

No. 19-GSR-4287

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BALLISTIC HOLDINGS, INC. and BALLISTIC MEMORY, INC.,

Appellants,

v.

CONSUMERCAM, LLC,

Appellee.

**APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF PENNYSYTON IN CIVIL ACTION NO. 1:16-GSR-10814,
JUDGE OLIVER S. RANGO**

BRIEF OF APPELLEE CONSUMERCAM, LLC.

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February 4, 2019

CERTIFICATE OF INTEREST

Counsel for the appellee certifies the following:

1. The full name of every party or amicus represented by me is:

ConsumerCam, LLC.

2. The name of the real party in interest represented by me is:

ConsumerCam, LLC.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

There are no parent companies.

4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or are expected to appear in this Court are:
-

February 4, 2019

Date

/s/ Akina R. Khan

Signature of Counsel

Akina R. Khan

Printed Name of Counsel

February 4, 2019

Date

/s/ Sheila S. Niaz

Signature of Counsel

Sheila S. Niaz

Printed Name of Counsel

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STATEMENT OF RELATED CASES

Pursuant to Federal Circuit Rule 47.5, counsel for the appellee ConsumerCam, LLC.

certify the following:

1. There are no other appeals in or from the same civil action or proceeding in the lower court or body that were previously before this or any other appellate court.
2. There are no cases known to counsel to be pending in this or any other court that will directly affect or be directly affected by this court's decision in the pending appeal.

February 4, 2019
Date

/s/ Akina R. Khan
Signature of Counsel

Akina R. Khan
Printed Name of Counsel

February 4, 2019
Date

/s/ Sheila S. Niaz
Signature of Counsel

Sheila S. Niaz
Printed Name of Counsel

JURISDICTIONAL STATEMENT

ConsumerCam, LCC (“ConsumerCam”) appeals from a final grant of summary judgment entered in the U.S. District Court for the District of Pennyston in Civil Action No. 1:16-GSR-10814, a suit for infringement of U.S. Patent GSR,784,314, (“’314 Patent”) assigned to Ballistic Holdings, Inc. (“Ballistic Holding”), under 35 U.S.C. § 271(c) (2012). Ballistic Memory, Inc. (“Ballistic Memory”) was properly joined as a required plaintiff under Fed. R. Civ. P. 19. The district court possessed original subject matter jurisdiction under 28 U.S.C. § 1338(a) (2012). A notice of appeal complying with Fed. R. App. P. 4(a) was timely filed and docketed as Appeal No. 19-GSR-4287. The Court of Appeals for the Federal Circuit has exclusive jurisdiction over this appeal under 28 U.S.C. § 1295(a)(1) (2012).

STATEMENT OF THE ISSUES

- I. Under *Impression Prods. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523 (2017) does the delivery of Devices practicing a patented technology, in exchange for a contractually agreed-to purchase price, constitute a sale of the Devices exhausting the patentee’s rights to control the downstream use of the Devices?
- II. When a patent specification overbroadly claims an invention, withholds critical limitations, and no reasonable jury could find that a POSITA could fully practice the claimed invention without undue experimentation, does the patent specification fail to enable the claimed invention?

STATEMENT OF THE CASE

ConsumerCam is a company known for its superior microprocessors and high-end consumer-grade cameras. (R. 2.) In searching for a superior semiconductor for its high-end cameras, (R. 3; App. 13.), ConsumerCam became intrigued by Ballistic Memory's semiconductor Device ("Device") that incorporated a patented graphene nanoribbon field-effect transistor ("GNRFET"). (R. 2.) These Devices were advertised to be the best and most innovative in the market and can be incorporated in microprocessors, memory hardware and many other electronic products. (R. 3; App. 12.)

Ballistic Memory's '314 Patent claimed a GNRFET containing a graphene nanoribbon ("GN"), which when properly manufactured to ranges of lengths and widths, can achieve ballistic switching speed. (App. 7.) Claim 1 recites to a GNRFET that can achieve switching speed of 1-1.2 THz when the GN is 5-35 nm wide and 20-23 nm long. (App. 6, 7, 25.) However, the specification and Fig. 2 only disclosed one "full, clear, concise, and exact" dimension—that nanoribbons with 5-15 nm width and 22 nm length achieve the claimed switching speed. (App. 6, 9, 23, 25.) Ballistic Memory's expert had to supplement the gap in disclosure by asserting that it would somehow be obvious to a person of ordinary skill in the art ("POSITA") that decreasing the length can dramatically increase the switching speed, resulting in the desired switching speed of over 1 THz, even at 35 nm width. (App. 3, 25, 26.) He suggested a POSITA would recognize this by simply conducting "minimum, routine experimentation." (App. 25.)

However, due to manufacturing limitations at the time of filing, the range of 15–35 nm was not practicable.

