15–1169, –1241

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–LMB-TRJ, Judge Leonie M. Brinkema

APPELLEES' BRIEF

Peter J. Brann
David Swetnam–Burland
Stacy O. Stitham
BRANN & ISAACSON
184 Main St., P.O. Box 3070
Lewiston, Maine 04243–3070
(207) 786–3566

Attorneys for Appellees

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, counsel for Appellees DeLorme Publishing Company, Inc. and DeLorme inReach LLC certifies the following:

1. The full name of every party represented by undersigned counsel:

   DeLorme Publishing Company, Inc.
   DeLorme inReach LLC

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 undersigned counsel:

   Not applicable.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by undersigned counsel:

   DeLorme inReach LLC is a wholly–owned subsidiary of DeLorme Publishing Company, Inc.

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

   Peter J. Brann
   David Swetnam–Burland
   Stacy O. Stitham
   BRANN & ISAACSON

   Edward A. Pennington
   John P. Moy
   Sean T.C. Phelan
   Jennifer L. Feldman
   SMITH, GAMBRELL & RUSSELL, LLP

Dated: May 11, 2015

/s/ Peter J. Brann
Peter J. Brann

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STATEMENT OF RELATED CASES

No appeal from the same civil action was previously before this or any other appellate court.

Plaintiffs–Appellees DeLorme Publishing Company, Inc. and DeLorme inReach LLC (collectively, "DeLorme") have appealed to this Court the determination of the International Trade Commission ("ITC" or "Commission") that DeLorme violated an ITC Consent Order by using certain imported, non–infringing, components in the domestic manufacture of its inReach devices. *DeLorme Publishing Co. v. ITC*, 2014–1572. The Commission concluded that DeLorme induced infringement of claims 1 and 2 of U.S. Patent No. 7,991,380 (the "'380 Patent" or "asserted patent"), the patent invalidated by the judgment at issue in this appeal. Although the same patent is involved, the parties and the issues are different, and BriarTek's motion to intervene in the ITC appeal was denied.

STATEMENT OF JURISDICTION

The underlying action was filed under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202, and arises under the Patent Laws of the United States, 35 U.S.C. § 1, *et seq*. The district court had jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, 2202. DeLorme addresses below the argument of Defendant–Appellant BriarTek IP, Inc. ("BriarTek") that the district court lacked jurisdiction over DeLorme's declaratory judgment action.

On November 19, 2014, the district court (Brinkema, J.) issued a 44–page Memorandum Opinion and an Order granting DeLorme's motion for summary judgment of invalidity, and entered final judgment in favor of DeLorme. A16–A61. On December 19, 2014, the district court entered an order awarding DeLorme its costs and staying their execution pending appeal. A10–15. BriarTek appealed both orders within 30 days, A4837, and thus this Court has appellate jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

STATEMENT OF ISSUES

1. Did the district court have jurisdiction over DeLorme's declaratory judgment action concerning invalidity and non–infringement of the '380 Patent after BriarTek filed two ITC complaints accusing DeLorme of infringement?

2. Did the district court act correctly conclude after several rounds of filings that it could rule on summary judgment?

3. Did the district court correctly conclude that the '380 Patent is invalid on multiple grounds?

4. Did the district court act within its discretion in awarding DeLorme costs incurred in discovery in the ITC proceedings after the district court ordered that discovery from the ITC proceedings be used in that court?

STATEMENT OF THE CASE

Nature of the Case. After BriarTek filed not one, but two, ITC complaints accusing DeLorme of infringing certain claims of the ’380 Patent, DeLorme filed a declaratory judgment action to establish once and for all that the claims of the ’380 Patent are invalid and that DeLorme had not infringed those claims. At the close of discovery, DeLorme filed a motion for summary judgment of invalidity, arguing that the claims of the ’380 Patent are invalid on numerous grounds, including anticipation, obviousness, and lack of patentable subject matter. A485–87. After multiple rounds of briefing to address issues raised by BriarTek, and after oral argument, the Court granted DeLorme’s motion, concluding that the asserted claims were invalid on the grounds of anticipation and obviousness. A16–A61. The court did not reach the other grounds of invalidity asserted by DeLorme. A58 & n.18. The court then awarded DeLorme its costs as the prevailing party. A10–15.

Procedural History. In order to put the dispute between the parties into context, we begin with a thumbnail history of the ITC proceedings filed by BriarTek against DeLorme. Those proceedings illustrate how BriarTek aggressively and repeatedly asserted the ’380 Patent against DeLorme; explain why DeLorme saw the need to file a declaratory judgment action to challenge the validity of the ’380 Patent; and establish how fact and expert discovery conducted

in the ITC proceedings were used by the parties in this action by direct order of the trial court.

Original ITC Investigation. On August 17, 2012, BriarTek filed a complaint with the ITC alleging that DeLorme was violating 19 U.S.C. § 1337 by importing into the United States and selling after importation certain two–way satellite communication devices, systems, and components thereof—specifically, inReach devices—that BriarTek asserted infringed certain claims of the '380 Patent. A175–209. On September 17, 2012, the ITC instituted an investigation. A150–51.

In the course of discovery in that investigation, DeLorme and BriarTek served technical expert reports on invalidity and non–infringement, which later became part of the summary judgment record by order of the trial court. *See* A3034–3107 (William Zancho expert report on behalf of DeLorme); A3108–3373 (Paul Steffes expert report on behalf of BriarTek); A3374–3470 (Zancho rebuttal expert report); A3471–92 (Steffes rebuttal expert report).

The investigation ended with the entry of a Consent Order between DeLorme and the ITC, which the Commission entered at DeLorme's request over BriarTek's objections. A153, A155–71. DeLorme agreed to the Consent Order because it had implemented a pre–existing plan to manufacture inReach devices in

the United States, and so was no longer importing the only "components" or "devices" accused of infringement by BriarTek in its ITC complaint. A100.

DeLorme specifically stated that it was entering the Consent Order "for settlement purposes only," and denied having committed any unfair act, including the importation or sale after importation of imported, infringing devices. A165 ¶ 8. DeLorme further stipulated that the Consent Order would "not apply with respect to any claim of any intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction, providing that such finding or judgment has become final and non–reviewable." A165 ¶ 6. Although BriarTek broadly asserts that DeLorme agreed in the Consent Order "[n]ot to challenge validity of the '380 Patent," Appellant's Brief at 17 (brackets added), that is incorrect—DeLorme agreed in the Consent Order only that it would "not seek to challenge the validity or enforceability of the '380 Patent *in any administrative or judicial proceeding to enforce the Consent Order*." A165 ¶ 7 (emphasis added).

ITC Enforcement Action. On April 10, 2013, only five days after the effective date of the Consent Order, BriarTek filed a second complaint in the ITC, this time seeking enforcement of the Consent Order on the ground that DeLorme was infringing the same claims of the '380 Patent asserted in the original ITC

investigation. A1841–42. The ITC initiated an enforcement proceeding on May 20, 2013. *Id*.

DeLorme's Declaratory Judgment Action. With BriarTek's filing of the enforcement complaint, BriarTek was again asserting the '380 Patent against DeLorme. So, on May 28, 2013, DeLorme filed a declaratory judgment action against BriarTek seeking a judgment that the '380 Patent was invalid, and alternatively, that DeLorme did not infringe any valid claim of the patent. A98–120.

BriarTek moved to dismiss the complaint for lack of jurisdiction. A121–246. After hearing, the district court summarily denied the motion to dismiss. A62. In the order denying the motion to dismiss, the court also "ORDERED that the parties are required to make use of all fact and expert discovery developed in proceedings before the U.S. International Trade Commission in this action." *Id*. BriarTek then asserted counterclaims against DeLorme, claiming that DeLorme infringed certain claims of the '380 Patent, and seeking damages and an injunction. A368–81.

In the ITC enforcement proceedings, the parties conducted third–party discovery relating to the prior art that ultimately was used to invalidate the '380 Patent in federal court. A404–405, A1196, A1198, A2929–39. Also, in the ITC enforcement proceeding, the parties submitted four additional non–infringement reports. A3493–3614 (Zancho expert report); A3615–3799 (Steffes expert report);

A3804–3922 (Zancho rebuttal expert report); A3923–30 (Steffes rebuttal expert report). In the federal court action, the parties exchanged five more expert reports on invalidity and non–infringement. A3931–4022 (Zancho expert report); A4023–4221 (Steffes expert report); A4222–4331 (Zancho rebuttal expert report); A4332–4420 (Steffes rebuttal expert report); A4421–43 (Zancho reply expert report).

As directed by the district court, *see* A1678–79, immediately after the close of discovery, and one day before the pre–trial conference, DeLorme filed its motion for summary judgment of invalidity, supporting brief, and evidence. A485–1167, A2917–39. In its summary judgment motion, DeLorme argued that the asserted claims of the ’380 Patent were anticipated by three prior art references not presented to the examiner: (1) a 1995 article, entitled “ORBCOMM PCS AVAILABLE Now!” (“ORBCOMM”) (A879–83); (2) a 2003 patent application published as U.S. Patent Application Pub. No. 2004/0111195 (“de Vries”) (A890–912); and (3) the user’s guide to the Iridium Satellite Series portable handset (“Motorola Manual”) (A930–1157). A501–12. DeLorme further argued that the asserted claims were obvious in light of ORBCOMM, de Vries, the Motorola Manual, and a reference that had been before the examiner, U.S. Patent Application Pub. No. 2006/007038 (“Boling”) (A753–66). A512–14. Additionally, DeLorme argued that the ’380 Patent’s claims lacked adequate written description, were not directed at patentable subject matter, and were indefinite. A514–22. In

support of this motion, DeLorme submitted the file history of the ’380 Patent, the asserted prior art, depositions from the ITC and the district court of individuals or corporations relating to the asserted prior art, a declaration from DeLorme’s expert, William Zancho, and excerpts from the deposition of BriarTek’s expert, Paul Steffes. A534–1167.

