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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

Brain Life LLC,		
vs.		Plaintiff,
Elekta, Inc.,		
		Defendant.

CASE NO. 12cv00303-CAB (BGS)

ORDER DENYING PLAINTIFF’S
MOTION TO DISMISS AND
GRANTING DEFENDANT’S
MOTION FOR SUMMARY
JUDGMENT BASED ON RES
JUDICATA
[Doc. Nos. 11, 31]

Introduction

Before the Court are defendant Elekta, Inc.’s Motion for Summary Judgment of Based on *Res Judicata* [Doc. No. 31] and plaintiff Brain Life LLC’s corresponding Motion to Dismiss Defendant’s Sixth Affirmative Defense of *Res Judicata* and Collateral Estoppel [Doc. No. 11.] The Court heard argument on January 10, 2013. Paul Adams, Esq., appeared for Brain Life. Thomas Jenkins, Esq., Callie Bjurstrom, Esq., and Theresa Gillis, Esq., appeared for Elekta. Having considered the submissions of the parties and the arguments of counsel, defendant Elekta’s Motion for Summary Judgment [Doc. No. 31] is GRANTED. Plaintiff Brain Life’s Motion to Dismiss [Doc. No. 11] is DENIED.

Plaintiff Brain Life brought this lawsuit against defendant Elekta for infringement of U.S. Patent No. 5,398,684 (“the ‘684 patent”). The patent claims both an apparatus and method for planning surgical treatment using a presentation of images from multiple scanning sources. Elekta moved for summary judgment under the doctrine of *res judicata*, therefore, the Court will begin with

1 a discussion of the history of the litigation of the ‘684 patent between these parties.

2 **Background**

3 In December, 1997, Medical Instrumentation and Diagnostics Corporation (“MIDCO”) was
4 the assignee of the ‘684 patent. MIDCO sued Elekta in this District Court alleging that Elekta’s
5 Gamma Knife, GammaPlan and SurgiPlan products infringed the ‘684 patent. *MIDCO v. Elekta AB*,
6 No. 97cv2271- RHW (S.D. Cal). The complaint, on its face, asserted infringement of all claims of the
7 ‘684 patent. Claims 1-52 of the patent are apparatus claims. Claims 53-109 are method claims. As
8 discovery proceeded, MIDCO elected to pursue only independent claim 1 of the ‘684 patent, an
9 apparatus claim. Just prior to trial, Elekta moved *in limine* for the dismissal with prejudice of claims
10 2-109. MIDCO did not oppose, and the court dismissed the claims without prejudice. *See 97cv2271*,
11 Doc. No. 464, at 10-11. The infringement case went to trial, and the jury made a finding of
12 infringement of claim 1 based on the district court’s construction of that claim.

13 Elekta appealed and the Federal Circuit reversed holding that the district court’s construction
14 of a mean-plus-function claim limitation of claim 1 was erroneous. *MIDCO v. Elekta AB*, 344 F.3d
15 1205, 1211 (Fed. Cir. 2003). The limitation in claim 1 of a “means for converting said plurality of
16 images into a selected format” was defined by the corresponding structures disclosed in the patent
17 specification that provide this function – a framegrabber and computer video processor, structures that
18 convert analog data into selected digital data. *Id.* at 1209. It was undisputed that the accused products
19 did not include the disclosed hardware and instead performed digital-to-digital conversion with
20 software and therefore were not covered by the properly construed claim. *Id.* at 1219. The case was
21 remanded for entry of judgment in favor of Elekta on the issue of infringement. *Id.*

22 On remand, MIDCO moved to reintroduce the dismissed method claims of the ‘684 patent.
23 The court denied MIDCO’s motion, finding MIDCO chose not to pursue those claims and it was too
24 late to reopen the case. Final judgment was entered for Elekta. 99cv2271, Doc. No. 569. MIDCO
25 appealed the denial of its motion to amend so it could revive the method claims. The Federal Circuit
26 summarily affirmed the denial in a *per curiam* decision. *MIDCO v. Elekta*, 128 Fed.Appx. 774 (Fed.
27 Cir. 2005). With that decision, the June 14, 2004 judgment of non-infringement of the ‘684 patent
28 entered in favor of Elekta became final.

