IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG Plaintiff, v. TEXAS INSTRUMENTS INCORPORATED, Defendant.	Civil Action No.4:23-cv-00753-SDJ **JURY TRIAL DEMANDED**

DEFENDANT TEXAS INSTRUMENTS'
MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

TABLE OF CONTENTS

I. INTRODUCTION 1

II. STATEMENT OF ISSUES TO BE DECIDED BY THE COURT 1

III. FACTUAL BACKGROUND 2

A. Dr. Sung's Complaint accuses TI of infringing the Asserted Patents using, *inter alia*, 3M Diamond pad conditioners, like the A160 conditioner. 2

B. Dr. Sung continued to accuse all 3M Diamond pad conditioners, even after TI identified specific models like the A160 3M Diamond pad conditioner. 3

C. TI's purchase and use of the A160 3M Diamond pad conditioners long predates Dr. Sung's Asserted Patents. 4

D. Despite knowing that he is accusing prior art, Dr. Sung continues to stay the course and drive-up discovery costs. 5

IV. LEGAL BACKGROUND 5

A. Summary judgment is appropriate when there are no genuine issues of material fact. 5

B. The on-sale bar under pre-AIA 35 U.S.C. § 102(b) applies for invalidity. 6

C. When the on-sale bar involves an Accused Product, invalidity is self-proving. 7

V. ARGUMENT 10

A. Dr. Sung consistently accuses all 3M Diamond pad conditioners—including the A160—of infringement, even after being told this product was prior art. 10

B. The Asserted Claims are invalid because the A160 3M Diamond pad conditioner was on sale (and purchased by TI) by September 20, 2000—well before the Asserted Patents' critical dates. 11

C. Resolution of this issue is ripe now. 13

VI. CONCLUSION 16

TABLE OF AUTHORITIES

CASES

Alacritech Inc. v. CenturyLink, Inc.
No. 2:16-CV-00693-JRG-RSP, 2017 WL 3007464 (E.D. Tex. July 14, 2017) 15

Allied Machine & Engineering Corp. v. Competitive Carbide, Inc.
No. 1:10-cv-773, 2011 WL 13193425 (N.D. Ohio July 5, 2011)..... 9, 14

Alpek Polyester, S.A. de C.V. v. Polymetrix AG
No. 2021-1706, 2021 WL 5974163 (Fed. Cir. Dec. 16, 2021)..... 5

Anderson v. Liberty Lobby, Inc.
477 U.S. 242 (1986)..... 6

Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.
731 F.2d 831 (Fed. Cir. 1984)..... 5

Bennett Regul. Guards, Inc. v. Canadian Meter Co., Inc.
184 Fed. App'x. 977 (Fed. Cir. 2006)..... 8

Big Baboon, Inc. v. SAP America, Inc.
No. 4:17-cv-02082-HSG, 2019 WL 1791421 (N.D. Cal. Apr. 24, 2019)
aff'd, 819 F. App'x 928 (Fed. Cir. 2020)..... 9, 14

Bright Ideas Co., Inc. v. Target Corp.
No. MJG-05-30l5, 2006 WL 6903811 (D. Md. Aug. 25, 2006)..... 10

Chien-Min Sung v. 3M Corp
No. 2:02-cv-191, Dkt. No. 1 (E.D. Tex. Aug. 19, 2002) 15

Cummings v. Adidas USA
716 F. Supp. 2d 323 (S.D.N.Y 2010)..... 10

D.L. Auld Co. v. Chroma Graphics Corp.
714 F.2d 1144 (Fed. Cir. 1983)..... 7, 13

Davis v. A.G. Edwards & Sons, Inc.
823 F.2d 105 (5th Cir. 1987) 14

Dean v. PowerTech Marine, Inc.
No. 5:19-cv-1567, 2023 WL 199682 (W.D. La. Jan. 17, 2023)..... 9

Dippin' Dots, Inc. v. Mosey
476 F.3d 1337 (Fed. Cir. 2007)..... 7, 13

Electromotive Div. of Gen. Motors Corp. v. Transp. Sys. Div. of Gen. Elec.
417 F.3d 1203 (Fed. Cir. 2005)..... 12

Empire Tech. Grp. Ltd. v. Light & Wonder, Inc.
No. 2:22-CV-00923-MMD-BNW, 2023 WL 8529084 (D. Nev. Dec. 7, 2023) 9, 14

Enzo Biochem, Inc. v. Gen-Probe, Inc.
424 F.3d 1276 (Fed. Cir. 2005)..... 6, 13

Evans Cooling Sys., Inc. v. Gen. Motors Corp.
125 F.3d 1448 (Fed. Cir. 1997)..... passim