In colloquy at the pre–trial conference, BriarTek argued that the district court should defer briefing and argument on DeLorme’s summary judgment motion because the court had not conducted formal claim construction and because claim construction in the ITC enforcement proceeding might impact the court’s consideration of DeLorme’s motion. A1687–1701. DeLorme took the position then, and now, that claim construction did not affect invalidity—the ’380 Patent was invalid under any construction, and thus claim construction was unnecessary. In a written order issued on November 27, 2013, a week after the final pre–trial conference, the court gave BriarTek the opportunity to explain the need for claim construction to decide DeLorme’s motion. A1702–1703.

> The Court has reviewed [DeLorme’s] motion for summary judgment and the memorandum and exhibits submitted in support, as well as the ITC documents submitted by [BriarTek]. From that review, it does not appear that claim construction will be needed to determine whether [BriarTek’s] patent is invalid in light of undisclosed prior art; however, [BriarTek] will be permitted to explain exactly why claim construction is needed.

A1703 (brackets added). The Court directed BriarTek to file a brief setting out its "position as to which specific claims, if any, require construction in order to dispose of [DeLorme's] motion and whether those claims are explicitly at issue in the ITC proceeding." *Id.* (brackets added). BriarTek did so, A1719–1949, and DeLorme filed a response. A1950–2021.

On January 16, 2014, having reviewed the parties' responses, the Court "determined that claim construction will not be needed to determine whether defendants' patent is invalid in light of undisclosed prior art." A2022–23. The court set a briefing schedule and hearing date for the summary judgment motion of February 21, 2014. *Id.*

In response, BriarTek filed a motion to strike facts and evidence supporting DeLorme's summary judgment motion. A2024–2122. Of the various arguments made in support of that motion, BriarTek has raised only one on appeal—whether the district court abused its discretion by refusing to strike almost the entire argument section of DeLorme's summary judgment brief for containing "attorney argument." *See* Appellant's Brief at 39–42. After briefing and argument, BriarTek's motion to strike was denied in its entirety for reasons stated in open court. A63 (order); A2904–13 (transcript).

The court heard oral argument on the summary judgment motion on February 21, 2014. In an order issued that day, the Court ordered the parties "to

serve and file supplemental briefs addressing claim construction directly relevant to the resolution of the issues already presented in [DeLorme's] Motion for Summary Judgment of Invalidity, [BriarTek's] opposition, and [DeLorme's] reply" and to "file complete copies of all their experts' reports." A2958 (brackets added).

On February 28, 2014, the parties jointly filed all 13 technical expert reports with the court. A3030–4443. On March 3, 2014, the parties submitted their respective briefs on claim construction issues "directly relevant to the resolution of the issues" presented in their earlier briefs in support of and opposition to DeLorme's summary judgment motion. A4444–89 (BriarTek's claim construction brief); A4490–4523 (DeLorme's claim construction brief).

On November 19, 2014, one day shy of a year after DeLorme filed its motion for summary judgment, the district court granted the motion in a 44–page Memorandum Opinion and Order, and entered final judgment in favor of DeLorme. A16–A61. For purposes of summary judgment, the court adopted BriarTek's claim constructions and adopted BriarTek's definition of a person of ordinary skill in the art. A28, 31–32. Having invalidated the '380 Patent on the grounds of anticipation and obviousness based on the three references not presented to the patent examiner, the court did not rely on a fourth reference discussed extensively by the parties, Boling, even though the court noted that it "overwhelmingly confirms the conclusion of invalidity" when considered with the

other three references, and the court did not address the other invalidity arguments asserted by DeLorme. A58 & n.18.

On December 1, 2014, DeLorme submitted its bill of costs. A4840–4953. BriarTek moved to stay consideration of the bill of costs, and, alternatively, opposed them on the grounds that DeLorme was not the prevailing party and that certain of the costs were not taxable. The court denied the motion to stay, and permitted additional briefing by BriarTek on the bill of costs. A5100. After briefing, on December 19, 2014, the court overruled BriarTek's objections, and awarded costs to DeLorme. A10–15. The awarded costs included the costs of discovery in the ITC proceedings that the court had ordered the parties to use in the district court action. A14–15. These timely appeals followed. A4837.

STATEMENT OF FACTS

The *relevant* material facts are set forth by the district court in the summary judgment opinion. Importantly, BriarTek does not dispute on appeal *any* of the facts found by the court in the summary judgment opinion, and does not dispute on appeal the authenticity of *any* of the prior art. Thus, rather than respond to BriarTek's characterizations of BriarTek, DeLorme, and the district court, we shall simply retrace the path taken by the district court.

"DeLorme and BriarTek, Inc. [(a related company to BriarTek IP, Inc.)] compete in the market for satellite–based emergency notification systems." A16 (brackets added); *see* A370−375.

> 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 person.

A16. BriarTek's product is the Cerberus, and DeLorme's competing product is the inReach, which is sold for a substantially lower price. A16–17; *see* A370, A374, A421.

The '380 Patent issued from U.S. Patent Application No. 11/693,434 (the "'434 Application"), which claimed a priority date of March 30, 2006. A18; *see* A65, A570, A581; *cf.* A3065, A3472−73, 3476 (both experts agree priority date immaterial for purposes of determining invalidity). Claim 1 of the '434 Application originally recited:

> 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;
>
> 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.

A18–19; *see* A559.

The U.S. Patent and Trademark Office ("PTO") initially rejected all proposed claims in the '434 Application as anticipated by Boling. A19; *see* A609–26. "The applicants then proposed claim amendments which they argued distinguished their invention from Boling." A19. "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.* (citing A767–94); *see* A783–84.

The PTO rejected the amended claims as obvious over Boling in light of U.S. Patent No. 5,914,675 ("Tognazzini") (A814–825). A19 (citing A795–825).

> 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."

A19 (quoting A830). "The USPTO later issued the '380 Patent." A19 (citing A855–63).

Thus, in 2011, BriarTek was awarded the '380 Patent for an invention entitled: "Global Bidirectional Locator Beacon and Emergency Communication System." A17; *see* A64–77 (patent). "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.'" A17 (quoting A72, 3:58–62). "Figure 1 of the '380 Patent shows the preferred embodiment of the invention:" A17.

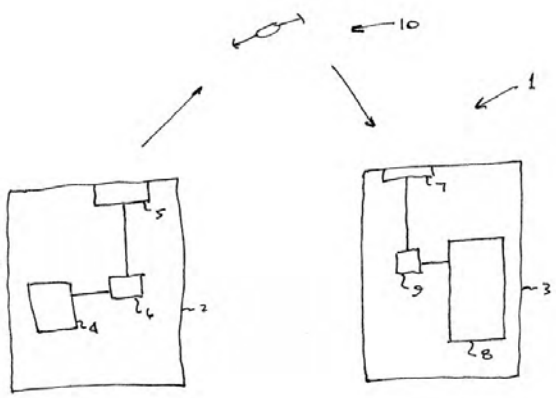


Fig. 1

"Figure 1 shows a user unit [2] in communication with a monitoring system [3] through a satellite network [10]." A17 (citing A72, 4:25–43).

"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,' the claims are not so limited.'" A20 (quoting A71, 1:22–23). "All of the asserted claims depend from or incorporate Claim 1, which recites" (A20):

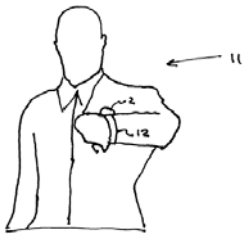
> 1. An emergency monitoring and reporting system, comprising:
>
> a user unit; and
>
> a monitoring system;
>
> wherein the user unit includes an input device, a user satellite communication system, and a user processor communicatively coupled to the input device and the user satellite communication 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.

A74, 8:2–23.

"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]).” A20 (citing A74, 8:2–23). “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.” A20 (citing A872–74 (BriarTek’s expert deposition)).

“BriarTek alleges that Delorme infringes claims 1, 2, 5–12, 17, 34, and 35 of the ’380 Patent [(the ‘asserted claims’)].” A20 (brackets added). As shown in the following chart, each of the asserted dependent claims adds various elements to the system disclosed by claim 1.

Claim 2	“The system of claim 1, wherein the user unit is adapted to be coupled to a user.” Figure 2, reproduced here, shows a user [11] wearing the user unit [2] as one would a wrist–watch [12]:  A67, Fig. 2.
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."

A67, A74–75. The district court found that each of these claims was invalid on multiple grounds. Against this backdrop, we turn to that conclusion.

