

United States District Court
For the Northern District of California

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

OPTIMUMPATH, LLC,
Plaintiff,

v.

BELKIN INTERNATIONAL, INC.;
CISCO-LINKSYS, LLC; D-LINK
SYSTEMS, INC.; NETGEAR, INC.; AND
SMC NETWORKS, INC.,
Defendants.

No. C 09-01398 CW
ORDER CONSTRUING
CLAIMS AND
GRANTING
DEFENDANTS' MOTION
FOR SUMMARY
JUDGMENT
(Docket Nos. 234 &
236)

Plaintiff OptimumPath and Defendants Belkin International,
Inc.; Cisco-Linksys, LLC; D-Link Systems, Inc.; and NETGEAR, Inc.
dispute the meaning of claims in OptimumPath's U.S. patent No.
7,035,281 ('281 patent).¹ In addition, Defendants move for
(1) summary judgment of non-infringement, (2) preclusion of
OptimumPath's claims based on the doctrine of equivalents, and
(3) summary judgment of invalidity. The motions were heard on

¹SMC Networks, Inc. was also a defendant in this action.
However, on April 11, 2011, the Court granted the parties'
stipulation to the dismissal with prejudice of OptimumPath's
claims against SMC, and SMC's counterclaims for non-infringement,
invalidity, and unenforceability. Docket No. 269.

1 February 17, 2011. Having considered all of the parties'
2 submissions and oral argument, the Court construes the claims, and
3 grants Defendants' motion for summary judgment.

4 DISCUSSION

5 The '281 patent is entitled "Wireless Provisioning Device."
6 The patent application was filed on September 13, 2000 by two
7 inventors, Anthony Spearman and Andrew Tompkins of Summerville,
8 South Carolina. Plaintiff asserts two independent claims, claims
9 1 and 13, and six dependent claims, claims 2, 6, and 9 through 12.

10 I. Claim Construction

11 A. Legal Standard

12 The construction of a patent is a matter of law for the
13 Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 372
14 (1996). "It is a 'bedrock principle' of patent law that 'the
15 claims of a patent define the invention to which the patentee is
16 entitled the right to exclude.'" Phillips v. AWH Corp., 415 F.3d
17 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting Innova/Pure Water,
18 Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1115
19 (Fed. Cir. 2004)). Accordingly, in construing disputed terms, the
20 Court first looks to the words of the claims. Vitronics Corp. v.
21 Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).
22 Generally, the Court ascribes the words of a claim their ordinary
23 and customary meaning. Id. The Federal Circuit instructs that
24 "the ordinary and customary meaning of a claim term is the meaning
25 that the term would have to a person of ordinary skill in the art
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1 in question at the time of the invention, i.e., as of the
2 effective filing date of the patent application." Phillips, 415
3 F.3d at 1313. Other claims of the patent in question can also
4 assist in determining the meaning of a claim term. Id. at 1314.
5 "Because claim terms are normally used consistently throughout the
6 patent, the usage of a term in one claim can often illuminate the
7 meaning of the same term in other claims." Id.

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9 The Federal Circuit also instructs that claims "must be read
10 in view of the specification, of which they are a part." Id. at
11 1315 (quoting Markman v. Westview Instruments, Inc., 52 F.3d 967,
12 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996)). The
13 specification must contain a description of the invention that is
14 clear and complete enough to enable those of ordinary skill in the
15 art to make and use it, and thus the specification is "always
16 highly relevant" to the Court's claim construction analysis.
17 Vitronics, 90 F.3d at 1582. "Usually, [the specification] is
18 dispositive; it is the single best guide to the meaning of a
19 disputed term." Id. In some cases, the specification may reveal
20 that the patentee has given a special definition to a claim term
21 that differs from its ordinary meaning; in such cases, "the
22 inventor's lexicography controls." Phillips, 415 F.3d at 1316.
23 The specification also may reveal the patentee's intentional
24 disclaimer or disavowal of claim scope. "In that instance, as
25 well, the inventor has dictated the correct claim scope, and the
26 inventor's intention, as expressed in the specification, is
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1 regarded as dispositive." Id. However, claims are not limited to
2 the preferred embodiment described in the specification. See SRI
3 Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121 (Fed.
4 Cir. 1985) (en banc, plurality opinion).

5 While emphasizing the importance of intrinsic evidence in
6 claim construction, the Federal Circuit has authorized courts to
7 rely on extrinsic evidence, which consists of "all evidence
8 external to the patent and prosecution history, including expert
9 and inventor testimony, dictionaries, and learned treatises."

10 Phillips, 415 F.3d at 1317 (quoting Markman, 52 F.3d at 980).

11 While extrinsic evidence may be useful to the Court, it is less
12 significant than intrinsic evidence in determining the legally
13 operative meaning of claim language. Id.; see also C.R. Bard,
14 Inc. v. U.S. Surgical Corp., 388 F.3d 858, 862 (Fed. Cir. 2004).

