accused product has any structure for the ‘mode selector means’ that is the same structure disclosed in the specification or its equivalent (the microcontroller as programmed and a switch) for accomplishing the claimed function.” (*Id.* at 47 (citing Tr. at 287-89| CX-893C at ¶¶ 227-30).)

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Discussion and Conclusion: Because Complainants have failed to meet their burden in demonstrating that the accused ScoopFree products meet the “comb drive means” limitation, I find that Complainants have failed to show that the ScoopFree products infringe claim 27.

I find that the ScoopFree products include the “pan-shaped housing” limitation of claim 27. The ScoopFree product is assembled by placing the bottomless litter box frame on top of a disposable cartridge. (*See* CPX-12 at 3.) The two parts are held together by a magnet connection. (*Id.*) The concept behind this design is what Alan Cook, Lucky Litter’s President and CEO, refers to as the “razor and blade business model,” in that the user buys a single litter box but must continually purchase new disposable cartridges. (Tr. at 798-99.)

Complainants argue that the combination of the litter box frame and the cartridge form the “pan-shaped housing.” (AIB at 47.) Complainants state that there is nothing in claim 27 that requires the “pan-shaped housing” to be a unitary structure, and therefore it is legally permissible for the “pan-shaped housing” to be formed by the combination of two components. (*Id.* at 48.)

I have construed “pan-shaped housing” to mean “a housing with four walls and a bottom that is upwardly open and which defines the litter chamber.” From an examination of the ScoopFree products, it is clear that it includes a housing with four walls and a bottom, and that the housing is upwardly open and defines the litter chamber. (*See, e.g.*, CPX-9, CPX-10.) The frame of the litter box includes the four walls, and the cartridge creates the bottom. (*Id.*) The litter box is upwardly open, and the four walls and the bottom define a litter chamber. (*Id.*) This conclusion is further supported by expert evidence, as Dr. Wood testified that “[t]he cartridge forms the bottom of the pan-shaped housing in addition to a portion of the sidewalls and a litter box creates the remaining portion of the sidewalls.” (CX-893C at ¶¶ 101-102.)

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The intrinsic evidence does not limit the “pan-shaped housing” to a unitary structure. Therefore, there is no reason to require that the “pan-shaped housing” be a unitary structure. *See Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1309 (Fed. Cir. 2005) (rejecting an attempt to limit the term “channel” to a unitary structure when the intrinsic evidence did not require doing so); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1367-69 (Fed. Cir. 2002) (refusing to limit the term “member” to a single-component structure). Thus, the combination of the litter box frame and the cartridge comprises the “pan-shaped housing.”

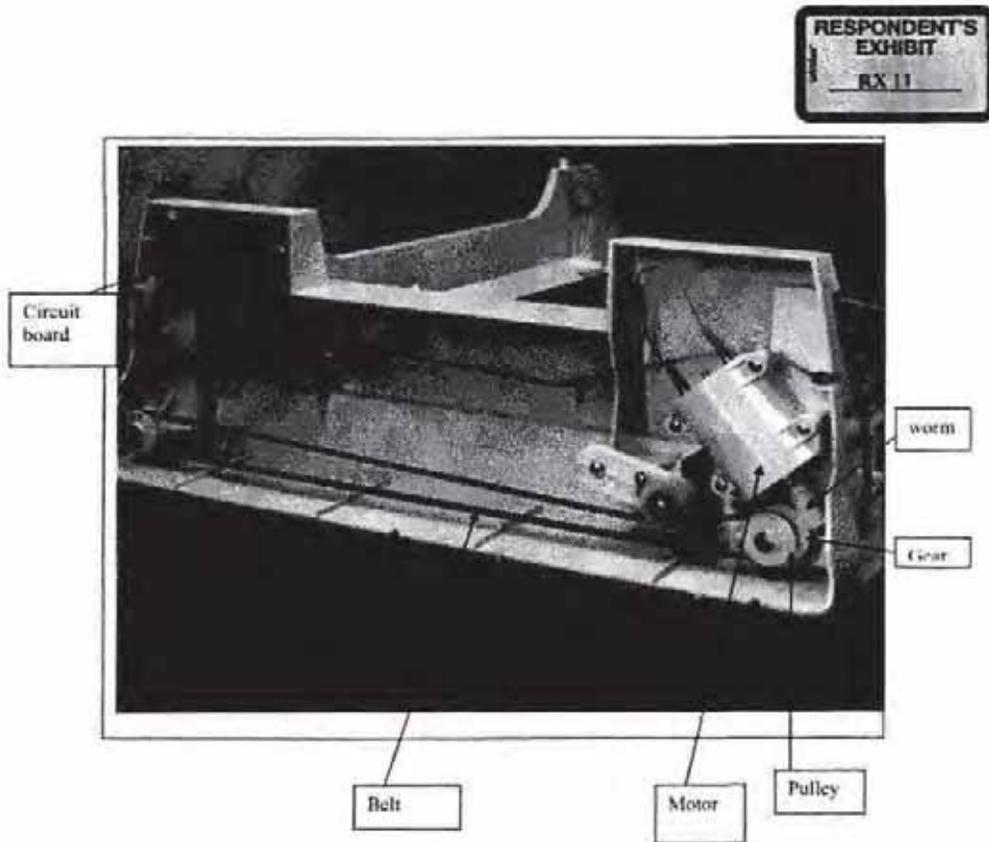
I find that the ScoopFree products include “a comb disposed in the litter chamber” as required by claim 27. (*See* CX-893C at ¶¶ 117-19.) Lucky Litter does not dispute this. (*See* Tr. at 815:21-24, JX-25C at 190:9-18, CX-189.)

I find that the ScoopFree products do not contain the “comb drive means” limitation, but for reasons different than articulated by Lucky Litter and Staff. I have already found that there was no disavowal of worm drives in the specification. Thus, the argument made by Lucky Litter and Staff regarding the claim not covering a lead screw drive has already been addressed and rejected.

I construed “comb drive means” as a means-plus-function term, with the function being “driving the comb between the storage position and the discharge position” and the structure being “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure. I find that the ScoopFree products do not meet the “comb drive means” limitation because they do not have an electric motor mounted to the shaft that supports the comb.

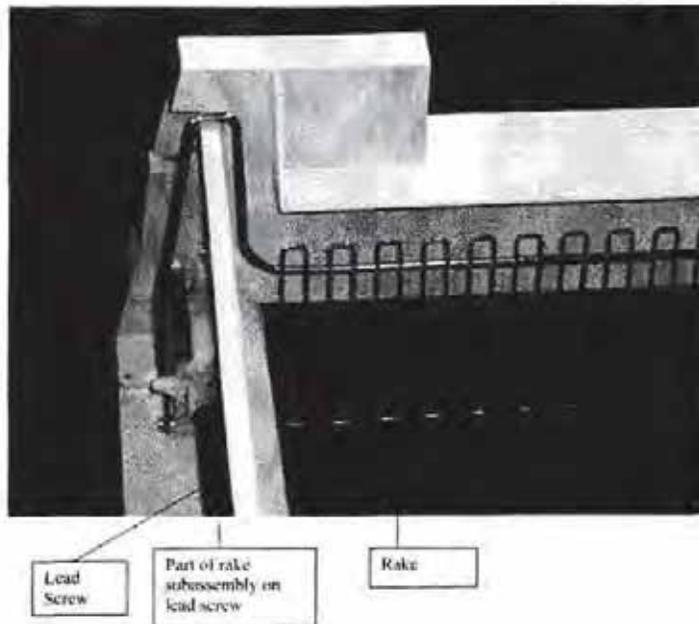
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The motor of the ScoopFree product is mounted on the back of the litter box frame (referred to as the “mechanism subassembly” by Lucky Litter). (RX-233C at ¶ 31.) It is not mounted on the shaft that carries the rake. This depicted in RX-11:



This is further evidenced by RX-17:

RESPONDENT'S
EXHIBIT
RX 17



Kristin Grube, the engineer in charge of the mechanical design of the ScoopFree product since 2004, described what is depicted in RX-17: “[a] rake subassembly is attached to the two nuts in the lead screw drive as shown the photographs marked RX 16 and RX 17. When the motor is operated, the worm gear transmission turns the lead screws. When the lead screws turn, the nuts and rake subassembly move linearly along the mechanism subassembly.” (RX-233C at ¶¶ 7, 51.)

These exhibits and Mr. Grube’s description make clear that the motor is not mounted on the shaft that supports the comb; instead, the motor is mounted on the back of the litter box frame. Thus, the ScoopFree products do not include the structure needed to infringe claim 27. In addition, I find that the structure in the ScoopFree products is not an equivalent under 35 U.S.C. § 112, ¶ 6 because the ScoopFree motor drives the comb in a substantially different manner than the motor in the ‘847 patent specification.

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Neither Complainants nor their expert offer any argument regarding whether the ScoopFree products meet the “comb drive means” limitation under the doctrine of equivalents. Therefore, I find that that issue has been waived by Complainants. (*See* Ground Rule 11.1.)

I find that the ScoopFree products meet the “mode selector means” limitation of claim 27. I construed “mode selector means” pursuant to 35 U.S.C. § 112, ¶ 6. I found that the claimed function is “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” I found that the disclosed structure is a switch and a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 and accompanying text.”

As to the function, the cycle button and microprocessor select between a manual operation mode and automatic operation mode. The evidence shows that when the ScoopFree product is first powered on, it is “configured for automatic operation.” (RX-233C at ¶ 61.) When a user presses the cycle button, the unit is put into a manual mode. (CX-893C at ¶¶ 366-374; *see also* JX-25C at 175:24-176:21, Tr. at 465:9-14.) The litter box remains in an automatic mode by default, and it can be put into a manual mode by pushing the cycle button. After the manual combing is completed, the unit returns to an automatic mode. The cycle button, in combination with the microprocessor, therefore allows a user to select between the two modes.

As to the structure, the cycle button of the ScoopFree products is a momentary switch. (RX-233C at ¶ 60, Tr. at 304:10-23, 464:5-9, 464:14-466:4.) The switch is connected to a microprocessor. (JX-5C at 204:11-207:9.)

In the algorithm in Figure 7 of the ‘847 patent, the microprocessor first checks to see whether the switch is set for manual mode. (JX-1 at 7:14-64, Fig. 7.) If the switch has been set

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for manual mode, the manual operation mode is executed. (*Id.*) If the switch has not been set for manual mode, the algorithm initiates the process to check for the presence of a cat, indicating automatic mode. (*Id.*)

The microprocessor in the ScoopFree products is similarly programmed to perform an algorithm that selects between a manual operation mode and an automatic operation mode. (CX-33C.) The ScoopFree algorithm does not literally match the algorithm from Fig. 7 because the microprocessor in the ScoopFree first checks to determine whether the IR beam has been broken (indicating the presence of a cat) before checking to see if the cycle button has been pushed. (*Id.*) This is different than the algorithm in Fig. 7 because the ScoopFree algorithm first checks for the presence of a cat before checking for the manual mode. Although the algorithms are not literally the same, I find that the algorithm disclosed in CX-33C for selecting between the modes is the equivalent of the algorithm disclosed in Fig. 7 under 35 U.S.C. § 112, ¶ 6. (*Id.*)

In *Kemco Sales, Inc. v. Control Papers Co. Inc.*, the Federal Circuit stated:

In order for an accused structure to literally meet a section 112, paragraph 6 means-plus-function limitation, the accused structure must either be the same as the disclosed structure or be a section 112, paragraph 6 “equivalent,” i.e., (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. Under a modified version of the function-way-result methodology described in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097, 85 USPQ 328, 330 (1950), two structures may be “equivalent” for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result.

208 F.3d 1352, 1364 (Fed. Cir. 2000) (citations omitted).

The ScoopFree algorithm performs the same function as disclosed in claim 27 in substantially the same way (checking whether one mode has been selected, and then moving on to checking for the other mode if the first mode has not been selected) with substantially the same result (the microprocessor puts the litter box into a manual or automatic mode based on the

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input from the user or the cat). The only difference is the order in which the algorithm checks whether each mode has been activated. I find this difference to be insubstantial.

I find that the ScoopFree products include both the “manual operation mode” and “automatic operation mode” from claim 27. When the cycle button is depressed, the comb will cycle once. (CX-893C at ¶¶ 366-374; CPX-12 at 5; *see also* JX-25C at 175:24-176:21; Tr. at 465:9-14.) This is a “manual operation mode,” i.e. “a mode of operation where combing is initiated in response to human-based input.” In the ScoopFree’s automatic mode, combing will be initiated after detecting the entry and exit of a cat plus a time delay. (CX-893C at ¶¶ 207-09; CPX-12 at 1; Tr. at 464:22-465:1; JX-5C at 150:3-12; JX-25C at 77:22-78:7.) This is an “automatic operation mode,” i.e. “a mode of operation where combing is initiated in response to a cat exit.”

2. Claim 33

Claim 33 recites:

33. A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb drive coupled to the housing;

a comb extending between two opposed sidewalls and being coupled to the comb drive and movable between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position wherein an operator causes the comb to move toward the discharge position and an automatic operation position wherein the comb moves toward the discharge position automatically upon the occurrence of a predetermined event.

(JX-1 at 14:10-28.)

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Complainants' Position: Complainants argue that Lucky Litter's ScoopFree products directly infringe claim 33. (AIB at 45.)

Complainants assert that the ScoopFree products have a “pan-shaped housing” as required by claim 33. Complainants assert that “[t]he ScoopFree Product forms a self-cleaning litter box when the frame of the ScoopFree Product is combined with the litter carriage... When so combined, it is clear and uncontroverted that the ScoopFree Product forms a pan-shaped area that holds the litter.” (*Id.* at 46-57 (citing CX-893C at ¶¶ 96, 101-02; JX-25C at 137:6-15; Tr. at 815:7-20).) Complainants assert that the structure that constitutes the “pan-shaped housing” does not need to be unitary. (*Id.* at 48.)

Complainants assert that the ScoopFree products include the third element of claim 33 requiring “a comb drive coupled to the housing.” Complainants state that when the term “comb drive” “is given its plain and ordinary meaning, which is ‘motor and gear train,’ the evidence is undisputed that the ScoopFree Products include a ‘comb drive.’” (AIB at 49 (citing Tr. at 320:24-322:1, 815:25-816:7; CX-893C at ¶¶ 36-37, 124, 126; CDX-370; JX-1 at 3:31-41, Figs. 1-3; RX-223C at ¶ 43; JX-25C at 190:19-191:2; CX-236C).) In their reply brief, Complainants assert that even if the ‘847 patent disavows worm drives, the ScoopFree products still infringe because they contain a lead screw drive, and not a worm drive. (ARB at 19 (citing Tr. at 736:12-19, 762:24-763:9, CX-209 at 6).)

Complainants assert that the ScoopFree products include “a comb extending between two opposed sidewalls...” as required by the fourth element of claim 33. (*See* CX-893C at ¶ 345; CDX-35.)

Complainants assert that the ScoopFree products include the “mode selector switch” of claim 33. Complainants identify the cycle button of the ScoopFree products as the switch.

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Complainants claim that the switch can be moved from the automatic operation position to the manual operation position by pushing it down. (AIB at 56 (citing JX-5C at 149:21-150:2; JX-5C at 169:23-170:6; RX-233C at ¶ 61; JX-6C at 140:14-22; JX-25C at 178:3-7; RX-236C at ¶ 32; Tr. at 234:4-13, 464:5-9, 465:2-5).) The Complainants argue that when the switch is in the up position, it is in the automatic operation position, and when the switch is in the down position, it is in the manual operation position. (*Id.* (citing RX-233C at ¶¶ 60, 61; JX-25C at 175:24-176:21, 178:3-7; Tr. at 234:4-13, 465:9-14; JX-5C at 149:21-150:2, 169:23-170:6; JX-6C at 140:14-22; RX-236C at ¶ 32).)

Complainants respond to Lucky Litter’s and Staff’s argument regarding the “movable between” language, by stating that “[i]n *Overhead Door*, the Federal Circuit considered and rejected virtually the same arguments Respondents make here – that a push button switch is not moveable between two positions because it does not have two set, stationary positions.” (*Id.* at 57.)

Complainants assert that the ScoopFree products include a “manual operation position” as required by claim 33. Complainants state that “[t]he down position of the cycle switch that initiates a manual comb litter operation is a ‘manual operation position.’” (AIB at 52 (citing RX-233C at ¶¶ 60, 61; JX-25C at 175:24-176:21, 178:3-7; JX-5C at 149:21-150:2, 169:23-170:6; JX-6C at 140:14-22; RX-236C at ¶ 32; Tr. at 234:4-13).)

Respondent Lucky Litter’s Position: Lucky Litter argues that it does not infringe claim 33. (LIB at 48.) Specifically, Lucky Litter asserts that its ScoopFree products do not meet the following claim limitations: “pan-shaped housing,” “comb drive,” “mode selector switch,” and “manual operation position.” (*Id.* at 49-51.)

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Lucky Litter states that the ScoopFree device has no “pan-shaped housing” because it “consists of a U-shaped plastic housing, which is affixed to a mechanical subassembly, both of which have no bottoms.” (LIB at 50 (citing RX-236C at ¶ 40; RX-13; RX-14; RX-15).)

Because the housing has no bottom, Lucky Litter argues that it does not define “an upwardly open litter chamber to be filled to a given fill level with cat litter” as required by claim 27. (*Id.*)

With regard to the “comb drive” limitation, Lucky Litter argues, for all of the reasons discussed *supra*, that the claim does not cover the lead screw drive used in the ScoopFree product. (LIB at 49.) Lucky Litter states that the differences between a “worm drive” and its lead screw drive are “mere semantics.” (*Id.*) Lucky Litter claims that “the long ‘worm 68’ shown in the Carlisi patent may also be described as a ‘lead screw.’” (*Id.* (citing JX-1 at 3:38-41, 6:12-26, Fig. 2).)

With regard to the “mode selector switch” limitation, Lucky Litter states that “[t]he ScoopFree products do not have a mode select switch that has a separate position for manual operation and another position for automatic operation.” (LIB at 49.) Lucky Litter asserts that it does not infringe claim 33 because “the [cycle] button does not have one position that is exclusively for automatic operation and another position that is exclusively for manual operation.” (*Id.* (citing RX-233C at ¶ 60; Tr. at 228:22-229:22, 476:22-477:11).)

In its reply brief, Lucky Litter claims that the prosecution history of the ‘847 patent renders the holding of *Overhead Door* inapplicable to this case. (LRB at 36.) Specifically, Lucky Litter points to the portion of the prosecution history where the applicants stated “Carlisi and Strickland, even when considered in combination, fail to disclose or suggest the switch of claim 33, which is moveable between manual and automatic positions.” (JX-2 at 375-76.)

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Lucky Litter argues that “[t]his statement requires that the switch have a [*sic*] one position for manual operation and another for automatic operation.” (LRB at 36 (emphasis in original).)

Lucky Litter’s argument regarding the “manual operation position” limitation is based on its proposed claim construction. Lucky Litter therefore argues that the ScoopFree device does not have a “manual operation position” because it does not place the litter box in a mode in which “self-cleaning is continued on a cyclical basis.” (LIB at 50 (citing RX-233C at ¶ 65; RX-236C at ¶¶ 32-33).)

Commission Investigative Staff’s Position: Staff argues that the evidence does not show that Lucky Litter infringes claim 33. (SIB at 48.) Staff claims that the ScoopFree products do not have a “comb drive” based on the argument that the ‘847 patent specification disavows coverage of worm drives. (*Id.* at 49.) Staff asserts that the ScoopFree products do not include the “mode selector switch” limitation because “[t]he cycle button does not have two positions” as required in claim 33. (*Id.* at 50.) Staff further asserts that Complainants’ doctrine of equivalents analysis is flawed because it reads out the “positions” limitation. (*Id.* (citing CX-893C at ¶¶ 377-78).)

Discussion and Conclusion: I find that the Lucky Litter ScoopFree products infringe claim 33.

For the same reasons as discussed regarding claim 27, *supra*, I find that the Lucky Litter ScoopFree products meet the “pan-shaped housing” limitation.

I find that the ScoopFree products meet the “comb drive” limitation of claim 33. I have already found that there was no disavowal of worm drives in the intrinsic evidence. Thus, Lucky Litter’s argument that its lead screw drive¹³ cannot be a “comb drive” has already been addressed and rejected. I construed “comb drive” to mean “a motor and gear train for driving the comb.”

¹³ Lucky Litter asserts that its lead screw drive is the same as a worm drive. (LIB at 49.)

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The ScoopFree products include a motor and gear train for driving the comb. (RX-11, RX-12, CX-893C at ¶¶ 298-304; *see also* Tr. at 815:25-816:7, RX-233C at ¶ 43, JX-6C at 101:18-20, JX-25C at 190:19-191:2.) Further, the comb drive of the ScoopFree products is coupled to the housing, as required by claim 33. (RX-11, RX-12.)

I find that the ScoopFree products meet the limitation requiring “a comb extending between two opposed sidewalls...” limitation in claim 33. (*See, e.g.*, CPX-9, CPX-10; CX-893C at ¶¶ 342, 345.) Lucky Litter does not dispute that this limitation is found in the ScoopFree products. (*See, e.g.*, CFF 1869, RRCFF 1869, CX-189, JX-6C at 102:3-16.)

