

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROCKWELL TECHNOLOGIES, LLC,)
)
 Plaintiff,)
)
 v.) C.A. No. 00-589 GMS
)
SPECTRA-PHYSICS LASERS, INC. and)
OPTO POWER CORPORATION,)
)
 Defendants.)

MEMORANDUM AND ORDER

I. INTRODUCTION

The plaintiff, Rockwell Technologies, LLC (“Rockwell”) filed the above-captioned action against Spectra-Physics Lasers, Inc. (“Spectra”) and Opto Power Corporation (“Opto”) on June 16, 2000. In its complaint, Rockwell alleges that Spectra and Opto are infringing U.S. Patent No. 4,368,098 (“the ‘098 patent”).

Presently before the court is Rockwell’s motion for summary judgment. In that motion, Rockwell asks the court to find that Dr. Robert Thomas’ work is not prior art under 35 U.S.C. §§ 102(g) and 103. For the reasons that follow, the court will grant this motion.

II. STANDARD OF REVIEW

The court may grant summary judgment “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c); *see also Boyle v. County of Allegheny, Pennsylvania*, 139 F.3d 386, 392 (3d Cir. 1998). Thus, the court may grant summary judgment only if the moving party shows that there are no genuine issues of material fact that would permit a reasonable jury to find for the

non-moving party. *See Boyle*, 139 F.3d at 392. A fact is material if it might affect the outcome of the suit. *Id.* (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-248 (1986)). An issue is genuine if a reasonable jury could possibly find in favor of the non-moving party with regard to that issue. *Id.* In deciding the motion, the court must construe all facts and inferences in the light most favorable to the non-moving party. *Id.*; *see also Assaf v. Fields*, 178 F.3d 170, 173-174 (3d Cir. 1999).

With these standards in mind, the court will describe the facts that led to the motion presently before the court.

III. BACKGROUND

The patent-in-suit relates to a process for forming “an epitaxial film of group III-V semiconductor disposed on a single crystal substrate.” Dr. Harold Manasevit (“Manasevit”) developed the process described in the ‘098 patent. Rockwell filed an application for a process patent on April 7, 1978.¹ This application issued as the ‘098 patent on January 11, 1983. It expired on January 11, 2000.

The alleged prior art in dispute is that of Dr. Robert Thomas (“Thomas”). During the summer of the 1966, Thomas was a civilian employee of the Rome Air Development Center at Griffins Air Force Base, in Rome, New York, and a graduate student at Syracuse University. As part of his graduate studies, he proposed a research project that would use organometallics to grow Group III/V semiconductor films.

His notebooks from that time show that during late 1966 and early 1967, he made some

¹Although Manasevit first filed an application for a patent on February 13, 1968, he subsequently filed further patent applications claiming priority to that application. As stated above, the ‘098 patent issued from one of those later applications.

literature notes, notes about which chemicals he might use, and how he might set up his instruments. In February and March of 1967, he was documenting the literature and doing preliminary experiments with silicon diethyl. During his deposition, he also testified that he was occupied with classwork and studying for his comprehensive exams at this time. Although he continued with his silicon diethyl experiments sporadically from June until September 1967, he did not perform any further experiments until March 1968. At that time, he began using triethylgallium and triethylarsine.

Following the March 1968 experiments, Thomas' notebooks reflect that he did not perform another experiment until August 14, 1968. On September 17, 1968, Thomas claims to have successfully grown a gallium phosphide single crystal film for the first time.²

IV. DISCUSSION

Patents are presumptively valid. *See* 35 U.S.C. § 282. To overcome this presumption, the party asserting invalidity based on 35 U.S.C. §§ 102 and 103 must establish such invalidity by clear and convincing evidence. *See Price v. Symsek*, 988 F.2d 1187, 1191 (Fed. Cir. 1993); *see also Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1175 (Fed. Cir. 1999), *cert. denied*, 527 U.S. 1036 (1999). “Clear and convincing” evidence is evidence that convinces the factfinder that the truth of a factual assertion is “highly probable.” *See Price*, 988 F.2d at 1191.

