2015-1169, -1241

In The
United States Court Of Appeals
For The Federal Circuit

DELORME PUBLISHING COMPANY, INC. and DELORME INREACH, LLC,

Plaintiffs-Appellees,

v.

BRIARTEK IP, INC.,

Defendant-Appellant.

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA IN NO. 1:13-CV-00640-LMBTRJ, JUDGE LEONIE M. BRINKEMA

BRIEF OF APPELLANT

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CERTIFICATE OF INTEREST

Counsel for Defendants-Appellants certifies the following:

1. The full name of every party or amicus curiae represented by me is:

BriarTek IP, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus curiae now represented by me in the trial court or agency or are expected to appear in this court are:

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Date: March 9, 2015

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STATEMENT OF RELATED CASES

DeLorme's appeal from the related Enforcement Proceeding is pending as *DeLorme Publishing Company et al. v. International Trade Commission*, Appeal No. 14-1572.

INTRODUCTION

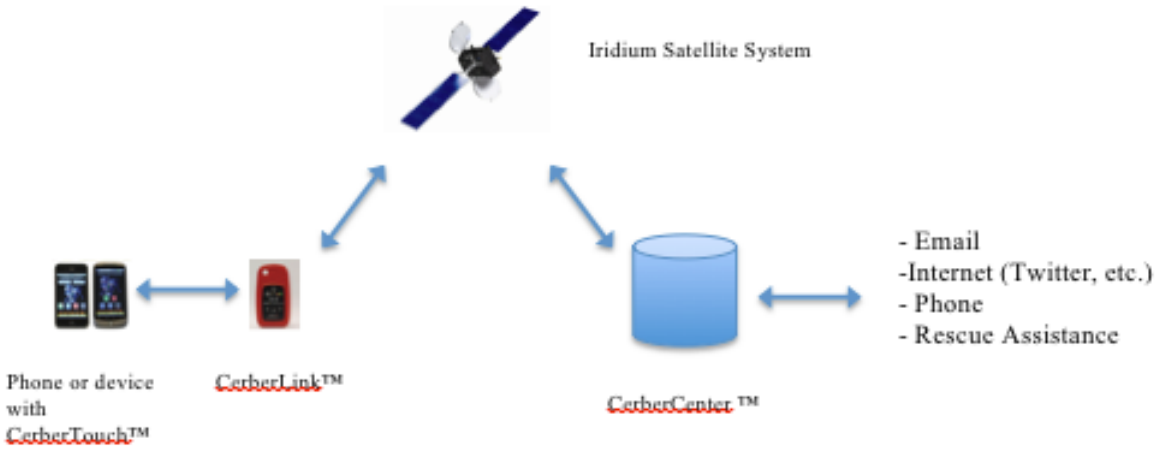
Appellant BriarTek IP, Inc. is an Alexandria, Virginia company that is commonly owned with BriarTek Inc. BriarTek IP, Inc. owns U.S. Patent No. 7,991,380 (the "'380 patent"). BriarTek is appealing four decisions by the district court in the Eastern District of Virginia: (i) to accept jurisdiction over a declaratory judgment complaint (A0062), (ii) not to strike attorney argument from a summary judgment motion (A0063), (iii) to invalidate all of the asserted claims of the '380 patent (A0016-60) and (iv) to award costs including costs from the International Trade Commission ("ITC") investigations (A0010-15). BriarTek is asking this Court to vacate, reverse and/or remand the matter, including an award of costs, if appropriate.

BriarTek Inc. manufactures a two-way satellite communication system, the Cerberus, which is covered by the '380 patent. A0126. The Cerberus system consists of three parts: CerberLink™ – a handheld satellite communications device with onboard GPS and Bluetooth interface. The CerberLink™ operates on the Iridium satellite network; CerberTouch™ – a smartphone application that allows the user to input settings and send and receive natural language text messages via satellite, cellular or wifi connections; and CerberCenter™ – a server that tracks users based on breadcrumbs, tracks and messages. CerberCenter™ is also where

users manage their account data and contact information. A0126-7. A picture of a CerberLink™ is shown below:



A depiction of the system is shown below.



for sale to the public and is also available for rent. Approximately 70 units were dispatched around Washington DC by the Crowd Logistics Manager for the 57th Presidential Inaugural Committee, National Mall – Public Viewing Area during the recent second term inauguration of President Obama and Vice-President Biden. Using the Cerberus system allowed Crowd Logistics to stay in communication and avoid the public cellular carriers. A0127.

Appelees DeLorme Publishing Co., Inc. and DeLorme InReach LLC (collectively "DeLorme") sell a competing product to the BriarTek Cerberus that is referred to as the InReach[tm]. When the BriarTek Cerberus product was introduced in 2011, DeLorme's reaction was memorialized in a November 18, 2011 email:

> This is a consumer item and a threat! We should not take it lightly. They have apple and we do not. We need to get the apple piece hammered out ***crush these bastards***! ….

A5172 (emphasis added). DeLorme would go on to buy several BriarTek CerberLink™ devices to determine how the it was made. A1172 & A5172. DeLorme's CEO, Michael Hefforn, even kept a BriarTek CerberLink™ on his desk. What DeLorme saw as its trump card, however, was the fact that it was a larger company that could manufacture overseas and win on price. A5172.

In light of unfair competition from products produced in Taiwan, on August 12, 2012, BriarTek requested initiation of ITC Investigation No. 337-TA-854 based on the alleged infringement of claims 1, 2, 5, 10, 11, 12 and 34 of the '380 patent. A0150-51. DeLorme voluntarily terminated the ITC Investigation based on a Consent Order. A0153, A0155-171. DeLorme claimed to have a preexisting plan to change its final manufacturing location from Taiwan to Yarmouth, Maine and asserted the dispute was moot. A0100.

After the Consent Order, DeLorme continued to use imported claimed components in violation of the ITC Consent Order. On April 10, 2013, BriarTek

petitioned the ITC under Rule 210.75 to initiate an Enforcement proceeding. A0173, A0219-38.

On May 24, 2013, the ITC instituted Investigation No. 337-TA-854 Enforcement, (the "Enforcement Proceeding"). A4541. Four days later, on May 28, 2013, DeLorme filed a declaratory judgment action (Case No. 1:13-CV-00640) to collaterally attack the Consent Order. A0098-0120. This appeal is based on the rulings made in the district court.

BriarTek initially moved to dismiss for lack of subject matter jurisdiction. A0124. Delorme's basis for jurisdiction was the ITC Consent Order and BriarTek's petition for the Enforcement Proceeding. A0138-141. There was no pending case-or-controversy involving BriarTek. DeLorme presented no evidentiary basis for jurisdiction. A0247. The court denied the motion but provided no insight into its decision. A0062. BriarTek is appealing this decision. A0062.

On November 18, 2013, a hearing was conducted in the Enforcement Proceeding. Two days after the hearing, on November 20, 2013, DeLorme filed a motion for summary judgment of invalidity. A0485. The parties agreed that the level of ordinary skill in the art was beyond a laymen but disagreed on the appropriate level. A0500. The summary judgment motion contained no element-by-element analysis, including no expert testimony applying the asserted claims to

the prior art. A0505-14; A1158-165. Rather, the motion relied upon attorney argument to prove invalidity. *Id*. This attorney argument, in the form of summary paragraphs, could never meet the requirements of clear and convincing evidence on summary judgment.

BriarTek first moved to strike the attorney argument from the summary judgment motion, but that motion was denied. A2024-122, A0063. BriarTek opposed the summary judgment motion (A2490) and supported its opposition with (i) evidence, including a declaration from its expert Dr. Steffes (A2550-87), (ii) evidence on claim construction, comparing the construed elements to the alleged references and (iii) evidence from DeLorme's expert who supported some of BriarTek's positions in the related ITC proceeding. BriarTek's opposition was directed to the motion as presented by DeLorme.

On March 11, 2014, the court was made aware that the ITC found that DeLorme infringed claim 2 of the '380 patent and was in violation of the Consent Order. A4524 & A5524-5. The ITC found that "there was clear evidence that Respondents [DeLorme] acted in bad faith." A5520.

On June 11, 2014, the court was made aware that DeLorme was fined $6,242,500. A4537. That matter is pending before this Court as Appeal No. 2014-1572.

On June 19, 2014, DeLorme wrote to the court pleading to invalidate the '380 patent because "a Court ruling invalidating the patent, either on summary judgment or at trial, would affect the outcome of the Commission proceedings." A4550.

On November 19, 2014, the court granted DeLorme's Summary Judgment but on substantive grounds created by the court in violation of Rule 56(f), not on the facts and issues that DeLorme presented in its motion. For example, because there was no element-by-element analysis in the motion, the court constructed it's own claim charts to invalidate asserted claims of the '380 patent. A0016-61.

The summary judgment motion did not discuss the appropriate claim construction so the court attempted to sidestep that flaw by using a contingent claim construction, BriarTek's construction, solely for the purpose of invalidity. A0027. The court then resolved the dispute over the level of ordinary skill in the art by using BriarTek's level of ordinary skill in the art. A0030. The Judge then created her own element-by-element analysis from later filed materials to invalidate the claims. A0032-41 and A0042-48. The judge-created claim charts cite to DeLorme's expert reports that apply DeLorme's claim construction, not BriarTek's, and render an opinion under a non-existent level of ordinary skill in the art, not the level adopted by the court.

In its summary judgment order, the court held de Vries anticipated claims 1, 5-12, 17, 34 and 35, but only did so by applying DeLorme's claim construction, not the adopted construction proposed by BriarTek. A salient example is where the court found "detailed text messages" were not in the claims. A0035. But in the adopted construction, "text entry device" was defined as "Keypad or virtual keyboard capable of entering ***detailed*** t[e]xt messages." A0029(emphasis added). The word "detailed" was in the claims as purportedly construed by the court but this construction was ignored.

The court also held "ORBCOMM" anticipated claims 1, 2, 17, 34 and 35 of the '380 patent, by once again creating its own claim charts that cited to the DeLorme expert report that applied DeLorme's claim construction. In ORBCOMM the court also weighed evidence. One of the points of distinction between claim 1 and the ORBCOMM reference concerns whether the "NCC" in the reference meets the "monitoring system" element in claim 1. A0045-46. Mr. Zancho, DeLorme's own expert, agreed with BriarTek's expert Dr. Steffes, that the "NCC" was not a claimed monitoring system. DeLorme's expert Mr. Zancho stated:

Q. Okay. So the NCC itself is not –

A. All by itself is not a monitoring system.

A2509, A2850. The court held the deposition testimony was a quote taken out of context. A0046. The cited deposition testimony was actually a request to DeLorme's expert to confirm his changed opinion set forth in his Reply expert report. In that report, Mr. Zancho stated: "I am not using these references to argue that the NCC is a monitoring service." A4432. The court's weighing of evidence and activist analysis was improper.

The court also had three obviousness combinations that the court, not DeLorme, made up. A0054-57. They were not combinations in the summary judgment motion or even combinations that DeLorme's expert opined on. A0512-14, A3931. BriarTek opposed the summary judgment motion as presented and had no notice or opportunity to respond to the court's new theories.

After constructing an order for DeLorme the court apparently believed would vitiate the ITC fine, the court went on award costs to DeLorme that included costs incurred in the ITC Investigations. A0010.

BriarTek is asking this Court to vacate, reverse and/or remand the matter and for any relief that this Court deem appropriate, including costs and reassignment.

JURISDICTION

BriarTek contests jurisdiction. On May 28, 2013, DeLorme filed a declaratory judgment action. DeLorme alleged subject matter jurisdiction under 28 U.S.C. §§ 1331, 1138(a), 2201 and 2202. DeLorme's Complaint identifies the

"justiciable controversy" as ITC investigation Nos. 337-TA-854 and BriarTek's petition to institute an enforcement proceeding. A0099-102. DeLorme's Complaint specifically stated its intent to comply with the Consent Order and that production was moved to the U.S. based on a "pre-existing business plan." A0100 at ¶12. There was no justiciable case or controversy.

BriarTek moved under Rule 12(b)(1) to dismiss for lack of jurisdiction. A0121. On July 18, 2013, the court held a hearing on the motion and denied it without prejudice. A0408, A0062.

STATEMENT OF ISSUES

The issues presented are as follows:

1. Did the court improperly find that it had jurisdiction when the prior dispute between the parties was settled by way of a Consent Order that DeLorme voluntarily entered into with the ITC, and BriarTek exercised its Constitutional First Amendment rights to request that the ITC exercise the ITC's rights under the Consent Order?

2. Did the court err in refusing to strike and then relying on attorney argument to understand the patent, the claims and the prior art, when the level of skill in the art is beyond a laymen?

3. Did the court err in not construing disputed claim terms prior to performing an invalidity analysis?

4. Did the court err in creating its own analysis for anticipation and obviousness that was based on expert reports filed after the summary judgment briefing was completed and upon which BriarTek was not given notice and opportunity to respond?

5. Did the court err in its anticipation analysis by weighing evidence, not using the purported claim construction and relying on an expert report that cited to a different claim construction and did not have a level of ordinary skill in the art?

6. Did the court improperly include costs from the ITC matters in its award costs?

STATEMENT OF THE CASE AND THE FACTS

A. BriarTek

BriarTek IP, Inc. is an Alexandria, Virginia company owned by the same three individuals that own and operate BriarTek Inc. BriarTek IP, Inc. was formed to hold the intellectual property associated with the products designed, developed and manufactured by BriarTek Inc. BriarTek Inc. designed, developed and manufactures the Cerberus, which is a two-way satellite communication system. A0126. The BriarTek Cerberus system is protected by U.S. Patent No. 7,991,380 (the "'380 patent"), which is the subject of this appeal. A0107-18.

B. DeLorme

DeLorme Publishing Company, Inc. and DeLorme InReach LLC are corporations with their principal place of business in Maine. A0098.

C. The ‘380 Patent

The ‘380 Patent is entitled “Global Bidirectional Locator Beacon and Emergency Communication System.” The '380 Patent issued from United States Patent Application No. 11/693,434 (the "'434 Application"), which was filed on March 29, 2007 and claimed priority to Provisional Application No. 60/788,411, filed on March 30, 2006. A0107.

The ‘380 Patent is directed to a monitoring and reporting system comprised of a user unit and a monitoring system. This allows for both the transmission and reception of data between the user and a monitoring system through satellite infrastructure. The patent recognized that simply sending precanned, preformatted or structured messages was insufficient to help many in need of rescue and thus was based around the ability to include detailed messaging. The ‘380 patent described these two very difference concepts:

> This single-key (or few-key) feature can be included in addition to the keyboard or other text entry device, so that a user can enter a detailed text message when able, and can send a general category message when unable to key text due to the severity of the user's condition, or can provide a first alert to be followed by a detailed message.

A0014. The inclusion of a detailed text entry device interplays with other elements of the claim, such as how the data is transmitted, received, monitored and ultimately viewed. A0116, A2560-70.

1. Claims of the '380 patent at issue

Claim 1 of the '380 patent provides:

> 1. An emergency monitoring and reporting system, comprising:
>
> a user unit; and
>
> a monitoring system;
>
> wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system;
>
> wherein the monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device;
>
> wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device; and
>
> wherein the input device includes a text entry device adapted to receive textual data entered by a user.

A0116.

Claim 2 recites "[t]he system of claim 1, wherein the user unit is adapted to be coupled to a user." A0116.

Claim 5 recites "[t]he system of claim 1, wherein the user unit further includes a memory device in communication with the user processor, and the input device includes an actuator that when selected accesses message data stored in the memory device." A0116.

Claim 6 recites "[t]he system of claim 5, wherein selection of the actuator causes the accessed message data to be transmitted by the user satellite communication system to the monitor communication system via the satellite network." A0116.

Claim 7 recites "[t]he system of claim 6, wherein the message data includes a plurality of instances of message data, wherein each data instance of said plurality of data instances is stored in a respective selectable portion of the memory device." A0116.

Claim 8 recites "[t]he system of claim 7, wherein the input device includes a selection device that is adapted to select one message data instance from among the plurality of data instances, wherein the selected one message data instance is transmitted by the user satellite communication system on selection of the actuation device." A0116.

Claim 9 recites "[t]he system of claim 8, wherein the selection device is a scrolling device." A0116.

Claim 10 recites "[t]he system of claim 1, wherein the user satellite communication system includes a transmitter, and wherein the input device is adapted to receive user data from a user and the user processor is adapted to format the data for transmission by the transmitter." A0116.

Claim 11 recites "[t]he system of claim 10, wherein the monitor satellite communication system includes a receiver that is adapted to receive transmissions from the transmitter via the satellite network, and wherein the monitor processor is adapted to format the user data received by the receiver for presentation to the observer on the output device." A0116.

Claim 12 recites "[t]he system of claim 11, wherein the output device is adapted to display textual messages." A0116.

Claim 17 recites "[t]he system of claim 1, wherein the user unit further includes a status sensor that is communicatively coupled to the user processor and that provides a status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network." A0117.

Claim 34 recites "[t]he system of claim 1, wherein the satellite network provide substantially global coverage." A0117.

Claim 35 recites "[a] method of providing a travel service, comprising: providing the user unit of claim 1 to a user; and monitoring the monitoring system of claim 1." A0117.

2. '380 Patent file history distinguishes precanned and detailed text messages

The difference between precanned messages and detailed text messages was important during prosecution and remains important to this appeal as the court did not appreciate the difference when creating its own claim charts and expressing its opinion on the general invalidity of the subject matter. See A0058 at Fn. 18.

The United States Patent and Trademark Office ("USPTO") rejected all proposed claims of the '434 application as anticipated by United States Patent Application Publication No. 2006/0007038 ("Boling"). A0737. The applicants proposed claim amendments to distinguish their invention from Boling. A0767. Specifically, applicants added the limitation "wherein the input device includes a text entry device adapted to receive textual data entered by a user" to the original language of claim 1. A0783. Applicants argued as follows:

> In contrast, Boling et al. discloses a two-way distress and emergency location apparatus that does not include a keypad or any means of entering text. … Outgoing signals are limited to numeric codes selected by the user that represent location coordinates or predetermined response options related to incoming signals from the radio system. …

> Thus, Boling, et al. do (sic) not disclose or suggest the inclusion of an input device that includes a text entry device adapted to receive textual data entered by a user. Boling et al only discloses a user interface 44 that allows the user to select pre-programmed responses to incoming messages and locally-generated prompts.

A0768, A2571. The USPTO rejected the claim as unpatentable over Boling in view of Tognazzini. A0797. The Tognazzini reference was used to disclose a keypad on a wireless telephone. In response to the rejection, no further claim amendments were made but applicants argued:

> One does not need the Tognazzini reference to know that cellular phone exist, and have keypads that allow for textual entry. However, one of ordinary skill in the art would not be suggested to use a text entry device with the Boling et al system, because the Cospas-Sarsat system is not designed to receive text messages, but rather only numeric codes representative of pre-programmed messages. ….
>
> Thus, the claimed invention is an improvement on the Boling et al. system in that it provides capabilities beyond those suggested or contemplated by Boling et al.,, even considering the availability of text-messaging hardware such as that disclosed by Tognazzini. That is, the Boling et al. system is not reasonably capable of being modified to allow for detailed text messaging, and therefore any teaching related to the transmission of text messaging cannot be applied to the Boling et al. system, and any such attempt would be unworkable absent substantial re-design on the order of patentable effort.

A0829-30, A2571-2. The difference between precanned and detailed text message manifests in the claim 1 in the construction of "text entry device," (A2567-8) "output device" (A2566-7), "mutual communication" (A2559) and "monitoring system" (A2562) elements.

D. ITC investigation No. 337-TA-854

On August 17, 2012, BriarTek IP, Inc. filed a complaint with the ITC alleging violations of Section 337 of the Tariff Act of 1930 for the importation into the United States and sale after importation of certain two-way global satellite communication devices, systems and components thereof that infringe the '380 patent to protect the Virginia made Cerberus from an imported infringing competitor. A0150-51.

Investigation No. 337-TA-854 was terminated based on a Consent Order voluntarily entered into by DeLorme. A0153. In the Consent Order DeLorme:

1. Expressly waived all rights to seek judicial review or otherwise challenge or contest the validity of the Consent Order;
2. Admitted to jurisdiction and the International Trade Commission's Rules for any modification of the Consent Order; and
3. Not to challenge validity of the '380 Patent.

A0164-5.

On April 2, 2013, DeLorme conduct did not stop. A0232-3. On April 10, 2013, BriarTek IP, Inc. brought this violation of the Consent Order to the attention of the ITC and petitioned for institution of an Enforcement Proceeding under 19 C.F.R. § 210.75. A0219.

E. After Enforcement Action instituted, DeLorme Filed the District Court Action

On May 28, 2013, DeLorme filed a complaint requesting a declaration of non-infringement (Count I) and a declaration of invalidity (count 2) of the '380 patent. A0098. DeLorme alleged subject matter jurisdiction under 28 U.S.C. §§ 1331, 1138(a), 2201 and 2202. A0099. DeLorme's complaint identifies the "justiciable controversy" as terminated ITC investigation No. 337-TA-854 and the filing of the 337-TA-854 Enforcement Complaint. A0101-2. DeLorme's complaint specifically pleads DeLorme's intent to comply with the Consent Order and that production was moved to the U.S. based on a "pre-existing business plan." A0100. There was no mention of conduct entered into because of the Consent Order and no expression of willingness to violate the Consent Order.

BriarTek moved under Rule 12(b)(1) to dismiss for lack of jurisdiction. A0121. DeLorme opposed the Motion and largely relied on *MedImmune, Inc. v. Genentech, Inc*., 549 U.S. 118 (2007) analogizing a Consent Order entered into between DeLorme and the ITC to a license agreement entered into between a patentee and a licensee. A0254.

On July 18, 2013, the court held a hearing on the motion and denied, without explanation, the Motion to Dismiss without prejudice. A0408, A0062.

F. After the Enforcement Proceeding Hearing, DeLorme Filed a Summary Judgment Motion of Invalidity

On November 18, 2013, the ITC conducted a one-day hearing in the Enforcement Proceeding. A1180.

Two days later, on November 20, 2013, DeLorme filed a summary judgment motion of invalidity. The motion alleged invalidity of claims 1-2, 5-12, 17 and 34-35 under anticipation, (102) and obviousness (103). It also alleged lack of written description (112), failure to claim patentable subject matter (101) and indefiniteness (112). A0485.

G. The Summary Judgment Motion Was Not Supported by Evidence

The summary judgment motion contained no claim construction in the motion's analysis, but did include a declaration from Mr. Zancho discussing some claim terms. A0495-8 & A1163.

DeLorme identified three pieces of prior art, "ORBCOMM," de Vries (U.S. Patent Publication No. 2004/0111195) and the "Motorola Manual." The motion had no element-by-element analysis of the claims and the alleged prior art. A0505-12.

The summary judgment motion sets out the alleged invalidity arguments in summary paragraphs that only relied upon attorney argument. A0505-10.

There is no explanation by an expert opining on the level of ordinary skill in the art that matched claimed elements with the references. A1158-65.

On November 21, 2013, the following day, the parties were scheduled for the final pretrial conference. A1687. During the hearing, BriarTek's counsel raised that the lack of claim construction submissions "precludes the invalidity issues." A1691. DeLorme took the position that "[c]laim construction is only relevant …as it applies to the infringement analysis…." A1693. The court then ordered that the ITC briefs be filed to see what the ITC did. A1695.

On November 27, 2013, the court held the ITC filings "clearly establish that the parties have argued claim construction is needed in that proceeding." A1702-3. The court permitted BriarTek to explain exactly what claim construction is needed. A1703. On December 12, 2013, BriarTek submitted its position on what claims terms require construction. A1719. On December 20, 2013, DeLorme submitted its response on claim construction. A1950. On January 16, 2014, the court held "[u]pon consideration of the parties' submissions, the Court has determined that claim construction will not be needed to determine whether defendants' patent is invalid in light of undisclosed prior art." A2022.

On January 24, 2014, BriarTek moved to strike alleged facts and evidence supporting the motion for summary judgment. A2024. Both experts and the ITC agreed that the level of ordinary skill was beyond a layman. BriarTek requested that the court strike the summary paragraphs that characterized references and

purported to apply them to the claims because these paragraphs were not evidence. A2040-1, A2121-2. The motion was denied. A0063.

On February 7, 2014, BriarTek opposed the summary judgment motion as presented by DeLorme (A2490), which included the declaration of BriarTek's expert, Dr. Paul Steffes (A2550).

On February 21, 2014, the court conducted a hearing on the summary judgment motion. A2957, A2959. During the hearing, the court stated that DeLorme's positions had shifted. A2967 at lines 10-17. The Court stated:

> All right, here's what I'm going to do: ***I'm not going to resolve this case on the pleadings that I have currently got.***

A2977 at lines 18-20 (emphasis added). The court required the parties to file all expert reports from the technical experts that were served in both the ITC and district court actions. The court also required supplemental briefing that will be "Markman-type." A2978. The court stated:

> I don't need responses to each other. I just want each of your affirmative positions as to what you believe the claims actually mean.