I find that the ScoopFree products include the “mode selector switch...being moveable between...” limitation. In arguing that the cycle button in the ScoopFree products is not a “mode selector switch,” Lucky Litter states that “the button does not have one position that is exclusively for automatic operation and another position that is exclusively for manual operation.” (LIB at 50 (emphasis in original).) Staff makes the same argument when it states that “[t]he cycle button does not have two positions.” (SIB at 50.)

I construed “mode selector switch” as “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.” I found that the intrinsic evidence did not require limiting the “mode selector switch” to a switch with two stationary positions. In *Overhead Door*, 194 F.3d at 1273-1274, the court found that a momentary switch meets the claim limitation “a switch moveable between program and operate positions.” The cycle button on the ScoopFree products is a “mode selector switch” under my construction. It is undisputed that the cycle button is operatively connected to the comb drive, in that the switch controls the energization of the motor to drive the comb. (*See* RX-233C at ¶ 61, Tr. at 734:4-15, JX-12C at 405:10-12, RX-236C at ¶ 32.)

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The cycle button is moveable between the manual and automatic operation positions.

The cycle button was described by Kristin Grube:

The cycle button is a momentary button disposed in the “off” position and it must physically be held in the “down” position to make contact. As soon as the cycle button is released, it returns to the “up” position.

(RX-233C at ¶ 60.)

The evidence shows that when the ScoopFree product is powered on, it is “configured for automatic operation.” (*Id.* at ¶ 61.) The cycle button is therefore in the automatic position, when it is in its “up” position. When a user presses the cycle button to its “down” position, the unit is put into a manual mode where combing is initiated in response to human-based input. (CX-893C at ¶¶ 366-374.) When the cycle button is depressed (the “down” position), it is in the manual position. (*Id.*) This was confirmed by Lucky Litter’ expert witness Dr. Cagan during cross examination:

Q. Now, in the ScoopFree product, when the green light is on -- it is right now. Can you see the green light?

A. Yes.

Q. The switch is in a position where the ScoopFree litter box is in an automatic operation mode, correct?

A. Correct.

Q. And in the automatic operation mode, the ScoopFree product will cycle after detecting cat entry and exit once, after a time period of delay elapses, correct?

A. Correct.

Q. Now, if the ScoopFree product is powered on and I go and I push the cycle switch, the cycle switch goes down, correct?

A. Correct.

Q. (Demonstrating). And the rake moves through the litter one time down and back?

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A. Correct.

Q. And by pushing the cycle switch down from the up position to the down position in the Lucky Litter ScoopFree product, that actuated the motor and caused the rake to cycle once through the litter?

A. Correct.

(Tr. at 464:14-465:14.) Thus, I find that the ScoopFree products include the “mode selector switch” required in claim 33.¹⁴

Lucky Litter attempts to distinguish *Overhead Door* from this case by pointing to the following statement from the prosecution history: “Carlisi and Strickland, even when considered in combination, fail to disclose or suggest the switch of claim 33, which is moveable between manual and automatic positions.” (JX-2 at 375-76.) I find that this statement does not render the holding of *Overhead Door* inapplicable. The statement from the prosecution merely re-states the claim language found in claim 33 and does not add any further limitation to the claim.

I find that the ScoopFree products include a “manual operation position.” I have adopted the following construction: “a position of the mode selector switch where combing is initiated in response to human-based input.”

It is undisputed that the ScoopFree products include a cycle button, that when pushed by a user, initiates a single combing cycle. (RX-233C at ¶ 61, Tr. at 734:4-15, JX-12C at 405:10-12, RX-236C at ¶ 32.) As the ScoopFree User Guide explains: “[a]lthough ScoopFree™ is designed to operate automatically, you may manually control the rake by pushing the cycle button on the top of the litter box.” (CPX-12 at 5.) Complainants have also offered expert

¹⁴ The cycle button has additional functions. While the rake is cycling, the cycle button may be pushed to stop the cycle. (CPX-12 at 5.) After the rake stops in mid-cycling, the cycle button may be pushed again to return the rake to the home position. (*Id.*) I find that these added functions do not affect the infringement analysis or prevent the ScoopFree products from meeting the “mode selector switch” limitation. See *Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 731 F.2d 840, 848 (Fed. Cir. 1984) (“[A]n accused device that contains the same feature as the patented device cannot escape infringement because in it that feature performs an additional function it does not perform in the patented device.”)

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evidence supporting their argument that the ScoopFree products include a “manual operation position.” (See CX-893C at ¶¶ 368, 371-374.) Thus, I find that the ScoopFree products include “a position of the mode selector switch where combing is initiated in response to human-based input.”

I have defined the term “automatic operation position” as “a position of the mode selector switch where combing is initiated in response to a cat exit.” When the manual mode has not been selected, the ScoopFree litter box is in an automatic mode, and the cycle switch is in its “up” position. This is the “automatic operation position” of claim 33. It is undisputed that the ScoopFree products comb in response to a cat exit when in the automatic mode. (See CPX-12 at 1, Tr. 464:22-465:1, RX-233C at ¶ 59.)

Having reviewed all of the elements of claim 33, I find that the ScoopFree products meet each of them. Therefore, I find that the ScoopFree products infringe claim 33.

3. Claim 41

Claim 41 recites:

41. The litter box of claim 27 further comprising a sensor system for determining whether a cat is in the litter chamber.

(JX-1 at 15:33-34.)

The ScoopFree products include a “sensor system for determining whether a cat is in the litter chamber.” (CX-893C at ¶¶ 252-59; CPX-12 at 1-2; RX-233C at ¶¶ 58-59; Tr. at 819:7-11.)

Nevertheless, because I have found that the SmartScoop products do not infringe independent claim 27, it follows that they do not infringe claim 41, which depends from claim 27. *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n. 9 (Fed. Cir. 1989) (“One who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim.”)

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4. Claim 42

Claim 42 recites:

42. The litter box of claim 41 wherein said sensor system includes a source of radiation and a radiation detector.

(JX-1 at 15:35-34-6.)

The sensor system in the ScoopFree products “includes a source of radiation and a radiation detector.” (CX-893C at ¶¶ 262-68; JX-6C at 90:12-17; JX-25C at 180:19-181:4.)

Nevertheless, because I have found that the ScoopFree products do not infringe claims 27 and 41, it follows that they do not infringe claim 42, which directly depends from claim 41 and indirectly depends from claim 27. *Wahpeton*, 870 F.2d at 1552 n. 9.

5. Inducement

Section 271(b) of the Patent Act prohibits inducement: “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” 35 U.S.C. § 271(b) (2008). As the Federal Circuit stated:

To establish liability under section 271(b), a patent holder must prove that once the defendants knew of the patent, they “actively and knowingly aid[ed] and abett[ed] another’s direct infringement.” However, “knowledge of the acts alleged to constitute infringement” is not enough. The “mere knowledge of possible infringement by others does not amount to inducement; specific intent and action to induce infringement must be proven.”

DSU Med. Corp. v. JMS Co., 471 F.3d 1293, 1305 (Fed. Cir. 2006) (*en banc*) (citations omitted).

Complainants’ Position: Complainants argue that Lucky Litter has induced infringement by importing and selling ScoopFree products and the replacement litter cartridges for the ScoopFree products. (AIB at 70-71.) Complainants also argue that Lucky Litter induces infringement by providing instructions on how to use the ScoopFree products and offering technical assistance and support to end-users of the ScoopFree products. (*Id.* at 72-73.)

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Complainants assert that the following facts demonstrate Lucky Litter's intent: (1) Lucky Litter knew of the patent and studied it; (2) Lucky Litter studied the Applica LitterMaid® product during the design process for the ScoopFree; (3) Lucky Litter failed to obtain an opinion of counsel; and (4) Lucky Litter never attempted to alter the ScoopFree product to avoid infringement of claims 27 and 33. (ARB at 28-29.)

Respondent Lucky Litter's Position: Lucky Litter argues that there is no inducement because the cartridges have substantial non-infringing uses. (LIB at 52.) Specifically, Lucky Litter claims that the cartridge can be used with a non-infringing manual litter box that will be marketed by Lucky Litter in the fourth quarter of this year, and the cartridge can be used on its own as a litter box. (*Id.*)

Commission Investigative Staff's Position: Staff argues that Complainants have failed to meet their burden to demonstrate the intent requirement for inducement. (SRB at 19.)

Discussion and Conclusion: In *DSU*, the Federal Circuit clarified the intent requirement necessary to prove inducement. As the court recently explained:

In DSU Med. Corp. v. JMS Co., this court clarified en banc that the specific intent necessary to induce infringement "requires more than just intent to cause the acts that produce direct infringement. Beyond that threshold knowledge, the inducer must have an affirmative intent to cause direct infringement."

Kyocera Wireless Corp. v. Int'l Trade Comm'n, --- F.3d ----, 2008 WL 4553140 (Fed. Cir. Oct. 14, 2008) (citation omitted).

After a review of the evidence submitted by Complainants, I find that Complainants have not met their burden to demonstrate the specific intent needed to find inducement. *See Lucent Techs. Inc. v. Gateway, Inc.*, 2007 WL 925510, at *2-3 (S.D. Cal. Mar. 21, 2007) ("Proof of inducing infringement requires the establishment of a high level of specific intent.").

Complainants failed to prove that Lucky Litter, by selling ScoopFree products and cartridges,

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providing instructions to end users on how to use the ScoopFree, and providing technical support to end users, had “an affirmative intent to cause direct infringement.” *DSU*, 471 F.3d at 1306. While Lucky Litter knew of the LitterMaid® products and the ‘847 patent, it does not follow that an affirmative intent to cause direct infringement can be inferred. This is consistent with my conclusions regarding the issue of copying discussed *supra* in connection with the objective indicia of non-obviousness.

6. Contributory Infringement

Section 271(c) of the Patent Act prohibits contributory infringement:

Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

35 U.S.C. § 271(c) (2008). As explained by the Federal Circuit, “[i]n order to succeed on a claim of contributory infringement, in addition to proving an act of direct infringement, plaintiff must show that defendant ‘knew that the combination for which its components were especially made was both patented and infringing’ and that defendant’s components have ‘no substantial non-infringing uses.’” *Cross Med. Prods., Inc.*, 424 F.3d at 1312 (citation omitted).

Complainants’ Position: Complainants argue that Lucky Litter has engaged in contributory infringement by importing and selling replacement litter cartridges for the ScoopFree products. (AIB at 76.) Complainants claim that the cartridges form an essential component of the ScoopFree product. (*Id.* at 76-77.) Complainants also claim that the cartridges have no substantial non-infringing uses. (*Id.* at 77-78.)

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Respondent Lucky Litter's Position: Lucky Litter argues that there is no contributory infringement because the cartridges have substantial non-infringing uses. (LIB at 52.) Specifically, Lucky Litter claims that the cartridges can be used with a non-infringing manual litter box that will be marketed by Lucky Litter in the fourth quarter of this year, and the cartridges can be used as stand-alone litter boxes. (*Id.*)

Commission Investigative Staff's Position: Staff argues that Complainants have failed to meet their burden to demonstrate the intent needed to prove contributory infringement. (SRB at 19.)

Discussion and Conclusion: Complainants have already proven an act of direct infringement, as I have found that the Lucky Litter ScoopFree products infringe claim 33.

I find that Complainants have proven the knowledge requirement of 35 U.S.C. § 271(c). Lucky Litter clearly knew of the '847 patent, and knew that the cartridges were to be used as a component of the ScoopFree product, which I have found infringes claim 33. *See Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 488-91 (1964); *DSU*, 471 F.3d at 1303; *Monolithic Power Sys., Inc. v. O2 Micro Int'l Ltd.*, 476 F. Supp. 2d 1143, 1158 (N.D. Cal. 2007).

In *Aro*, the Supreme Court found that the knowledge requirement had been met when the alleged infringer received a letter from the patent holder alleging infringement of the patent-in-suit. 377 U.S. at 489-91. Similarly, in *Monolithic Power*, the court found that a defendant's knowledge that its products are made for use in an allegedly infringing product is enough to satisfy the knowledge requirement under 35 U.S.C. § 271(c). 476 F. Supp. 2d at 1158. Lucky Litter has known about the '847 patent since it was in the process of developing the ScoopFree (*see* RX-153C) and has known since at least April 2007 that its cartridges are made for use in an allegedly infringing product. (*See* RX-150.) Complainants identify evidence to support my

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finding regarding knowledge. (See Tr. 800:3-8, 808:19-22, CX-85C, CX-810.) Lucky Litter offers no evidence or argument to rebut Complainants' evidence on this issue.

Staff argues that “no intent has been shown concerning contributory infringement,” but intent is not an element of contributory infringement. “[P]roof of a defendant’s *knowledge*, not *intent*, that his activity cause infringement [is] necessary to establish contributory infringement.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990) (emphasis in original).

I also find that Complainants have proven that there are no substantial non-infringing uses. Use of the cartridges in a forthcoming manual litter box product is too speculative to be considered a substantial non-infringing use. Alan Cook testified that the manual litter box will be on the market “[p]rior to the end of this year.” (RX-229C at ¶ 12.) This hypothetical use cannot qualify as a substantial non-infringing use. *Cf. D.O.C.C., Inc. v. Spintech, Inc.*, 36 U.S.P.Q.2d 1145, 1155 (S.D.N.Y. 1994) (“Contributory infringement liability is not meant for situations where noninfringing uses are common as opposed to farfetched, illusory, impractical or merely experimental.”) Nothing prevents Lucky Litter from either delaying the release of the manual product, or canceling it altogether. Use of the cartridges with a manual litter box cannot qualify as a substantial non-infringing use when that use has not yet occurred in the market.

I further find Complainants have met their burden in showing that use of the cartridges alone as litter boxes does not qualify as a substantial non-infringing use. Lucky Litter admitted that the cartridges are “specifically designed” and “especially made” for the ScoopFree products. (CX-189 at 2.) Kristin Grube testified that the cartridge “doesn’t act as a litter box.” (JX-6C at 72:15.) He went on to state that “although someone could use it by itself as a litter box, it’s not

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intended that way. It's intended to work with the automated part of the system.” (*Id.* at 72:16-19.)

Lucky Litter offers the testimony of Alan Cook in an attempt to show that the use of the cartridge alone is a substantial non-infringing use. Mr. Cook provided the following testimony regarding the cartridges:

Yes, [a cartridge] can be used on its own without any other apparatus. In fact, some customers use the tray before purchasing the ScoopFree litter box or ScoopFree Ultra to see if their cat will adapt to the litter.

(RX-197C at ¶ 61.)

Some consumers will purchase the litter cartridge before they purchase a ScoopFree or ScoopFree Ultra to see if their cat will adapt to the crystal litter. I have also heard of consumers using the cartridge by itself as a disposable litter box when they travel with their cat, or even in their home because it is more convenient than regular, more traditional litter boxes.

(RX-229C at ¶ 2.) Mr. Cook further testified that he has used the cartridge as a stand-alone litter box “on many occasions[.]” (*Id.* at ¶ 5.)

Mr. Cook’s testimony does not overcome the evidence offered by Complainants. Lucky Litter fails to identify any evidence corroborating Mr. Cook’s allegation that customers have used the cartridges as stand-alone litter boxes. Even if Mr. Cook’s allegations are true, Lucky Litter offers no evidence that such use is “substantial.” *See Pickholtz v. Rainbow Techs., Inc.*, 260 F. Supp. 2d 980, 989 (N.D. Cal. 2003) (explaining that “the inquiry into what constitutes ‘substantial’ use is essentially a quantitative one”). I cannot find that use of the cartridges alone is a substantial non-infringing use based solely on the unsupported assertions of Lucky Litter’s President and CEO.

Therefore, I find that Lucky Litter’s importation and sale of the cartridges constitutes contributory infringement pursuant to 35 U.S.C. § 271(c).

C. OurPet's

1. Claim 8

Claim 8 recites:

In an improved self-cleaning cat litter box including:

a pan-shaped housing having a bottom and two spaced side walls connecting a storage end wall to a discharge end wall, the housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb path extending from the storage end wall to the discharge end wall;

a comb extending between the side walls; and

a comb drive for driving the comb along the comb path from a storage position adjacent to the storage end wall to a discharge position adjacent to the discharge end wall and back to the storage position, the comb projecting down into the litter chamber to a level below the fill level and near the housing bottom while the comb moves toward the discharge end wall so that the comb engages any clumps in the litter and carries such clumps to the discharge position;

the improved construction comprising:

a track member, defining the comb path, mounted to one side wall above the fill level;

a carriage supporting the comb;

a guide wheel mounted on the carriage and engaging the track member;

and a reversible drive motor, comprising a part of the comb drive, mounted on the carriage.

Complainants' Position: Complainants assert that the accused SmartScoop products (hereinafter "SmartScoop") infringes claim 8. They argue that SmartScoop includes a "comb drive," because SmartScoop is shown to have a motor and gear train. (citing CX-893C at ¶¶ 474-491, 665, 843-845; CDX-4; CDX-45; RX-231 at ¶ 72; CPX-49.)

Complainants argue that the SmartScoop has a carriage, which they define as "the structure that carries or supports the comb." Complainants assert that OurPet's argument is

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based upon an erroneous construction of the term “carriage” and point to Complainants’ argument regarding construction of the term “carriage” to support their position. (AIB at 38-39, 61-62.)

Complainants argue in their reply brief that the SmartScoop has the equivalent of a “carriage,” even if OurPet’s flawed construction is adopted. (citing CPX-36; CPX-37; CX- at ¶¶ 392-395, 540-547.) Complainants argue that OurPet’s does not dispute that its structure performs the function of carrying or supporting the comb. Instead, OurPet’s points to additional functions that its carriage performs, such as carrying the waste receptacle. (citing OIB at 52.) Complainants argue that the fact that the SmartScoop carriage performs functions in addition to the function of the claim does not avoid infringement by equivalents. (ARB at 22.)

Complainants add that “Dr. Wood testified that the SmartScoop Products meet the ‘comb drive’ element of claim 8 under the doctrine of equivalents.” (citing CX-893C at ¶¶ 486-508; CPX-33-CPX-49; CDX-44-CDX-45.) Dr. Wood concluded that any differences between the “comb drive” structures in the SmartScoop Products and the “comb drive” of claim 8 are insubstantial under OurPet’s construction. (*Id.*) The SmartScoop product drive mechanism performs the same function (driving the comb along the comb path from a storage position adjacent the storage end wall to a discharge position adjacent to the discharge end wall and back to the storage position), in substantially the same way (by a motor, gear train, and translational energy transmission elements), to achieve substantially the same result (translating the comb from a storage position to a discharge position and back to the storage position) as the “comb drive” when given OurPet’s construction. (citing CX-893C at ¶¶ 497-504; CPX-33-CPX-49; CDX-44-CDX-45.) Dr. Wood’s testimony is “uncontroverted.” (AIB at 61.)

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Complainants argue in their reply brief that OurPet's is in error regarding the function of the comb drive, because "they do not focus on the *function* ascribed to the claim element. *Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1363 (Fed. Cir. 2001) (declining to adopt a function different from that *explicitly* recited in the claim)." (ARB at 23 (emphasis in original).) Complainants argue that the evidence "... is uncontroverted that the stated function for the 'comb drive' or 'drive means' in the '847 Patent is 'driving the comb'." (*Id.*) They assert that OurPet's admits that the function of the comb drive in the '847 Patent does not include rotating the comb or propelling the waste receptacle. (*Id.*)

Complainants argue in their reply brief that Staff admitted in its Pre-Hearing Statement that the SmartScoop products have a "comb drive" as required by claims 8, 31 and 33, and a "drive means" as required by Claim 24. (citing Staff Pre-Hearing Statement at 28.) They urge a finding that Staff's contention in its post-hearing brief that the SmartScoop products lack the "comb drive" of claim 8 (SIB 42-43) and the "drive means" of claim 24 (SIB 44-45) should be treated as abandoned and withdrawn pursuant to Ground Rule 8(f). (ARB at 22.)

Complainants argue in their reply brief that the SmartScoop product includes a "comb path," "track member," and "guide wheel." (ARB at 26.) Complainants argue that their expert Dr. Wood provided seventy pages of testimony to support his opinion, and that opinion testimony was neither "conclusory" nor filled with assertions that failed to address each and every element necessary to a *prima facie* case of infringement. (ARB at 26.) Complainants assert that Dr. Wood's testimony specifically addressed each and every element of claim 8, including the "comb path," "track member," "guide wheel," and "discharge position adjacent ..." elements. (See CPX-33-CPX-49, CDX-42, CX-893C at ¶¶ 446-448 ("comb path")); (CDX-46; CX-893C at ¶¶ 520-521 ("track member")); (CX-893C at ¶ 432; CDX-41 ("discharge position

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adjacent”)); and (CX-893C at ¶¶ 554-555 (“guide wheel”).) They cite exhibits CX-893C at ¶¶ 136-216 and CDX-41 to support this argument, and they point to his specific opinion testimony that SmartScoop infringes claim 8 of the ‘847 patent. (CX-893C at 573.)

Complainants argue that Dr. Wood was only required to offer the general opinion that the SmartScoop infringed claim 8. They cite *Symbol Techs. v. Opticon, Inc.*, 935 F.2d 1569, 1576 (Fed. Cir. 1991) for the proposition that Federal Rule of Evidence (FRE) 705 “functions to abbreviate trials by permitting opinion testimony without factual foundation. We see no reason why Rule 705 is not fully applicable to patent trials and opinion testimony on infringement. ... Symbol was permitted to rest its prima facie case on Barkan’s expert testimony, including charts, that the patents were infringed, and the District Court was free to accept or reject that evidence.” (ARB at 26-27.)

