

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. SACV 19-835 JVS (DFMx) Date December 1, 2021
Title Fisher & Paykel Healthcare Limited v. Flexicare Inc. et al.

Present: The **James V. Selna, U.S. District Court Judge**
Honorable

Lisa Bredahl

Not Present

Deputy Clerk

Court Reporter

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

Not Present

Not Present

Proceedings: [IN CHAMBERS] Order Regarding Motion to Strike Prior Art References

Before the Court is Plaintiff Fisher & Paykel Healthcare Limited’s Motion to Strike Defendants Flexicare Inc., Flexicare Medical Limited, and Flexicare (Group) Limited’s (collectively, “Flexicare”) Excessive Prior Art References, or in the alternative, to Compel Defendants to Comply with Case Narrowing Order. See Mot., ECF Nos. 519 (Notice of Motion), 520 (Supporting Memorandum). The motion is fully briefed. See Opp., ECF Nos. 524, 526 (sealed); Reply, ECF No. 527.¹

The Court finds this matter appropriate for resolution without oral argument. Fed. R. Civ. P. 78; L.R. 7-15. Therefore, the Court **VACATES** the December 6, 2021, hearing. For the following reasons, the Court **DENIES** the motion.

I. BACKGROUND

In this action, Fisher alleges that Flexicare infringes nine Fisher patents. See Third Amended Complaint (“TAC”), ECF No. 107, ¶¶ 30-41. The patents relate to breathing circuits, which are devices used to deliver humidified, temperature-controlled air to a patient. Fisher alleges infringement based on Flexicare’s sale of VentiMyst heated breathing circuits, non-VentiMyst heated breathing circuits, and Veoflo nasal cannula products. Id. ¶¶ 39-41.

¹ The Court is mindful that certain materials have been filed under seal. The Court does not believe that any sealed information is reflected in this order. If the parties disagree, they shall notify the Court which parts of the order they believe should be redacted.

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This case is in its late stages. The Court has already issued a Claim Construction order and numerous orders on the parties' Motions for Summary Judgment. Due to pandemic-related witness travel restrictions, trial has been delayed until March 22, 2022.

As relevant here, on August 30, 2021, the Court issued an order requiring the parties to narrow the asserted claims and prior art references. See Narrowing Order, ECF No. 510. Specifically, based on the parties' joint narrowing proposal, the Court ordered "Fisher to narrow its asserted claims to ten (10) total claims," and "Flexicare to narrow its asserted prior art references to fifteen (15) total references." Id.

After receiving Flexicare's narrowed prior art references, Fisher filed the present motion to exclude two asserted references for exceeding the 15-reference limit. Alternatively, Fisher seeks an order requiring Flexicare to comply with the Narrowing Order. Fisher bases its motion on the premise that each of two asserted prior art references—the "Perma Pure Prior Use and Invention" and "Hytrek as described in the Hytrek Product Properties Guide, December 1993 and Hytrek HTR-8171 Polyester Elastomer Product Datasheet, August 1990"—comprises more than a single reference.

II. LEGAL STANDARD

Northern District of California Patent Local Rules 3-1 and 3-3 identify the requirements for patent infringement and invalidity contentions. Among other things, the rules for patent invalidity contentions require "[a] chart identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found." N.D. Cal. PLR 3-3(c). Invalidity contentions must disclose "[a]ny grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1)." Id. at 3-3(d).

The rules are "designed specifically to require parties to crystallize their theories of the case early in the litigation so as to prevent the shifting sands approach to claim construction," or a shifting sands approach to litigation in general. O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc., 467 F.3d 1355, 1364 (Fed. Cir. 2006) (internal quotations omitted); see also Polaris PowerLED Techs., LLC v. VIZIO, Inc., No. SA CV 18-1571-JVS-DFMx, 2020 WL 4258663, at *2 (C.D. Cal. May 14, 2020). To that end, "[d]istrict courts possess the authority to limit patent claimants to a set of representative claims."

