Appeal No. 2014-1732

United States Court of Appeals

for the

Federal Circuit

CONVOLVE, INC.,

Plaintiff-Appellant,

– and –

THE MASSACHUSETTS INSTITUTE OF TECHNOLOGY,

Plaintiff,

– v. –

COMPAQ COMPUTER CORP.,

Defendant-Appellee,

– and –

SEAGATE TECHNOLOGY, LLC,

Defendant-Appellee,

– and –

SEAGATE TECHNOLOGY, INC.,

Defendant.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK, IN CASE NO. 1:00-CV-05141-GBD-JCF, HONORABLE GEORGE B. DANIELS

REPLY BRIEF FOR PLAINTIFF-APPELLANT

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May 1, 2015

Form 9

FORM 9. Certificate of Interest

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Convolve, Inc. v. Compaq Computer Corp.

No. 2014-1732

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party) Convolve, Inc. certifies the following (use "None" if applicable; use extra sheets if necessary):

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

Convolve, 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 now represented by me in the trial court or agency or are expected to appear in this court are:

See Schedule A attached hereto

May 1, 2015
Date

/s/ John T. Moehringer
Signature of counsel

John T. Moehringer
Printed name of counsel

Please Note: All questions must be answered

cc: counsel of record

SCHEDULE A TO CERTIFICATE OF INTEREST

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

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Appellees' litany of arguments defending summary judgment invite this Court to join in the district court's errors of law and usurpation of the jury's fact-finding role. None of these arguments carries appellees' "heavy burden of demonstrating the absence of any material issues of fact." *Nationwide Life Ins. Co. v. Bankers Leas. Ass'n*, 182 F.3d 157, 160 (2d Cir. 1999). As detailed below, summary judgment should be vacated, Compaq's alternative argument should be rejected, and this case should be remanded to finally provide Convolve the "right to present [its] case to the jury." *Id.*

ARGUMENT

I. SEAGATE MISCHARACTERIZES THE RECORD AND THE LAW

Seagate's brief repeatedly misrepresents the record and the law. Indeed, to support the district court's erroneous analysis, Seagate conflates distinct concepts, wholly ignores others, and mislabels out-of-circuit caselaw as controlling. While many of these misrepresentations are addressed below, the most egregious instances should be noted at the outset.

First, the bedrock of Seagate's "user interface" argument is its representations that Convolve's proposed construction "would have defined 'user interface' to include 'a person or device that uses the user interface," and that the

"district court rejected that construction as too broad." SGT27.[1] Convolve's proposed construction was, in fact, virtually identical to the construction adopted by the district court. A96; A1033. What Seagate appears to have done is misdirect the Court to a tangential discussion regarding the singular term "user," which Convolve argued was a "fragment" that should not be construed separately from "interface." A387, A412, A448, A463, A477, A499, A518.

Second, Seagate repeatedly claims that Convolve lost claim construction and could have appealed. Quite the opposite; the district court adopted Convolve's proposed construction almost verbatim and wholesale rejected appellees' "user interface" construction. A96; A1195. Indeed, *appellees* moved for reconsideration of the "user interface" construction, *not* Convolve. A92-94. In that briefing, appellees acknowledged that the district court rejected their argument that "the user interface is not a machine-machine interface." A1195-97. Regardless, Seagate's tactics cannot obfuscate the real issue: the district court construed user interface "specifically to include circumstances where a person has, at some point, dictated what the parameters should be." A81.

Lastly, Seagate represents out-of-circuit precedent as binding. *Alpha/Omega Ins. Servs. v. Prudential Ins. Co. of Am.*, 272 F.3d 276 (5th Cir. 2001), cited at

[1] "SGT__" references the "Brief of Defendant-Appellee Seagate Technology LLC," ECF-41. "CPQ__" references the "Confidential Brief For Defendant-Appellee Compaq Computer Corporation," ECF-39. "CNV__" references Convolve's "Brief For Plaintiff-Appellant," ECF-29.

SGT35, is a *Fifth* Circuit decision. While Convolve does not believe Seagate purposefully intended to mislead the Court, this type of fast-and-loose handling of the facts and law infects Seagate's entire brief.

II. THIS COURT SHOULD VACATE SUMMARY JUDGMENT ON THE "USER INTERFACE" LIMITATION

A. Convolve's Evidence Precludes Summary Judgment

Convolve presented substantial evidence that the accused drives satisfy the "user interface" limitation, but that evidence was improperly dismissed by the district court and goes essentially unrebutted by Seagate. CNV36-37. Nowhere has either the district court or Seagate meaningfully addressed Convolve's reliance on industry standards, Seagate product manuals, source code, and corporate/expert testimony—all demonstrating that this limitation is met. This Court credited some of this *very* evidence in determining that Convolve had provided sufficient evidence of indirect infringement of the "user interface" limitation. A2026-27.