A2978 at lines 25-21:2.

On February 28, 2014, the parties jointly submitted the expert reports the judge requested. A3030 & A3801.

On March 3, 2014, BriarTek and DeLorme submitted their Markman briefing. A4444 & A4490.

H. While the Summary Judgment Motion Was Pending the ITC Enforcement Proceeding Moved Forward

On March 7, 2014, the ITC issued an initial Determination and Recommendation On Remedy. A4524. DeLorme was found to infringe claim 2 of the '380 patent. A4544. On June 9, 2014, the ITC imposed a $6,242,500 fine on DeLorme for violation of the Consent Order and specifically found "clear evidence that Respondents [DeLorme] acted in bad faith." A5520 & A4545.

On June 19, 2014, DeLorme pleaded for the court to vitiate the ITC's actions. DeLorme wrote:

> Third, a Court ruling invalidating the patent, either on summary judgment or at trial, would affect the outcome of the Commission proceedings. DeLorme cannot violate its consent order with the Commission if the claimed infringement found by the Commission is of an invalid claim of the '380 patent. See, e.g., ECF No. 41–11 at 3, ¶ 6. Thus, a ruling on DeLorme's summary judgment motion, still pending over half a year after being filed, is of vital importance to the parties.

A4550.

I. The Court Rules on the Summary Judgment Motion

On November 19, 2014, the court issues its Order on the summary judgment motion. A0016.

Because of the claim construction conundrum, the court adopted a contingent claim construction which included the constructions the parties agreed to for use at the ITC and "[f]or the purpose of evaluating this motion, BriarTek's proposed constructions are adopted." A0027. The ITC agreed to constructions were:

Claim Number	**Claim Term**	**ITC Agreed Construction**
Claim 1	"a user processor communicatively coupled"	"an apparatus on or in the user device that processes data or information, and transmits the data or information between the input device and the user satellite communication system."
	"monitoring processor communicatively coupled"	"an apparatus on or in the monitoring system that processes data or information between the output and the monitoring satellite system."
	"adapted for mutual communication via a satellite network"	"configured for two-way communication via the satellite communication network."
	"adapted to receive textual data entered by a user"	"configured for entry of text messages by the user."
Claim 2	"adapted to be coupled to a user"	"configured for physically coupling or tethering to a user."

Claim 5	"memory device in communication with the use processor"	"memory chipset or circuitry that is accessed by an apparatus on or in the user device that processes data or information."
	"an actuator that when selected accesses message data stored in the memory device."	"a key or button that accesses message data stored on the memory chipset or circuitry."
Claim 10	"adapted to format the data for transmission"	"configured for processing the data for transmission."

A0027-8. BriarTek's constructions that were adopted by the court were:

Claim	**Claim Term**	**BriarTek's Proposed Construction**
Claim 1	An emergency monitoring and reporting system	a system for observing and checking the progress as well as providing an account of individuals operating in serious or unexpected conditions
	a user unit; and	a device or equipment used by a user

	a monitoring system	a communications system to check on the progress of a user and to receive information from the user
	an input device	a thing adapted for receipt of data
	a user satellite communication system	the transmitter, receiver and antenna necessary for mutual communication via a satellite network
	monitoring satellite communication system	the transmitter, receiver and antenna necessary for mutual communication via a satellite network
	an output device	A device or equipment that is capable of displaying data and information
	output device can present information to an observer that corresponds to information entered at the input device	The output device displays textual messages and/or audio messages, corresponding to the format of the message sent by the user unit, and the information displayed matches or agrees almost exactly with the information input

	text entry device	keypad or virtual keyboard capable of entering detailed text messages
Claim 5	actuator	A switch, button or virtual button
Claim 8	A selection device	A mechanism that accesses a plurality of data, including a scrolling device.
Claim 12	wherein the output device is adapted to display textual messages	the output device displays the text message that matches or agrees almost exactly with the information input by the user
Claim 17	A status sensor	A device or process that determines the presence or absence of a parameter.

A0028-9.

The court adopted BriarTek's level of ordinary skill in the art, which was "a bachelor's degree in physics or engineering with approximately ten years of experience in the field of satellite communications, satellite navigations, or wireless interfaces, or a master's degree in physics or engineering and five years of relevant experience, or a Ph.D. and research in the same field." A0030. Indicative of the fact that the court was not focusing on the motion as filed and on the

opposition to that motion, the court cites to Dr. Steffes' expert report (A4023), which the court ordered to be filed after the hearing on the summary judgment motion. BriarTek's Opposition relied upon a declaration from BriarTek's expert, Dr. Steffes, (A2550). The level opined on by DeLorme's expert Mr. Zancho did not exist in his opening report on invalidity and changed overtime, as described in Dr. Steffes' declaration. A2555-7. In fact, the "Zancho Opening Report" (A3931) that the court relies upon in its order did not contain an opinion on the level of ordinary skill in the art, let alone the level adopted by the court. A2556.

The court then went on to find claims 1, 5-12, 17, 34 and 35 anticipated in view of de Vries by creating its own claim charts. The court-created claim chart (A0032-41) refers to sections of de Vries that are not mentioned in DeLorme's summary judgment motion (A0508-10). DeLorme's claim 1 analysis for De Vries was as follows:

> Claim 1. The de Vries system has a user unit: the "satcom unit" on the boat. See id. ¶ [0009]. There is an input device that includes a text entry device: a keypad. See id. ¶ [0037] ("In another embodiment, the operator unit may further comprise a keypad (not shown) that allows composition of text messages while the boater is underway, which may be sent in the same manner as any canned messages."); compare '380 Patent, 1:58. There is a user satellite communication system. See id. ¶ [0044] ("The satellite terminal 310 may additionally provide a means for sending and receiving communications via communications satellites. The communications can be text, data, spoken, or any other form of communication."). The de Vries system also discloses a monitoring system, the land–based center of operations. Communication between them is mutual. See id. ¶ [0009] (text signals can be sent both ways between user and land–based operations center).

A0508. The citations used by the court do not match what DeLorme argued in its summary judgment motion. The court, for example, create the following analysis for the "user unit" element:

'380 Patent	**Summary Judgment**	**Order on De Vries**
"comprising: a user unit"	"The de Vries system has a user unit: the "satcom unit" on the boat. See id. ¶ [0009]." A0508.	"Marine SatCom Unit 506 (MSU) in de Vries Figures 5A and 5B, and related description in ¶¶ [0044]-[0046]. The unit "may provide a means for sending and receiving communications via communication satellites. The communication can be text, data, or spoken, or any other form of communication." Id. See also Zancho Opening Report ¶135. A0032.

The court appears to have taken Ms. Zancho's opening expert report (A3973) and copied the export report even though it was not of record or relied upon by DeLorme in the summary judgment motion.

In constructing its analysis, the court ignored the adopted claim constructions. The paragraphs in Mr. Zancho's expert report cited by the court (e.g. "Zancho Opening Report ¶135") are under the title "Anticipation and/or Obvious **Under DeLorme's Proposed Claim Construction**." A3973 (emphasis added). They are not under BriarTek's construction.

The court also ignored that DeLorme's expert, Mr. Zancho, did not set forth or apply a level of ordinary skill in the art in the report relied upon by the court. A2556. Or that the level was disputed and that DeLorme's expert declaration attached to the summary judgment motion never opined under BriarTek's level. A1161-2 ("22. I consider the level of ordinary skill proposed by Dr. Steffes to be excessive.")

After creating its own analysis and citations, the court dismissed Dr. Steffes' testimony concerning de Vries by ignoring the adopted claim constructions. Dr. Steffes' noted that de Vries lacked detailed text messages. The court stated that "'using detailed messages' is not an element in claim 1," stating further that "'detailed' does not appear in any claim in the '380 Patent.'" A0035. The court ignored BriarTek's construction of "text entry device," which was "keypad or virtual keyboard capable of entering **detailed** text messages." A0029 (emphasis added).

The court then went on to find claims 1, 2, 17, 34 and 35 anticipated by ""ORBCOMM PCS Available Now!" and written by Todd Hara. A0043. The court created a similar claim chart referring to Mr. Zancho's later filed expert report, not the summary judgment motion. A0043-49. Once again the court cited to portions of the report titled "1. Invalidity Under **DeLorme's Proposed Claim Construction**", not invalidity under BriarTek's construction. A3980 (emphasis added).

BriarTek presented evidence in the form of Dr. Steffes' testimony (A2574-79) and Mr. Zancho's deposition (A2860) that ORBCOMM did not include the claimed monitoring system of claim 1. Specifically, the summary judgment motion identified a Network Control Center ("NCC") described in ORBCOMM as the monitoring system. A0506. BriarTek's position was consistent with DeLorme's expert, Mr. Zancho, who opined in his reply expert report that "I am not using these references to argue that the NCC is a monitoring service." A2736. Mr. Zancho further confirmed this fact in his deposition. A2860 at 78:21-23("Q. Okay. So the NCC itself is not – A. All by itself is not a monitoring system.") Despite this evidence, the court weighed the testimony and found that the NCC was a monitoring system. A0046.

On obviousness, without notice or opportunity to respond, the court created its own obviousness combinations that were not contained in the summary

judgment motion or even in the subsequently filed expert reports. The court invalidates claims 1, 2, 5-11 and 34 as obvious over De Vries in view of Motorola Manual. A0054. The court invalidated claim 1 as obvious over ORBCOMM in view of De Vries. A0056. The court invalidates claim 17 as obvious over De Vries in view of Motorola and in view of ORBCOMM. A0056-7. The court invalidated claim 2 as obvious over ORBCOMM in view of De Vries and in view of the Motorola Manual. A0057. In constructing its own combinations over which BriarTek had no notice, the court uses a "layman" standard. See A0054 ("It would have been clear to even a layperson …")

On November 21, 2014, BriarTek timely appealed. A4837.

On December 1, 2104, DeLorme moved for costs, which were objected to. A4840. The court awarded costs to be paid to DeLorme that were from the ITC investigations despite the fact that the issues were not the same. A0010. BriarTek timely appealed that order as well, which was joined into the single appeal now presented.

SUMMARY OF ARGUMENT

A case or controversy did not exist for the purposes of assuming jurisdiction when the prior dispute between the parties was settled by way of a Consent Order DeLorme voluntarily entered into with the ITC and BriarTek exercised its

Constitutional First Amendment rights to request that the ITC exercise the ITC's rights under the Consent Order.

It was an abuse of process not to strike attorney argument describing a reference and the claims when the level of skill in the art is greater than a mere laymen.

The court cannot invalidate a patent claim without first performing claim construction or at the very least comparing competing claim constructions to determine, on an element-by-element, basis the narrower construction.

The court may not raise new issues not contained in a summary judgment motion and not provide the opposing party notice and opportunity to respond without violating Fed. R. Civ. P. Rule 56(f).

The court erred in its anticipation analysis by weighing evidence, not using the purported claim construction and relying on an expert report that cited to a different claim construction and did not have a level of ordinary skill in the art.

The court cannot award costs for costs incurred in a prior resolved ITC Investigation which included issues different from those before the court.

ARGUMENT

STANDARDS OF REVIEW

A. Standard of Review for jurisdiction

This Court reviews a denial of a motion to dismiss for lack of subject matter jurisdiction *de novo*. *Prasco, LLC v. Medicis Pharm. Corp.,* 537 F.3d 1329, 1335 (Fed. Cir. 2008). The burden of establishing subject matter jurisdiction rests with the plaintiff, in this case DeLorme, as the party asserting jurisdiction. *United States v. Hays,* 515 U.S. 737, 743 (1995). DeLorme was required to prove the jurisdictional triad of injury in fact, causation, and redressability. *See FW/PBS, Inc. v. Dallas,* 493 U.S. 215, 231 (1990)(overruled in part on other grounds). The threshold question for declaratory judgment jurisdiction is "whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment." *MedImmune*, 549 U.S., at 127 (citation omitted).

B. Standard of Review for Motion to Strike

Review of a denial of a motion to strike is not an issue unique to patent law, and the Court applies the law of the regional circuit. *Anchor Wall Sys. v. Rockwood Retaining Walls*, 340 F.3d 1298, 1313 (Fed. Cir. 2003). The Fourth Circuit

reviews a denial of a motion to strike under an abuse of discretion standard. *Shaw v. Shroud,* 13 F.3d 791, 805 (4th Cir. 1993).

C. Standard of Review of Summary Judgment

A grant of summary judgment is reviewed under the law of the regional circuit. *Grober v. Mako Prods.,* 686 F.3d 1335 (Fed. Cir. 2012). The Fourth Circuit reviews a grant of summary judgment *de novo*. *Henry v. Purnell*, 652 F.3d 524, 531 (4th Cir. 2011). "Summary judgment is appropriate only if taking the evidence and all reasonable inferences drawn therefrom in the light most favorable to the nonmoving party, 'no material facts are disputed and the moving party is entitled to judgment as a matter of law.'" *Id*. (*citing Ausherman v. Bank of Am. Corp.*, 352 F.3d 896, 899 (4th Cir. 2003).) Summary judgment requires that there be no reasonably disputed facts capable of altering the outcome. Fed. R. Civ. P. 56(a).

D. Standard of Review For Award of Costs

Determination of the prevailing party is a question of law reviewed *de novo*. *Inland Steel Co. v. LTV Steel Co.,* 364 F.3d 1318, 1320 (Fed. Cir. 2004). Whether an award of costs is reasonable is determined under the law of the regional circuit. *Shum v. Intel Corp.,* 629 F.3d 1360, 1370 (Fed. Cir. 2010). The Fourth Circuit reviews an award of costs under the abuse of discretion standard. *Cherry v. Champion Int'l Corp.*, 186 F.3d 442, 446 (4th Cir. 1999).

DISCUSSION OF THE ISSUES

A. The Court Improperly Assumed Subject Matter Jurisdiction Of DeLorme's Collateral Attack On The ITC Consent Order

On May 28, 2013, DeLorme filed a declaratory judgment action requesting a declaration of non-infringement (Count I) and a declaration of invalidity (count 2) of the '380 patent. DeLorme alleged subject matter jurisdiction under 28 U.S.C. §§ 1331, 1138(a), 2201 and 2202.

DeLorme's Complaint identifies the "justiciable controversy" as ITC investigation No. 337-TA-854 that was terminated by way of a Consent Order and BriarTek's petition to institute an enforcement proceeding. A0099-102. DeLorme's Complaint specifically stated its intent to comply with the Consent Order and that production was moved to the U.S. based on a "pre-existing business plan." A0100 at ¶12. DeLorme's opposition attached no evidence and instead relied on the terminated ITC proceeding. A0247-64.

Having voluntarily entered into a Consent Order, DeLorme could not appeal the Consent Order or otherwise seek rehearing. 19 C.F.R. § 210.21(c)(waiving all rights to seek judicial review). DeLorme cannot collaterally attack the Consent Order by initiating a suit against BriarTek.

1. There was no redressable injury attributable to BriarTek

The jurisdictional focus is "the facts existing at the time the complaint under consideration was filed." *GAF Bldg. Materials Corp. v. Elk Corp.,* 90 F.3d 479,

483 (Fed. Cir. 1996). A consent order is a contract between DeLorme and the ITC. *United States v. ITT Continental Baking Co.*, 420 U.S. 223, 238 (1975). BriarTek is not a party to that contract. DeLorme was required to have a "specific live grievance" with BriarTek. *Lewis v. Continental Bank Corp.,* 494 U.S. 472, 479 (1999). There was none.

The imminent injury must "result from the actions of the respondent, not from the actions of a third party beyond the Court's control" in order to confer standing. *Doe v. Va. Dep't. of State Police*, 713 F.3d 745, 755 (4th Cir. 2013). This is consistent with DeLorme's position in Appeal No. 14-1572 (Doc. 9) at 2-3, that the Enforcement Action does not involve assertion of BriarTek's rights. *See Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1260-1 (Fed. Cir. 2014). The Consent Order and the petition for enforcement are not disputes between DeLorme and BriarTek, but between DeLorme and the ITC.

Having disclaimed any action other than compliance with the Consent Order, DeLorme cannot use that same Consent Order to establish the immediacy requirement, which requires that there is an immediate impact on DeLorme and that the lapse of time creates uncertainty. *Matthews Int'l Corp. v. Biosafe Eng'g,* LLC, 695 F.3d 1322, 1328-31 (Fed. Cir. 2012)(failing to allege facts that it intends to infringe makes the alleged harm "too remote and speculative to support the exercise of declaratory judgment jurisdiction.").

In a declaratory judgment action a plaintiff suffers an injury when he "abandons that which he claims a right to do" because of "an assertion of rights by the defendant." *Alpharma, Inc. v. Purdue Pharma., L.P.,* 634 F. Supp. 2d 626, 631 (W.D. Va. 2009). The Consent Order and voluntary compliance therewith mooted any "specific live grievance" DeLorme could have had with BriarTek. *Lewis,* 494 U.S. at 479. Thus, the fact that the ITC Investigation occurred and was (i) terminated and the termination was (ii) uncontested by DeLorme, mooted any grievance.

In *Already, LLC v. Nike, Inc.,* 133 S. Ct. 721 (2013), the Supreme Court addressed an analogous situation. In *Already*, the issue was whether a covenant not to sue combined with a lack of sufficient or concrete plans to violate the agreement, renders the dispute moot. *Id* at 728. As the Supreme Court noted "[n]o matter how vehemently the parties continue to dispute the lawfulness of the conduct that *precipitated* the lawsuit, the case is moot if the dispute 'is no longer embedded in any actual controversy about the plaintiffs' particular legal rights.'" *Id* at 727 (italics added)(*citing Alvarez v. Smith,* 558 U. S. 87, 93 (2009)). The Consent Order was a contract voluntarily entered into by DeLorme with the ITC that resolved the dispute and cannot be the basis for jurisdiction.

Indicative of the fact that there was no live grievance is the lack of impact that the ultimate summary judgment order has had on the alleged basis for jurisdiction. Federal Circuit law defines "prevailing party" for the purposes of

patent litigation. *Manildra Milling Corp. v. Ogilvie Mills, Inc.,* 76 F.3d 1178, 1182 (Fed. Cir. 1996). Not every alteration in the legal relationship between parties, however, satisfies our prevailing party test. Instead, the alteration must be (1) material and (2) modify the defendant's behavior in a way that directly benefits the plaintiff. *Id.* In this instance, the Consent Order and the ITC Enforcement Proceeding are not impacted. See Appeal No. 2014-1572.

Specifically the summary judgment order had no impact on the Consent Order. The Consent Order by its terms is not impacted unless the patent is invalidated by a final and non-appealable order. A0157-8 ("provided that such finding or judgment bas become final and non-reviewable.") The requirement for finality and non-reviewability is precisely the reason there are two pending appeals, one addressing DeLorme's violation of the Consent Order (Appeal No. 2014-1572) and the instant appeal.

Allowing DeLorme to use the ITC action to establish jurisdiction invites a collateral attack of all administrative actions.

2. A petition requesting the ITC to initiate An Enforcement Proceeding is subject to Noerr-Pennington immunity

BriarTek's Petition under 19 C.F.R. § 210.75 was request for the ITC to enforce the ITC's contractual rights. A0180. It was a protected First Amendment communication over which no liability can be attributed. *Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc.,* 365 U.S. 127 (1961); *United*

Mine Workers of America v. Pennington, 381 U.S. 657 (1965), and *California Motor Transport Co. v. Trucking Unlimited,* 404 U.S. 508 (1972).

3. MedImmune is inapplicable

In *MedImmune*, the Supreme Court dealt with the issue of whether a contract between the patent holder and plaintiff needed to be breached prior to filing the declaratory judgment action. The controversy has to be between the parties having adverse legal interest. *Id* at 127. In *MedImmune*, the plaintiff "eliminated the imminent threat of harm by simply not doing what he claimed the right to do." *Id.* In this case, DeLorme did not plead that it was being forced to abandon its rights or risk prosecution. Once DeLorme voluntarily entered into a Consent Order and then pled compliance with the Consent Order, any concern about future compliance was not ripe.

B. The Court Abused Its Discretion When It Refused To Strike Attorney Argument

Generally speaking, only competent admissible evidence is eligible for consideration on summary judgment. *Greensboro Professional Fire Fighters Ass'n v. City of Greensboro,* 64 F.3d 962, 967 & n.5 (4th Cir. 1995); accord Fed. R. Civ. P. 56(c)(2) ("A party may object that the material cited to support or dispute a fact cannot be presented in a form that would be admissible in evidence."). Attorney argument is not a substitute for evidence. *Enzo Biochem v. Gen-Probe, Inc.,* 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for

evidence"); *Perfect Web Technologies, Inc. v. InfoUSA. Inc.,* 587 F.3d 1324, 1332 (Fed. Cir. 2009).

The court held that the level of ordinary skill in the art was not that of a laymen. The court adopted BriarTek's level of ordinary skill in the art that was "a bachelor's degree in physics or engineering with approximately ten years of experience in the field of satellite communications, satellite navigations, or wireless interfaces, or a master's degree in physics or engineering and five years of relevant experience, or a Ph.D. and research in the same field." A0030. In the summary judgment motion, DeLorme used attorney argument to described what the patent discloses or what an alleged piece of prior art discloses. See A0493-95 describes the prosecution history, A0495-8 describes the claims, A0502-5 characterizes the claim scope, A0505-7 describes ORBCOMM, A0508-0510 describes de Vries, A05010-2 describes Motorola, and A0512-4 describes obviousness. The use of attorney argument is not evidence and is not seen through the eyes of a person of ordinary skill in the art. For example, the a portion of the attorney argument related to the de Vries invalidity analysis is:

> Claim 1. The de Vries system has a user unit: the "satcom unit" on the boat. See id. ¶ [0009]. There is an input device that includes a text entry device: a keypad. See id. ¶ [0037] ("In another embodiment, the operator unit may further comprise a keypad (not shown) that allows composition of text messages while the boater is underway, which may be sent in the same manner as any canned messages."); compare '380 Patent, 1:58.

A0508. A portion of the ORBCOMM attorney argument related to the invalidity analysis is:

> Claim 1. ORBCOMM is an emergency monitoring and reporting system which meets the United States Department of Defense's requirement for world–wide continuous Combat Search and Rescue communication and geolocation capability. Id. at 875 ¶ 2.1.2. ORBCOMM describes a user unit, which it calls a subscriber communicator or SC. See id. at 874; 876, Fig. 3–2. "The SCs are compact, light–weight devices with long–life batteries, 5–watt transmitters, antenna, keypad, and LCD screens." Id. at 874 ¶ 3.1.4.

A0505. The attorney argument obviousness analysis is:

> As to any element the Court might find missing in the ORBCOMM, de Vries, or Motorola Manual references, those elements are readily apparent in—and the person of ordinary skill in the art would have drawn them from—the remaining references. Boling, de Vries, and the Motorola Manual disclose canned messages, arguably absent from ORBCOMM. Boling and de Vries disclose concierge service, arguably absent from the Motorola Manual. Boling, de Vries, and ORBCOMM disclose the use of an additional status sensor, also arguably absent from the Motorola Manual.

A0514. This is all attorney argument.

"Typically, testimony concerning anticipation must be testimony from one skilled in the art and must identify each claim element, state the witnesses' interpretation of the claim element, and explain in detail how each claim element is disclosed in the prior art reference." *Schumer v. Lab. Comp. Sys., Inc.,* 308 F.3d 1304, 1315-16 (Fed. Cir. 2002). Not only can an attorney not subsume the role of an expert but allowing an attorney to do so is reversible error. *Sundance, Inc. v.*

Demonte Fabricating Ltd., 550 F.3d 1356, 1362 (Fed. Cir. 2008) (permitting unqualified attorney to testify on issue of invalidity was abuse of discretion).

The attorney arguments concerning the '380 patent and the references should have been stricken and the failure to strike it was an abuse of discretion. When it is stricken, there is nothing left of the actual motion, and thus no basis on which DeLorme could prove clearly and convincingly that it is entitled to summary judgment.

D. The Court Did Not Apply The Adopted Constructions To De Vries Or ORBCOMM

The court committed several errors of law and abused its discretion in finding that the de Vries patent application anticipated claims 1, 5-12, 17, 34 and 35 and that that ORBCOMM anticipated claims 1, 2, 17, 34, and 35.

It is a bedrock principle that "a determination that a claim is anticipated involves a two-step analysis: 'the first step requires construing the claim,' and '[t]he second step in the analysis requires a comparison of the properly construed claim to the prior art . . . .'" *Enzo Biochem, Inc. v. Applera Corp*., 599 F.3d 1325, 1331 (Fed. Cir. 2010) (quoting *Power Mosfet Techs., LLC v. Siemens AG*, 378 F.3d 1396, 1406 (Fed. Cir. 2004).