SUMMARY OF ARGUMENT

BriarTek's approach to this appeal, and indeed, to this entire litigation may be succinctly summarized—no court should ever reach the merits of DeLorme's contention that the '380 Patent is invalid on numerous grounds. According to BriarTek, the district court should not have entertained DeLorme's declaratory judgment action. The court should not have read the argument portion of DeLorme's summary judgment brief because it contained "attorney argument." The court should not have decided the summary judgment motion without conducting claim construction. The court should not have reached its own conclusions on anticipation and obviousness in invalidating the '380 Patent. And the court should not have considered or awarded DeLorme its costs after granting final judgment in favor of DeLorme. Once these procedural roadblocks are brushed aside, it becomes evident that BriarTek does not seriously challenge the correctness of the district court's invalidation of the '380 Patent on the merits.

The district court had jurisdiction to consider DeLorme's declaratory judgment action—BriarTek twice filed complaints with the ITC alleging that

DeLorme was infringing the ’380 Patent. This litigious conduct certainly constitutes a substantial controversy between parties having adverse legal interests of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. BriarTek cannot point to any case in which any court concluded it lacked declaratory judgment jurisdiction after a party filed one, much less two, formal complaints alleging infringement, and continued to assert up until the moment that the patent was invalidated that the other party was infringing its patent.

The district court did not abuse its discretion in denying BriarTek’s motion to strike almost all of the argument in DeLorme’s brief on the grounds that it was “attorney argument.” BriarTek no longer contests the authenticity or validity of any of the prior art used to invalidate the ’380 Patent, and thus its argument reduces to the proposition that an attorney who is a layman should not be permitted to argue in a summary judgment brief what the uncontested evidence shows. To describe that argument is to refute it.

The district court did not err in invalidating the ’380 Patent without conducting full–blown claim construction. Indeed, since the court adopted BriarTek’s constructions and its definition of a person of ordinary skill in the art, BriarTek can scarcely complain. Moreover, BriarTek does not—and cannot—explain why this kerfuffle makes any difference whatsoever because the trial court

allowed the parties separately to brief claim construction issues before ruling on DeLorme's motion, and because no one disputes that claim construction is immaterial to the conclusion that the '380 Patent is invalid.

The district court properly invalidated the '380 Patent on the grounds of anticipation and obviousness based on three pieces of prior art that were not before the patent examiner. This was not a baseball arbitration in which the court had to choose between two alternatives, *i.e.*, DeLorme's entire argument or BriarTek's entire argument. The court could, and did, reach its own conclusions on anticipation and obviousness. Additionally, this Court could affirm invalidation of the '380 Patent on alternative grounds raised below, namely, obviousness in light of Boling in addition to the three references relied upon by the district court, and patent–ineligible subject matter.

Finally, the district court did not abuse its discretion in awarding DeLorme its costs, including discovery costs incurred in the ITC proceedings that the district court ordered be used in the federal court proceedings. Those discovery materials were put to good use—DeLorme relied upon them to invalidate the '380 Patent. BriarTek likewise relied upon ITC discovery materials in the federal court proceeding—most of its opposition to the summary judgment motion, and virtually every document identified on its trial exhibit list in the district court, came from ITC discovery materials.

ARGUMENT

I. THE DISTRICT COURT PROPERLY CONCLUDED THAT IT HAD DECLARATORY JUDGMENT JURISDICTION CONCERNING VALIDITY AND NON–INFRINGEMENT OF THE ’380 PATENT.

BriarTek contends that the district court lacked jurisdiction to entertain DeLorme’s declaratory judgment action asserting invalidity and non–infringement of the ’380 Patent. *See* Appellant’s Brief at 35–39. Not so.

Before turning to the substance of BriarTek’s argument, we note that BriarTek did not include the district court order denying its motion to dismiss in its notice of appeal. A4837. This Court, therefore, may not have jurisdiction to consider BriarTek’s argument. *See Minnesota Mining and Mfg. Co. v. Chemque, Inc*., 303 F.3d 1294, 1309 (Fed. Cir. 2002) (“even a liberal construction” of Fed. R. App. P. 3(c)(1)(B) “warrants finding that there is no jurisdiction since the notice of appeal … does not even mention validity issues”) (ellipsis added).

On the merits, BriarTek’s argument is easily dispatched. The district court has jurisdiction to declare the parties’ rights in any case of actual controversy. 28 U.S.C. § 2201(a).

> The burden is on the party claiming declaratory judgment jurisdiction … to establish that an Article III case or controversy existed at the time that the claim for declaratory relief was filed and that it has continued since.

Danisco U.S. Inc. v. Novozymes A/S, 744 F.3d 1325, 1329 (Fed. Cir. 2014) (ellipsis added and citations omitted).

> Basically, the question in each case 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, Inc. v. Genentech, Inc., 549 U.S. 118, 127 (2007) (quotation omitted).

"Although there is no bright–line rule applicable to patent cases, we have held that 'Article III jurisdiction may be met where the patentee takes a position that puts the declaratory judgment plaintiff in the position of either pursuing arguably illegal behavior or abandoning that which he claims a right to do.'" *Organic Seed Growers and Trade Ass'n v. Monsanto Co.*, 718 F.3d 1350, 1355 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 901 (2014) (quoting *SanDisk Corp. v. STMicroelectronics, Inc.*, 480 F.3d 1372, 1380–81 (Fed. Cir. 2007)). "A reasonable apprehension of suit is not necessary." *Organic Seed Growers*, 718 F.3d at 1355. Indeed, it is "not 'necessary that a patent holder make specific accusations' of infringement against the declaratory judgment plaintiff." *Id.* (quoting *Micron Tech., Inc. v. MOSAID Techs., Inc.*, 518 F.3d 897, 901 (Fed. Cir. 2008)).

> Article III does not mandate that the declaratory judgment defendant have threatened litigation or otherwise taken action to enforce its rights before a justiciable controversy can arise, and the Supreme Court has repeatedly found the existence of an actual case or controversy even in situations in which there was no indication that

> the declaratory judgment defendant was preparing to enforce its legal rights.

Danisco, 744 F.3d at 1330 (collecting cases). "The Court has instead only 'required that the dispute be definite and concrete, touching the legal relations of parties having adverse legal interests; and that it be real and substantial and admit of specific relief through a decree of a conclusive character….'" *Id*. (quoting *MedImmune*, 549 U.S. at 127) (other citation and brackets omitted; ellipsis added). At bottom, DeLorme faced the dilemma of abandoning its inReach device or "running the risk of being sued for infringement, which is precisely the type of situation that the Declaratory Judgment Act was intended to remedy." *Danisco*, 744 F.3d at 1332 (citing *MedImmune*, 549 U.S. at 129) (other citations omitted).

Here, BriarTek filed not one, but two, ITC complaints alleging that DeLorme was infringing the '380 Patent. This history of patent litigation properly could be considered in concluding that there was an actual controversy between the parties. "We see no reason why we should not similarly consider a pattern of administrative challenges in analyzing the totality of the circumstances." *Danisco*, 744 F.3d at 1331; *see also D2L Ltd. v. Blackboard, Inc.*, 671 F. Supp. 2d 768, 776 (D. Md. 2009) (considering cases filed in Texas, Canada and the ITC to find declaratory judgment jurisdiction). BriarTek cannot point to any case in which formal infringement complaints were filed, and a court then found that it lacked declaratory judgment jurisdiction.

BriarTek argues that DeLorme's lawsuit was an improper collateral attack on the ITC Consent Order. *See* Appellant's Brief at 35–37. DeLorme sought a declaration that it did not infringe the '380 Patent and that the '380 Patent is invalid, but DeLorme did not seek review of the Consent Order or anything else concerning the proceedings before the ITC.

The fact that the first ITC proceeding concluded in a Consent Order certainly did not end the controversy between DeLorme and BriarTek. Although the first ITC proceeding had terminated, the fact that BriarTek filed that action in 2012, alleging that DeLorme was infringing the '380 Patent well within the six–year statute of limitations for seeking damages for patent infringement in federal court, is relevant in determining that the district court had declaratory judgment jurisdiction. *Cf. Prasco, LLC v. Medicis Pharm. Corp.*, 537 F.3d 1329, 1341 (Fed. Cir. 2008) ("Prior litigious conduct is one circumstance to be considered in assessing whether the totality of circumstances creates an actual controversy.").

Furthermore, under the Consent Order, it would "not apply with respect to any claim of intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction, providing that such judgment has become final and non–reviewable." A165 ¶ 6. BriarTek is thus wrong when it asserts that DeLorme "disclaimed any action other than compliance with the Consent Order[.]"

Appellant's Brief at 36 (brackets added); *cf. MedImmune*, 549 U.S. at 135 ("Promising to pay royalties on patents that have not been held invalid does not amount to a promise *not to seek* a holding of their invalidity.") (emphasis in original).

Moreover, BriarTek filed a second ITC complaint in which it asserted that DeLorme was infringing the '380 Patent, and that complaint was pending at the time and well after DeLorme filed its declaratory judgment complaint. This certainly is not "analogous" (Appellant's Brief at 37) to *Already LLC v. Nike, Inc*., 133 S. Ct. 721 (2013). Suffice it to say, a complaint alleging infringement is not the same as a covenant not to sue. Also, given BriarTek's threat to "bankrupt" DeLorme through the second ITC proceeding before DeLorme could invalidate BriarTek's patent in federal court, A4548, there should be no doubt that a live controversy continued throughout the district court litigation between BriarTek and DeLorme.