Complainants argue that Staff has offered no evidence or expert testimony from the perspective of a person of ordinary skill to counter Dr. Wood’s analysis. Complainants assert that OurPet’s own witnesses confirmed that the discharge “occurs at the wall with the radius at the end of the SmartScoop box, that the radius matches the radius of the swing of the rake, that when the rake comes out of the litter with waste it is within a quarter inch of the discharge end wall, and that the rake must be close to the discharge end wall to keep the waste from falling off the comb tines.” (ARB at 27 (citing JX-8C at 41:22-25, 42:1-10, 77:6-14, 78:4-15, and 143:1-9).)

Respondent OurPet’s Position: OurPet’s argues that SmartScoop does not infringe claims 8, 24 and 31,¹⁵ because SmartScoop does not possess a “carriage” which OurPet’s asserts should be construed as “motor, gear train, battery case, and batteries carried by a rotatable shaft.” (OIB at 46.) OurPet’s argues that the SmartScoop Waste Unit and Motor Unit slide on top of the

¹⁵ OurPet’s asserts that SmartScoop does not infringe claims 13, 25 and 32, because they depend on claims 8, 24 and 31 respectively. (OIB at 46.)

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housing, such that there is no “rotatable shaft” that carries “a motor, gear train, battery case, and batteries.” They argue, too, that there is no battery case or batteries. (*Id.* at 47.)

OurPet’s adds, in its reply brief, an argument that SmartScoop does not infringe because it does not have a motor mounted on the waste receptacle, which they argue is required by the ‘847 patent. (ORB at 49-50 (citing RX-141.2-RX-141.3; RX-231 at ¶¶ 10-12).)

OurPet’s argues that the doctrine of equivalents cannot be applied to find that the SmartScoop possesses a “carriage,” because “[t]here is *no* rotatable shaft to carry the motor, gear train, batteries and battery case. Instead, they assert, the assembly that holds the waste receptacle slides on the top of the housing.” (OIB at 52 (citing RX-138; RX-230 at ¶¶ 32-33, 43).) They argue that this assembly “is substantially different from the ‘comb drive’ described in the specification in that assembly is designed to propel the waste receptacle, whereas the ‘comb drive’ does not. This drastic design difference of the assembly of the SmartScoop ... performs a different function in that it propels the waste receptacle and does not prohibit rotation of the comb. In fact, the assembly enables the comb to rotate. Therefore, the assembly of the SmartScoop ... cannot be equivalent to the ‘carriage,’ as claimed.” (OIB at 52.)

OurPet’s argues that SmartScoop does not possess a “comb drive,” “comb drive means,” or “drive means” as required by Claims 8, 13, 24, 25, 27, 31-33 and 41. They say that the reason SmartScoop does not possess the required structure is that “worm drives” are excluded from the proper construction of those terms, and SmartScoop uses a worm drive. Therefore, they urge, SmartScoop does not literally infringe, and no infringement under the doctrine of equivalents can be found, because to do so would include as an equivalent that which has been affirmatively disavowed. (OIB at 48.)

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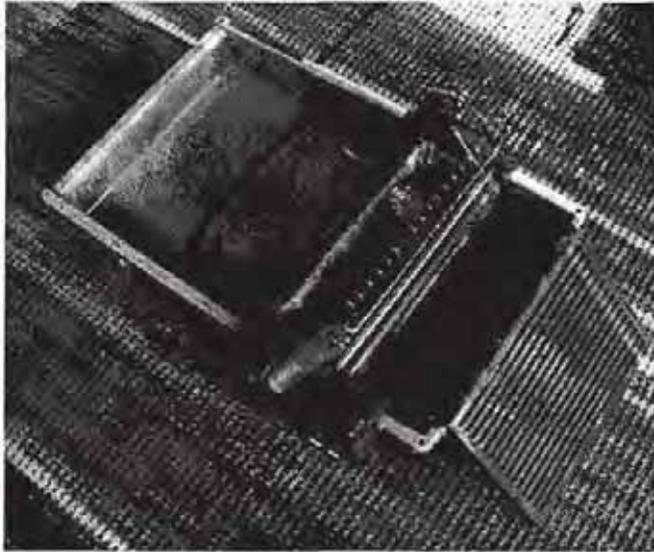
OurPet's argues, too, that the doctrine of equivalents cannot be applied to find that the SmartScoop possesses a "comb drive," "comb drive means," or "drive means," because the "definition of a 'comb drive' in the specification expressly and affirmatively calls for a motor to be in a driving relationship with rotatable shaft and expressly states that the comb is held in a substantially vertical position." (OIB at 53.) OurPet's asserts that the SmartScoop does not possess "shaft 41" that extends across the width of the housing. (RX-231 at ¶ 64; RX-141.) They say that in contrast, the assembly that supports the waste receptacle slides across the top of the housing and is propelled by the drive system. (OIB at 53.)

OurPet's argues that the SmartScoop drive system is substantially different from the "comb drive" described in the specification in that the SmartScoop assembly is designed to propel the waste receptacle, whereas the "comb drive" does not. They refer to this as a "drastic design difference" of the drive system of the SmartScoop which performs a different function in that "it propels the waste receptacle and does not prohibit rotation of the comb." (OIB at 53.) They cite the specification of the '847 patent, which states in part, "[c]omb 43 remains in a substantially erect position as shown in FIG 2 [so that] it is prevented from rotating in the direction of arrow B by the engagement of auxiliary guide wheels 64 and 65 with the tracks 32 and 33." (*Id.*) In fact, they argue, the assembly and drive system enable the comb to rotate. (RX-138; RX-230 at ¶¶ 31, 34-41; RX-232C at ¶¶ 30-46; RX-139.) Therefore, they say, the drive system of the SmartScoop cannot be equivalent to the "comb drive." (OIB at 53.)

OurPet's argues in its reply brief that SmartScoop does not infringe claims 8 and 13, because it does not have a "discharge position" that is "adjacent to the discharge end wall." OurPet's admits that the SmartScoop has a "discharge position" ((ORB at 44 (citing RX-231 at ¶ 21)), but asserts that the SmartScoop does not drive the comb to a discharge position adjacent to

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the discharge end wall. They argue that the comb on the SmartScoop rotates to its discharge position so that upon discharge, the comb is in a vertical position, as indicated in RX-138.8 (shown below) and is not adjacent to the discharge end wall. (ORB at 45-46.)



(RX-138.8.)

Commission Investigative Staff's Position: Staff argues that the evidence fails to show that OurPet's infringes claim 8, and that dependent claim 13 is likewise not infringed due to the failure to prove infringement of independent claim 8. (SIB at 41.)

Staff asserts that the evidence proffered by the Complainants fails to set forth a *prima facie* case of infringement, because it omits certain claim elements. Staff states that the evidence does not show that the SmartScoop has "a comb path extending from the storage end wall to the discharge end wall" or a "track member, defining the comb path" or "a discharge position adjacent to the end wall." (SIB at 41.)

Staff argues that Complainants offered no evidence that the comb path extends from one wall to another wall. (SIB at 42 (citing CX-893C at ¶ 448).) They argue that "[n]o evidence was offered concerning the path itself or how the [SmartScoop] meets the claim element when

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[SmartScoop] stops significantly short of the discharge end wall.” (SIB at 42.) Staff asserts that the evidence shows the SmartScoop waste unit stops substantially short of the discharge end wall. (*Id.* (citing RX-232C at ¶¶ 30-46; RX-231 at ¶¶ 53-62; RX-138.8; CDX-41; CDX-45).) They also assert that the evidence fails to show that the comb does not start from a position “at ‘the storage end wall’ as required by the claim.” (SIB at 42 (citing CPX-33).)

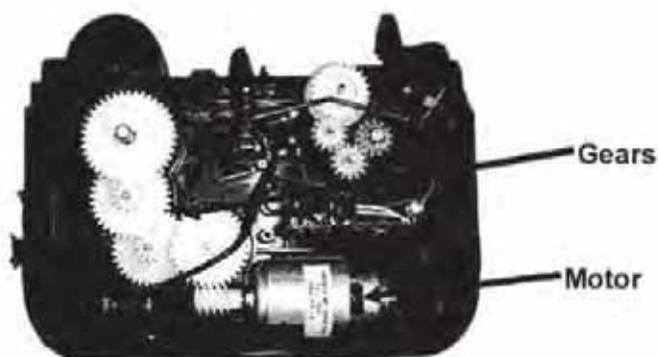
Staff argues regarding “a track member, defining the comb path” that the comb path element requires the path to extend from one end wall to an opposite end wall. There is no testimony, they say, concerning the requirement that the track “be from one end wall to another end wall.” (SIB at 43-44 (citing CX-893 at ¶ 521).)

Staff asserts that the evidence fails to prove that the comb drive of SmartScoop drives the comb to a “discharge position adjacent to the discharge end wall,” and argues that the device (i.e. the “waste unit”) actually stops “substantially short of the discharge end wall.” (SIB at 42.) To support their contentions, Staff cites the same evidence in the record here as they cited to support their argument regarding the comb path. (*Id.* at 42-43.)

Discussion and Conclusion: I find that the evidence supports the conclusion that the accused SmartScoop possesses a “comb drive” and a “carriage” as construed herein. Nevertheless, Complainants have failed to prove that the SmartScoop product infringes claim 8, because they have failed to show that the SmartScoop has a “discharge position adjacent to the discharge end wall” as required in the fourth element of claim 8. In addition, the evidence does not support a finding that element 8 of claim 8 is met. That element requires “a reversible motor...mounted on the carriage.”

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It is clear to me that the SmartScoop contains the “comb drive” that is required by claim 8, which I have construed as “a motor and gear train for driving the comb.” This is shown by CPX-49, which illustrates the SmartScoop motor and gear train.



(CPX-49)

In his direct testimony, Dr. Wood testified that, when the term “comb drive” is construed to be a motor and gear train, the SmartScoop product infringes that element of claim 8. (CX-893C at ¶¶ 486-493.) He confirmed that opinion during cross-examination. (Tr. at 330:4-10.) I find his testimony on this point credible, and concur that the SmartScoop does, in fact, possess a “comb drive” as that term is construed in this case and literally infringes that portion of element 4 of claim 8.

OurPet’s argument to the contrary based upon an assertion that its drive is substantially different in design from the “comb drive” in the ‘847 patent is based on the fact that the drive moves the waste receptacle through the litter box along with the comb. OurPet’s misapprehends the law on this point. An accused device cannot escape infringement by merely adding features, if it otherwise has adopted the basic features of the patent. Also, an accused device that contains the same feature as the patented device cannot escape infringement because in that feature it performs an additional function it does not perform in the patented device. *Radio Steel & Mfg.*

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Co., 731 F.2d at 848. Thus, OurPet's cannot escape infringement on this point based upon the assertion that its carriage includes the waste receptacle and the comb drive moves not only the comb but the receptacle as well.

While Complainants have correctly stated the Federal Circuit's analysis of Federal Rule of Evidence 705 in *Symbol Technologies, Inc.*, 935 F.2d at 1576, regarding the adequacy of expert opinion, the facts of that case differ from the instant case. In *Symbol Technologies*, the opposing counsel did not cross-examine the expert whose testimony was later challenged as inadequate to establish infringement. Counsel in that case simply relied on the argument that an opinion without detailed discussion of its underlying facts was inadequate to establish the correctness of the opinion. The trial court credited the expert's conclusion despite the lack of underlying detail, and the Federal Circuit upheld the court's finding. Thus, the expert's opinion is entitled to some weight as evidence, even in the absence of facts or data underlying his opinion. Nevertheless, I am not required to accept the opinion of an expert as dispositive when, as in the case at hand, evidence is introduced to counter the expert's opinion.

Based upon the evidence before me in this case, I find that, contrary to Dr. Wood's opinion, the SmartScoop does not infringe element 4 of claim 8 in its entirety, because it does not possess a "discharge position adjacent to the discharge end wall" as required therein. The term discharge position clearly refers to the final position of the comb upon discharge of the litter. The next movement contemplated in the '847 patent is "... back to the storage position." (JX-1 at 10:27.) As is illustrated by RX-138.8, *supra*, that terminal point for the SmartScoop is not adjacent to the discharge end wall.

The term "adjacent" is defined as: "not distant: NEARBY," with synonyms being "ADJOINING, CONTIGUOUS, ABUTTING, and CONTERMINUS." WEBSTER'S NEW

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COLLEGIATE DICTIONARY, (1979 ed.) p. 14. RX-138.8 shows that the position of the “comb” in the accused SmartScoop product terminates its movement in a “discharge position” that is not fairly described as “nearby” when one considers the relationship of the comb in its “discharge position” (i.e. vertical and removed from the discharge end wall) and the overall confines of the comb path and relative distances available between the “storage position at the storage end wall” and the “discharge position” at the “discharge end wall.”¹⁶

Based on the foregoing, I find that the accused SmartScoop does not literally infringe the portion of the fourth element of claim 8 that requires the comb to be adjacent to the discharge end wall when it is in the discharge position. It follows, therefore, that the SmartScoop does not literally infringe claim 8 of the ‘847 patent.

Inasmuch as I have found that the SmartScoop does not literally infringe the fourth element of claim 8, I turn to the question of whether or not it infringes that element under the doctrine of equivalents. A finding of infringement under the doctrine of equivalents requires a showing that the difference between the claimed invention and the accused product was insubstantial. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950); *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1364 (Fed. Cir. 2007). One way of doing so is by showing on a limitation by limitation basis that the accused product performs substantially the same function in substantially the same way with substantially the same result as each claim limitation of the patented product. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39-40 (1997); *Stumbo*, 508 F.3d at 1364. “The function-way-result test is particularly suitable for analyzing the equivalence of mechanical devices[.]” *Stumbo*, 508 F.3d at 1364.

¹⁶ While the comb does travel “adjacent” to the discharge end wall during its movement toward the “discharge position,” the requirement is that it be “adjacent to the discharge end wall” when it arrives at the “discharge position.”

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The '847 patent teaches a comb drive that drives the comb from "a storage position adjacent to the storage end wall to a discharge position adjacent to the discharge end wall." (JX-1 at 10:24-26.) It also teaches "the comb moves toward the discharge end wall so that the comb engages any clumps in the litter and carries such clumps to the discharge position." (*Id.* at 10:29-32) The term "discharge position," as used in the '847 patent, clearly refers to the final position of the comb upon discharge of the litter and the point at which its movement toward the discharge end wall terminates. The evidence shows that the comb drive of the SmartScoop performs the same function (i.e. engaging any clumps in the litter and carrying them to the discharge position) and achieves the same result (i.e. cleaning the cat litter box). The difference, however, is the manner in which the result is obtained. While element 4 of claim 8 of the '847 patent teaches that the comb terminates its movement at a point adjacent to the discharge end wall, the SmartScoop comb carries the clumps it has engaged to the discharge end wall and beyond, turning vertically to dump the clumps into a waste receptacle located behind the comb and that has moved with the comb the length of the comb path. Thus, it does not achieve the result in the same manner as that taught by the '847 patent in element 4 of claim 8. (RX-138.) In an invention of this type and magnitude, that difference in the manner of achieving the result is not, in my view, "insubstantial." Therefore, the SmartScoop does not infringe element 4 of claim 8 under the doctrine of equivalents.

I have previously construed the term "carriage" to be "the structural element that supports and carries the comb through the self-cleaning litter box." The evidence supports a finding that the accused SmartScoop infringes the sixth element of claim 8, in that it possesses "a carriage supporting the comb." Physical exhibits CPX-35 ("SmartScoop Litter Box waste carriage"), CPX 37 ("SmartScoop Litter Box waste carriage") and CPX-38 ("SmartScoop Litter Box tines"),

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demonstrate that the SmartScoop does, in fact, have a “structural element” (i.e. the waste carriage) that supports and carries the comb (i.e. the “tines”). In addition, Dr. Wood testified that the SmartScoop possesses a “carriage that supports the comb.” (CX-893C at ¶¶ 534-536.) He also testified that the comb or rake is “carried” by the carriage as the litter box performs a cleaning operation. (*Id.* at ¶ 546.)

Mr. O’Toole, who worked on development of the SmartScoop for OurPet’s (Tr. at 1068:8-1069:6) testified on cross-examination. While he appeared to attempt to avoid a direct answer to the question, after being shown a video of his deposition testimony, Mr. O’Toole admitted that he had previously identified deposition Exhibit 126D (i.e. CPX-33) as the “carriage.” (Tr. at 1074:1-1079:14, 1081:19-1082:9.) OurPet’s position (OIB-47) that the SmartScoop does not infringe, because it does not possess a carriage with a “rotatable shaft” that carries “a motor, gear train, battery case, and batteries,” is based on a misconstruction of the term “carriage.”

I note, however, that element 8 of claim 8 requires that the motor be “mounted on the carriage.” The evidence shows that the motor and gear train are, in fact, mounted on the housing and not on the carriage. (*See* CPX-33; RX-140). The definition of “mounted” relevant to this situation is “attached to a support,” which necessarily means that the thing to be mounted must rest on and be supported by the thing on which it is “mounted.” WEBSTER’S NEW COLLEGIATE DICTIONARY, (1979 ed.) p. 746. The evidence here shows that the opposite is true; the carriage is mounted partially on the motor. Therefore, that requirement of element 8 of claim 8 is not met, and the SmartScoop does not literally infringe claim 8.

It was not necessary to construe the term “comb path,” as it was not disputed at the hearing. In addition, by failing to indicate that it was an issue in dispute at the hearing, OurPet’s

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waived that issue pursuant to Ground Rule 8(f). Nevertheless, contrary to Staff's argument, and using OurPet's own definition of the term, the SmartScoop does possess a comb path that extends from the storage end wall to the discharge end wall. Although the "discharge position" is not adjacent to the discharge end wall, as demonstrated, *supra*, the path the comb takes on its journey from the storage position to the discharge position transits the entire length of the litter box from the storage end wall to the discharge end wall and beyond. (RX-138; RX-230 at ¶¶ 31, 34-41; RX-232C at ¶¶ 30-46; RX-139.)

Regarding the term "storage end wall," its construction was not disputed and it was not necessary to construe it for this case. Since claim 8 describes the storage end wall as one of the end walls connected by two side walls, it follows that the storage end wall is the wall opposite the discharge end wall. I note that OurPet's own exhibit, RX-138, shows the comb initially located at its storage position which is located adjacent to the end wall opposite the discharge end wall. Staff's assertion that the comb stops "approximately 5 inches from the storage end wall" is made without supporting evidence in the record. They refer to CPX-33. What CPX-33 and RX-138 actually show is that the comb is stored adjacent to the storage end wall, which is shaped so that the lower portion of the wall "defines the litter chamber" and the upper portion recesses to nest the waste receptacle. Using CDX-42, which also shows the comb in the storage position adjacent to the storage end wall, Dr. Wood testified credibly that he had dissected the SmartScoop, labeled the structural elements in the Exhibit and opined that they "claim term of the claim chart covers the SmartScoop self-cleaning litter box." (CX-893C at ¶¶ 448, 450-454.) I concur on this point.

The testimony of Dr. Wood, which is uncontroverted, is that the SmartScoop has a track member, defining the comb path, mounted to one side wall above the fill level. He referred to

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CDX-46, CPX-33 and CPX-49 to illustrate his testimony on this point. (CX-893C at ¶¶ 529-531.)

Dr. Wood also provided testimony, which is uncontroverted, that the SmartScoop possesses a “guide wheel mounted on the carriage and engaging the track member.” Using CDX-48, CDX-111 and CDX-114, he illustrated his point. He credibly testified that SmartScoop infringes this element of claim 8. (CX-893C at ¶¶ 552-555.)

2. Claim 13

Claim 13 recites:

An improved cat litter box according to claim 8 and further comprising:

a cat exit sensor for sensing exit of a cat from the litter chamber; and

delay means, connected to the sensor and to the reversible motor, for actuating the comb drive motor to drive the comb from the storage position to the discharge position, at a predetermined time interval subsequent to sensing of exit of a cat from the litter chamber.

Complainants’ Position: Complainants’ have offered no specific position regarding infringement of dependent claim 13 independent of their arguments that OurPet’s infringes independent claim 8.

Respondent OurPet’s Position: OurPet’s asserts that SmartScoop does not infringe claim 13, because it depends from claim 8. (OIB at 46.)

Commission Investigative Staff’s Position: Staff takes the position that dependent claim 13 is not infringed due to the failure to prove infringement of claim 8. (SIB at 41.)

Discussion and Conclusion: Because I have found that the SmartScoop products do not infringe independent claim 8, it follows that they do not infringe claim 13, which depends from claim 8. *Wahpeton*, 870 F.2d at 1552 n. 9.

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3. Claim 24

Claim 24 recites:

A self cleaning litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

moving means disposed in the pan-shaped housing;

a carriage supporting the moving means; and

drive means for driving the moving means between a storage position and a discharge position, the moving means projecting down into the litter chamber to a level below the fill level while the moving means moves toward the discharge position so that the moving means engages clumps in the litter and moves such clumps toward the discharge position;

said drive means including motor means mounted on the carriage for driving the moving means between the storage position and the discharge position.

Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claims 24 and 31. Those arguments will, therefore, not be repeated here. The arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 24.

Complainants also argue that the accused SmartScoop meets the "drive means" element of claim 24 under the doctrine of equivalents. To support this argument, they cite Dr. Wood's testimony (CX-893C at ¶¶ 847-851) and CDX-58.