Impressed by the GNRFET technology, (App. 7), ConsumerCam agreed to buy 4,000,000 of the Devices at \$8 each for a total of \$32,000,000 from Ballistic Memory. (R. 3.) The document memorializing the sale (“Agreement”) set the delivery date to be on July 6, 2015, warranted the Devices for two years, and attempted to limit the use or resale of the Devices into blockchain technology without prior permission from Ballistic Memory. (App. 3, 10.) Following the Agreement, Ballistic Memory’s own Chief Marketing Officer, Glinda Goode, made a press announcement titled “Ballistic Memory to Sell Two Million Semiconductor Devices to ConsumerCam for Use in High-End Cameras.” (App. 12 (emphasis added).) The press release stated “ConsumerCam will purchase 2,000,000 semiconductor Devices from Ballistic Memory”. (*Id.*)

On October 5, 2015, Ballistic Memory consented to ConsumerCam’s resale of 2,000,000 Devices to OffTheBlockchain, a Swedish company intending to use them in blockchain technology. (R. 3, 4.) Unforeseeably, Sweden retroactively imposed a 50% sales tax on sellers of blockchain products on October 28, 2015. (R. 4.) The retroactive tax alone induced a \$1,000,000 loss on the resale. (*Id.*) Ballistic Memory, however, demanded commission on the resale on November 12, 2015, and due to the unforeseen loss from the tax, ConsumerCam responded that it would not make the payment. (*Id.*)

Ballistic Memory could have asserted a breach of contract claim until November 12, 2016 because of Pennyston’s one-year statute of limitations on contract claims. (*Id.*) Nonetheless, on December 3, 2016, more than a year after the contract claim accrued,

Ballistic Memory filed a complaint against ConsumerCam. (*Id.*) Ballistic Memory claimed ex post facto, that the sale of 4,000,000 Devices was merely a license and alleged that because of the resale, ConsumerCam induced and contributed to the infringement of the '314 Patent by OffTheBlockchain. (*Id.*) The parties stipulated to indirect infringement. (R. 5.) ConsumerCam moved for summary judgment, arguing that (1) the patent was invalid for lack of enablement, and (2) Ballistic Memory's patent rights were exhausted after selling the Devices to ConsumerCam, under *Impression Prods. v. Lexmark Int'l, Inc.*, 137 S. Ct. 1523 (2017). (*Id.*)

The U.S. District Court for the District of Pennyston, in Civil Action No. 1:16-GSR-10814, granted ConsumerCam's motion for summary judgment of patent exhaustion. (App. 3.) The district court relied on Ballistic Memory's press release and on the deposition testimony of John Tinny, one of the inventors of the '314 Patent. (App. 4, 14.) The district court found that Ballistic Memory's choice of calling the Agreement a "nonexclusive license" was strategic. (App. 21.) Although ConsumerCam's own counsel, Dorothy Billina, referred to the Agreement as a "licensing agreement" at times, (App. 17,) and the Agreement itself limited some rights to use and resale the Devices into blockchain market, (R. 3,) the district court nevertheless found that there was overwhelming evidence that the Agreement between Ballistic Memory and ConsumerCam was a sale. (App. 4.)

The district court denied Ballistic Memory's motion for summary judgment because it found that there were genuine issues of material fact. (App. 3.) The district court interpreted the claims for their plain and ordinary meaning. (App. 2.)

ConsumerCam argued the '314 Patent was non-enabling on two grounds. First, ConsumerCam claimed that the specification did not enable the full scope of claim 1 because that claim recites that GNs 5–35 nm wide can achieve switching speeds of 1.0 to 1.2 THz, while Fig. 2 depicts that only GNs of widths 5 to 10 nm achieve switching speeds of 1.0 to 1.2 THz. (App. 2.) Second, Fig. 2 only enabled a GNR-FET having the length 21–23 nm, but the claim captured a much larger scope. (App. 3.) Relying on the expert's opinion, the district court found that genuine disputes of material fact existed and denied summary judgment of non-enablement. (*Id.*)

Subsequently, ConsumerCam appealed the denial of summary judgment of non-enablement, and Ballistic Memory appealed the grant of summary judgment of patent exhaustion. (R. 5.)

STANDARD OF REVIEW

This Court applies the law of the regional circuit when reviewing a district court's grant of summary judgment involving matters of patent law. *Microsoft Corp. v. GeoTag, Inc.*, 817 F.3d 1305, 1313 (Fed. Cir. 2016) (citation omitted). The Ninth Circuit reviews the granting and denial of summary judgment *de novo*, constructing reasonable inferences most favorable to the nonmoving party. *Earl v. Nielsen Media Research, Inc.*, 658 F.3d 1108, 1112 (9th Cir. 2011) (citation omitted).

Summary judgment is appropriate when no genuine dispute of material fact exists and "the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986). The movant bears the burden of

proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). A genuine dispute exists if the evidence can support a reasonable jury to return a verdict for either party. *Anderson*, 477 U.S. at 248. A fact is material if it affects the outcome of the case. *Id.*

SUMMARY OF THE ARGUMENT

Recognizing the century-old doctrine of exhaustion, the district court granted summary judgment in favor of ConsumerCam. Finding exhaustion had occurred because, even after taking all reasonable inference most favorable to Ballistic Memory, the transaction between Ballistic Memory and ConsumerCam was a sale of patented products. Ballistic Memory also failed to establish any genuine issue of material fact under the standard set forth in *Impression Prods. v. Lexmark Int'l, Inc.* The district court found that Ballistic Memory called the agreement a “license” merely to attempt to preserve its patent rights. The contractual provisions intending to limit the resale of the Devices were simply attempts to overcome the evidence suggesting that Ballistic Memory had enjoyed full economic rewards and thereby exhausted all its right in the Device’s delivery according to this transaction. No reasonable jury could have found that ConsumerCam failed meet its burden of establishing patent exhaustion, making the district court granting summary judgment appropriate.