The court adopted BriarTek's proposed claim construction for the purpose of the summary judgment motion only. A0028. The court's contingent construction of disputed terms was improper. A "court may not invalidate the claims of a patent

without construing the disputed limitations of the claims and applying them to the allegedly invalidating acts." *Dana Corp. v. AM. Axle & Mfg.,* 279 F.3d 1372, 1376 (Fed. Cir. 2002). The attempt to use a contingent construction was improper.

By adopting one construction but applying another, the court misapplied the law. Under the constructions that were contingently adopted, the court concluded that the asserted claims were invalid as anticipated by de Vries and ORBCOMM. A0032 & A0043. The court erred in applying the second step of an anticipation analysis because it applied ***DeLorme's*** proposed claim constructions to de Vries and ORBCOMM, not BriarTek's.

The summary judgment order includes claim charts showing the "evidence" the court relied on in concluding that the asserted claims except claim 2 were anticipated by de Vries. A0032-41. These charts cited to Mr. Zancho's report at ¶¶ 133, 135-152. *Id*. In Mr. Zancho's report, paragraphs 135-152 fall under the heading "Anticipation and/or Obvious Under ***DeLorme's Proposed Claim Construction***." A3973 (emphasis added). Mr. Zancho thus was clear that paragraphs 135-152 related to DeLorme's proposed construction, not BriarTek's. And in fact, there is no analysis in these paragraphs with respect to BriarTek's constructions—i.e., the claim constructions adopted in the summary judgment order. Further, the court cited paragraph 133 of the Zancho report to demonstrate that the preamble of claim 1 was found in de Vries. A0032. But paragraph 133,

does not mention the preamble of claim 1, nor does it mention BriarTek's claim construction of the preamble. A3973. As a result, none of the paragraphs 133, 135-152 of the Zancho report analyze de Vries with respect to BriarTek's proposed claim constructions. The court, therefore, erred in concluding that de Vries anticipated the asserted claims because the court's analysis did not compare the claims, as construed by BriarTek and adopted by the court, with de Vries—a required step in an anticipation analysis. *Enzo Biochem*, 599 F.3d at 1331.

The same is true for the court's claim chart on ORBCOMM. The paragraphs from the Zancho report relied on by the court, paragraphs 156-162 and 171-173 (A0043-8), all fall under the heading "Invalidity Under ***DeLorme's Proposed Claim Construction***." A3980 (emphasis added). Mr. Zancho thus was clear that paragraphs 156-162 and 171-173 related to DeLorme's proposed construction, not BriarTek's. And in fact, there is no analysis in these paragraphs with respect to BriarTek's constructions. The court, therefore, erred in concluding that ORBCOMM anticipated the asserted claims because the court's analysis did not compare the claims, as construed by BriarTek and adopted by the court, with ORBCOMM—a required step in an anticipation analysis. *Enzo Biochem*, 599 F.3d at 1331.

E. DeLorme's "Evidence" of Anticipation Under BriarTek's Claim Constructions is Conclusory and Therefore Insufficient

There is only ***one sentence*** from the Zancho report that even mentions BriarTek's claim constructions vis-à-vis de Vries. It is the following:

> **2. Invalidity Under BriarTek's Proposed Claim Construction**
>
> 153. It is my opinion that, under BriarTek's proposed claim constructions, de Vries also anticipates, and/or renders obvious, claims 1, 2, 5-12, 17, 34 and 35 of the '380 patent because the claimed features are taught by the portions of de Vries and secondary references discussed above, under either BriarTek's or DeLorme's construction.

A3979-80. The above is reprinted exactly as it appears in Mr. Zancho's expert report. Mr. Zancho's analysis of ORBCOMM under BriarTek's claim construction is wholly conclusory and consists of only ***three sentences***. It is the following:

> **2. Invalidity Under BriarTek's Proposed Claim Construction**
>
> 175. It is my opinion that, under BriarTek's proposed claim constructions, ORBCOMM also anticipates and/or renders obvious claims 1, 2, 5-12, 17, 34 and 35 of the '380 patent because the claimed features are taught by the portions of ORBCOMM as discussed above. BriarTek's claim construction is generally broader than DeLorme's and thus the prior art tends to be more invalidating under BriarTek's proposed construction. This is true for all grounds of invalidity stated herein.

A3988. The above is reprinted exactly as it appears in Mr. Zancho's expert report. While these two passages are not cited in the summary judgment order, they demonstrate that the Zancho report wholly failed to establish clearly and

convincingly that de Vries or ORBCOMM anticipates any asserted claim of the '380 patent under BriarTek's claim construction.

First, Mr. Zancho cannot conclude that de Vries or ORBCOMM actually anticipates any claim of the '380 patent under the adopted constructions because he states that the reference "anticipates, and/or renders obvious" the asserted claims. Mr. Zancho's equivocal "and/or" language cannot amount to clear and convincing evidence.

Second and perhaps more importantly, the sentences are conclusory and contains no analysis under the adopted constructions. This Court has repeatedly held that a patent challenger cannot meet its burden of proof on invalidity where it relies on conclusory statements, rather than an analysis showing how, under the governing claim construction, each element of a claim is found in a prior art reference. In *Schumer v. Lab. Comp. Sys., Inc*., this Court stated:

> Typically, testimony concerning anticipation must be testimony from one skilled in the art and must identify each claim element, state the witnesses' interpretation of the claim element, and explain in detail how each claim element is disclosed in the prior art reference. The testimony is insufficient if it is merely conclusory.

Schumer, 308 F.3d, at 1315-16. Aside from *Schumer*, the Federal Circuit has consistently maintained that conclusory statements do not suffice for clear and convincing evidence. *See NTP, Inc. v. Research in Motion, Ltd*., 418 F.3d 1282, 1325 (Fed. Cir. 2005) (affirming court's denial of JMOL on invalidity and

agreeing with court that "[m]uch of Dr. Reed's direct testimony was conclusory and failed to analyze and explain the claim language and which components of the prior art embodied each element of the asserted claims."); *Mentor H/S, Inc. v. Sonique Surgical Sys., Inc*., 244 F.3d 1365, 1376-77 (Fed. Cir. 2001) (reversing court's grant of a new trial stating "[t]he court, in conclusory fashion, asserted that the references anticipate the claim limitations, an assertion unsupported by the record in light of the defendants' burden to prove facts establishing anticipation by clear and convincing evidence"); and *Koito Mfg. Co., Ltd. v. North Am. Lighting, Inc.*, 381 F.3d 1142, 1152 (Fed. Cir. 2004) ("General and conclusory testimony, such as that provided by Dr. Kazmer in this case, does not suffice as substantial evidence of invalidity.").

Here, the evidence the court relied on in its summary judgment order was not in the motion and included paragraphs that analyzed invalidity under a claim construction that was different from what the court adopted. And the only mention of invalidity under the adopted claim constructions from Mr. Zancho stated that the references anticipated and/or rendered obvious the claims under BriarTek's construction. Even if the court could have relied upon the expert reports that were not of record at the time the motion was filed, under Federal Circuit precedent, Mr. Zancho's conclusory statements are wholly insufficient to satisfy DeLorme's clear and convincing burden of proof.

F. There Was No Evidence On Anticipation Under The Adopted Level Of Ordinary Skill

The court also did not consider the anticipation analysis from the perspective of the level of one of ordinary skill in the art that it adopted. "What a prior art reference discloses or teaches is determined from the perspective of one of ordinary skill in the art." *Sundance, Inc.*, 550 F.3d, at 1361 n.3 (citing *Scripps Clinic & Research Found. v. Genentech, Inc*., 927 F.2d 1565, 1576 (Fed. Cir. 1991). DeLorme's summary judgment motion attached a declaration from its expert, Mr. Zancho, which disagreed on the appropriate level of ordinary skill in the art proposed by BriarTek. 110-119. Mr. Zancho opined that Dr. Steffes' level "to be excessive." A1162. Here, the court adopted the level of ordinary skill proposed by BriarTek. This level was a person with:

> a bachelor's degree in physics or engineering with approximately ten years of experience in the field of satellite communications, satellite navigations, or wireless interfaces, or a master's degree in physics or engineering and five years of relevant experience, or a Ph.D. and research in the same field

A0030-1. The court all but ignored this factual finding when it then adopted opinions rendered under different levels.

The "Zancho Opening Report" (A3931) that the court relies upon did not contain an opinion on the level of ordinary skill in the art. See A3931-4021, A2556 ("16. Mr. Zancho's Expert Report on Invalidity did not contain an opinion on the level of ordinary skill in the art. See Exhibit E."). Without evidence of

anticipation from the perspective of one having ordinary skill with the qualifications adopted by the court, DeLorme failed to meet its evidentiary burden on proving anticipation. *Schumer*, 308 F.3d, at 1315-16.

G. BriarTek Raised Genuine Issues as to Whether de Vries Anticipated Claims of the '380 Patent

BriarTek's opposition to the summary judgment motion argued, with a supporting sworn declaration from its expert, Dr. Steffes that de Vries did not anticipate the asserted claims of the '320 patent. A2579-82. BriarTek addressed the arguments as presented in the summary judgment motion. A0489. Specifically, Dr. Steffes testified that de Vries did not anticipate any of the asserted claims because it disclosed "pre-canned" messaging, and thus did not disclose mutual communication using detailed text messages. With respect to claim 1, Dr. Steffes testified in part:

> The publication appears to disclose that a user can send text messages but explicitly states that they are sent in the same manner as the canned messages ("which may then be sent in the same manner as any canned messages.") The canned messages are pre-stored. The reference is disclosing a system in which the canned messages can be changed in the field and sent as a standard canned message. This is a different process from engaging in mutual communication using detailed text messages.

A2579-80. This testimony, from an expert basing his opinions on specific quotes in de Vries raises a genuine issue as to whether de Vries anticipates claim 1. The court discarded Dr. Steffes's opinion on two grounds. First, the court stated that Dr. Steffes' testimony was conclusory, citing to his expert reports. A0035. But this Court has held that an expert's testimony is not conclusory where the expert

ties his opinions to specific disclosures in a prior art reference. *Med. Instrumentation and Diagnostics Corp. v. Elektra AB*, 344 F.3d 1205, 1220 (Fed. Cir. 2003). Here, Dr. Steffes identified relevant portions of de Vries and explained why it disclosed pre-canned messaging as opposed to mutual communication using detailed text messages, as required by claim 1. Under *Med. Instrumentation*, Dr. Steffes' testimony was not conclusory. Rather, it was the only actual evidence in the record that analyzed de Vries under the adopted claim construction and under the adopted level of ordinary skill.

1. The court ignored its own claim construction

Secondly, the court stated that even if Dr. Steffes' testimony was not conclusory, it did not raise a genuine issue because "'using detailed messages' is not an element in claim 1," stating further that "'detailed' does not appear in any claim in the '380 Patent.'" A0035. The court ignored BriarTek's construction of "text entry device," which was "keypad or virtual keyboard capable of entering **detailed** text messages." A0029 (emphasis added). BriarTek's construction specifically required detailed text messages. That the court stated "detailed messages" was not apart of claim 1 demonstrates that its anticipation analysis was not applying BriarTek's claim construction—the construction adopted by the Court for purposes of summary judgment.

2. The court did not view the evidence in a light most favorable to BriarTek

With respect to claims 5-9 BriarTek presented evidence to rebut the arguments made in the summary judgment motion through its expert Dr. Steffes that de Vries did not anticipate claims 5-9. A2580-1. The basis of Dr. Steffes' testimony was that because de Vries disclosed pre-canned messages, it could not satisfy claims 5-9. A2580-1. The court disagreed with Dr. Steffes' testimony and determined that de Vries did disclose composition of text messages because it stated "'[t]he boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons…the operator unit may further comprise a keypad…that allows composition of text messages while the boater is underway.' De Vries ¶ [0037]." A0037 (ellipses and emphasis from summary judgment order). In disagreeing with Dr. Steffes and providing its own interpretation of de Vries via ellipses and emphasis, the court did not view the evidence in the light most favorable to BriarTek but instead improperly weighed evidence and made a determination against BriarTek. The entire statement from de Vries, which was not included in the summary judgment order is this:

> The boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons. These canned text messages may be preset by the boater before the voyage by typing messages in a Web-based interface. The boater may then select from among the pre-set canned messages, or from among a number of default standard messages, e.g., announcing an emergency. In another embodiment, the operator unit may further comprise a keypad (not

> shown) that allows composition of text messages while the boater is underway, which may then be sent in the same manner as any canned messages.

A0908 at [0037]. The underline above shows all the disclosure in de Vries that the court left out when it was concluding that de Vries was capable of detailed text messaging. But Dr. Steffes specifically pointed out that the last phrase in the paragraph above, "which may then be sent in the same manner as any canned messages" demonstrates to one of ordinary skill that de Vries does not disclose detailed text messaging but rather pre-canned messaging. A2581. By ignoring this phrase of de Vries, which specifically formed Dr. Steffes' opinion of why de Vries did not anticipate, the court improperly weighed evidence against BriarTek on summary judgment.

With respect to claims 10 and 11, the court held, without any evidentiary support, that claims 10 and 11 which recite "format the data for transmission by the transmitter" "do not require the processor to change the format of the data, but rather merely provide that the processor 'format[s] the data for transmission.'" A0038-9. The term "adapted to format the data for transmission" had an agreed to construction of "configured for processing the data for transmission." A0028. There was no evidentiary basis to dispute Dr. Steffes' declaration. A2581.

Dependent claim 17 requires a sensor that is coupled to the use processor and the use processor to format the data for communication to the monitoring system. A2581. The motion makes no mention of this limitation. A0509-10. The court placed the burden on BriarTek to explain why the limitation was not present. A0040. There is no legal basis to flip the burden of proof.

With respect to claims 34 and 35, they require "substantially global coverage" (A0022). Dr. Steffes pointed out that the reference only works on the sea and does not cover land, which precludes substantial global coverage. A2582. The court took judicial notice that the sea covers a large portion of the world and equates it, with no evidence from one of ordinary skill in the art. A0040. The court improperly created its own evidence and ignored the only evidence of record.

BriarTek raised genuine issues on anticipation that preclude grant of summary judgment.

H. BriarTek Raised Several Genuine Issues of Fact Concerning ORBCOMM

1. BriarTek presented evidence that ORBCOMM was not operational

BriarTek presented evidence in the form of testimony from Dr. Steffes and the deposition of Mr. Zancho, which supported BriarTek's view that the system described in ORBCOMM was not operational. A2574-5 & A2861 at 82:4-15. The court attempted to sidestep this evidence by stating that whether ORBCOMM was

operational was not relevant, as long as the reference was enabling. A0045. DeLorme has the burden of proof to establish clearly and convincingly that a prior art reference is enabling. *3M Co. v. Chemque, Inc*., 303 F.3d 1294, 1305-08 (Fed. Cir. 2002) (finding insufficient evidence to support jury's verdict of invalidity where, among other failings, the patent challenger did not put forth evidence that the reference was enabled); *Helifix Ltd. v. Blok-Lok, Ltd*., 208 F.3d 1339, 1346 (Fed. Cir. 2000).

Here, DeLorme presented no evidence and the court did not cite to any indicating that ORBCOMM was enabling to one of ordinary skill. Furthermore, BriarTek presented evidence that ORBCOMM was not operational. This evidence raised a genuine issue as to whether ORBCOMM was enabling—something DeLorme has to prove with clear and convincing evidence. Because DeLorme did not present such evidence, the court's grant of the summary judgment motion was erroneous.

2. BriarTek Presented Evidence that ORBCOMM lacked claimed elements

BriarTek presented evidence, in the form of Dr. Steffes' testimony, that DeLorme was applying ORBCOMM differently from how Mr. Zancho applied the reference in his expert report. A2575-6. Dr. Steffes' provided evidence that ORBCOMM lacked the claimed monitoring system. A2576-7. Dr. Steffes

referenced Mr. Zancho's deposition that ORBCOMM did not include the claimed monitoring system of claim 1. A2577.

Specifically, the summary judgment motion identified a Network Control Center ("NCC") described in ORBCOMM as the monitoring system. See A0506 ("ORBCOMM describes communication between the user unit and the monitoring system via a satellite network. *See id*. at 878 ¶ 3.1.1.1 ('The ORBCOMM satellites are very simple spacecraft whose main function is to complete the link between the SCs and the NCC [Network Control Center].'").

Mr. Zancho opined in his reply expert report (which the court did not cite to but was filed with the opening report that was cited to) that "I am not using these references to argue that the NCC is a monitoring service." A2736. Mr. Zancho further confirmed this fact in his deposition:

Q. Okay. So the NCC itself is not –

A. All by itself is not a monitoring system.

A2860 at 78:21-23. After confirming that the NCC by itself was not a monitoring system, Mr. Zancho then testified that an observer would have to supply an output device for there to be a monitoring system:

Q. What do you need then for the monitoring service?

A. The monitoring system would include an output device supplied by the observer.

A2860 at 79:20-24. Mr. Zancho again made clear that the NCC was not a monitoring system and that an output device from an observer must be added to the ORBCOMM system for there to be a monitoring system. Dr. Steffes testified that he agreed with Mr. Zancho that the NCC was not a monitoring system, and further testified that ORBCOMM did not include a monitoring system. A2576-7.

Despite this considerable evidence in favor of BriarTek, the court rejected it and found that the NCC was a monitoring system. A0044. The court specifically found BriarTek to have taken Mr. Zancho's testimony out of context, and that what he really meant came from another part of this deposition, where he testified "[t]here's two ways to see the message [through the NCC]. One is by an outside observer attaching himself to that or the operator of the network control center can see those messages on that screen." A0046.

The court's analysis is a textbook example of a court weighing evidence on summary judgment rather than viewing the evidence in the light most favorable to the non-movant. Indeed, Fourth Circuit case law specifically forbids the court from weighing the credibility of deposition testimony. *Summerlin v. Edgar,* 809 F.2d 1034, 1039 (4th Cir. 1987). The issue of whether Dr. Steffes' testimony and Mr. Zancho's deposition (and reply expert report) supports BriarTek's view that ORBCOMM does not have a monitoring system is an issue for the jury, not the trial judge. Moreover, that Mr. Zancho opined in an expert report and testified under

oath at a deposition that the NCC was not a monitoring system, there is absolutely evidence in the record from which a reasonable jury could conclude that ORBCOMM discloses a monitoring system. Indeed, Mr. Zancho said so under oath.

With respect to claim 2, the court inferred that the ability to hold a device inferred tethering or coupling. A0046. Dr. Steffes explicitly rejected this notion. A2577. The court's logic is counter to the logic that the court used with respect to de Vries. The court stated that in the context of de Vries a handheld device such as a PDA does not necessarily disclose tethering or coupling. A0041. In the context of ORBCOMM, the court held that "pocket sized" somehow disclosed tethering or coupling. A0046-7. Not only did the court lack evidence, it improperly weighed the evidence and did so in an inconsistent manner.

With respect to claim 17, the court took the position that BriarTek did not raise a material fact. A0040. Claim 17 requires that the status sensor "is communicatively coupled to the user processor and that provides a status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network." A0117. The term "status sensor" was held to mean "a device or process that determines the presence or absence of a parameter." A0029. DeLorme's basis for the alleging the element was met was "[t]he reference discloses a status sensor communicatively coupled to an SC adapted to communicate status information to

the monitoring system over the satellite network." A0507. That was it. In the motion, there was no citation to evidence where the coupling and formatting elements were met. The court merely assumed that "formatting is necessary to communicate sensor signals" A0047, which is not supported by any evidence. BriarTek was responding to the motion, not to the Court's after-the-fact reasoning. Dr. Steffes explained in detail the problem with the reference not disclosing a sensor, let alone coupling it to the user processor for transmission. A2579.

With respect to claim 34, BriarTek disputed that ORBCOMM disclosed substantially global coverage. Dr. Steffes explained the system was non-operational and was not capable of global coverage. A2579. The Court had no basis to claim that BriarTek did not dispute the element being present.

I. The Court's Obviousness Analysis Lacked An Evidentiary Basis

In addition to finding that de Vries and ORBCOMM anticipated claims of the '380 patent, the court found that each of the asserted claims were obvious based on four combinations, de Vries in view of the Motorola Manual, ORBCOMM in view of de Vries, de Vries in view of the Motorola Manual in view of ORBCOMM, and ORBCOMM in view of de Vries in view of the Motorola Manual. A0054-7. The court's obviousness analysis was it's own and not based on the summary judgment motion, where DeLorme provided a single paragraph explaining that the asserted claims were obvious. DeLorme stated:

> As to any element the Court might find missing in the ORBCOMM, de Vries, or Motorola Manual references, those elements are readily apparent in—and the person of ordinary skill in the art would have drawn them from—the remaining references. Boling, de Vries, and the Motorola Manual disclose canned messages, arguably absent from ORBCOMM. Boling and de Vries disclose concierge service, arguably absent from the Motorola Manual. Boling, de Vries, and ORBCOMM disclose the use of an additional status sensor, also arguably absent from the Motorola Manual.

A0514. This single paragraph is conclusory as it does not cite to any evidence much less the clear and convincing evidence required by DeLorme to prevail on obviousness. *NTP, Inc.*, 418 F.3d, at 1325 (conclusory evidence not sufficient to meet "high burden" of obviousness). Moreover, DeLorme's motion on obviousness does not cite to any actual evidence supporting it. To prevail on obviousness, DeLorme must have presented clear and convincing evidence of obviousness. *Sanofi-Synthelabo v. Apotex, Inc*., 550 F.3d 1075, 1086 (Fed. Cir. 2008). Here it presented only attorney argument, which is not evidence. *Enzo Biochem,* 424 F.3d, at 1284 ("Attorney argument is no substitute for evidence").

Even if the court's own obviousness combinations, which were not part of the summary judgment motion, could properly be considered, the court's obviousness analysis lacked an evidentiary basis and failed to consider BriarTek's evidence of non-obviousness. This Court has been clear that:

> Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 418, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007). Rather, ***obviousness***

> ***requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements*** in the normal course of research and development to yield the claimed invention.

Unigene Labs., Inc. v. Apotex, Inc., 655 F.3d 1352, 1360 (Fed. Cir. 2011). The court's analysis on obviousness accepted as true BriarTek's evidence of what claim elements were missing in each reference, and then stated that secondary references contained such elements and that it would have been obvious to combine the references. A0054-7. So for example, the court stated that de Vries in view of the Motorola manual rendered obvious each of the asserted claims. The court stated, "De Vries specifically suggests use of a device like the Motorola satellite phone, which BriarTek does not contend provides detailed messaging capability. Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of de Vries and the Motorola Manual to reach the invention of claim 1." A0054. The court provided similar arguments with respect to dependent claims. See A0054-6. The problem with the court's analysis is two-fold.

First, DeLorme did not make these arguments. It is highly improper for the court to create its own obviousness contentions and then find that the claims would have been obvious under them. Interjecting new issues in a summary judgment order is a violation of the requirement for notice and opportunity to respond. See Fed. R. Civ. P. 56(f) (preventing Judges from raising issues *sua sponte* without reasonable notice and opportunity to respond). See also *Fin Control Sys. Pty v.*

Oam, 265 F.3d 1311, 1321 (Fed. Cir. 2001) (If the court has "not provide[d] the parties with adequate notice of an opportunity for [the losing party] to present evidence and argument in opposition to the motion," granting summary judgment sua sponte is inappropriate.). By making new obviousness arguments and then ruling on them, the court violated Rule 56(f) and precluded an opportunity for BriarTek to respond.

Second, there was no evidentiary basis for the court's obviousness contentions, as indicated by no citation to the record. Why a person of ordinary skill would make the combination suggested by the court requires clear and convincing evidence. *Sanofi-Synthelabo*, 550 F.3d at 1086. The law does not allow a trial judge to make an unsupported conclusion that it would have been obvious to a person of ordinary skill to combine two references. That is especially true here, where the level of ordinary skill adopted by the court was beyond a layperson. A0052. The court, as a layperson, assumed that you can add a keyboard (such as that found in a Motorola sat phone) to the system of de Vries which uses a system such as the COSPAS SARSAT. This is not a possible combination, in other words you could never use a text keyboard with that type of satellite system as was discussed during prosecution before the USPTO. A2571

With respect to the remaining three bases of obviousness, the court again cites to what BriarTek argued was missing from the references and the trial judge

simply stated without evidence that references could be combined to render claim obvious to one of ordinary skill. A0056-7.

Despite the court's violation of Rule 56(f) and the lack of evidence supporting its position, BriarTek nonetheless presented evidence by way of its expert that the asserted claims were not obvious. Dr. Steffes could only respond to the motion and not the after-the-fact creations the court considered. Dr. Steffes testified:

> I disagree that mixing these systems would be possible, let alone obvious to one of ordinary skill in the art. Each one of these systems if limited by its technical implementation. They are not all the same and certainly not generically interchangeable. My understanding of the obviousness inquiry is comparable to anticipation in that all elements of the claims, as interpreted, must be found in the multiple references. Based on the claims, I do not see how or why one of ordinary skill in the art would be led to combine any of these references.