Respondent OurPet's Position: OurPet's arguments regarding claim 8 were written in a manner to apply also to claims 24 and 31. Those arguments will, therefore, not be repeated here. The arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 24.

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OurPet's adds, in its reply brief, an argument that SmartScoop does not infringe because it does not have a motor mounted on the waste receptacle, which they argue is required by claim 24. (ORB at 49-50 (citing RX-141.2-RX-141.3; RX-231 at ¶¶ 10-12).)

Commission Investigative Staff's Position: Staff argues that claim 24 is indefinite because "moving means" has no meaning. Therefore, they assert, the claim is invalid.

In the alternative, if the infringement question is reached regarding claims 24 and 25, Staff argues that the evidence fails to show that the "drive means" element reads on the SmartScoop product. Staff asserts that "Complainants' expert failed to show that the structure disclosed in the specification for 'drive means' ('tracks 32 and 33 with apertures 32A and 33A on either side of the housing, the guide wheels 52 and 53 with pins 52A and 53A, the rotating shaft 41, the gear 57 and the motor 55') is also found in the accused product or that equivalents thereof are found in the accused product." (SIB at 45.) Staff argues that Complainants' expert presented "only a truncated explanation for infringement – the erroneous opinion being based on an incorrect claim construction for the term 'drive means.'" (*Id.* at 44-45.)

Discussion and Conclusion: I find that the evidence supports the conclusion that the accused SmartScoop has a "moving means" and a "carriage supporting the moving means" as construed herein. Nevertheless, Complainants have failed to prove that the SmartScoop product infringes claim 24, because they have failed to show that the SmartScoop product has a "drive means" as required by the fifth element of claim 24.

The term "moving means" was construed pursuant to 35 U.S.C. § 112, ¶ 6 to define the function as "engaging clumps in the litter and moving them toward the discharge position;" the structure revealed in the specification is a "comb" plus any equivalents of that structure. The evidence is clear that the accused SmartScoop does possess a "comb" that engages clumps in the

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litter and moves them toward the discharge position. (RX-138; RX-230 at ¶¶ 31, 34-41; RX-232C at ¶¶ 30-46; RX-139.)

The term “carriage” has previously been construed to mean “the structural element that supports and carries the comb through the self-cleaning litter box.” The evidence supports a finding that the accused SmartScoop possesses “a carriage supporting the comb.” Physical exhibits CPX-35 (“SmartScoop Litter Box waste carriage”), CPX-37 (“SmartScoop Litter Box waste carriage”) and CPX-38 (“SmartScoop Litter Box tines”) demonstrate that the SmartScoop does, in fact, have a “structural element” (i.e. the waste carriage) that supports and carries the comb (i.e. the “tines”).

In addition, the testimony of Dr. Wood and the reluctant Mr. O’Toole cited in the discussion of claim 8, *supra*, related to the carriage, is relevant here. Dr. Wood testified that the SmartScoop possesses a “carriage that supports the comb.” (CX-893C at ¶¶ 534-536.) He also testified that the comb or rake is “carried” by the carriage as the litter box performs a cleaning operation. (*Id.* at ¶ 546.) Mr. O’Toole ultimately admitted that he had previously identified deposition Exhibit 126D (i.e. CPX-33) as the “carriage.” (Tr. at 1074:1-1079:14, 1081:19-1082:9.) OurPet’s position (OIB at 47) that the SmartScoop does not infringe because it does not possess a carriage with a “rotatable shaft” that carries “a motor, gear train, battery case, and batteries,” is based on a misconstruction of the term “carriage.”

The term “drive means” was construed pursuant to 35 U.S.C. § 112, ¶ 6 to define the function as “driving the comb between the storage position and the discharge position;” the structure revealed in the specification is “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure.

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It is uncontroverted that the SmartScoop does not possess “shaft 41” that extends across the width of the housing. (RX-231 at ¶ 64; RX-141.) The evidence shows that, instead, the assembly that supports the waste receptacle slides acts as the carriage and is propelled by the drive system that is mounted on the housing. (RX-141; CPX-33; RX-140.) The definition of “mounted” relevant to this situation is “attached to a support,” which necessarily means that the thing to be mounted must rest on and be supported by the thing on which it is “mounted.” WEBSTER’S NEW COLLEGIATE DICTIONARY, (1979 ed.) p. 746. The evidence here shows that the motor is mounted on the housing, and not on the carriage. In fact, the opposite is true; the carriage is mounted partially on the motor. In the case at hand, the evidence is clear that the structure of the accused SmartScoop is not identical to the structure of the “drive means” taught in element 5 of claim 24.

I find, too, that the evidence shows that the SmartScoop differs substantially from the requirement taught in element 5 of claim 24, because the structure does not perform its function in the same manner. *Kemco*, 208 F.3d at 1364. It does so using a motor that is mounted on the housing and that moves the carriage along the track using a wheel mounted in connection with the housing. The drive means taught by claim 24 is one that is connected in a driving relationship to the “shaft 41” that is lacking in the SmartScoop product and which functions substantially differently than the SmartScoop system for driving its carriage and comb. (RX-231 at ¶ 64; RX-141; CPX-33; RX-140.)

The court in *Kemco* also treated the issue of doctrine of equivalents, when it stated:

If an accused structure is not a section 112, paragraph 6 equivalent of the disclosed structure because it does not perform the identical function of that disclosed structure and hence does not literally infringe, it may nevertheless still be an “equivalent” under the doctrine of equivalents. Thus, if one applies the traditional function-way-result test, the accused structure must perform substantially the same function, in substantially the same way, to achieve

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substantially the same result, as the disclosed structure.^{FN6} A key feature that distinguishes “equivalents” under section 112, paragraph 6 and “equivalents” under the doctrine of equivalents is that section 112, paragraph 6 equivalents must perform the identical function of the disclosed structure...while equivalents under the doctrine of equivalents need only perform a substantially similar function.

FN6. We note that the basic inquiry under the doctrine of equivalents is whether the differences between the accused and disclosed structure are “insubstantial,” and that the function-way-result analysis may not always be decisive in making that determination.

Because the “way” and “result” prongs are the same under both the section 112, paragraph 6 and doctrine of equivalents tests, a structure failing the section 112, paragraph 6 test under either or both prongs must fail the doctrine of equivalents test for the same reason(s). That was the case in *Chiuminatta*, in which the “way” was determined to be substantially different under a section 112, paragraph 6 analysis. Accordingly, we concluded that the accused structure did not infringe under the doctrine of equivalents for precisely the same reason.

208 F.3d at 1364 (citations omitted).

Based upon the foregoing, I find that the structure of the accused SmartScoop product does not infringe element 5 of claim 24 under the doctrine of equivalents, because the “way” in which it performs the function of driving the carriage is substantially different from that of the “drive means” as construed pursuant to 35 U.S.C. § 112, ¶ 6.

4. Claim 25

Claim 25 recites:

The litter box of claim 24 wherein the motor means includes a reversible drive motor.

Complainants’ Position: Complainants have offered no specific position regarding infringement of dependent claim 25 independent of their arguments that OurPet’s infringes independent claim 24.

Respondent OurPet’s Position: OurPet’s asserts that SmartScoop does not infringe claim 25, because it depends on claim 24. (OIB at 46.)

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Commission Investigative Staff's Position: Staff set forth its position regarding claim 25 in its argument on claim 24. That position will, therefore, not be repeated here. The arguments by Staff related to claim 24 are by this reference incorporated in this section regarding claim 25. (SIB at 44-45.)

Discussion and Conclusion: Because I have found that the SmartScoop products do not infringe independent claim 24, it follows that they do not infringe claim 25, which depends from claim 24. *Wahpeton*, 870 F.2d at 1552 n. 9.

5. Claim 27

Claim 27 recites:

A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb disposed in the litter chamber;

comb drive means for driving the comb between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level while the comb moves toward the discharge position so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

mode selector means for selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.

Complainants' Position: Complainants argue that SmartScoop has a mode selector means “for selecting between a manual and automatic operation mode,” which they define, incorrectly, as “a switch.” (AIB at 64-65.) They argue, correctly, that the function is “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” They say that the switch in the SmartScoop product is the structure that performs the foregoing function. They argue, “[a]fter the SmartScoop product is

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powered on ... [it] is in a mode of operation where it will actuate the comb to rake through the litter a pre-set time period after detecting cat entry and exit.” (AIB at 65 (citing Tr. at 991:18-992:7; JX-10C at 155:23-156:7, 157:20-158:3; JX-9C at 148:7-13, 179:17-24; JX-19C at 103:16-104:4).) The Complainants point to the SmartScoop user guide as evidence of this fact, to wit:

How It Works

The SmartScoop Self-Scooping Litter Box features a sensor that detects when your cat is in the box. Once the cat leaves the box, it begins a 15 minute countdown. After the countdown, SmartScoop begins a cleaning cycle and scoops the box clean of all waste and clumps. Clumps and waste are deposited in the waste bin and the litter is smoothed out by the litter rake as the motor unit returns to the “ready” position at the back of the box.

(CPX-40 at 4.)

Complainants argue that the push button switch in the SmartScoop allows for selecting between the automatic operation mode and a manual operation mode. They assert that when the SmartScoop product is in automatic operation mode, it can be put into manual operation mode using the switch. They point to testimony by OurPet’s corporate designee as confirming the SmartScoop can be put into a manual operation mode by pushing the switch down twice. When the switch is manually pushed the second time, the comb is actuated and goes down and back through the litter once.¹⁷ The Complainants assert that the switch in the SmartScoop Product thus allows for selecting between automatic and manual operation mode for the comb drive. Whenever the product is in automatic operation mode, the switch allows the user to select manual operation mode instead by pushing it down twice. (AIB at 65-66.)

¹⁷ In this paragraph, Complainants repeatedly cite a list of testimony and exhibits to support these assertions, which I will only list once in this footnote, to wit: JX-11C at 33:14-20; JX-15C at 49:14-20, 52:7-53:4; CX-334C; CX-335C; CX-175C; CX-327C; JX-10C at 114:20-115:6, 133:3-15, 147:23-148:10, 155:23-156:7; CX-174C; JX-9C at 161:4-14; Tr. at 889:1-15; CX-137 at 11; Tr. at 931:8-18, 942:11-20; JX-19C at 55:10-12, 58:2-9, 58:16-59:4, 60:4-16, 61:9-20, 64:14-65:15, 67:24-68:20, 125:15-126:1, 153:15-154:9, 154:22-155:2, 155:4-20, 165:15-18, 177:7-14, 179:17-21, 179:23-25, 182:4-8, 190:11-22, 192:7-193:5; CX-280C; JX-18C at 257:22-259:15, 259:16-260:3; CX-210; JX-8C at 37:14-25, 88:2-9, 89:21-90:3, 57:10-58:2 59:20-61:4, 62:6-12, 177:22-178:11; CX-137; RX-231 at ¶¶ 18, 19; RX-140; CX-911; CDX-64; CX-893C at ¶¶ 695-696; CPX-33-CPX-49.

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Complainants argue that OurPet's cannot avoid infringement by claiming that its push button switch is a "power" button that performs on/off functions. First, they say, the "power" switch in the SmartScoop does not supply power to the microcontroller. They say that OurPet's corporate designee testified that the SmartScoop switch does not allow or disallow power to the microcontroller. While the switch is labeled "Power" on the actual product, it actually has nothing to do with supplying or cutting power to/from the microcontroller.¹⁸ Complainants assert that OurPet's designee testified that the real function of the SmartScoop switch is for selecting between the SmartScoop automatic operation mode (*i.e.*, combing in response to cat-based input plus a time delay) and a manual operation mode (*i.e.*, combing in response to a human-based input), quoting:

Q. Okay. Now, if the litter box is in state 4, where we have labeled that as the parked state where the IR sensor is on and it is waiting for an IR sensor event, is this the state where it is looking for a cat to come into the box in state 4?

A. Yes.

Q. If the SmartScoop is in state 4 where it is looking for a cat to enter the box and a user wants to manually activate the rake -- manually activate a cleaning cycle, excuse me, how would a user do that?

A. A user would press the power switch once and then press it again, which will put it into state 1 and then let it do its thing.

(CX-88C at 178:19-179:8.)

Complainants argue that the SmartScoop would not avoid infringement even if the switch did perform on/off functions, because the '847 patent describes that an on/off switch can be used, and also describes a switch for selecting between manual and automatic operation modes. (AIB at 67 (citing RX-236C at ¶¶ 27-28; Tr. at 463:15-23, 463:24-464:4, 487:10-488:24; Tr. at

¹⁸ Again, in this paragraph, Complainants repeatedly cite a list of testimony and exhibits to support each assertion, which I will cite but once in this footnote, to wit: Tr. at 933:1-5, 936:19-25, 937:10-13; JX-19C at 73:1-25, 74:1-25, 90:2-6; CX-904C; Tr. at 1083:16-19, 1083:21-1084:9, 1084:17-1085:1; CX-136C; Tr. at 264:7-16, 305:5-22, 311:4-314:8.

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268:13-20, 297:14-299:20; CX-894C at ¶¶ 89-90, 92-94; Tr. at 596:16-597:6; CX-893C at ¶¶ 365, 810).) They assert, that even if the on/off and “selecting-between” functionality were combined into one switch, the switch would still perform the claimed “selecting-between” function, and thus would not avoid infringement, because adding functionality to a structure that otherwise meets the language of a claim does not avoid infringement. (*Id.* (citing JX-11C at 33:14-20; JX-15C at 49:14-20, 52:7-53:4; CX-334C; CX-335C; CX-175C; CX-327C; JX-9C at 161:4-14).) They argue that the claim uses introductory “comprising” language for just that purpose, to allow the claim to cover products that have functions or features in addition to those that are expressly claimed. *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1371-72 (Fed. Cir. 2005). (“The word ‘comprising’ transitioning from the preamble to the body signals that the entire claim is presumptively open-ended. . . . The addition of elements not recited in the claim cannot defeat infringement.”).

Complainants argue that OurPet’s cannot successfully assert that the SmartScoop is not covered by the “mode selector means” claim language because the switch is a push button or momentary switch and does not have two distinct, stationary positions. They point to *Overhead Door* in which, they say, the Federal Circuit held that language virtually identical to the switch for “selecting between” two operation modes language in claim 27 covers a push button switch. 194 F.3d at 1273-74. The Complainants argue that there is no substantive difference between the claim language at issue in *Overhead Door* and the claim language at issue in this investigation. (AIB at 67.)

In their reply brief, Complainants argue that SmartScoop has a “manual operation mode” as required by claim 27. They assert that the evidence is uncontroverted that the SmartScoop allows the operator to manually cycle the rake through the litter one time. (ARB at 23 (citing Tr.

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at 819:2-6; JX-5C at 169:23-170-6; RX-233C at ¶ 61; Tr. at 734:4-15; JX-12C at 405:10-12; JX-25C at 175:2-7; RX-236C at ¶ 32; CX-893C at ¶ 188.) Complainants assert that OurPet's argument is based upon a construction of "manual operation mode" which is erroneously confined to "combing on a cyclical basis." (ARB at 23.)

Respondent OurPet's Position: OurPet's asserts that SmartScoop does not possess a "mode selector means for selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means" as required by claims 27 and 41. They argue that the SmartScoop possesses a switch that has only "off" and "on" positions, rather than a switch that has one position that corresponds to an "automatic operation mode" and one switch position that corresponds to a "manual operation mode," which they argue is required to find infringement. (OIB at 49-50.)

OurPet's points to the declaration of Complainants' expert Dr. Wood in which he said, "[t]he '847 Patent written description adequately conveys to a person of ordinary skill in the art a manual mode of operation, an automatic mode of operation, and an [*sic*] mode selector means for selecting between those modes of operation." (*Id.* at 49 (citing Tr. at 238:25-239:13, 288:22-290:3, 302:15-303:4; RX-142C).) OurPet's states that the SmartScoop possesses a switch that has only "off" and "on" positions, and they point to the SmartScoop SmartStart Guide for Fresher Litter which states:

To begin operation, press the POWER button. SmartScoop will automatically complete one cleaning cycle. After completing a cleaning cycle, the unit will be at rest until cat is detected. Upon detection of a cat, the SmartScoop will begin a 15 minute countdown before beginning a cleaning cycle... Pressing the POWER button off and on will cause the unit to automatically complete a cleaning cycle.

(RX-140 at 10.)

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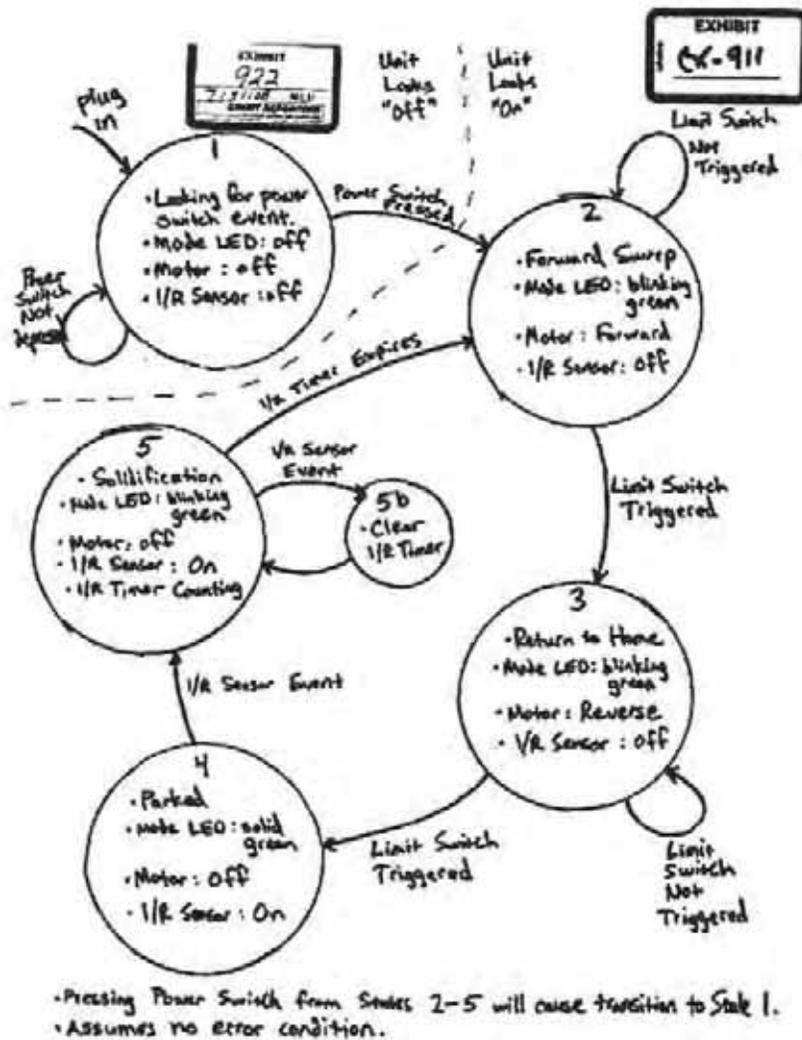
OurPet's argues that, if the "on" position is considered to correspond to the "automatic operation mode," then it is not possible for the "off" position to correspond to a "manual operation mode" and *vice versa*. OurPet's argues that, using the Complainants' rationale, the "on" position would have to correspond to both the "manual operation mode" and the "automatic operation mode" and assert that it is not possible to "select between" two distinct modes with the SmartScoop switch. (OIB at 49-50.)

OurPet's argues in its reply brief that a user of SmartScoop cannot use the power button to select between different modes, because "... the very phrase 'selecting *between*' different modes requires that there be more than one mode to select from." (ORB at 52 (emphasis in original).) They assert that the SmartScoop only has a single mode of operation, which is "on." They say there is no other mode, so it is not possible to select between modes. (*Id.*)

OurPet's also argues that the SmartScoop does not infringe under the doctrine of equivalents, because the result of the operation of the "power button" on the SmartScoop is substantially different than that of the "mode selector means" or "mode selector switch" of the '847 Patent. OurPet's argues that the "mode selector of the '847 Patent" does not provide the capability to turn the unit off, like the power button of the SmartScoop. (*Id.* at 53.) Instead, it simply switches between manual and automatic operation modes. (*Id.*)

OurPet's points to the deposition transcript of Mr. Jason Kocher which contains a "state diagram," shown below:

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(CX-911.)

OurPet’s asserts that the “state diagram” illustrates that, when the SmartScoop is plugged into an electrical outlet, but the power button is not pressed, the motor and *infrared* sensor are off, and the unit is looking for a power switch event. During this time, the unit “looks ‘off.’” (ORB at 54.) When the power button is pressed, they assert, “the SmartScoop unit engages in one forward sweep (see state 2 in the diagram).” (*Id.*)

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OurPet's argues, too, that even if the initial cleaning cycle of the SmartScoop could be construed as "manual," it is not "cyclical" and therefore not a "manual operation mode" as required by the claim. (OIB at 50.)

Commission Investigative Staff's Position: Staff argues that the evidence does not show that claim 27 reads on the SmartScoop product. Staff argues "... the evidence does not show that the 'comb drive means' limitation or the 'mode selector means' limitations are found in the accused product. The lack of evidence concerning the comb drive means is the same problem as found with claim 24 ..." (SIB at 45.)