A patentee cannot arbitrarily induce additional public costs by framing its sales into licenses. Taking any reasonable inference most favorable to Ballistic Memory, the nature of the transaction and the intent of the parties still make this transaction a sale,

not a license. With respect to enablement, the district court failed to recognize that Ballistic Memory's expert's testimony, when properly considered, failed to raise any genuine issue of material fact. Thus, the district court failed to recognize the necessity of conducting a robust analysis for non-enablement under the *Wands* factors. Even construing Ballistic Memory's expert's opinion on the facts most favorable to Ballistic Memory, no reasonable jury would find any *Wands* factors to be satisfied. Furthermore, even without applying all eight *Wands* factors, the district court failed to recognize that the expert witness had effectively conceded that a POSITA would not be able to practice the full scope of the claims without undue experimentation. Therefore, the district court's denial of summary judgment on the non-enablement issue is entirely unjustified.

I. This Court should affirm the district court's grant of summary judgment of patent exhaustion because, when the facts and reasonable inferences are construed in Ballistic Holdings' favor, there was no genuine issue of material fact that the Agreement was a sale in all meaningful respects, which entitled ConsumerCam to judgment as a matter of law.

In all meaningful respects, the Agreement constituted a sale exhausting Ballistic Holdings' rights in the 4,000,000 units of the Device covered by the Agreement. The full price of the 4,000,000 units was paid up-front, and delivery of the units completed the sale. As the district court correctly found, "[t]he evidence overwhelmingly shows that Ballistic [Memory] sold ConsumerCam the semiconductor Devices, while framing the sale agreement as a license to attempt to preserve their patent enforcement rights."

(App. 4.)

Under the doctrine of patent exhaustion and *Impression Products v. Lexmark Int'l, Inc.*, a licensee's authorized sale exhausts the patentee's rights in the units sold. 137 S.

Ct. at 1534–35. Thus, Ballistic Memory’s sale to ConsumerCam exhausted Ballistic Holdings’ patent rights in the 4,000,000 units sold under the Agreement. Accordingly, Ballistic Memory and Ballistic Holdings (collectively “Ballistic”) can no longer impose restrictions on its bona fide purchasers’ post-sale activities using patent law. *See id.*

ConsumerCam, therefore, had no obligation under U.S. patent law to comply with the unenforceable post-sale restrictions. The district court got it exactly right when it found that ConsumerCam was entitled to summary judgment because Ballistic’s patent rights were exhausted.

A. This Court reviews the district court’s grant of summary judgment *de novo*, and the factual findings underlying the district court’s decision are reviewed for clear error.

Under Ninth Circuit law, this Court “review[s] the district court’s grant of summary judgment *de novo*.” *Earl*, 658 F.3d at 1112 (citation omitted). This Court reviews the district court’s factual findings for clear error. *Home Sav. of Am. v. United States*, 399 F.3d 1341, 1346 (Fed. Cir. 2005).

As the party asserting the affirmative defense of patent exhaustion, ConsumerCam bears the burden of showing exhaustion by a preponderance of the evidence. *See Jazz Photo Corp. v. United States*, 439 F.3d 1344, 1350 (Fed. Cir. 2006), *abrogated on other grounds by Impression Prods. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523 (2017). ConsumerCam bears the burden of showing that summary judgment is proper. *See Matsushita Elec. Indus. Co.*, 475 U.S. at 586. However, “when the moving party has carried its burden under Rule [56(a)], its opponent must do more than simply show that there is some metaphysical doubt as to the material facts.” *Id.* Thus, to prevail on

appeal, Ballistic must show that there are genuine issues, and not mere “metaphysical doubts[,] as to the material facts.” *See id.* at 586–87.

B. Ballistic’s own evidence shows that referring to the sale as a licensing agreement was merely a pretext to avoid the legal consequences of a sale.

ConsumerCam met its burden of showing patent exhaustion by a preponderance of the evidence because Ballistic’s own evidence weighs in favor of construing the Agreement as a sale. The evidence shows that references to a license agreement were made as mere pretext to retain post-sale control over the 4,000,000 units purchased by ConsumerCam. The effect of such an authorized sale is to exhaust Ballistic’s rights and nullify its right to enforce post-sale restrictions using patent laws. *See Impression Prods.*, 137 S. Ct. at 1529.

1. Labelling the sale executed by the Agreement a “nonexclusive license” cannot alter the Agreement into a license and does not create any genuine issues of material fact.

Ballistic argues that there is a genuine dispute of material fact because Ballistic contests that the Agreement is a license, while ConsumerCam maintains that the Agreement created a sale. Whether the Agreement is a sale or license is a material fact since it determines whether exhaustion occurred. *See Anderson*, 477 U.S. at 248.