A2584. The court did not view this evidence in the light most favorable to BriarTek, but rather casted it aside stating that obviousness did not require physical substitution of elements. A0051. The court again was weighing evidence. Dr. Steffes was not saying obviousness required physical substitution, rather he testified that each of the systems were limited and were not the same. Thus, a person of ordinary skill in the art would not find them generically interchangeable and would not be led to combine any of the references. So even if the court's obviousness analysis could be properly considered and constitute clear and

convincing evidence, there still is a genuine issue as to whether the asserted claims are obvious.

J. The Court Abused Its Discretion By Relying On Post Motion Filings Not Argued By The Delorme And To Which Briartek Had No Ability To Respond

By constructing its own claim charts, creating its own anticipation and invalidity arguments and using expert reports filed after the hearing, the court violated Rule 56(f). A losing party must have had notice and the opportunity to respond. *See Int'l Vis. Corp. v. Crown Metal Mfg. Co.,* 991 F.2d 768, 770 (Fed Cir. 1993) (per curiam). That is why Federal Rule 56(f) provides that courts may enter judgment only "[a]fter giving notice and a reasonable time to respond." Fed. R. Civ. P. 56(f).

Specifically, the relied on DeLorme expert report of William Zancho as "evidence" and on the arguments contained therein despite the fact that the report was not of record when the motion was filed and not relied upon in the motion. A0032-41, A0043-50 & A0054-57. Because Mr. Zancho's expert report was not part of the record on summary judgment, the court's consideration of it was erroneous. *L&W, Inc. v. Shertech, Inc.*, 471 F.3d 1311, 1315 n.2 (Fed. Cir. 2006).

K. Award Of Costs Was An Abuse Of Discretion

The court awarded costs, which included document costs for discovery that occurred before the ITC. A0014-5. The issues before the ITC and the court were

not identical and there was no attempt to parse out the discovery that could be reused and the discovery that was wholly irrelevant to the ITC. There was no statutory basis for awarding costs associated with the ITC proceedings. In awarding costs for the ITC, the court abused its discretion.

CONCLUSION

This Court should vacate, reverse and/or remand the court's opinions on jurisdiction, refusal to strike evidence, granting of summary judgment of invalidity and in awarding costs, and for any relief that this Court deem appropriate, including costs and reassignment.

Date: March 9, 2015

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FILED
JAN 31 2014
CLERK, U.S. DISTRICT COURT
ALEXANDRIA, VIRGINIA

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

DELORME PUBLISHING COMPANY, INC., et al.,

Plaintiffs,

v.

BRIARTEK IP, INC., et al.,

Defendants.

1:13cv00640 (LMB/TRJ)

ORDER

For the reasons stated in open court, it is hereby

ORDERED that defendants' Motion to Strike Alleged Facts and Evidence Supporting Plaintiff's Motion for Summary Judgment of Invalidity [Dkt. No. 134] be and is DENIED.

The Clerk is directed to forward copies of this Order to counsel of record.

Entered this 31st day of January, 2014.

Alexandria, Virginia

/s/
Leonie M. Brinkema
United States District Judge

FILED
NOV 19 2014
CLERK, U.S. DISTRICT COURT
ALEXANDRIA, VIRGINIA

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

DELORME PUBLISHING COMPANY, INC., et al.,	)	
Plaintiffs	)	1:13cv640 (LMB/TRJ)
v.	)	
BRIARTEK IP, INC. et al.,	)	
Defendants.	)	

MEMORANDUM OPINION

Before the Court is plaintiffs' Motion for Summary Judgment of Invalidity [Dkt. No. 109] ("Motion for Summary Judgment"). For the reasons that follow, the motion will be granted.

I. BACKGROUND

Plaintiffs DeLorme Publishing Company, Inc. and DeLorme Inreach, LLC (collectively "DeLorme") brought this action against defendant BriarTek IP, Inc. ("BriarTek")[1] seeking a declaratory judgment that they do not infringe any claims of United States Patent No. 7,991,380 ("the '380 Patent") and that the claims of the '380 Patent are invalid and, therefore, unenforceable. BriarTek has filed a counterclaim alleging that DeLorme infringes claims 1, 2, 5-12, 17, 34, and 35 of the '380 Patent ("the asserted claims").

DeLorme and BriarTek, Inc.[2] compete in the market for satellite-based emergency notification systems. These systems allow a person, such as a hiker or rock climber, encountering a dangerous situation in an area not well-served by cellular communications to contact emergency personnel. DeLorme markets a number of such products under the InReach

[1] DeLorme's Complaint named as defendants BriarTek IP, Inc. and BriarTek, Inc. See [Dkt. No. 1]. DeLorme later voluntarily dismissed its claims against BriarTek, Inc. See [Dkt. Nos. 141, 142].
[2] BriarTek, Inc. and BriarTek IP, Inc. share common ownership. BriarTek Inc.'s Answer [Dkt. No. 24] ¶ 10.

trademark, and BriarTek's product is called the "Cerberus." See DeLorme's Counter-claim Answer [Dkt. No. 39] ("DeLorme's Answer") ¶ 23. DeLorme's devices "are sold at a substantially lower price than" BriarTek's. Id.

In 2011, BriarTek was awarded the '380 Patent for an invention titled "Global Bidirectional Locator Beacon and Emergency Communications System." The invention is described as "a simple text messaging device that uses commercial satellite infrastructure to send and receive short text messages in the event of an emergency." '380 Patent col. 3 lines 58-62. Figure 1 of the '380 Patent illustrates a preferred embodiment of the invention:

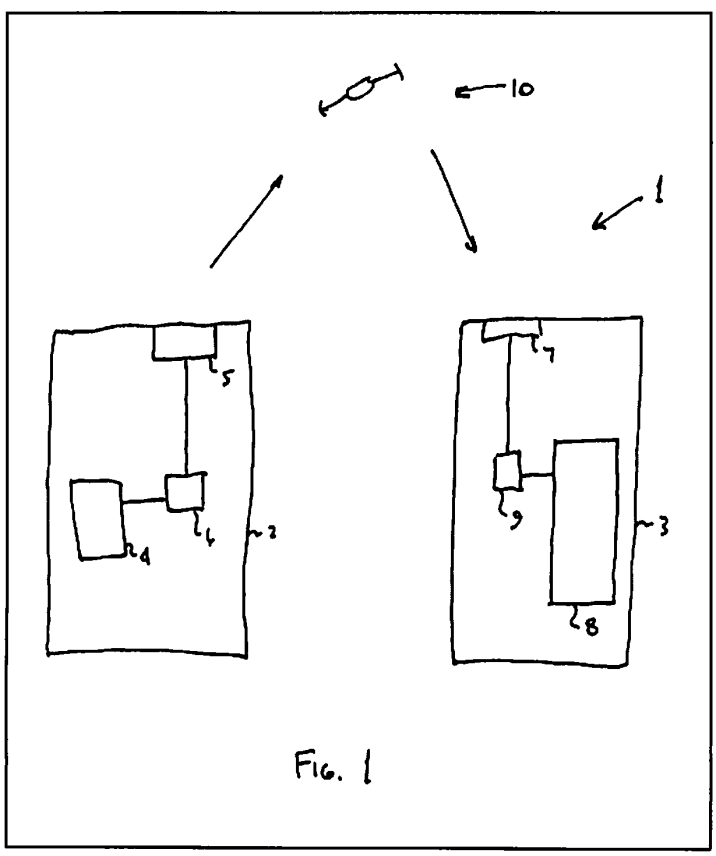


FIG. 1

Figure 1 shows a user unit [2] in communication with a monitoring system [3] through a satellite network [10]. '380 patent col. 4 lines 25-43.

On August 17, 2012 BriarTek filed ITC investigation No. 337-TA-854, alleging that DeLorme's InReach™ devices infringed the '380 Patent. DeLorme's Answer ¶ 24. Over BriarTek's objection, the ITC terminated the investigation after DeLorme consented on March 7, 2013 to an order in which it agreed not to sell or offer for sale within the United States after importation any devices that infringe claims 1, 2, 5, 10-12, or 34 of the '380 Patent. Id. The consent order terminated the investigation before the Administrative Law Judge ("ALJ") made a determination regarding the validity of the '380 Patent. On June 9, 2014 the ITC found that DeLorme violated the consent order and imposed a civil penalty of $6,242,500. Notice of International Trade Commission's Issuance Of Civil Penalty [Dkt. No. 163] at 2.

DeLorme filed the instant declaratory judgment complaint on May 28, 2013. After BriarTek's Motion to Dismiss was denied, it filed an answer and counter-claim. DeLorme has moved for summary judgment, to which BriarTek has responded, and DeLorme has filed a reply. [Dkt. Nos. 110, 139, and 140].

A. Prosecution History of the '380 Patent

The '380 Patent issued from United States Patent Application No. 11/693,434 (the "'434 Application"), which was filed on March 7, 2007 and claimed priority to Provisional Application No. 60/788,411 ("the Provisional Application"), filed on March 30, 2006.[3] DeLorme's Brief in Support of Its Motion for Summary Judgment of Invalidity [Dkt. No. 110] ("DeLorme Br.") at David Swetnam-Burland Declaration ("DSB Dec.") Ex. 1. Claim 1 of the '434 application originally recited

[3] DeLorme's expert contests whether the Provisional Application provides sufficient written description to support the '434 Application's claim to priority under 35 U.S.C. 112. See Opening Expert Report of William Zancho on Invalidity [Dkt. No. 154] Ex. 9 at 67 ("Zancho Opening Report"). DeLorme does not raise that issue in its Motion. See DeLorme Br. Because DeLorme does not assert any reference from between March 30, 2006 and March 7, 2007 (the date range implicated by the Provisional Application), the issue does not affect the outcome of this case and the Court will treat the effective filing date of the '434 Application as March 30, 2006.

> [a]n emergency monitoring and reporting system, comprising:
>
> a user unit; and
>
> a monitoring system;
>
> wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system;
>
> wherein the monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device;
>
> and wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device.
>
> Id.

The United States Patent and Trademark Office ("USPTO") rejected all proposed claims of the '434 application as anticipated by United States Patent Application Publication No. 2006/0007038 ("Boling"). DSB Dec. Exs. 2, 3. The applicants then proposed claim amendments which they argued distinguished their invention from Boling. Specifically, they added the limitation "wherein the input device includes a text entry device adapted to receive textual data entered by a user" to the original language of claim 1. Id. Ex. 4.

The USPTO rejected the amended claims as obvious over Boling in light of United States Patent No. 5,914,675 ("Tognazzini"). Id. Exs. 5, 6. The applicants argued in response that the amended claims were not obvious because

> the claimed invention is an improvement on the Boling et al. system in that it provides capabilities beyond those suggested or contemplated by Boling et al., even considering the availability of text-messaging hardware such as that disclosed by Tognazzini. That is, the Boling et al. system is not reasonably capable of being modified to allow for detailed text messaging, and therefore any teaching related to the transmission of text messaging cannot be applied to the Boling et al. system, and any such attempt would be unworkable absent substantial re-design on the order of patentable effort.

DSB Dec. Ex. 7. The USPTO later issued the '380 Patent. Id. Ex. 8.

B. The '380 Patent

BriarTek alleges that DeLorme infringes claims 1, 2, 5-12, 17, 34, and 35 of the '380 Patent. Although the "Background of the Invention" describes allowing a traveler to contact rescue authorities when "outside of the range of traditional telephones, cellular phones, or radios," '380 Patent col. 1 lines 22-23, the claims are not so limited. All of the asserted claims (1, 2, 5-12, 17, 34, and 35) depend from or incorporate Claim 1, which recites

> [a]n emergency monitoring and reporting system, comprising:
> a user unit; and
> a monitoring system;
> wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system;
> wherein the monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device;
> wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device;
> and wherein the input device includes a text entry device adapted to receive textual data entered by a user.

'380 Patent col. 8 lines 2-23.

In essence, claim 1 discloses a system consisting of two components, a user unit (Figure 1 [2]) and a monitoring system (Figure 1 [3]), that send text messages to each other via a satellite network (Figure 1 [10]). Id. There is no limitation on the size, shape, or form of the user unit or the monitoring system in the claim language or the patent specification. DSB Dec. Ex. 10 (Deposition of Paul Gregory Steffes) ("Steffes Dep.") at 30, 36, 44.

As shown in the following chart, each of the asserted dependent claims adds various elements to the system disclosed in claim 1:

Claim 2	"The system of claim 1, wherein the user unit is adapted to be coupled to a user."
Claim 5	"The system of claim 1, wherein the user unit further includes a memory device in communication with the user processor, and the input device includes an actuator that when selected accesses message data stored in the memory device."
Claim 6	"The system of claim 5, wherein selection of the actuator causes the accessed message data to be transmitted by the user satellite communication system to the monitor satellite communication system via the satellite network."
Claim 7	"The system of claim 6, wherein the message data includes a plurality of instances of message data, wherein each data instance of said plurality of data instances is stored in a respective selectable portion of the memory device."
Claim 8	"The system of claim 7, wherein the input device includes a selection device that is adapted to select one message data instance from among the plurality of data instances, wherein the selected one message data instance is transmitted by the user satellite communication system on selection of the actuation device."
Claim 9	"The system of claim 8, wherein the selection device is a scrolling device."
Claim 10	"The system of claim 1, wherein the user satellite communication system includes a transmitter, and wherein the input device is adapted to receive user data from a user and the user processor is adapted to format the data for transmission by the transmitter."
Claim 11	"The system of claim 10, wherein the monitor satellite communication system includes a receiver that is adapted to receive transmissions from the transmitter via the satellite network, and wherein the monitor

	processor is adapted to format the user data received by the receiver for presentation to the observer on the output device."
Claim 12	"The system of claim 11, wherein the output device is adapted to display textual messages."
Claim 17	"The system of claim 1, wherein the user unit further includes a status sensor that is communicatively coupled to the user processor and that provides a status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network."
Claim 34	"The system of claim 1, wherein the satellite network provide [sic] substantially global coverage."
Claim 35	"A method of providing a travel service, comprising providing the user unit of claim 1 to a user; and monitoring the monitoring system of claim 1."

II. DISCUSSION

DeLorme moves for summary judgment, arguing that the claims at issue in the '380 Patent are invalid as anticipated by three prior art references. In the alternative, DeLorme argues that the asserted claims are obvious in light of those same references. DeLorme also argues that the '380 Patent is invalid because it contains inadequate written description of the invention, is directed to unpatentable subject matter, and contains claims which are indefinite. BriarTek responds that the claims are not invalid, and that two of the references that DeLorme cites are not prior art because DeLorme has not presented sufficient proof of public availability before the critical date.

A. Standard of Review

Summary judgment is appropriate where the record demonstrates "that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter

of law." Fed. R. Civ. P. 56(c). A genuine issue of material fact exists "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-48 (1986).

The Court must view the record in the light most favorable to the nonmoving party, see Bryant v. Bell Atl. Md., Inc., 288 F.3d 124, 132 (4th Cir. 2002); however, the "mere existence of a scintilla of evidence in support of the [nonmovant's] position will be insufficient; there must be evidence on which the jury could reasonably find for the [nonmovant]." Anderson, 477 U.S. at 252; see also Othentec Ltd. v. Phelan, 526 F.3d 135, 140 (4th Cir. 2008); TecSec, Inc. v. Int'l Bus. Machines Corp., 763 F. Supp. 2d 800, 804-05 (E.D. Va. 2011) aff'd, 466 F. App'x 882 (Fed. Cir. 2012). When relying on expert testimony, "[a] party does not manufacture more than a merely colorable dispute by submitting an expert declaration that something is black when the moving party's expert says it is white; there must be some foundation or basis for the opinion." Invitrogen Corp. v. Clontech Labs., 429 F.3d 1052, 1080 (Fed. Cir. 2005). Unsupported statements that a reference does not teach a limitation, even from an expert, are insufficient to avoid summary judgment. See Krippelz v. Ford Motor Co., 667 F.3d 1261, 1269 (Fed. Cir. 2012).

B. Availability of Prior Art

Before determining whether a reference invalidates a claim, the Court must first determine whether the reference is available as prior art under 35 U.S.C. 102.[4] DeLorme's motion for summary judgment relies on three references, none of which were before the USPTO when it examined the '434 application. The first is United States Patent Application Publication

[4] The America Invents Act ("AIA") extensively amended 35 U.S.C. 102. Pub. L. No. 112-29, §3, 125 Stat. 284, 285-93 (2011). As the '380 Patent was filed before the AIA's implementation date, pre-AIA § 102 must be applied. See Solvay S.A. v. Honeywell Int'l. Inc., 742 F.3d 998, 1000 n.1 (Fed. Cir. 2014). All references to 35 U.S.C. §§ 101, 102, 103, and 112 refer to the pre-AIA versions of those statutes.

No. 2004/0111195 ("de Vries"). DSB Dec. Ex. 14. The second is a user guide for Motorola's Iridium Satellite Series 9505 portable handset (the "Motorola Manual"). DSB Dec. Ex. 17. The third is an Institute of Electrical and Electronics Engineers ("IEEE") article titled "ORBCOMM PCS Available Now!" ("ORBCOMM"). DSB Dec. Exs. 11, 12.

BriarTek has not contested de Vries' availability as prior art, see BriarTek IP, Inc. and BriarTek, Inc.'s Opposition [Dkt. No. 139] ("BriarTek Opp'n"), given that it was published on June 10, 2004; however, BriarTek contends that DeLorme has presented insufficient evidence that ORBCOMM and the Motorola Manual were published before the effective filing date of the '380 Patent, and previously moved to strike those references as prior art. See id. at 18-19 (ORBCOMM), 25-26 (Motorola Manual). BriarTek's Motion to Strike those references was argued in open court and denied from the bench. Order Denying Motion to Strike [Dkt. No. 138]. To ensure the clarity of the record, BriarTek's arguments are addressed here.

"Whether a reference was published prior to the critical date, and is therefore prior art, is a question of law based on underlying factual questions." TypeRight Keyboard Corp. v. Microsoft Corp., 374 F.3d 1151, 1157 (Fed. Cir. 2004). "Public accessibility is the touchstone in determining whether a reference constitutes a printed publication." ResQNet.com, Inc. v. Lansa, Inc., 594 F.3d 860, 866 (Fed. Cir. 2010) (internal quotation marks omitted).

1. Motorola Manual

BriarTek has not raised a material factual dispute regarding whether the Motorola Manual was available to the public; instead, it merely makes the assertion that "there is no evidence presented that the document was publicly available." BriarTek Opp'n at 25. That argument fails for several reasons. First, the manual itself bears a copyright date of 1999. Motorola Manual at 115. Moreover, DeLorme deposed Eva Valentine, the person who created the Motorola Manual.

DSB Dec. Ex. 15 at 5-6. Ms. Valentine testified that the Motorola Manual was distributed "with the actual, physical product." Id. at 9. Members of the public could also receive a copy via CD-ROM, downloading over the Internet, or by calling Motorola. Id. at 10-14.[5] Ms. Valentine confirmed that the phone (and therefore the manual) was available to the public at some point during 2000. Id. at 8.[6]

BriarTek does not present any evidence to rebut Ms. Valentine's statements, instead simply asserting that "[t]here is no evidence presented that the document was publicly available." BriarTek Opp'n at 25. Such lawyer argument does not create a factual dispute. In light of the copyright date on the Motorola Manual and the uncontroverted testimony of Ms. Valentine, there is no genuine dispute of material fact regarding the public availability of the Motorola Manual. Therefore, as a matter of law, the Motorola Manual is a qualifying printed publication under 35 U.S.C. 102.

2. ORBCOMM

BriarTek has also failed to raise a material factual dispute regarding whether ORBCOMM was available to the public, again merely arguing that "[t]here is no evidence that [ORBCOMM] was publicly available." BriarTek Opp'n at 18. That argument was contradicted by BriarTek's own expert, who stated that he believed that ORBCOMM was published in 1995.

[5] "Q. Would the user guide have been in paper form when distributed with the phone?
A. Yes, but we also had an electronic copy available, I believe, through the website.
Q. So if a customer wanted to get a copy of the user guide from Motorola, they could go online to get it? . . .
A. Yes. And I believe we also created CD ROMs of the user guide.
. . .
Q. Could somebody also call up Motorola and ask for a copy of the user guide? . . .
A. Yes."

[6] "Q. Do you know when the user guide for the 9505 would have become available?
A. I'm assuming if my dates are correct, 2000."

Steffes Dep. at 10. Further, ORBCOMM's corporate representative, Donald Brickerd, Jr., stated in his deposition that ORBCOMM was published in 1995. DSB Dec. Ex. 12 at 9.[7]

By failing to come forward with any evidence, in the form of declarations, depositions, or documentation, indicating that ORBCOMM was not publicly available, BriarTek has failed to rebut the evidence of prior publication. Therefore, as a matter of law, ORBCOMM is also a qualifying printed publication under 35 U.S.C. 102.

Because de Vries, the Motorola Manual, and ORBCOMM were all available as printed publications more than one year before Oct. 4, 2006 (the effective filing date of the '380 Patent), as a matter of law each of the three references qualifies as prior art under 35 U.S.C. § 102(b).

C. Claim Construction

"The first step in any invalidity analysis is claim construction." Akamai Techs., Inc. v. Cable & Wireless Internet Servs., Inc., 344 F.3d 1186, 1192 (Fed. Cir. 2003). "[C]laim construction is the province of the court, not a jury." Ballard Med. Prods. v. Allegiance Healthcare Corp., 268 F.3d 1352, 1358 (Fed. Cir. 2001). Although "some courts have found it useful to hold hearings and issue orders comprehensively construing the claims in issue . . . [s]uch a procedure is not always necessary," id., as "the district court has considerable latitude in determining when to resolve issues of claim construction." CytoLogix Corp. v. Ventana Med. Sys., 424 F.3d 1168, 1172 (Fed. Cir. 2005). Accordingly, a district court may adopt the non-moving party's claim construction for the purposes of evaluating a motion for summary judgment. See Teknowledge Corp. v. Cellco P'ship, 626 F. Supp. 2d 1027, 1033 (N.D. Cal. 2009), aff'd, 374 F. App'x 972, 973 (Fed. Cir. May 6, 2010) (per curiam). If a reference anticipates even under the patentee's definition of the claim language, then summary judgment is

[7] "A. The Todd Hara article came out in 1995."

appropriate. Id. It is significant that BriarTek has not alleged that construing the claims affects whether any claim is invalid. For example, BriarTek has not argued that a piece of prior art invalidates a claim under DeLorme's construction, but does not invalidate under BriarTek's construction. See BriarTek Opp'n.

Both BriarTek and DeLorme have filed proposed claim constructions. DeLorme's Claim Construction Brief [Dkt. No. 156]; BriarTek IP, Inc.'s Submission on Claim Construction [Dkt. No. 155] ("BriarTek's Claim Construction Brief"). BriarTek and DeLorme also agreed to the constructions of a number of terms in their litigation before the ITC. See BriarTek's Claim Construction Brief Att. 3 ("Agreed Constructions"). DeLorme maintains that claim construction is not necessary. Delorme's Claim Construction Brief at 1-2.

Solely for the purposes of evaluating the summary judgment motion, this Court will adopt the constructions that the parties agreed to before the ITC. To ensure the clarity of the record, those constructions are set forth below.

Claim Number	Claim Term	Agreed Construction
Claim 1	"a user processor communicatively coupled"	"an apparatus on or in the user device that processes data or information, and transmits the data or information between the input device and the user satellite communication system."
	"monitoring processor communicatively coupled"	"an apparatus on or in the monitoring system that processes data or information between the output device and the monitoring satellite system."

	"adapted for mutual communication via a satellite network"	"configured for two-way communication via the satellite communications network."
	"adapted to receive textual data entered by a user"	"configured for entry of text messages by the user."
Claim 2	"adapted to be coupled to a user"	"configured for physically coupling or tethering to a user."
Claim 5	"memory device in communication with the user processor"	"memory chipset or circuitry that is accessed by an apparatus on or in the user device that processes data or information."
	"an actuator that when selected accesses message data stored in the memory device"	"a key or button that accesses message data stored on the memory chipset or circuitry."
Claim 10	"adapted to format the data for transmission"	"configured for processing the data for transmission."

The parties dispute the meanings of a number of claim terms. See DeLorme's Claim Construction Brief at 11-22 (listing both proposed constructions). For the purposes of evaluating this motion, BriarTek's proposed constructions are adopted. Those constructions are set forth below.

Claim Number	Claim Term	BriarTek's Construction
Claim 1	"An emergency monitoring and reporting system."[8]	"a system for observing and checking the progress as well as providing an account of individuals operating in serious or unexpected conditions."