FMC Techs., Inc. v. OneSubsea IP UK Ltd.
412 F. Supp. 3d 706 (S.D. Tex. 2019) 10

Gammino v. Southwestern Bell Tel., L.P.
512 F. Supp. 2d 626 (N.D. Tex. 2007) 10

In re King
801 F.2d 1324 (Fed. Cir. 1986)..... 6, 13

Matsushita Elec. Indus. Co. v. Zenith Radio Corp.
475 U.S. 574 (1986)..... 5

Minton v. National Ass'n. of Securities Dealers, Inc.
336 F.3d 1373 (Fed. Cir. 2003)..... 6

Perfect Surgical Techs., Inc. v. Olympus Am., Inc.
No. 4:12-cv-05967, 2013 WL 12214189 (N.D. Cal. Dec. 16, 2013) 10

Peters v. Active Mfg. Co.
129 U.S. 530 (1889)..... 1

Robotic Vision Sys., Inc. v. View Eng'g, Inc.
249 F.3d 1307 (Fed. Cir. 2001)..... 6

SRI Int'l v. Matsushita Elec. Corp. of Am.
775 F.2d 1107 (Fed. Cir. 1985)..... 5

Upsher-Smith Lab., Inc. v. Pamlab, LLC
412 F.3d 1319 (Fed. Cir. 2005)..... 7

Vanmoor v. Wal-Mart Stores, Inc.
201 F.3d 1363 (Fed. Cir. 2000)..... 6, 7, 8

WPEM, LLC v. SOTI Inc.
837 F. App'x 773 (Fed. Cir. 2020) 15

ZT IP, LLC v. VMware, Inc.
No. 3:22-CV-0970, 2023 WL 1785769 (N.D. Tex. 2023) 15

STATUTES

35 U.S.C. § 102(b) ..... passim

35 U.S.C. § 271(g) 13

RULES

Fed. R. Civ. P. 56 5

Fed. R. Civ. P. 56(d) 14

Fed. R. Civ. P. 56(e) 5

P.R. 3-1 3

P.R. 3-1(b) 3, 10

I. INTRODUCTION

This is a uniquely frivolous case warranting early summary judgment and dismissal. Dr. Sung accused the prior art of infringement. Neither of the two facts needed to grant this motion can be genuinely disputed:

> (1) Dr. Sung accused TI of infringing the asserted patents by using third party 3M's "Diamond pad conditioner" products, and
>
> (2) certain of these accused 3M Diamond pad conditioners were "on sale"—and in fact sold to TI and in use—up to a decade before the Asserted Patents alleged critical dates (that is, for § 102(b), one year before the earliest effective filing dates).

These facts doom Dr. Sung's patents under 35 U.S.C. §102(b) even at this early stage. It is axiomatic "that which infringes, if later, would anticipate if earlier." *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889). Indeed, the Federal Circuit has explained that in this atypical scenario where a prior art product is accused of infringement, defendant's "burden [to show invalidity] is met by [plaintiff's] allegation, forming the sole basis for the complaint, that the [prior art] infringes." *Evans Cooling Sys., Inc. v. Gen. Motors Corp.*, 125 F.3d 1448, 1451 (Fed. Cir. 1997). Thus, the Court can determine—even at this early stage—that the asserted claims are invalid based on Dr. Sung's own allegations of infringement without the need for claim construction or expert testimony. *Id.*

TI respectfully requests that the Court grant summary judgment that the asserted claims of Dr. Sung's '862, '802, and '270 patents are invalid under 35 U.S.C. § 102(b), dismiss this case with prejudice, and issue a judgment in TI's favor on its counterclaims 1–3 of invalidity.

II. STATEMENT OF ISSUES TO BE DECIDED BY THE COURT

Where Dr. Sung alleges that certain prior art CMP conditioner products infringe the Asserted Claims, should the Court grant summary judgment that the Asserted Claims are invalid under 35 U.S.C. §102(b) pursuant to, *e.g.*, *Evans Cooling*, 125 F.3d at 1451?

III. FACTUAL BACKGROUND

A. Dr. Sung's Complaint accuses TI of infringing the Asserted Patents using, *inter alia*, 3M Diamond pad conditioners, like the A160 conditioner.

In his Complaint, Dr. Sung asserts three patents against TI: U.S. Patent Nos. 9,138,862 ("the '862 patent"), 9,724,802 ("the '802 patent") and 8,974,270 ("the '270 patent") (collectively, the "Asserted Patents"). Dkt. No. 1 ("Complaint") at ¶ 25.[1] The Asserted Patents "relate to chemical mechanical polishing/planarization ("CMP") pad dressers and dressing and conditioning methods." *Id.* As the Complaint acknowledges, the CMP process is a standard semiconductor manufacturing process used to polish or planarize the surface of the semiconductor wafers[2] by removing excess material through both chemical and mechanical reactions. *See id.* at ¶ 26. With CMP, a wafer is pressed into and rotated against a polishing pad in conjunction with a slurry to remove protrusions and planarize the surface. *See id.* To extend the life of the CMP pads, a CMP pad "conditioner" is rotated against the CMP pad in conjunction to condition or regenerate the surface of the CMP pad. *See id.* at ¶ 27.[3]

