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United States District Court
Northern District of California

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

CONTOUR IP HOLDING, LLC,
Plaintiff,
v.
GOPRO, INC.,
Defendant.

Case No. [3:17-cv-04738-WHO](#)

**ORDER ON MOTION TO STRIKE,
MOTION FOR JUDGMENT ON THE
PLEADINGS, AND CLAIM
CONSTRUCTION**

Re: Dkt. No. 535

CONTOUR IP HOLDING, LLC,
Plaintiff,
v.
GOPRO, INC.,
Defendant.

Case No. [3:21-cv-02143-WHO](#)

Re: Dkt. No. 20

Plaintiff and counter-defendant Contour IP Holdings, LLC (“Contour”) sued defendant and counter-claimant GoPro, Inc. (“GoPro”) for patent infringement, alleging that several of GoPro’s products infringe patents that concern point-of-view digital video cameras. Since then, Contour filed a follow-on suit that asserts the same patents against newer GoPro products. Three matters are before me: Contour’s motion to strike GoPro’s inequitable conduct affirmative defense in the second suit, GoPro’s motion for judgment on the pleadings that the subject matter is unpatentable, and the construction of two claim terms. The motion to strike is granted, but GoPro may move for leave to amend in response to specific pleading deficiencies. The motion for judgment on the pleadings is denied without prejudice to GoPro raising the matter on an evidentiary record at summary judgment. My construction of the disputed terms is the final section of this Order.

1 Separately, the parties should from now on adhere to the previous order consolidating the
 2 cases, which provided that “the lowest numbered case shall be treated as the docket.” Dkt. No.
 3 532. They should submit all filings on that consolidated docket for simplicity.

4 **BACKGROUND**

5 Contour originally filed this suit in 2017. Dkt. No. 1.¹ It has an involved history that will
 6 not be repeated here. The present motions stem from a second case that Contour filed in 2021 that
 7 asserted the same claims of the same patents against more recent GoPro products. *See* 2143 Dkt.
 8 No. 1 (“Compl.”). I consolidated the cases. Dkt. No. 532.

9 The technology is discussed as it becomes relevant to the analysis below. As a general
 10 matter, the patents concern point-of-view digital video cameras. In the second suit, Contour
 11 asserts claim 11 of U.S. Patent No. 8,890,954 (“the ‘954 Patent”) and claim 3 of U.S. Patent No.
 12 8,896,694 (“the ‘694 Patent”). *See* Compl. ¶¶ 78–123.

13 Claim 11 of the ‘954 patent is as follows:

14 11. A portable, point of view digital video camera, comprising:

15 a lens;

16 an image sensor configured to capture light propagating through the lens and
 17 representing a scene, and produce real time video image data of the scene;

18 a wireless connection protocol device configured to send real time image content
 19 by wireless transmission directly to and receive control signals or data signals by
 20 wireless transmission directly from a personal portable computing device executing
 an application; and

a camera processor configured to:

21 receive the video image data directly or indirectly from the image sensor,

22 generate from the video image data a first image data stream and a second
 23 image data stream, wherein the second image data stream is a higher quality
 than the first image data stream,

24 cause the wireless connection protocol device to send the first image data
 25 stream directly to the personal portable computing device for display on a
 26 display of the personal portable computing device, wherein the personal
 portable computing device generates the control signals for the video

27
 28 ¹ References to the docket are to case 3:17-cv-4738 unless otherwise noted; references to the
 docket in case 3:21-cv-2143 are preceded by “2143.”

1 camera, and wherein the control signals comprise at least one of a frame
2 alignment, multi-camera synchronization, remote file access, and a
3 resolution setting, and at least one of a lighting setting, a color setting, and
4 an audio setting,

5 receive the control signals from the personal portable computing device,
6 and

7 adjust one or more settings of the video camera based at least in part on at
8 least a portion of the control signals received from the personal portable
9 computing device.

10 2143 Dkt. No. 1-1 (“954 Patent”) cl. 11. Claim 3 of the ‘694 patent recites a “point of view
11 digital camera *system*.” 2143 Dkt. No. 1-2 cl. 3 (emphasis added). But, as explained below, claim
12 11 is largely representative of both for present purposes; when there are meaningful differences,
13 they are discussed.

14 In the initial case, I conducted claim construction in July 2018. *See* Order Regarding
15 Claim Construction (“Const. Order”) [Dkt. No. 251]. Based on those constructions, I granted
16 partial summary judgment to Contour that GoPro’s products infringed claim 11. *See* Order on
17 Motion for Partial Summary Judgment (“SJ Order”) [Dkt. No. 445]. The case was set to proceed
18 to trial but was stalled multiple times due to the COVID-19 pandemic. In March 2021, I denied
19 Contour’s motion for an accounting or ongoing royalty to add the new products to the suit, which
20 led to it filing the second suit. Dkt. No. 524.

21 LEGAL STANDARD

22 I. MOTION TO STRIKE

23 A. Generally

24 Federal Rule of Civil Procedure (“FRCP”) 12(f) allows the Court to “strike from a
25 pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.”
26 “The function of a 12(f) motion to strike is to avoid the expenditure of time and money that must
27 arise from litigating spurious issues by dispensing with those issues prior to trial.” *Whittlestone,*
28 *Inc. v. Handi-Craft Co.*, 618 F.3d 970, 973 (9th Cir. 2010) (citation and alteration omitted).
Motions to strike “are generally disfavored [by courts] because the motions may be used as
delaying tactics and because of the strong policy favoring resolution on the merits.” *Barnes v.*
AT&T Pension Ben. Plan-Nonbargained Program, 718 F. Supp. 2d 1167, 1170 (N.D. Cal. 2010)

1 (citation omitted). Such motions should only be granted if “the matter has no logical connection
2 to the controversy at issue *and* may prejudice one or more of the parties to the suit.” *New York*
3 *City Employees’ Ret. Sys. v. Berry*, 667 F. Supp. 2d 1121, 1128 (N.D. Cal. 2009). “Where the
4 moving party cannot adequately demonstrate such prejudice, courts frequently deny motions to
5 strike even though the offending matter literally was within one or more of the categories set forth
6 in Rule 12(f).” *Id.* (citation and quotation marks omitted).