1. Accused Drives Meet the Limitation

Rather than addressing Convolve's evidence directly, Seagate's "user interface" argument ignores the actual construction of that term:

> software, hardware, firmware, or a combination thereof that allows a person, directly or indirectly, to alter parameters.

A96. Seagate does not and cannot dispute that all accused drives were designed to permit users to alter drive parameters. A5992; A6033; A6075. Seagate instead obfuscates by: discussing what it believes the district court meant to say in its claim construction, and defending the district court's decision to act as fact-finder, about the degree to which the accused products allow users to alter parameters "indirectly," when shown Seagate drives reading on that construction as written. SGT18-19, 21-22, 27-34. This was a fundamental error.

Infringement is a two-step process, involving: first, claim construction, and then applying that construction to accused products. *Convolve, Inc. v. Compaq Computer Corp.*, 527 F. App'x 910, 926 (Fed. Cir.) ("*Convolve I*"), *cert. denied*, 134 S. Ct. 801 (2013). The district court, however, relied on precedent that the infringement inquiry can be "collapse[d]" into one of claim construction and "amenable to summary judgment." A33. But that caselaw is inapplicable where the parties dispute "the application of th[e] claim construction to the accused device." *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1302 (Fed. Cir. 2011). While the district court could have modified its claim construction (A31, citing *Pfizer, Inc. v. Teva Pharm., USA, Inc.*, 429 F.3d 1364, 1377 (Fed. Cir. 2005)), it declined to on multiple occasions. A92-94; A31 (reaffirming the prior construction). The parties sharply dispute application of the *actual* claim

construction to accused Seagate drives; this alone precludes summary judgment. *Id.* *Infra* Part II.B.

Seagate defends the district court's holding that Convolve's application of "indirectly" is "inconsistent with" the *Markman* Order. A34; SGT31-32. But as that Order explained, accused infringers cannot "avoid[] infringement" by placing intermediate hardware (*i.e.*, the mouse) and software (*i.e.*, mouse interface) between the user and the accused user interface. A81. "To avoid such pedantic arguments," the *Markman* Order utilized "indirectly" specifically "to include circumstances where a person has, at some point, dictated what the parameters should be." *Id.* The district court nevertheless accepted the same "pedantic" argument on summary judgment, reasoning that "intermediate layers," such as "the mouse, the cable, the driver for the mouse, the driver for the keyboard, the driver for the display," rendered the accused interfaces too "far removed from the user." A34-35 (citing A2617-18 (¶ 446)).

The *Markman* Order instructed that devices meet the "user interface" limitation where "a person has, at some point, dictated what the parameters should be." A81. Moreover, this Court previously credited evidence showing that Seagate customers "used the user interface in an infringing way," because they

were instructed by Seagate on how to alter the drives parameters. A2026-27.[2] Convolve's infringement analysis faithfully applied the *Markman* Order's construction and its explanation for including "indirectly" in that construction. It was manifest error for the district court—when provided evidence that the accused interfaces meet that construction *as written*—to act as fact-finder that the accused products function too "indirectly." Fact-finding is the jury's job. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). Even if Seagate's argument that the District Court tacitly modified the construction of "indirectly" to exclude the accused products were accepted, summary judgment must be vacated, because it is never appropriate "to construe a claim solely to exclude the accused device." *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1367-68 (Fed. Cir. 2008).

2. Seagate Does Not Dispute That Accused Drives Were Designed to Permit Users to Alter Parameters

Seagate does not dispute that the accused drives were designed to permit a user to alter drive parameters. Seagate attempts to sow confusion by arguing that, because it is supposedly not possible to alter drive parameters without "install[ing] it in a computer," certain accused drive components therefore are not "user interface[s]." SGT28. This argument ignores record evidence that the accused

[2] Contrary to Seagate's suggestion, it remains liable for this induced infringement even if this Court affirms summary judgment that Seagate does not directly infringe. SGT39 n.3; A2026-27.

drives provide users the ability to alter drive parameters. CNV12-13. In other words, Seagate specifically programmed each drive to respond to user instructions for choosing either quick or quiet seeks. *Id.*; A6008-09; A6051-52; A6094-95. Without that special programming, users cannot interact with the drive to alter seek modes. *Id.* Thus, users interface with accused drives through a combination of software, hardware, firmware that allows a user to alter the drive's parameters. A96. Seagate's myopic focus on "device-to-device" connections is a red herring distracting the Court from evidence that the "user interface" limitation is satisfied.