Regarding the "mode selector means," Staff argues that the evidence "fails to show structure in the accused product that is the same or equivalent to the structure disclosed in the specification that corresponds to the 'mode selector means.' First, the algorithm disclosed in the specification for operating the microcontroller – structure that corresponds to mode selector means for selecting between a manual operation mode and an automatic operation mode – discloses a continuous cycling manual mode." (*Id.* at 45-46.) Staff argues that Complainants' offered no evidence that such a mode is found in the accused product. Staff asserts that Complainants' expert instead testified that a person could repeatedly press the on/off button which would cause repeated cycling of the unit. (*Id.* at 46 (citing CX-893C at ¶ 682).) Staff argues that the disclosed algorithm requires a continuous cycling of the unit when it is in a manual mode. They assert, "[e]vidence that one can repeatedly press a button to cause repeated cycling does not present evidence that the disclosed algorithm is present in the accused product. In fact, the necessity of having to repeatedly turn the unit on and off suggest that the accused product has an algorithm that requires only a single operation of the units when the unit is turned on and that it will not repeatedly cycle as required by the patent claim." (*Id.*) Staff concludes

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that Complainants have offered no competent testimony showing that the SmartScoop has any structure for the “mode selector means” that is the “same structure disclosed in the specification or its equivalent (the microcontroller as programmed and a switch) for accomplishing the claimed function.” (*Id.* (citing Tr. 287-88; CX-893C at ¶¶ 690-694).)

Discussion and Conclusion: I find that Complainants have failed to prove that the SmartScoop product infringes claim 27, because they have failed to show that the SmartScoop product has a “a mode selector means” as required by the fourth element of claim 27 or a “comb drive means” as required by the third element of claim 27.

The term “mode selector means” was construed pursuant to 35 U.S.C. § 112, ¶ 6 to define the function as “selecting between at least a manual operation mode for said comb drive means and an automatic operation mode for said comb drive means.” The disclosed structure is “a switch and a microprocessor programmed to perform the algorithm that selects between a manual operation mode and an automatic operation mode as disclosed in Figure 7 and accompanying text” plus any equivalents thereof.¹⁹

The evidence establishes that the accused SmartScoop product has a switch and a microprocessor programmed to perform an algorithm that initiates a manual cleaning cycle when a momentary switch is pressed. In his deposition, Mr. Jason Kocher testified that he was the one hired to design the initial prototype of the SmartScoop. (JX-19C at 9:19-10:01) He testified that he created a prototype in which the littler box could be reset by cycling the power on and off, and that was coded to begin a cycle every time it was turned on. (*Id.* at 54:18-24)

The similarity ends there. Once the SmartScoop completes a manual cleaning cycle, the microprocessor does not perform an algorithm to see whether or not it remains in the manual

¹⁹ *Overhead Door*, cited by Complainants, is inapposite. The term mode selector means is construed pursuant to 35 U.S.C. § 112 ¶ 6. While it does involve a switch, it also involves additional structure well beyond a switch.

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operation mode. Without further input from the switch, the SmartScoop product's microprocessor completes algorithms causing it to move into an automatic operation mode. Mr. Kocher testified that the box was designed with a PIC microcontroller. (*Id.* at 59:10-12) He testified extensively regarding the workings of the microcontroller and switch of the accused SmartScoop, indicating that the switch labeled "power" does not actually gate power to the box. Rather, when the switch is pressed "the unit proceeded to tell the motor to go in a forward direction relative to the shape of the box." (*Id.* at 90:02-06, 75:23-76:06.) He testified that once the unit has gone through a cleaning cycle, the microcontroller goes into "a portion of the polling loop where it is trying to figure out if there is a cat in the box via the *infrared* sensory system." If the IR sensors detect an object in the box, there is a long pause, on the order of 10 or 15 minutes, after which the unit will move forward and perform its cleaning action and return home. (*Id.* at 125:08-14, 103:16-105:03.) At that point if a user wants to cycle the rake, the easiest way to do it is to press the power switch once and then press it again and it will run one more cycle. (*Id.* at 125:21-126:01.) Mr. Kocher created a "state diagram," (depicted in CX-911), which illustrates the functions described, *supra*.

Mr. Kocher's testimony establishes that the SmartScoop product has a switch and a microprocessor. When the unit is plugged in and appears "off," its microprocessor is in a waiting state. Once the switch is pressed, the microprocessor performs an algorithm that identifies a manual operation and causes the unit to perform a cleaning cycle, after which the microprocessor moves into an automatic mode in which it waits for its IR sensor to detect entry and exit of a cat. When that occurs, the microprocessor performs an algorithm that institutes a 10 to 15 minute delay after which the unit performs a cleaning cycle and returns to its home monitoring state.

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The term “comb drive means” was construed pursuant to 35 U.S.C. § 112 ¶ 6 to define the function as: “driving the comb between the storage position and the discharge position;” the structure revealed in the specification is “a reversible electric motor 55 mounted on and connected in driving relationship to the shaft 41 and the gear train that connects the motor 55 to the shaft 41” plus any equivalents of that structure.

The definition for “comb drive means” is identical to that given the term “drive means” in this case. Therefore, the discussion and analysis of whether or not the accused SmartScoop product infringes element 3 of claim 27 is the same as that applied to the question of whether or not the accused SmartScoop product infringes elements 4 or 5 of claim 24. The discussion regarding elements 4 and 5 of claim 24, *supra*, is hereby incorporated by reference.

Based upon the foregoing, I find that the accused SmartScoop product does not infringe claim 27.

6. Claim 31

Claim 31 recites:

A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb drive coupled to the housing;

a comb extending between two opposed sidewalls and being coupled to the comb drive and movable between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

a comb supporting carriage, said comb drive including a drive motor mounted on the carriage.

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Complainants' Position: Complainants' arguments regarding claim 8 were written in a manner to apply also to claims 24 and 31. Those arguments will, therefore, not be repeated here. The Arguments by Complainants related to claim 8 are by this reference incorporated in this section regarding claim 31.

Respondent OurPet's Position: OurPet's arguments regarding claim 8 were written in a manner to apply also to claims 24 and 31. Those arguments will, therefore, not be repeated here. The Arguments by OurPet's related to claim 8 are by this reference incorporated in this section regarding claim 31.

Commission Investigative Staff's Position: Staff argues that the evidence shows that each limitation of claims 31 and 32 reads on the SmartScoop product. (SIB at 48 (citing CX-893C at ¶¶ 724, 727, 734, 741, 755, 769, 789, 794).)

Discussion and Conclusion: I find that the evidence supports the conclusion that the accused SmartScoop possesses a "comb drive" and a "carriage" as construed herein. Nevertheless, Complainants have failed to prove that the SmartScoop product infringes claim 31, because they have failed to show that the SmartScoop product possesses a "comb drive including a drive motor mounted on the carriage" or "a comb ... being coupled to the comb drive ..."

It is clear to me that the SmartScoop contains the "comb drive" that is required by claim 31, which I have construed as "a motor and gear train for driving the comb." This is shown by CPX-49, in the discussion of claim 8, *supra*, which illustrates the SmartScoop motor and gear train. In his direct testimony, Dr. Wood testified that when the term "comb drive" is construed to be a motor and gear train, the SmartScoop product infringes that element of claim 8. (CX-893C at ¶¶ 486-493.) He confirmed that opinion during cross-examination. (Tr. at 330:4-10.) I find his testimony on this point credible, and using a consistent definition of the term "comb drive"

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conclude that the SmartScoop possesses a “comb drive” as that term is construed in this case. The evidence also shows that the comb drive is coupled to the housing as required by element 2 of claim 31. (*See* CPX-33; RX-140.) Therefore, I find that the SmartScoop literally infringes element 2 of claim 31.

Nevertheless, element 4 of claim 31, recites a “comb drive including a drive motor mounted on the carriage.” The evidence shows that the motor and gear train are, in fact, mounted on the housing and not on the carriage. (*See* CPX-33; RX-140). I note that the definition of “mounted” relevant to this situation is “attached to a support,” which necessarily means that the thing to be mounted must rest on and be supported by the thing on which it is “mounted.” WEBSTER’S NEW COLLEGIATE DICTIONARY, (1979 ed.) p. 746. The evidence here shows that the motor is mounted on the housing, and not on the carriage. In fact, the opposite is true; the carriage is mounted partially on the motor. Therefore, that requirement of element 4 of claim 31 is not met, and the SmartScoop does not literally infringe element 4 of claim 31.

I have previously construed the term “carriage” to be “the structural element that supports and carries the comb through the self-cleaning litter box.” The evidence supports a finding that the accused SmartScoop infringes element 4 of claim 31, in that it possesses “a comb supporting carriage.” Physical exhibits CPX-35 (“SmartScoop Litter Box waste carriage”), CPX-37 (“SmartScoop Litter Box waste carriage”) and CPX-38 (“SmartScoop Litter Box tines”) demonstrate that the SmartScoop does, in fact, have a “structural element” (i.e. the waste carriage) that supports and carries the comb (i.e. the “tines”).

In addition, the testimony of Dr. Wood and the reluctant Mr. O’Toole cited in the discussion of claim 8, *supra*, related to the carriage, is relevant here. Dr. Wood testified that the SmartScoop possesses a “carriage that supports the comb.” (CX-893C at ¶¶ 534-536.) He also

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testified that the comb or rake is “carried” by the carriage as the litter box performs a cleaning operation. (*Id.* at ¶ 546.) Mr. O’Toole ultimately admitted that he had previously identified deposition Exhibit 126D (i.e. CPX-33) as the “carriage.” (Tr. at 1074:1-1079:14, 1081:19-1082:9.) OurPet’s position (OIB at 47) that the SmartScoop does not infringe, because it does not possess a carriage with a “rotatable shaft” that carries “a motor, gear train, battery case, and batteries,” is based on a misconstruction of the term “carriage.”

Element 3 of claim 31 teaches “a comb ... being coupled to the comb drive ...” Exhibit RX-141 is a series of five photographs showing the SmartScoop product being assembled from a point that begins with a disassembled state of the component parts and (1) adding the “comb drive” element, which is the motor and gear train, by mounting that element on the housing; (2) placing the carriage on the SmartScoop and “coupling” it to the “comb drive;” (3) placing the comb on the carriage. CPX-33 shows the comb (CPX-38) connects to the carriage (CPX-37) at the point marked “S,” with a portion of the comb bent to a 90° angle and seated in a gear “I.” CPX-33 also shows that when CPX-37 is mounted on the litter box housing and the motor and gear train housing (CPX-49), the gear “I” connects with a gear “H,” which is not part of the gear train in the comb drive; but which is located in the same housing as the comb drive. Because the comb is indirectly connected to the comb drive and is three steps removed from a direct connection to the comb drive itself, I find that it is not coupled to the comb drive.

Based on the foregoing, because the accused SmartScoop does not infringe elements 3 and 4 of claim 31, I find that it does not infringe claim 31.

7. Claim 32

Claim 32 recites:

The litter box of claim 31 wherein the drive motor is reversible.

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Complainants' Position: Complainants have offered no specific position regarding infringement of dependent claim 32 independent of their arguments that OurPet's infringes independent claim 31.

Respondent OurPet's Position: OurPet's asserts that SmartScoop does not infringe claim 32, because it depends on claim 31. (OIB at 46.)

Commission Investigative Staff's Position: Staff set forth its position regarding claim 32 in its argument on claim 31. That position will, therefore, not be repeated here. The Argument by Staff related to claim 31 is by this reference incorporated into the in this section regarding claim 32. (SIB at 44-45.)

Discussion and Conclusion:

Because I have found that the SmartScoop products do not infringe independent claim 31, it follows that they do not infringe claim 32, which depends from claim 31. *Wahpeton*, 870 F.2d at 1552 n. 9.

8. Claim 33

Claim 33 recites:

A self-cleaning cat litter box comprising:

a pan-shaped housing defining an upwardly open litter chamber to be filled to a given fill level with cat litter;

a comb drive coupled to the housing;

a comb extending between two opposed sidewalls and being coupled to the comb drive and movable between a storage position and a discharge position, the comb projecting down into the litter chamber to a level below the fill level so that the comb engages clumps in the litter and moves such clumps toward the discharge position; and

a mode selector switch operatively connected to said comb drive, the switch being movable between a manual operation position wherein an operator causes the comb to move toward the discharge position and an automatic operation position

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wherein the comb moves toward the discharge position automatically upon the occurrence of a predetermined event.

Complainants' Position: Complainants argue that the SmartScoop products have a “mode selector switch” that is “moveable between” manual and automatic positions as required by claim 33. (AIB at 68 (citing JX-19C at 192:25-193:5; RX-231 at ¶¶ 18, 19; RX-140; Tr. at 889:1-15; CX-137 at 11; JX-8C at 37:14-25, 38:1-6, 57:10-58:2, 59:20-61:4, 62:6-12, 88:2-9, 89:21-90:3, 179:5-20; JX-9C at 148:7-13, 179:17-24; JX-18C at 153:20-24; CDX-75; CX-893C at ¶¶ 806-807, 813-818; CDX-75).) They refer to their argument regarding the “mode selector means” element of claim 27, and reiterate that the SmartScoop has a switch, a manual operation mode where an operator manually activates a cleaning cycle by pushing the switch, and an automatic operation mode where the rake operates in response to a cat-based input plus a time delay. (AIB at 68 (citing JX-9C at 148:7-13; JX-8C at 37:14-25, 57:10-58:2, 59:20-61:4, 62:6-12, 88:2-9, 89:21-90:3, 179:5-20).)

Complainants' argument on this point is virtually identical to their argument on the issue of “mode selector means,” to wit: “The switch in the SmartScoop Product is ‘moveable between’ a ‘manual operation position’ and an ‘automatic operation position.’” (AIB at 68 (citing JX-19C at 125:15-126:1, 153:15-154:9, 154:22-155:2, 155:4-20, 177:7-14, 179:17-21, 179:23-5 [*sic*], 182:4-8, 190:11-22, 192:7-193:5; CX-911; CX-280C; JX-18C at 257:22-259:15; JX-8C at 57:10-58:2, 59:20-61:4, 62:6-12, 177:22-178:11; CX-137).) “After the SmartScoop Product is powered on, much like the ScoopFree Product, the SmartScoop Product is in automatic operation mode where it will actuate the comb to rake through the litter in response to cat entry and exit plus a time delay.” (*Id.* (citing Tr. at 991:18-992:7; JX-10C at 155:23-156:7, 157:20-158:3; JX-9C at 148:7-13, 179:17-24; JX-19C at 103:16-104:4).) “At that point, the

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switch is in the up or open position.” (*Id.* (citing JX-19C at 192:25-193:5).) “This is an ‘automatic operation position.’” (*Id.* (citing JX-8C at 37:14-25, 88:2-9, 89:21-90:3).)

“The switch can then be moved from the automatic operation position to a manual operation position by pushing it down twice.” (AIB at 68 (citing JX-19C at 179:17-21, 179:23-5 [*sic*]).) “When the switch is pushed the second time, a single comb litter operation is manually initiated.” (*Id.* (citing JX-10C at 155:23-156:7; JX-11C at 33:23-34:2; CX-136C; JX-19C at 75:23-76:8, 76:14-20, 125:15-126:1, 179:17-21, 179:23-5 [*sic*]; JX-8C at 59:20-61:4, 62:6-12, 177:22-178:11; CX 137; Tr. at 1083:21-1084:9; CX-136C).) “The switch must be moved to the down or closed position to initiate a manual comb litter operation, much like the push button in Mr. Waters’ prototype.” (*Id.* (citing CX-894C at ¶¶ 57-59, 89-90, 93-94; Tr. at 568:14-24; JX-1 at Figs. 1-3; Tr. at 463:24-464:4; CDX-64; CX-893C at ¶¶ 695-696; CPX-40 at 11; CPX-33-CPX-49).) “The position of the switch in the down position when the manual comb litter operation is initiated is a ‘manual operation position.’” (*Id.* (citing JX-10C at 155:23-156:7; JX-11C at 33:23-34:2; CX-136C; JX-19C at 75:23-76:8, 76:14-20, 125:15-126:1, 179:17-21, 179:23-5 [*sic*]; JX-8C at 59:20-61:4, 62:6-12, 177:22-178:11; CX 137; Tr. at 1083:21-1084:9; CX-136C).)

Thus, they argue, the SmartScoop switch is “moveable between” manual and automatic positions. (*Id.*) “Whenever the SmartScoop product is in automatic operation mode and the switch is up, the switch can be moved between an automatic operation position and a manual operation position by pushing it down twice to initiate manual operation.” (*Id.* at 69 (citing JX-19C at 179:17-21, 179:23-5 [*sic*]).) “That is all the ‘switch being moveable between’ language of Claim 33 literally requires.” (*Id.*)

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In their reply brief, Complainants point to the testimony of their expert Dr. Wood “that there are insubstantial differences between the SmartScoop Products and the ‘mode selector switch’ of Claim 33.” (ARB at 25 (citing CX-893C at ¶¶ 813-818).) They argue that Dr. Wood also testified that the SmartScoop performs the same function (“selecting between a manual operation mode and an automatic operation mode”) in substantially the same way (using a switch that provides a signal to control logic), to achieve the same result (cleaning in response to human based input or a cat-based input). (*Id.*)

Complainants reiterate that the SmartScoop switch is not an on/off switch and even if it were, it would not change the fact that it is “moveable between” manual and automatic operation positions. (*Id.* at 24 (citing Tr. at 933:1-5, 936:19-25).) Complainants again cite *Overhead Door*, 194 F.3d at 1273-74, to support their argument that a push-button switch is a “switch moveable between” two positions. (*Id.*)

Respondent OurPet’s Position: OurPet’s argues that the SmartScoop does not possess “a mode selector switch operatively connected to said comb drive, the switch being moveable between a manual operation position wherein an operator causes the comb to move toward the discharge position and an automatic operation position wherein the comb moves toward the discharge position automatically upon the occurrence of a predetermined event.” They assert that the correct construction of the claim phrase is “a mode selector switch operatively connected to said comb drive, the switch being moveable between switch position for self-cleaning of the litter box continued on a cyclical basis position wherein an operator causes the comb to move toward the comb position near the wall that is adjacent to the waste receptacle and switch position for delayed cleaning upon the exit of a cat wherein the comb moves toward the comb position near the wall that is adjacent to the waste receptacle automatically upon the occurrence

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of a predetermined event,” and they quote Complainants’ expert Dr. Wood as saying, “[t]he description above adequately conveys to a person of ordinary skill in the art a manual operation position, and automatic operation and a mode selector switch that is movable between automatic operation and manual operation positions.” (OIB at 50-51 (citing Tr. at 238:25-239:13, 288:22-290:3, 302:15-303:4; “287:16-280:3”[sic]; RX-231 at ¶ 32).)

OurPet’s continues their argument on this point with one that is identical to their argument for “mode selector means,” to wit: “if the ‘on’ position is considered to correspond to the ‘automatic operation mode,’ then it is not possible for the ‘off’ position to correspond to a ‘manual operation mode’ and visa versa.” (OIB at 52.) OurPet’s argues that, using the Complainants’ rationale, the “on” position would have to correspond to both the “manual operation mode” and the “automatic operation mode” and assert that it is not possible to “select between” two distinct modes with the SmartScoop switch. (*Id.* at 51-52.)

Similarly, in its reply brief, OurPet’s puts forth the argument that a user of SmartScoop cannot use the power button to select between different modes, because “... the very phrase ‘selecting between’ different modes requires that there be more than one mode to select from.” (ORB at 52 (emphasis in original).) They assert that the SmartScoop only has a single mode of operation, which is “on.” (*Id.*) They say there is no other mode, so it is not possible to select between modes. (*Id.* (citing RX-231 at ¶ 28).)

OurPet’s argument regarding the inapplicability the doctrine of equivalents to the SmartScoop product’s “on/off” switch is identical to its argument concerning claim 31, and it will not be repeated here. That argument is by this reference incorporated into the argument regarding this claim 33.

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OurPet's argues, again, that even if the initial cleaning cycle of the SmartScoop could be construed as "manual," it is not "cyclical" and therefore not a "manual operation mode" as required by the claim. (OIB at 52.)

Commission Investigative Staff's Position: Staff argues that the evidence does not show that claim 33 reads on the SmartScoop, because it lacks "a 'mode selector switch' that is *moveable* between a manual operation *position* and an automatic operation *position*. The plain language of the claim requires a switch that moves between two positions." (SIB at 48 (emphasis in original).)

Staff argues that the evidence does not show that the power button on the SmartScoop is moveable between a manual operation position and an automatic operation position. (*Id.* (citing Tr. at 290, 292-93).)

Staff argues, too, that "Complainants' doctrine of equivalents analysis is likewise flawed because it fails to address the claim element as written. Instead, Complainants' expert changes the purpose of the claim element from a switch having 'positions' to a switch having 'modes' of operation. CX-893C (Wood Q.812). The expert's doctrine of equivalents analysis then addresses this non-existent claim term and completely omits any discussion of different positions for the accused switch. CX-893C (Wood Q.813-Q818)." (SIB at 48.) Staff asserts that the patentee stressed to the USPTO that the switch of claim 33 was "moveable." (*Id.* at 49.) Staff argues that the Complainants have now abandoned that reasoning. (*Id.*)

Discussion and Conclusion: I find that the evidence supports the conclusion that the accused SmartScoop possesses a "mode selector switch...being moveable between... a manual operation position ... and an automatic operation position" as taught in element 4 of claim 33. This is the sole disputed issue related to infringement by SmartScoop of claim 33.

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I construed “mode selector switch” as “a switch that is operatively connected to the comb drive and is moveable between the manual and automatic operation positions.” I found that the intrinsic evidence did not require limiting the “mode selector switch” to a switch with two stationary positions. In *Overhead Door*, 194 F.3d at 1273-74, the court found that a momentary switch meets the claim limitation “a switch moveable between program and operate positions.”

