

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION**

FREE-FLOW PACKAGING
INTERNATIONAL, INC.,

Plaintiff,

vs.

AUTOMATED PACKAGING SYSTEMS,
INC.,

Defendant.

) CASE NO. 5:17-cv-02318

) JUDGE SARA LIOI

) Jury Trial Demanded

**PLAINTIFF FREE-FLOW PACKAGING INTERNATIONAL, INC.'S
VALIDITY AND ENFORCEABILITY CONTENTIONS**

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I. INTRODUCTION

Pursuant to Local Patent Rule 3.7 and the Case Management Plan (Dkt. No. 135 at 2), Plaintiff Free-Flow Packaging International, Inc. (“FPI”) hereby serves its Validity and Enforceability Contentions (“Contentions”) for U.S. Patent Nos. 9,003,743 (“the ’743 patent”) and 8,323,774 (“the ’774 patent”) (collectively, “asserted patents”).

FPI provides these Contentions based on its investigation to date, and without the benefit of full discovery. As such, FPI’s Contentions are necessarily preliminary in nature. Moreover, because Defendant Automated Packaging Systems, Inc.’s (“Automated”) Invalidity and Unenforceability Contentions suggested it may disclose additional prior art and contentions, FPI reserves the right to amend, modify, or supplement these Contentions in accordance with Local Patent Rule 3.10 and to the extent permitted by the Federal Rules of Civil Procedure, this Court, and its Local Patent Rules. FPI also reserves the right to rely on any facts, documents, or other evidence that is subsequently discovered, determined to be relevant for any purpose, or omitted from these Contentions or the accompanying production.

The Court has not yet construed any claim term of the asserted patents. Without a claim construction order, FPI provides these Contentions based on the plain and ordinary meaning to a person of ordinary skill in the art consistent with the intrinsic evidence of the asserted patents. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). However, even if a more broad reading of the asserted claims is used, they are still valid and not anticipated or rendered obvious by the references Automated relies upon. FPI reserves the right to amend, modify, or supplement these Contentions following the Court’s construction of any claim term of the asserted patents, or any position that Automated, its fact witnesses, or its expert witnesses may take concerning claim interpretation, infringement, invalidity, or enforceability. Nothing herein should be construed as an admission regarding the construction of any claim term. FPI reserves the right to challenge

any of Automated's proposed claim constructions and propose alternative constructions to those that Automated has advocated for, may advocate for, or that it expressly or implicitly relies on.

FPI reserves the right to rely on expert testimony, including testimony from any expert Automated identifies. FPI will produce documents related to expert testimony in accordance with the Local Patent Rules and the Case Management Plan. *See* Dkt. No. 135 at 1-2.

Automated served its Invalidity and Unenforceability Contentions on February 16, 2018.¹ As discussed in detail below, these contentions are deficient. FPI reserves the right to object, strike, or otherwise exclude or respond to Automated's indication that prior art not included in its contentions, whether or not currently known to Automated, may become relevant depending on the claim constructions ultimately adopted by the Court. *See, e.g.*, IC at 3. FPI also reserves the right to object, strike, or otherwise exclude or respond to Automated's contentions because they are merely "exemplary" and "representative" (*see, e.g., id.* at 9-10), and thus do not provide a complete invalidity analysis as required by the Local Patent Rules. FPI further reserves the right to object, strike, or otherwise exclude or respond to any additional obviousness combinations of the references or references not already identified by Automated, as well as Automated's ability to use such references or combinations for any purpose in this litigation.

II. LOCAL PATENT RULE 3.7(A)

For at least the reasons set forth in detail below, FPI contends that all claims of the asserted patents are valid and enforceable.

¹ FPI refers to the invalidity portion of Automated's contentions as "Invalidity Contentions" or "IC"; to the unenforceability portion as "Unenforceability Contentions" or "UC"; and to them collectively as "Automated's Invalidity and Unenforceability Contentions."

A. Automated's Identification of Prior Art Is Deficient

Automated's identification of prior art pursuant to Local Patent Rule 3.5 is deficient for myriad reasons, and FPI therefore provides the following objections and responses.

First, while Automated identifies 15 alleged prior art references in response to Local Patent Rule 3.5(a), Automated's charts only refer to eight distinct references.² *See* IC at 7-8. Automated's disclosure of any other references is therefore incomplete, improper under the local patent rules, and any allegations of invalidity with respect to these other references are not properly disclosed. In addition, Automated attempts to reserve the right to asserted different combinations of references that it did not provide charts for. *See id.* at 15-16. This disclosure is also incomplete, improper under the local patent rules, and any allegations of invalidity with respect to these unidentified and uncharted combinations are not properly disclosed. FPI objects to any future attempt by Automated to rely on any other references not charted pursuant to Local Patent Rule 3.5(c). However, to the extent the Court allows Automated to rely on an uncharted reference, FPI reserves the right to respond and provide responsive charts.

Second, Automated contends that "there are statutory bars precluding patentability of the subject matter of the '774 and '743 patents, including offers for sale and public uses or products that qualify as prior art under 35 U.S.C. § 102(b)." IC at 8. Automated also contends that "FPI may have offered for sale or publicly used products or systems qualifying as prior art under § 102(b)." *Id.* These disclosures are incomplete and violate Local Patent Rule 3.5(a) because they do not, for example, identify prior art under 35 U.S.C. § 102(b) by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became

² Automated did not chart seven references: (1) Japanese Unexamined Patent App. Pub. H7-291358; (2) U.S. Patent No. 5,427,830; (3) U.S. Patent No. 5,487,470; (4) WO 90/09320; (5) U.S. Patent No. 5,857,571; (6) U.S. Patent No. 5,314,086; and (7) U.S. Patent No. 4,096,306.

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