B. Seagate's Arguments Lack Merit

1. Seagate's Own Evidence Contradicts Its Core Argument

Seagate argues that computer users "cannot alter the mode of the disk drive using the ATA or SCSI." SGT28 (arguing that ATA/SCSI are "device-to-device interfaces", "located deep" within the computer, where users "cannot see them"); SGT31. Seagate's witnesses and records contradict this argument.

Seagate's ATA interface planning manager's testimony about "the function of the ATA interface" refutes Seagate's argument :

> It ***allows you to issue*** read-and-write, seek, along with many other ***commands***, over a parallel bus from a host ***to the drive*** that allows data to be transferred in both directions.

A5343 (Tr. 6), A5347 (Tr. 23) (emphasis added). He further testified about the function of the "AAM" portion of the ATA-6 standard:

> It allows you to send commands over the interface to control the actuator.

A5364 (Tr. 91). Seagate detailed those commands in the accused drives' product manuals. A6008-09; A6051-52; A6094-95; A2618-19 (¶¶ 449-51). Seagate engineers offered similar testimony about enabling acoustic seek mode selection "through the SCSI interface" of accused Cheetah drives. A5454 (Tr. 159-61); A6136 (Tr. 151); A6176 (Tr. 68-69); A6208 (Tr. 303). A reasonable jury, hearing these admissions, could find that the ATA/SCSI interfaces "allow[ ] a person … to alter parameters" per the 2005 *Markman* Order. A96. *Anderson*, 477 U.S. at 248. Indeed, a reasonable EDTX jury returned just that verdict. A2581-82.

Seagate's records similarly contradict its argument that users cannot alter drive mode "using the ATA or SCSI." SGT28. Before this litigation, Seagate intended ***to market*** the AAM "selectable switching mechanism residing in the ATA interface" of its "next generation" products—*e.g.*, the accused U5, ATA3 and ATA4. A5514; A2567 (¶ 238).[3] This feature "residing in the ATA interface" allowed "even end users [to] configure a disc drive on the fly." *Id.*; A5232

[3] Seagate quashed this anticipated marketing blitz when it discovered the pending '473 application. A2662 (¶¶ 632-633) (citing A5508); A2567 (¶ 237).

(Seagate logbook noting Convolve's "customer selectable features" through "ATA interface").

This evidence corroborates Convolve's summary judgment evidence (*i.e.*, expert testimony; Seagate code and product manuals; appellees' records and testimony) showing how users interface with accused drives to alter seek mode via commands issued through the ATA/SCSI interfaces. CNV12-13. In other words, Convolve showed how the ATA/SCSI interfaces each are, in this Court's words, "a user interface that gives a user the ability to choose between seeks that are 'slower' but quieter, or 'faster' but louder." A2026. Convolve's infringement evidence thus "giv[es] effect to all terms in the claim," *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (cited at SGT29), and hardly "'expand[s] the 'user' aspect of the term to the point of obsolescence.'" SGT29. Seagate attacks Convolve's evidence, but this argument's merits can best be judged by where Seagate relegates it—a footnote. SGT28 n.2.

Seagate focuses instead on testimony from Convolve's expert, but it is unsurprising he could not switch modes on a de-powered drive in a law-firm conference room. A4181-82. After all, hard drives require electricity to operate. *See* A5065. Regardless, that expert testified that the drive "has the capability, as defined by the *Markman* Ruling, that allows a user to alter settings on the drive." A4181-82 (cited at SGT28); A5051-52; A5063-65. *Cf. SiRF Tech., Inc. v. ITC*,

601 F.3d 1319, 1331 (Fed. Cir. 2010) (chip maker directly infringed once chips were "enabled and ready to process data" in co-defendant's GPS receivers). The EDTX jury, moreover, heard the *identical* argument about Convolve's expert in that case, but nevertheless found that the ATA interface is a "user interface." A2956; A2581-82.

Seagate asks this Court to weigh this collective evidence, and credit movant Seagate's representations over non-movant Convolve's evidence showing that users can switch the accused drives' modes via the ATA/SCSI interfaces. But those "are jury functions, not those of a judge" on summary judgment. *Anderson*, 477 U.S. at 255. The district court's failure to "draw[] all reasonable inferences in Convolve's favor" on summary judgment is reversible error. *Convolve I*, 527 F. App'x at 928.