15 Furthermore, extrinsic evidence is unlikely to lead to a reliable
16 interpretation of claim language unless considered in the context
17 of the intrinsic evidence. Phillips, 415 F.3d at 1319.

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19
20 B. Analysis

21 The parties dispute the meaning of the following terms:
22 "wireless card," "network card," "chassis," "channeling
23 controller," "routes" and "authenticator."² Claims 1 and 2 recite
24 the disputed language, but the terms and phrases appear throughout
25

26 _____
27 ² Defendants initially sought construction of the term
28 "public domain networks," but the parties now agree that this term
need not be construed.

1 the patent. The claims are as follows, with the disputed language
2 underlined:

3 Claim 1

4 A wireless provisioning device for use in public domain
5 networks wherein the wireless provisioning device is
6 accessible by a user of mobile computing devices,
comprising:

7 a chassis;

8 at least one network card;

9 at least one wireless card;

10 at least one processor;

11 an operating system, the operating system operably
12 configured in the chassis to control the at least one,
13 network card, the at least one wireless card and the at
14 least one processor, which are operatively coupled with
the chassis;

15 a packet-switched interface capable of receiving a
16 multiplicity of inbound framed packet-data to provide
inbound packets and transmitting a multiplicity of
17 outbound framed packet-data comprising outbound packets;

18 a channeling controller, coupled to the packet-switched
19 interface that channels the inbound packets based on the
inbound address information and constructs the outbound
20 packets and channels the outbound packets with the
outbound address information, the channeling controller
21 capable of being effectively connected to at least one
network via the operating system; and

22 an authenticator in operative communication with the
23 operating system to allow authentication at the wireless
provisioning device;

24 whereby the user of a mobile computing device connects
25 to the wireless provisioning device without having to
26 first access the Internet.

27 Claim 2

28 The wireless provisioning device of claim 1, wherein the

1 channeling controller routes the outbound packets.

2 '281 patent at 12:63-13:28.

3 1. Wireless card

4 OptimumPath contends that the word "wireless card" need not
5 be construed. Defendants' proposed construction is

6 a removable printed circuit board having an electrical
7 connector that allows it to connect to a corresponding
8 electrical connector in the chassis that is separate
9 from the network card(s) and transmits and receives
data using a wireless connection.

10 OptimumPath responds that a wireless card refers generally to any
11 component, removable or integrated, with electronic circuitry
12 providing a wireless interface.

13 The sparse language cited by OptimumPath, found in the
14 summary of the invention, indicates that the wireless card was
15 intended to mean a wireless interface. However, a full reading of
16 the specification demonstrates that the wireless card was meant to
17 be a removable wireless interface, as opposed to a component
18 integrated into the invention's internal circuitry. The
19 specification describes the wireless provisioning device as one
20 capable of being "configured with differing numbers of wireless
21 cards and network cards." Id. at 10:11-15. The user can
22 "increase the number of potential customers to the connection
23 point in the network by adding cards and antennas[.]" Id. at
24 10:8-10. At various points, the specification refers to the
25 insertion and addition of cards. Id. at 9:43-47; 9:63-65. The
26 capacity to add or remove cards gives the invention the
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1 flexibility that is one of its defining characteristics. Id. at
2 9:63-10:2. In order to insert or remove a wireless card, it must
3 be a separate, stand-alone circuit board, not a chip soldered and
4 integrated onto the main circuit board inside the chassis.
5 Figures 1 and 2 affirm this understanding because they depict
6 multiple, external wireless cards. Contrary to OptimumPath's
7 argument, this interpretation does not rest solely on the
8 preferred embodiments described in the specification. See Fuji
9 Photo Film Co., Ltd. v. International Trade Com'n., 386 F.3d 1095,
10 1106 (Fed. Cir. 2004).

11
12 In addition to the intrinsic evidence, industry dictionaries
13 provide support for Defendants' interpretation of the term
14 "wireless card." The Microsoft Computer User's Dictionary (1998),
15 the IEEE Authoritative Dictionary on IEEE Standards Terms (2000),
16 the IBM Dictionary of Computing (1994), and Microsoft Press
17 Computer (1994) all define a "card" as a printed or electrical
18 "circuit board" or component that "plug[s] into" or "can be
19 plugged into" a computer. These definitions are uniform and
20 consistent with the understanding of a wireless card as one that
21 is separate and removable from the main circuit board, which is
22 internal to the wireless provisioning device. Boston Scientific
23 Scimed, Inc. v. Cordis Corp., 554 F.3d 982, 987 (Fed. Cir. 2009)
24 ("Courts may of course 'rely on dictionary definitions when
25
26 construing claim terms, so long as the dictionary definition does
27 not contradict any definition found in or ascertained by a reading
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1 of the patent documents . . .") (citing Phillips, 415 F.3d at
2 1322-23).