[8] This language only appears in the preamble of claim 1. A preamble only limits the claim if it recites essential structure or gives meaning to the claim. Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed. Cir. 2003). "Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim." Bicon, Inc. v. Straumann Co., 441 F.3d 945, 952 (Fed. Cir. 2006) (internal quotation marks omitted). Further, "[f]or apparatus claims . . . generally patentability depends on the claimed structure, not on the use or purpose of that structure." Marrin v. Griffin, 599 F.3d 1290, 1294 (Fed. Cir. 2010). Accordingly, the Federal Circuit has found that the preamble language "for permitting a user to write thereon without the use of a marking implement" recited an intended use, and so did not limit the claim. Id.

The preamble of claim 1 appears to be an intended use of the claimed system, rather than reciting essential structure or giving the claim meaning. DeLorme argues that preambles are generally not limiting, but nonetheless proposes a definition for the term. DeLorme's Claim Construction Brief at 12-13.

	"user unit"	"a device or equipment used by a user."
	"monitoring system"	"a communications system to check on the progress of a user and to receive information from the user."
	"input device"	"a thing adapted for receipt of data."
	"text entry device"	"keypad or virtual keyboard capable of entering detailed te[x]t messages."
	"user satellite communication system"	"the transmitter, receiver, and antenna necessary for mutual communication via a satellite network."[9]
	"monitoring satellite communication system"	"the transmitter, receiver, and antenna necessary for mutual communication via a satellite network."
	"output device"	"a device or equipment that is capable of displaying data and information."
	"output device can present information to an observer that corresponds to information entered at the input device"	"the output device displays textual messages and/or audio messages, corresponding to the format of the message sent by the user unit, and the information displayed matches or agrees almost exactly with the information input."
Claim 5	"actuator"	"a switch, button, or virtual button."
Claim 8	"selection device"	"a mechanism that accesses a plurality of data, including a scrolling device."
Claim 12	"wherein the output device is adapted to display textual messages"	"the output device displays the text messages that matches or agrees almost exactly with the information input by the user."
Claim 17	"status sensor"	"a device or process that determines the presence or absence of a parameter."

[9] BriarTek's definition indicates that a transmitter, receiver and antenna are "necessary" for mutual communication via a satellite network. Accordingly, a transmitter, receiver, and antenna are inherently present in any reference that teaches mutual communication via a satellite network.

D. Level of Ordinary Skill in the Art

Numerous aspects of evaluating patentability including interpretation of the written description, Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996), anticipation, Advanced Display Sys. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000), obviousness, KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 405 (2006), written description, Ariad Pharm., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc), and claim construction. Phillips v. AWH Corp, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc), require reference to a person with ordinary skill in the art at the time of invention. BriarTek argues that a person with the appropriate level of ordinary skill in the art would have a bachelor's degree in physics or engineering with approximately ten years of experience in the field of satellite communications, satellite navigations, or wireless interfaces, or a master's degree in physics or engineering and five years of relevant experience, or a Ph.D. and research in the same field. Opening Expert Report of Paul G. Steffes [Dkt. No. 154] Ex. 10 ("Steffes Opening Report") at 20-21. DeLorme argues that a person with the appropriate level of ordinary skill in the art would have a bachelor's degree in electrical or computer engineering and three to five years of practical experience in designing and implementing wireless subscriber equipment devices or systems for commercial applications. DeLorme Br. at 8.

Although BriarTek emphasizes the "[n]eed for [e]vidence on [o]ne of [o]rdinary [s]kill in the [a]rt," BriarTek's Claim Construction Brief at 3, BriarTek does not identify any issue in the instant motion where resolving the level of ordinary skill in the art makes a difference. See BriarTek Opp'n. For example, nowhere does BriarTek argue that the claims would be obvious to a person of the experience described by DeLorme, but would not be obvious to a person of the experience described by BriarTek. Indeed, it would seem that BriarTek's proposed person of

ordinary skill is more likely to find the patent invalid because BriarTek's person of ordinary skill has more education and experience than DeLorme's. For the purposes of resolving DeLorme's summary judgment motion, the Court adopts BriarTek's definition of a person of ordinary skill in the art.

E. Anticipation

Because patents are entitled to a presumption of validity by virtue of their approval by the USPTO, a challenger must prove invalidity by clear and convincing evidence. Microsoft Corp. v. i4i Ltd. P'ship, 131 S.Ct. 2238, 2242 (2011). A patent will be declared invalid due to anticipation only if "each and every limitation" of the patent is found "either expressly or inherently in a single prior art reference." IPXL Holdings, L.L.C. v. Amazon.com, Inc., 430 F.3d 1377, 1381 (Fed. Cir. 2005) (citation omitted). "[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." Transclean Corp. v. Bridgewood Servs., Inc., 290 F.3d 1364, 1373 (Fed. Cir. 2002) (emphasis removed).

"Anticipation is a question of fact." Glaverbel Societe Anonyme v. Northlake Mkting. & Supply, Inc., 45 F.3d 1550, 1554 (Fed. Cir. 1995). Even so, anticipation "may be decided on summary judgment if the record reveals no genuine dispute of material fact." Golden Bridge Tech., Inc. v. Nokia, Inc., 527 F.3d 1318, 1321 (Fed. Cir. 2008). General statements that a reference lacks a claimed limitation do not create a material dispute. See Krippelz, 667 F.3d at 1269. "[T]here must be some foundation or basis for the opinion" that a reference does not teach a claim limitation. Invitrogen Corp., 429 F.3d at 1080. Further, a patentee cannot prevent summary judgment by arguing that a reference lacks unclaimed features. King Pharms., Inc. v. Eon Labs., Inc., 616 F.3d 1267, 1275 (Fed. Cir. 2010).

1. De Vries

Patent Application Publication No. 2004/0111195 to Jeroen Joost de Vries et al., titled "Systems and Methods for Marine Satellite Monitoring," describes a "service for tracking information relating to the location and condition of boats, as well as other information useful to boaters." De Vries ¶ [0002]. "In one embodiment, the invention includes a marine telematics system comprising a satcom unit on a boat . . . for sending and receiving signals to a land-based center of operations." Id. ¶ [0009]. "The signals may . . . include speech or text signals from the boater to the land-based center of operations or speech or text signals from the land-based center of operations to the boater." Id. The speech and text communications may be sent between the user unit on the boat and the land-based center of operations via satellite. Id. ¶ [0036]. As a matter of law and as shown in the following tables, de Vries anticipates claims 1, 5-12, 17, 34, and 35 of the '380 Patent.

i. Claim 1

'380 Patent Claim 1	De Vries
"An emergency monitoring and reporting system"	"The marine telematics system of the invention may include components that ensure a boater's safety by providing support in the case of emergencies and guidance in case the boater becomes lost," and allows for "contacting a local emergency response authority, such as harbor police or the Coast Guard." De Vries ¶¶ [0008], [0010]. The system allows for detection of events and "handling of situations which may arise while the boat is in use or at dock." See also Zancho Opening Report ¶ 133.
"comprising: a user unit"	"Marine SatCom Unit 506 (MSU)" in de Vries Figures 5A and 5B, and related description in ¶¶ [0044] - [0046]. The unit "may provide a means for sending and receiving communications via communications satellites. The communications can be text, data, spoken, or any other form of communication." Id. See also Zancho Opening Report ¶ 135.

"comprising . . . a monitoring system"	The system includes a "land-based center of operations . . . that is manned by a land-based systems operator who monitors incoming signals and messages" and exchanges "speech and text signals" with the boater. Id. ¶ [0009]. "Once the message has been received, the land-based system operator can send a receipt signal." Id. ¶ [0033]. The land-based center of operations "receiv[es] signals . . . from a boat equipped with a satcom unit . . . send[s] signals from the land-based center of operations to the boat indicating that the signals have been received, and update[es] a database containing information about the position of the boat." Id. ¶ [0010]. The signals "may include instructions for responding to events on the boat that are detected by one or more sensors on the boat." Id. See also Zancho Opening Report ¶ 138.
"wherein the user unit includes an input device"	The user unit includes a keypad including "buttons 176 for scrolling through text appearing in the text window 174 and buttons 178 for scrolling through menu options." There may also be "a button 180 for selecting a function," de Vries ¶¶ [0035] – [0037], and "[t]he boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." id.; See also Zancho Opening Report ¶ 136.
"wherein the user unit includes . . . a user satellite communication system"	"[A]ll communications between the boat and the land-based Center are via the Marine SatCom Unit (MSU), communicating with satellites." De Vries ¶ [0044]. See also Zancho Opening Report ¶ 137.
"wherein the user unit includes . . . a user processor communicatively coupled to the user device and the user satellite communication system"	"The invention may further include a computer connected to a communications network . . . In one embodiment, information from the computer is received over the communications network," de Vries ¶ [0009], and "the operator module could be a computer such as a laptop computer, or a handheld device, such as a PDA." Id. ¶ [0039]. Further, "a processor is necessary for the Operator's Module to execute t[he] functions of the operators module" – i.e., the processor is inherent. Zancho Opening Report ¶ 137.

"wherein the monitoring system includes a monitoring satellite communication system"	"[T]he land-based operations center [can] send text messages to the boater via satellite data transmission." De Vries ¶ [0036]. See also Zancho Opening Report ¶ 138.
"wherein the monitoring system includes . . . an output device"	"[T]he land-based operations center [can] send text messages to the boater via satellite data transmission," de Vries ¶ [0036], and the boater can "communicate with the land-based operations center or with friends or family via text messages." Id. ¶ [0037]. Communicating via text messages requires being able to see those messages. See also Zancho Opening Report ¶ 139.
"wherein the monitoring system includes . . . a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device"	"[T]he land-based operations center [can] send text messages to the boater via satellite data transmission." De Vries ¶ [0036]. See also Zancho Opening Report ¶ 138.
"wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network"	"[T]he land-based operations center [can] send text messages to the boater via satellite data transmission." De Vries ¶¶ [0033], [0034], [0036]. See also Zancho Opening Report ¶ 138.
"such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device"	The boater can "communicate with the land-based operations center or with friends or family via text messages." De Vries ¶¶ [0033]-[0034] and [0037]. See also Zancho Opening Report ¶¶ 138-40.
"and wherein the input device includes a text entry device adapted to receive textual data entered by a user."	"[T]he operator unit may further comprise a keypad . . . that allows composition of text messages while the boater is underway, which may then be sent in the same manner as any canned messages." De Vries ¶ [0037]. See also Zancho Opening Report ¶ 140.

BriarTek does not dispute that de Vries teaches the vast majority of claim 1. See BriarTek Opp'n at 23. BriarTek only argues that de Vries does not anticipate claim 1 because de Vries "disclos[es] a system in which canned messages can be changed in the field and sent as a standard canned message. This is a different process from engaging in mutual communication using detailed text messages." Id. at 23. The argument appears directed to the requirement in

claim 1 of the '380 Patent that "the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network."

BriarTek's argument is unconvincing for several reasons. Neither BriarTek nor Dr. Steffes, their expert, explain why the communication process employed by de Vries differs from the claimed process. BriarTek Opp'n at 23; Rebuttal Expert Report of Paul G. Steffes On Behalf Of BriarTek Inc. And BriarTek IP. Inc. [Dkt. No. 154] Ex. 11 ("Steffes Rebuttal Report") at 8. As such, the argument amounts to a conclusory statement of validity, which cannot prevent summary judgment. Krippelz, 667 F.3d at 1269.

Even if BriarTek were correct in arguing that the system of de Vries is different from "mutual communication using detailed text messages," "using detailed messages" is not an element in claim 1 of the '380 Patent. The word "detailed" does not appear in any claim in the '380 Patent, and BriarTek does not dispute that de Vries teaches mutual communication. Moreover, the written description of the '380 Patent focuses the invention on "send[ing] and receiv[ing] short text messages." '380 Patent col. 3 lines 58-62 (emphasis added). Thus, BriarTek directs its sole argument that de Vries does not anticipate claim 1 to a feature not present in the claim. Presenting argument regarding unclaimed features cannot prevent summary judgment. King Pharms., 616 F.3d at 1275.

Accordingly, BriarTek does not raise a material dispute regarding the validity of claim 1. As de Vries teaches, expressly or inherently, each and every feature of claim 1, the claim is invalid as anticipated by de Vries.

ii. Claims 5-9[10]

'380 Patent Claim 5	De Vries
"The system of claim 1, wherein the user unit further includes a memory device in communication with the user processor"	"The boater may select one of a preset number of canned messages to send . . . These canned text messages may be preset by the boater before the voyage." De Vries ¶ [0037]. For the messages to be pre-set, they must be stored, which necessarily means that a memory device is needed. Zancho Opening Report ¶ 142.
"and the input device includes an actuator that when selected accesses message data stored in the memory device."[11]	"The boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." De Vries ¶ [0037]. See also Zancho Opening Report ¶ 142.

'380 Patent Claim 6	De Vries
"The system of claim 5, wherein selection of the actuator causes the accessed message data to be transmitted by the user satellite communication system to the monitor communication system via the satellite network."	"When the emergency button 110 is pressed, a visual signal 120 . . . may be provided . . . to indicate that . . . the emergency transmission is being sent." De Vries ¶ [0028]. "Pressing the emergency button 110 may automatically activate an automated position report function. The automated position report function may then send a report of the boat's position to the land-based system operator." Id. ¶ [0029]. Further, "[t]he boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." Id. ¶ [0037]. See also Zancho Opening Report ¶ 143.

'380 Patent Claim 7	De Vries
"The system of claim 6, wherein the message data includes a plurality of instances of message data, wherein each data instance of said plurality of data instances is stored in a respective selectable portion of the memory device."	"The boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." De Vries ¶ [0037]. See also Zancho Opening Report ¶ 144.

[10] BriarTek groups claims 5-9 together in opposing the Motion for Summary Judgment. BriarTek Opp'n at 23-24. Accordingly, those claims will be addressed together.

[11] The term "actuator" has been construed to mean "a key or button that accesses message data stored on the memory chipset or circuitry."

'380 Patent Claim 8	De Vries
"The system of claim 7, wherein the input device includes a selection device that is adapted to select one message data instance from among the plurality of data instances, wherein the selected one message data instance is transmitted by the user satellite communication system on selection of the actuation device."	"The boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." De Vries ¶ [0037]. See also Zancho Opening Report ¶ 145.

'380 Patent Claim 9	De Vries
"The system of claim 8, wherein the selection device is a scrolling device."	"The operator module may include buttons 176 for scrolling through text appearing in the text window 174 and buttons 178 for scrolling through menu options," de Vries ¶ [0035], and "the boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons." Id. ¶ [0037]. See also Zancho Opening Report ¶ 146.

Taken together, claims 5-9 describe sending and receiving preset messages. BriarTek does not dispute that de Vries teaches the majority of the limitations of claims 5-9. See BriarTek Opp'n at 24. BriarTek only argues that de Vries is limited to teaching canned messages or detailed messages, but cannot teach both. Id. at 24; BriarTek Opp'n Att. 2 ("Steffes Dec.") ¶ 67. BriarTek does not explain why a device could not send both types of messages. Contrary to BriarTek's argument, de Vries specifically states that "[t]he boater may select one of a preset number of canned text messages to send using the scroll 176, menu 178, and select 180 buttons . . . the operator unit may further comprise a keypad . . . that allows composition of text messages while the boater is underway." De Vries ¶ [0037] (emphasis added). Thus, de Vries specifically teaches that a boater can either (1) select a preset message to send or (2) compose customized

text messages while underway. BriarTek cannot create a material dispute by simply "submitting an expert declaration that something is black when the moving party's expert says it is white; there must be some foundation or basis for the opinion." Invitrogen Corp., 429 F.3d at 1080. Because de Vries unambiguously teaches sending both types of messages, BriarTek's arguments to the contrary amount to conclusory allegations that cannot prevent summary judgment. Krippelz, 667 F.3d at 1269.

iii. Claims 10 and 11[12]

'380 Patent Claim 10	De Vries
"The system of claim 1, wherein the user satellite communication system[13] includes a transmitter, and wherein the input device is adapted to receive user data from a user and the user processor is adapted to format the data for transmission by the transmitter."	"[T]he boater [can] communicate with the land-based operations center or with friends or family via text messages," de Vries ¶ [0037], and the messages are sent "via satellite data transmission." Id. ¶ [0036]. See also Zancho Opening Report ¶ 147-48.

'380 Patent Claim 11	De Vries
"The system of claim 10, wherein the monitor satellite communication system includes a receiver that is adapted to receive transmissions from the transmitter via the satellite network, and wherein the monitor processor is adapted to format the user data received by the receiver for presentation to the observer on the output device."	"[T]he boater [can] communicate with the land-based operations center or with friends or family via text messages," de Vries ¶ [0037], and the messages are sent "via satellite data transmission." Id. ¶ [0036]. See also Zancho Opening Report ¶ 147-48.

BriarTek argues that "de Vries is using pre-programmed messages which would not disclose detailed text messages and would not disclose the need to change the format of the data." BriarTek Opp'n at 25. Contrary to BriarTek's argument, claims 10 and 11 of the '380

[12] BriarTek groups claims 10 and 11 together in opposing the Motion for Summary Judgment. BriarTek Opp'n at 24-25. Accordingly, those claims will be addressed together.

[13] BriarTek's definition of this claim term indicates that a transmitter, receiver and antenna are "necessary" for mutual communication via a satellite network. Accordingly, a transmitter, receiver, and antenna are inherently present in any system that teaches mutual communication via a satellite network.

Patent do not require the processor to change the format of the data, but rather merely provide that the processor "format[s] the data for transmission." Because BriarTek argues regarding limitations which are not present in claims 10 or 11, BriarTek does not create a material dispute. King Pharms., 616 F.3d at 1275. Moreover, BriarTek does not present argument or evidence regarding the detailed text messages that de Vries also teaches, and which Mr. Zancho states require formatting for transmission. Zancho Opening Report ¶ 147. Finally, BriarTek does not set forth facts indicating that the "canned" messages would not need to be formatted, but instead simply asserts that they would not need to be formatted. BriarTek Opp'n at 25. For these reasons, BriarTek's assertions amount to a conclusory allegation through attorney argument that cannot prevent summary judgment. Krippelz, 667 F.3d at 1269.

iv. Claim 12

'380 Patent Claim 12	De Vries
"The system of claim 11, wherein the output device is adapted to display textual messages."	"[T]he boater [can] communicate with the land-based operations center or with friends or family via text messages," de Vries ¶ [0037], and the messages are sent "via satellite data transmission." Id. ¶ [0036]. See also Zancho Opening Report ¶ 147-48.

BriarTek does not specifically dispute that de Vries anticipates claim 12. See BriarTek Opp'n at 23-25.

v. Claim 17

'380 Patent Claim 17	De Vries
"The system of claim 1, wherein the user unit further includes a status sensor that is communicatively coupled to the user processor and that provides status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network."	"When the water level sensor detects . . . a water level in the bilge area where it should not be, indicating that the boat is taking on water, [the sensor] may send a signal to the operator module, which may then . . . send a signal to the land-based system." De Vries ¶ [0037]. See also Zancho Opening Report ¶ 150.

BriarTek argues that the sensor in de Vries is not coupled to the user processor and that the processor does not format the data for communication; however, BriarTek does not set forth facts regarding why that would be the case, or how de Vries' system would operate without a processor or data formatting. See BriarTek Opp'n at 25. Thus, BriarTek's arguments amount to a conclusory allegation that cannot prevent summary judgment. Krippelz, 667 F.3d at 1269.

vi. Claim 34

'380 Patent Claim 34	De Vries
"The system of claim 1, wherein the satellite network provide[s] substantially global coverage"	The system uses "Global Positioning Systems (GPS) [which] are worldwide satellite based navigation systems." See also Zancho Opening Report ¶ 151.

BriarTek argues that de Vries only expressly addresses use by boats, that de Vries does not describe coverage of land masses, and therefore de Vries "teach[es] against coverage on land masses." BriarTek Opp'n at 25. This argument fails for numerous reasons. First, "[t]eaching away is irrelevant to anticipation." Seachange Int'l., Inc. v. C-COR, Inc., 413 F.3d 1361, 1380 (Fed. Cir. 2005). Second, claim 34 uses the term "substantially global coverage," with no specific mention of land masses. The Court takes judicial notice that the globe is substantially covered by water.[14] Therefore, a reasonable reading of de Vries would be that the invention provides for "substantially global coverage" and BriarTek does not create a material dispute regarding that term.

[14] See, e.g., http://www.noaa.gov/ocean.html ("The ocean covers 71 percent of the Earth's surface.").

vii. Claim 35

'380 Patent Claim 35	De Vries
"A method of providing a travel service, comprising providing the user unit of claim 1 to a user, and monitoring the monitoring system of claim 1."	"The data may include trip planning information such as the coordinates of waypoints, or the data may indicate the coordinates of a geofence." De Vries ¶ [0010]. See also Zancho Opening Report ¶ 152.

BriarTek does not specifically dispute that de Vries anticipates claim 35. See BriarTek Opp'n at 25; Steffes Dec. ¶ 71-72 (addressing claim 34, and then moving to the next reference).

For the foregoing reasons, claims 1, 5-12, 17, 34, and 35 of the '380 Patent are invalid as anticipated by de Vries.

viii. Claim 2

DeLorme argues that de Vries teaches the '380 Patent's claim 2, that "the user unit is adapted to be coupled to a user," because de Vries teaches at [0039] that "the operator module could be a computer such as a laptop computer, or a handheld device such as a PDA." As PDAs "commonly include belt clips, lanyards, carabineers, or other fasteners that can connect the unit to the user," DeLorme Br. Att. 19 ("Zancho Dec.") ¶ 26, DeLorme argues that de Vries inherently teaches that the user unit may be "adapted to" or "configured to" be coupled to the user. DeLorme Br. at 16-17. Although BriarTek does not respond to DeLorme's argument that de Vries' teaching of a PDA satisfies the "coupling" element, see BriarTek Opp'n at 23, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." Transclean Corp., 290 F.3d at 1373. Although DeLorme makes a strong case that de Vries teaches coupling, there is insufficient evidence to establish that it is necessary that the described PDAs include fasteners that could connect them to the user. Giving BriarTek the benefit of the doubt, BriarTek has raised a material factual dispute

regarding whether de Vries teaches claim 2. Accordingly, DeLorme has not presented sufficient evidence to conclude that claim 2 is invalid as a matter of law as anticipated by de Vries.