2. The Intrinsic Record Supports the 2005 Construction

Unable to attack the district court's original construction, Seagate attempts to arbitrarily read-in requirements not suggested by the words themselves. Indeed, Seagate appears to concede that "user interface" cannot "be construed to cover only" GUIs and switches. SGT30-31. Seagate nevertheless uses those embodiments to limit "user interface" to "the site at which the person using the device can interact with it to change the disk drive settings." SGT31. This sleight-of-hand is precisely the claim construction "danger" this Court repeatedly cautions

against: "reading limitations from the specification into the claim." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005). This danger is particularly acute here, where: the claim construction covers a full "range of user interfaces" (A80-81), and Seagate's witnesses and records contradict its representations about the ATA/SCSI interfaces. *Supra* Part II.B. The district court correctly rejected appellees' invitation to improperly read in such limitations during *Markman*, and should have rejected it again at summary judgment. A1281-82; A92-94.

Seagate's "user interface" argument ignores relevant prosecution history. SGT29-34. Seagate does not dispute that Convolve filed a broadening amendment on this limitation, and did so *specifically* to ensure that Seagate's drives *themselves* fell within claim scope. CNV8, 40; A1930-42; A1096; A1137-38 (Tr. 116-17), A1176-77 (Tr. 270-72). "User interface" cannot be restricted, as Seagate requests, via limitations removed by the broadening amendment. *See U.S. v. Telectronics, Inc.*, 857 F.2d 778, 783 (Fed. Cir. 1988).

3. Seagate Fails to Meaningfully Respond to The Mandate Argument

Seagate's arguments regarding *Convolve I*'s mandate should be rejected. SGT34-37.

Convolve did not waive its argument that summary judgment on remand contradicts this Court's mandate. SGT34-35. The mandate rule "is necessary to the operation of the hierarchical judicial system," *Mirchandani v. U.S.*, 836 F.2d

1223, 1225 (9th Cir. 1988), and Seagate cites no authority barring this Court from enforcing ***its own mandate***. Regardless, there is no waiver because the evidence grounding this Court's mandate is "inextricably linked" with the evidence/arguments Convolve raised on remand. CNV14. *Cordis v. Boston Scientific Corp.*, 658 F.3d 1347, 1359 (Fed. Cir. 2011) (rejecting waiver).

On the merits, Seagate's mandate argument twists *Convolve I*'s holding. SGT36-37. *Convolve I* reversed summary judgment regarding indirect infringement of the asserted method claims (A2026-27); in particular, the district court's rejection of "evidence of manuals instructing users on how to alter parameters and selling drives that were capable of alteration" (A1446; CNV14). Seagate suggests that this Court's holding, that Convolve provided sufficient "evidence of direct infringement by customers" via the seek selection feature in Seagate's drives, somehow left open the issue of *direct* infringement of related apparatus claims by that same user interface. SGT36-37. But the "showing of indirect infringement" in *Convolve I* "necessarily require[d] a showing of direct infringement" (527 F. App'x at 929); Seagate's argument thus boils down to suggesting this Court did not understand the evidence or its own indirect infringement precedents. SGT37. The mandate rule precludes reconsideration of not just "issues actually raised" in *Convolve I* but also "any issue within the scope of th[at] judgment," including whether the ATA/SCSI interfaces utilized by

Seagate's customers are "user interfaces." *Amado v. Microsoft Corp.*, 517 F.3d 1353, 1360 (Fed. Cir. 2008).

Even without the mandate rule, the evidence supporting this Court's *indirect* infringement holding would support a verdict that Seagate's drives had user interfaces that allowed "users to select between different performance levels of the disk drives." A2027. The district court's reading of the evidence should yield to this Court's, ***not*** vice versa.

C. The EDTX Jury Verdict Cannot Simply Be Ignored

Seagate's arguments, denigrating the EDTX jury verdict and "decisions of a Magistrate Judge," should be rejected. SGT24, 37-39. Rather than properly respond to Convolve's argument, Seagate joins the district court in dismissing, out-of-hand, the verdict and decisions from one of the Nation's busiest patent jurisdictions.

Confronted with the EDTX verdict, Seagate parrots the district court's speculation that "'it is highly unlikely' that the Texas case involved 'exactly the same' arguments." SGT38 (citing A44 n.24). "Conjecture and speculation are not competent evidence, however." *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 429 (Fed. Cir. 1986). Seagate does not dispute the *actual* facts cited by Convolve: the two cases' "user interface" constructions are virtually identical, and both share the

same accused "user interface"—*i.e.*, the industry-standard ATA-interface. CNV16; SGT36-37; A6000.