3 Finally, an OptimumPath pending application before the United
4 States Patent and Trademark Office (PTO), Application No.
5 11/157,592 ('592 application), contradicts its assertions in this
6 action that the '281 patent encompasses wireless interface chips
7 and chipsets. The PTO Examiner rejected the '592 application
8 because it was anticipated by or obvious in light of another
9 OptimumPath application, No. 10,223,255 ('255 application).
10 OptimumPath does not dispute that its '255 application adopted the
11 entirety of its '281 patent, which was pending at that point. In
12 response to the Examiner's rejection, OptimumPath sought to
13 distinguish the '592 application from the '255 application. It
14 explained that the '592 application offered a configuration with a
15 microprocessor chipset that allowed for an indeterminate number of
16 connections, as an alternative to a configuration containing "up
17 to seven wireless connections and one wired connection, or one
18 wired connection and seven wireless connections, or any
19 combination as seen fit for the network."
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22 Thus, by implication, the '281 patent, which also described
23 the wireless provisioning device as containing "up to seven
24 wireless connections and one wired connection, or seven wired
25 connections and one wireless connection, or any combination as
26 seen fit for the network," with no mention of chipsets or chips,
27 treated wireless cards as circuit boards, distinct from chips and
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1 chipsets, which are integrated into motherboards as opposed to
2 insertable and removable.

3 Accordingly, the Court construes a wireless card as "a
4 removable printed circuit board having an electrical connector
5 that allows it to connect to a corresponding electrical connector
6 in the chassis that is separate from the network card(s) and
7 transmits and receives data using a wireless connection."
8

9 2. Network card

10 OptimumPath contends that the phrase "network card" need not
11 be construed. Defendants' proposed construction is "a removable
12 printed circuit board having an electrical connector that allows
13 it to connect to a corresponding electrical connector in the
14 chassis that is separate from the wireless card(s) and transmits
15 and receives data using a wired connection."
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17 Defendants rely on much of the same patent language that
18 refers to the wireless cards as being separate, but capable of
19 insertion into the chassis. They also point to Figure 1, which
20 identifies a "10/100 NIC," a network card that is separate from
21 four wireless cards, and capable of insertion into the chassis.
22 The specification expressly identifies Figure 1 as "an exemplary
23 embodiment of a wireless provisioning device in accordance with
24 the present invention." Id. at 12:7-9.
25

26 OptimumPath counters by pointing out that Figure 2 depicts a
27 "2 slot wireless Router" but it does not show a network card
28 separate from the motherboard. OptimumPath notes that the

1 specification refers to Figure 2 as an embodiment of the patent
2 when it states, "The presently preferred embodiments of the
3 invention will be best understood by reference to the drawings of
4 FIGS. 1-3." Id. at 11:40-42. In addition, the specification
5 describes Figure 2 as "a schematic diagram of a two slot wireless
6 device embodiment in accordance with the present invention." Id.
7 at 3:13-15. According to OptimumPath, because claim 1 requires at
8 least one network card, and a network card is not depicted in
9 Figure 2, the network card must be integrated into the
10 motherboard, not a "separate, removable circuit board."

11
12 However, the specification further explains that Figure 2
13 depicts a 2.4 Ghz bridge, and states that "a typical configuration
14 for a 2.4 Ghz bridge 200 is either 1 or 2 wireless cards with
15 PCM/CIA connectors." Id. at 12:28-30. The specification explains
16 that the "output for the wireless bridge 200 is either the 10/100
17 ethernet or the other wireless card 210." Id. at 12:31-32. Thus,
18 Figure 2 provides a schematic drawing of a 2.4 Ghz bridge which
19 may be configured in two ways--one that includes two wireless
20 cards and no network card, and another that includes a wireless
21 card and a network card. Accordingly, the configuration of the
22 Figure 2 bridge with a network card may embody the claimed
23 invention, even though the configuration of the Figure 2 bridge
24 without a network card does not. The Federal Circuit has
25 explained, "Our precedent is replete with examples of subject
26 matter that is included in the specification, but is not claimed."
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1 TIP Systems, LLC v. Phillips & Brooks/Gladwin, Inc., 529 F.3d
2 1364, 1373 (Fed. Cir. 2008). It is true that the Federal Circuit
3 has also stated that generally claims are not interpreted to
4 exclude embodiments disclosed in the specification. Oatey Co. v.
5 IPS Corp., 514 F.3d 1271, 1276 (Fed. Cir. 2008). Nonetheless,
6 while Figure 2's depiction of a wireless bridge with two wireless
7 cards may not be an embodiment of the claimed invention, an
8 alternate configuration of the figure, as described in the
9 specification, is an embodiment.

11 Accordingly, the Court construes a network card as a
12 removable printed circuit board having an electrical connector
13 that allows it to connect to a corresponding electrical connector
14 in the chassis that is separate from the wireless card(s) and
15 transmits and receives data using a wired connection.