However, the dispute over the interpretation of the Agreement is not genuine because the evidence cannot convince a reasonable jury to return a verdict for Ballistic. *See id.*

In determining whether a sale exhausting the patentee’s monopoly rights in the patent has occurred, courts have long “refused to allow the form into which the parties chose to cast the transaction to govern.” *United States v. Masonite Corp.*, 316 U.S. 265, 278

(1942). More importantly, disguising a sale to be a license, merely by labelling the transaction a license, cannot transform a bona fide sale into a license. *Bauer & Cie v. O'Donnell*, 229 U.S. 1, 16 (1913). From Lord Coke's time, such tactics to disguise a clear and bona fide sale as a license in order to fix the purchaser's resale price and other post-sale activities have been deemed repugnant to the public interest. *Straus v. Victor Talking Mach. Co.*, 243 U.S. 490, 500-01 (1917).

There is no genuine dispute that the Agreement constituted a sale. First, ConsumerCam paid the full, fixed price of \$32,000,000 for the 4,000,000 units purchased. (R. 3.) Even under the most rudimentary definition of a sale, this exchange of goods for a lump sum consideration constitutes a bona fide sale. *See Bauer & Cie*, 229 U.S. at 13 (“[T]o vend is to part with the thing for a consideration.”); *Sale*, *Black's Law Dictionary* (10th ed. 2014) (defining sale as a “transfer of property or title for a price”). Second, the rights received by ConsumerCam in exchange for the \$32,000,000 were exactly those that one would expect a bona fide purchaser to receive – the rights of use and resale. (R. 3.) *See Impression Prods.* 137 S. Ct. at 1534 (explaining that the purchaser has “the right to use, sell, or import [purchased items] because those are the rights that come along with ownership”). Third, Ballistic provided a two-year warranty promising to replace any defective units. (R. 3.) This warranty is characteristic of a regular sale, and further exposes the identity of the parties to the transaction as that of seller and purchaser, making the Agreement a contract for sale, rather than a “nonexclusive license.” (*Id.*)

The heart of Ballistic's argument, nonetheless, rests on the fact that it labelled the Agreement a “nonexclusive license.” (*Id.*) Ballistic's own press release, however, called

the transaction a sale. (App. 12.) By calling ConsumerCam’s subsequent sales “resales,” (R. 3 (emphasis added)), Ballistic further showed that the transaction under the Agreement resembled a sale. More importantly, the deposition testimony of Mr. Tinny, shows that Ballistic’s choice of calling the Agreement a “nonexclusive license” was strategic. (App. 21.) While Mr. Tinny understood the Agreement to have been a sale, (App. 18), he was instructed by Ballistic’s upper management to call the Agreement a license to strategically preserve Ballistic’s patent rights. (App. 20.) Ballistic employed this strategy to maintain control over ConsumerCam’s resale of the Devices in the lucrative market of blockchain technology since Ballistic knew that blockchain technology was “hot” at the moment. (R. 3; App. 13.)

Even when the facts and reasonable inferences are construed in Ballistic’s favor, there is no genuine issue to be resolved at trial regarding the character of the Agreement. The Agreement was a sale, and summary judgment in ConsumerCam’s favor should be upheld.

2. Because ConsumerCam paid Ballistic its full reward for the 4,000,000 units, Ballistic’s rights in those units were exhausted, entitling ConsumerCam to judgment as a matter of law.

The right of a patent owner to restrict the use and resale of its products practicing the patent disappears as soon as the products are placed “into the hands of a purchaser in the ordinary channels of trade and full consideration paid therefor.” *Gen. Talking Pictures Corp. v. W. Elec. Co.*, 304 U.S. 175, 180 (1938). The relevant inquiry is “whether or not there has been such a disposition of the article that it may fairly be said that the patentee has received his reward for the use of the article.” *Masonite Corp.*, 316

U.S. at 278 (citations omitted). Even when a patentee grants a license, the “transaction constitutes a sale for exhaustion purposes” if the patentee receives its full reward through the transaction. *LG Elecs., Inc. v. Bizcom Elecs., Inc.*, 453 F.3d 1364, 1370 (Fed. Cir. 2006) (citation omitted), *rev’d on other grounds*, *Quanta Comput., Inc. v. LG Elecs., Inc.*, 553 U.S. 617 (2008).

Even when the facts are viewed in the light most favorable to Ballistic, the transaction under the Agreement exhausted Ballistic’s patent rights since Ballistic received its full and fair reward from the payment of \$32,000,000. The transaction was “in the ordinary channels of trade,” and therefore, as soon as the units of the Device were placed in ConsumerCam’s possession, the sale exhausting Ballistic’s rights had occurred. *See Gen. Talking Pictures Corp.*, 304 U.S. at 180.

While Ballistic might argue that “full consideration” for the units sold under the Agreement would require the payment of the per-unit fee for selling the Devices in the blockchain market, any reasonable jury would find that Ballistic’s stance was created out of whole cloth. Post-sale conditions and restrictions on resale are unlawful under patent laws. *Impression Prods.*, 137 S. Ct. at 1529. Accordingly, these restrictions cannot bear on the sufficiency of the reward or consideration that makes a transaction a sale for patent exhaustion purposes. Holding otherwise would be to legitimize creative use of meaningless post-sale restrictions to make an end run around long-established patent law.