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Thought, Inc. v. Oracle Corp., No. 12-CV-05601-WHO, 2013 WL 5587559, at *2 (N.D. Cal. Oct. 10, 2013) (citing In re Katz Interactive Call Processing Patent Litig., 639 F.3d 1303, 1313–14 (Fed. Cir. 2011); Stamps.com Inc. v. Endicia, Inc., 437 Fed. Appx. 897, 902 (Fed. Cir. 2011)). Likewise, district courts may limit the number of asserted prior art references. See, e.g., Thought, Inc., 2013 WL 5587559 at *2 (“in complex actions district courts have ‘broad discretion’ in administering their cases, as long as the parties’ due process rights are protected).

III. DISCUSSION

A. *Summary of Arguments*

Fisher moves to strike two of Flexicare’s prior art references, on the grounds that they do not specifically identify a reference so Fisher cannot respond, and they exceed the 15-reference limit imposed by the Narrowing Order. First, Fisher moves to strike the reference styled as “Perma Pure Prior Use and Invention,” which Fisher contends is two references: prior use *and* invention. Mot. at 4. Further, Fisher argues this description is vague, making it unclear “which Perma Pure alleged prior use or which alleged [Perma Pure] invention Flexicare will be asserting at trial.” Id. at 5. This is because, Fisher explains, “Perma Pure has used Nafion and other materials for many different applications,” and Perma Pure is the assignee of at least 15 patents and patent applications covering various technologies. Id. Further, Fisher argues that Flexicare’s expert reports don’t solve this problem because they too reference Perma Pure’s use of Nafion across various applications. Id. at 5-6. Fisher also contends that it does not know under which invalidity theory Flexicare asserts Perma Pure. Id. at 6.

Second, Fisher moves to strike the reference styled as, “Hytrell as described in the Hytrell Product Properties Guide, December 1993 and Hytrell HTR-8171 Polyester Elastomer Product Datasheet, August 1990,” because it includes at least two references, neither of which identifies a specific prior art instrumentality. Id. Rather, Fisher argues this references encompasses “numerous different types of Hytrell grades and materials.” Id. at 6-7 (noting reference subsumes at least 23 different types of Hytrell used across different compositions, properties, and applications). Further, as with the Perma Pure reference, Fisher contends that it does not know under which invalidity theory Flexicare asserts Hytrell. Id. at 7-8. Fisher also argues that, because this reference cites a collection

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of documents, it violates the Court’s earlier order on amending contentions. Id. at 8 (citing ECF No. 155 at 3).

Beginning with Perma Pure, Flexicare responds that its invalidity contentions and expert reports explain in great detail that it relies on Perma Pure’s large bore, thin wall Nafion tubing. Opp. at 1 (citing Sauer Decl., ECF No. 526-1, Ex. A, Collins Report at ¶¶ 908-43, including headings identifying asserted invalidity theories). Flexicare argues that its Perma Pure reference does not violate the Narrowing Order because “Perma Pure’s large bore, thin wall Nafion tubing is one prior art product,” and “Flexicare relies on the same Perma Pure large bore, thin wall Nafion tubing for invalidity grounds under 35 U.S.C. §§ 102(a), 102(f), and 102(g);” thus, “Perma Pure’s prior use and invention are not separate prior art instrumentalities, but separate statutory grounds.” Id. at 2; see also id. at 5-7 (summarizing invalidity theory based on Nafion tubing from Perma Pure’s use to dry exhaled patient breath from 1998 through 2000), 14-15 (similar).