17 3. Chassis

18 OptimumPath contends that the word "chassis" need not be
19 construed, while Defendants' proposed construction is "a casing
20 having slots for removable network and wireless cards."
21 OptimumPath's expert, Dr. Teresa Dahlberg, stated in her report
22 that the chassis described in the '281 patent houses the
23 components of the wireless provisioning device. The '281 patent
24 describes the chassis as containing slots capable of accommodating
25 the addition of various cards and antennas. "The user can also
26 increase the number of potential customers to the connection point
27 in the network by adding cards and antennas without the need for
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1 chassis changes." '281 patent at 10:8-11. "By inserting the
2 cards in the slots of a chassis that contains open-source code,
3 preferably LINUX, as its operating system (OS), the wireless
4 provisioning device can be configured as a router or a bridge."
5 Id. at 9:43-47. Because the device requires removable wireless
6 and network cards, the chassis must contain slots for the
7 insertion of both. Accordingly, the Court construes the term
8 chassis as "a casing having slots for removable network and
9 wireless cards."

11 4. Channeling controller

12 Defendants assert that it is unnecessary to construe the
13 meaning of "channeling controller" because the plain claim
14 language is sufficient to define the term. The claim language
15 states that the "channeling controller . . . channels the inbound
16 packets based on the inbound address information and constructs
17 the outbound packets and channels the outbound packets with the
18 outbound address information." Id. at 13:13-17. The prosecution
19 history for the '281 patent reveals that, after the Examiner
20 rejected claim 1 on the grounds that the description of
21 "channeling controller" was insufficiently definite, OptimumPath
22 responded that "it may readily be ascertained from the claim
23 itself that the channel controller directs and assembles the
24 inbound and outbound data packets based on their address, which
25 gives a definite scope to claim 1." Declaration of Todd Briggs
26 (Briggs Decl.), Ex. DD, DEF005394.
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1 In its opening brief, OptimumPath sought a construction of a
2 "channeling controller" as "a component that routes or bridges
3 packets in a network." In its reply brief, OptimumPath appears to
4 narrow its proposed construction, asserting that the channeling
5 controller is a component of the wireless provisioning device that
6 performs the dynamic routing function.

7 "Without a customary meaning of a term within the art, the
8 specification usually supplies the best context for deciphering
9 claim meaning." Honeywell Intern. Inc. v. Universal Avionics
10 Systems Corp., 488 F.3d 982, 991 (Fed. Cir. 2007). Therefore, the
11 Court rejects OptimumPath's new proposed construction that the
12 "channeling controller" is a component of the wireless
13 provisioning device that necessarily performs the dynamic routing
14 function. Instead, the Court construes the term channeling
15 controller in accordance with the claim language as a component
16 that channels inbound packets based on inbound address information
17 and constructs outbound packets and channels outbound packets with
18 the outbound address information.

21 5. Routes

22 Defendants assert that "routes" includes dynamic or static
23 routing, whereas OptimumPath contends that it requires dynamic
24 routing. Because the term dynamic routing is not expressly used
25 in the '281 patent, the issue is whether the specification, claims
26 or other evidence supports a construction that requires dynamic
27 routing. According to Dr. Dahlberg, the specification clearly
28

1 contemplates dynamic routing because it refers to the Routing
2 Information Protocol (RIP), '281 patent at 7:41-50, which is a
3 form of dynamic routing. Furthermore, the specification describes
4 routers as making

5 use of the destination network identifier in a message
6 to determine an optimum path from the source network
7 to the destination network. Various routing
8 algorithms may be used by routers to determine the
9 optimum paths.

10 Id. at 8:14-18. This description of the routing function reflects
11 dynamic or adaptive routing, rather than static routing, which
12 does not seek out the optimum path for the transmission of data
13 packets. Declaration of Corby R. Vowell in Support of Opening
14 Claim Construction Brief, Ex. 5, IEEE 100--The Authoritative
15 Dictionary of IEEE Standard Terms 16 (7th Ed. 2000). Therefore,
16 the Court finds that "routes" requires dynamic routing.

17 6. Authenticator

18 OptimumPath proposes that the term "authenticator" be
19 construed as,

20 a mechanism for authenticating the identity of a
21 device or user in a manner that does not require the
22 wireless provisioning device to be rebooted each time
a new user or device is added to the network.

23 Defendants, on the other hand, seek to define the term more
24 broadly, simply as "a mechanism for authenticating the identity of
25 a device or user."³

26
27 ³ The construction Defendants propose in their brief is not
28 the same as the construction they previously set forth in the
Joint Claim Construction Statement.