7 In resolving a motion to strike, the pleadings must be viewed in the light most favorable to
8 the nonmoving party. *Platte Anchor Bolt, Inc. v. IHI, Inc.*, 352 F. Supp. 2d 1048, 1057 (N.D. Cal.
9 2004). “Ultimately, whether to grant a motion to strike lies within the sound discretion of the
10 district court.” *Cruz v. Bank of New York Mellon*, No. 12-CV-00846-LHK, 2012 WL 2838957, at
11 *2 (N.D. Cal. July 10, 2012) (citing *Whittlestone*, 618 F.3d at 973).

12 **B. Failure to State an Affirmative Defense**

13 **i. Generally**

14 Under FRCP 12(b)(6), a district court must dismiss a complaint if it fails to state a claim
15 upon which relief can be granted. To survive a Rule 12(b)(6) motion to dismiss, the plaintiff must
16 allege “enough facts to state a claim to relief that is plausible on its face.” *See Bell Atl. Corp. v.*
17 *Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when the plaintiff pleads facts
18 that “allow the court to draw the reasonable inference that the defendant is liable for the
19 misconduct alleged.” *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citation omitted). There
20 must be “more than a sheer possibility that a defendant has acted unlawfully.” *Id.* While courts
21 do not require “heightened fact pleading of specifics,” a plaintiff must allege facts sufficient to
22 “raise a right to relief above the speculative level.” *See Twombly*, 550 U.S. at 555, 570.

23 In deciding whether the plaintiff has stated a claim upon which relief can be granted, the
24 Court accepts the plaintiff’s allegations as true and draws all reasonable inferences in favor of the
25 plaintiff. *See Usher v. City of Los Angeles*, 828 F.2d 556, 561 (9th Cir. 1987). However, the court
26 is not required to accept as true “allegations that are merely conclusory, unwarranted deductions of
27 fact, or unreasonable inferences.” *See In re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir.
28 2008).

1 If the court dismisses the complaint, it “should grant leave to amend even if no request to
2 amend the pleading was made, unless it determines that the pleading could not possibly be cured
3 by the allegation of other facts.” *See Lopez v. Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000). In
4 making this determination, the court should consider factors such as “the presence or absence of
5 undue delay, bad faith, dilatory motive, repeated failure to cure deficiencies by previous
6 amendments, undue prejudice to the opposing party and futility of the proposed amendment.” *See*
7 *Moore v. Kayport Package Express*, 885 F.2d 531, 538 (9th Cir. 1989).

8 **ii. Rule 9(b)**

9 FRCP 9(b) imposes a heightened pleading standard when a claim alleges fraud or mistake.
10 Federal Circuit law governs “whether inequitable conduct has been pleaded with particularity
11 under Rule 9(b).” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1326 (Fed. Cir. 2009).
12 Under FRCP 9(b), to state a claim for fraud, a party must plead with “particularity the
13 circumstances constituting the fraud.” “[T]he ‘circumstances’ in Rule 9(b) must be . . . pleaded in
14 detail—this means the who, what, when, where, and how of the alleged fraud.” *Exergen*, 575 F.3d
15 at 1327 (some internal quotation marks and alteration omitted). However, “[m]alice, intent,
16 knowledge, and other conditions of mind of a person may be averred generally,” Fed. R. Civ. P.
17 9(b), including knowledge of the withheld information and specific intent to deceive, *Exergen*, 575
18 F.3d at 1327.

19 **II. MOTION FOR JUDGMENT ON THE PLEADINGS**

20 FRCP 12(c) provides that, “[a]fter the pleadings are closed—but early enough not to delay
21 trial—a party may move for judgment on the pleadings.” A motion for judgment on the pleadings
22 can “raise the defense of failure to state a claim.” *McGlinchy v. Shell Chem. Co.*, 845 F.2d 802,
23 810 (9th Cir. 1988). When that is so, the court employs “same test as a motion under Rule
24 12(b)(6),” which is stated above. *Id.*

25 **III. CLAIM CONSTRUCTION**

26 Claim construction is a matter of law. *See Markman v. Westview Instruments, Inc.*, 517
27 U.S. 370, 372 (1996); *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).
28 Terms contained in claims are “generally given their ordinary and customary meaning.” *Vitronics*,

1 90 F.3d at 1582. When determining the proper construction of a claim, a court begins with the
2 intrinsic evidence of record, consisting of the claim language, the patent specification, and, if in
3 evidence, the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005);
4 *see also Vitronics*, 90 F.3d at 1582. “A claim term used in multiple claims should be construed
5 consistently” *Inverness Med. Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d
6 1365, 1371 (Fed. Cir. 2002).

7 “The appropriate starting point [] is always with the language of the asserted claim itself.”
8 *Comark Commc ’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998). “[T]he ordinary
9 and customary meaning of a claim term is the meaning that the term would have to a person of
10 ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date
11 of the patent application.” *Phillips*, 415 F.3d at 1312. “There are only two exceptions to this
12 general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when
13 the patentee disavows the full scope of a claim term either in the specification or during
14 prosecution.” *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

15 “Importantly, the person of ordinary skill in the art is deemed to read the claim term not
16 only in the context of the particular claim in which the disputed term appears, but in the context of
17 the entire patent, including the specification.” *Phillips*, 415 F.3d at 1313. “Claims speak to those
18 skilled in the art,” but “[w]hen the meaning of words in a claim is in dispute, the specification and
19 prosecution history can provide relevant information about the scope and meaning of the claim.”
20 *Electro Med. Sys., S.A. v. Cooper Life Scis., Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994) (citations
21 omitted). “[T]he specification is always highly relevant to the claim construction analysis.
22 Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Vitronics*,
23 90 F.3d at 1582. “However, claims are not to be interpreted by adding limitations appearing only
24 in the specification.” *Id.* “Thus, although the specifications may well indicate that certain
25 embodiments are preferred, particular embodiments appearing in a specification will not be read
26 into the claims when the claim language is broader than such embodiments.” *Id.* Conversely,
27 “where [] the claim language is unambiguous, [the Federal Circuit has] construed the claims to
28 exclude all disclosed embodiments.” *Lucent Techs., Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1215–

1 16 (Fed. Cir. 2008). “[T]he description may act as a sort of dictionary, which explains the
2 invention and may define terms used in the claims,” and the “patentee is free to be his own
3 lexicographer,” but “any special definition given to a word must be clearly defined in the
4 specification.” *Markman*, 517 U.S. at 989–90.