Finally, BriarTek argues that its filing of the second ITC complaint was a "protected First Amendment communication" under the *Noerr–Pennington* doctrine. *See* Appellant's Brief at 38–39. *First*, this argument was not raised before the district court, and thus is waived. *See Stauffer v. Brooks Bros. Group, Inc.*, 758 F.3d 1314, 1322 (Fed. Cir. 2014). *Second*, BriarTek does not provide any "developed argument" concerning this new theory, and thus this argument is

doubly waived. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006). *Third*, the *Noerr–Pennington* doctrine is a defense to an antitrust claim, *see Tyco Healthcare Group LP v. Mutual Pharm. Co.*, 762 F.3d 1338, 1342 (Fed. Cir. 2014), and thus is irrelevant to the question whether there was a sufficiently live controversy between BriarTek and DeLorme to ground declaratory judgment jurisdiction over a patent dispute. The district court had jurisdiction over DeLorme's declaratory judgment action.

II. THE DISTRICT COURT PROPERLY GRANTED SUMMARY JUDGMENT OF INVALIDITY.

A. The District Court Did Not Abuse Its Discretion Or Err In Ruling On DeLorme's Summary Judgment Motion.

BriarTek principally objects to DeLorme's summary judgment motion on procedural grounds. Scattered throughout BriarTek's brief are variations on a theme that no court should ever answer the question whether the '380 Patent is valid. The court should have stricken the argument portion of DeLorme's summary judgment brief because it contained "attorney argument." The court should have conducted full–blown claim construction instead of adopting BriarTek's proposed constructions. The court should not have reached its own legal conclusions on anticipation and obviousness, but either adopted or rejected the parties' positions wholesale. The court should not have considered any of the expert reports that BriarTek claims contradicted the summary judgment evidence submitted by

DeLorme, all of which were subsequently submitted jointly by the parties as part of the supplemental briefing on the summary judgment motion. In fact, through multiple rounds of briefing, BriarTek received all of the process that it was due, and indeed, more process than almost anyone ever receives. Not only that, BriarTek cannot identify any way in which any of these purported procedural missteps affected or could have affected the outcome.

1. The District Court Did Not Abuse Its Discretion In Denying BriarTek's Motion To Strike "Attorney Argument" From DeLorme's Summary Judgment Brief.

BriarTek asserts that the district court abused its discretion in denying its motion to strike much of DeLorme's summary judgment brief on the grounds that it contained "attorney argument." *See* Appellant's Brief at 39–42. Neither common sense nor the cited authority supports this contention.

Before turning to BriarTek's contention on appeal, it is important to note that BriarTek no longer challenges any of the *evidence* cited by DeLorme to invalidate the '380 Patent. Thus, BriarTek is no longer contesting that ORBCOMM and the Motorola Manual are prior art, and BriarTek is no longer challenging the depositions that authenticated the ORBCOMM and Motorola Manual prior art. BriarTek likewise did not, and does not, contest the validity of the other prior art considered by the district court, namely, the Boling and de Vries references.

On appeal, BriarTek only challenges "attorney argument" in the summary judgment brief. Some of BriarTek's arguments on appeal have been waived because they were not raised below. *See Stauffer, Inc.*, 758 F.3d at 1322.

In the district court, BriarTek sought to exclude "attorney argument" only from the argument section of DeLorme's summary judgment brief, namely, pages 10–20 and 22–30 of the brief, which is almost the entire argument. A2040–41; *see* A502–12, A514–22 (challenged portions of brief). BriarTek did not challenge DeLorme's statement of material facts, A493–501, or any other portion of DeLorme's summary judgment filings on the grounds that they contained impermissible "attorney argument." *See* A2027–49 (BriarTek's motion to strike). Thus, BriarTek cannot challenge now on appeal as impermissible "attorney argument" the statement of material facts or the one page of the argument it failed to challenge below. *See* Appellant's Brief at 40 (new arguments challenging A493–98, A513).

This leaves BriarTek's motion to strike much of DeLorme's summary judgment argument below on the grounds that it was impermissible "attorney argument." *See* Appellant's Brief at 40–41 (challenging A502–12, A514). According to BriarTek, DeLorme's counsel cannot argue what the undisputed evidence shows because counsel is not an expert witness. *Id.* Coupled with BriarTek's further argument that the district court cannot reach any legal

conclusion not specifically argued by the parties, *see, e.g.*, Appellant's Brief at 58 ("The court's obviousness analysis was it's [*sic*] own and not based on the summary judgment motion"), this means that once DeLorme's argument "is stricken, there is nothing left of the actual motion[.]" Appellant's Brief at 42 (brackets added). In other words, DeLorme's counsel cannot argue the evidence, and without that argument, the court cannot rule on summary judgment.

Even BriarTek's cited authorities do not support this radical reimagining of the role of counsel in litigation. In *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1332 (Fed. Cir. 2009), this Court discounted a position that "is merely attorney argument *lacking evidentiary support*." (emphasis added). The point, of course, is not that attorneys cannot *argue* the evidence, but that their arguments cannot *substitute* for such evidence. Attorneys have argued the significance of evidence since the days of Hammurabi.

This conclusion is underscored by another case relied upon by BriarTek. In *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356 (Fed. Cir. 2008), after holding that the testimony of an unqualified patent attorney should have been excluded from evidence, this Court nonetheless concluded that even without expert testimony the asserted patent was invalid on the grounds of obviousness. *Id.* at 1365. In that case, Defendant's litigation counsel could, and did, argue to this Court that the patent–in–suit was invalid, even if Defendant's expert, a different

attorney, was unqualified to testify. Similarly, DeLorme's litigation counsel could, and did, argue what the undisputed evidence showed, and the district court could, and did, reach its own conclusions on the validity of the '380 Patent.

2. The District Court Did Not Err In Adopting BriarTek's Claim Constructions And BriarTek's Definition Of Person Of Ordinary Skill For Purposes Of Summary Judgment.

Claim Construction. BriarTek asserts that the district court erred in failing to conduct claim construction before resolving the summary judgment motion. *See* Appellant's Brief at 32, 42–45. BriarTek contends that it was error for the court to adopt BriarTek's proposed constructions. *Id*. The procedure employed by the court was entirely proper, and more importantly, BriarTek does not explain why it makes any difference whatsoever whether the court adopted BriarTek's proposed constructions, DeLorme's proposed constructions, or a different set of constructions altogether.

To set the stage, it bears repeating that BriarTek sought to defer a ruling on summary judgment until after the court conducted claim construction. A1687–1701. DeLorme has always taken the position that claim construction did not affect the invalidity analysis. The court gave BriarTek the opportunity to explain why claim construction was necessary. A1702–1703. Despite its initial conclusion that claim construction would not make any difference, A1703, the court nevertheless gave BriarTek two opportunities to offer its views on claim construction. A1719–

1949, A4444–89. After considering those submissions, in granting summary judgment, the district court noted:

> 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.

A27 (citing BriarTek's summary judgment brief). The court adopted for purposes of summary judgment BriarTek's constructions. *Id*.

BriarTek asserts that the district court erred by adopting BriarTek's proposed constructions for purposes of summary judgment instead of separately construing all disputed claim terms without regard to their relevance to the question of invalidity. *See* Appellant's Brief at 42–43. However, as the district court noted:

> 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," [*Ballard Med. Prods. v. Allegiance Healthcare Corp*., 268 F.3d 1352, 1358 (Fed. Cir. 2001)], as "the district court has considerable latitude in determining when to resolve issues of claim construction." *CytoLogix Corp. v. Jentana Med. Sys*., 424 F.3d 1168, 1172 (Fed. Cir. 2005).

A26 (brackets and ellipsis added by court). "When there is no dispute as to the meaning of a term that could affect the disputed issues in the litigation, 'construction' may not be necessary." *Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313, 1318–19 (Fed. Cir. 2007). "Accordingly, a district court may adopt the

non–moving party's claim construction for the purposes of evaluating a motion for summary judgment." A26 (citing *Teknowledge Corp. v. Cellco P'ship*, 626 F. Supp. 2d 1027, 1033 (N.D. Cal. 2009), *aff'd*, 374 Fed. Appx. 972 (Fed. Cir. May 6, 2010) (*per curiam*)); *see also GlaxoSmithKline LLC v. Banner Pharmacaps, Inc.*, 744 F.3d 725, 729–30 (Fed. Cir. 2014) ("[W]e affirm the district court's finding that 'solvate' is adequately described, without needing to choose between the offered constructions of 'solvate.'") (brackets added). Thus, BriarTek cannot complain about the district court adopting its constructions for purposes of summary judgment, particularly when it cannot explain why it makes any difference on invalidity.

BriarTek next asserts that the district court did not actually utilize its constructions because the court cited DeLorme's expert report in concluding that de Vries and ORBCOMM anticipated the '380 Patent, and thus must have applied DeLorme's constructions instead. *See* Appellant's Brief at 44–45. This misreads the report of DeLorme's expert, William Zancho. Zancho made it clear in his report that he reached the same conclusion of invalidity under either party's claim construction because any dispute over claim scope did not alter that conclusion. A3979−80, A3988, A4002, A4011. BriarTek does not disagree with Zancho on this point or explain why it makes a whit of difference which construction is used. *See* Appellant's Brief at 44–45.