1 **Current Litigation**

2 In September, 2009, MIDCO exclusively licensed the '684 patent, which was by then expired,
3 to a company that subsequently assigned the license to Brain Life. On July 23, 2010, Brain Life filed
4 a patent infringement suit in this District Court against Elekta alleging infringement of the '684
5 patent's method claims by Elekta's GammaKnife, SurgiPlan and ERGO++ treatment systems. *Brain*
6 *Life LLC v. Elekta, Inc., et al.*, No. 10cv1539-LAB, Doc. No. 1. Elekta moved to dismiss the
7 complaint based on the doctrine of *res judicata*. 10cv1539, Doc. No. 32.

8 *Res judicata*, or claim preclusion, is the general concept that when a final judgment is rendered
9 on the merits, another action may not be maintained between the parties on the same claim. *See*
10 *Hallco Mfg. Co. v. Foster*, 256 F.3d 1290, 1294 (Fed. Cir. 2001). The court in the 10cv1539 case
11 applied the Ninth Circuit standard for the analysis of whether Brain Life should be precluded by the
12 prior final judgment from asserting infringement of the '684 patent against Elekta. The court
13 considered whether "(1) the same parties, or their privies, were involved in the prior litigation, (2) the
14 prior litigation involved the same claim as the later suit, and (3) the prior litigation was terminated by
15 a final judgment on the merits." 10cv1539, Doc. No. 45 (citing *Gospel Missions of America v. City*
16 *of Los Angeles*, 328 F.3d 548, 555 (9th Cir.)). Brain Life conceded that MIDCO is its predecessor-in-
17 interest in the '684 patent and the prior action against Elekta was terminated by a final judgment on
18 the merits in favor of Elekta. The court therefore concluded that the disputed issue was whether the
19 same claim was involved. 10cv1539, Doc. No. 45 at 10.

20 In the context presented to the court, the word "claim" was synonymous with "cause of action,"
21 and the court rejected Brain Life's argument "that Elekta's claim preclusion argument must fail
22 because Brain Life is asserting different 'claims' of the '684 patent" (i.e., the previously withdrawn
23 method claims instead of the previously asserted apparatus claim) in the present litigation. 10cv1539,
24 Doc. No. 45 at 10.

25 Each patent establishes an independent and distinct property right. *Kearns v. General Motors*
26 *Corp.*, 94 F.3d 1553, 1555 (Fed. Cir. 1996). As such, the previously litigated cause of action was for
27 infringement of the '684 patent. MIDCO elected to only assert one apparatus claim, despite having
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1 a full and fair opportunity to pursue all the claims of the patent.¹ The court rejected plaintiff's
2 contention it could split its cause of action for infringement of the '684 patent into separate suits
3 asserting separate claims of the patent. *See also Mars Inc. v. Nippon Conlux Kabushiki-Kaisah*, 58
4 F.3d 616, 619 (Fed. Cir. 1995) (a party may not split a cause of action into separate grounds of
5 recovery and raise the separate grounds in successive lawsuits); *Hemphill v. Kimberly-Clark Corp.*,
6 530 F.Supp.2d 108, 110-111(D.D.C. 2008) (patentee's second action asserting an alternative
7 independent claim of the same patent dismissed under *res judicata* which precludes relitigating issues
8 that were or could have been raised in the first action). Accordingly, when final judgment was entered
9 in the first suit for infringement of the '684 patent, with a finding of non-infringement, it barred future
10 litigation by Brain Life against Elekta as to all the claims of the '684 patent, asserted or that could have
11 been asserted, against the devices accused in the first action and Elekta's future products that are
12 essentially the same.