5 On the other hand, it is a fundamental rule that “claims must be construed so as to be
6 consistent with the specification.” *Phillips*, 415 F.3d at 1316. “The construction that stays true to
7 the claim language and most naturally aligns with the patent’s description of the invention will be,
8 in the end, the correct construction.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d
9 1243, 1250 (Fed. Cir. 1998).

10 The court may consider the prosecution history of the patent, if in evidence. *Markman*, 52
11 F.3d at 980. The prosecution history may “inform the meaning of the claim language by
12 demonstrating how the inventor understood the invention and whether the inventor limited the
13 invention in the course of prosecution, making the claim scope narrower than it would otherwise
14 be.” *Phillips*, 415 F.3d at 1317 (citing *Vitronics*, 90 F.3d at 1582–83); *see also Chimie v. PPG*
15 *Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (“The purpose of consulting the prosecution
16 history in construing a claim is to exclude any interpretation that was disclaimed during
17 prosecution.”) (internal quotations omitted).

18 In most situations, analysis of this intrinsic evidence alone will resolve claim construction
19 disputes. *Vitronics*, 90 F.3d at 1583. However, “it is entirely appropriate . . . for a court to consult
20 trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent
21 file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in
22 the pertinent technical field.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309
23 (Fed. Cir. 1999). Extrinsic evidence “consists of all evidence external to the patent and
24 prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.”
25 *Markman*, 52 F.3d at 980. All extrinsic evidence should be evaluated in light of the intrinsic
26 evidence. *Phillips*, 415 F.3d at 1319. Courts should not rely on extrinsic evidence in claim
27 construction to contradict the meaning of claims discernible from examination of the claims, the
28 written description, and the prosecution history. *Pitney Bowes*, 182 F.3d at 1308 (citing *Vitronics*,

1 90 F.3d at 1583). While extrinsic evidence may guide the meaning of a claim term, such evidence
2 is less reliable than intrinsic evidence. *Phillips*, 415 F.3d at 1318–19.

3 DISCUSSION

4 I. MOTION TO STRIKE

5 Contour moves to strike GoPro’s twelfth affirmative defense of inequitable conduct.² It
6 makes three arguments: (1) GoPro’s own pleading shows that the alleged inequitable conduct is
7 not cognizable; (2) GoPro fails to plead “the who” of the conduct with particularity; and (3) GoPro
8 fails to plead intent. I disagree with Contour on the first argument, but agree on the second (a
9 finding that moots the third argument). Its motion is GRANTED. Rather than going through a
10 new filing followed by another potential motion to dismiss, if GoPro wishes to amend the Answer,
11 it must file a motion seeking leave to amend within 21 days (and attach the amended Answer it
12 would file as an exhibit) with the briefing to focus on whether the defense is adequately pleaded.
13 The motion and opposition are limited to 15 pages, the reply to seven.

14 “Inequitable conduct is an equitable defense to patent infringement that, if proved, bars
15 enforcement of a patent.” *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1285
16 (Fed. Cir. 2011) (en banc). The defendant must show that “(1) an individual associated with the
17 filing and prosecution of a patent application made an affirmative misrepresentation of a material
18 fact, failed to disclose material information, or submitted false material information; and (2) the
19 individual did so with a specific intent to deceive the [Patent and Trademark Office (“PTO”).”
20 *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1327 n.3 (Fed. Cir. 2009). Inequitable
21 conduct must be pleaded with particularity under Rule 9(b). *Id.* at 1326–27.

22 A. The Ambarella Chips

23 The inequitable conduct that GoPro identifies is, at its core, that: a third-party company,
24 Ambarella, Inc., invented the processor that permitted Contour’s technology to perform the “dual-
25 streaming” feature; Ambarella provided that processor to Contour; Contour used the processor in
26

27 ² Contour’s motion also moved to dismiss a counterclaim it believed was premised in part on
28 inequitable conduct. GoPro’s Opposition represents that none of its counterclaims are predicated
on inequitable conduct. *See* 2143 Dkt. No. 21 at 5 n.1. Contour relies on that representation in
only pursuing the motion to strike, *see* 2143 Dkt. No. 22 at 2, and I now rely on it in ruling.

1 securing its patent; and Contour failed to disclose to the PTO that it used the processor. *See*
 2 Answer [2143 Dkt. No. 19] ¶¶ 138–44. Contour moves to strike because, it argues, GoPro’s own
 3 pleading shows that the Ambarella chips were publicly available prior art. *See* Motion to Strike
 4 and Dismiss (“Strike Mot.”) [Dkt. No. 20] 8. As a matter of law, says Contour, someone is not an
 5 inventor for patent purposes if they merely contribute prior art. *Id.* The net result, in its view, is
 6 that GoPro’s own pleading shows Contour’s omission of the information cannot have been
 7 inequitable.

8 Contour’s argument lacks merit. GoPro does not only allege that the inequitable conduct
 9 was an incorrect identification of inventorship. It is true, as Contour argues, that “[a] contribution
 10 of information in the prior art cannot give rise to joint inventorship because it is not a contribution
 11 to conception.” *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1362 (Fed. Cir. 2004). But the
 12 inequitable conduct defense here is materially different than a pure incorrect-inventorship claim.
 13 GoPro’s allegation is that Contour was required to inform the PTO of the alleged use of and
 14 reliance on the Ambarella chips, not just that it was required to name other inventors. Answer ¶
 15 146. Contour did so, on GoPro’s account, “to overcome prior art rejections.” *Id.* ¶ 145. The
 16 materiality of that disclosure may ultimately be impacted—maybe even determined—by whether
 17 it was publicly available. But the mere fact that Ambarella’s engineers could not have been (on
 18 Contour’s account) named inventors does not necessarily mean that Contour did not have a duty to
 19 disclose its use of Ambarella’s chips. That is a factual issue that will be sorted out on an
 20 evidentiary record. Contour’s only case, in contrast, involved an inequitable conduct claim that
 21 turned entirely on the identity of the correct inventors. *See Crocs, Inc. v. Effervescent, Inc.*, 248 F.
 22 Supp. 3d 1040, 1050–52 (D. Colo. 2017). (That decision addressed other inequitable conduct
 23 theories but found the omitted information not material; that is not the portion Contour relies on.)