Person Of Ordinary Skill In The Art. Likewise, BriarTek urged the district court to adopt a definition of person with ordinary skill in the art at the time of the invention. A2502, A2554, A4042−4043. Once again, as the court noted in granting summary judgment:

> BriarTek does not identify any issue in the instant motion where resolving the level of ordinary skill in the art makes a difference. 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.

A30–31 (citing BriarTek's summary judgment brief). The court then adopted for purposes of summary judgment BriarTek's proposed definition of the person of ordinary skill in the art. A31.

On appeal, BriarTek claims that DeLorme failed to meet its evidentiary burden by failing to submit evidence on the ordinary skill in the art. *See* Appellant's Brief at 48–49. This is inaccurate. In addition to his declaration submitted with DeLorme's summary judgment motion, A1161, DeLorme's expert stated his opinion on the person of ordinary skill in the art in expert reports filed in the ITC on March 1, March 15, July 29, and August 5, 2013, A3037−38, A3385−86, A3505, A3814−15, all of which were filed in the district court as part of the supplemental briefing on summary judgment. Additionally, he repeated his

opinion in an expert report filed in the district court dated October 1, 2013, A4234, and he expressed the further opinion in yet another expert report filed in the district court dated October 31, 2013, "that the asserted claims would be even more obvious" under BriarTek's definition. A4422−4423.

More importantly, BriarTek does not even acknowledge the district court's self–evident conclusion that BriarTek's proposed definition requiring more education and experience made it easier to invalidate the '380 Patent. And, most importantly, BriarTek does not argue that it makes any difference whatsoever. BriarTek cannot complain about the court adopting its own proposed definition of the ordinary skill in the art.

3. The District Court Did Not Err In Reaching Its Own Legal Conclusions Concerning Anticipation And Obviousness.

BriarTek repeatedly takes the district court to task for reaching its own conclusions concerning anticipation and obviousness. *See* Appellant's Brief at 45–47, 58–61, 63. "By creating its own claim charts," *id*. at 63, or by "creating its own anticipation and invalidity arguments," *id*., BriarTek contends that the district court overstepped its role. According to BriarTek, "[i]t is highly improper for the court to create its own obviousness contentions and then find that the claims would have been obvious under them." *Id*. at 60 (brackets added). If the court's analysis did not track word–for–word DeLorme's analysis, then BriarTek argues that the court erred. *See* Appellant's Brief at 45–47, 58–61. This, however, is not the law.

Pursuant to Fed. R. Civ. P. 56(c), "[t]he court need consider only the cited materials, but it may consider other materials in the record" (brackets added). In other words, the court may consider the entire record in reaching its decision. Moreover, the court can reach its own conclusion on the legal questions, and is not limited to accepting or rejecting the parties' arguments wholesale. "The district court also has an obligation, despite any obfuscation or lack of assistance of counsel, to carefully consider, and independently decide, the issues in the case." *LSI Indus., Inc. v. ImagePoint, Inc.*, 279 Fed. Appx. 964, 969 (Fed. Cir. May 22, 2008) (quoted in *TecSec, Inc. v. IBM Corp.*, No. 1:10cv115 (LMB/TCB), slip op. at 18 (E.D. Va. May 7, 2015) (Brinkema, J.)). Thus, "the trial judge has an independent obligation to determine the meaning of the claims, notwithstanding the views asserted by the adversary parties." *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995). The trial judge certainly has the additional independent obligation to determine legal issues—that is, after all, the essence of being a judge.

In this case, the trial court did not uncritically accept or reject either side's legal arguments. The court rejected DeLorme's argument that de Vries anticipated claim 2 of the '380 Patent, A41, that ORBCOMM anticipated claims 10–12 of the '380 Patent, A48–49, and that the Motorola Manual anticipated any of the asserted claims of the '380 Patent, A49–50. The court accepted DeLorme's argument that

de Vries and ORBCOMM between them anticipated all of the asserted claims of the ’380 Patent, A32–48, and that de Vries, ORBCOMM, and the Motorola Manual together rendered all of the asserted claims of the ’380 Patent obvious, A54–58, but analyzed the evidence and reached its own independent assessment. That it did not parrot DeLorme’s brief, even if it reached the same ultimate conclusion of invalidity, only underscores the independence of the federal judiciary to draw conclusions of law based on undisputed material facts.

4. The District Court Did Not Abuse Its Discretion In Ordering Supplemental Summary Judgment Briefing And Filings.

BriarTek’s final arrow in its procedural quiver is that the district court abused its discretion by using expert reports filed after the initial summary judgment hearing that were not part of the initial round of briefing. *See* Appellant’s Brief at 63. BriarTek misses the mark.

At the summary judgment hearing on February 21, 2014, BriarTek for the second time sought briefing on claim construction before a ruling on summary judgment. Additionally, BriarTek argued that DeLorme’s expert declaration in support of summary judgment was contradicted by his expert reports in both the ITC and the district court, and accused DeLorme of cherry–picking from his testimony “because they disagree with him on most issues.” A2977. Needless to say, DeLorme vigorously disputed each of these assertions. Faced with this “he said, he said,” the district court stated: “I’m not going to resolve this case on the

pleadings that I have currently got." *Id*. As requested by BriarTek, the court then ordered the parties to "file complete copies of all their experts' reports." A2958. And, as noted above, as requested by BriarTek, the court ordered the parties to brief claim construction issues relevant to invalidity. *Id*.

Thus, claim construction briefs and all 13 technical expert reports were filed and made a part of the summary judgment record because *BriarTek* requested it. Suffice it to say, BriarTek cannot complain on appeal about assertions of invited error. *Chem. Eng. Corp. v. Essef Indus., Inc.*, 795 F.2d 1565, 1572 (Fed. Cir. 1986).

More fundamentally, there was nothing improper about the district court's decision to order supplemental briefing and filings before deciding DeLorme's summary judgment motion. Indeed, trial courts can even enter summary judgment *sua sponte*, so long as they give the losing party the opportunity to come forward with its contrary evidence. *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986); *see Massey v. Del Labs., Inc.*, 118 F.3d 1568, 1572 (Fed. Cir. 1997) ("[T]here is nothing inherently improper about the district court entering summary judgment for a non–movant.") (brackets added). The touchstone is whether the losing party has had a full and fair opportunity to ventilate the issues involved in the motion. *See Massey*, 118 F.3d at 1572. BriarTek has no beef under that standard. It was given two chances to brief claim construction and to submit expert reports that it

contended eviscerated DeLorme's summary judgment motion. BriarTek received all of the process it was due, and more, when the district court rejected BriarTek's arguments on the merits, to which we now turn.

B. The District Court Properly Invalidated The '380 Patent On Grounds Of Anticipation And Obviousness.

The district court invalidated the '380 Patent as anticipated by two references (de Vries and ORBCOMM), and obvious in light of three references (de Vries, ORBCOMM, and the Motorola Manual), none of which was before the patent examiner during the prosecution of the '434 Application. A31–57. Before turning to BriarTek's arguments, we note that BriarTek does not challenge on appeal that any of these references is prior art to the '380 Patent. BriarTek does not challenge on appeal that de Vries anticipated claim 12, A39, that ORBCOMM anticipated claim 35, A48, or that the specific combinations identified by the district court rendered all of the claims obvious, A54–57. Also, in the district court, BriarTek did not dispute that de Vries and ORBCOMM anticipated claim 35. A41, A48. Any new argument on appeal to this effect has been waived. *See Stauffer, Inc.*, 758 F.3d at 1322. BriarTek's remaining challenges are meritless.

1. Two Undisclosed Prior Art References Anticipated The '380 Patent.

The district court correctly concluded that the '380 Patent's claims were anticipated under 35 U.S.C. § 102. "'Anticipation' means that the claimed

invention was previously known, and that all of the elements and limitations of the claim are described in a single prior art reference." *Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313, 1319 (Fed. Cir. 2007) (citation omitted). "[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference." *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (brackets added). "Although anticipation is a question of fact, a district court may, on summary judgment, invalidate a patent claim as anticipated by a prior art reference if the patentee does not identify a genuine issue of material fact to avoid summary judgment." *Taurus IP, LLC v. DaimlerChrysler Corp.*, 726 F.3d 1306, 1324–25 (Fed. Cir. 2013).

De Vries. Utilizing detailed claim–by–claim, element–by–element charts, the substance of which BriarTek generally does not contest, the district court concluded that de Vries anticipated claims 1, 5–12, 17, and 34–35 of the '380 Patent. A32–41. We address BriarTek's challenges *seriatim*.

Claim 1. "BriarTek does not dispute that de Vries teaches the vast majority of claim 1." A34 (citing BriarTek's summary judgment brief). BriarTek criticizes the court's conclusion on the grounds that de Vries discloses "pre–canned messaging" and thus "did not disclose mutual communication using detailed text messages." Appellant's Brief at 49. The court rightly rejected this argument

because neither BriarTek nor its expert, Paul Steffes, "explain why the communication process employed by de Vries differs from the claimed process." A35 (citations omitted). BriarTek's conclusory statement of validity is insufficient to stave off summary judgment. *See* A35 (citing *Krippelz v. Ford Motor Co*., 667 F.3d 1261, 1269 (Fed. Cir. 2012)).