Convolve is not "attempt[ing] to bind" appellees to the EDTX verdict. SGT38. Rather, Convolve cites that verdict as powerful evidence that "a reasonable jury could return a verdict for [Convolve]." *Anderson*, 477 U.S. at 248. That is hardly an "extraordinary assertion." SGT38. Indeed, it "would be remiss to overlook" this evidence of what an *actual*—not hypothetical—jury found when presented the industry-standard ATA interface and a virtually-identical claim construction. *Cf. Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008); *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1327 (Fed. Cir. 2010) (infringement finding against one standardized product creates "persuasive case" against another).

Following trial, the EDTX case was reassigned to a new magistrate judge, who recently sustained the verdict against ATA-interface drives over multiple JMOL motions. A5051-52; A5063-65. ***Thus, a jury and <u>two</u> judges have determined that the ATA interface is a claimed "user interface."*** *Id.*; A2577-79 (¶¶ 277-80); A2121-22; A2124-25.

III. SUMMARY JUDGMENT OF INTERVENING RIGHTS SHOULD BE VACATED

Seagate cherry-picks facts from the intrinsic record in an unsuccessful attempt to justify the district court's improper *per se* analysis concerning Convolve's clarifying amendment. Seagate fails to respond to Convolve's argument that the district court incorrectly applied the "broadest reasonable interpretation" rule in the litigation context, which led to misunderstanding the prosecution history, including an inappropriate dismissal of the highly-relevant 2001 amendment over Rowan. Seagate's purported analysis of the claim language and specification is as superficial as the district court's, and is inconsistent with the entirety of the claim, the patent as a whole, and appellees' prior construction of "acoustic noise."

A. Seagate Fails To Cure The File History Analysis Tainted By The Broadest Reasonable Interpretation

Seagate did not respond to Convolve's argument that the district court's alleged identity analysis applied an improper standard. CNV47-48. The failure to distinguish between the PTO's "broadest reasonable interpretation" and the claim construction methodology applicable in litigation infected the district court's entire file history analysis. Seagate's cursory and incomplete file history analysis does not cure these defects; instead it highlights why intervening rights should have been denied, as occurred in EDTX. SGT47-48; A3186.

Seagate states, without citation, that "[i]n 2008, the asserted claims were substantively amended to overcome a patentability rejection by the PTO." SGT40. Both Seagate and the district court rely on claim rejections during reexamination for the proposition that the PTO found the claims "anticipated" by Koizumi. SGT41; A48-49. In proper context, this fact alone does not create intervening rights; however Seagate—like the district court—jumps to the improper conclusion that the subsequent amendment was necessary and therefore "substantive." SGT41-42; A48-49. Contrary to this leap, there are "many situations" in which an amendment in reexamination, made to overcome rejection under the PTO's broadest reasonable interpretation, is not substantive under 35 U.S.C. § 252—*i.e.*, where, as here, "the scope of the amended claim is substantially identical to that of the original patent claim, as the original patent claim would have been interpreted by a district court" under the *Phillips* framework. SGT42; A50. *See* Off. Patent Trial Prac. Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116-17 (Fed. Cir. 1987) (addition of clarifying antecedent clause, in response to § 112 rejection, to make clear what was already implied, was not substantive amendment).

The district court was obligated to do its own analysis under the *Phillips* framework rather than presume that the PTO—which used the inapplicable "broadest reasonable interpretation" standard—had already done this job during

reexamination. A4929-30 ("[T]he examiner has simply asserted that Koizumi teaches that unwanted acoustic noise is reduced when silent mode is selected, thereby anticipating the broadest reasonable interpretation of the claim language."). The error was further compounded when the district court used this short-circuited analysis to dismiss the overwhelming evidence that, in fact, the amendment was contemporaneously understood and stated to be clarifying. A51, A57.

Seagate simply adopts and quotes wholesale the district court's improper dismissal of the evidence showing the amendment was "clarifying." SGT47. That is, based simply on the 2008 rejection under the "broadest reasonable interpretation" standard, which is inapplicable in litigation, both Seagate and the district court dismiss the PTO's characterizations of the amendment as clarifying and ignore the other evidence throughout the reexamination that is consistent with this understanding. In the 6/16/08 Office Action, the examiner simply states that Convolve's interpretation "[could] not be gleaned from the language of the claims as they presently exist in the '473 patent." A4929. An examiner interview was held in response to this office action; both Convolve and the Examiner provided interview summaries that confirmed the proposed amendment discussed therein was "clarifying." A2704; A2724-25, A2727. Convolve's Remarks also stated that the claims were amended "to clarify that the acoustic noise level being reduced is seek noise." A2726. In response to the Reply and Examiner Interview, the claims

as clarified were allowed. A2711-13. The Examiner did not contest the content of either Convolve's interview summary or its categorization of the amendment as clarifying.