13 Consequently on the motion to dismiss, the court addressed whether Elekta established that
14 claim preclusion applies in the case presently before this Court because the accused products in this
15 second action are essentially the same as the accused products in the prior action. "Accused devices
16 are essentially the same where the differences between them are merely colorable or unrelated to the
17 limitations in the claim of the patent." *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1324 (Fed. Cir.
18 2008). Although Elekta argued that the currently accused products are essentially the same, and
19 therefore subject the benefit of claim preclusion, the court found that the complaint sufficiently plead
20 that the accused products were different and denied the motion. The court, however, directed the
21 parties to engaged in a preliminary round of discovery and summary judgment motions focusing
22 "exclusively on the essential sameness question." 10cv1539, Doc. No. 45 at 15, n.8.

23 The court then granted Elekta's motion to sever the dispute between Brain Life and Elekta from
24 the originally filed complaint and ordered a separate complaint be filed. 10cv1539, Doc. No. 69. The
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26 ¹ The method claims of the '684 were asserted, withdrawn and then Brain Life's predecessor
27 moved to amend to reassert method claim 53 against the originally accused Elekta products on remand
28 from the Federal Circuit in the first litigation. 97cv2771, Doc. No. 569 at 3, n.2. Presumably MIDCO
had a good faith basis for its request to revive method claim 53 in the first litigation, so it can
reasonably be inferred that plaintiff believed the originally accused products infringed at least the
independent method claim of the '684 despite its decision during discovery not to pursue it.

1 new matter, *Brain Life LLC v. Elekta, Inc.*, 12cv0303-CAB, was filed on February 3, 2012 [Doc. No.
2 1], and was transferred to the undersigned on February 24, 2012 [Doc. No. 8].

3 The parties engaged in discovery. Brain Life moved to dismiss Elekta's affirmative defenses
4 of *res judicata* and collateral estoppel. [Doc. No 11.] Elekta moved for summary judgment on its *res*
5 *judicata* defense. [Doc. No. 31.]

6 **Discussion**

7 In the current litigation, Brain Life alleges that subsequent versions of the previously litigated
8 Elekta GammaPlan and SurgiPlan products and a product not previously sold in the United States,
9 ERGO++, infringe method claims of the '684 patent. Brain Life does not assert infringement of the
10 apparatus claims and acknowledges that it could not prove infringement of those claims because these
11 current products, including ERGO++, function in the same manner with regard to the "converting
12 means" limitation as the products previously adjudged non-infringing. They do not convert analog
13 images to a digital format using the hardware disclosed in the specification, but employ a software
14 digital-to-digital conversion means.

15 It is undisputed that there is no material difference between the currently accused products and
16 the previously adjudicated non-infringing products as to the limitations of claim 1, the only claim at
17 issue in the first suit. If the accused products of the second suit remain unchanged with respect to the
18 corresponding claim limitations at issue in the first suit, there remains no avenue for the patentee to
19 pursue. *Nystrom v. Trex Company, Inc.*, 580 F.3d 1281, 1285 (Fed. Cir. 2009). This rule applies here.

20 Brain Life contends, however, that there is no corresponding claim limitation involved in this
21 second suit as the asserted method claims do not have the same means-plus-function limitation. Brain
22 Life argues that the similarity of the accused products in this second case regarding the previously
23 adjudicated apparatus claim is not a bar to its current allegations, as it now seeks to assert the '684
24 patent's method claims. Brain Life further contends that many of the dependent method claims were
25 not ripe for litigation in the first case, as it is only with the addition of new features to the defendant's
26 products that they are now subject to current infringement allegations.

27 Elekta responds that, upon entry of final judgment in the first litigation, Brain Life is barred
28 from suing it on the '684 patent, as long as the accused products are essentially the same as to the first

1 finding of non-infringement. The final judgment of the first litigation bars the claims that were
2 brought or could have been brought. That the method claims were not adjudicated on the merits in
3 the first action does not except them from claim preclusion. *See Kearns*, 94 F.3d at 1554-1555
4 (plaintiff's infringement action as to five patents previously dismissed on procedural grounds without
5 adjudication on the merits, was barred by *res judicata* from being asserted against the same defendant
6 in a subsequent case).

