

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
Atlanta Division**

CANON, INC.,)	
)	
Plaintiff,)	
)	CASE NO. 1:11-cv-03855-RLV
v.)	
)	
COLOR IMAGING, INC. and)	
GENERAL PLASTIC)	
INDUSTRIAL CO., LTD.,)	
Defendants.)	
)	
_____)	

**DEFENDANTS’ AMENDED INVALIDITY CONTENTIONS
PURSUANT TO LOCAL PATENT RULE 4.3**

I. INTRODUCTION

Pursuant to Rule 4.3 of the Local Patent Rules of the Northern District of Georgia, and the Court’s Markman Order of January 10, 2014, adopting the August 26, 2013 Report and Recommendations of the Special Master (“Markman Order”), Defendants General Plastic Industrial Co., LTD. and Color Imaging, Inc. (“Defendants”) hereby provide their Amended Invalidity Contentions with respect to the claims identified by Plaintiff Canon, Inc. (“Plaintiff”) in Plaintiff’s Supplemental and Amended Disclosure of Asserted Claims and Infringement Contentions to the Defendants. The Asserted Claims are claims 24, 25, and 30 (the

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“Asserted Claims”) of U.S. Patent No. 7,647,012 (“the ’012 patent” or “the Patent-In-Suit”).

The following contentions are based on the claim constructions set forth in the Markman Order. Defendants reserve the right to challenge the Court’s Markman Order on appeal and to modify their contentions if the Markman Order is modified in any manner. Nothing in these contentions shall be taken as an admission by Defendants that the Markman Order is correct.

With respect to each asserted claim and based upon its investigation to date, Defendants hereby: (a) identify each currently known item of prior art that either anticipates or renders obvious each asserted claim; (b) specify whether each such item of prior art (or a combination of several of the same) anticipates each asserted claim and/or renders it obvious; (c) for each combination of items of prior art, identify the motivation to combine such items; (d) submit a chart identifying where each element in each asserted claim is disclosed, described, or taught in the prior art, and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and (e) identify the grounds for invalidating the Asserted Claims based upon indefiniteness under 35 U.S.C. § 112 ¶ 2 and 6. In addition, pursuant to Patent L.R. 4.3(b) and based upon its investigation to date,

Defendants are producing documents under Patent L.R. 4.3(b) required to accompany these Invalidity Contentions.

Defendants further reserve the right to rely on any documents produced, and invalidity contentions made, by Defendants in the other past, pending or future litigations brought involving the '012 patent.

II. RESERVATIONS

The information and documents that Defendants produce are provisional and subject to further revision as follows: Defendants expressly reserve the right to amend the disclosures and document production herein should Plaintiff provide any information that it failed to provide in its Patent L.R. 4.1 disclosures or should Plaintiff amend its Patent L.R. 4.1 disclosures in any way. Furthermore, because Defendants' search for and analysis of relevant prior art is ongoing, Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including identifying, charting, and relying on additional references, should Defendants' further search and analysis yield additional information or references, consistent with the Patent Rules and the Federal Rules of Civil Procedure. Moreover, Defendants reserve the right to revise their ultimate contentions concerning the invalidity of the Asserted Claims, which may change depending upon the Court's construction of the Asserted Claims, any findings as to the

priority date of the Asserted Claims, and/or positions that Plaintiff or expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues.

Moreover, Plaintiff's disclosures under Patent L.R. 4.1 are deficient in numerous respects. For example, Plaintiff has failed to show where or how Defendants' accused toner bottle products meet each and every limitation of the '012 patent. Further, Plaintiff has not complied with the Local Patent Rules by, at a minimum, failing to provide a "chart identifying where each element of each asserted claim (i.e., claims 24, 25, and 30) is found within each Accused Instrumentality...." Patent L.R. 4.1. Because such deficiencies may lead to further grounds for invalidity, Defendants specifically reserve the right to modify, amend, or supplement their contentions as Plaintiff modifies, amends, or supplements its disclosures under Patent L.R. 4.1 and/or 4.5 and/or produces the required documents and any other documents responsive to Defendants' discovery requests.

Defendants further reserve the right to rely upon applicable industry standards and prior art cited in the file history and possible re-examination history of the '012 patent and related U.S. and foreign patent applications as invalidating references or to show the state of the art. Prior art not included in these Amended Invalidity Contentions, whether known or unknown to Defendants, may become

relevant. In particular, Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify other references that would anticipate or render obvious the allegedly missing limitation(s) of the disclosed system or method.

Defendants' claim charts in Exhibit A (for the '012 patent) cite to particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions are only examples, and Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that the prior art discloses a claim limitation or the invention as a whole. Defendants further reserve the right to rely on uncited portions of the prior art references, other publications, and testimony, including expert testimony, to establish bases for combinations of certain cited references that render the Asserted Claims obvious.

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