1 The plain language of asserted claims 1, 2, 6, and 9 through
2 13 does not make express reference to an authenticator capable of
3 adding new users without rebooting. Defendants correctly argue
4 that, because the rebooting requirement is omitted in the asserted
5 claims but included in other, unasserted claims, it is
6 impermissible to import such a limitation into the asserted
7 claims. Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d
8 1313, 1326 (Fed. Cir. 2003) ("Our court has made clear that when a
9 patent claim does not contain a certain limitation and another
10 claim does, that limitation cannot be read into the former claim
11 in determining either validity or infringement"). Furthermore,
12 because the '281 patent specification provides an explicit
13 definition for "authentication," which does not include a no-
14 rebooting requirement, it is improper to import such a limitation
15 into the definition of authentication. Linear Tech. Corp. v.
16 Int'l Trade Comm'n, 566 F.3d 1049, 1054 (Fed. Cir. 2009)
17 (affirming a claim construction because it was consistent with the
18 specification's explicit definition).
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21 Thus, while the patent addresses a problem with the prior
22 art, which required rebooting each time a change was made to the
23 list of authorized users or devices, and the specification states
24 that the invention does not require rebooting, this aspect of the
25 patent describes a characteristic of the invention, rather than a
26 requirement of the authenticator. Therefore, the Court construes
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1 an authenticator as simply a mechanism for authenticating the
2 identity of a device or user.

3 II. Motion for Summary Judgment

4 A. Legal Standard

5 Summary judgment is properly granted when no genuine and
6 disputed issues of material fact remain, and when, viewing the
7 evidence most favorably to the non-moving party, the movant is
8 clearly entitled to prevail as a matter of law. Fed. R. Civ. P.
9 56. Celotex Corp v. Catrett, 477 U.S. 317, 322-23 (1986);
10 Eisenberg v. Ins. Co. of N. Am., 815 F.2d 1285, 1289 (9th Cir.
11 1987). The court must draw all reasonable inferences in favor of
12 the party against whom summary judgment is sought. Matsushita
13 Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986);
14 Intel Corp. v. Hartford Accident & Indem. Co., 952 F.2d 1551, 1558
15 (9th Cir. 1991).

16
17
18 Material facts which would preclude entry of summary judgment
19 are those which, under applicable substantive law, may affect the
20 outcome of the case. The substantive law will identify which
21 facts are material. Anderson v. Liberty Lobby, Inc., 477 U.S.
22 242, 248 (1986).

23 B. Non-Infringement

24
25 The Court now considers whether there is evidence that the
26 accused devices infringe the '281 patent given the Court's
27 constructions. "Infringement is assessed by comparing the accused
28 device to the claims; the accused device infringes if it

1 incorporates every limitation of a claim, either literally or
2 under the doctrine of equivalents." MicroStrategy Inc. v.
3 Business Objects, S.A., 429 F.3d 1344, 1352 (Fed. Cir. 2005)
4 (alterations omitted). "If, however, even one claim is missing or
5 not met, there is no literal infringement." Id.

6 1. Literal Infringement

7 As explained above, the Court has construed the wireless and
8 network cards to be separate, removal circuit boards providing
9 wireless and network interfaces, and has further defined the
10 chassis as a casing having slots for removable network and
11 wireless cards. OptimumPath's expert, Dr. Dahlberg, has conceded
12 that, under those constructions, none of the accused products
13 literally infringes the '281 patent. Briggs Decl., Ex. I,
14 Dahlberg Dep. at 85:24-87:7; 88:11-24 and 90:19-91:7. Therefore,
15 the Court summarily adjudicates that the accused devices do not
16 literally infringe the '281 patent.

17 2. Doctrine of Equivalents

18 Defendants contend that OptimumPath failed to comply with the
19 requirements of Patent Local Rule 3-1(e), and thus should be
20 precluded from asserting an infringement claim based on the
21 doctrine of equivalents. Patent Local Rule 3-1 requires a
22 plaintiff to serve on all parties a "Disclosure of Asserted Claims
23 and Infringement Contentions." Separately for each opposing
24 party, the disclosure must include, among other information,
25 "[w]hether each limitation of each asserted claim is alleged to be
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1 literally present or present under the doctrine of equivalents in
2 the Accused Instrumentality." Patent L.R. 3-1(e). Under the
3 heading "Patent L.R. 3-1(e)," OptimumPath referred to an attached
4 Exhibit A, a claims chart that provided no indication as to
5 whether it asserted literal or doctrine of equivalents
6 infringement with respect to each limitation of each of its
7 asserted claims. Thus, OptimumPath did not expressly invoke the
8 doctrine of equivalents, as required by Patent Local Rule 3-1.

9
10 Nevertheless, OptimumPath asserts that Defendants were
11 sufficiently notified of its equivalency claims through its
12 disclosure under the heading Patent Local Rule 3-1(c). There,
13 OptimumPath stated that its

14 disclosures pursuant to Patent L.R. 3-1(c) are set
15 forth in the chart as Exhibit A. For purposes of
16 infringement of the '281 Patent and the disclosure
17 requirements of L.R. 3-1(c), OptimumPath asserts that
18 the Accused Instrumentalities all function in the same
or substantially similar manner and include the same
or substantially similar components.