The button on the SmartScoop called the “power” switch is a “mode selector switch” under my construction. It is undisputed that the power button is operatively connected to the comb drive. The evidence establishes that the accused SmartScoop product has a switch and a microprocessor programmed to perform a manual cleaning cycle when the switch is pressed while the unit is in a waiting mode. In his deposition, Mr. Jason Kocher testified that he was the one hired to design the initial prototype of the SmartScoop. (JX-19C at 9:19-10:01.) He testified that he created a prototype in which the littler box could be reset by cycling the power on and off, and that was coded to begin a cycle every time it was turned on. (*Id.* at 54:18-24.) Mr. Kocher testified that the box was designed with a PIC microcontroller. (*Id.* at 59:10-12.) He testified extensively regarding the workings of the microcontroller and switch of the accused SmartScoop, indicating that the switch labeled “power” does not actually gate power to the box. Rather, when the switch is pressed “the unit proceeded to tell the motor to go in a forward direction relative to the shape of the box.” (JX-19C at 90:02-06, 75:23-76:06.) He testified that once the unit has gone through a cleaning cycle, the microcontroller goes into “a portion of the polling loop where it is trying to figure out if there is a cat in the box via the *infrared* sensory system.” (*Id.*) If the IR sensors detect an object in the box, there is a long pause, on the order of 10 or 15 minutes, after which the unit will move forward and perform its cleaning action and return home. (*Id.* at 125:08-14, 103:16-105:03.) At that point if a user wants to cycle the rake,

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the easiest way to do it is to press the power switch once and then press it again and it will run one more cycle. (*Id.* at 125:21-126:01.)

Thus the so-called “power” switch when pressed a first time causes the SmartScoop to go into a manual operation mode in which a cleaning cycle occurs in response to the human input of pressing the momentary switch. Immediately upon completing the connection calling for a manual cleaning cycle, the switch returns to its “up” position and allows the SmartScoop processor to assume an automatic operating mode, in which it waits for an IR sensor to inform it that a cat has exited the litter box. At that point the SmartScoop automatically initiates a delay of 10 to 15 minutes, after which the automatic cleaning cycle is initiated. Once the SmartScoop is in automatic operation mode, in order to place it back into a manual operation mode, one need only press the switch twice – first, to put it into its “waiting” mode, and second to put it into a manual operation mode as described, *supra*.

I find that the SmartScoop product infringes claim 33, because it possesses a switch that is moveable between a manual operation position and an automatic operation position as taught by element 4 of claim 33. Therefore, the SmartScoop infringes the ‘847 patent.

9. Inducement

Section 271(b) of the Patent Act prohibits inducement: “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” 35 U.S.C. § 271(b) (2008). As the Federal Circuit stated:

To establish liability under section 271(b), a patent holder must prove that once the defendants knew of the patent, they “actively and knowingly aid[ed] and abett[ed] another’s direct infringement.” However, “knowledge of the acts alleged to constitute infringement” is not enough. The “mere knowledge of possible infringement by others does not amount to inducement; specific intent and action to induce infringement must be proven.”

DSU, 471 F.3d at 1305 (citations omitted).

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Complainants' Position: Complainants allege that respondent OurPet's induces infringement. They assert that "[w]ith full knowledge of the Waters '847 Patent and its relevance to the SmartScoop Products, OurPet's induced infringement by: 1) selling products, the SmartScoop self-cleaning litter box and waste bags and carbon filters, that infringe the Waters '847 Patent when used; and 2) providing instructions in its user guide which, when followed, result in an infringement of the Waters '847 Patent." (AIB at 74.) They assert, too, that OurPet's induces infringement by selling replacement "No-Touch" waste bags and carbon filters, because they are designed and intended for end-users to continue using the infringing SmartScoop self-cleaning litter box. (*Id.* at 74-75.) Finally, Complainants argue that OurPet's induces infringement of the Waters '847 patent by providing instructions to end-users which, when followed, result in direct infringement by the end-user, because the instructions inform the user how to assemble and operate the SmartScoop litter box. (*Id.* at 75-76.) They say that the foregoing actions show that "Lucky Litter" [*sic*] has engaged in affirmative acts with the requisite intent and is liable for inducing infringement. (*Id.* at 76 (citing *Golden Blount, Inc. v. Peterson Co.*, 438 F.3d 1354, 1362-1363 (Fed. Cir. 2006); *Moleculon Research Corp. v. CBS, Inc.* 793 F.2d 1261, 1272 (Fed. Cir. 2005)).)

Complainants argue that the fact that OurPet's knew of the existence of the '847 patent, "tore apart and examined LitterMaid® products throughout the development process...shipped LitterMaid® units to its China manufacturer...and failed to rely on competent opinion of counsel concerning the potential for infringement of the '847 Patent," all leads to the conclusion that OurPet's knew or should have known of its infringement of the '847 patent. (ARB at 30-31 (citing JX-9C at 205:3-10; JX-11C at 70:18-23, 84:8-17, 87:1-11, 103:23-104:8, 105:20-106:1, 106:10-16; JX-10C at 31:12-21, 33:9-13, 190:13-19, 191:7-21; 192:14-193:7; JX-8C at 98:17-

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25, 99:1-8, 124:7-125:6; JX-14C at 57:10-58:3; JX-18C at 224:2-10; CX-128C; CX-178C; CX-177C; Tr. at 1072:25-1073:25, 1254:15-1258:6; CX-934C at ¶ 414.)

Respondents OurPet's Position: OurPet's argues that because Complainants have failed to prove direct infringement, there can be no inducement of infringement on OurPet's part. (ORB at 55.) They argue, too, that specific intent is required to prove inducement, which in turn requires a "showing that the alleged infringer's actions induced infringing acts and that he knew or should have known his actions would induce actual infringements." (*Id.* (quoting *DSU*, 471 F.3d at 1304).) OurPet's argues that the requisite specific intent has not been proven. (*Id.* at 55-56.)

OurPet's admits that it was aware of the '847 patent; but they assert that they "designed around the patent." (*Id.* at 55.) They point to numerous differences between the SmartScoop product and the '847 patent and the LitterMaid® product. (*Id.* at 55-56.)

Commission Investigative Staff's Position: Staff argues that Complainants have failed to cite any evidence showing an intent to infringe the '847 patent. They argue that "the intent requirement for inducement requires more than just intent to cause the acts that produce direct infringement." (SRB at 19 (quoting *DSU*, 471 F.3d at 1306).) Staff asserts that "[n]otwithstanding this high burden, Complainants only discuss the acts that allegedly produce direct infringement ..." and they say that this evidence "is insufficient as a matter of law to show induced infringement." (*Id.*)

Discussion and Conclusion: I find that the evidence does not support a finding that Respondent OurPet's is liable for inducement under 35 U.S.C. § 271(b).

In *DSU*, the Federal Circuit sat *en banc* to clarify the specific intent requirement necessary to prove inducement. The Federal Circuit held that "[t]he plaintiff has the burden of

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showing that the alleged infringer's actions induced infringing acts and that he knew or should have known his actions would induce actual infringements." *DSU*, 471 F.3d at 1304.

In discussing the requisite specific intent, the court elaborated:

To establish liability under section 271(b), a patent holder must prove that once the defendants knew of the patent, they "actively and knowingly aid[ed] and abett[ed] another's direct infringement." However, "knowledge of the acts alleged to constitute infringement" is not enough. The "mere knowledge of possible infringement by others does not amount to inducement; specific intent and action to induce infringement must be proven."

Id. at 1305 (citations omitted).

The Court more recently reiterated its sound position on this point when it said:

In *DSU Med. Corp. v. JMS Co.*, this court clarified en banc that the specific intent necessary to induce infringement "requires more than just intent to cause the acts that produce direct infringement. Beyond that threshold knowledge, the inducer must have an affirmative intent to cause direct infringement."

Kyocera Wireless Corp. v. Int'l Trade Comm'n, --- F.3d ----, 2008 WL 4553140 (Fed. Cir. Oct. 14, 2008) (citation omitted).

After a review of the evidence submitted by Complainants, I find that Complainants have not met their burden to demonstrate the specific intent needed to find inducement. Although OurPet's knew of the '847 patent when they developed the SmartScoop product, and they examined in detail the LitterMaid® product, the evidence supports a conclusion that OurPet's object was to "design around" the '847 patent and the LitterMaid® product rather than to "copy" it.

While their marketing efforts may have resulted in users infringing the '847 patent, there is no evidence in the record to prove that they had the specific intent to induce infringement. The evidence cited by Complainants shows no more than the fact that OurPet's caused users to

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assemble and use the SmartScoop product and its accessories – not that they knowingly induced users to infringe the '847 patent.

VI. UNENFORCEABILITY

A. Applicable Law

“Applicants for patents have a duty to prosecute patent applications in the Patent Office with candor, good faith, and honesty. A breach of this duty...constitutes inequitable conduct.” *Honeywell Int'l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 999 (Fed. Cir. 2007) (citations omitted). In order to prove inequitable conduct, a party must establish that the patent applicant “(1) made an affirmative misrepresentation of material fact, failed to disclose material information, or submitted false material information, and (2) intended to deceive the U.S. Patent and Trademark Office (‘PTO’).” *Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359, 1363 (Fed. Cir. 2007). “Both elements of a conclusion of inequitable conduct, intent and materiality, are questions of fact and must be proven by clear and convincing evidence.” *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1345 (Fed. Cir. 2007). Once threshold levels of materiality and intent are met, a court must weigh the facts and determine whether the applicant’s actions amounted to inequitable conduct:

The nondisclosure or misrepresentation must meet threshold levels of both materiality and intent. Once the threshold levels of materiality and intent have been established, the trial court must weigh materiality and intent to determine whether the equities warrant a conclusion that inequitable conduct occurred. The more material the information misrepresented or withheld by the applicant, the less evidence of intent will be required in order to find inequitable conduct.

Honeywell, 488 F.3d at 999 (citations omitted); *see also Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (“[E]ven if a threshold level of both materiality and intent to deceive are proven by clear and convincing evidence, the court may still decline to render the patent unenforceable.”)

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“Information is ‘material’ when there is a substantial likelihood that a reasonable examiner would have considered the information important in deciding whether to allow the application to issue as a patent.” *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1179 (Fed. Cir. 1995). A patent applicant, however, has no obligation to disclose a reference that is cumulative or less pertinent than those already before the examiner. *Id.*

“[T]he accused infringer must prove...that the material information was withheld with the specific intent to deceive the PTO.” *Star Scientific, Inc.*, 557 F.3d at 1366. Intent need not be proven by direct evidence. *Bruno Indep. Living Aids, Inc. v. Acorn Mobility Servs., Ltd.*, 394 F.3d 1348, 1354 (Fed. Cir. 2005). “Rather, in the absence of a credible explanation, intent to deceive is generally inferred from the facts and circumstances surrounding a knowing failure to disclose material information.” *Id.*

B. Positions of the Parties

Respondent Lucky Litter’s Position: Lucky Litter argues that Applica took inconsistent positions before two different examiners during the reissue prosecution of the ‘847 patent and the prosecution of U.S. Pat. No. 6,082,302 (“the ‘302 patent”). (LIB at 52-53.) Lucky Litter claims that Applica intentionally withheld information from each examiner in order to convince the examiner in each case to allow the respective claims. (*Id.* at 53.)

Lucky Litter claims that Applica’s failure to notify the examiner of the ‘302 patent prosecution alone was inequitable conduct. (*Id.* at 55 (citing JX-2).) Lucky Litter further contends that Applica made statements during the ‘302 patent prosecution characterizing the ‘847 patent specification.²⁰ Specifically, Lucky Litter argues that Applica stated during the ‘302 patent prosecution that the ‘847 patent specification does not disclose operating in response to

²⁰ The statements made during the ‘302 patent prosecution relate to the specification of U.S. Pat. No. 5,477,812 (“the ‘812 patent”), which was later reissued as the ‘847 patent. The specifications and drawings of the ‘812 patent and ‘847 patent are identical.

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human intervention, i.e. manual operation. (*Id.* at 56 (citing JX-7; JX-1).) Lucky Litter focuses on the following passage from the '302 patent prosecution:

The Examiner has previously allowed Claims 10 through 12. Claims 13 through 16 stand objected under 35 U.S.C. 103(a) as being unpatentable over Waters. **Unlike the prior art automated litter box disclosed in the Waters patent, the present Applicants have recognized that a mechanically-operated litter box should be both automated and capable of operation in response to human intervention.** Applicants have recognized that, at times, it is undesirable for the litter box to remove cat waste automatically after a predetermined period after the cat has left the litter box. For example, during sleeping hours the automatic operation of the cat litter box may interrupt sleep. It may be more desirable to maintain the litter box in an off state and then allow a human to mechanically commence operation of the litter box upon awakening or at such other times as the human so desires.

(JX-7 at PTO 000399 (emphasis added).)

Lucky Litter argues that this statement is inconsistent with the reissue proceedings, as Applica sought coverage of a litter box that included a manual operation mode, i.e. a mode where combing is initiated in response to human intervention. (LIB at 55-57.) According to Lucky Litter, this is directly contrary to Applica's statement in the '302 patent prosecution that the '847 patent specification does not disclose manual operation. (*Id.*) Lucky Litter also cites to the testimony of Arnold Thaler, former Executive Vice President of Applica, where Mr. Thaler agrees with Lucky Litter's counsel that the '812 patent does not disclose a manual cleaning mode. (LRB at 46 (citing JX-24C at 183:13-22).)

Lucky Litter argues that Applica's failure to disclose the '302 patent prosecution to the examiner, especially the statements made regarding the specification of the '847 patent, was a material omission because they would have affected the examiner's decision on whether to allow the reissue claims which include manual operation. (LIB at 57-59.) Lucky Litter cites to the USPTO regulations on the duty of disclosure, claiming that any information that is inconsistent

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with a position that an applicant takes in asserting an argument of patentability is material. (LRB at 40 (citing 37 C.F.R. § 1.56).)

Lucky Litter further claims that Applica intended to deceive the USPTO. Using the testimony of Applica's Executive Vice President Arnold Thaler, Lucky Litter argues that it can be inferred that Applica was trying to gain coverage of a litter box that allowed for manual operation. (LIB at 60-61 (citing JX-24C at 106:5-17, 127:22-128:3, 132:20-133:1, 183:13-22, 209:15-210:2; RX-4 at Fig. 22).) Thus, according to Lucky Litter, Applica filed both the application that lead to the '302 patent and sought to reissue the '812 patent in an attempt to ensure that it obtained coverage of manual operation. (*Id.*) As stated by Lucky Litter:

Thus, after the '847 reissue application and the '302 application had been assigned to different examiners, Applica was placed in a position where it could play both of its hands. It could try to obtain claims in the '847 patent reissue application that were broad enough to cover manual operation, and if that did not succeed, it could try to obtain such coverage in its '302 application.

(*Id.* at 61.)

Respondent OurPet's Position: OurPet's agrees with and adopts Lucky Litter's inequitable conduct argument. (OIB at 25; ORB at 25.)

Complainants' Position: Complainants argue that Respondents have failed to prove inequitable conduct. Specifically, Complainants argue that the failure to inform the examiner during the reissue proceeding about the statements made during the '302 patent prosecution was not a material omission. (WIB at 20-30.) Complainants argue that there was no intent to deceive the USPTO. (*Id.* at 31.)

Complainants present multiple arguments as to why the omission was not material. First, Complainants argue that WRC prosecuted the '847 patent while Applica prosecuted the '302 patent. Complainants point to 37 C.F.R. §1.56, which states that "information is material to

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patentability when...[i]t refutes, or is inconsistent with, a position the applicant takes...” As Complainants explain, “because there is no overlap in applicants, no ‘applicant’ could have taken an inconsistent position in connection with these two separate patent proceedings.” (WIB at 20 (citing CX-894C at ¶¶ 233-34; CX-592C at 20; CX-839C at 1; CX-897C at ¶¶ 15-18, 43-44, 69).)

Second, Complainants argue that the statements made in the ‘302 patent prosecution were consistent. Complainants accuse Respondents of taking statements from the ‘302 patent prosecution out of context. (*Id.* at 20-21.) Complainants claim that if the entire prosecution argument is examined, it becomes clear that Applica distinguished the ‘302 patent over the ‘812 patent due to the additional manual operation switch that is included in the ‘302 patent and missing from the ‘812 patent. (*Id.* at 24 (citing JX-7 at 114-116, 127-133).)

Third, Complainants argue that, as a matter of law, arguments made during the prosecution of a later unrelated patent application have no effect on the claim scope of an earlier patent application. (*Id.* at 26 (citing JX-2 at 1; JX-7 at 17-43, 175-201).) Because the ‘847 patent and the ‘302 patent are not related, Complainants assert that the statements made during the prosecution of the ‘302 patent cannot be material to the patentability of the claims in the ‘847 patent. Complainants rely heavily on the Federal Circuit’s decision in *Pfizer, Inc. v. Ranbaxy Labs Ltd.*, 457 F.3d 1284 (Fed. Cir. 2006) to support their argument.

Fourth, Complainants argue that the characterization of the ‘847 patent specification made during the ‘302 patent prosecution cannot constitute a mischaracterization because the examiner in the ‘847 prosecution had the ‘847 patent specification in front of him. (WIB at 30.) Complainants argue that attorney argument cannot change what the actual ‘847 patent specification discloses. (*Id.*) Complainants claim that the USPTO was correct in allowing

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claims covering manual operation, as the '847 patent specification discloses manual operation.

(*Id.* at 28-29.)

Complainants argue that Respondents have presented no evidence of an intent to deceive the USPTO. (*Id.* at 31.) Complainants characterize Respondents' intent theory as "inferential and improperly speculative." (*Id.*) Complainants further claim that Respondents rely solely on attorney argument to prove intent. (WRB at 26.)

Commission Investigative Staff's Position: Staff states that "[although the evidence is exceptionally close on the question of inequitable conduct, the Staff does not believe that the evidence shows that the asserted '847 patent is unenforceable due to inequitable conduct." (SIB at 51.) Staff argues that the examiner reviewing the reissue proceeding would not have changed course based on Applica's statements from the '302 patent prosecution. (*Id.* at 52.) Staff asserts that it is more likely that the '302 patent prosecution would have been affected had Applica fully disclosed its statements to each of the examiners. (*Id.*)

C. Discussion and Conclusion

I find that Complainants did not commit inequitable conduct, and thus the '847 patent is enforceable.

The basis for Respondents' argument is that Complainants failed to inform the examiner working on the reissue prosecution of statements made during the prosecution of the '302 patent. Respondents claim that those statements were inconsistent with the positions argued in the reissue proceedings. I find that the Respondents have not presented clear and convincing evidence that such statements were actually inconsistent.

The statements in the '302 patent prosecution to which Respondents refer were made by Applica in responding to an Office Action. The examiner rejected claims 13-16 of the

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application that lead to the '302 patent as obvious in light of the '812 patent (referred to as "Waters" in the prosecution). In attempting to overcome the rejection, Applica argued:

The Examiner has previously allowed Claims 10 through 12. Claims 13 through 16 stand objected under 35 U.S.C. 103(a) as being unpatentable over Waters. Unlike the prior art automated litter box disclosed in the Waters patent, the present Applicants have recognized that a mechanically-operated litter box should be both automated and capable of operation in response to human intervention. Applicants have recognized that, at times, it is undesirable for the litter box to remove cat waste automatically after a predetermined period after the cat has left the litter box. For example, during sleeping hours the automatic operation of the cat litter box may interrupt sleep. It may be more desirable to maintain the litter box in an off state and then allow a human to mechanically commence operation of the litter box upon awakening or at such other times as the human so desires.

Independent Claim 13 discloses a mode selector switch having a manual operation selecting position and an automatic operation selecting position. When the mode selector switch is in the manual operation selecting position, a manual operation switch is electrically connected to the mode selector switch whereby the comb drive moves the comb in response to actuation of the manual operation switch. These specific elements are neither taught nor suggested by the cited art.

Absent a specific suggestion in the prior art that, as in this case, an automated cat litter box should include a mode selector switch having a manual mode of operation and a second switch to enable human intervention for manual operation of the litter box, the Examiner has essentially undertaken a retrospective view of inherency in the teachings of the Waters reference. "[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989)." The Examiner in rendering a rejection under 35 U.S.C. 103 is required to cast his mind back to the time the invention was made to consider the thinking of one of ordinary skill in the art guided only by the prior art references and the then accepted wisdom in the field. It is especially important when the technology is not complex and may easily be understood that the methodology of requiring some prior art teaching be cited by the Examiner; otherwise, the Examiner has fallen victim to the insidious effect of a hindsight reconstruction of the invention where the inventors' disclosure is used against the inventors. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). In the absence of a specific showing of the manual activation switch in combination with a mode selector switch having a manual position, it is respectfully submitted that Claim 13, as originally presented, is patentably distinct over the cited prior art.

(JX-7 at PTO 000399-400.)