24 **B. The “Who”**

25 As noted, Rule 9(b) requires that the answer “identify the specific who, what, when, where,
 26 and how of the material misrepresentation or omission committed before the PTO.” *Exergen*, 575
 27 F.3d at 1328. Contour argues that GoPro has not identified the “who.” *See* Strike Mot. 9–10.

28 I agree that GoPro has not identified the “who” with sufficient specificity. Its general

1 allegation on this front identifies “Contour and/or the named inventors on the Asserted Patents, or
2 persons acting at their direction on or their behalf, including prosecution counsel and others.”
3 Answer ¶ 139. That is insufficient under Federal Circuit precedent, which requires identification
4 of the “specific individuals” who committed the alleged misconduct, not just formulations like
5 “[patentee], its agents and/or attorneys.” *Exergen*, 575 F.3d at 1329 (some internal quotation
6 marks omitted); *see, e.g., BlackBerry Ltd. v. Typo Prod. LLC*, No. 14-CV-00023-WHO, 2014 WL
7 1867009, at *1–*2 (N.D. Cal. May 8, 2014) (finding allegation that “Griffin, Holmes, Lazaridis,
8 Little, Major and/or Kelly withheld” information insufficient). The remainder of this part of the
9 Answer is also peppered with allegations that just argue that “Contour” or “the applicant”
10 generally “failed to disclose” information, *see, e.g.,* Answer ¶ 146, which is similarly deficient.
11 *Exergen*, 575 F.3d at 1329.

12 None of GoPro’s other allegations save this vague pleading. In its Opposition, GoPro
13 identifies the “who” it apparently intended: one of the named inventors, Laura O’Donnell. *See*
14 *Opposition to the Strike Mot.* (“Strike Oppo.”) [Dkt. No. 21] 8–9. The Answer itself does not
15 single out O’Donnell in this way; she is referenced a few times, but they tend to be grouped along
16 with other similar allegations about other inventors or Contour more generally. *See, e.g.,* Answer
17 ¶¶ 140, 143. If O’Donnell is GoPro’s “who,” then its pleading is deficient. The only two
18 allegations about her are: (1) she admitted she received “public and proprietary information from
19 Ambarella” about the A5 and other processors, *id.* ¶ 142, and (2) Contour submitted a declaration
20 from her “in which she attested that she and the other identified inventors are the sole joint
21 inventors of the invention,” *id.* ¶ 143. If this is intended to be an inequitable conduct charge
22 against O’Donnell alone, it fails to spell out the “what, when, where, why, and how” of the
23 information she allegedly withheld. Instead, it discusses vague information that was withheld by
24 its ever-changing roster of allegedly inequitable actors.

25 GoPro muddies the waters further by saying that it has adequately identified O’Donnell
26 “for example” and it has pleaded the actions of specific people “including” O’Donnell. *Strike*
27 *Oppo.* 8–9. Yet its brief only ever identifies a case against her, not anyone else. And, to top it off,
28 GoPro ends that section of its brief with this enigmatic assertion: “That there are other actors

1 whose malfeasance might also have constituted inequitable conduct, such as the other inventors,
 2 prosecution counsel, and the patentee’s agents (such as Jason Green, a former Contour employee
 3 who participated in the PTO interview) does not render the pleading deficient” *Id.* 9.³
 4 Wrong. GoPro must plead *all* of the inequitable conduct with particularity, and for every person.
 5 Even if it had made out a full case against O’Donnell, it cannot then (as it appears to imply)
 6 bootstrap any number of other people in with allegations that would be insufficient on their own.

7 In short, GoPro’s pleading is inadequate. If it amends the defense, it must make clear
 8 precisely the “who” it is charging with inequitable conduct. It must do so for every person so
 9 accused. For each, it must lay out the other elements required by Rule 9(b). It cannot hide behind
 10 “for examples” and “includings.” And all of this must be clear from the face of the Answer, with
 11 no strategic ambiguity so it can fill in the blanks later.⁴

12 **II. MOTION FOR JUDGMENT ON THE PLEADINGS**

13 GoPro moves for judgment on the pleadings because it contends that the asserted claims
 14 cover patent-ineligible subject matter. *See* Motion for Judgment on the Pleadings (“MJP”) [Dkt.
 15 No. 535]. For the reasons that follow, its motion is DENIED without prejudice to raising it again
 16 at summary judgment based on a factual record.

17 35 U.S.C. § 101 restricts the scope of patentable subject matter to “any new and useful
 18 process, machine, manufacture, or composition of matter, or any new and useful improvement
 19 thereof.” But “laws of nature, natural phenomena, and abstract ideas are not patent-eligible
 20 because they represent the basic tools of scientific and technological work.” *Visual Memory LLC*
 21 *v. NVIDIA Corp.*, 867 F.3d 1253, 1257 (Fed. Cir. 2017) (internal quotation marks and citation
 22 omitted). In *Alice Corporation Pty. v. CLS Bank International*, 573 U.S. 208 (2014), and *Mayo*
 23 *Collaborative Servs. v. Prometheus Lab’ys, Inc.*, 566 U.S. 66 (2012), the Supreme Court clarified
 24 the two-step framework for determining whether patents claim this type of ineligible subject
 25

26 _____
 27 ³ This affirmative defense—in fact, the entire Answer—does not ever name Green in the
 28 allegations, further illustrating GoPro’s problems.

⁴ Because of this finding there is no need or way to address Contour’s other argument that GoPro
 has not adequately alleged specific intent to deceive the PTO.

1 matter. Because “[a]t some level, all inventions embody, use, reflect, rest upon, or apply laws of
2 nature, natural phenomena, or abstract ideas[,] . . . an invention is not rendered ineligible for patent
3 simply because it involves an abstract concept.” *Alice*, 573 U.S. at 217 (internal quotation marks,
4 alteration, and citation omitted). Certain “applications” of those concepts can be made “to a new
5 and useful end” and be patentable. *Id.* (internal quotation marks and citations omitted). Patent
6 eligibility under Section 101 is a question of law and can be determined on a Rule 12(b)(6) motion
7 (and therefore the functional equivalent of this type of Rule 12(c) motion). *Genetic Techs. Ltd. v.*
8 *Merial L.L.C.*, 818 F.3d 1369, 1373 (Fed. Cir. 2016).