19 OptimumPath contends that this catch-all statement preserved its
20 claims based on the doctrine of equivalents.

21 Courts in this district, however, have strictly applied
22 Patent Local Rule 3-1(e). Rambus Inc. v. Hynix Semiconductor
23 Inc., 2008 WL 5411564, *3 (N.D. Cal.) (holding that plaintiff's
24 failure to comply with Patent Local Rule 3-1(d), the predecessor
25 rule to Rule 3-1(e), "provides ample, alternative justification
26 for dismissing Rambus's claims of infringement under the doctrine
27 of equivalents"); MEMC Electronic Materials v. Mitsubishi

1 Materials Silicon Corp., 2004 WL 5363616, *4-6 (N.D. Cal.)
2 (precluding reliance on the doctrine of equivalents and barring
3 related expert testimony because plaintiff failed to disclose such
4 claims as required by Patent Local Rule 3-1(d)). "The patent
5 local rules were adopted by this district in order to give
6 infringement contentions and claim charts more 'bite.'" MEMC
7 Electronic, 2004 WL 5363616 at *4.

8
9 Thus, judges of this court have rejected plaintiffs' attempts
10 to assert claims under the doctrine of equivalents with blanket
11 statements. Rambus, 2008 WL 5411564 at *3 ("The Patent Local
12 Rules require a limitation-by-limitation analysis, not a
13 boilerplate reservation."); MEMC Electronic, 2004 WL 5363616 at *5
14 ("This blanket statement does not identify where each element of
15 each asserted claim is found within each wafer and does not point
16 out each element of each asserted claim that MEMC claims is
17 present under the doctrine of equivalents."). Here, OptimumPath
18 also relies on a blanket statement, asserting substantial
19 similarities as to the instrumentalities, but failing to link
20 those similarities to particular claims or limitations within the
21 '281 patent. This language falls short of the requirements of
22 Patent Local Rule 3-1(e). Accordingly, OptimumPath's reliance on
23 the doctrine of equivalents is barred. Genentech, Inc. v. Amgen,
24 Inc., 289 F.3d 761, 773-74 (2002).

25
26
27 Even if the Court were to consider OptimumPath's arguments
28 under the doctrine of equivalents, OptimumPath fails to produce

1 sufficient evidence of infringement. The parties agree on two
2 tests to determine equivalence--the "insubstantial difference
3 test," and the "function-way-result" test. "An element in the
4 accused product is equivalent to a claim limitation if the
5 differences between the two are 'insubstantial' to one of ordinary
6 skill in the art." Seafoss v. Pioneer Consol. Corp., 374 F.3d
7 1142, 1150 (Fed. Cir. 2004). "Under the function-way-result test,
8 one considers whether the element of the accused device at issue
9 performs substantially the same function, in substantially the
10 same way, to achieve substantially the same result, as the
11 limitation at issue in the claim." The Federal Circuit has stated
12 that it applies the insubstantial differences test, and "[i]n
13 appropriate cases" the function-way-result test "offers additional
14 guidance on the question of equivalence." Dawn Equipment Co. v.
15 Kentucky Farms, Inc., 140 F.3d 1009, 1015-16 (Fed. Cir. 1998).
16 The Supreme Court has not ruled on which test provides the better
17 approach. Instead the Court has explained,
18

19
20 In our view, the particular linguistic framework used
21 is less important than whether the test is probative
22 of the essential inquiry: Does the accused product or
23 process contain elements identical or equivalent to
24 each claimed element of the patented invention?

25 Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S.
26 17, 40 (1997).

27 Dr. Dahlberg states in her report that an integrated wireless
28 card is equivalent to a separate, removable wireless card because
it performs the same function, in substantially the same way, and

1 achieves the same result, by essentially allowing network-capable
2 devices to access the network through a wireless connection.
3 Briggs Decl., Ex. I, Dahlberg Dep. at 93:18-97:17. Dr. Dahlberg's
4 report, however, does not establish equivalency in another
5 important regard. It is undisputed that integrated wireless
6 chipsets cannot be removed from an internal motherboard without
7 causing damage, and thus the removable wireless cards offer the
8 distinct advantage of permitting upgrades, repairs and
9 modifications, rendering the wireless provisioning device more
10 adaptable. Declaration of Dr. Nicholas Bambos, (Bambos Decl.)
11 ¶ 90. The ability to add or remove cards provides flexibility
12 that is one of the defining characteristics of the wireless
13 provisioning device. '281 patent at 9:63-10:2. Because
14 OptimumPath has not produced evidence to establish the equivalence
15 of this element of the accused devices, the Court summarily
16 adjudicates that the devices do not infringe the '281 patent under
17 the doctrine of equivalents.
18

19
20 III. Invalidity

21 Defendants assert that three prior art devices invalidate the
22 '281 patent by anticipation or obviousness.

23 Title 35 U.S.C. § 102 establishes the various grounds for
24 invalidation of patents based on anticipation by prior art. The
25 defense of anticipation requires "the presence in a single prior
26 art disclosure of all elements of a claimed invention arranged as
27 in the claim.'" Therasense, Inc. v. Becton, Dickinson and Co.,

1 593 F.3d 1325, 1333 (Fed. Cir. 2010) (quoting Transclean Corp. v.
2 Bridgewood Servs., Inc., 290 F.3d 1364, 1373 (Fed. Cir. 2002)).