2. ORBCOMM

Titled "ORBCOMM PCS Available Now!" and written by Todd Hara of Orbital Communications Corporation, ORBCOMM was published in Volume 2 of the 1995 IEEE Military Communications Conference Record. ORBCOMM describes a system which "can provide the United States Armed Forces with two-way on-the-move data messaging anywhere in the world" using "light-weight and pocket-sized" subscriber communicators which send messages via satellite. § 1.0. Figure 1 illustrates the system as used to facilitate military operations:

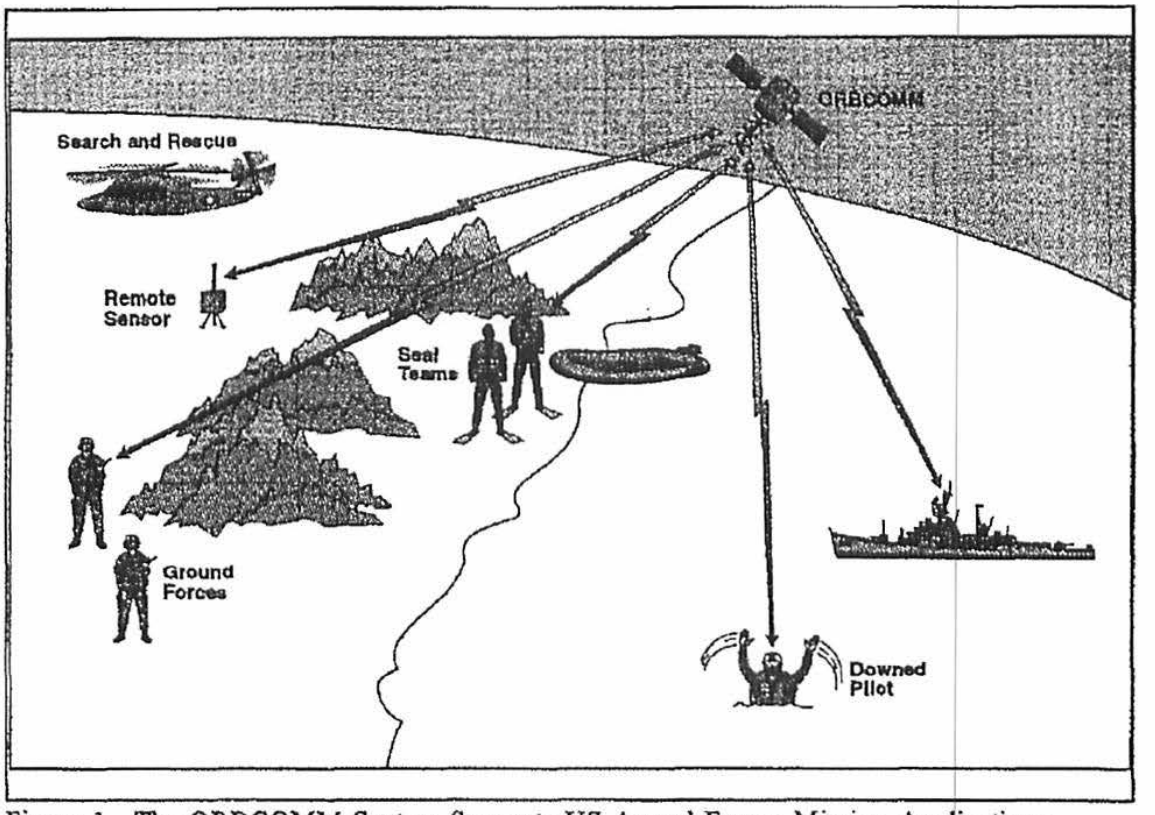


Figure 1. The ORBCOMM System Supports US Armed Forces Mission Applications

Figure 3-2 illustrates the technical implementation:

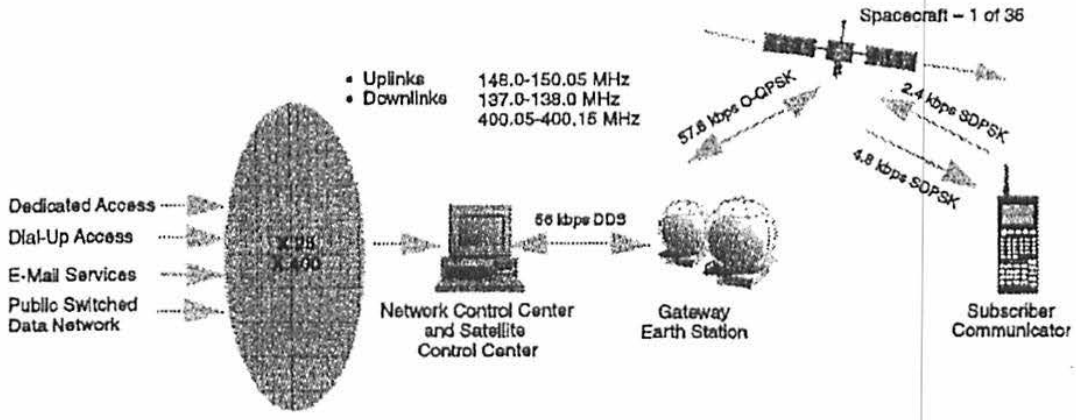


Figure 3-2. ORBCOMM System Components

One embodiment of the ORBCOMM system allows for more effective search and rescue operations. § 2.1.2. "The ORBCOMM system can effectively and inexpensively provide world-wide continuous Combat Search and Rescue . . . The downed pilot can summon SAR [Search and Rescue] teams with a light weight . . . [subscriber communicator]. The pilot will be automatically notified when his SAR message is received by the SAR team." Id.

As a matter of law and as shown in the table under each subheading, ORBCOMM anticipates claims 1, 2, 17, 34, and 35 of the '380 Patent.

i. Claim 1

'380 Patent Claim 1	ORBCOMM
"An emergency monitoring and reporting system"	"US Armed forced can use the ORBCOMM system for . . . search and rescue," ORBCOMM § 1.0, and "[t]he ORBCOMM system can effectively and inexpensively provide world-wide continuous Combat Search and Rescue." Id. § 2.1.2. See also Zancho Opening Report ¶ 156.
"comprising: a user unit"	"Thousands of messages have been sent to and from the satellites using Subscriber

	Communicators (SCs) (user terminals) to other SCs, Internet mail, fax machines, and pagers." ORBCOMM § 1.0. See also id. Fig. 3-2; Zancho Opening Report ¶ 157.
"comprising . . . a monitoring system"	"[G]round segment," "network control center," and "satellite control center" allow monitoring of the SCs. ORBCOMM §§ 3.1.2 – 3.1.2.4. See also id. § 1.0; Zancho Opening Report ¶ 161.
"wherein the user unit includes an input device"	"The SCs are compact, light-weight devices with . . . [a] keypad." ORBCOMM §3.1.4; Zancho Opening Report ¶ 158.
"wherein the user unit includes . . . a user satellite communication system"	"The SCs are compact, light-weight devices with . . . 5-watt transmitters." ORBCOMM §§ 3.0, 3.1.1.1, and 3.1.4. See also Zancho Opening Report ¶ 158.
"wherein the user unit includes . . . a user processor communicatively coupled to the user device and the user satellite communication system"	ORBCOMM § 3.1.4 (describing operation of the SC). See also Zancho Opening Report ¶ 159.
"wherein the monitoring system includes a monitoring satellite communication system"	"The GES transmits to the satellite . . . [and] receives . . . transmissions from the satellite." ORBCOMM §§ 3.0.2, 3.1.1.1, and 3.1.2.4. See also Zancho Opening Report ¶ 159.
"wherein the monitoring system includes . . . an output device"	ORBCOMM § 3.1.2.2 and Fig. 3-2 (showing monitor at NCC). See also Zancho Opening Report ¶¶ 160-61.
"wherein the monitoring system includes . . . a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device"	"The NCC is comprised of highly available dual processor computers." ORBCOMM §§ 3.1.2 – 3.1.2.4 and Fig. 3-2. See also Zancho Opening Report ¶ 161.
"wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network"	"Thousands of messages have been sent to and from the satellites using Subscriber Communicators (SCs) (user terminals) to other SCs, Internet mail, fax machines, and pagers," ORBCOMM § 1.0, the ORBCOMM System can be used for "two-way messaging," id. § 1.1, and "[t]he ORBCOMM System uses a constellation of 36 satellites." Id. § 3.1.1.1. See also Zancho Opening Report ¶¶ 159, 161.
"such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device"	The ORBCOMM System can be used for "two-way messaging," ORBCOMM § 1.1, and "[t]he ORBCOMM System user can compose, transmit, and receive messages." Id. § 3.0, Fig. 3-2. See also Zancho Opening Report ¶ 161.

"and wherein the input device includes a text entry device adapted to receive textual data entered by a user."	The ORBCOMM System can be used for "two-way messaging." ORBCOMM § 1.1. See also Zancho Opening Report ¶ 161

BriarTek first argues that ORBCOMM does not anticipate claim 1 because ORBCOMM "had latencies of up to several hours per message" and thus "[w]hile ORBCOMM may allow for two-way communications, it does not allow for two-way conversation as required in the application." BriarTek Opp'n at 19. BriarTek appears to be referencing the requirement in claim 1 of the '380 Patent that "the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network." Read literally, claim 1 does not require any particular latency or effectiveness, only "mutual communication," and BriarTek admits that ORBCOMM teaches "two-way communications. Id. Accordingly, BriarTek's argument is directed to an unclaimed limitation which cannot prevent summary judgment. King Pharms., 616 F.3d at 1275.

BriarTek next argues that ORBCOMM does not anticipate claim 1 because it does not describe a system that was functioning when the article was published. BriarTek Opp'n at 18; Steffes Dec. ¶ 51. That argument fails because "anticipation does not require actual performance of suggestions in a disclosure. Rather, anticipation only requires that those suggestions be enabling to one of skill in the art." Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1379 (Fed. Cir. 2001). Even if the system described by ORBCOMM did not exist when the article was published, and even if the system never existed at all, that does not prevent a finding of anticipation. Id. ORBCOMM is valid prior art for all that it enables, regardless of whether or not the system was functional at the time of publication.

BriarTek also argues that ORBCOMM does not teach the '380 Patent's monitoring system because ORBCOMM's Network Control Center ("NCC", see ORBCOMM Fig. 3-2 and §

3.1.2.2) only monitors and routes traffic, but does not contain an output device. BriarTek Opp'n at 20; Steffes Dec. ¶¶ 53-54. That argument is flatly contradicted by ORBCOMM Fig. 3-2, which shows a computer including a display as part of the NCC. Although BriarTek argues that Mr. Zancho admitted that the NCC is not a monitoring system by itself, BriarTek quotes Mr. Zancho out of context. In his deposition, Mr. Zancho stated that one way to see messages in the ORBCOMM reference does involve an output device, and he makes clear that "[t]here's two ways to see the message [through the NCC]. One is by an outside observer attaching himself to that or the operator of the network control center can see those messages on that screen." BriarTek Opp'n Ex. G ("Zancho Dep.") p. 80 lines 7-11. BriarTek cannot manufacture a material dispute by "submitting an expert declaration that something is black when the moving party's expert says it is white; there must be some foundation or basis for the opinion." Invitrogen Corp., 429 F.3d at 1080. Therefore, BriarTek has not adequately contested the conclusion that the NCC allows for the reading of incoming messages on the screen at the NCC. See BriarTek Opp'n at 20; Steffes Dec. ¶¶ 53-54. Accordingly, BriarTek does not create a material dispute regarding whether ORBCOMM invalidates claim 1.

ii. Claim 2

'380 Patent Claim 2	ORBCOMM
"The system of claim 1, wherein the user unit is adapted to be coupled to a user."	"The SCs are light-weight and pocket-sized." ORBCOMM § 1.0. See also . Zancho Opening Report ¶ 162.

ORBCOMM teaches that the Subscriber Communicators (SCs) are pocket-sized, § 1.0, which leads to the conclusion that the SCs may be tethered or coupled to the user by placing the SC in the user's pocket. BriarTek questions whether a downed pilot could necessarily carry the SC, BriarTek Opp'n at 21, but does not contest that an SC may be tethered or coupled to the user

by being placed in the user's pocket. Thus, BriarTek has not raised a material dispute regarding whether ORBCOMM invalidates claim 2.

iii. Claim 17[15]

'380 Patent Claim 17	ORBCOMM
"The system of claim 1, wherein the user unit further includes a status sensor that is communicatively coupled to the user processor and that provides a status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network."	"[T]he ORBCOMM System can . . . [provide] remote sensor control, transmission of data from intrusion, motion heat sensors." ORBCOMM ¶ 2.0. See also Zancho Opening Report ¶ 171 (formatting is necessary to communicate sensor signals).

BriarTek repeats its arguments about ORBCOMM lacking a monitoring system,[16] but does not contest that sensor signals must be formatted before they can be transmitted, nor that ORBCOMM teaches a status sensor that is coupled to the user processor and that transmits information. See BriarTek Opp'n at 22. Therefore, BriarTek has not raised a material dispute regarding the invalidity of claim 17.

iv. Claim 34

'380 Patent Claim 34	ORBCOMM
"The system of claim 1, wherein the satellite network provide[s] substantially global coverage."	The ORBCOMM System "can provide the United States Armed Forces with two-way on-the-move data messaging anywhere in the world." ORBCOMM § 1.0. See also Zancho Opening Report ¶ 172.

BriarTek argues that the article states that only one satellite had been launched at the time of publication. See BriarTek Opp'n at 22. As discussed above, "anticipation does not require actual performance of suggestions in a disclosure. Rather, anticipation only requires that those

[15] DeLorme does not argue that ORBCOMM anticipates claims 5-9 of the '380 Patent.
[16] Those arguments, for the reasons explained above regarding claim 1, are unconvincing.

suggestions be enabling to one of skill in the art." Bristol-Myers Squibb, 246 F.3d at 1379. The question is not what actually existed at the time that ORBCOMM was published, but rather what ORBCOMM suggested to one of ordinary skill in the art. ORBCOMM specifically states that its system operates "anywhere in the world." § 3.0; Zancho Opening Report ¶ 172. BriarTek does not dispute that ORBCOMM teaches a system that operates anywhere in the world. Therefore, BriarTek has not raised a material dispute regarding claim 34, which is anticipated by ORBCOMM.

v. Claim 35

'380 Patent Claim 35	ORBCOMM
"A method of providing a travel service, comprising providing the user unit of claim 1 to a user, and monitoring the monitoring system of claim 1."	The ORBCOMM system allows users to "[c]ommunicate on-the-move" from the SCs, and can "[t]rack the position of logistics throughout shipment." ORBCOMM § 2.0. See also Zancho Opening Report ¶ 173.

BriarTek does not specifically dispute that ORBCOMM teaches the limitations of claim 35, instead relying on its arguments regarding claim 1. BriarTek Opp'n at 22. For the same reasons that BriarTek's arguments are unconvincing regarding claim 1, they are unconvincing regarding claim 35.

vi. Claims 10-12

DeLorme argues that ORBCOMM anticipates claims 10-12. See DeLorme Br. at 14-15. Claim 10 depends on claim 1. Claim 11 depends on claim 10, and claim 12 depends on claim 11. Because dependent claims incorporate the limitations of the claim (or claims) on which they depend, claim 10 must be invalid in order for claims 11 and 12 to be invalid.

Claim 10 provides that "the user satellite communication system includes a transmitter, and wherein the input device is adapted to receive user data from a user and the user processor is

adapted to format the data for transmission by the transmitter." DeLorme argues that "[t]he SCs include five-watt transmitters." DeLorme Br. at 14; Zancho Opening Report ¶ 168. DeLorme does not argue that ORBCOMM teaches the formatting limitation, or that the formatting limitation is inherent. See DeLorme Br. at 14; Zancho Opening Report ¶ 168. Therefore, DeLorme does not argue that ORBCOMM teaches each and every limitation of claim 10. Neither does Mr. Zancho present specific facts regarding the formatting limitation. Id. Therefore, DeLorme does not present sufficient evidence to conclude that ORBCOMM anticipates claim 10 as a matter of law. Because summary judgment is not appropriate as to claim 10, neither is it appropriate as to claims 11 or 12.

3. Motorola Manual

DeLorme has presented insufficient evidence to conclude that the Motorola Manual anticipates, as a matter of law, claims 1, 2, 5-12, 17, 34, or 35 of the '380 Patent.

The Motorola Manual, titled "Satellite Series 9505 Portable Telephone User's Guide," Motorola Manual at 1, describes how the phone can be placed into "satellite mode," which allows communication via satellite. See id. at 46, 188. Using the phone in satellite mode allows "communication in many remote areas around the world." Id. at i.

DeLorme argues that the Motorola Manual teaches each element of claim 1 because a person of ordinary skill could have created the system of claim 1 by using one satellite phone as the user unit, and connecting another satellite phone to a computer to create a monitoring system. DeLorme Br. at 19; Zancho Opening Report ¶ 201. The Motorola Manual itself does not describe such a system, nor does DeLorme claim that it does. See DeLorme Br. at 19; Zancho Opening Report ¶ 201. Instead, DeLorme argues that "a second Motorola handset could satisfy all of the elements of the claimed monitoring system." DeLorme Br. at 19. That someone could arrange

two phones in a particular manner does not mean that the Motorola Manual teaches that arrangement; indeed, the Motorola Manual does not teach any arrangement involving two phones, other than general calling and texting. See Motorola Manual. Further, BriarTek presented evidence that a person of ordinary skill would not understand the Motorola Manual to teach a monitoring system. Steffes Rebuttal Report at 13.

This evidence establishes a genuine issue of material fact regarding whether the Motorola Manual anticipates claim 1 of the '380 Patent. Because claims 2, 5-12, 17, 34, and 35 depend, directly or indirectly, on claim 1, BriarTek has raised a genuine issue of material fact regarding whether the Motorola Manual anticipates those claims as well.

In summary, claims 1, 5-12, 17, 34, and 35 of the '380 Patent are invalid as anticipated by de Vries. Additionally, claims 1, 2, 17, 34, and 35 of the '380 Patent are invalid as anticipated by ORBCOMM; however, there is insufficient evidence to conclude that the Motorola reference anticipates any of the asserted claims of the '380 Patent.

F. Obviousness

Even where an invention has not been identically disclosed in one prior art reference, the patent claims may nevertheless be invalid where "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a).

Obviousness under 35 U.S.C. § 103 "is a question of law based on underlying findings of facts," namely (i) the scope and content of the prior art, (ii) the characteristics and understanding of an individual of ordinary skill in the art at the time of invention, (iii) the differences between the claimed invention and the prior art, and (iv) the evidence of secondary factors of non-

obviousness. See Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Eisai Co. Ltd. v. Dr. Reddy's Labs., Ltd., 533 F.3d 1353, 1356 (Fed. Cir. 2008). "Where . . . the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate." KSR, 550 U.S. at 427.

"[T]he legal determination of obviousness may include recourse to logic, judgment, and common sense, in lieu of expert testimony." Wyers v. Master Lock Co., 616 F.3d 1231, 1239 (Fed. Cir. 2010). The Court may determine that a claimed invention was obvious, even without expert testimony, if the invention was "easily understandable." Id. "[W]here all of the limitations of the patent were present in the prior art references, and the invention was addressed to a known problem, KSR compels the grant of summary judgment of obviousness." Id. (internal quotation marks omitted). Further, "it is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements." In re Mouttet, 686 F.3d 1322, 1332 (Fed. Cir. 2012). Instead, "the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art." Id. To the extent that BriarTek has raised a genuine dispute of material fact regarding anticipation of any claim of the '380 Patent, BriarTek has not raised a genuine dispute of material fact regarding the obviousness of those claims.

1. Scope and Content of the Prior Art

Only references analogous to the claimed invention may be considered when evaluating obviousness. Wyers, 616 F.3d at 1237. To determine whether a reference is analogous, courts should consider "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor,

whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved." Id. BriarTek does not contest that the references cited by DeLorme are analogous art. See BriarTek Opp'n at 27-28. Therefore, there is no dispute regarding the scope and content of the prior art.

2. Level of Ordinary Skill in the Art

For the purposes of this motion, the Court adopts BriarTek's definition of a person of ordinary skill in the art. To determine obviousness, the Court views a person of ordinary skill in the art as a person with a bachelor's degree in physics or engineering with approximately ten years of experience in the field of satellite communications, satellite navigations, or wireless interfaces, or a master's degree in physics or engineering and five years of relevant experience, or a Ph.D. and research in the same field. Steffes Opening Report at 20-21. Accordingly, there is no material dispute regarding the level of ordinary skill.

3. Secondary Considerations

"[S]econdary considerations such as commercial success, long felt but unsolved needs, failure of others, etc. . . . may have relevancy" to the obviousness determination. Graham, 383 U.S. at 17-18. The Court must consider such factors, when presented, in evaluating obviousness. In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation, 676 F.3d 1063, 1075 (Fed. Cir. 2012). In this case, neither DeLorme nor BriarTek offered evidence of secondary considerations for this Court to consider. See DeLorme Br.; BriarTek Opp'n. Accordingly, there is no material dispute regarding secondary considerations.

4. Differences Between Claimed Invention and Prior Art

Before making a determination of obviousness, the Court must resolve any differences between the claimed invention and the prior art. Graham, 383 U.S. at 17-18. As explained in the

anticipation section above, the Court has found that de Vries and ORBCOMM teach almost every asserted claim. For the purposes of evaluating obviousness, BriarTek's arguments that these references do not anticipate the asserted claims will be accepted, so that there is no dispute regarding the differences between the claimed invention and the prior art.

Regarding claim 1, BriarTek argues that de Vries does not teach "mutual communication using detailed text messages." BriarTek Opp'n at 23. Regarding claim 2, BriarTek argues that de Vries does not teach coupling or tethering. Id. Regarding claims 5-9, BriarTek repeats its arguments regarding the requirement for detailed text messages. Id. at 24. Regarding claims 10-11, BriarTek admits the "need" to change the format of data when using detailed text messages and argues that because de Vries does not teach detailed text messages, formatting is not present. Id. at 25. Regarding claim 17, BriarTek argues that de Vries does not teach that the sensor is coupled to the user processor to format the data for communication. Id. Regarding claim 34, BriarTek argues that de Vries does not teach global coverage. Id. BriarTek does not dispute that all other claim limitations are present in de Vries. See id. at 23-25.

Regarding claim 1, BriarTek argues that ORBCOMM does not contain a monitoring system. Id. at 19-20. Regarding claim 2, BriarTek argues that ORBCOMM does not teach coupling. Id. at 21. Regarding claim 34, BriarTek argues that ORBCOMM does not teach worldwide coverage. Id. at 22. BriarTek does not contest that all other claim limitations are present in ORBCOMM. See id. at 19-22.

Regarding claims 5 and 7, BriarTek argues that the Motorola Manual does not teach pre-stored text messages. Id. at 26.

5. Resolving Obviousness

For the purposes of resolving obviousness, it will be assumed that BriarTek is correct regarding the differences between the claimed invention and the prior art. This assumption renders the factual underpinnings of the obviousness inquiry without dispute. Accordingly, the legal determination of obviousness is ripe for summary judgment adjudication.

i. De Vries in view of the Motorola Manual

Regarding claims 1 and 5-9, BriarTek argues that de Vries does not teach detailed text messaging. Id. at 23-24. DeLorme argues and BriarTek concedes that the Motorola Manual does teach detailed text messaging. DeLorme Br. at 18-19; Zancho Opening Report ¶ 201; BriarTek Opp'n at 25-27. It would have been obvious to one of ordinary skill in the art to combine de Vries and the Motorola Manual to arrive at the invention of claims 1 and 5-9. It would have been clear to even a layperson that sending customized detailed messages would be preferable to sending "canned" messages because customized messages allow for more robust communication. Further, de Vries specifically teaches that its user unit could be a device similar to the satellite phone described by the Motorola Manual. See de Vries [0039] ("The operator module could be . . . a handheld device such as a PDA."). Accordingly, De Vries specifically suggests use of a device like the Motorola satellite phone, which BriarTek does not contest provides detailed messaging capability. Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of de Vries and the Motorola Manual to reach the invention in claim 1.

Regarding claim 2, BriarTek argues that de Vries does not teach coupling to a user. BriarTek Opp'n at 23. As discussed above, there is a strong case for concluding that de Vries does teach coupling; however, there can be no reasonable dispute that the Motorola Manual does

teach coupling, and BriarTek does not contest this teaching. DeLorme Br. at 19; Zancho Opening Report ¶ 209; BriarTek Opp'n at 25-27. Indeed, the Motorola Manual specifically discloses a carry case and wrist strap. Motorola Manual at 22-23. BriarTek also does not contest that de Vries teaches that its user unit may be a handheld device, and that handheld devices often come with methods to attach the device to the user. See BriarTek Opp'n. Therefore, it would have been obvious to combine the teachings in these two references to arrive at the invention in claim 2. A person of ordinary skill in the art would have recognized that allowing for coupling with the user would make the user unit more portable, and thus easier to use. This would have rendered the claimed invention obvious to one of ordinary skill in the art.

Regarding claims 10 and 11, BriarTek argues that formatting is not present in de Vries because de Vries does not teach detailed text messages. BriarTek also argues that when sending detailed text messages a device "need[s] to change the format of the data." BriarTek Opp'n at 25. As discussed above, the Motorola Manual teaches detailed text messages and BriarTek admits that formatting is necessary for sending detailed text messages. Therefore, the combination of de Vries and the Motorola Manual teaches all of the limitations in claims 10 and 11, even under BriarTek's reading of the prior art. Therefore, these claims would have been obvious to one skilled in the art.

Regarding claim 34, BriarTek argues that de Vries does not teach substantially global coverage. BriarTek Opp'n at 25. DeLorme argues, and BriarTek does not contest, that the Motorola Manual does teach substantially global coverage. DeLorme Br. at 20; Zancho Opening Report ¶ 218; BriarTek Opp'n at 25-27. Thus, the combination of the two references teaches each element of claim 34. It would have been obvious to one of ordinary skill in the art to combine these teachings to arrive at the invention as claimed. Specifically, one of ordinary skill

in the art would have recognized the advantage of having more coverage in a communication system, and would have recognized that substantial coverage would increase the number of people with whom a user could communicate.

ii. ORBCOMM in view of de Vries

DeLorme also argues that ORBCOMM and de Vries render the '380 Patent obvious. Regarding claim 1, BriarTek argues that ORBCOMM does not teach a monitoring system, BriarTek Opp'n at 19-20; however, BriarTek does not contest that de Vries teaches a monitoring system. See BriarTek Opp'n at 23-25. Thus, the combination of ORBCOMM with de Vries teaches each element of claim 1. The advantages of a central system to monitor, for example, the search and rescue operations taught by ORBCOMM would have been obvious to one of ordinary skill. A central system allows for easier coordination of rescue operations – a stated goal of ORBCOMM,[17] and would have rendered the invention of claim 1 obvious to one of ordinary skill in the art.

iii. De Vries in view of the Motorola Manual in view of ORBCOMM

Regarding claim 17, BriarTek argues that de Vries does not teach that the sensor is coupled to the user processor to format the data for communication. BriarTek Opp'n at 25. DeLorme argues that ORBCOMM does teach this limitation, and BriarTek does not dispute that ORBCOMM teaches a sensor which transmits information. DeLorme's Reply Brief [Dkt. No. 140] ("Reply Br.") at 140; BriarTek Opp'n at 22. BriarTek also does not dispute that de Vries teaches a monitoring system which receives information from a sensor, see BriarTek Opp'n at 25, and that sensor signals must be formatted before they are transmitted. See id. at 22. It would have been obvious to one of ordinary skill in the art to combine the de Vries, ORBCOMM, and

[17] ORBCOMM § 2.1.2 ("The ORBCOMM System can effectively and inexpensively provide world-wide [Combat Search and Rescue] coverage using the ORBCOMM satellite constellation.").