9 At the first step of the *Alice/Mayo* framework, courts must “determine whether the claims
10 at issue are directed to a patent-ineligible concept.” *Alice*, 573 U.S. at 218. Accordingly, the court
11 must “articulate with specificity what the claims are directed to and ask whether the claims are
12 directed to an improvement to . . . functionality versus being directed to an abstract idea.” *Visual*
13 *Memory*, 867 F.3d at 1258 (internal quotation marks and citations omitted). The Federal Circuit
14 has instructed that this inquiry asks “what the patent asserts to be the focus of the claimed advance
15 over the prior art.” *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1292 (Fed. Cir. 2020) (internal
16 quotation marks and citations omitted). The court must “focus on the language of the Asserted
17 Claims themselves . . . considered in light of the specification” and avoid “overgeneralizing” those
18 claims or stating them at too “high [a] level of abstraction.” *Id.* (internal quotation marks and
19 citations omitted).

20 At the second step, the court must “consider the elements of each claim both individually
21 and as an ordered combination to determine whether the additional elements transform the nature
22 of the claim into a patent-eligible application.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327,
23 1334 (Fed. Cir. 2016) (internal quotation marks and citations). The court must “search for an
24 inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the
25 patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”
26 *Alice*, 134 S. Ct. at 2355 (internal quotation marks and citations omitted). But this allegedly
27 inventive concept “cannot simply be an instruction to implement or apply the abstract idea on a
28 computer” and “must be significantly more than the abstract idea itself.” *BASCOM Glob. Internet*

1 *Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).

2 Generally, this innovation “must involve more than performance of well-understood,
3 routine, [and] conventional activities previously known to the industry.” *Content Extraction &
4 Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014). “[T]he
5 mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a
6 patent-eligible invention.” *Id.* at 1348. However, “an inventive concept can be found in the non-
7 conventional and non-generic arrangement of known, conventional pieces.” *BASCOM*, 827 F.3d
8 at 1350.

9 Though GoPro makes several related arguments, it most heavily relies on the Federal
10 Circuit’s recent decision in *Yu v. Apple Inc.*, 1 F.4th 1040 (Fed. Cir. 2021). *See, e.g.*, MJP 11–12;
11 Reply ISO MJP (“MJP Reply”) [Dkt. No. 543] 5–7. That case came from a motion to dismiss.
12 There, the representative claim recited “[a]n improved digital camera.” *Id.* at 1042. That
13 invention comprised, among other things, two image sensors and lenses that would each produce
14 an image. *See id.* One of the image sensors was “sensitive to a full region of visible color
15 spectrum.” *Id.* The two images would be digitized and stored. *Id.* Most crucially, the images
16 would be processed to produce a “resultant” image in which the first (without the full spectrum)
17 enhanced the second (with the full spectrum). *Id.*

18 The Federal Circuit affirmed the district court’s finding that the claim was directed to an
19 abstract idea. It first explained that the “idea and practice of using multiple pictures to enhance
20 each other has been known by photographers for over a century.” *Id.* at 1043. The claim only
21 recited “[c]onventional camera components” to create the enhanced image: the sensors, lenses,
22 converting circuitry, memory, and processor. *Id.* Each of those components, the court said,
23 “perform only their basic function” and were “set forth at a high degree of generality.” *Id.*
24 Indeed, the specification discussed a need for a “generic solution” to produce high resolution
25 images. *Id.* (internal quotation marks omitted). And this claim was “simply a generic
26 environment in which to carry out the abstract idea” of using one image to enhance another. *Id.*
27 In making its determination, the court rejected the argument that the claim covered a “specific
28 solution” to particular problems; it held that, instead, the “solution to those problems is the

1 abstract idea itself—to take one image and ‘enhance’ it with another.” *Id.* at 1044. The majority
 2 also rejected the argument, advanced by the dissent, that the claim covered a particular
 3 configuration of physical devices (like lenses and sensors) and so was not abstract. *See id.* at 1044
 4 & n.2; *see also id.* at 1046 (Newman, J., dissenting) (“The invention . . . is a digital camera having
 5 two lenses mounted in front of separate image sensors, with analog to digital conversion circuitry,
 6 a memory that stores the images, and a digital processor that enhances the images. This camera is
 7 a mechanical and electronic device of defined structure and mechanism; it is not an ‘abstract
 8 idea.’”).

9 Unlike *Yu* or other cases that GoPro cites, I cannot find in its favor based only on the
 10 pleadings. If an abstract idea is applied in a non-generic environment and embodied a functional
 11 improvement, it succeeds at step one. *Alice*, 573 U.S. at 217. If the claim elements in ordered
 12 combination transform the nature of the claim into one that is not abstract, it succeeds at step two.
 13 *Enfish*, 822 F.3d at 1334. As the Federal Circuit has explained, though these analyses are distinct,
 14 they have overlap. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir.
 15 2016). Here, for the reasons that follow, Contour’s well-pleaded allegations (which must be taken
 16 as true at this stage) prevent a finding in GoPro’s favor on both steps for the same fundamental
 17 reason.

18 Claim 11⁵ recites a “point of view digital video camera.” As an initial matter, under well-
 19 settled law, that the claim recites a mechanical device is not determinative of whether it is in fact
 20 directed to an abstract idea. *Yu*, 1 F.4th at 1044 & n.2. Just as the “digital camera” in *Yu* could
 21 still be in truth directed at patenting an abstract idea, so can the “digital video camera” here.

22 Contour pleads that, at the time the patent issued, point-of-view video cameras faced a
 23 concrete functional problem: users could not readily see and control the video while using the
 24 cameras for their intended purpose (e.g., attached to the body during movement). Compl. ¶¶ 12,
 25 14. So, Contour pleads, it came up with an innovative solution: the camera would stream a low

27 ⁵ Both parties agree that claim 11 of the ‘954 patent is representative for purposes of the Section
 28 101 analysis. *See* MJF 3; Dkt. No. 539 at 11 n.7. Consequently, I discuss only that claim in the
 body of the Order, but the analysis applies to all asserted claims. *See Elec. Power*, 830 F.3d at
 1352 (treating claim as representative for Section 101 analysis).