For each of the Asserted Patents, Dr. Sung's infringement allegations are premised on TI's use of CMP pad conditioner products purchased from third parties such as 3M. *See, e.g.*, Complaint at ¶¶ 31, 35, 36, 59, 81. One relevant group of accused products is 3M's Diamond pad

---

[1] Dr. Sung previously worked for a Taiwanese company named Kinik. But Dr. Sung's relationship with Kinik ended in litigation and criminal charges in Taiwan and the US for breach of their agreements, including allegedly improperly taking intellectual property that belonged to Kinik (including the Asserted Patents). *See* Ex. 6, *Chien-Min Sung v. Kinik Company*, No. 1:14-cv-01027, Dkt. No 37 at ¶ 10 (Nov. 5, 2015, D. Del). Dr. Sung also pled guilty to a felony relating to his misappropriation of GE trade secrets. *See* Ex. 1, Sung Dep., IPR2014-01523, Paper 1014 (June 4, 2015); Ex. 2, *In the matter of Certain Abrasive Products*, 337-TA-449, Hr'g Tr. (Oct. 17, 2001).

[2] In semiconductor manufacturing, multiple integrated circuits are manufactured on a large circular slice of semiconductor material called a wafer. Wafers must then be sliced and packaged into individual chips.

[3] An illustration of a typical CMP process can be seen in Figure 1 of TI's U.S. Patent No. 5,522,965 from 1996. *See* Ex. 3 at 2 (annotations to Figure 1 added).

conditioners. *Id.* Exhibits 4, 9, and 14 to the Complaint purport to chart how the 3M Accused Instrumentalities infringe the Asserted Patents and generally identify 3M Diamond pad conditioners as accused products. *See* Complaint Ex. 4 at 1–3; Ex. 19 at 1–3, Ex. 14 at 1–2; *see also id.* at ¶¶ 37, 60, 82. Each of these Exhibits refer to the same page of 3M's website related to 3M Diamond pad conditioners: "https://www.3m.com/3M/en_US/p/d/b5005035338." *See, e.g.*, Complaint Ex. 4 at 3. This 3M webpage identifies several "Product Series" within the "3M Diamond Pad Conditioner" group, including the A160 model conditioner. The website has an A160 datasheet as its top link on "Frequently viewed resources," and it lists the A160 datasheet first in the "Resources" section of the page.

B. Dr. Sung continued to accuse all 3M Diamond pad conditioners, even after TI identified specific models like the A160 3M Diamond pad conditioner.

Before Dr. Sung served his infringement contentions, he served discovery on TI requesting that TI identify the specific models of accused third party pad conditioners that it was using. TI responded and identified, among others, the 3M Diamond pad conditioner model A160. Ex. 4 at 6, TI Response to Sung 1st Set of Interrogatories (Nos. 1-11), Appendix A.

Dr. Sung subsequently served his infringement contentions—asserting '862 patent claims 1–13, 15, 17–20; '802 patent claims 1–21; and '270 patent claims 1–8 ("Asserted Claims"). Ex. 5 at 2–4, (Sung Infringement Contentions Cover Pleading). Rather than identifying each (or any) accused instrumentality "by name or model number" as required by P.R. 3-1, Dr. Sung's contentions parroted the Complaint's general accusations against all 3M Diamond pad conditioners, failing to identify or chart any specific model despite obtaining discovery from TI on specific 3M Diamond pad conditioner models it was using.

TI emailed Dr. Sung's counsel noting how Dr. Sung's contentions failed to comply with the Local Patent Rule 3-1(b) and requesting Dr. Sung confirm if any of the specific conditioners

that TI uses—like the A160—were accused of infringement. Ex. 7 at 13, 9, 5 and 2 (Email re Deficiencies with Sung's Infringement Contentions). After refusing to answer for weeks, Dr. Sung's counsel ultimately confirmed that Dr. Sung was indeed accusing ***all*** 3M Diamond pad conditioners. *Id.* at 1 and 3

C. TI's purchase and use of the A160 3M Diamond pad conditioners long predates Dr. Sung's Asserted Patents.

Even assuming Dr. Sung's alleged priority dates, TI's purchase and use of the A160 predates the Asserted Patents ***by years***. [redacted] *Id.* Yet, TI's business records and witness testimony show that [redacted]

Moreover, 3M documents produced in response to Dr. Sung's subpoena corroborate that the A160 Diamond Pad Conditioner was on sale and in use at TI before the alleged critical dates. *See, e.g.*, [redacted]

[4] Notably, in a prior case, Dr. Sung declared under penalty of perjury that he invented the '802 patent ***after*** Oct. 28, 2013. Ex. 13 at 5. And Dr. Sung's counsel ***in this case*** stated, "its contention is and will remain that the priority date [for the '802 patent] is Oct. 3, 2014." Ex. 20 at 1. Based on this, the Court found Dr. Sung "only claims priority to October 3, 2014." Ex. 14 at 2. But for purposes of this motion, TI does not need to dispute the claimed priority.