3 Section 102(a) provides that a claimed invention cannot be
4 validly patented if it was known, in use, patented, or described
5 in a printed publication anywhere in the world, before the
6 patentee's date of invention. 35 U.S.C. § 102(a).

7 To invalidate a patent under section 102(b), an invention
8 must have been "patented or described in a printed publication in
9 this or a foreign country or in public use or on sale in this
10 country, more than one year prior to the date of the application
11 for the patent in the United States." 35 U.S.C. § 102(b).

12 Section 102(g) "provides that an applicant is not entitled to
13 a patent if 'before such person's invention thereof, the invention
14 was made in this country by another, who had not abandoned,
15 suppressed, or concealed it.'" Apotex Corp. v. Merck & Co., Inc.,
16 507 F.3d 1357, 1359 (Fed. Cir. 2007) (quoting 35 U.S.C. § 102(g)).

17 If the requirements for an anticipation defense are not
18 satisfied, obviousness provides another theory for invalidating a
19 patent. Title 35 U.S.C. § 103(a) provides,
20
21

22 A patent may not be obtained though the invention is
23 not identically disclosed or described as set forth in
24 section 102 of this title, if the differences between
25 the subject matter sought to be patented and the prior
26 art are such that the subject matter as a whole would
27 have been obvious at the time the invention was made
28 to a person having ordinary skill in the art to which
said subject matter pertains.

1 To avoid being obvious, a patent must be "more than the
2 predictable use of prior art elements according to their
3 established functions." KSR In't Co. v. Teleflex Inc., 550 U.S.
4 398, 417 (2007). To determine obviousness, "the invention must be
5 considered as a whole and the claims must be considered in their
6 entirety." Kahn v. General Motors Corp., 135 F.3d 1472, 1479
7 (Fed. Cir. 1998).

8
9 A. ISP Base Station

10 Defendants assert that certain ISP Base Station prior art,
11 that corresponding to 1998 and 1999 invoices, contained every
12 limitation of claims 1, 2 and 9 through 12, except for a removable
13 network card and chassis, if those terms are construed as
14 Defendants propose. However, Defendants contend that the
15 removable network card and slotted chassis would have been obvious
16 to one of ordinary skill in the art because other versions of the
17 ISP Base Stations included removable network cards. Defendants
18 further argue that the other two asserted claims--6 and 13--are
19 obvious because it would have been obvious to combine the ISP Base
20 Station with a Linux operating system.

21
22 OptimumPath's sole argument that the ISP Base Station does
23 not invalidate the asserted claims of the '281 patent is that the
24 device performed only a bridging function, not a routing function,
25 and therefore did not include the patent's claimed channeling
26 controller. This argument fails in light of the Court's
27 construction of the channeling controller, as a component which
28

1 "channels the inbound packets based on the inbound address
2 information and constructs the outbound packets and channels the
3 outbound packets with the outbound address information." In
4 addition, Defendants present evidence the ISP Base Station did
5 perform the routing function, and OptimumPath presents no evidence
6 to the contrary. Doug Karl's testimony and corroborating evidence
7 supports that the ISP Base Station used RIP. OptimumPath does not
8 dispute, and its own expert agrees, that RIP is a dynamic routing
9 protocol. Dahlberg Report, ¶ 21. Therefore, the Court grants
10 Defendants' motion for summary adjudication that the ISP Base
11 Station invalidates the asserted claims of the '281 patent.

13 B. Apple AirPort

14 Defendants next argue that the Apple AirPort prior art
15 invalidates all of the asserted claims of the '281 patent due to
16 anticipation under sections 102(b) and (g), and obviousness under
17 section 103(a).

18 With respect to timing, OptimumPath disputes only that the
19 Apple AirPort was prior art within the meaning of section 102(b).
20 The relevant portion of section 102(b) states that a patent is
21 invalid if the claimed invention was on sale more than one year
22 prior to the date the patent application was filed. 35 U.S.C.
23 § 102(b). OptimumPath points out the absence of evidence as to
24 when the Apple AirPort was first sold or shipped. However, a
25 claimed invention is considered "on sale" within the meaning of
26 section 102(b) when it is offered for sale. Scaltech, Inc. v.
27
28

1 Retec/Tetra, LLC, 269 F.3d 1321, 1325 (Fed. Cir. 2001). The
2 sealed evidence upon which Defendants rely shows that the AirPort
3 was on sale within the meaning of § 102(b) more than one year
4 before the application for the '281 patent was filed.