1 quality video to a smartphone so that the user could watch what was being recorded removed from
2 the camera; it would store a high quality video that would be the one ultimately used; and it would
3 receive specified control signals from the smartphone so that users could control the image
4 removed from the camera. *Id.* This is also reflected in the patents. *See generally, e.g.*, ‘954
5 Patent.

6 All this removes the case from the orbit of *Yu* and related cases as a matter of pleading. In
7 *Yu*, the district court made an explicit and uncontested finding that enhancing one image with
8 another was well-known to photographers for a century. *Yu*, 1 F.4th at 1043. Similarly, in another
9 of GoPro’s leading cases, the district court made an explicit and uncontested finding that putting
10 together multiple images to form a panoramic one is something that the visual cortex did since the
11 “dawn of humanity.” *FullView, Inc. v. Polycom, Inc.*, 485 F. Supp. 3d 1156, 1163 (N.D. Cal.
12 2020). GoPro offers no basis to make a similar finding here and Contour’s pleading forecloses it.
13 Accordingly, I cannot find that this all took place in only a generic environment at step one or was
14 uninventive at step two. *Cf. Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018)
15 (explaining that concepts may only be found unpatentable as a matter of law when “there is no
16 genuine issue of material fact regarding whether the claim element or claimed combination is
17 well-understood, routine, conventional to a skilled artisan in the relevant field”).

18 GoPro’s remaining arguments may succeed on an evidentiary record, but they do not
19 today. Many depend on material from outside the pleadings—in particular, the briefs and expert
20 reports filed in this litigation. *See, e.g.*, MJP 7. At this posture, I may only look at the pleadings,
21 things incorporated into the pleadings, and matters subject to judicial notice. *See, e.g., Brown v.*
22 *Elec. Arts, Inc.*, 724 F.3d 1235, 1247–48 (9th Cir. 2013).⁶ To get around this, GoPro says that I
23 can take judicial notice of all of these litigation matters. MJP Reply 3–4. But that does not mean I
24 can take judicial notice of the *truth* of any statement in them. Similarly, GoPro says that the law
25 of the case enables me to rely on, for instance, what was found at summary judgment. *Id.* That is
26 not fully accurate. That doctrine prevents, in the main, a court from redeciding issues. *Ingle v.*
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28 ⁶ I will not *sua sponte* convert this into a motion for summary judgment.

1 *Circuit City*, 408 F.3d 592, 595 (9th Cir. 2005). But GoPro has presented no authority for the
2 view that it displaces normal standards governing different types of motions. If GoPro’s argument
3 were accepted, *any* motion for judgment on the pleadings that took place after summary judgment
4 could rely on anything found as an *evidentiary* matter at summary judgment. In effect, it would
5 allow a second bite at that apple.

6 Equally as fundamentally, I am required to credit any well-pleaded allegation that does not
7 contradict a matter subject to judicial notice. *See Usher*, 828 F.2d at 561. (And again, GoPro’s
8 argument that it can slap the label “judicial notice” on extra-pleadings positions is incorrect.)
9 While I agree with GoPro that it may be appropriate to take judicial notice of Contour’s own
10 positions with respect to the claims (as opposed to other evidence), the only such position that
11 would make a difference is the argument that Contour has admitted the Ambarella chips
12 (discussed above) are prior art. MJP 11–12. Yet even that is not sufficient on this record because
13 “the mere fact that something is disclosed in a piece of prior art . . . does not mean it was well-
14 understood, routine, and conventional.” *Berkheimer*, 881 F.3d at 1369. Soon the parties will have
15 the opportunity to present *evidence* about whether the Ambarella chips so qualify.

16 GoPro is not foreclosed from raising this argument again at summary judgment. Then, the
17 evidence can test Contour’s allegations of inventiveness and the parties can offer concrete
18 evidence about the state of the ideas at play at the time of invention.

19 **III. CLAIM CONSTRUCTION**

20 Claim construction has already been conducted in this case. *See generally* Construction
21 Order. Here, because the new complaint was filed, the parties seek construction of two terms, one
22 that was not previously construed, one that was.

23 **A. Control Signals**

24 Claim 11 of the ‘954 recites “[a] portable, point of view digital video camera, comprising”
25 among other things, “a camera processor.” It says that the camera processor is “configured to,”
26 among other things,

27 cause the wireless connection protocol device to send the first image data stream directly to
28 the personal portable computing device for display on a display of the personal portable
computing device, *wherein the personal portable computing device generates the control*

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signals for the video camera, and wherein the control signals comprise at least one of a frame alignment, multi-camera synchronization, remote file access, and a resolution setting, and at least one of a lighting setting, a color setting, and an audio setting.”

’954 Patent cl. 11 (emphasis added). Claim 3 of the ’694 patent also includes identical language about personal portable computing devices. The parties’ dispute is over the emphasized “wherein” clause:

Contour’s Proposal	GoPro’s Proposal	Claim Construction
The scope of the claim is limited to a point of view digital video camera. The “wherein” clause is part of defining the control signals that the camera processor is configured to receive.	Limiting; plain and ordinary meaning.	The claim is limited to a point of view digital video camera (or camera system). The clause at issue helps define the control signals that the processor is configured to receive.

The dispute, in other words, is about whether, to infringe, an accused technology needs to include a personal portable computing device (e.g., a smartphone) or whether the reference to such a device is only to define the control signals, but it itself is not claimed. For the reasons that follow, I agree with Contour.