Seagate argues that the 2001 Amendment "nowhere stated that the amended claims would be limited to reductions of 'seek acoustic noise.'" SGT48. This is not true. Convolve specifically stated that "all of the independent claims have been amended herein to state that the noise to be reduced during a seek operation is acoustic noise." A1910. Moreover, Convolve distinguished the Rowan reference because Rowan's "acoustic noise reduction … deals only with control of the spindle motor, not with control of seek." *Id.* Seagate admits that the April 2001 Amendment "distinguish[ed] Koizumi and Rowan as reducing the spindle speed." SGT48. These statements alone show that the district court's definition of "acoustic noise" as inclusive of spindle motor noise is wrong. Indeed, appellees cited this Amendment to support their construction excluding spindle noise from the scope of "acoustic noise." A656. As Compaq's expert testified, the '473 patent—as originally issued—"can only achieve acoustic noise reduction in the seek" and "can't quiet the spindle." A2867.25 (Tr. 379).

Seagate provides no answer for the district court's failure to consider the entirety of the prosecution history and faulty assumption that the re-examiner considered—but rejected—the prior prosecution when requesting the clarifying

amendment. A56-57. Because the examiner was applying a "broadest reasonable interpretation" analysis during the reexamination proceeding, his analysis was expressly limited to the broadest reasonable interpretation of the claim language, consistent with the specification. A4929; CNV51-52. This is no substitute for the proper *Phillips* analysis.

Simply put, a proper POSITA analysis of the prosecution history—repeatedly referring to the amendment as clarifying and distinguishing prior art "deal[ing] only with control of the spindle motor, not with control of seek"—does not support the conclusion that the "acoustic noise" of the original claims had a different scope, encompassing spindle noise. A1906-13; A1852.

B. Seagate's Argument Regarding The Claim Language And Specification Contradict Appellees' Prior Claim Construction Arguments

Seagate's primary claim language argument is that intervening rights is proper, simply because Convolve's amendment "added 'a new modifier." SGT43. This superficial analysis amounts to an improper *per se* rule. *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1361 (Fed. Cir. 1991) ("Identical" under 35 U.S.C. § 252, "does not mean verbatim."). Moreover, this new position contradicts appellees' prior *Markman* position, which construed the original claim language "acoustic noise"—before the addition of the modifier—to exclude "audible noise emanating from the spindle motor." A656. Seagate's tactical shift is a transparent

attempt to improperly "shield" appellees behind the doctrine of intervening rights. The "purpose" of the doctrine is not served by allowing Seagate to now allege it is prejudiced by an understanding of the original claim scope that appellees themselves espoused before the amendment. SGT40.

In its principal brief, Convolve showed how reading "acoustic noise" on spindle and other, unspecified acoustic noise (A58) improperly read "inverse relation" and "in accordance with" out of the claims. CNV22-24, 49-50. Seagate attempts to dismiss the required inverse relationship between the seek time and acoustic noise by pointing to a specification passage concerning an inverse relation between power consumption and seek time. SGT49. This fails, however, because that section discusses an unclaimed embodiment that is "irrelevant to the claimed invention," which claims an inverse relation between *seek* time and *seek* noise. *MyMail, Ltd. v. Am. Online, Inc.*, 476 F.3d 1372, 1377 (Fed. Cir. 2007). Notably, Seagate now ignores the specification sections, regarding the inverse relation between noise level and seek time, that appellees cited in 2002 to support their construction excluding spindle noise from the scope of "acoustic noise." A656 (citing A130-31 (6:59-7:5 and 7:31-49). Seagate's failure to address the actual claim language and its selective specification citations are telling.

Seagate makes the unsupported statement that "there can be an inverse relation between seek time and many types of disk drive noise, including spindle

noise." SGT49. It is not surprising that no intrinsic record support is provided, because none exists. "Seek time," as defined in the '473 patent, has nothing to do with the spindle motor. A269-70; A132 (10:15-21). Seagate's statement, that "slowing the spindle motor" yields a "predictable" inverse relation between seek time and acoustic noise, is attorney argument devoid of evidentiary support. SGT51. A POSITA, after reading the '473 patent, would agree with the inventor and appellees' own experts that "Convolve technology affects the seek portion of the acoustics" and does not "affect the idle acoustics" of the spindle motor. A5841 (Tr. 786-87); A2867.25 (Tr. 379); A2803 (Tr. 194-95).