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From a review of the full passage, I find that Applica's argument centered on distinguishing claims 13-16 based on the two switches disclosed in the claims – the mode selector switch and the manual operation switch. Pending claim 13 included a “mode selector switch” similar to the “mode selector switch” found in claim 33 of the '847 patent. But claim 13 also included a “manual operation switch.” According to the claim language, an operator would need to actuate the “manual operation switch” when the “mode selector switch” was in the manual operation position in order to manually drive the comb. (JX-7 at PTO 000306.) Figure 22 of the '302 patent depicts the two switches:

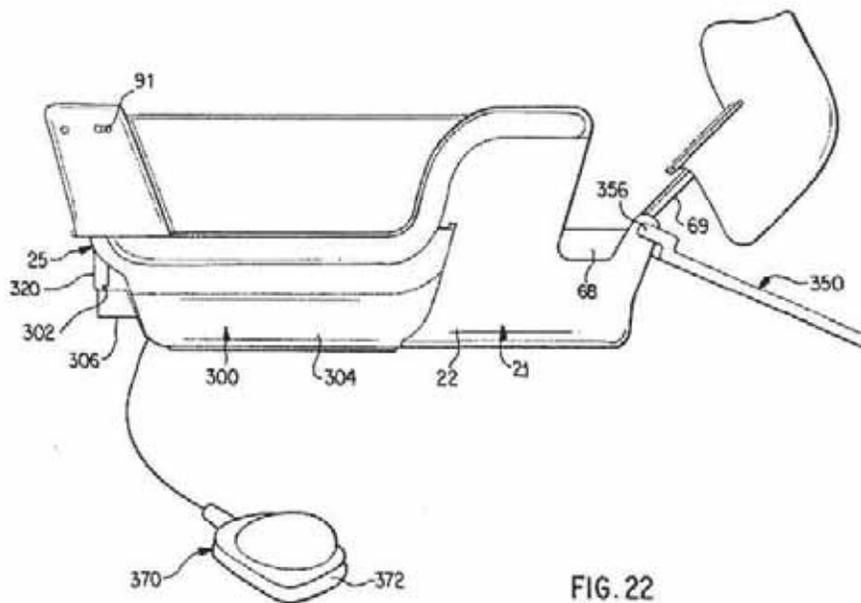


FIG. 22

(RX-4 at Fig. 22.) In this figure, the “mode selector switch” is labeled 91, and the “manual operation switch” is labeled 370. The shared specification of the '812 patent and '847 patent discloses the use of only a single switch, mode select switch 91. (See JX-1 at 7:14-29.)

I find that Applica distinguished the '812 patent not on the basis of it failing to disclose a manual operation mode, but on the basis of it only disclosing one switch. Claims 13-16 of the '302 patent disclosed two switches, the second switch being devoted to initiating the manual operation mode. Because I do not find that Applica's statements during the '302 patent

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prosecution were inconsistent with the '847 patent specification or claims, I do not find that Complainants' failure to disclose such statements to the examiner was a material omission that would have affected the examiner's patentability determination.

Further, I find that even if the statements from the '302 patent prosecution were found to be inconsistent with the positions taken in the '847 patent prosecution, the failure to raise such statements would not be a material omission. Certain claims added during the reissue, such as claims 27 and 33, cover manual operation. These claims must have found support in the original specification for the examiner to allow them. *See TurboCare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) ("When the applicant adds a claim...after the original filing date...the new claims...must find support in the original specification.")

These claims are in fact supported by the specification, which discloses manual operation. (JX-1 at 7:14-44, Fig. 7; JX-3 at 7:12-27, Fig. 7.) Applica's attorneys' argument regarding what the '812 patent specification discloses cannot change the fact that the manual mode is disclosed in the specification of the '812 patent. The examiner had the specification in front of him, thus rendering Applica's statements irrelevant and inconsequential.

In addition, I find that Respondents have failed to present clear and convincing evidence of a specific intent to deceive. Respondents focused on the testimony of Arnold Thaler, and argued that Complainants improperly tried to gain coverage of manual operation through the '847 patent when they allegedly knew that the '847 patent did not cover manual operation.

I find that nothing in Mr. Thaler's testimony or any of the other evidence indicates that there was any specific intent on the part of Complainants to deceive the USPTO. Nothing in the evidence leads to the inference that WRC had any improper motives while prosecuting the '847

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patent. As discussed above, WRC was entitled to seek protection for the manual operating mode, and it chose to do so through the reissue. Therefore, Complainants could not have intended to deceive the USPTO when WRC was seeking patent protection for subject matter that it was entitled to under the patent statute.

Because Respondents have met neither the materiality nor intent requirements, they have failed to demonstrate clear and convincing evidence of inequitable conduct.

VII. DOMESTIC INDUSTRY

A. Applicable Law

In patent-based proceedings under section 337, a complainant must establish that an industry “relating to the articles protected by the patent...exists or is in the process of being established” in the United States. 19 U.S.C. § 1337(a)(2) (2008). Under Commission precedent, the domestic industry requirement of Section 337 consists of an “economic prong” and a “technical prong.”

The “economic prong” of the domestic industry requirement is satisfied when it is determined that the economic activities set forth in subsections (A), (B), and/or (C) of subsection 337(a)(3) have taken place or are taking place with respect to articles protected under the asserted patent. *Certain Data Storage Systems and Components Thereof*, Inv. No. 337-TA-471, Initial Determination Granting EMC’s Motion No. 471-8 Relating to the Domestic Industry Requirement’s Economic Prong (unreviewed) at 3 (Public Version, October 25, 2002). With respect to the “economic prong,” 19 U.S.C. § 1337(a)(2) and (3) provide, in full:

(2) Subparagraphs (B), (C), (D), and (E) of paragraph (1) apply only if an industry in the United States, relating to the articles protected by the patent, copyright, trademark, mask work, or design concerned, exists or is in the process of being established.

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(3) For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark, mask work, or design concerned—

- (A) significant investment in plant and equipment;
- (B) significant employment of labor or capital; or
- (C) substantial investment in its exploitation, including engineering, research and development, or licensing.

Given that these criteria are listed in the disjunctive, satisfaction of any one of them will be sufficient to meet the domestic industry requirement. *Certain Integrated Circuit Chipsets and Products Containing Same*, Inv. No. 337-TA-428, Order No 10, Initial Determination (Unreviewed) (May 4, 2000), citing *Certain Variable Speed Wind Turbines and Components Thereof*, Inv. No. 337-TA-376, Commission Op. at 15, USITC Pub. 3003 (Nov. 1996).

To meet the technical prong, the complainant must establish that it practices at least one claim of the asserted patent. *Certain Point of Sale Terminals and Components Thereof*, Inv. No. 337-TA-524, Order No. 40 (April 11, 2005). “The test for satisfying the ‘technical prong’ of the industry requirement is essentially same as that for infringement, i.e., a comparison of domestic products to the asserted claims.” *Alloc v. Int’l Trade Comm’n*, 342 F.3d 1361, 1375 (Fed. Cir. 2003). The technical prong of the domestic industry can be satisfied either literally or under the doctrine of equivalents. *Certain Excimer Laser Systems for Vision Correction Surgery and Components Thereof and Methods for Performing Such Surgery*, Inv. No. 337-TA-419, Order No. 43 (July 30, 1999).

B. Economic Prong

In Order Nos. 28 and 34, I found that Complainants met the economic prong. On August 8, 2008, the Commission issued a notice of decision to review and modify my initial

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determination. The Commission modified Order No. 28 only to include the clarifying order, Order No. 34. Therefore, it is unnecessary to further discuss the economic prong.

C. Technical Prong

Complainants' Position: Complainants assert that Applica's LitterMaid® LM Basic 500 and Elite models practice claims of the '847 patent. Specifically, Complainants allege that the LitterMaid® LM Basic 500 and Elite models practices claims 8, 13, and 14. (AIB at 78-79.) Complainants claim that their assertion is supported by unrebutted expert testimony. (*Id.* at 78.) Complainants also assert that Respondents and Staff have waived the opportunity to oppose Complainants on technical prong because they failed to raise the issue in their pre-hearing statements. (*Id.* (citing Ground Rule 8(f).))

Respondents' Position: Neither Respondent addresses the technical prong in their post-hearing briefs.

Commission Investigative Staff's Position: Staff asserts that "[t]he evidence shows that Applica practices at least claim 8 of the '847 patent." (SIB at 51.) Staff cites to Dr. Wood's testimony to support its assertion. (*Id.*)

Discussion and Conclusion: I find that Complainants satisfy the technical prong of the domestic industry requirement. Complainants have presented detailed expert testimony that LitterMaid® LM Basic 500 and Elite models practice claims 8, 13, and 14 of the '847 patent. (CX-893C at ¶¶ 1112-1174.) Neither Respondents nor Staff attempt to refute or rebut this testimony. Respondents have waived the argument that Complainants do not meet the technical prong because Respondents did not address the issue in their pre-hearing statements or post-hearing briefs. (*See* Ground Rules 8(f), 11.1.) Therefore, I find that the LitterMaid® LM Basic 500 and Elite models practice claims 8, 13, and 14 of the '847 patent.

VIII. REMEDY & BONDING

The Commission's Rules provide that subsequent to an initial determination on the question of violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, the administrative law judge shall issue a recommended determination containing findings of fact and recommendations concerning: (1) the appropriate remedy in the event that the Commission finds a violation of section 337; and (2) the amount of bond to be posted by respondents during Presidential review of Commission action under section 337(j). *See* 19 C.F.R. § 210.42(a)(1)(ii).

A. General Exclusion Order

Complainants seek a general exclusion order that prohibits the importation of all infringing self-cleaning cat litter boxes and components thereof. (AIB at 79-88.)

Under Section 337(d), the Commission may issue either a limited or a general exclusion order. A limited exclusion order instructs the U.S. Customs and Border Protection ("CBP") to exclude from entry all articles that are covered by the patent at issue and that originate from a named respondent in the investigation. A general exclusion order instructs the CBP to exclude from entry all articles that are covered by the patent at issue, without regard to source.

A general exclusion order may issue in cases where (a) a general exclusion from entry of articles is necessary to prevent circumvention of an exclusion order limited to products of named respondents; or (b) there is a widespread pattern of violation of Section 337 and it is difficult to identify the source of infringing products. 19 U.S.C. § 1337(d)(2). The statute essentially codifies Commission practice under *Certain Airless Paint Spray Pumps and Components Thereof*, Inv. No. 337-TA-90, Commission Opinion at 18-19, USITC Pub. 119 (Nov. 1981) ("*Spray Pumps*"). *See* *Certain Neodymium-Iron-Boron Magnets, Magnet Alloys, and Articles Containing the Same*, Inv. No. 337-TA-372 ("*Magnets*"), Commission Opinion on Remedy, the

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Public Interest and Bonding at 5 (USITC Pub. 2964 (1996)) (statutory standards “do not differ significantly” from the standards set forth in *Spray Pumps*).

In *Magnets*, the Commission confirmed that there are two requirements for a general exclusion order: a “widespread pattern of unauthorized use;” and “certain business conditions from which one might reasonably infer that foreign manufacturers other than the respondents to the investigation may attempt to enter the U.S. market with infringing articles.” The Commission went on to state the following factors as relevant to determining whether there is a “widespread pattern of unauthorized use:”

- (1) a Commission determination of unauthorized importation of the infringing article into the United States by numerous foreign manufacturers; or
- (2) the pendency of foreign infringement suits based on foreign patents corresponding to the U.S. patent; [or]
- (3) other evidence which demonstrates a history of unauthorized foreign use of the patented invention.

Magnets, Commission Opinion on Remedy, the Public Interest, and Bonding at 6 (citing *Spray Pumps*).

In addition, the Commission listed the following factors as relevant to showing whether “certain business conditions” – the second *Spray Pumps* factor – exist:

- (1) the existence of an established demand for the article in the U.S. market and conditions of the world market;
- (2) the availability to foreign manufacturers of U.S. marketing and distribution networks;
- (3) the cost for foreign entrepreneurs to build a facility that can produce the patented articles;
- (4) the number of foreign manufacturers whose facilities could be converted to manufacture the patented article; and

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(5) the foreign manufacturers' cost to convert a facility to produce the patented articles.

Id.

1. Widespread Pattern of Unauthorized Use

Complainants assert that the evidence shows a widespread pattern of unauthorized use. They argue that Respondents have sold for importation, imported and/or sold after importation into the United States over 200,000 units of infringing self-cleaning litter boxes and components thereof, with a value of more than \$15,000,000. (AIB at 82 (citing CX-582C at 2; CX-805C; CX-899C; OURP049236).) Complainants say that Respondents and/or their manufacturers sell the infringing self-cleaning litter boxes either over the internet or to hundreds of domestic wholesalers, distributors and/or retailer who then resell the infringing products in the United States. (*Id.* (citing CX-899C at 4-5; CX-748C; CX-382; JX-17C at 97:2-24; JX-12C at 385:11-386:1, 306:15-388:8, 474:12-475:5, 422:12-423:14; CX-265C).) Complainants assert that Respondents also purchase their infringing products from unaffiliated Chinese companies and either directly import the infringing products into the United States for sale and distribution, or their customers purchase and take title of the products directly from the manufacturer and import the units themselves. (*Id.* (citing CX-204 at 5-6; JX-8C at 26:12-22, 27:20-24, 27:9-28:10; JX12C at 438:14-439:16; CX-269C; CX-734C).) Complainants state that Respondents agree that, in addition to the four foreign manufacturers of Respondents' infringing products, there are hundreds, if not thousands, of additional Chinese manufacturers of pet products that can easily and inexpensively convert their production lines to manufacture infringing self-cleaning litter boxes to supply the void that will exist after Respondents' infringing products are removed from the marketplace. (*Id.* (citing JX-12C at 440:21-441:9; CX-896C at ¶¶ 114, 115, 118-19; JX-12C

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at 440:21-443:5; JX-10C at 194:9-21, 195:8-21; CX-179C; CX-324C; CX-325C; CX-326C; CX-328C; CX-330C; CX-239C.)

Complainants point to a foreign infringement suit they have brought in Japan based upon a foreign patent related to the '847 patent – *Waters Research Company v. Kabushiki Kaisha, D.I.N. and Kabushiki Kaisha Japan Youngest*, (Yo) 22020,2000, Tokyo District Court, Japan (settled).

Complainants argue that there is un rebutted evidence of unauthorized foreign use of infringing self-cleaning litter boxes. For example, Respondents sell their infringing products in Canada. (AIB at 83 (citing Tr. at 884:1-6; CX-748C).) Complainants assert that Lucky Litter has determined that a Chinese company named TMC Pet Products Co., Ltd., (“TMC”) was offering a self-cleaning litter box that was “very similar” to Lucky Litter’s ScoopFree self-cleaning litter box. (*Id.* (citing CX-499C at LL0158962, LL0158966).)

Respondents argue that, if infringement is found, the remedy should be a limited exclusion order directed solely at the specific accused litter boxes. (LIB at 62; OIB at 56.) Respondents assert that no evidence was presented at the hearing on the subject of a remedy. (LIB at 62-63; OIB at 56.) They argue that the selected remedy must have a “reasonable relation to the unlawful practices found to exist.” *Hyundai Elecs. Indus. Co. v. United States Int’l Trade Comm’n*, 899 F.2d 1204, 1209 (Fed. Cir. 1990) (quoting *Jacob Siegel Co. v. Fed. Trade Comm’n*, 327 U.S. 608, 613 (1946)). Lucky Litter adds that no limited exclusion order or cease and desist order should apply to the sale of cartridges for Lucky Litter’s LB1 or LB2 litter boxes, as it would interrupt the supply of cartridges to consumers who have purchased Lucky Litter LB1 and LB2 products. (LIB at 63.)

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In their reply briefs, Respondents argue that there are no foreign infringement suits *pending*. The Japanese suit was settled. (LRB at 47; ORB at 62.)

Staff argues that, if a violation of Section 337 is found, a limited exclusion order should issue directed to Respondents' infringing automated litter boxes. Staff argues that a general exclusion order is warranted only in limited circumstances, one of which is a showing of a widespread pattern of unauthorized use of the patented invention. Staff asserts that the evidence and arguments presented by Complainants lacks foundation. (SIB at 52-53.)

Staff asserts that Complainants have failed to show that there is a pattern of violating and that it is difficult to identify the source of infringing goods. There are only two Respondents shown to have violated Complainants' patent rights, and Complainants' assertion of widespread pattern of violation is based on these same two Respondents' importation of infringing goods to infringers in general that is supposed to evidence a more widespread pattern of violation. Since there are only two infringers (i.e. the Respondents) shown, a limited exclusion order directed to the Respondents is adequate. Staff also argues that the evidence does not show that the source of the infringing products is difficult to identify, because self-cleaning litter boxes are not simply commodities that are easily passed through trade channels without identifying the manufacturer. (SRB at 21-22.) Staff offers no evidence in support of this last assertion.

2. Business Conditions

Complainants allege that business conditions exist that will result in foreign companies attempting to enter the U.S. market with infringing self-cleaning litter boxes and components. They assert that there is an existing and increasing demand for infringing self-cleaning litter boxes and components in both the U.S. and world markets. (AIB at 84 (citing CX-895C at ¶¶ 152, 155; CX-896C at ¶¶ 79-82, 84-87, 96, 104, 108, 142-143; JX-12C at 474:12-475:5; CX-

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899C at 4-5; CX-748C; CX-751C).) Complainants say that as of 2006, an estimated 38.4 million households in the United States owned a total of approximately 90.5 million cats, with an average of approximately 2.3 to 2.4 cats per household. (*Id.* (citing CX-758; CX-896C at ¶¶ 89-91, 102, 111; CX-752C; CX-756).) Complainants assert that they and Lucky Litter agree that approximately { } of those U.S. households own a patented self-cleaning litter box. (*Id.* (citing CX-896C at ¶ 113; CX-232C at KF00007).) This percentage, they argue, is increasing and expected to continue to increase, because the number of households that own a litter box is increasing significantly and the patented automatic self-cleaning litter boxes represent a substantial technological advance over previous manual litter boxes. (*Id.* (citing CX-895C at ¶¶ 111, 112, 158; Tr. at 201:14-25; CX-934C at ¶¶ 207-15; CDX-322C; CX-552C; CX-542C; CX-559C; CX-560C; CX-562C; CX-568C; CX-557C; CX-758; CX-756; CX-752C; CX-138C; CX-232C; CX-896C at ¶¶ 89-91, 101-03, 111-13).) As a result, they argue, consumers are demanding and will continue to demand self-cleaning litter boxes in increasing numbers. (*Id.* (citing *Certain Processes for the Manufacture of Skinless Sausage Casings and Resulting Product*, Inv. Nos. 337-TA-148/169, Comm'n Op. at 15 (Dec. 1984) (superior technology of patented article "implies that imports are likely to be infringing"))).

Complainants argue that existing U.S. marketing and distribution networks are readily available to foreign manufacturers and importers, which is further proof that business conditions for foreign entry exist. (AIB at 85 (citing CX-896C at ¶¶ 104-05, 107-08; CX-756; CX-899C; CX-748C; CX-382; JX-17C at 97:2-24; JX-12C at 385:11-386:1, 386:15-388:8, 422:12-423:14, 474:12-475:5; CX-265C).) Complainants say that the distribution networks for self-cleaning litter boxes includes mass merchandisers like Wal-Mart, Target, and K-Mart, pet specialty stores

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such as Petco and Petsmart, drug stores, independent pet dealers, military bases, veterinarians, and the internet. (*Id.* (citing CX-896C at ¶¶ 107, 108).)

Complainants argue that it is relatively inexpensive for foreign companies to convert to manufacturing infringing self-cleaning litter boxes. In light of the robust demand in the United States, foreign entities are likely to retool their facilities at minimal cost (i.e. {

} to produce infringing products. (*Id.* at 86 (citing CX-582C; CX-805C; CX-899C; RX-230; Tr. at 902:1-5; 911:4-5; Daskocil's Answer to Notice of Investigation; CX-895C; CX-896C; CX-751C; CX-758; CX-756; CX-752C; CX-232C; CX-138C; CX-757; CX-748C; JX-17C; JX-12C; CX-265C; CX-118; JX-13C; JX-9C; JX-10C; JX-11C; CX-179C; CX-324C; CX-325C; CX-326C; CX-328C; CX-330C; CX-239C).) They also argue that a profit margin of greater than 100% with low production costs, easily accessible distribution networks, and high demand, makes the manufacture of self-cleaning litter boxes a highly attractive business opportunity. (*Id.* at 87 (citing CX-582C; CX-805C; CX-899C; RX-230; Tr. at 902:1-5; 911:4-5; Daskocil's Answer to Notice of Investigation; CX-895C; CX-896C; CX-751C; CX-758; CX-752C; CX-756; CX-138C; CX-757; CX-748C; CX-382; JX-17C; JX-12C; CX-265C; JX-9C).) In their post-hearing reply briefs, Respondents argue that Complainants' "business conditions" argument "would apply to practically any consumer product business in the United States." (LRB at 48; ORB at 62.)

Staff argues that the business conditions from which one might reasonably infer that foreign manufacturers, other than the named respondents, may attempt to enter the United States with infringing goods are not shown. Staff asserts that the evidence regarding available distribution channels and the ease of manufacturing is insufficient and speculative. (SRB at 20-21.) In its reply brief, Staff states that there is no credible evidence in the record that any

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company has attempted to the market or that there is any threat of new entries into the market. (SRB at 21.) In addition, they argue, the fact that this is the first time that Complainants have attempted to enforce the '847 patent since it was issued in 1995, weighs against the need for a general exclusion order. (*Id.*)

3. Risk of Circumvention

Complainants argue that it would be relatively easy to circumvent a limited exclusion order, because the infringing litter boxes that would be subject to the exclusion order do not identify their manufacturer and thousands of units are already indirectly imported into the United States by customers of the Respondents (i.e. not by Respondents themselves). (AIB at 87 (citing CX-118; CX-805C; JX-13C at 59:23-62:12; CX-340; CPX-4 through CPX-18; CPX-34 through CPX-49; CX-896C at ¶¶ 132-34; CX-499C).) They say that From January 1, 2008 to May 31, 2008, at least 10,620 units of Lucky Litter's self-cleaning litter box were imported indirectly by Lucky Litter's customers and not directly by Lucky Litter. (*Id.* (citing CX-805C).) They argue that those purchases directly from the manufacturer or through other channels would render any limited exclusion order meaningless, because CBP would not have any way to know that such products are Lucky Litter's infringing products. (*Id.*) Complainants argue that the infringing litter boxes could be packaged and sold by Lucky Litter's manufacturer, and point to the incident in which Lucky Litter has already experienced a copy cat version of its litter box being manufactured and sold in China. (*Id.* at 88 (citing CX-499C at LL0158962, LL0158966).)