As to the Hytrel reference, Flexicare notes that it relies on Hytrel “as evidence of what a person of ordinary skill in the art would understand from Gansel’s [a prior art patent filed in 1996] reference to Hytrel tubing material.” Id. ; see also id. at 8-9 (citing Sauer Decl., ECF No. 524-6, Ex. H, Gansel at 2:1-4 (“[m]aterials commonly used to form the flexible tubing include...Hytrel”). Even counting Hytrel as an asserted invalidity reference, Flexicare argues that the “Hytrel Documents count as a single prior art instrumentality for narrowing purposes because the Hytrel Documents were produced by the same author (DuPont), describe the same material (Hytrel), and are used for the same purpose (to show breathable Hytrel was known and commercially available in the early 1990s).” Id. at 2-3; see also id. at 8 (noting the Hytrel documents “span 14 pages,” “were produced by DuPont[,] and incorporated into Flexicare’s Amended Invalidity Contentions with the Court’s permission in July 2020”), 16-17 (similar). Further, Flexicare argues the Hytrel documents comprising the reference make clear what is cited, because the documents consistently refer to “a Hytrel grade that allows passage of water vapor.” Id. (citing Wentzel Decl., ECF No. 521, Ex. 6 at DUP000008; id. at Ex. 7; Sauer Decl., ECF No. 526-1, Ex. A, Collins Report, ¶ 1178). Regarding the contention that the Hytrel reference encompasses 23 different types of material, Flexicare responds that, “the Gansel reference to ‘Hytrel’ material in general is a classic genus reference that encompasses *all* species of a limited, known brand of material, *i.e.*, Hytrel.” Opp. at 17 (emphasis added) (citing Abbvie Inc. v. Mathilda and Terence Kennedy Institute of Rheumatology Trust, 764 F.3d 1366 (Fed. Cir. 2014) (“when a genus is so limited that a

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person of ordinary skill in the art can at once envisage each member of this limited class, ... a reference describing the genus anticipates every species within the genus”) (quotation marks omitted)).

Finally, Flexicare asks the Court to disregard Fisher’s motion because Fisher waited more than 15 months to seek clarification concerning these references, and striking them now (after the close of discovery) would prejudice Flexicare. *Id.* at 3 (noting Flexicare disclosed Perma Pure in 2019 and Hytrel in 2020, as single prior art references); *id.* at 19-21; see also ECF No. 155 at 4 (Order on amending contentions, declining to consider argument that certain prior art references comprised multiple references, noting that Fisher “has not affirmatively sought clarification from the Court in the past six months on either issue”).

In reply, Fisher argues that Flexicare’s reliance on expert reports and other documents “only confirm[s] the expansive scope of information that could be encompassed by th[e] [Perma Pure] entry,” which “does not adequately identify a prior art ‘reference.’” Reply at 2. Even though Flexicare describes this reference as “Perma Pure’s large bore, thin wall Nafion tubing,” Fisher argues this is not what the reference says. *Id.* at 2-3. Fisher maintains that this reference counts as multiple references because it relies on different configurations developed by different people at different times, as reflected in an array of documents. *Id.* at 3.

Turning to Hytrel, Fisher argues that, “It remains unclear which of the numerous different types of Hytrel grades and materials Flexicare is asserting as prior art.” *Id.* at 5-7 (noting, e.g., different water absorption rates and tear resistance strengths). Fisher rejects Flexicare’s genus argument, asserting that “[w]hether the Hytrel entry on Flexicare’s list refers to the entire Hytrel family of materials or just the numerous materials described in the two Hytrel documents, Flexicare’s entry does not identify a single, specific reference or material.” *Id.* at 6. Further, Fisher argues that, if Flexicare is not relying on Hytrel as a prior art reference, but rather for some other purpose, it should be removed from the reference list. *Id.* at 7.

Regarding Flexicare’s procedural arguments, Fisher argues there is no deadline for motions to strike references, or motions to compel compliance with Court orders. *Id.* at 8. Fisher contends that, until the Court entered the further Narrowing Order, it was unclear what references would remain asserted. *Id.* Finally, Fisher argues that Flexicare would

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not be prejudiced as a result of the Court granting the motion because Flexicare has failed to explain why discovery would need to be reopened. Id. at 13.