[redacted]

D. Despite knowing that he is accusing prior art, Dr. Sung continues to stay the course and drive-up discovery costs.

After confirming Dr. Sung was in fact intentionally accusing TI's use of the A160 3M Diamond pad conditioners, TI conferred with Dr. Sung's counsel multiple times. TI explained that the accused A160 was prior art and that TI had been using these A160 conditioners since the early 2000s (as documented in its invalidity contentions and corroborated by both TI and third-party 3M documentation). Nevertheless, Dr. Sung reaffirmed his contentions, continuing to accuse TI's use of all 3M Diamond pad conditioners, including use of the A160 conditioner.

IV. LEGAL BACKGROUND

A. Summary judgment is appropriate when there are no genuine issues of material fact.

"[S]ummary judgment is a procedural device for promptly disposing of actions in which there is no genuine issue of any material fact even though such issue might have been raised by formal pleadings." *Alpek Polyester, S.A. de C.V. v. Polymetrix AG*, No. 2021-1706, 2021 WL 5974163, at *5 (Fed. Cir. Dec. 16, 2021). "[C]ourt[s] should utilize the salutary procedure of Fed. R. Civ. P. 56 to avoid unnecessary expense to the parties and wasteful utilization of the jury process and judicial resources." *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984). The burden of demonstrating the absence of any genuine dispute of material fact initially rests with the movant. *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1116 (Fed. Cir. 1985) (en banc). If met, the burden then shifts to the nonmovant to "set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e); *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). "[T]he mere existence of *some*

alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment . . . ." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247–48 (1986).

B. The on-sale bar under pre-AIA 35 U.S.C. § 102(b) applies for invalidity.

Under 35 U.S.C. § 102(b),[5] a "person shall be entitled to a patent unless . . . (b) the invention was . . . on sale in this country, more than one year prior to the date of the application for patent in the United States." To show a patent claim is invalid under § 102(b), a challenger must prove by clear and convincing evidence that a product embodying the invention in the claim was "on sale" more than one year prior to the earliest application date to which the patent claims priority (the "critical date"). *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000). Invalidity under the on-sale bar is a question of law with underlying questions of fact. *Robotic Vision Sys., Inc. v. View Eng'g, Inc.*, 249 F.3d 1307, 1310 (Fed. Cir. 2001).

The on-sale bar equally applies to method claims. *Minton v. National Ass'n. of Securities Dealers, Inc.*, 336 F.3d 1373, 1378 (Fed. Cir. 2003) (ruling lease of patentee's trading system to a local brokerage firm raised an on-sale bar against patentee's method claims because the system substantially "embod[ied] the claimed method"). For example, a prior art product "can be used to support an anticipation rejection of method claims that, in essence, simply define what happens when that [product] is placed in the environment in which the [product] will be used." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986); *accord Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1285 (Fed. Cir. 2005) ("[T]he offer to sell the compositions invalidates [method of use claims] based on those same [products]."). Likewise, the sale of a product produced by a patented process creates an on-sale bar that invalidates method claims covering that process. *Dippin' Dots,*

[5] As previously discussed, all alleged priority dates pre-date the Leahy-Smith America Invents Act of 2012. Therefore, TI bases this motion on pre-AIA law, but the result would be the same under the AIA.

Inc. v. Mosey, 476 F.3d 1337, 1344 (Fed. Cir. 2007) ("The public sale of goods produced by a process more than one year before a patent is filed places that process in the § 102(b) prior art."); *see also D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147–48 (Fed. Cir. 1983) (affirming summary judgment that patentee's pre-critical date sales of a product made by the patented process created an on-sale bar that invalidated method claims).

C. When the on-sale bar involves an Accused Product, invalidity is self-proving.

In a typical case applying § 102(b)'s on-sale bar, the accused infringer must demonstrate that the prior art contains each and every limitation of the asserted claims. However, "[a] century-old axiom of patent law holds that a product 'which would literally infringe if later in time anticipates if earlier.'" *Upsher-Smith Lab., Inc. v. Pamlab, LLC*, 412 F.3d 1319, 1322 (Fed. Cir. 2005) (citation omitted). Thus, where an accused product itself was on sale before the critical dates of the asserted patents (like is the case here), the accused infringer need not show that the product meets the elements of the claims—instead, that showing is completely satisfied by the plaintiff's own infringement allegations. *Evans Cooling*, 125 F.3d at 1451; *Vanmoor*, 201 F.3d at 1366. In this atypical situation—where the patentee has accused a prior art product of infringement—no claim construction or comparison of the product to the claims is needed. The only showing required for summary judgment of invalidity is that the accused product was on sale prior to the critical date.