Furthermore, Ballistic has not proffered any evidence contrary to the fact that the payment of \$32,000,000 constituted full consideration for the 4,000,000 units sold. It has

not shown that the sale price of \$8.00 per unit initially charged to ConsumerCam was any less than what it normally charges. Even if Ballistic could show that it had offered a lower price per unit in exchange for the ability to impose post-sale restrictions, those restrictions could not be used to prevent exhaustion. *See id.* at 1525–26 (finding that even though patentee had offered a lower price, patentee could not impose post-sale restrictions in exchange for discounted price). Finally, Ballistic “must do more than simply show that there is some metaphysical doubt as to the material facts” by affirmatively showing that the \$8.00 per unit charged to ConsumerCam was less than the “full reward.” *See Matsushita Elec. Indus. Co.*, 475 U.S. at 586.

Ballistic wanted to reap the profits of ConsumerCam’s resale of the Devices, and at the same time, wanted ConsumerCam to pay full sale price per unit sold. Ballistic cannot have it both ways and recover twice for the same units of the Device. Permitting Ballistic to recover multiple times would be contradictory to the law and purpose behind the doctrine of patent exhaustion. *See Keurig, Inc. v. Sturm Foods, Inc.*, 732 F.3d 1370, 1375 (Fed. Cir. 2013). Consequently, no reasonable jury could find in Ballistic’s favor, and there are no genuine disputes of material facts. Summary judgment in ConsumerCam’s favor was therefore appropriate.

3. Imposing limitations on ConsumerCam’s post-purchase use and resale of the 4,000,000 units does not convert the sale into a license.

The restrictions on use and resale of the 4,000,000 units cannot alter the nature of the Agreement from a sale into a license. To argue that the Agreement was a license because of the restrictions, and then use the character of the Agreement as a license to

validate the restrictions, is circular and unlawful under *Impression Products*, 137 S. Ct. at 1534–35. *Impression Products* held that “[a] patentee’s authority to limit licensees does not . . . mean that patentees can use licenses to impose post-sale restrictions on *purchasers* that are enforceable through the patent laws.” *Id.* (emphasis in original).

This case should be decided the same way as *Impression Products* because the facts are similar in all meaningful respects. In *Impression Products*, the Court faced a post-sale restriction which the plaintiff-patentee argued prevented exhaustion of its patent rights. *Id.* at 1525–26. Here, this Court faces a strikingly similar argument from Ballistic. The “Return Program” customers in *Impression Products* were restricted from using the purchased cartridges more than once and from reselling or transferring the cartridges to anyone but the patentee. *Id.* at 1525. In return, the customers paid the patentee a discounted price that customers not in the “Return Program” could not avail. *Id.* As in *Impression Products*, ConsumerCam faced restrictions on resale of patented products, and the seller, Ballistic, claimed the transaction was a license because of the post-sale restrictions. In *Impression Products*, the Court found that the transactions with the Return Program customers, in all respects, operated like a sale, and the restrictions did not convert the transactions into licenses because the restrictions were post-*sale* restrictions. *Id.* at 1526, 1531. Because the restrictions here are also post-sale restrictions, this Court, just like *Impression Products*, should find that the transaction constituted a sale and exhausted patentee’s rights. *See id.*

Under *Impression Products*, Ballistic cannot use the very restrictions that needed to be validated through a license to argue that the Agreement was a license. *See* 137 S.

Ct. at 1526. The Agreement, standing alone, must be a license. Ballistic cannot show this because, save for the restrictions which are themselves not valid under patent law, ConsumerCam had received full title to the 4,000,000 units purchased for the fixed, up-front payment of \$32,000,000. (R. 3.) There is, therefore, no genuine dispute as to any material fact that the Agreement was a sale, and ConsumerCam is entitled to judgment as a matter of law.

C. ConsumerCam had no obligation under U.S. patent law to comply with Ballistic's post-sale restrictions because any reasonable jury would find that Ballistic's rights to enforce the restrictions through patent laws were exhausted.

Even though, until *Impression Products*, patentees could impose restrictions on their sale of patented products to prevent patent exhaustion, *Impression Products* pronounced that sale of patented products exhausts all patent right, "regardless of any restrictions the patentee purports to impose." 137 S. Ct. at 1526. Nonetheless, under *Impression Products*, a patentee may enforce post-sale restrictions to a limited extent "as a matter of contract law but may not do so through a patent infringement lawsuit." *Id.*

After Ballistic sold the Devices, Ballistic could no longer enforce its post-sale restrictions through the patent laws. *See id.* at 1534–35. The proper avenue for enforcing the post-sale restrictions was through a contract lawsuit. *See id.* at 1526. Pennyston's one-year statute of limitations on Ballistic's contract claim, however, had run by the time it decided to bring a lawsuit against ConsumerCam. (R. 4.) ConsumerCam's alleged breach of contract occurred on November 12, 2015. (*Id.*) Ballistic had until November 12, 2016 to bring its contract claim but chose to wait until December 3, 2016, by when the one-year statute of limitations had run. (*Id.*)

Because Ballistic cannot lawfully enforce the post-sale restrictions to demand the per-unit resale fee, either under the patent laws or contract laws, ConsumerCam has no obligation to pay the \$4.00 per-unit fee for the 2,000,000 Devices resold to OffTheBlockchain. ConsumerCam is, therefore, entitled to judgment as a matter of law as no reasonable jury can find for the non-movant Ballistic.