Motorola Manual teachings to arrive at the invention in claim 17. One of ordinary skill would have recognized the advantage of a central system to monitor, for example, the sensor systems taught by ORBCOMM. § 2.0. BriarTek does not contest that transmitting sensor information requires formatting. See BriarTek Opp'n at 22. Thus, the combined references rendered the invention in claim 17 obvious to one of ordinary skill in the art.

iv. ORBCOMM in view of de Vries in view of the Motorola Manual

Regarding claim 2, BriarTek argues that ORBCOMM does not teach coupling to a user, BriarTek Opp'n at 23, but does not contest DeLorme's argument that the Motorola Manual does teach coupling. DeLorme Br. at 19; Zancho Opening Report ¶ 209; BriarTek Opp'n at 25-27. Indeed, the Motorola Manual specifically teaches a carry case and wrist strap, Motorola Manual at 22-23, ORBCOMM teaches that the Subscriber Communicators (SCs) are pocket-sized, § 1.0, and De Vries teaches that the user unit can be a PDA. ¶ [0039]. BriarTek does not contest either that ORBCOMM teaches that its user unit may be a handheld device, or that handheld devices often come with methods for attaching the device to the user. See BriarTek Opp'n. It would have been obvious to combine these teachings to arrive at the invention in claim 2. A person of ordinary skill in the art would have recognized that allowing for coupling with the user would make the user unit more portable, and thus easier to use. This would have rendered the claimed invention obvious to one of ordinary skill in the art.

v. BriarTek's Obviousness Arguments

BriarTek presents two general arguments to oppose a finding that any of the claims are obvious; however, each fails as a matter of law. First, BriarTek argues that "[o]bviousness cannot be established by merely finding identical parts in the prior art." BriarTek Opp'n at 27. As authority, BriarTek cites Applied Med. Res. Corp. v. U.S. Surgical Corp., 147 F.3d 1374,

1380 (Fed. Cir. 1998). That argument fails because the section of Applied Med. Res. Corp. that BriarTek cites addresses anticipation, not obviousness. Id. at 1380. Even so, BriarTek states a truism. Finding identical parts in the prior art is neither necessary nor sufficient under Graham and KSR; rather, the Court must resolve the factual underpinnings, and then determine obviousness in light of those facts. See KSR, 550 U.S. at 406-07; Graham, 383 U.S. at 17-18.

Second, BriarTek argues that mixing of the systems described in DeLorme's cited references would not be possible, because "each . . . system[] i[s] limited by its technical implementation" and therefore the systems are "not generically interchangeable." BriarTek Opp'n at 28. But "it is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements." Mouttet, 686 F.3d at 1332. Instead, "the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art." Id. The Court is satisfied that, for the reasons above, the combined teachings of the references, combined with the knowledge of one of ordinary skill in the art, would have suggested the claimed invention. Thus, the claims are obvious as a matter of law.[18]

G. Written Description, Indefiniteness, and Subject Matter

Because all the asserted claims have been found to be invalid as a matter of law over the prior art, either as anticipated or as obvious, the arguments regarding written description, indefiniteness, and subject matter eligibility need not, and will not, be addressed.

[18] The parties also present numerous arguments regarding Boling. Because the other cited prior art is sufficient, the Court does not need to refer to Boling to resolve either the anticipation or obviousness analysis. When considered with the other references, however, Boling overwhelmingly confirms the conclusion of invalidity.

III. CONCLUSION

For the reasons stated above, plaintiffs' Motion for Summary Judgment [Dkt. No. 109] will be granted by an appropriate Order to be issued with this Memorandum Opinion.

Entered this 19th day of November, 2014.

Alexandria, Virginia

/s/
Leonie M. Brinkema
United States District Judge

FILED
NOV 19 2014
CLERK, U.S. DISTRICT COURT
ALEXANDRIA, VIRGINIA

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

DELORME PUBLISHING COMPANY, INC., et al.,	)	
Plaintiffs	)	1:13cv640 (LMB/TRJ)
v.	)	
BRIARTEK IP, INC. et al.,	)	
Defendants.	)	

ORDER

For the reasons stated in the accompanying Memorandum Opinion, plaintiffs' Motion for Summary Judgment of Invalidity [Dkt. No. 109] is GRANTED, and it is hereby

ORDERED, ADJUDGED, AND DECLARED that United States Patent No. 7,991,380 is invalid; and it is further

ORDERED that judgment be and is entered in favor of the plaintiffs.

The Clerk is directed to enter judgment in plaintiffs' favor pursuant to Fed. R. Civ. P. 58 and forward copies of this Order and the accompanying Memorandum Opinion to counsel of record.

Entered this 19th day of November, 2014.

Alexandria, Virginia

/s/
Leonie M. Brinkema
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

Alexandria Division

DELORME PUBLISHING COMPANY, INC., et al.,	)
Plaintiffs,	)
v.	) Civil Action No. 1:14cv640 (LMB/TRJ)
BRIARTEK IP, INC. et al.,	)
Defendants.	)

JUDGMENT

Pursuant to the order of this Court entered on November 19, 2014 and in accordance with Fed. R. Civ. P. 58, JUDGMENT is hereby entered in favor of the plaintiffs Delorme Publishing Company, Inc., et al.

FERNANDO GALINDO, CLERK

By: /s/
Y. Guyton, Deputy Clerk

Dated: 11/19/2014
Alexandria, Virginia

U 1892294

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

August 02, 2012

THIS IS TO CERTIFY THAT ANNEXED HERETO IS A TRUE COPY FROM THE RECORDS OF THIS OFFICE OF:

U.S. PATENT: *7,991,380*
ISSUE DATE: *August 02, 2011*

By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

CATHY FOWLER
Certifying Officer

US007991380B2

(12) **United States Patent**
Collins et al.

(10) **Patent No.: US 7,991,380 B2**
(45) **Date of Patent: Aug. 2, 2011**

(54) **GLOBAL BIDIRECTIONAL LOCATOR BEACON AND EMERGENCY COMMUNICATIONS SYSTEM**

(75) Inventors: **Charles K. Collins**, Alexandria, VA (US); **Joseph Landa**, Alexandria, VA (US)

(73) Assignee: **Briar Tek IP**, Alexandria, VA (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 985 days.

(21) Appl. No.: **11/693,434**

(22) Filed: **Mar. 29, 2007**

(65) **Prior Publication Data**

US 2007/0232275 A1 Oct. 4, 2007

Related U.S. Application Data

(60) Provisional application No. 60/788,411, filed on Mar. 30, 2006.

(51) **Int. Cl.**
H04M 11/04 (2006.01)

(52) **U.S. Cl.** **455/404.1**; 455/414.4; 455/404.2; 455/3.02; 455/12.1

(58) **Field of Classification Search** 455/12.1, 455/404.2, 413, 427, 422, 11.1, 404.1, 456.1, 455/414.1, 414.4, 414.3, 412.2, 515, 13.2; 705/3; 340/988, 426, 573.1, 573.4, 572.1, 340/568.1, 825.49, 989

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

4,833,477	A *	5/1989	Tendler	342/389
5,497,149	A *	3/1996	Fast	340/988
5,598,460	A *	1/1997	Tendler	455/404.2
5,914,675	A *	6/1999	Tognazzini	340/989
6,083,248	A *	7/2000	Thompson	607/30
2003/0137424	A1 *	7/2003	Gehlot et al.	340/573.4
2004/0239498	A1 *	12/2004	Miller	340/539.13
2005/0239477	A1 *	10/2005	Kim et al.	455/456.1
2006/0007038	A1 *	1/2006	Boling et al.	342/357.1
2006/0009191	A1 *	1/2006	Malone, III	455/404.1
2006/0200842	A1 *	9/2006	Chapman et al.	725/34
2007/0057798	A1 *	3/2007	Li et al.	340/573.1
2007/0136099	A1 *	6/2007	Neligh et al.	705/3
2008/0186135	A1 *	8/2008	Boling et al.	340/7.51
2009/0099777	A1 *	4/2009	Roy et al.	702/6

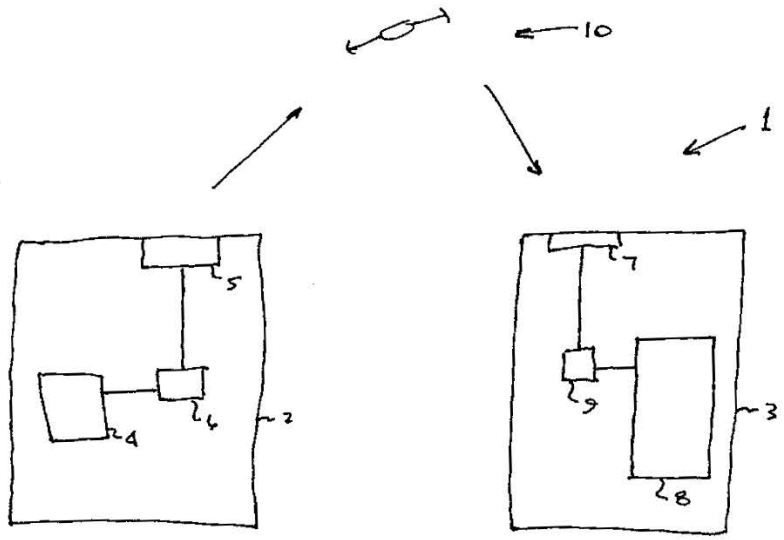
* cited by examiner

Primary Examiner — Tan Trinh
(74) *Attorney, Agent, or Firm* — IP Strategies

(57) **ABSTRACT**

An emergency monitoring and reporting system includes a user unit and a monitoring system. The user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system. The monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device. The user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information corresponding to information entered at the input device to an observer.

55 Claims, 5 Drawing Sheets



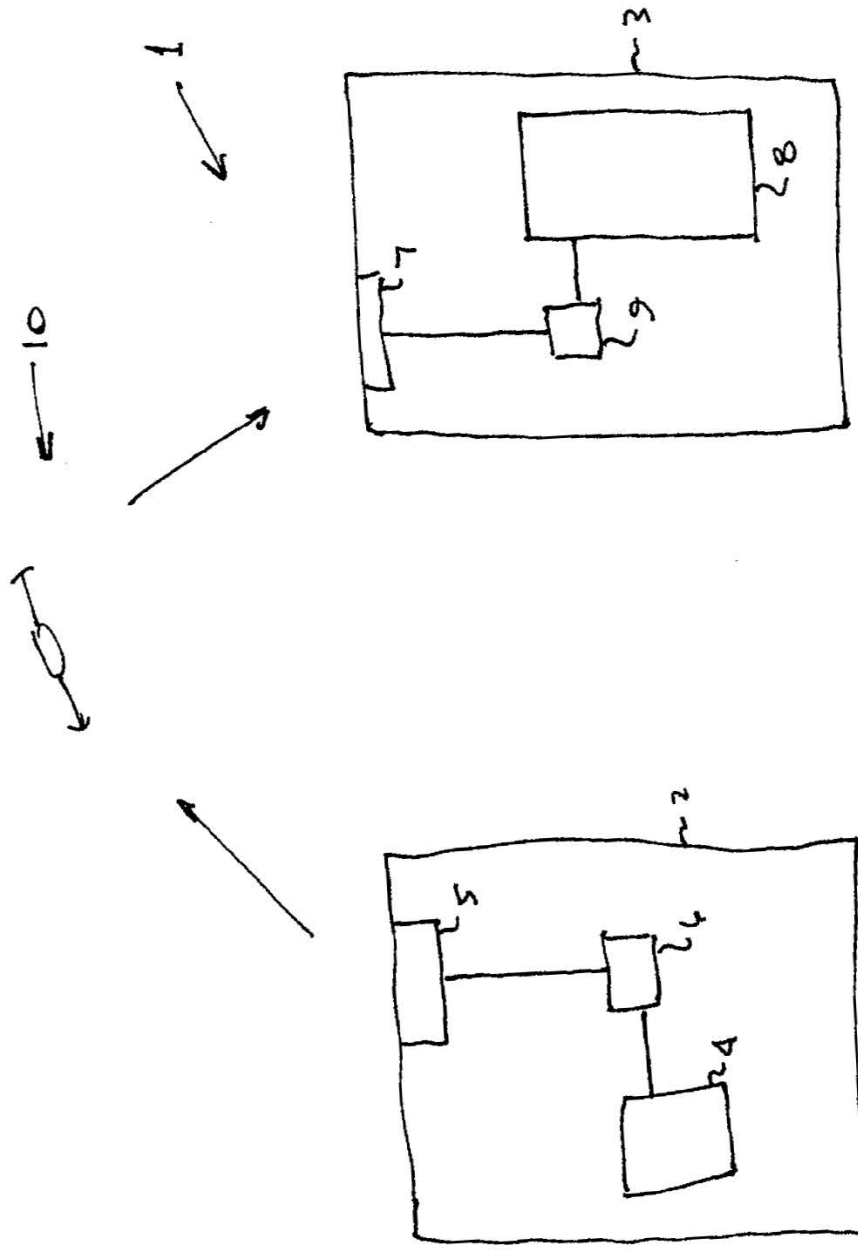


Fig. 1

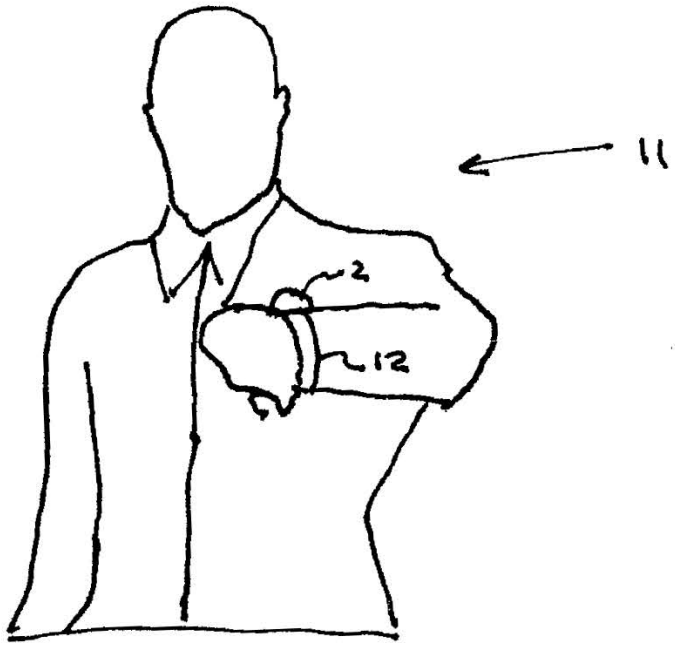


FIG. 2

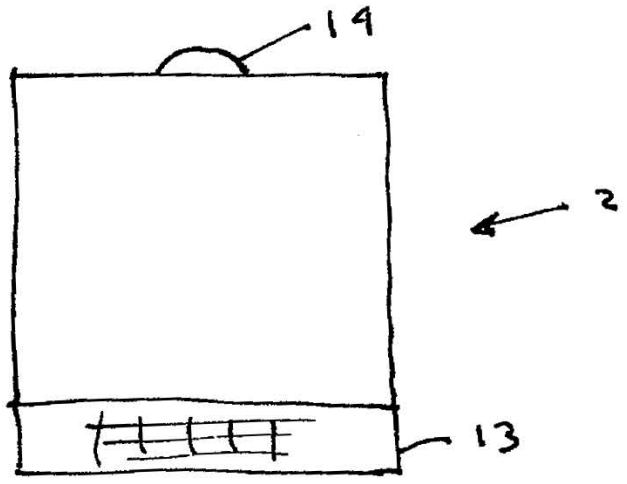


FIG. 3

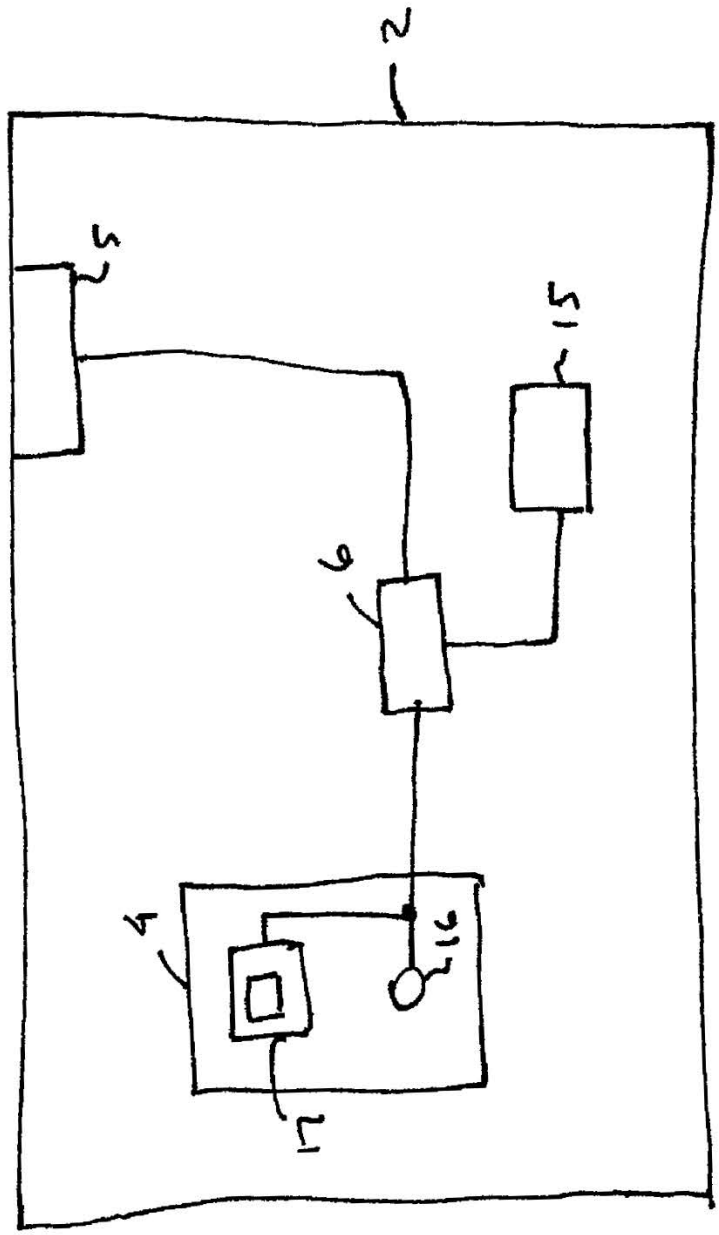


FIG. 4

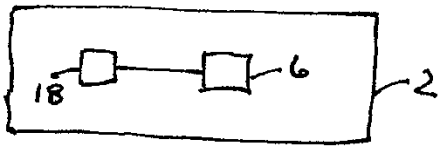


FIG. 5

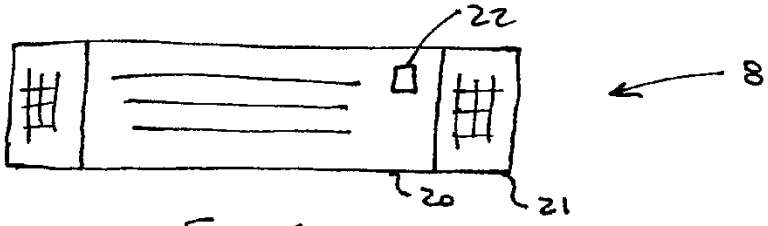


FIG. 6

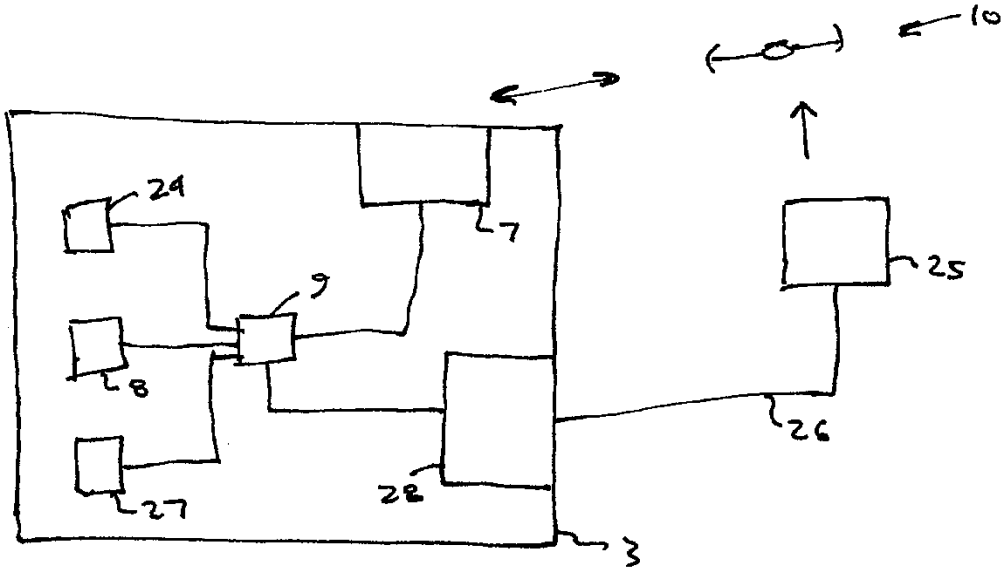


FIG. 8

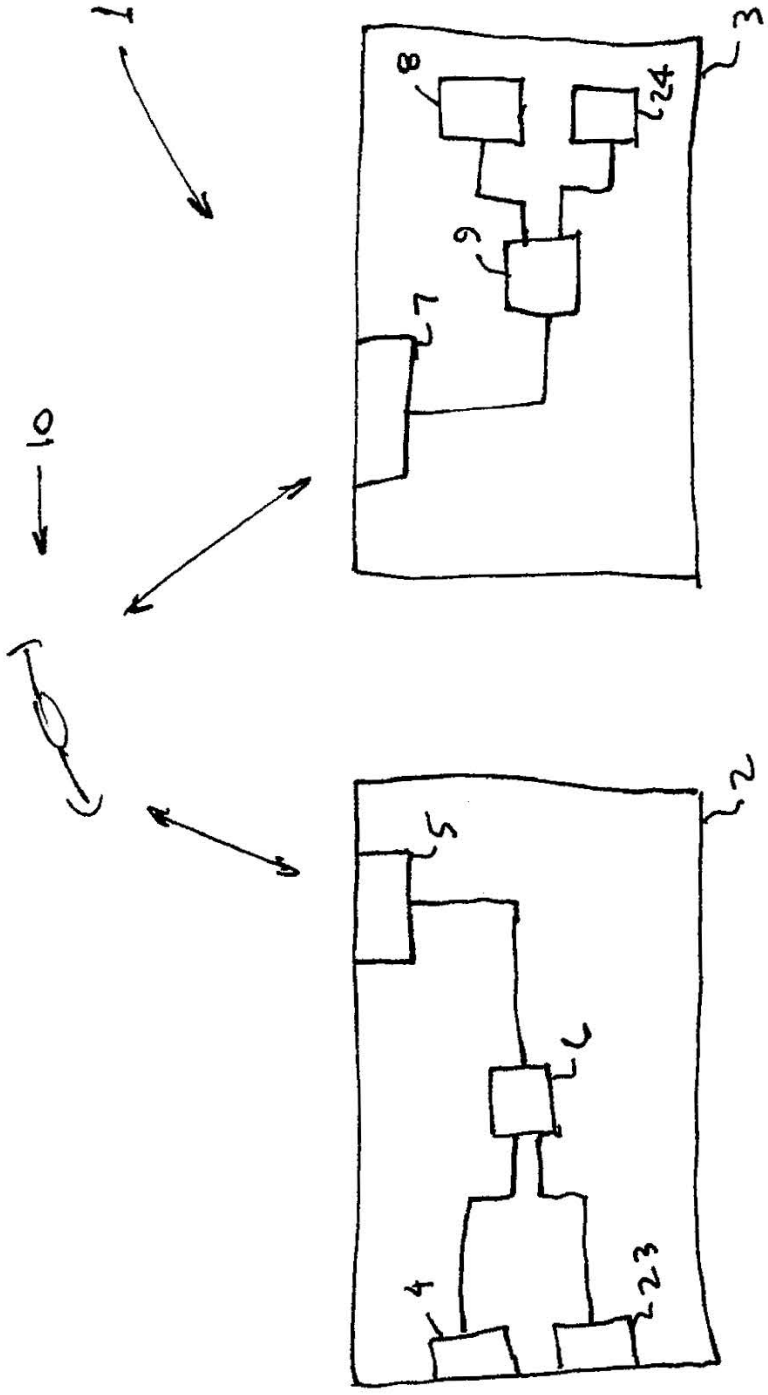


FIG. 7

GLOBAL BIDIRECTIONAL LOCATOR BEACON AND EMERGENCY COMMUNICATIONS SYSTEM

CROSS-REFERENCE TO RELATED APPLICATION

This is related to, and claims the benefit under 35 USC §119(e) of U.S. Provisional Application for Patent No. 60/788,411, which was filed on Mar. 30, 2006.