I start with the plain language and structure of the claims. *Vitronics*, 90 F.3d at 1582. By their plain language, the claims are directed toward a video camera (or camera system in claim 3), not toward a video camera plus a personal portable computing device. That video camera then includes the remaining aspects of the claim as indicated by the use of the common transitional phrase, “[a] portable point of view digital video camera, *comprising*” everything that follows. ’954 Patent cl. 11 (emphasis added); *see CIAS, Inc. v. All. Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007) (“In the patent claim context the term ‘comprising’ is well understood to mean ‘including but not limited to.’”). One of the things that the video camera is comprised of is “a camera processor.” And the personal portable device clause at issue here is contemplated in a clause subordinate to that camera processor clause. The claim states that the camera processor is “configured to” do a series of things (like receive video image data). In turn, one thing in the list that *the camera processor* is configured to do is to “cause the wireless connection protocol device to send the first image data stream directly to the personal portable computing device for display on a display of the personal portable computing device.” ’954 Patent cl. 11. The “wherein” clause

1 follows and modifies that clause. The plain and ordinary meaning, in context, is that the camera
2 processor sends the stream to the personal portable computing device and receives control signals
3 from it. Accordingly, as a matter of ordinary meaning, basic grammar, and the claim’s structure,
4 Contour’s interpretation is correct.

5 Other clues bolster this conclusion. The claimed video camera comprises four elements: a
6 lens, image sensor, wireless connection protocol device, and camera processor. Every part of the
7 claim is directed toward one of those. The remaining parts of the “camera processor” element
8 here likewise are all directed *at the camera processor*. Aside from the clause in dispute, the claim
9 says that the camera processor is “configured” to (1) receive the video image data, (2) generate a
10 first image and second image stream, (3) receive control signals from the personal portable
11 computing device, and (4) adjust one or more setting of the camera. It would be unnatural and
12 illogical if the fifth requirement—of which this clause is a part—departed so starkly from the
13 others and was directed at *claiming* an entirely different device. ‘954 Patent cl. 11. Still more, if
14 the patent *did* intend to claim a personal portable computing device, it is difficult to think of a
15 more oblique way of doing so. On GoPro’s account, Contour would have squirreled away its *only*
16 claim of the device at the bottom layer of a Russian-nesting-doll-style element group that is
17 facially addressed to entirely different devices.⁷

18 GoPro’s counterarguments are unconvincing. As an initial matter, while GoPro pays lip
19 service to plain meaning and claim structure, it quickly leaves them behind to highlight other
20 considerations. *See* Responsive Claim Construction Brief (“Resp. Br.”) [Dkt. No. 545] 3–6. Its
21 only real attempt to show that the plain language supports it is the argument that “wherein”
22 clauses are binding and this claim construction, apparently, would render it not binding. Resp. Br.
23 3–5. That does not change the analysis. No one disputes that the clause is just as binding as any.
24 The question here is what that (binding) clause *means*: does it claim the separate device or
25 describe what the camera processor is configured to do?

26 Turning to GoPro’s primary arguments, it first points to a figure from the specification that
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28 ⁷ Because I conclude that the claim itself unambiguously shows that Contour’s position is correct,
there is no need to address its argument about claim differentiation.

1 depicts cameras *and* a smartphone. *Id.* 5–6. As explained, the specification does include this and
2 a few other similar references. But that does not offer GoPro any help because it would be
3 virtually impossible to helpfully describe the video camera without referencing how it interacts
4 with the personal portable computing device, which is all the specification shows. That the
5 specification does so is no surprise and certainly does not show that Contour claimed smartphones
6 despite the plain meaning and clear structure of the claims.

7 Next, GoPro argues that the prosecution history supports it. *Id.* 6–7. In essence, it argues
8 that after a version of the claim was rejected, Contour added the wherein clause at issue to get
9 around prior art. *Id.* The evidence it proffers, however, does not support that assertion. Although
10 the rejected version of the claims did not include the clause, there are a number of changes from
11 the rejected to the accepted claims, including the specificity added by describing what the camera
12 processor is configured to do. *See* Dkt. No. 545-3. GoPro offers nothing more than the two
13 different versions. If there is some evidence that the PTO believed Contour was claiming a
14 personal portable computing device and that somehow saved its patent, GoPro has not presented
15 it.

16 GoPro asserts that Contour’s litigating positions also show that its interpretation is correct.
17 Resp. Br. 7–9. I have, however, found that the patent itself unambiguously settles the issue of its
18 meaning, so examining the extrinsic evidence is not warranted. *Pitney Bowes*, 182 F.3d at 1309.
19 Nonetheless, to ensure that Contour has not spoken out of both sides of its mouth, I analyze this
20 argument. GoPro is incorrect. The “litigating positions” it speaks of are actually a few snippets in
21 reports from Contour’s expert. In the first, Contour’s expert was opining about whether GoPro
22 conceived of the “control signals” term and whether it infringed. As part of that analysis, she
23 stated that “[s]pecifically, each of the asserted claims *requires that the personal device generate*
24 *controls signals*, including at least one control signals in each of two groups: (1) frame alignment,
25 multi-camera synchronization, remote file access, or resolution; and (2) lighting, color, or audio
26 settings. [GoPro’s expert] never identifies any evidence that GoPro conceived of sending these
27 specific control signals, and thus has failed to show conception of these limitations.” Dkt. No.
28 545-1 ¶ 142 (emphasis added). And she said that GoPro’s expert “never identifies any evidence

1 that GoPro reduced to practice sending these specific control signals.” *Id.* ¶ 203.

2 In the context that GoPro tries to remove it from, these cherry-picked lines of expert
3 testimony in one rebuttal report do not transform the claim into something it is not. These
4 statements are at least as consistent with Contour’s interpretation as GoPro’s. Contour’s expert
5 never opined that a personal portable computing device was required to infringe. All she
6 discussed was the signals generated, sent, and received—which are geared toward the camera
7 processor.

8 GoPro also relies on her infringement analysis, but that is even less helpful to it. All that
9 she said there was that “the accused products allow the user to control various settings of the
10 camera through the GoPro app,” that her exemplary citations of accused products included “apps,”
11 and that she was “able to control settings of the camera from the phone.” *Id.* ¶¶ 453–54. Under
12 the claim construction I adopt, analyzing those settings makes sense because the processor must be
13 configured to control them. That does not mean that the device itself is claimed. Indeed, that
14 GoPro cannot point to a clearer statement from Contour’s infringement analysis tends to indicate
15 Contour never adopted this position.

16 GoPro also relies on several Federal Circuit cases that, in its view, compel reading the
17 claim as it urges. Its leading case is *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945 (Fed. Cir. 2006).
18 *See, e.g.*, Resp. Br. 9–10. The patent in *Bicon* claimed a plastic cuff used in dental implants.
19 *Bicon*, 441 F.3d at 947–51. As here, the parties disputed whether that claim also covered another
20 apparatus—an “abutment”—that was referenced in the claim but did not appear in the preamble.
21 *Id.* at 950. The Federal Circuit held that the abutment was indeed claimed. *Id.* at 951–52.