The prime example of this principle is *Evans Cooling*. There, the plaintiff alleged that GM's LT1 engine contained a cooling system that infringed plaintiff's patent. 125 F.3d at 1450. The district court granted GM's motion for summary judgment of invalidity on GM's showing that its dealers put the accused LT1 engine on sale to retail customers more than one year prior to the priority date of the patent. *Id.* In affirming the district court's holding, the Federal Circuit rejected

plaintiff's contention that GM had not demonstrated that the accused LT1 engine actually met (*i.e.*, anticipated) each and every limitation of the asserted claims:

> Evans . . . argue[s] that summary judgment was inappropriate because GM did not meet its burden of proving by clear and convincing evidence that the [LT1] engine of the 1992 Corvette anticipated the claims of the '636 patent. . . .We do not agree. This is not the typical case where the patentee has placed some device on sale prior to the critical date and the accused infringer must demonstrate that this device actually embodied or rendered obvious the patented invention. Here, the entire basis of the lawsuit is Evans'—the patentee's—contention that the LT1 engine—the device that was put on sale—contains a cooling system that infringes. . . . Although GM bore the burden of proving that the LT1 engine embodied the patented engine or rendered it obvious for purposes of the summary judgment motion, this burden is met by Evans' allegation, forming the sole basis for the complaint, that the LT1 engine infringes.

Id. at 1451.

Similarly, in *Vanmoor*, the plaintiff accused defendants of infringing his patent by selling a cartridge used to dispense caulking compound. 201 F.3d at 1364–65. In affirming summary judgment, the Federal Circuit held that, while the defendants "bore the burden of proving" the accused cartridges anticipated plaintiff's patent, "that burden was satisfied by plaintiff's allegation that the accused cartridges infringe the [] patent." *Id.*[6] Because there was no genuine dispute that some of the accused cartridges were on sale and used before the critical date, plaintiff's patent was invalid, and defendants were entitled to summary judgment. *Id.* at 1367.

District courts around the country have followed *Evans Cooling* and *Vanmoor*, granting summary judgment of invalidity when the accused product was shown to be on-sale prior art. For example, in *Allied Machine & Engineering Corp. v. Competitive Carbide, Inc.*, the plaintiff's complaint accused two products of infringement. No. 1:10-cv-773, 2011 WL 13193425, at *1

[6] *See also Bennett Regul. Guards, Inc. v. Canadian Meter Co., Inc.*, 184 Fed. App'x. 977, 978 n.1 (Fed. Cir. 2006) ("When the anticipatory reference is the accused product, the Defendant's burden [of showing that the anticipatory reference contains each and every claim element] is satisfied by the Plaintiff's infringement allegations in the Complaint that the accused product embodies the claimed invention.").

(N.D. Ohio July 5, 2011). After the case management conference, the defendant moved for summary judgment of invalidity because one of the products identified in the complaint had been on sale before the critical date. *Id.* Although the plaintiff tried to recant its claim against the prior art product, the court granted summary judgment of invalidity based on the complaint's accusations. *Id.* at *3.

Likewise, in *Big Baboon, Inc. v. SAP America, Inc.*, the plaintiff identified several products in its complaint as allegedly infringing, including an "R/3 3.1" product. No. 4:17-cv-02082-HSG, 2019 WL 1791421, at *2 (N.D. Cal. Apr. 24, 2019), *aff'd*, 819 F. App'x 928 (Fed. Cir. 2020). Thereafter, defendants moved for summary judgment of invalidity, showing that the R/3 3.1 product had been sold before the critical date. *Id.* The Court granted the early summary judgment—finding that "Plaintiff's accusations serve as a 'binding admission' that satisfies Defendants' burden to prove for purposes of its invalidity argument that the accused product contains all of the elements of the asserted claims." *Id.* Although the plaintiff tried to "reverse course" and suggest only certain versions of the R/3 3.1 product were accused, the Court rejected plaintiff's suggestion that it was "entitled to conduct discovery on the technical modification timeline of the R/3 3.1 system" based on speculated differences—finding that "Plaintiff's own allegation that R/3 3.1 is the infringing product obviates the need for an element-by-element analysis that might make additional discovery potentially necessary." *Id.* at *3–4.

Many other courts have reached similar conclusions in § 102(b) cases.[7] In these cases, no claim construction or technical analysis was necessary to resolve the summary judgment motion.