Seagate criticizes Convolve's specification-based argument because the specification "never uses the phrase 'seek acoustic noise.'" SGT45. Semantic word-games aside, the specification also "never uses the phrase" spindle or any terminology referencing spindles or spindle acoustics. CNV25-26. Yet Seagate and the district court reach well-beyond the specification's teachings to read the claims on spindle acoustics. A58; SGT43. *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1301 (Fed. Cir. 2004). The annotated disk drive reproduced at SGT10 is not even from the '473 patent, which does not depict or number the spindle motor for description. A109; CNV25-26. Seagate's need to go beyond the patent's four corners to depict a spindle motor highlights the district court's faulty construction.

Pressed to find any specification support for its spindle noise construction, Seagate quotes boilerplate that "'the invention can be used to control *any* dynamic system.'" SGT46. Such "boilerplate," however, "carries little weight" in claim construction, *Les Traitments Des Eaux Poseidon, Inc. v. KWI, Inc.*, 135 F. Supp. 2d 126, 135 (D. Mass. 2001), and cannot impart "broader meaning" to claim scope dictated by other intrinsic evidence, *Interdigital Commc'ns, Inc. v. ITC*, 2015 WL 669305, *7 (Fed. Cir. Feb. 18, 2015) (A6283-94). Seagate ignores almost all of Convolve's specification evidence "'repeatedly, consistently, and exclusively'" tying seeks to acoustic noise. CNV24-26, 48-49; SGT45-46. *Irdeto*, 383 F.3d at 1303. The '473 patent's repeated, consistent, and exclusive use of "acoustic" and "noise" to denote acoustics generated by the seeking/moving actuator arm "manifest[s] the patentee's clear intent to so limit the term." *Id.*

A proper analysis of the '473 patent's numerous passages, linking the "acoustic noise" of the original claim language to seek operation and the discussion of the inverse relationship between seeks and acoustic noise, highlights that the scope of the original "acoustic noise" claim language is limited to seek noise, and excludes spindle acoustics. A128 (1:15-20, 28-36), A109 (Fig. 10A), A137 (19:6-32), A128 (2:5-10, 2:13-16), A130-31 (6:65-7:5), A131 (7:31-35), A132 (9:55-67, 10:22-28, 10:58-62), A137 (20:24-29), A141 (27:59-62), A148 (42:4-9). Seagate's attempts to now abandon appellees' prior argument, that the

term "acoustic noise" in the original claims "does not include electrical noise or audible noise emanating from the spindle motor," should be rejected. A656.

C. The District Court Claim Interpretation Analysis Was Incomplete And Is Not Entitled To Deference

In a footnote, Seagate suggests that the district court gave "acoustic noise" the meaning it would have to a POSITA, and that this "finding" is entitled to deference. SGT43 n.4. The district court mentioned a POSITA one time—in summarizing Convolve's arguments. A47. Moreover, to the degree the district court provided any analysis regarding how a POSITA would construe "acoustic noise," it was scant and excluded extrinsic evidence. A53. Therefore, contrary to Seagate's assertion, this Court's review remains *de novo*. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015).

Had the extrinsic evidence been considered, it would have gutted appellees' intervening rights defense. CNV26-28, 52-53. Seagate does not contest that appellees' experts both testified that the asserted claims—*as originally issued*—had nothing to do with spindle noise. SGT51-52; CNV26-28. Unable to explain this testimony from appellees' own camp, Seagate impugns it as irrelevant to claim construction. SGT51. But expert testimony, particularly under cross-examination, remains highly relevant to ensure that the Court's construction is consistent with that of a POSITA. *Phillips*, 415 F.3d at 1318; *Teva*, 135 S. Ct. at 841. Here, appellees' experts' cross-examination demonstrates that intervening rights was

grounded in a spindle noise construction no POSITA would make. A2803 (Tr. 194-95), A2867.25 (Tr. 378-379).

Under the proper litigation *Phillips* analysis, the amended claims are substantially identical to the original claims. CNV20-29, 44-55. The district court's "facially nonsensical" spindle noise construction "'cannot be correct.'" *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1255 (Fed. Cir. 2010).

D. Seagate Ignored The EDTX Rejection Of Intervening Rights

Seagate's argument fails to respond to the EDTX court's rejection of "the very same intervening rights defense." CNV29-30, 55; SGT39-52. "Given 'the importance of uniformity in the treatment of a given patent,'… this court would be remiss to overlook [the EDTX] construction" (*Finisar*, 523 F.3d at 1329), holding that "the 'acoustic noise' of the original claims was that generated by and associated with seek operations" (A3186).