5 Defendants argue that the '281 patent is obvious in light of
6 the Apple AirPort. First, Defendants argue that the Apple AirPort
7 contains every limitation of claims 1 and 9 through 12, except for
8 a removable network card and chassis as Defendants construe those
9 terms. Defendants contend that it would have been obvious to one
10 of ordinary skill in the art to use a removable network card in
11 the Apple AirPort because removable network cards at the time were
12 widely available and were included in some versions of Karl's ISP
13 Base Station.
14

15 Similarly, Defendants assert that claims 6 and 13 were
16 rendered obvious by the AirPort because the Linux operating system
17 was freely available as a fully functional "off-the-shelf"
18 operating system and a person of ordinary skill would have
19 recognized that combining it with the Linux operating system would
20 improve the device.
21

22 Finally, Defendants argue that the Apple AirPort renders
23 obvious claim 2 of the '281 patent, which claims "[t]he wireless
24 provisioning device of claim 1, wherein the channeling controller
25 routes the outbound packets." '281 patent at 13:27-28. Karl
26 testified to having sold hundreds of upgrades for the Apple
27 AirPort before September, 1999, which added the routing function
28

1 to the device. The sealed testimony on which OptimumPath relies
2 does not create a material dispute as to the availability of these
3 upgrades for the Apple AirPort at that time.

4 OptimumPath's argument that the Apple AirPort does not render
5 obvious the asserted claims of the '281 patent relies on two
6 purported distinctions between the patent and the Apple AirPort.
7 First, OptimumPath argues that the AirPort did not perform a
8 routing function, and therefore lacked a channeling controller.
9 This argument, however, is unavailing because the Court's
10 construction of channeling controller does not require that it
11 must perform a routing function. Thus, even if the Apple AirPort
12 did not perform a routing function, that is not sufficient to show
13 that it did not include the channeling controller element of
14 claims 1 and 13 of the '281 patent. Furthermore, if the
15 channeling controller were construed to require that it perform a
16 routing function, as explained earlier, adding such a function
17 would have been obvious. Therefore, OptimumPath's argument as to
18 the channeling controller fails to establish that the asserted
19 claims of the '281 patent were not obvious in the light of the
20 Apple AirPort.
21
22

23 Second, OptimumPath argues that the AirPort did not render
24 obvious the asserted claims of the patent because the
25 authenticator, under its proposed construction, includes a no-
26 rebooting requirement. However, Court has construed the
27 authenticator without the no-rebooting requirement. Therefore,
28

1 even if the AirPort required rebooting, this does not show that it
2 did not contain the authenticator element of the '281 patent. In
3 addition, Defendants have produced evidence that the Apple AirPort
4 did not require rebooting, and OptimumPath has failed to submit
5 any contrary evidence that would demonstrate a dispute of fact as
6 to this issue. Therefore, the Court finds that the AirPort
7 invalidates the asserted claims of the '281 patent due to
8 obviousness.
9

10 C. Täht/Retkowski System

11 Finally, Defendants argue that the asserted claims of the
12 '281 patent are invalid as anticipated by the Täht/Retkowski
13 System. The Court need not resolve this issue because the Court
14 has found that the ISP Base Station and Apple AirPort invalidate
15 the asserted claims of the '281 patent.
16

17 CONCLUSION

18 The Court construes the following terms in the '281 patent.
19 A "wireless card" is a removable printed circuit board having an
20 electrical connector that allows it to connect to a corresponding
21 electrical connector in the chassis that is separate from the
22 network card(s) and transmits and receives data using a wireless
23 connection. The Court construes a "network card" as a removable
24 printed circuit board having an electrical connector that allows
25 it to connect to a corresponding electrical connector in the
26 chassis that is separate from the wireless card(s) and transmits
27 and receives data using a wired connection. The Court construes
28

1 the term "chassis" as a casing having slots for removable network
2 and wireless cards. A "channeling controller" is a component that
3 channels inbound packets based on inbound address information and
4 constructs outbound packets and channels the outbound packets with
5 outbound address information. "Routes" requires dynamic routing.
6 An "authenticator" is a mechanism for authenticating the identity
7 of a device or user.

8
9 The Court GRANTS Defendants' motion for summary judgment on
10 OptimumPath's claim for literal infringement, and Defendants'
11 motion to preclude OptimumPath's claims based on the doctrine of
12 equivalents. The Court also finds that the accused devices do not
13 infringe under the doctrine of equivalents. The Court GRANTS
14 Defendants' motion for summary judgment that asserted claims 1, 2,
15 6, and 9 through 13 of the '281 patent are invalidated by the ISP
16 Base Station prior art and the Apple AirPort prior art. The
17 pretrial conference and trial dates are vacated. The clerk shall
18 enter judgment in Defendants' favor, and Defendants shall recover
19 costs from Plaintiffs.

20
21 IT IS SO ORDERED.

22
23
24 Dated: 4/12/2011

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26
27
28


CLAUDIA WILKEN
United States District Judge