[7] *Empire Tech. Grp. Ltd. v. Light & Wonder, Inc.*, No. 2:22-CV-00923-MMD-BNW, 2023 WL 8529084, at *3 (D. Nev. Dec. 7, 2023) (granting summary judgment after limited discovery "because [plaintiff's] display and demonstration of the accused [product] … was an invalidating prior public use"); *Dean v. PowerTech Marine, Inc.*, No. 5:19-cv-1567, 2023 WL 199682, at *4 (W.D. La. Jan. 17, 2023) (granting summary judgment—even after plaintiff dismissed its claims—

Because the patentee accused the product of infringement, coverage of the product by the claims was necessarily conceded by the patentee, and the only remaining question was whether the accused product was on sale before the critical date. That is precisely the scenario at issue here.

V. ARGUMENT

A. Dr. Sung consistently accuses all 3M Diamond pad conditioners—including the A160—of infringement, even after being told this product was prior art.

From his Complaint to his infringement contentions, Dr. Sung has consistently taken the position that all 3M Diamond pad conditioners are accused of infringement. Dr. Sung's accusations against 3M Diamond pad conditioners were not accidental—they are central to his broad theory of infringement. Instead of actually identifying specific products and charting each of them against the asserted claims, Dr. Sung chose to file a Complaint and serve contentions that rely on general allegations against the entire category of 3M Diamond pad conditioners.

After TI noted that Dr. Sung's contentions failed to comply with Local Patent Rule 3-1(b), Dr. Sung's counsel persisted with its claim that Dr. Sung's Complaint and contentions were not

---

because "[plaintiff's] infringement allegations invalidate his own patent" when an "materially identical" version of the accused product was on sale before priority date of asserted patent); *FMC Techs., Inc. v. OneSubsea IP UK Ltd.*, 412 F. Supp. 3d 706, 716 (S.D. Tex. 2019) (granting summary judgment of invalidity where accused infringer presented "evidence that [a version of the accused product], which is materially identical to the [accused product] was the subject of a commercial sale to Shell before the effective filing date for the [asserted] Patent.); *Cummings v. Adidas USA*, 716 F. Supp. 2d 323, 328-29, 334 (S.D.N.Y 2010) (granting summary judgment of invalidity because sales records showed that Nike had sold eighteen samples of the accused shoe to sales representatives and showrooms before the critical date); *Bright Ideas Co., Inc. v. Target Corp.*, No. MJG-05-3015, 2006 WL 6903811, at *2-4 (D. Md. Aug. 25, 2006) (finding business records, including order forms sent to prospective customers and reports reflecting the existence of unshipped orders for the accused product prior to the critical date justified summary judgment of invalidity); *Gammino v. Southwestern Bell Tel., L.P.*, 512 F. Supp. 2d 626, 637 (N.D. Tex. 2007) (grating summary judgment of invalidity, noting that "Gammino cannot have it both ways—he cannot recover for infringement on the basis of [the alleged infringing telephone service] if those same services existed in prior art."); *Perfect Surgical Techs., Inc. v. Olympus Am., Inc.*, No. 4:12-cv-5967, 2013 WL 12214189, at *2 (N.D. Cal. Dec. 16, 2013) (granting summary judgment that a product identical to the accused product was on sale before the critical date, but limiting invalidity to the instant lawsuit and its defendants).

limited to any specific 3M Diamond pad conditioners models—covering not only the models that TI identified in discovery such as the A160, but *all* 3M Diamond pad conditioners. [redacted]

And Dr. Sung never disputed that he was accusing the A160 3M Diamond pad conditioner. To the contrary, Dr. Sung and his counsel continued to insist they were entitled to accuse the A160 3M Diamond pad conditioner even after (1) 3M produced documents confirming it was prior art, (2) TI charted the A160 3M Diamond pad conditioner as prior art in its invalidity contentions, (3) TI produced purchase records corroborating its predating purchase and use of A160 3M Diamond pad conditioners, and (4) TI's counsel told lead counsel for Dr. Sung that he was accusing prior art A160 conditioners on multiple meet and confers leading up to this motion.

B. The Asserted Claims are invalid because the A160 3M Diamond pad conditioner was on sale (and purchased by TI) by September 20, 2000—well before the Asserted Patents' critical dates.

Dr. Sung's own allegation of infringement against 3M Diamond pad conditioners like the A160 carries TI's burden of establishing that the product met all elements of the Asserted Claims at the time of sale. *See Evans Cooling*, 125 F.3d at 1451 (holding that defendants' burden of showing the claims were anticipated by the accused product was "met by [the patentee's] allegation . . . that the [product] infringes"). [redacted]

Dr. Sung cannot genuinely dispute that the A160 was on sale before these critical dates. Sales records, supporting documents, and testimony all establish that 3M had sold (and TI had purchased and used) thousands of A160 3M Diamond pad conditioners before these critical dates. TI's purchasing records memorialize these 3M sales. [redacted]

[redacted]

Ex. 8 at ¶ 6, Ex. A. [redacted] Even "a single sale or offer for sale suffices to bar patentability." *Electromotive Div. of Gen. Motors Corp. v. Transp. Sys. Div. of Gen. Elec.*, 417 F.3d 1203, 1210 (Fed. Cir. 2005). Here, there were thousands of A160 conditioners sold, delivered, and used ***by TI alone*** before the relevant critical dates. Each such purchase is sufficient to invalidate the Asserted Patents under § 102(b).