7 The Court finds that to allow Brain Life to assert the patent's independent method claim, or
8 its dependent claims, now would be impermissibly claim splitting. MIDCO apparently believed the
9 use of the originally accused products practiced at least the patent's independent method claim at the
10 time of the first case. Indeed, MIDCO attempted to revive claim 53 after remand from the Federal
11 Circuit. As such, MIDCO had the opportunity to have the method claim adjudicated on the merits in
12 the first litigation.

13 Further, a review of the two independent claims of the '684 patent further supports Elekta's
14 position that Brain Life is barred from suing it on the '684 patent. Claim 53, the alleged independent
15 method claim, mirrors claim 1, the previously litigated apparatus claim of the patent as set forth below,
16 albeit without the "means for" limitation. Given the ultimate construction of the mean-plus-function
17 limitations of claim 1, it would have been prudent for MIDCO to have also asserted claim 53 as a back
18 up, but it did not do so:

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<p>1 1. An apparatus for generating a presentation 2 of images from a variety of imaging sources, 3 the apparatus comprising:</p> <p>4 means for acquiring a plurality of images 5 from a plurality of separate imaging 6 sources;</p> <p>7 means for converting said plurality of 8 images into a selected format;</p> <p>9 means for storing said plurality of images;</p> <p>10 means for selectively recalling and 11 displaying at least two images of said 12 plurality of images upon a single display 13 device;</p> <p>14 means for manipulating at least one of said 15 at least two images independently of the 16 other image;</p> <p>17 means for comparing said at least two 18 images;</p> <p>19 means for determining stereotactic 20 coordinates and performing volumetric 21 determinations from said at least two 22 images; and</p> <p>23 means for determining distances and areas 24 from said at least two images.</p>	<p>53. A method for generating a presentation of images from a variety of imaging sources, the method comprising the steps of:</p> <p>acquiring a plurality of images from a plurality of separate imaging sources;</p> <p>converting the plurality of images into a selected format;</p> <p>storing the plurality of images;</p> <p>selectively recalling and displaying at least two images of the plurality of images upon a single display device;</p> <p>manipulating at least one of the at least two images independently of the other image;</p> <p>comparing the at least two images;</p> <p>determining stereotactic coordinates and performing volumetric determinations from the at least two images; and</p> <p>determining distances and areas from the at least two images.</p>
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18 Thus, while new features may have brought additional dependent method claims into play,
19 claim 53 could have been asserted in the first case. For whatever reason MIDCO made a “tactical
20 decision” in the initial suit not to pursue this claim timely. “That choice did not pay off.” *Nystrom*,
21 580 F.3d at 1286.

22 Although the Court finds no case directly on point as to these particular circumstances, the
23 Court concludes that purpose of the doctrine of claim preclusion is best served by finding for the
24 defendant Elekta in this matter. Brain Life’s predecessor sued Elekta for infringement of the ‘684
25 patent. It voluntarily elected to proceed narrowly only going to trial on claim 1 of the patent. When
26 it lost on that claim, it sought to assert claim 53 on remand and the request was denied as untimely.
27 Final judgment was entered for Elekta. With the understanding that its products did not infringe this
28 patent, the defendant continued to develop, make and sell its products. Elekta never changed the

1 aspect of its products that made them non-infringing. Brain Life cannot revisit the decision MIDCO
2 made many years ago to forego including in its infringement action claim 53, when it could have been
3 asserted in the first litigation, and revive that allegation now against products that are essentially the
4 same as the accused products that were found not to infringe. It would be contrary to the notion of
5 litigation repose and the prohibition against claim splitting.

6 **Conclusion**


7 Defendant Elekta's Motion for Summary Judgment of Res Judicata [Doc. No. 31] is
8 GRANTED. Plaintiff Brain Life's Motion to Dismiss [Doc. No. 11] is DENIED. Judgment is entered
9 for the Defendant Elekta, Inc.

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11 DATED: January 30, 2013

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CATHY ANN BENCIVENGO
United States District Judge

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