B. Analysis

1. Perma Pure Reference

The Court concludes that the reference, “Perma Pure Prior Use and Invention,” constitutes a single reference, consistent with the requirements of the Narrowing Order. Although Fisher states that it does not understand what this item references, Flexicare is not hiding the ball. As explained, this reference comprises “Perma Pure’s large bore, thin wall Nafion tubing.” See generally Opp. at 15. In a footnote, Fisher makes a passing argument that even this clarification is too vague, but Fisher fails to explain why. See Reply at 3 n.2. Further, Flexicare may assert that a single prior art reference invalidates a patent under multiple statutory grounds (e.g., § 102(f), § 102(g)), without violating the Narrowing Order governing the number of asserted references. Relatedly, the term “use and invention” speaks to invalidity theories, not different references. Accordingly, the Court denies the motion as to this reference.

2. Hytrel Reference

The Court likewise concludes that the reference, “Hytrel as described in the Hytrel Product Properties Guide, December 1993 and Hytrel HTR-8171 Polyester Elastomer Product Datasheet, August 1990,” constitutes a single reference, and therefore does not violate the Narrowing Order. In the context of this case, this reference is understood in conjunction with another asserted prior art reference, U.S. Patent No. 5,794,986, issued to Gansel et al. on August 18, 1998. See ECF No. 524-6. Gansel discloses a semi-disposable ventilator breathing circuit tubing with releasable coupling. See id. Gansel “relates generally to medical ventilators and, more specifically, to tubing for use in that portion of the ventilator commonly known as the breathing circuit.” Id. at 1:9-11. Gansel explains that, “Materials commonly used to form the flexible tubing include,” among other things, “HYTREL®, which is a thermoplastic copolymer produced by DuPont, Inc.” Id. at 2:1-4; compare Opp. at 16 (“Prior art from the mid-1990s that is not challenged by FPH—Gansel—discloses flexible breathing circuit tubing made of Hytrel.”).

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The Court agrees with Flexicare that the cited Hytrel documents may be construed as a single reference where they “describe the properties of the prior art Hytrel material called out in Gansel, including that it is a material that allows passage of water vapor.” Opp. at 16. Further, as Flexicare observes, the two Hytrel documents share a single author (DuPont), describe the same material (Hytrel as referenced in Gansel), and are used for the same purpose here. *Id.* at 18. Thus, the documents are sufficiently related to be treated as part of a single asserted reference to Hytrel as disclosed in Gansel. *See, e.g., Iridescent Networks, Inc. v. AT&T Mobility, LLC*, No. 6:16-CV-01003-RWS, 2017 WL 8751908, at *2 (E.D. Tex. June 15, 2017) (“The Court finds that, as a general matter, [prior art], can constitute a single prior art reference and may include associated references that describe [it],” especially “where the allegations of infringement read onto” that technology,” but “[t]he accused infringer must demonstrate that the cited references constitute a single prior art instrumentality or single author”).

The Court also finds this reference permissible because, to the extent the two Hytrel documents encompass multiple grades, Flexicare may present evidence that a person of ordinary skill in the art would understand Hytrel, as referenced in Gansel, encompasses all of the listed grades. *See, e.g., Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001) (“[T]he disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited.”); *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 871-72 (Fed. Cir. 2015) (patent “specification discloses the genus of saturated fatty acid amides and states that good results are achieved with the narrower genus of saturated fatty acid amides having 12 to 35 carbon atoms,” and “Behenamide falls within the narrower preferred genus because it is a saturated fatty acid amide with 22 carbon atoms”). Accordingly, the Court denies the motion as to this reference.

3. Procedural Arguments

Because Fisher filed its motion in response to the final version of Flexicare’s prior art references following the Narrowing Order, the Court will allow the motion as timely. The Court observes, however, that Fisher objected to these references as early as October 1, 2020. *See* ECF No. 524-4, Sauer Decl., Ex. E (Oct. 1, 2020 Fisher letter to Flexicare) at 2-3. Trial remains several months away. Therefore, rather than using this pandemic-related delay as a time for raising further preexisting issues, the Court encourages the

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parties to meet and confer to resolve such issues, as informed by the Court's prior rulings, with the goal of working toward efficient trial presentations.

IV. CONCLUSION

For the foregoing reasons, the Court **DENIES** the motion and **VACATES** the December 6, 2021 hearing.

IT IS SO ORDERED.

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