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## Fed. Circ. Wades Into Pivot Question In Canon Toner IP Row

By **Khorri Atkinson**

Law360, Washington (April 10, 2020, 6:06 PM EDT) -- A Federal Circuit panel gave few hints Friday about whether it agrees that the U.S. International Trade Commission erroneously terminated an investigation into whether several companies' imports infringed on seven Canon Inc. patents for toner cartridges used in laser-beam printers.

The dispute came to the three-judge panel last May after the ITC **affirmed** Administrative Law Judge Dee Lord's decision to grant summary determinations to Ninestar Corp., Print-Rite NA Inc. and Aster Graphics Inc. and their subsidiaries. The complaint hinges on whether claim construction of the cartridges' patents required a "pivotable coupling member" as part of its mechanism for inserting the cartridge into the printer.

The ITC ruled, without further analysis, that Judge Lord correctly concluded there was no infringement because the claims require a pivot or incline — an argument Ninestar, Print-Rite and Aster had also asserted.

During Friday's 35-minute-long teleconference hearing, the panel heard arguments on Canon's request to overturn the ITC's holding and remand the case for further proceedings on the proper claim construction. Venable LLP attorney Michael P. Sandonato, who's representing the electronics manufacturing giant, argued that the claim language Canon chose to define its invention cannot be reasonably interpreted as requiring pivoting.

The parties had agreed that the patents allow straight-line movement as a substitute for pivoting "at least at some level," the attorney added.

That prompted a swift rebuttal from U.S. Circuit Judge Kathleen O'Malley, who asserted there's no evidence in the record suggesting there was an "actual agreement" on whether there's a substitute for pivoting.

"The question really isn't if there is any pivoting that occurs," the judge said. "The argument is, 'There's a pivot,' so it's not a substitute in their view."

But Sandonato, the co-chair of Venable's IP litigation practice group, doubled down, saying "There's debate over whether there can be a complete substitute or partial substitute, [but] everyone agreed that [the straight-line movement can be a] substitute for pivoting at least at some level."

The specification of the invention, he said, indicates the angle of the coupling member's movement "should be small." Zero is an angle, and a "small angle encompasses no angle," the attorney argued.

"We're asking [the circuit court] for a claim construction that would include a zero-degree angle, a type of movement in which the coupling member doesn't tilt at all and only moved axially," Sandonato said. "That's consistent with the plain meaning of the claims here."

Canon has also argued in briefs to the circuit court that Judge Lord improperly used the patents' written description, instead of the claims, to define the invention. The judge wrongly changed the scope of the claims and made them different from what Canon applied for and the U.S. Patent and

Trademark Office allowed, the company contented.

Meanwhile, Clint Gerdine of the ITC's Office of the General Counsel told the appeals court panel that the commission's determination is appropriate. He said the patents' specification "characterizes the invention as a coupling member requiring to move ... by transmitting a rotational force from the driveshaft to the toner cartridge smoothly."

"The claimed invention and the benefits ... cannot be accomplished with the absence of pivoting," he said.

The patents-in-suit are U.S. Patent Nos. 9,746,826; 9,836,026; 9,841,729; 9,857,764; 9,857,765; 9,869,960; and 9,874,846.

Judges Pauline Newman, Kathleen O'Malley and Richard Taranto sat on the panel for the Federal Circuit.

Canon is represented by Michael P. Sandonato, Edmund J. Haughey, Dennis J. McMahon, Seth E. Boeshore and Andrew J. Kutas of Venable LLP.

The ITC is represented in-house by Clint A. Gerdine, Dominic L. Bianchi, Wayne W. Herrington and Sidney A. Rosenzweig.

The case is In the Matter of Certain Toner Cartridges and Components Thereof, case number 19-1950, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Dani Kass. Editing by Adam LoBelia.

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