Also, BriarTek is wrong about de Vries. In fact, de Vries describes an embodiment in which "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." A908. In other words, de Vries disclosed the use of both pre–canned messages and detailed messages.

In any event, this is not a case in which the court "ignored its own claim construction." Appellant's Brief at 50. As the court correctly noted, "'using detailed messages' is not an element in claim 1 of the '380 Patent." A35. "The word 'detailed' does not appear in any claim in the '380 Patent, and BriarTek does not dispute that de Vries teaches mutual communication." *Id*.

BriarTek points to its proposed construction of a "text entry device," which was "keypad or virtual keypad *capable of* entering detailed text messages." Appellant's Brief at 50 (emphasis altered). Even if the text entry device must be *capable of* entering detailed text messages, claim 1 is not limited to sending

detailed text messages, which the court noted requires only that "the user satellite communication system and the monitoring satellite communication system are adapted for mutual communication via a satellite network." A35 (quoting A74, 8:16–18). "Moreover, the written description of the '380 Patent focuses the invention on 'send[ing] and receiv[ing] *short* text messages.'" A35 (quoting 72, 3:58–62) (emphasis and brackets added by court). In short, de Vries anticipated claim 1.

Claims 5–9. "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." A37. Relying on the portion of de Vries quoted above that the text messages "may then be sent in the same manner as any canned messages," A908, BriarTek and its expert leap to the illogical conclusion that only pre–canned messages can be sent according to the teaching of de Vries. *See* Appellant's Brief at 51–52. "BriarTek does not explain why a device could not send both types of messages." A37. Indeed, there is no textual support or other evidence for that misinterpretation. "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.'" A38 (quoting *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1080 (Fed. Cir. 2005)). Claims 5–9 are anticipated by de Vries.

Claims 10–11. In the district court, BriarTek challenged anticipation of claims 10–11 on the grounds that de Vries "would not disclose the need to change the format of the data." A38 (quoting BriarTek's summary judgment brief). "Contrary to BriarTek's argument, claims 10 and 11 of the '380 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.'" A38–39 (brackets added by court and quoting patent, A74, 8:53). Although BriarTek attacks this conclusion on appeal as lacking "evidentiary support," Appellant's Brief at 52, the court was quoting the language of the '380 Patent. BriarTek's conclusory citation to its expert's declaration without any explanation, *see id*., cannot change the calculus. Claims 10–11 are anticipated by de Vries.

Claim 12. As discussed, BriarTek did not dispute below and does not dispute here that de Vries anticipates claim 12.

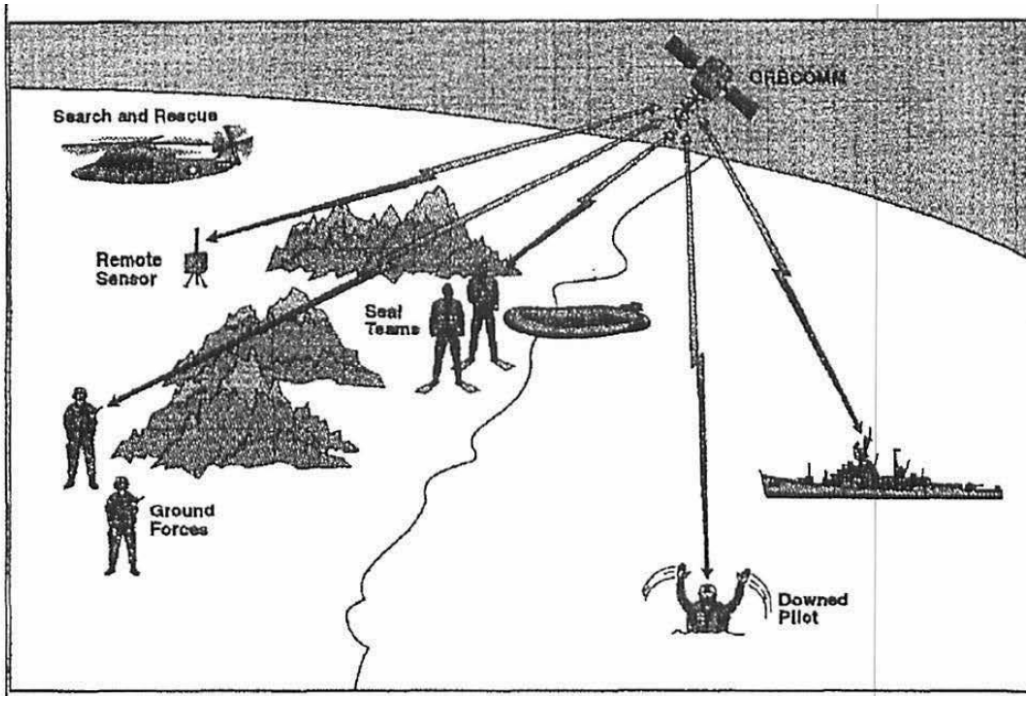
Claim 17. Claim 17 requires a "status sensor that is communicatively coupled to the user processor," and de Vries discloses a "water sensor" that detects a water level and "may send a signal to the operator module." A39 (citations omitted). Without any explanation, BriarTek transforms this into a limitation that the sensor must be "coupled to the use processor and the use processor [*sic*] to format the data for communication to the monitoring system." Appellant's Brief at 53. The district court did not "flip the burden of proof" in concluding that

"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." A40 (citation omitted). Claim 17 is anticipated by de Vries.

Claim 34. Claim 34 requires "substantially global coverage," and BriarTek attacks the district court for taking judicial notice from the records of the National Oceanic and Atmospheric Administration ("NOAA") that oceans cover 71 percent of the Earth's surface. *See* Appellant's Brief at 53; A40. BriarTek labels this as the court "creat[ing] its own evidence." *Id*. (brackets added). BriarTek does not—and cannot—dispute that the ocean does cover nearly three–quarters of the Earth, or that this is a proper subject of judicial notice under Fed. R. Evid. 201(b)(2). *Cf. Newman v. Village of Hinsdale*, 592 F. Supp. 1307, 1310 n.8 (N.D. Ill. 1984) (NOAA records are "federal statistics of which this court may take judicial notice"). Claim 34 is anticipated by de Vries.

Claim 35. As noted, BriarTek did not challenge below that de Vries anticipates claim 35. In a new, hence waived, argument, BriarTek now erroneously asserts that, like claim 34, claim 35 requires "substantially global coverage." In fact, claim 35 only tells a reader to provide a user unit of claim 1 to a user and to monitor the monitoring system to provide a travel service. A75, 9:65–67. Claim 35 is anticipated by de Vries.

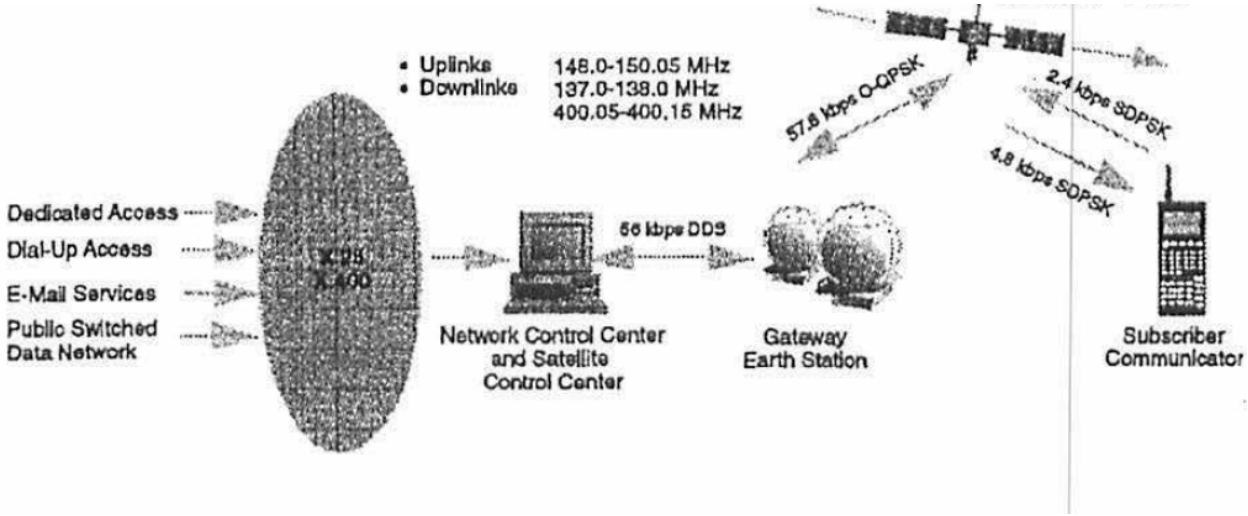
ORBCOMM. Utilizing detailed claim–by–claim, element–by–element charts, the substance of which BriarTek generally does not contest, the district court concluded that ORBCOMM anticipated claims 1–2, 17, and 34–35 of the '380 Patent. A42–48. Published in 1995, ORBCOMM describes a system that sounds remarkably like the system claimed by the '380 Patent—it "'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." A42 (quoting A879). "Figure 1 illustrates the system as used to facilitate military operations:"



Id. We address BriarTek's challenges *seriatim*.