FIELD OF THE INVENTION

The present invention is related to the monitoring, searching, and rescuing of individuals during emergency situations regardless of their location on the globe.

BACKGROUND OF THE INVENTION

Travelers to remote locations sometimes require the ability to contact rescue authorities in the event of emergencies. Currently, when a traveler is outside the range of traditional telephones, cellular phones, or radios he can either carry a satellite phone or a one-way emergency beacon such as an emergency positioning radio beacon (EPIRB). A problem with satellite phones is that they are typically expensive and are not always set up with the appropriate emergency contact information. A major drawback to standard emergency beacons is that they only operate in one direction. A user pushes an alerting button and the rescue authorities then have to determine the appropriate response with no additional information such as condition of the party and nature of the emergency. A bidirectional communications tool that is capable of sending and receiving short text messages and that can be remotely monitored would help save lives and greatly reduce false alarms and unneeded search and rescue operations.

SUMMARY OF THE INVENTION

According to an aspect of the invention, an emergency monitoring and reporting system includes a user unit and a monitoring system. The user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system. The monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device. The user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information to an observer that corresponds to information entered at the input device. Preferably, the satellite network provides substantially global coverage.

The user unit can be adapted to be coupled to a user.

The input device can be adapted to receive text data entered by a user. For example, the input device can be a keypad.

The input device can be adapted to receive voice input from a user. In this case, the user processor can be adapted to convert the voice input to text.

The user unit can also include a memory device in communication with the user processor, and the input device can include an actuator that when selected accesses message data stored in the memory device. Selection of the actuator can cause the accessed message data to be transmitted by the user satellite communication system to the monitor communication system via the satellite network. The message data can include a number of instances of message data, and each data instance can be stored in a respective selectable portion of the memory device. In this case, the input device can include a selection device that is adapted to select one message data instance, and the selected message data instance is transmitted by the user satellite communication system on selection of the actuator. The selection device can be, for example, a scrolling device.

The user satellite communication system can include a transmitter, the input device can be adapted to receive user data from a user, and the user processor can be adapted to format the data for transmission by the transmitter. The monitor satellite communication system can include a receiver that is adapted to receive transmissions from the transmitter via the satellite network, and the monitor processor can be adapted to format the user data received by the receiver for presentation to the observer on the output device. The output device can be adapted to display textual messages and/or audio messages. The output device can include an alarm that is actuated on receipt of the user data by the receiver of the user data. For example, the alarm can include an audio alarm and/or a visual alarm.

The user unit can also include a status sensor that is communicatively coupled to the user processor and that provides a status output. The user processor can be adapted to format the status output for communication from the user unit to the monitoring system via the satellite network. For example, the status sensor can include a motion sensor and/or an accelerometer.

The user unit can also include an output device and the monitor unit can also include an input device. The first satellite communication system can include a user transmitter and a user receiver, and the second satellite communication system can include a monitor transmitter and a monitor receiver. The monitor input device can be adapted to receive textual data entered by the observer at the monitor input device. For example, the monitor input device can be a keypad.

The monitor input device can be adapted to receive voice input from an observer. In addition, the monitor processor can be adapted to convert the voice input to text. The monitoring system can also include a memory device in communication with the monitor processor, and the monitor input device can include an actuator that when selected accesses message data stored in the memory device. Selection of the actuator can cause the message data to be transmitted by the monitor satellite communication system to the user communication system via the satellite network. The message data can include a plurality of instances of message data, and each data instance can be stored in a respective selectable portion of the memory device. The monitor input device can include a selection device that is adapted to access a selected message data instance, and the selected message data instance can be transmitted by the user satellite communication system on selection of the actuator. The selection device can be, for example, a scrolling device.

The user output device can be adapted to display textual messages and/or audio messages. The user output device can include an alarm, such as an audio alarm and/or a visual alarm.

The monitoring system can be adapted to receive information from an information source, via the satellite network or some other channel. For example, the information can be news information, and can include weather advisories. The monitoring system can also include database memory, which can store information such as news information, weather information, and rescue information.

The monitoring system can also include a server, such as a data mining server, which can be adapted to search for and collect travel-related information, via the Internet or over some other channel. The travel-related information can include traveler information, travel advisory information, weather advisory information, and/or rescue authority information. The server can be adapted to organize the collected information according to geographical location. The server can provide the information to the monitoring satellite communication system, and the monitoring satellite communication system can transmit the information to the user satellite communication system via the satellite network. The monitoring satellite communication system can transmit the information to the user satellite communication system according to a timing sequence. For example, the timing sequence can be periodic. Alternatively, the monitoring satellite communication system can transmit the information to the user satellite communication system in response to the occurrence of an event. For example, the event can include an update to the information, or a manual transmission under the control of the observer. The event can also include an indication that the beacon crosses a geographic boundary. The user unit can include a GPS receiver or similar device to determine a geographical location of the user. Geographical data can be sent to the monitoring system for display on the output device, according to a timed sequence or whenever the user crosses a predetermined geographical boundary.

The user unit can include a satellite beacon that transmits a beacon signal according to a timed sequence, and the monitoring system can include a receiver that receives the beacon signal via the satellite network and provides an indication of the presence or absence of the beacon signal at the output device.

According to another aspect of the invention, a method of providing a travel service can include providing the user unit to a user, and monitoring the monitoring system. This method can also include receiving information from an information source at the monitoring system, and transmitting the information to the user unit.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. **1** is a block diagram of an exemplary emergency monitoring and reporting system according to the invention.

FIG. **2** is a rendering of an exemplary user unit, shown worn by a user.

FIG. **3** is a block diagram of an exemplary user unit.

FIG. **4** is a block diagram of an exemplary user unit.

FIG. **5** is a block diagram of an exemplary user unit.

FIG. **6** is a diagram of an exemplary output device.

FIG. **7** is a block diagram of an exemplary emergency monitoring and reporting system.

FIG. **8** is a block diagram of an exemplary monitoring system.

DETAILED DESCRIPTION OF THE INVENTION

In general, the invention is a simple text messaging device that utilizes commercial satellite infrastructure to send and receive short text messages in the event of an emergency. These messages indicate the nature of the emergency and the type of assistance that is required. A user unit carried by the traveler includes a simple text entry device such as a keyboard or touch screen, a display, a processor with onboard memory, and a satellite data modem with appropriate antenna. This text messaging device can be manually operated by the user initiating a message or automatically triggered by a sensor connected to the user unit via an electronic interface, or which is included in the user unit. Alerts at a monitor station can be caused by a user message received at the monitoring station, or by the absence of a message during a pre-arranged time window (dead man's switch).

As an alternative to text messaging, the user unit can include a series of keys that indicate pre-set conditions, so that a general category of the condition of the user is transmitted without the need to key in text. This single-key (or few-key) feature can be included in addition to the keyboard or other text entry device, so that a user can enter a detailed text message when able, and can send a general category message when unable to key text due to the severity of the user's condition, or can provide a first alert to be followed by a detailed message.

The monitoring system includes a computer that can communicate with the satellite system and a database of both rescue groups and news alerts such as dangerous weather conditions that are sent to remote travelers to help prevent an emergency situation from developing. The invention also includes monitoring of the beacons for alert conditions such as when a use pushes a panic button or if a sensor causes an alarm. The monitoring computer can also relay messages to designated recipients, such as emergency personnel.

As shown in FIG. **1**, an emergency monitoring and reporting system **1** according to the invention includes a user unit **2** and a monitoring system **3**. The user unit **2** includes an input device **4**, a satellite communication system **5**, and a processor **6** that is communicatively coupled to the input device **4** and the satellite communication system **5**. The monitoring system **3** includes a satellite communication system **7**, an output device **8**, and a processor **9** that is communicatively coupled to the satellite communication system **7** and the output device **8**. The system components are supplied with appropriate power, for example, by providing AC power to the monitoring system and a battery or fuel cell to the user unit. The user satellite communication system **5** and the monitoring satellite communication system **7** include all the hardware, firmware, and software necessary for mutual communication via a satellite network **10**, including a modem and antenna. Communicating via the satellite network **10**, the output device **8** at the monitoring system **3** can present information entered at the input device **4** of the user unit **2**, or information corresponding to an input action taken by the user, to an observer at the monitoring system **3**. The input device **4** receives user data from a user and the processor **6** formats the data for transmission by the satellite communication system **5** transmitter. The monitor processor **9** formats the user data received by the receiver of the monitor satellite communication system **7**, for presentation to the observer at the output device **8**. Optionally, the monitoring system can also include a relay transmitter, so that messages from the user can be relayed directly to response personnel. Preferably, the satellite network provides substantially global coverage, although in some applications more limited coverage is adequate.

As shown in FIG. **2**, the user unit **2** can be adapted to be coupled to or worn by a user **11**, through the use of a strap, a clip, a hook-and-loop fastener, or any other known removable fastening implement **12**. The fastening implement **12** can be used to attach the user unit **2** to the user **11**, such as by providing an armband to hold the user unit **2**, or to attach the user unit **2** to the user's clothing or other equipment, such as by providing an belt clip or pocket clip for holding the user unit **2**. If the particular embodiment of the user unit **2** is small enough, it can be strapped to the user's wrist, much like a wristwatch. Larger user units can be worn much like a PDA, cell phone, or pager, using a similar clip-on holder. Alterna-

tively, the user unit **2** can be carried by the user, for example, in a pocket, backpack, or briefcase.

The input device **4** can be any device that can accept an input entered by the user that can be processed by the user unit **2**. This input can be textual, audible, or any other type of communication. For example, the input device **4** can be a keypad **13** or a microphone **14**, or can include both a keypad **13** and a microphone **14**, as shown in FIG. **3**. If the input device **4** accepts a voice input, the message can be transmitted as a voice signal, or certain embodiments can include voice-to-text software so that the processor **6** can convert the voice input to text prior to transmission by the satellite communication system **5**. Other types of input devices, such as touch screens and pressure sensitive writing tablets can be used with the system **1**. Such an input device allows the user to compose a message that is particular to the situation being experience. Preferably, each transmission of a message by the user will include a header or other field that includes a user identifier, such as an ID number, for embodiments in which the system **1** is monitoring more than one user unit **2**. This user identifier is presented at the output device **8** along with the message.

The user unit **2** can also be used to transmit a pre-recorded message that is appropriate for the user's situation. For example, as shown in FIG. **4**, a memory device **15** in communication with the processor **6** can store the message, such as "MEDICAL EMERGENCY". The input device **4** according to this embodiment includes an actuator **16**, such as a switch that when depressed accesses the message data stored in the memory device **15**. Depression of the actuator **16** causes the accessed message data to be transmitted by the satellite communication system **5** so that the prerecorded message can be read at the monitoring station. This feature can be provided instead of the message composition feature, or in addition, so that a quick alert can be sent, to be followed by a detailed message.

The input device **4** can also include an image capturing device, such as a still camera or video camera, in which case the output device **8** includes a monitor for displaying sent images. Such images can be useful to the observer or to response personnel in, for example, evaluating a medical condition or helping to direct a lost traveler.

In some embodiments of the invention, the memory device **15** stores a number of different messages, and the input device **4** includes a selection device **17**, such as a scrolling device, multiple key device, or touch-sensitive screen, that the user can utilize to select an appropriate message. These prerecorded messages can correspond, for example, to categories of alerts, the sending of one of which will be followed by a detailed message. The selected message is then transmitted by the satellite communication system **5** on depression of the actuation device **16**, which can be a separate device or which can be integrated into the selection device **17**.

Particular embodiments of the user unit **2** also include a status sensor **18** that is communicatively coupled to the processor **6**, as shown in FIG. **5**. The status sensor **18** determines the presence or absence of a status parameter, and/or a value of that parameter, and provides a status output **19** to the processor **6**. The processor **6** formats the status output **19** for transmission by the satellite communication system **5**, so that an observer receiving the user information at the monitoring system **3** has an indication of the parameter value. Different sensors can be used, alone or in combination, depending on the status parameters of interest. For example, the status sensor **18** can include a motion sensor, so that a lack of motion can be observed at the monitoring system, possibly indicating a problem by indicating the presence or absence of the motion parameter. The status sensor **18** can include an accelerometer, instead of or in addition to the motion sensor or other status sensor, which might indicate a fall if the accelerometer detects motion exceeding a predetermined acceleration threshold as the parameter value. The sensor can also sense and indicate biological information such as heart rate and body temperature, to be used by remote medical personnel so that a medical emergency can be analyzed even before personnel reach the user.

The output device **8** displays textual messages and/or audio messages, corresponding to the format of the message sent by the user unit **2**. As shown in FIG. **6**, an exemplary embodiment of the output device **8** includes a text display **20** for displaying textual messages, such as an LCD display, and audio speakers **21** for providing voice messages or audio alarms. The output device can also indicate a visual alarm by flashing the text display **20**, or by flashing a dedicated visual alarm indicator **22**, such as an LED. The alarm can indicate that there is an incoming message, or that the category of message is an emergency alert. In either case, the alarm might be followed by a detailed message, if the user is able to compose and send one. The output device can be a portable device that communicates wirelessly with the rest of the monitoring system, to provide mobility for the observer while maintaining continuous contact with the user.

As shown in FIG. **7**, certain embodiments of the invention provide for two-way communication between the user unit **2** and the monitoring system **3**. As in the embodiment shown in FIG. **1**, the system **1** includes a user unit **2** and a monitoring unit **3**. The user unit **2** includes an input device **4**, a satellite communication system **5**, and a processor **6** communicatively coupled to the input device **4** and the satellite communication system **5**, as well as an output device **23** at which messages from the monitoring system **3** are provided for the user. Likewise, the monitoring system **3** includes a satellite communication system **7**, an output device **8**, and a processor **9** communicatively coupled to the satellite communication system **7** and the output device **8**, as well as an input device **24** by which messages and/or information are provided, to be transmitted to the user. In this embodiment, each satellite communication system **5**, **7** includes both a transmitter and a receiver, to enable two-way communication. This embodiment of the system **1** allows an observer at the monitoring system **3** to reply to a user, in order to acknowledge that the user's message has been received, to request additional information, or for any other purpose. The user unit output device **23** includes any or all of the features of the monitoring system output device **8**, and the monitoring system input device **24** includes any or all of the features of the user unit input device **4**, as described above.

As shown in FIG. **8**, certain embodiments of the monitoring system **3** receives information from an information source **25**. This information can be received at the satellite communication system **7**, via the satellite network **10**, or it can be provided via some other channel, such as over a cable link **26**. This information can be news information, such as weather advisories, rescue information, or other information that is useful to travelers, outdoorsmen, or anyone else using the system **1**. The monitoring system **3** can also include database memory **27**, which can store the received information and data, messages, or annotations entered by the observer at the input device **24**. The database memory can store other information as well, such as medical emergency information or user information manually entered by the observer at the input device.

As shown in FIG. **8**, certain embodiments of the monitoring system also include a server **28**, such as a data mining server, which searches for and collects travel-related infor-

mation or other information that would be useful to the user. For example, the server can tap into news agency information available via the satellite network **10**, or can subscribe to a cable news service, or can search for relevant information via the Internet. The travel-related information can include traveler information, travel advisory information, weather advisory information, and/or rescue authority information, which will be of use to the observer at the monitoring system **3** in determining risks and other factors associated with the user, as well as general geographic information that can be sent to lost travelers. The server, under the control of the processor **9** or its own internal processor, can sort and organize the collected information according to geographical location or any other category specified by the observer at the observer's discretion or the user's request.

The monitoring system **3** transmits the information gathered by the server **28**, preferably after storage in the database memory **27**, to the user unit **2** via the satellite network **10**. The observer can parse the information, either automatically according to the categorization criteria or manually, to transmit information that is particularly relevant to the user. This information is then "pushed" to the user. The information can be transmitted to the user according to a timing sequence, such as periodically, in response to the occurrence of an event, or at the discretion of the observer. For example, the information can be transmitted at the top of every hour, every time relevant information is updated at the monitoring system **3**, in response to a request by the user, or on detection of a change in status of the user.

The user unit **2** can include a satellite beacon that transmits a beacon signal according to a timed sequence, such as periodically, and the monitoring system **3** can include a receiver that receives the beacon signal via the satellite network **10** and provides an indication of the presence or absence of the beacon signal at the output device **8**. The beacon signal can also carry an identification field, so that a number of users can be tracked individually at the monitoring system **3**. In the embodiments shown herein, it is assumed that the beacon can be provided using the hardware that has already been described. That is, the processor **6** can be used to generate pulses or other signals necessary to transmit the satellite beacon signal from the satellite communication system **5**, and the monitor processor **9** can recognize this beacon signal after reception by the satellite communication system **7** and can process the signal for presentation at the output device **8**, which can include a dedicated beacon field or which can transparently monitor beacon signals and only display user IDs for beacons that are not detected. It is contemplated, however, that the system **1** can include dedicated circuitry to provide, detect, and present an indication of the beacon signal. The beacon can be linked to a GPS system, so that the location of the user can be tracked as his or her presence is monitored.

It is also contemplated that the system of the invention can be provided as a travel service, by providing the user unit to a user, such as a traveler, particularly to a traveler in an outdoor or remote setting, and monitoring the monitoring system for the user and possibly other users as well. The user unit can be rented to users, who will be charged for use of the unit and/or the service of monitoring the user. Alternatively, the user unit can be sold, with different models including different features as described herein. The user can then purchase connection time with the monitoring system, either on a continuous basis or for particular periods during which the system will be used. Monitoring personnel at the monitoring system would then watch for messages from the user, "push" appropriate information to the user, and take action if necessary.

We claim:

1. An emergency monitoring and reporting system, comprising:

a user unit; and

a monitoring system;

wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system;

wherein the monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device;

wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present information to an observer, wherein the information corresponds to information entered at the input device; and

wherein the input device includes a text entry device adapted to receive textual data entered by a user.

2. The system of claim **1**, wherein the user unit is adapted to be coupled to a user.

3. The system of claim **1**, wherein the input device is adapted to receive voice input from a user.

4. The system of claim **3**, wherein the user processor is adapted to convert the voice input to text.

5. The system of claim **1**, wherein the user unit further includes a memory device in communication with the user processor, and the input device includes an actuator that when selected accesses message data stored in the memory device.

6. The system of claim **5**, wherein selection of the actuator causes the accessed message data to be transmitted by the user satellite communication system to the monitor communication system via the satellite network.

7. The system of claim **6**, wherein the message data includes a plurality of instances of message data, wherein each data instance of said plurality of data instances is stored in a respective selectable portion of the memory device.

8. The system of claim **7**, wherein the input device includes a selection device that is adapted to select one message data instance from among the plurality of data instances, wherein the selected one message data instance is transmitted by the user satellite communication system on selection of the actuation device.

9. The system of claim **8**, wherein the selection device is a scrolling device.

10. The system of claim **1**, wherein the user satellite communication system includes a transmitter, and wherein the input device is adapted to receive user data from a user and the user processor is adapted to format the data for transmission by the transmitter.

11. The system of claim **10**, wherein the monitor satellite communication system includes a receiver that is adapted to receive transmissions from the transmitter via the satellite network, and wherein the monitor processor is adapted to format the user data received by the receiver for presentation to the observer on the output device.

12. The system of claim **11**, wherein the output device is adapted to display textual messages.

13. The system of claim **11**, wherein the output device is adapted to play audio messages.

14. The system of claim **11**, wherein the output device includes an alarm that is actuated on receipt of the user data by the receiver of the user data.

15. The system of claim 14, wherein the alarm includes an audio alarm.

16. The system of claim 14, wherein the alarm includes a visual alarm.

17. The system of claim 1, wherein the user unit further includes a status sensor that is communicatively coupled to the user processor and that provides a status output, wherein the user processor is adapted to format the status output for communication from the user unit to the monitoring system via the satellite network.

18. The system of claim 17, wherein the status sensor includes at least one of a motion sensor and an accelerometer

19. The system of claim 1, wherein

the input device is a user input device,

the output device is a monitor output device,

the user unit further includes a user output device,

the monitor unit includes a monitor input device,

the first satellite communication system includes a user transmitter and a user receiver, and

the second satellite communication system includes a monitor transmitter and a monitor receiver.

20. The system of claim 19, wherein the monitor input device is adapted to receive textual data entered by the observer at the monitor input device.

21. The system of claim 20, wherein the monitor input device is a keypad.

22. The system of claim 19, wherein the monitor input device is adapted to receive voice input from an observer.

23. The system of claim 22, wherein the monitor processor is adapted to convert the voice input to text.

24. The system of claim 19, wherein the monitoring system further includes a memory device in communication with the monitor processor, and the monitor input device includes an actuator that when selected accesses message data stored in the memory device.

25. The system of claim 24, wherein selection of the actuator causes the message data to be transmitted by the monitor satellite communication system to the user communication system via the satellite network.

26. The system of claim 25, wherein the message data includes a plurality of instances of message data, wherein each data instance of said plurality of data instances is stored in a respective selectable portion of the memory device.

27. The system of claim 26, wherein the monitor input device includes a selection device that is adapted to access a selected one message data instance from among the plurality of data instances, wherein the selected one message data instance is transmitted by the user satellite communication system on selection of the actuation device.

28. The system of claim 27, wherein the selection device is a scrolling device.

29. The system of claim 19, wherein the user output device is adapted to display textual messages.

30. The system of claim 29, wherein the user output device is adapted to play audio messages.

31. The system of claim 29, wherein the user output device includes an alarm.

32. The system of claim 31, wherein the alarm is an audio alarm.

33. The system of claim 31, wherein the alarm is a visual alarm.

34. The system of claim 1, wherein the satellite network provide substantially global coverage.

35. A method of providing a travel service, comprising:

providing the user unit of claim 1 to a user; and

monitoring the monitoring system of claim 1.

36. An emergency monitoring and reporting system, comprising:

a user unit; and

a monitoring system;

wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication system;

wherein the monitoring system includes a monitoring satellite communication system, an output device, and a monitoring processor communicatively coupled to the monitoring satellite communication system and the output device;

wherein the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network such that the output device can present user information to an observer, wherein the user information corresponds to information entered at the input device; and

wherein the monitoring system is adapted to receive external information from an information source via the satellite network and to provide at least a portion of the external information to the user unit, wherein the at least a portion of the external information is particularly relevant to a geographical location of a user corresponding to the user unit.

37. The system of claim 36, wherein the information is news information.

38. The system of claim 37, wherein the news information includes weather advisories.

39. The system of claim 36, wherein the monitoring system further includes database memory.

40. The system of claim 39, wherein the database memory stores news information.

41. The system of claim 39, wherein the database memory stores weather information:

42. The system of claim 39, wherein the database memory stores rescue information.

43. The system of claim 36, wherein the monitoring system further includes a server.

44. The system of claim 43, wherein the server is a data mining server.

45. The system of claim 44, wherein the data mining server is adapted to search for and collect travel-related information.

46. The system of claim 45, wherein the data mining server is adapted to search for information via the Internet.

47. The system of claim 45, wherein the travel-related information includes at least one of traveler information, travel advisory information, weather advisory information, and rescue authority information.

48. The system of claim 47, wherein the server is adapted to organize the collected information according to geographical location.

49. The system of claim 45, wherein the server provides the information to the monitoring satellite communication system, and the monitoring satellite communication system transmits the information to the user satellite communication system via the satellite network.

50. The system of claim 49, wherein the monitoring satellite communication system transmits the information to the user satellite communication system according to a timing sequence.

51. The system of claim 50, wherein the timing sequence is periodic.

52. The system of claim 50, wherein the monitoring satellite communication system transmits the information to the user satellite communication system in response to the occurrence of an event.

53. The system of claim 52, wherein the user unit includes a satellite beacon that transmits a beacon signal according to a time sequence, and the monitoring system includes a receiver that receives the beacon signal via the satellite network and provides an indication of at least one of the presence and absence of the beacon signal at the output device.

54. The system of claim 53, wherein the event includes at least one of an update to the information, under the control of the observer, and when the beacon crosses a predetermined geographical boundary.

55. A method of providing a travel service, comprising:

providing the user unit of claim 49 to a user;

monitoring the monitoring system of claim 49; and

transmitting the information to the user satellite communication system via the satellite network.

* * * * *

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on March 9, 2015, I electronically filed the foregoing with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered CM/ECF users.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be deposited with United Parcel Service for delivery to the Clerk, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 717 Madison Place, N.W., Washington, D.C. 20439.

The necessary filing and service were performed in accordance with the instructions given to me by counsel in this case.

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Dated: March 9, 2015

/s/ John R. Fuisz
John R. Fuisz

Counsel for Appellant