22 That claim is different from this one in the crucial ways that drove the Federal Circuit’s
23 decision. That court explained that there were two broad reasons that it found the abutment to be
24 claimed: “the full text of the claim, read in the context of the entire patent” and “problems
25 presented by [the other] proposed construction.” *Id.* at 952. The claim recited “[a]n emergence
26 cuff member for use in preserving the interdental papilla during the procedure of placing an
27 abutment on a root member implanted in the alveolar bone of a patient in which [a] the abutment
28 has a frusto-spherical basal surface portion” *Id.* at 948. From the start, then, the claim is

1 structured quite differently from this one. There are other differences that mattered to the court.
2 The claim “include[d] a detailed description of the abutment’s physical characteristics and
3 define[d] the emergence cuff in a way that depends on those physical characteristics.” *Id.* at 950.
4 That definition is like the definition by reference here: in *Bicon*, if the claim did not include the
5 abutment, one definition would have “no meaning” and two limitations would be “meaningless.”
6 *Id.* at 950–51. Here, there is no part of the claim that loses meaning if the personal portable
7 computing device is not claimed.

8 Finally, GoPro tosses in several citations to its expert report that, according to it, illustrate
9 that a POSITA would understand the claim to require the device itself. To the extent it relies on
10 this evidence, I reject it. Under settled Federal Circuit law, extrinsic evidence cannot be used to
11 contradict the plain meaning of a term.

12 **B. Generate**

13 The parties’ other dispute is over the “generate” term. As noted, I already construed this
14 term to mean “record in parallel from the video image data a first image data stream and a second
15 image data stream, wherein the second image data stream is a higher quality than the first image
16 data stream” or “record in parallel first video image content and second video image content
17 corresponding to the video image data representing the scene, wherein the second video image
18 content is a higher quality than the first video image content,” depending on the precise claim.
19 Const. Order 9–13.

20 GoPro now seeks what it labels a “clarification” of the construction. It describes that
21 clarification as: “the Court’s construction . . . permits any level of processing or altering prior to
22 recording, and permits one image data stream/video image content to be generated from the
23 other.” Resp. Br. 12. This argument comes not from any claim construction but from summary
24 judgment. There, I found that GoPro’s product infringed claim 11 as a matter of law. That
25 dispute “[c]ame] down to the ‘generate’ term.” SJ Order. Among other things, GoPro’s expert
26 argued that alterations during processing “means that a POSITA would no longer consider [the
27 stream] to be from the video image data” as the construction required. *Id.* 7. I held that “Claim
28 11 says nothing about processing or alteration, and the plain language of ‘from the video image

1 data' indicates nothing about processing or alteration. *Id.* 8. Yet, GoPro's expert's opinion
2 "impliedly adds a processing- and alteration-related requirement." *Id.*; *see also id.* 10.

3 The construction will not be altered. I recognize that courts *may*, in their discretion, revisit
4 claim constructions, *Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1361 (Fed.
5 Cir. 2002), and a genuine dispute between the parties over the meaning of a construction can be
6 one ground for reexamination, *Wi-Lan USA, Inc. v. Apple Inc.*, No. 13CV0798, 2014 WL
7 12789112, at *1 (S.D. Cal. Apr. 11, 2014). But there is no good reason to do so here and various
8 considerations lean against it.

9 This claim and others were already the subject of an intensive claim construction process.
10 Contour suggested the plain and ordinary meaning of the generate terms. Many of GoPro's
11 proposals, in contrast, contained the "in parallel" language. I adopted at least that portion of its
12 proposal. *See* Const. Order 9–13. Then, with claim construction settled, the parties carried out
13 discovery, summary judgment briefing, and trial preparation in reliance on it. At summary
14 judgment, I did what all infringement analyses require: determine whether the claim as construed
15 reads on the accused product. I did not change the construction (nor do I understand GoPro to
16 argue that I did, otherwise it would not really be a "clarification"). To the contrary, I rejected
17 *GoPro's* attempt to effectively change the construction. *See, e.g.*, SJ Order 10 ("GoPro did not
18 request that any processing-related requirements be included in the construction of the generate
19 term. Such a question of scope was proper for resolution at the claim construction stage and is
20 improper now."). The claim construction speaks for itself. The summary judgment order speaks
21 for itself. There is no convincing reason to rewrite the claim construction just because it was
22 applied in a particular way at summary judgment.

23 Several considerations affirmatively counsel against altering the construction. While a
24 genuine dispute about the meaning of a construction might suggest that clarification is warranted, I
25 do not think it would be a productive development in patent litigation if claim constructions were
26 routinely rewritten in light of their specific application at summary judgment. At best, it would
27 invite a second round of claim construction via "clarification" after many summary judgment
28 disputes. Moreover, altering the construction in these circumstances may result in unintended,

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Northern District of California

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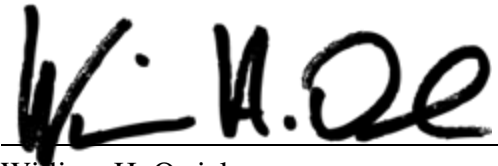
undesirable consequences. For one, application of a claim term at summary judgment may require a detailed and nuanced analysis. Attempting to capture each application of the term in a distilled, curt construction has potential to invite mischief. For another, if the claim meaning is unsettled—even in an attempt to align it with what happened at summary judgment—it may invite arguments about how binding rulings on summary judgment really are in light of the changed construction. In this situation, I believe the better course is simply for GoPro and Contour to make their substantive arguments (e.g., at the next round of summary judgment) relying both on the claim construction and the more robust discussion that occurred at summary judgment, both of which are binding.

CONCLUSION

The motion to strike GoPro’s twelfth affirmative defense is GRANTED; GoPro may move for leave to amend within 21 days on the terms stated in this Order. The motion for judgment on the pleadings is DENIED. The claims are construed as described above.

IT IS SO ORDERED.

Dated: September 13, 2021



William H. Orrick
United States District Judge