The on-sale bar applies equally to the asserted apparatus and method claims. With respect to the '802 and '270 patents (which only have apparatus claims), Dr. Sung is reading those claims directly on the 3M Diamond pad conditioners, including the A160. Thus, the sale and use of the A160 renders the Asserted Claims for the '802 and '270 patents invalid by the § 102(b) on-sale bar. *Evans Cooling*, 125 F.3d at 1451. With respect to the '862 patent (which only has method claims), Dr. Sung is reading his claims on TI's use of the 3M Diamond pad conditioners, including

the A160, and is also alleging that TI infringes by importing its own semiconductor products that were manufactured with a CMP process that involved these 3M Diamond pad conditioners under 35 U.S.C. § 271(g). Ex. 15 (Sung's 3M '862 Infringement Chart) at 1 [redacted]; *see also id.* at 2–4, 16 (identifying the A160), 24 (same). Here too, the on-sale bar applies because the '862 patent's methods are merely methods of use that "in essence, simply define what happens when that [product] is placed in the environment in which the [product] will be used." *In re King*, 801 F.2d at 1326; *see also Enzo Biochem*, 424 F.3d at 1285. Tellingly, even for claim 12, which discusses CMP polishing of semiconductors and not the conditioner directly, Dr. Sung's contentions cite to a 3M datasheet ***for a conditioner***, not any information about TI semiconductors. Ex. 15 at 44. [redacted] Thus, to the extent that Dr. Sung's '862 patent's method claims cover TI end products manufactured using CMP pads conditioned with 3M Diamond pad conditioners, then TI's sales [redacted] are also 102(b) prior art that invalidates these method claims. *See Dippin' Dots*, 476 F.3d at 1344 ("The public sale of goods produced by a process more than one year before a patent is filed places that process in the § 102(b) prior art."); *D.L. Auld*, 714 F.2d at 1147–48.

C. Resolution of this issue is ripe now.

Prior to bringing this motion, TI provided Dr. Sung with evidence of its purchases of the A160 3M Diamond conditioner before the critical date and asked Dr. Sung to dismiss its case or at least limit it (and discovery) to specific conditioners that are not prior art. Dr. Sung responded

that it did not matter that he was accusing prior art at this stage of the case, and he will not address it until after significant discovery takes place. But this approach to litigation is improper and contrary to law.

This motion under *Evans Cooling* is premised on Dr. Sung's accusation that the A160 3M Diamond pad conditioner meets the elements of the claims. Any request for discovery about how the A160 operates, the extent of TI's current use of the A160, or other CMP conditioners are irrelevant to this motion. As case law confirms, when the patent owner accuses a specific product of infringement, as was done here with the A160 3M Diamond pad conditioner, it concedes that the product meets the elements of the claims. As such, claim construction and an element-by-element comparison are not needed, making the issue ripe for early disposition. *See, e.g.*, *Big Baboon*, 2019 WL 1791421 at *2 (resolving case early and rejecting request for additional discovery under Rule 56(d)); *Allied Mach.*, 2011 WL 13193425 at *2-3 (granting summary judgment after case management conference). And while TI repeatedly tried to address this issue with Dr. Sung without motion practice, it is now irrelevant to this motion whether Dr. Sung decides to drop his allegations against all 3M Diamond pad conditioners, or just the A160. Dr. Sung's Complaint and infringement contentions are binding admissions, and he may not reverse course. *See, e.g.*, *Big Baboon*, 2019 WL 1791421, at *3 (rejecting plaintiff's attempt to "reverse course," finding that the allegations in the complaint constituted binding admissions); *Empire Tech.*, 2023 WL 8529084 at *3 (same); *see also Davis v. A.G. Edwards & Sons, Inc.*, 823 F.2d 105, 108 (5th Cir. 1987) ("[F]actual assertions in pleadings are . . . judicial admissions conclusively binding on the party that made them." (citation and quotation omitted)).