D. Public policy disfavors restraints on alienation, and if the district court's grant of summary judgment is not affirmed, this Court should, at minimum, order a remand back to the district court.

Enforcing Ballistic's post-sale restrictions is contrary to the public policy against restraints on alienation. Because the sale of an item incorporating a patent ensures that the patentee has secured its financial reward for the invention, "the patent laws provide no basis for restraining the use and enjoyment of the product." *Impression Prods.* 137 S. Ct. at 1526. As such, the patent exhaustion doctrine reflects a "hostility toward restraints on alienation." *Id.*

Here, Ballistic's post-sale restrictions on ConsumerCam's use, resale, and possession of the Device are all restrictions on alienation that "run afoul" of the common law principle disfavoring restrictions on alienation of property. *See id.* Accordingly, the district court's grant of summary judgment should be affirmed, and ConsumerCam should not be obligated to comply with Ballistic's attempted post-sale restrictions as a matter of public policy.

Finally, even if this Court reverses the district court's decision, ConsumerCam requests the Court to also remand the issue back to the district court. Disagreeing with the district court to hold that there is a genuine issue for trial will require this Court to

“consult a ‘vast pretrial record, with numerous conflicting affidavits, depositions, and other discovery materials.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 674 (2009) (quoting *Johnson v. Jones*, 515 U.S. 304, 316 (1995)). As such, this is a “process [that] generally involves matters more within a district court’s ken” and should be resolved on remand by the district court. *Id.*

II. This Court should reverse the district court’s decision to deny summary judgment because ConsumerCam was entitled to judgement as a matter of law that the claims are not enabled and there is no genuine dispute as to any material fact.

Even when viewing all evidence in the light most favorable to Ballistic, the evidence still does not pass the requisite threshold of enablement. Ballistic’s expert provides no corroborating evidence, rather he recites his own opinion, which confirms that the claims in the invention were created at the time of filing. First, the breadth of the claims is not commensurate with the breadth of the disclosure. Second, the district court could not reach the ultimate judgment as a matter of law because it did not make a determination of the level of skill in art or make clear the level of skill in the art that a POSITA would reasonably have. Third, because the specific dimension of the length cannot be accurately predicted without undue testing, the level of predictability in the art cannot be accurately ascertained. Finally, there is no genuine dispute of material fact regarding whether a POSITA would have been able to practice the claimed invention with respect to the amount of direction provided by the patent disclosure, which provides little to no direction as to how to make the claimed invention.

Therefore, the district court was incorrect in denying summary judgment of non-enablement, and ConsumerCam respectfully requests this Court to reverse the district court's decision.

A. This Court reviews the district court's final decision of summary judgment *de novo*, while the underlying factual basis for this determination is reviewed for clear error.

This court "review[s] the denial of a motion for judgment as a matter of law under the law of the regional circuit." *Alfred E. Mann Found. for Sci. Research v. Cochlear Corp.*, 841 F.3d 1334, 1339 (Fed. Cir. 2016). The Ninth Circuit reviews denials of summary judgment *de novo*. *Branch Banking & Tr. Co. v. D.M.S.I., LLC*, 871 F.3d 751, 759 (9th Cir. 2017) (citation omitted). This Court reviews the district court's factual findings for clear error. *Home Sav. of Am. v. United States*, 399 F.3d 1341, 1346 (Fed. Cir. 2005).

While determination of enablement is a question of law reviewed *de novo*, the underlying facts probative of enablement are reviewed for clear error. *In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1988). Because ConsumerCam moved to invalidate the '314 Patent for non-enablement, all facts and reasonable inferences are construed favorable to Ballistic. *See Earl*, 658 F.3d at 1112. The party challenging the validity of an issued patent for lack of enablement "must show by clear and convincing evidence that a [POSITA] would not be able to practice the claimed invention without 'undue experimentation.'" *Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1188 (Fed. Cir. 2014) (citing *In re Wands*, 858 F.3d at 736-737).

B. This Court should reverse the district court's decision because the district court failed to properly apply the *Wands* factors and improperly determined that ConsumerCam was not entitled to summary judgment of non-enablement.

A patent specification must contain a written description of “the manner and process of making and using” in “full, clear, concise, and exact terms” so that a POSITA can “make and use the same.” 35 U.S.C. § 112(a) (2012). Failing to meet this standard renders the claim non-enabled and invalid. *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993).

“A claim is sufficiently enabled even if a considerable amount of experimentation is necessary,” as long as “the experimentation is merely routine” and does not impose undue burdens of experimentation. *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 684 (Fed. Cir. 2015) (citing *In re Wands*, 858 F.2d at 737.) Experimentation is undue when POSITA must “exercise inventive skill” in order to practice the full scope of the invention set forth by the claims. *In re Beach*, 152 F.2d 981, 983 (C.C.P.A. 1946). In determining whether the necessary experimentation is undue, this Court considers evidence under eight *Wands* factors. *Vasudevan Software, Inc.*, 782 F.3d at 684. (citing *In re Wands*, 858 F.2d at 737). The *Wands* factors that a court may consider are:

- (1) the quantity of experimentation necessary,
- (2) the amount of direction or guidance presented,
- (3) the presence or absence of working examples,
- (4) the nature of the invention,
- (5) the state of the prior art,
- (6) the relative skill of those in the art,
- (7) the predictability or unpredictability of the art,
- and (8) the breadth of the claims.