Claim 1. BriarTek argues that ORBCOMM did not anticipate claim 1 because it lacked the claimed monitoring system. *See* Appellant's Brief at 54–57.

As the district court found, however, BriarTek's argument "is flatly contradicted by ORBCOMM Fig. 3–2, which shows a computer including a display as part of the NCC [Network Control Center]." A46 (brackets added).



A43 (quoting A881). Although BriarTek argues further that DeLorme's expert "admitted" that the NCC was not a monitoring system, *see* Appellant's Brief at 55–56, as the district court found, "BriarTek quotes Mr. Zancho out of context." A46.

> 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."

Id. (quoting A2680) (brackets added by court). Suffice it to say, a system that "can provide the United States Armed Forces with two–way on–the–move data messaging anywhere in the world" (A879) has a monitoring system. ORBCOMM anticipates claim 1.

Claim 2. BriarTek argues that it was illogical to conclude that the ability to hold a handheld device implied tethering or coupling. *See* Appellant's Brief at 57. In the district court, however, BriarTek questioned "whether a downed pilot could necessarily carry" an ORBCOMM pocket–sized device, but the court found that it did not contest that it "may be tethered or coupled to the user by being placed in the user's pocket." A46–47. If this Court considers BriarTek's new argument on appeal, it should reject it. Courts should not suspend logical thought in a patent case. ORBCOMM describe a system of downed pilots using "light–weight and pocket–sized" devices in search–and–rescue missions. A879. This inherently describes a device that can be coupled to its user. Otherwise, its utility to a downed pilot would be nil. ORBCOMM anticipates claim 2.

Claim 17. BriarTek now claims on appeal that ORBCOMM did not disclose a "status sensor," which was required by claim 17. *See* Appellant's Brief at 57. In the district court, however, "BriarTek … 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." A47. Once again, this Court should not consider BriarTek's new argument on appeal.

In any event, the ORBCOMM system discloses as some of its mission applications, "[r]emote sensor control, transmission of data from in[]trusion, motion heat sensors." A880 (brackets added). Indeed, Figure 1 discloses a "remote

sensor." A879. The system was designed to transmit "[p]osition information, sensor information, [and] text, if you wished." A2936 (brackets added). The district court did not err in finding that ORBCOMM disclosed a sensor, *i.e.*, ORBCOMM anticipated claim 17.

Claim 34. BriarTek contends that ORBCOMM did not disclose substantially global coverage. *See* Appellant's Brief at 58. In the district court, however, "BriarTek does not dispute that ORBCOMM teaches a system that operates anywhere in the world." A48. Furthermore, ORBCOMM specifically states that it "can compose, transmit and receive messages … anywhere on the world." A881 (ellipsis added); *see* A48 (quoting A881).

In passing, BriarTek also argues that ORBCOMM did not anticipate claim 34 because the system was not operational. *See* Appellant's Brief at 58. As the district court correctly noted, that is not the standard—"anticipation does not require actual performance of suggestions in a disclosure." A47 (quoting *Bristol–Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1379 (Fed. Cir. 2001)). "Rather, anticipation only requires that those suggestions be enabling to one of skill in the art." *Id*. ORBCOMM anticipated claim 34.

Claim 35. As noted, BriarTek did not dispute below and does not dispute here that ORBCOMMM anticipates claim 35.

2. Three Undisclosed Prior Art References Rendered The ’380 Patent Obvious.

Analyzing the ’380 Patent on a claim–by–claim, element–by–element basis, the substance of which BriarTek generally does not challenge, the district court concluded that three prior art references that were not before the patent examiner—de Vries, ORBCOMM, and the Motorola Manual—together rendered all of the asserted claims of the ’380 Patent obvious. A50–58. BriarTek challenges the entire notion that the district court could decide this issue on summary judgment. *See* Appellant’s Brief at 58–63.

Obviousness under 35 U.S.C. § 103 is a question of law based on underlying facts. A50 (citing *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.” A51 (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007)) (ellipsis added by court). Relevant factors include the scope and content of the prior art; the difference between the prior art and the claimed invention; the level of ordinary skill in the field of the invention; and any relevant objective considerations. A50; *see 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*.

A51 (brackets added by court). BriarTek does not challenge *any* of the legal standards applied by the district court, and BriarTek does not seriously dispute *any* of the relevant factors that led the district court to invalidate the asserted claims of the '380 Patent on the grounds of obviousness.

Scope And Content Of Prior Art. "Only references analogous to the claimed invention may be considered when evaluating obviousness. *Wyers*, 616 F.3d at 1237." A51. "BriarTek does not contest that the references cited by Delorme are analogous art." A52 (citing BriarTek's summary judgment brief). BriarTek does not—and cannot—suggest otherwise on appeal.

Level Of Ordinary Art In The Skill. The district court adopted BriarTek's definition of a person of ordinary skill in the art. *Id*. BriarTek never explains why this would make any difference in this case, and indeed, for purposes of

obviousness, never explains why expert testimony was even necessary since the alleged invention—two–way text communications via satellite from a user unit to a monitoring system—was easily understandable.

Although BriarTek's expert flatly stated without explanation that "I do not see how or why one of ordinary skill in the art would be led to combine any of these references[,]" Appellant's Brief at 62 (brackets added and quoting A2584), the district court was not required to credit such *ipse dixit*.

> 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."

A23 (brackets added by court and quoting *Invitrogen*, 429 F.3d at 1080). Having provided no foundation for its expert's conclusory conclusion, the district court was not "weighing evidence" (Appellant's Brief at 62) when it rejected BriarTek's unsupported assertion. In any event, "there is no material dispute regarding the level of ordinary skill" because BriarTek identifies no way in which the varying skill levels proposed by DeLorme and BriarTek makes a difference to the judgment of invalidity. A52.

Secondary Considerations. Neither party contended that secondary considerations played any role in the obviousness analysis. A52.

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." A52 (citing *Graham*, 383 U.S. at 17–18). For purposes of its obviousness analysis, notwithstanding its views that de Vries and ORBCOMM anticipated the asserted claims of the '380 Patent, the district court accepted BriarTek's arguments concerning the missing elements in each of the prior art references. A52–53. BriarTek does not—and cannot—challenge this approach. *See* Appellant's Brief at 60. "This assumption renders the factual underpinnings of the obviousness inquiry without dispute." A54. "Accordingly, the legal determination of obviousness is ripe for summary judgment adjudication." *Id*.

As noted above, BriarTek does not contest that the *substance* of any of the combinations of the three prior art references not before the patent examiner—de Vries, ORBCOMM, and the Motorola Manual—together rendered all of the asserted claims of the '380 Patent obvious. *Compare* A54–57 *with* Appellant's Brief at 58–63. That should be the end of the matter.

Instead, BriarTek argues first that the district court erred because the specific combinations had not been argued in detail by DeLorme. *See* Appellant's Brief at 58–59. This, however, is a reprise of BriarTek's procedural argument dispatched above. Indeed, since DeLorme had argued in its original summary judgment motion that de Vries, ORBCOMM, and the Motorola Manual each anticipated the

'380 Patent, it could not predict what elements BriarTek might argue, or what elements the district court might find, were missing from those references, and thus must be analyzed separately for obviousness. *See* A41–42, A48–50 (court finding certain claims not anticipated by the three prior art references cited by DeLorme). Under BriarTek's approach, unless a party presciently predicts which claims are not anticipated and then briefs in exhaustive detail obviousness for those claims, no court could ever rule on obviousness. BriarTek does not cite any authority supporting such a radical approach. Thus, DeLorme was not required to go through the mindless exercise of repeating verbatim the element–by–element, claim–by–claim analysis it presented in support of its anticipation arguments, *see* A505–512, in the obviousness section of its argument in order for those arguments to count, as BriarTek appears to suggest.

BriarTek finally argues that "the court's obviousness analysis lacked an evidentiary basis and failed to consider BriarTek's evidence of non–obviousness." Appellant's Brief at 59. BriarTek did not submit any *evidence* of non–obviousness other than its expert's conclusory assertion to that effect. As noted above, that is not enough.

As for the "evidentiary basis" of the district court's conclusion, we need look no further than the court's detailed analysis, complete with claim charts and extensive record citations, from the first 35 pages of the court's opinion. *See* A16–

50. The court certainly did not have to repeat each of its citations each time it referred to de Vries, ORBCOMM, or the Motorola Manual. BriarTek does not cite any authority requiring such busywork by district courts.

Once BriarTek's various "gotcha" arguments are rejected, the merits become crystalline—all of the asserted claims of the '380 Patent were properly rejected by the district court on the grounds of anticipation and obviousness.

C. This Court Could Affirm Invalidation Of The '380 Patent On Alternative Grounds Argued Below.

This Court may affirm a grant of summary judgment on a ground supported by the record but not addressed by the district court if it concludes that there was no genuine issue as to any material fact and the moving party was entitled to a judgment as a matter of law. *AquaTex Indus., Inc. v. Techniche Solutions*, 479 F.3d 1320, 1328 (Fed. Cir. 2007); *accord Bowling v. Wellmore Coal Corp.*, 114 F.3d 458, 460 (4th Cir. 1997). Rather than gild the lily, we address only two of the alternative grounds argued below.