The only discovery relevant to the material facts raised in this motion is whether the 3M Diamond pad conditioners, like the A160 (what Dr. Sung accused of infringement), were on sale

[redacted] This is a simple question to answer. A basic search of public evidence before filing this case would have revealed that the A160 3M Diamond pad conditioner predates the Asserted Patents. For example, 3M's US Patent No. 7,125,324, which was filed on March 9, 2004, identifies the "diamond pad conditioner, obtained from 3M of St. Paul, Minn., ***under the designation A160***" as a commercially available product. Ex. 16 (emphasis added). Under the Patent Rules, Dr. Sung and his counsel were "expected to rigorously analyze all publicly available information before bringing suit." *Alacritech Inc. v. CenturyLink, Inc.*, No. 2:16-CV-00693-JRG-RSP, 2017 WL 3007464, at *1 (E.D. Tex. July 14, 2017) (citing cases). Thus, Dr. Sung cannot feign ignorance[8] that the A160 3M Diamond pad conditioner is prior art. Moreover, Dr. Sung already sought discovery from 3M ***in this case*** that confirms that A160 is prior art. *See, e.g.*, Exs. 9, 10, 11. And 3M witness's sworn testimony confirms [redacted]. Ex. 12. In short, Dr. Sung has no excuse for filing this case directly accusing prior art and for refusing to drop such allegations after TI pointed it out.[9]

[8] In fact, Dr. Sung knows these products are prior art because he has been involved in two prior lawsuits involving 3M Diamond pad conditioners. First, in 2001, 3M sued Kinik, where Dr. Sung worked at the time, in the International Trade Court ("ITC") for infringing one of its patents, and Dr. Sung was a witness. *See, e.g.*, Ex. 17 (witness list). In that ITC action, 3M's Diamond pad conditioners played a prominent role as the basis for 3M's domestic industry. *See* Ex. 18 (showing advertising for 3M Diamond pad conditioners was admitted into evidence in October 2001 as Ex. C-35); Ex. 19 (ITC Ex. C-35). And in 2002, Dr. Sung (still at Kinik) was the plaintiff in a case against 3M, accusing 3M Diamond pad conditioners of infringing a patent unrelated to the patents here. *Chien-Min Sung v. 3M Corp*, No. 2:02-cv-191, Dkt. No. 1 (E.D. Tex. Aug. 19, 2002).

[9] *Accord WPEM, LLC v. SOTI Inc.*, 837 F. App'x 773, 775 (Fed. Cir. 2020) (affirming § 285 fees, where a reasonable investigation "would have tipped off a reasonable plaintiff to evaluate whether the product accused of infringement predates, and therefore potentially anticipates, the asserted patent claims."); *ZT IP, LLC v. VMware, Inc.*, No. 3:22-CV-970, 2023 WL 1785769, *3-4 (N.D. Tex. 2023) (awarding § 285 fees to the accused infringer where the publicly available evidence that the patentee relied on to prove infringement, a user's manual for the accused product, proved that the accused product was prior art to the asserted patent) ("Put bluntly, [plaintiff] had ample opportunities to recognize the frivolousness of its position…").

VI. CONCLUSION

Simply put, Dr. Sung's allegations against prior art doom his case and it is improper for him to continue prosecution of this litigation. For the reasons given above, TI respectfully requests that the Court grant TI summary judgment of invalidity, holding the Asserted Claims—'862 patent claims 1–13, 15, 17–20; '802 patent claims 1-21; and '270 patent claims 1–8—invalid under 35 U.S.C. § 102(b); dismiss this case with prejudice; and issue a judgment in TI's favor on its counterclaims 1–3 of invalidity.

DATED: March 13, 2024

Respectfully submitted,

/s/ Bradley W. Caldwell
Bradley W. Caldwell
Texas State Bar No. 24040630
Email: bcaldwell@caldwellcc.com
Robert Seth Reich, Jr.
Texas State Bar No. 24088283
Email: sreich@caldwellcc.com
Aisha M. Haley
Georgia State Bar No. 656793
Email: ahaley@caldwellcc.com
CALDWELL CASSADY CURRY P.C.
2121 N. Pearl St., Suite 1200
Dallas, Texas 75201
Telephone: (214) 888-4848
Facsimile: (214) 888-4849

Amanda A. Abraham
Texas State Bar No. 24055077
Email: aa@rothfirm.com
ROTH & ABRAHAM LAW FIRM
115 North Wellington, Suite 200
Marshall, Texas 75670
Telephone: (903) 935-1665
Facsimile: (903) 935-1797

Andrea Leigh Fair
Texas State Bar No. 24078488
Email: andrea@wsfirm.com
Jack Wesley Hill
Texas State Bar No. 24032294
Email: wh@wsfirm.com
WARD, SMITH & HILL, PLLC
1507 Bill Owens Parkway
Longview, Texas 75604
Telephone: (903) 757-6400
Facsimile: (903) 757-2323

ATTORNEYS FOR DEFENDANT TEXAS INSTRUMENTS INCORPORATED

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document has been served upon counsel of record via electronic mail on March 13, 2024.

/s/ R. Seth Reich Jr.
R. Seth Reich Jr.