Id. A genuine issue of material fact regarding any *Wands* factor precludes summary judgment of non-enablement. *Id.*

The facts clearly show that the *Wands* factors favor non-enablement. The '314 Patent disclosure cannot enable a POSITA to fully practice the claimed invention because Ballistic's own evidence clearly shows that the necessary enabling information was unavailable to a POSITA at the time of filing of the application. Therefore, ConsumerCam respectfully requests this Court to reverse the district court's denial of summary judgment of non-enablement.

1. There is no genuine dispute of material fact that the breadth of the claims is not commensurate with the breadth of the disclosure.

Even taking all reasonable inferences in favor of Ballistic, the specification does not teach the parameters required to achieve the claimed switching speed, and the breadth of the claims cannot be correlated with the breadth of the disclosure. "[T]he scope of enablement must be commensurate with the scope of protection sought." *In re Moore*, 439 F.2d 1232, 1236 (C.C.P.A. 1971).

When a range is claimed, there must be reasonable enablement of the scope of the range. *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). That is, the scope of the specification should bear reasonable correlation to the scope of the claim. *In re Fisher*, 427 F.2d 833, 839 (C.C.P.A. 1970). It was undisputed at the district court level that the claims should be interpreted for their plain and ordinary meaning. (App. 2.) Therefore, the district court erred in denying ConsumerCam's motion for summary judgment of non-enablement because the specification does not teach how to achieve the claimed switching speed at the time of filing.

Claim 1 is vague and broad. It captured a transistor with a graphene nanoribbon characterized by a length and a width, which results in switching speed of 1–1.2 THz. (App. 7.) Claim 1 defined the width to be 5–35 nm. (*Id.*) The length of the transistor, however, was undefined. (*Id.*) The specification only recited one “full, clear, concise, and exact” dimension – that nanoribbons with 5–15 nm width and 21–23 nm length achieved the claimed switching speed. (App. 25.) Ballistic’s expert suggested a POSITA would recognize that switching speeds of 1–1.2 THz could be achieved by simply conducting “minimum, routine experimentation” to discover the undisclosed range of the length and width. (*Id.*) However, the length range of less than 20 nm was not practicable due to manufacturing limitations at the time of filing. So, a POSITA would not have been able to find the operative range of L through routine experimentation. (*Id.*)

The expert’s statement that the claims provided a “full, clear, concise, and exact” disclosure that adequately teaches the patented invention to those skilled in the relevant art deprives the public of a meaningful inventive concept because the level of skill in the art is not defined. In addition, the claim could not be made at the time of filing to achieve the claims stated. The claims of the breadth and the disclosure need to be commensurate. The claim, however, does not specify the range and the one example given does not cover the entire range. The expert claims that the range would be obvious to a POSITA; this expert, however, is incorrect because the range cannot be practiced due to the manufacturing limitations. In fact, the patent even conceded that the technology to support the claimed range does not even exist; specifically, the patent

states that the limitation would be overcome in the near future, indicating it was not enabled at the time of filing. (App.6.)

Even when taking Ballistic's expert declaration most favorable to Ballistic, a POSITA still cannot practice the invention because of the manufacturing limitation. Undue experimentation would be required to overcome the manufacturing limitation. This still does not resolve the issue of the untaught but allegedly "recognizable" range captured by the breadth of the claim at 15–35 nm, which is twice the size of the range at 5–15 nm that is actually taught in disclosure. (App 25.) There is no genuine dispute that the breadth of the claim is not commensurate with the breadth of the disclosure, therefore ConsumerCam is entitled to summary judgment for non-enablement.

2. There is no genuine dispute of material fact regarding the level of one of ordinary skill in the art because the expert testimony and the specification demonstrate that a POSITA would not have been able to practice the claimed invention.

The claim must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Envtl. Designs, Inc. v. Union Oil Co.*, 713 F.2d 693, 694 (Fed. Cir. 1983). This requires determining what the ordinary level of skill in the art was at the time of filing. Factors to be considered in determining the level of ordinary skill in the art may include: "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

Here, the level of ordinary skill in the art at the time of filing would not have allowed a POSITA to practice the claimed invention. With the existing manufacturing limitations, a POSITA at the time of filing would not have had the skill to know how to make GNs 20 nm long. (App. 6.) Thus, undue experimentation would be required to augment the level of ordinary skill in the art that would allow sufficient enablement.

Nonetheless, Ballistic claims that there is at least a genuine dispute of material fact regarding the level of skill in the art because the district court made no explicit findings on the level of skill in the art. The district court relied on the expert's understanding of what a POSITA would know to assume the level of skill in the art. It was, however, unreasonable for the district court to rely on a person of extraordinary skill in the art, such as the expert, to determine the typical level of skill in the art. Thus, the district court erroneously assumed that the level of skill in the art at the time of filing would allow a POSITA to practice the claimed invention.