A patent shall not issue if the invention that is the subject of the patent “was made in this country by another who had not abandoned, suppressed, or concealed it.” 35 U.S.C. § 102(g). Two questions are relevant to a Section 102(g) analysis: (1) whether the alleged prior inventor was the

²During his deposition, Thomas was unable to give a particularized account of his activities during the large time gaps in his notebook, and could only speculate as to what he was doing during those times.

first to conceive of the claimed invention's subject matter and (2) whether the alleged prior inventor exercised reasonable diligence in later reducing the process to practice. *See Marhurkar v. C.R. Bard Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). An inventor is entitled to priority based on conception only as of the date when the complete conception has been manifested or disclosed in some fashion. *See Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997) (noting that a “[c]onception must be proved by corroborating evidence which shows that the inventor disclosed to others his ‘complete thought expressed in such clear terms as to enable those skilled in the art to make the invention.’”) (internal citation omitted.) With regard to diligence, “[w]here a party is first to conceive but second to reduce to practice, the party must demonstrate reasonable diligence toward reduction to practice from a date just prior to the other party's conception to its reduction to practice.” *Marhurkar*, 79 F.3d at 1578. The inventor must account for the entire critical period by showing either activity aimed at reduction to practice or legally adequate excuses for inactivity. *See Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed. Cir. 1987).

In opposition to Rockwell's motion, Spectra and Opto first argue that Rockwell is collaterally estopped from bringing this motion because the United States Court of Federal Claims declined to grant summary judgment on a similar issue. *See Rockwell Int'l v. U.S.*, 37 Fed. Cl. 478, 503-05 (Ct. Cl. 1997), *aff'd in part*, 147 F.3d 1358 (Fed. Cir. 1998). The court must disagree because a determination that there remain genuine issues of material fact is not a “final decision.” *See Johnson v. Jones*, 515 U.S. 304, 313 (1995); *see also Whitford v. Boglino*, 63 F.3d 527, 530 (7th Cir. 1995) (stating that the denial of summary judgment is not a final judgment, but rather an interlocutory order in the *res judicata* context.)

Spectra and Opto next argue that Rockwell's motion is premature because expert reports

were not yet due when the motion was briefed. Again, the court disagrees. Rockwell filed its motion on September 4, 2001, which was the deadline established by the Scheduling Order for filing non-Markman-dependant summary judgment motions. Spectra and Opto cannot now claim that they were surprised when such a motion was filed before expert reports were due. Additionally, while they may be relevant, Spectra and Opto fail to explain the relevance of expert reports with regard to whether Thomas conceived an invention prior to Manasevit or was diligent in reducing his work to practice.

Moreover, in their opposition papers, Spectra and Opto did not address the merits of Rockwell's motion. In so doing, they have failed to offer any evidence that Thomas was the first to conceive of the claimed process, or that he exercised reasonable diligence in reducing his process to practice. *See Marhurkar* 79 F.3d at 1577. Due to Spectra's and Opto's decision to let the record, as established by Rockwell, speak for itself, the court must conclude that no reasonable factfinder could determine that Thomas' work constitutes prior art.

The record reflects that Thomas' techniques were different from those utilized by Manasevit. Thomas used triethylarsine, rather than arsine. He did not add the Group V reactant before the Group III reactant. Thomas also used temperatures around 485 degrees celsius, while Manasevit used a significantly lower temperature. Additionally, Thomas testified at his deposition that he used stoichiometrically equivalent amounts of Group III and V gases, rather than an excess of Group V reactant.

The present record also reflects that Thomas did not develop his specific technique until after Manasevit's February 13, 1968 patent application was filed. His notebooks demonstrate that during late 1966 and early 1967, he only made some literature notes, notes about which chemicals he might

use, and general provisions for setting up his instruments. In February and March of 1967, he was documenting the literature and doing preliminary experiments with silicon diethyl. Thomas testified that he was also otherwise occupied with comprehensive exams which took place in June 1967 and again in June 1968. Thomas' notebook shows only sporadic experiments with silicon diethyl from June until September 1967. His notebook further reflects that he did not perform any more experiments until March 1968, at which time he first used triethylgallium and triethylarsine. It was not until September 17, 1968 that Thomas claims to have successfully grown a gallium phosphide single crystal film for the first time.

V. CONCLUSION

In light of Spectra's and Opto's failure to defend themselves as to the merits of this motion, the court is constrained to conclude that there is a lack of clear and convincing evidence by which a reasonable factfinder could determine that Thomas' work was prior art.

For these reasons, IT IS HEREBY ORDERED that:

1. Rockwell's motion for summary judgment that Robert Thomas' work is not prior art (D.I. 158) is GRANTED.

Date: April 8, 2002

Gregory M. Sleet
UNITED STATES DISTRICT JUDGE