Respondents did not address this issue in their briefs.

Staff argues that the evidence does not support the existence of available distribution channels or the ease of manufacturing. They assert that the Complainants' positions are based on insufficient and speculative testimony. (SIB at 53 (citing CX-896C at ¶¶ 105-108, 114-129).)

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4. Discussion and Conclusion

The evidence supports a finding that there is a pattern of widespread importation of the infringing products by foreign manufacturers. Respondent Lucky Litter has set up and encouraged a system wherein its customers in the United States order directly from the manufacturers and are supplied by them without involvement by Lucky Litter. Lucky Litter has unaffiliated manufacturers engaged in importation of its infringing products into the United States. Respondents have sold for importation, imported and/or sold after importation into the United States over 200,000 units of infringing self-cleaning litter boxes and components thereof, with a value of more than \$15,000,000. (CX-582C at 2; CX-805C; CX-899C at OURP049236.)

The evidence shows that the offending products do not bear any identifying data showing their manufacturer, making it difficult to trace their origin. No evidence has been introduced that a Chinese manufacturer is licensed under the '847 patent. The evidence supports a finding that there are a large number of Chinese manufacturers with substantial production capacity, which are producing the infringing litter boxes and components, and if they are not currently producing infringing cat litter boxes within the scope of claims in issue, they could easily begin producing such cat litter boxes. Staff offers no evidence to counter Mr. Silvestri's testimony and he is established as the general manager of the pet products division of Applica and is quoting from studies he considers reliable on the subject and his own knowledge. (CX-896C at ¶¶ 105-108, 114-129).

Complainants' reference to the lawsuit in Japan is unhelpful, because it was already settled.

In addition, I find that business conditions exist to promote foreign companies attempting to enter the U.S. market with infringing self-cleaning litter boxes and components. There is an

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existing and increasing demand for infringing self-cleaning litter boxes and components in both the U.S. and world markets. Existing U.S. marketing and distribution networks are readily available to foreign manufacturers and importers. Those distribution networks include mass merchandisers such as Wal-Mart, Target, and K-Mart, pet specialty stores such as Petco and Petsmart, drug stores, independent pet dealers, military bases, veterinarians, and the internet.

Combining the foregoing evidenced widespread infringement with the available distribution networks and the fact that manufacturers are not visibly disclosed on the product, I find that a limited exclusion order would be extremely easy to circumvent and would be rendered meaningless as a result.

Based on all of the foregoing, pursuant to 19 U.S.C. § 1337(d)(2)(A), I find that a general exclusion from entry of articles is necessary to prevent circumvention of an exclusion order limited to products of named Respondents.

Based on all of the foregoing, pursuant to 19 U.S.C. § 1337(d)(2)(B), I find that a general exclusion from entry of articles is necessary, because there is a widespread pattern of unauthorized use within the United States, and it is difficult to identify the source of the infringing products.

It is, therefore, recommended that a general exclusion order be issued in this case.

B. Limited Exclusion Order

A limited exclusion order directed to respondents' infringing products is among the remedies that the Commission may impose. 19 U.S.C. § 1337(d)(1).

Complainants argue that, in addition to a general exclusion order, limited exclusion orders directed at all infringing self-cleaning litter boxes and components thereof that are manufactured by or on behalf of Respondents or any of their affiliated companies, parents,

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subsidiaries, contractors, or other related business entities, or their successors or assigns are appropriate. (AIB at 88 (citing *Rotary Printing Apparatus*, ITC Inv. No. 337-TA-320 (June 24, 1992); Commission Rule § 210.50(c).))

Lucky Litter argues that, if a remedy is required, the appropriate remedy is a limited exclusion order directed solely at the specific litter boxes – Lucky Litter LB1 and LB2 – that were accused in this investigation. (LIB at 62.) Lucky Litter adds that no limited exclusion order should apply to the sale of cartridges for Lucky Litter’s LB1 or LB2 litter boxes, as it would interrupt the supply of cartridges to consumers who have purchased Lucky Litter LB1 and LB2 products. (*Id.* at 63.)

OurPet’s argues that, if a remedy is required, the appropriate remedy is a limited exclusion order directed solely at the specified accused litter box – the OurPet’s SmartScoop product – that was accused in the investigation. (OIB at 55.)

Staff recommends that, if a remedy is needed, only the issuance of a limited exclusion order directed at Respondents’ infringing automated litter boxes is appropriate. (SIB at 52.)

I concur that, if a violation is found and the Commission decides not to issue a general exclusion order, a limited exclusion order should issue. The limited exclusion order should apply to Respondents and all of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns and should be limited to those of Respondents’ products that have been found to infringe the ‘847 patent.

C. Cease & Desist Order

Section 337 provides that in addition to, or in lieu of, the issuance of an exclusion order, the Commission may issue a cease and desist order as a remedy for violation of section 337. *See* 19 U.S.C. § 1337(f)(1). The Commission generally issues a cease and desist order directed to a

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domestic respondent when there is a “commercially significant” amount of infringing, imported product in the United States that could be sold so as to undercut the remedy provided by an exclusion order. See *Certain Crystalline Cefadroxil Monohydrate*, Inv. No. 337-TA-293, USITC Pub. 2391, Comm’n Op. on Remedy, the Public Interest and Bonding at 37-42 (June 1991); *Certain Condensers, Parts Thereof and Products Containing Same, Including Air Conditioners for Automobiles*, Inv. No. 337-TA-334, Comm’n Op. at 26-28 (Aug. 27, 1997).

Complainants argue that Respondents admit that they maintain a domestic inventory of thousands of units of the accused self-cleaning litter boxes and components thereof. (AIB at 88 (citing Tr. at 770:5-7, 769:13-17, 769:18-21, 771:4-10, 894:5-8, 893:24-894:4, 894:9-24, 894:23-24; CX-169C; CX-698C; CX-204).) They argue that a domestic inventory of one infringing product is a “sufficient inventory” for purposes of a cease and desist order. To support this argument, they cite *Hardware Logic*, USITC Pub. 2089, Comm’n Op. at 26 (Mar. 1998). They argue that a cease and desist order should issue prohibiting Respondents and any of their principals, stockholders, officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and/or majority owned business entities, successors, and assigns, and to each of them from selling, distributing, advertising, promoting, marketing, storing, exhibiting, demonstrating, or testing the infringing products in the United States, and from performing any engineering functions, including but not limited to customer assistance and support, in the United States. (AIB at 89.)

Respondents argue that the evidence does not justify the issuance of a cease and desist order, because the evidence has shown that they can avoid infringement by making a software change to eliminate the “manual operation mode” or “manual operation position,” and it would be unfair to impose a cease and desist order on any such inventory, because by the time the

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period for Presidential review had passed, any remaining inventory in the U.S. would be commercially insignificant. (LIB at 63 (citing *Certain EPROM, EPROM Flash Memory, and Flash Microcontroller Semiconductor Devices, and Products Containing Same*, USITC Pub. 3180, Inv. No. 337-TA-395, Comm'n Op. at 85 (Dec. 2000); *Certain Cigarettes and Packaging Thereof*, Inv. No. 337-TA-424, USITC Pub. 3366, Comm'n Op. at 16 (Public Version)(Nov. 2000)); *see also* OIB at 56.)

Lucky Litter adds that no cease and desist order should apply to the sale of cartridges for Lucky Litter's LB1 or LB2 litter boxes, as it would interrupt the supply of cartridges to consumers who have purchased Lucky Litter LB1 and LB2 products. (LIB at 63.)

Staff argues that Respondents OurPet's and Lucky Litter maintain a commercially significant inventory of accused litter boxes. Therefore, a cease and desist order against Respondents appears in order. (SIB at 53 (citing *Certain Agricultural Tractors*, Inv. No. 337-TA-380, Comm'n Op. at 31, USITC Pub. 3026 (March 1997); *Certain Cigarettes*, Inv. No. 337-TA-424, Comm'n Op. at 10, USITC Pub. 3366 (Nov. 2000)).)

The evidence supports a finding that the Respondents maintain a commercially significant inventory of infringing litter boxes and related components. Lucky Litter and OurPet's each maintain an inventory of self-cleaning litter boxes numbering in the thousands. (Tr. at 770:5-7, 769:13-17, 769:18-21, 771:4-10, 894:5-8, 893:24-894:4, 894:9-24, 894:23-24; CX-169C; CX-698C; CX-204.)

The argument that Respondents can avoid infringement by making a software change is based on something that Respondents might or might not do or even be able to do in the future. It is speculative and is given little weight here. The fact is that the Respondents maintain a commercially significant inventory of infringing litter boxes and related components.

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It is recommended that the Commission issue a cease and desist order prohibiting Respondents and any of their principals, stockholders, officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and/or majority owned business entities, successors, and assigns, and to each of them from selling, distributing, advertising, promoting, marketing, storing, exhibiting, demonstrating, or testing the infringing products in the United States, to wit: Lucky Litter LB1 and LB2 and components thereof (including cartridges), and the OurPet's SmartScoop Litter Box (i.e. Smartscoop Litter Box Basic, SmartScoop Litter Box Deluxe, SmartScoop Litter Box Re-Shipper; and SmartScoop Litter Box Canada).

D. Bonding During Presidential Review Period

The Administrative Law Judge and the Commission must determine the amount of bond to be required of a respondent, pursuant to section 19 U.S.C. § 1337(j)(3), during the 60-day Presidential review period following the issuance of permanent relief, in the event that the Commission determines to order a remedy. The purpose of the bond is to protect the complainant from any injury. 19 C.F.R. §§ 210.42(a)(1)(ii), 210.50(a)(3).

When reliable price information is available, the Commission has often set the bond by eliminating the differential between the domestic product and the imported, infringing product. *See Certain Microsphere Adhesives, Processes for Making Same, and Products Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Comm'n Op. a 24 (1995). In other cases, the Commission has turned to alternative approaches, especially when the level of a reasonable royalty rate could be ascertained. *See, e.g., Certain Integrated Circuit Telecommunication Chips and Products Containing Same, Including Dialing Apparatus*, Inv. No. 337-TA-337, Comm'n Op. at 41 (1995). A 100 percent bond has been required when no

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effective alternative existed. *See, e.g., Certain Flash Memory Circuits and Products Containing Same*, Inv. No. 337-TA-382, USITC Pub. No. 3046, Comm'n Op. at 26-27 (July 1997) (a 100% bond imposed when price comparison was not practical because the parties sold products at different levels of commerce, and the proposed royalty rate appeared to be *de minimis* and without adequate support in the record).

Complainants seek a bond of 100%, arguing that it is not possible to usefully determine and compare the imported value of the accused products and the sales price of the domestic industry products, because: (a) there are a wide range of products that practice/infringe the patents-in-suit (LitterMaid® Basic and LitterMaid® Elite, ScoopFree LB1, LB2 (and soon LB3), and the SmartScoop Litter Box Basic, SmartScoop Litter Box Deluxe, SmartScoop Litter Box Re-Shipper; and SmartScoop Litter Box Canada); (b) there are numerous alternative packages of components sold with each self-cleaning litter box that affect the pricing; (c) pricing is determined by the relationship with the customer and the volume of products sold to that customer; and (d) there are a wide range of prices for the products sold (between \$45 and \$199). (AIB at 89 (citing CX-896C at ¶¶ 151, 153-159; Tr. at 397:8-18, 772:2-13, 775:8-12, 776:15-777:1; CX-752C; CX-169C; JX-12C at 478:11-18; CX-805C; CX-748C; JX-9C at 233:25-234:19, 242:4-25, 232:12-17, 236:14-17; CX-204).) Complainants further cite *Certain Neodymium-Iron Boron Magnets*, Inv. No. 337-TA-372, Comm'n Op. on Remedy, the Public Interest, and Bonding, 1996 WL 1056324 (April 30, 1996), which stated, “[i]n cases such as this one, in which it is impossible for the Commission to calculate what level of bond based on price differentials will protect a complainant from any injury, it is appropriate to issue a bond of 100% of entered value.”

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Respondents argue that, in prior investigations, the Commission has set bond amounts based upon various theories to prevent injury to the complainant. Some bases for the bond rate include: (a) an average of the amounts by which the infringing imports undersell the complainants' product, expressed in terms of a percentage of the value of the imported product upon entry; and (b) royalty rates complainant charged or proposed to licensees under the patent-in-suit. (LIB at 64 (citing *Certain Reclosable Plastic Bags and Tubing*, Inv. No. 337-TA-266 (1987)).) Respondents say that, in this case, Complainant Applica has paid Complainant Waters Research Company a net royalty of { } (*Id.* (citing RX-26C).) Lucky Litter argues that the bond should be, at most, set at { } for the sale of complete LB1 and LB2 products. They assert no bond should be applied to the sale of cartridges, because Complainants do not make them and cannot supply them. (*Id.*) OurPet's argues that the bond should be set, at most, at { } for the sale of OurPet's SmartScoop product. (OIB at 57.) OurPet's adds in its reply brief that no bond should be applied to the sale of waste bags, filters, no-stick spray, and litter-catching ramps, because Complainants do not make them and cannot supply them. (ORB at 63.) They cite no evidence in their reply brief to support this contention.

Staff says that the Commission "typically sets the Presidential review period bond based on the price differential between the imported or infringing product, or based on a reasonable royalty." (SIB at 54.) They point out that no evidence on price differentials was presented at the hearing, and argue that Complainants' evidence concerning the difficulty in price comparisons lacks merit. (*Id.* at 55 (citing CX-896C at ¶¶ 151-159).) Staff indicates that { } of Complainants' sales are to { } customers. (*Id.* (citing Tr. at 396-397).) They argue that Complainants' financial data concerning sales price, costs and margins was readily available at the hearing and Complainants' failure to offer price differential evidence was an election by

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Complainants. (*Id.*) Therefore, they assert, the 100% rate should not apply without a strong showing of an inability to make such a comparison. (*Id.* (citing *Certain Rubber Antidegradants*, Inv. No. 337-TA-533, Comm'n Op. at 40 (1006)).)

Staff argues that the bond in this matter should be set at { } They say that the evidence shows an established royalty rate of { } for the patented good. (SIB at 55 (citing CX-592C at WAT000385).) They argue that the actual rate is actually lower when costs are deducted from the gross royalty rate. (*Id.* (citing CX-562C at 4).) They say that for 2006 the gross royalty rate yielded { } (*Id.*) Adding all royalties together, including Canadian sales, yields a gross royalty of { } and a net royalty of { } for an effective yield of approximately { } of the gross royalty. (*Id.* at 56.) This, they argue, shows the true royalty rate "is closer to { } calculated as follows: { } (*Id.*)

It is recommended that, pursuant to 19 U.S.C. § 1337(j)(3), the Commission set the 60-day Presidential Review period bond in the amount of 100% of the entered value of infringing articles.

In setting the bond amount, the Commission has, when appropriate and practical, considered the differential in sales price between the patented product made by the domestic industry and the lower price of the infringing imported product, and has set a bond amount sufficient to eliminate that difference. Basing the bond on price differentials between Complainants' and Respondents' products in this investigation would be very problematic because of the variety of products involved (e.g. Lucky Litter's LB1 and LB2 products and related cartridges; SmartScoop Litter Box Basic, SmartScoop Litter Box Deluxe, SmartScoop Litter Box Re-Shipper; and SmartScoop Litter Box Canada), the wide variations in pricing (between \$45 and \$199), and the many distribution methods employed (Respondents directly

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import the infringing products into the United States for sale and distribution, or their customers purchase and take title of the products directly from the manufacturer and import the units themselves, and they are sold on the internet). Under these circumstances, setting an individual bond amount for each kind of self-cleaning cat litter box and various components thereof sold separately is not practical or justified. In cases where a price comparison is not possible, the Commission has set a 100 percent bond during the Presidential review period. *EPROMs*, USITC Pub. 2196 at 132-34 (1989); *Certain Amorphous Metal Alloys and Amorphous Metal Articles*, Inv. No. 337-TA-143, USITC Pub. No. 1664 at 11-12 (1984); *Certain Electrical Wire Discharge Machining Apparatus and Components Thereof*, Inv. No. 337-TA-290, Commission Opinion at 20 (March 16, 1990).

Respondents have suggested that a bond of { } is appropriate, since there is evidence that such a royalty is paid by Complainant Applica to Complainant WRC. There is no evidence in this case that Complainants have previously entered into royalty agreements with non-affiliated entities. The Respondents' suggestion also overlooks the fact that the { } royalty paid by Applica to WRC is {

} (RX-24C; RX-25C; RX-26C.) A royalty of { } has also been found *de minimis*. See *Certain Flash Memory Circuits and Products Containing Same*, Inv. No. 337-TA-382, Comm'n Op. at 41-42 (June 1997). In this case, the potential profit for infringing foreign manufacturers is greater than 100%. A bond of 100% of the entered value of the infringing articles is appropriate and recommended.

IX. MATTERS NOT DISCUSSED

This Initial Determination's failure to discuss any matter raised by the parties, or any portion of the record, does not indicate that it has not been considered. Rather, any such

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matter(s) or portion(s) of the record has/have been determined to be irrelevant, immaterial or meritless. Arguments made on brief which were otherwise unsupported by record evidence or legal precedent have been accorded no weight.

X. CONCLUSIONS OF LAW

1. The Commission has subject matter jurisdiction, in rem jurisdiction, and in personam jurisdiction.
2. There has been an importation of the accused self-cleaning cat litter boxes and components thereof which are the subject of the alleged unfair trade allegations.
3. An industry does exist in the United States that exploits the patent at issue, as required by 19 U.S.C. § 1337(a)(2).
4. U.S. Pat. No. RE36,847 is not invalid, is enforceable and is infringed.
5. There is a violation of 19 U.S.C. § 1337(a)(1).

XI. ORDER

Based on the foregoing, and the record as a whole, it is my Final Initial Determination that there is a violation of 19 U.S.C. § 1337(a)(1) in the importation into the United States, sale for importation, and the sale within the United States after importation of certain self-cleaning cat litter boxes and components thereof.

If the Commission determines that there is a violation, I recommend that a general exclusion order should issue and a bond of 100 percent of the entered value of any infringing self-cleaning cat litter boxes and components thereof be imposed during the Presidential review period.

If the Commission determines that there is a violation, I recommend that a cease and desist order should issue prohibiting Respondents and any of their principals, stockholders,

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officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and/or majority owned business entities, successors, and assigns, and to each of them from selling, distributing, advertising, promoting, marketing, storing, exhibiting, demonstrating, or testing the infringing products in the United States, to wit: Lucky Litter LB1 and LB2 and components thereof (including cartridges), and the OurPet's SmartScoop Litter Box (i.e. Smartscoop Litter Box Basic, SmartScoop Litter Box Deluxe, SmartScoop Litter Box Re-Shipper; and SmartScoop Litter Box Canada).

I hereby **CERTIFY** to the Commission my Final Initial and Recommended Determinations together with the record consisting of the exhibits admitted into evidence. The pleadings of the parties filed with the Secretary, and the transcript of the pre-hearing conference and the hearing, as well as other exhibits, are not certified, since they are already in the Commission's possession in accordance with Commission rules.

It is further **ORDERED** that:

In accordance with 19 C.F.R. § 210.39, all material heretofore marked *in camera* because of business, financial and marketing data found by the administrative law judge to be cognizable as confidential business information under 19 C.F.R. § 201.6(a), is to be given *in camera* treatment continuing after the date this investigation is terminated.

Pursuant to 19 C.F.R. § 210.42(h), the initial determination shall become the determination of the Commission unless a party files a petition for review of the initial determination pursuant to 19 C.F.R. § 210.43(a), or the Commission, pursuant to 19 C.F.R. § 210.44, orders on its own motion a review of the initial determination or certain issues therein.

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Within fourteen days of the date of this document, each party shall submit to the office of the Administrative Law Judge a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions must be made by hard copy by the aforementioned date and must include a copy of this document with red brackets indicating any portion asserted to contain confidential business information to be deleted from the public version. The parties' submission concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.

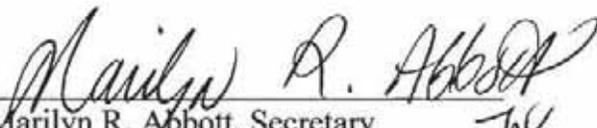
Issued: 12/11/2008
DATE



Robert K. Rogers, Jr.
Administrative Law Judge

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Kevin G. Baer, Esq.**, Commission Investigative Attorneys, and the following parties via first class mail and air mail where necessary on December 24, 2008.


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**IN THE MATTER OF CERTAIN SELF-CLEANING
LITTER BOXES AND COMPONENTS THEREOF**

Inv. No. 337-TA-625

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