Therefore, there is no genuine dispute of material fact that the level of ordinary skill in the art factor was not met, and ConsumerCam is entitled to judgment as a matter of law.

3. There is no genuine dispute of material fact regarding the level of predictability in the art because the specific dimension of length cannot be accurately predicted without testing.

Although inventions involving electrical components are often predictable, because the invention parameter is unknowable without testing, the art in '314 Patent cannot be predicable. *See In re Vickers*, 141 F.2d 522, 526-27 (C.C.P.A. 1944).

Predicable arts are those that can be forecasted accurately without actual testing, and a single embodiment can provide a broad enablement. U.S. Patent & Trademark Office, *supra Manual of Patent Examining Procedure*, § 2164.05(a) [hereinafter *Manual*] (citing *In re Vickers*, 141 F.2d 522, 526–27 (C.C.P.A. 1944)). A field is unpredictable when a POSITA “cannot predict the outcome of an experiment without actually carrying out the experiment.” *Takeda Pharm. Co., Ltd v. Handa Pharm., LLC*, No. C-11-00840 JCS, 2013 WL 9853725, at *46 (N.D. Cal. Oct. 17, 2013).

Here, the invention is unpredictable because the switching speed cannot be predicted without experimentation. Ballistic’s expert admitted that, at the time of the invention, a POSITA “*would have* recognized that switching speed increases as [length] is decreased,” but the POSITA would still need to “experiment with different value of the [length]” to achieve the precise desirable switching speed. (App. 25 (emphasis added).) Ballistic may argue this is weak because foreseeable is “just a word” and their expert argues that it was already established at the time of filing. ConsumerCam must show that the POSITA would not have known how to make and use the invention on the basis of that disclosure; they can, indeed, do so, as what the patent claims to be achievable was not yet so at the time of filing. Rather Ballistic speculated that it would be achievable in the future with technical advancements. No reasonable inference can be drawn to suggest the desirable switching speed of different length can be predicted without experimentation. Therefore, this district court improperly ruled for summary judgment as a matter of law.

4. There is no genuine dispute of material fact that the amount of direction provided by the inventor in the patent disclosure is insufficient to make the claimed invention.

“The amount of direction needed to enable the invention is inversely related to . . . the predictability in the art.” *Manual, supra*, § 2164.03 (citing *In re Fisher*, 427 F.2d 833, 839 (C.C.P.A. 1970)). The “amount of guidance or direction” refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention.” *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004). The more predictable the art, the less the amount of guidance necessary. *Id.*

Because the inventor provided little direction on how to make the invention, this factor strongly favors the finding of non-enablement. The '314 Patent only disclosed the dimensions of the invention when the width of the nanoribbons is between 5–15 nm, leaving the exact dimension of the invention when the width of the nanoribbons is between 15–35 nm undisclosed. (App. 25.) Without knowing the exact dimension of the claimed transistor, a POSITA would not be able to make the claimed invention without further experimentation. Even with routine experimentation, a POSITA still could not make the invention. Even with routine experimentation, a POSITA still could not make the invention because while the patent recites how to make a 20 nm long nanoribbon, it was impossible to do so given the manufacturing limitations at the time of filing. Even if value is given to what the expert is saying, the claim on its own should have already provided the necessary direction without having to rely on an expert. Therefore, because the '314 Patent failed to disclose sufficient direction on how to make the claimed invention, this factor favors finding the claims of '314 Patent unenabled.

C. The totality of the circumstances show that undue experimentation would be necessary for a POSITA to practice the invention.

The Court's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. *In Re Wands*, 858 F.2d at 737. Having considered the totality of the circumstances, even if the Court finds that Ballistic meets all the *Wands* factors and all reasonable inferences are made in Ballistic's favor, ConsumerCam is still entitled to summary judgment because no reasonable juror could have found that a POSITA would have been able to practice the invention without undue experimentation.

ConsumerCam has met the burden of proving that there are no genuine disputes of material fact and is entitled to judgment as a matter of law because Ballistic cannot satisfy the *Wands* factors for enablement. Even when drawing all reasonable inferences in favor of the non-movant, there are no genuine disputes of material fact, and ConsumerCam was entitled to judgment as a matter of law for non-enablement.

CONCLUSION

Because no genuine disputes of material fact concerning both non-enablement and patent exhaustion exist or are present, and because ConsumerCam is entitled to summary judgment on the issues of exhaustion and non-enablement, ConsumerCam respectfully requests this Court to affirm the district court's grant of summary judgment that the '314 Patent is exhausted, and to reverse and remand the denial of summary judgment of non-enablement. If the Court finds that the district court's granting of

summary judgment is not warranted, ConsumerCam requests the Court to remand the case back to the district court.

PROOF OF SERVICE

Pursuant to Rule 25(d) of the Federal Rules of Appellate Procedure, Counsel for Appellee, ConsumerCam, LLC. files this BRIEF OF APPELLEE CONSUMERCAM, LLC. I hereby certify that Appellee's brief was served on the Court of Appeals for the Federal Circuit and on opposing counsel in compliance with Rule 25(d)(1)(B) and submit the following proof of service.

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Respectfully Submitted,

February 4, 2019

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