1. Boling Overwhelmingly Confirms The Conclusion Of Obviousness.

The trial court ruled that the asserted claims of the '380 Patent were anticipated by ORBCOMM and de Vries, and obvious in light of ORBCOMM, de Vries, and the Motorola Manual. Because those three pieces of prior art sufficed to establish invalidity, the Court did not find it necessary to analyze the Boling

reference (A753–766), which the examiner twice relied on in rejecting the applicants' claims during prosecution (A735–752, A795–813). That said, to quote the trial court, "When considered with the other references, … Boling overwhelmingly confirms the conclusion of invalidity." A58 (ellipsis added). The reason why is obvious. There is no dispute that Boling anticipated every element of the asserted claims except for the text entry device, which the applicants added to the input device of the user unit specifically to overcome Boling.

The examiner found that Boling anticipated every element of the original claim language of the '434 Application. A737–46. The applicants did not dispute that conclusion. Instead, they amended the claim to add the text entry device because, as they wrote the examiner, "Boling *et al.* … does not include a keypad or any means of entering text." A768 (ellipsis added). In response, the examiner agreed that Boling anticipated every element of claim 1 except that "Boling does not mention the input device includes a text entry device adapted to receive textual data entered by a user." A798. Even so, the examiner found that Tognazzini supplied this missing element, rendering the amended claims obvious. A797–808. In overcoming that objection, the applicants argued that Boling "could not make use of text messages even if the hardware for entering text were made available." A688–689. At no time did the applicants argue or suggest that Boling did not

anticipate every other element of the language of the amended claims. *See* A826–840.

As night follows day, Boling supplies any element even arguably missing from ORBCOMM, de Vries, and the Motorola Manual, all of which disclose the "text entry device" added to claim 1 of the '380 Patent to overcome anticipation by Boling. *See* A34 (text entry device in de Vries); A45 (text entry device in ORBCOMM); A54 ("BriarTek concedes that the Motorola Manual does teach detailed text messaging."). Although this Court need not look to Boling to affirm the judgment of obviousness, it may do so with ease.

2. The '380 Patent Claims The Abstract Idea Of Two–Way Satellite Text–Messaging.

"Laws of nature, natural phenomena, and abstract ideas are not patentable." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013). In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Court set out the two–part test to assess subject matter–eligibility under 35 U.S.C. § 101. *First*, a court must "determine whether the claims at issue are directed to patent–ineligible concepts." *Alice*, 134 S. Ct. at 2355. *Second*, if the claims are drawn to a patent–*in*eligible concept, the court must conduct a "search for the inventive concept—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself." *Id*. (quotation and brackets omitted). An

abstract idea cannot become patent–eligible by restricting its field of use. *Id*. at 2358. Nor is it enough to add "token postsolution components" to the abstract idea. *Bilski v. Kappos*, 130 S. Ct. 3218, 3231 (2010).

Claim 1 of the '380 Patent, on which all of the asserted claims are based, recites a user unit—a device without any defined size, shape, or physical structure—and a monitoring system—a second device without any defined size, shape, or physical structure. A66, Fig.1; A72, 4:30–34, 40–50; A74, 8:23; *see* A872–874 (deposition of BriarTek's expert). Claim 1 then defines these as capable of sending and receiving text messages over a satellite network, which is part of the "commercial satellite infrastructure." A72, 3:59.

Put differently, the '380 Patent claims the abstract idea of two–way text messaging by satellite. It does not disclose any element or set of elements that renders it "significantly more than a patent upon the ineligible concept itself." *Alice*, 134 S. Ct. at 2355. The claimed system "is not tied to a specific structure or machine." *DigiTech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). Any technical functionality is defined in purely generic terms. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014). The claims do not solve a problem inherent to satellite text–messaging technology; they simply instruct the reader to use such technology functionally described to send and receive text messages. *Cf. DDR Holdings, LLC v. Hotels.com, L.P.*, 773

F.3d 1245, 1257 (Fed. Cir. 2014) ("Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.").

If considered limiting, the preamble to claim 1 does not help, because it just limits the invention to the field of use to "emergency monitoring and reporting." A75, 8:2–3. Purported method claim 35 just instructs the reader to use the system described in claim 1. A75, 9:65–67. The dependent claims just add token post–solution components to the abstract idea. The additions of a tethering device (claim 2, A74, 8:24–25); express claiming of canned messages (claims 5–9, A74, 8:30–49); a transmitter for transmitting data or a receiver for receiving them (claims 10–11, A74, 8:50–60); the ability to display text messages (claim 12, A74, 8:61–62); a status sensor (claim 17, A75, 9:5–10); or substantially global coverage (claim 34, A63–64), do not make concrete the conceptual idea of two–way satellite text messaging. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) ("Adding routine additional steps … does not transform an otherwise abstract idea into patent–eligible subject matter.") (ellipsis added). To the contrary, all of the asserted claims of the '380 Patent describe generic equipment performing generic functions in a generic fashion. The '380 Patent does not claim patentable subject matter.

III. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN AWARDING DELORME ITS COSTS.

After the district court invalidated all of the asserted claims of the '380 Patent, DeLorme submitted its bill of costs. A4840–4953. In the district court, BriarTek objected on various grounds, including that DeLorme was not a prevailing party. A4954–5024. After briefing, the court rejected BriarTek's effort to stay resolution of this issue, rejected BriarTek's objections, and awarded DeLorme its costs. A10–15. On appeal, BriarTek only objects to the award of "document costs for discovery that occurred before the ITC." Appellant's Brief at 63 (citing A14–15). The district court did not abuse its discretion in awarding DeLorme such costs.

In denying BriarTek's motion to dismiss, in which BriarTek expressed concerns about duplication and the cost of discovery from parallel proceedings, the district court "ORDERED that the parties are required to make use of all fact and expert discovery developed in proceedings before the U.S. International Trade Commission in this action." A62. The court's action saved the parties effort and expense by eliminating the need to duplicate discovery originally taken in the ITC. Under such circumstances, it was entirely within the court's discretion to award DeLorme costs incurred for ITC discovery. *See Monolithic Power Sys., Inc. v. O2 Micro Int'l Ltd.*, No. 08–cv–4567, slip op. at *15–16 (N.D. Cal. Mar. 3, 2011) (permitting recovery in district court action of deposition costs in an ITC

investigation when, in the interests of efficiency, the court ordered use of all discovery obtained through the ITC parallel investigation pertaining to the case) (A4845, A4932–53). Since the court's action was taken to address BriarTek's concerns, it scarcely behooves BriarTek now to complain about the court's remedial action.

Furthermore, the parties made extensive use of the ITC discovery materials in the district court action. As noted above, that included many of the materials that each side filed in conjunction with the summary judgment motion. BriarTek certainly considered the ITC discovery materials relevant to the district court action. Indeed, 270 of the 290 exhibits identified by BriarTek in its pre–trial disclosures in the district court action, *i.e.*, 93% of BriarTek's exhibits, were documents originally produced at the ITC. A5031–32, A5038, A5041–56. The district court did not abuse its discretion by awarding DeLorme the cost of documents produced in the ITC.

CONCLUSION

DeLorme respectfully requests that the Court affirm the district court's orders granting DeLorme final judgment of invalidity and award of its costs.

Dated: May 11, 2015

Respectfully submitted,

/s/ Peter J. Brann
Peter J. Brann
pbrann@brannlaw.com
David Swetnam–Burland
dsb@brannlaw.com
Stacy O. Stitham
sstitham@brannlaw.com
BRANN & ISAACSON
184 Main St., Box 3070
Lewiston, Maine 04243–3070
(207) 786–3566

Attorneys for Appellees

United States Court of Appeals
for the Federal Circuit

DeLorme Publishing Co., Inc. v. BriarTek IP, Inc., 2015-15-1169, -1241

CERTIFICATE OF SERVICE

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by BRANN & ISAACSON, Attorneys for Appellees to print this document. I am an employee of Counsel Press.

On **May 13, 2015** counsel has authorized me to electronically file the foregoing corrected **Appellees' Brief** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to all counsel registered as CM/ECF users, including any of the following:

John R. Fuisz
Sudip K. Kundu
THE FUISZ–KUNDU GROUP LLP
1455 Pennsylvania Avenue, NW, Suite 400
Washington, DC 20004
jfuisz@fuiszkundu.com
skundu@fuiszkundu.com
Counsel for Appellant BriarTek IP, Inc.

Paper copies will also be mailed to the above principal counsel at the time paper copies are sent to the Court.

The brief was originally filed and served on May 11, 2015. Upon acceptance by the Court of the e-filed document, six paper copies will be filed with the Court within the time provided in the Court's rules.

May 13, 2015

/s/ Robyn Cocho
Counsel Press

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type–volume limitation of Fed. R. Appellant's P. 28.1(e)(2)(B), because it contains 13,400 words, excluding the parts of the brief exempted by Fed. R. Appellant's P. 32(a)(7)(B)(iii) and Federal Circuit Rule 32(b).

2. This brief complies with the typeface requirements of Fed. R. Appellant's P. 32(a)(5), and the type style requirements of Fed. R. Appellant's P. 32(a)(6), because it has been prepared in a proportionally–spaced typeface using Microsoft Word in Times New Roman 14 point font.

Dated: May 11, 2015

/s/ Peter J. Brann
Peter J. Brann