IV. SUMMARY JUDGMENT ON "COMMANDS" SHOULD BE VACATED

A. Compaq Does Not Dispute That Seagate Drives Output Shaped Commands

Compaq never contests that Seagate drives, installed in accused Compaq computers, output shaped commands.[4] Instead, Compaq's "commands" argument focuses exclusively on the BIOS processor. Although Compaq characterizes as "irrelevant" the uncontested fact that the drive processor outputs shaped commands, this fact satisfies the "commands" limitation for the separate infringement theories that: (1) Compaq's computers generate the F10 BIOS user interface and the processor in Seagate's ATA drives outputs shaped commands, and (2) the same processor in Seagate's drives generates the ATA/SCSI user interfaces and outputs shaped commands.

B. Compaq's New Claim Construction Argument Is Untimely And Fails On The Merits

Because Compaq cannot dispute that Seagate drives output shaped commands, it attempts *on appeal* to construct a prosecution disclaimer argument to both supersede the 2005 *Markman* Order and read this embodiment out of the claims. CPQ18, 22-23.

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[4] Compaq quibbles over whether counsel admitted that the underlying Seagate drives output shaped commands, but never otherwise addresses Convolve's evidence. CPQ18-19, n.3.

First, this argument is waived because appellees never raised it in their summary judgment briefs. A2215-17; A3226-27. Indeed, appellees relied on the 2005 "outputting commands" construction in seeking summary judgment. A3226-27. Compaq "may not [now] introduce new claim construction arguments on appeal or alter the scope of the claim construction positions it took below.'" *Digital-Vending Servs. Int'l, LLC v. Univ. of Phx., Inc.*, 672 F.3d 1270, 1273-74 (Fed. Cir. 2012) (refusing to consider "substantially different" construction on appeal).

Second, Compaq's argument that Convolve disavowed the 2005 "commands" construction collapses upon even cursory review of the reexamination file history.

In 2008, Seagate initiated the second '473 patent reexamination, which focused on the "Ray Thesis." A2555 (¶ 188); A2091. During reexamination, the Examiner purported to find a "user interface" in the firmware Ray incorporated "into the [RA73] drive that enabled … the ability of the drive to respond to commands from a host computer for altering the seek mode." A5522. Convolve traversed this specific rejection by showing how Ray lacks the "host computer" discussed in the Office Action. A5020-22. Convolve's Response never disclaimed the embodiment whereby commands are generated by the drive's

controller/processor. A132 (10:4-8). Indeed, that Response explained that the '473 Patent discloses that the code:

> is processed either by (i) the processor 25 of a host computer, (ii) a separate controller/processor 73 dedicated to the disk drive, or (iii) a combination of (i) and (ii).

A5013. When a later Office Action suggested that "the user interface runs on the processor of the host computer, but not on the processor of the disk drive," Convolve objected, because this "restrictive" construction ignored the disclosure that seeks can be controlled by a "separate controller/processor 73 dedicated to the disk." A5046-48. The PTO issued a NIIRC soon thereafter confirming all asserted claims. A6276-82. Compaq omits Convolve's Response correcting the PTO's "restrictive" construction.

Convolve disavowed nothing during reexamination. Convolve instead embraced the full claim scope disclosed in the specification—*i.e.*, the opposite of the "clear and unambiguous disavowal" required for disclaimer. *3M Innovative Props. Corp. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373 (Fed. Cir. 2003).

C. The '473 Patent Does Not Require The BIOS Processor To Output Shaped Commands

The district court erred when it assumed that the same processor must generate the user interface and output shaped commands. Compaq's opposition is

nothing more than a *post facto* attempt to justify this mistaken application of the claims.

First, the *Markman* Order twice deemed the embodiment whereby the drives themselves output shaped commands "within the scope of the claim[s]." A85-86. Indeed, the specification teaches that the actuator seeks "in accordance with control signals received from processor 73," which may be a "separate controller dedicated to the disk drive." A132 (10:6-14). Compaq's argument thus violates well-settled precedent that "claims should rarely, if ever, be construed to exclude a preferred embodiment." *Glaxo Grp. Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1347 (Fed. Cir. 2004).

Second, the claim language covers multi-processor embodiments. Compaq's analysis of the asserted claims is unavailing. Compaq argues that the claims require that only one processor be used, incorrectly asserting that claim 9—which requires "*a processor* which executes the process steps so as (1) to generate a user interface … and (iii) to output commands"—is representative of all asserted claims. CPQ19-20.[5] Claim 14, for example, does not recite "a processor" and instead recites "code for providing a user interface" and "code to output commands." A149-50. Nothing in this claim prevents separate processors from

[5] Even if claim 9 were limited to a single processor, Compaq computers infringe claim 9 insofar as the disk drive processor therein generates the ATA/SCSI interface and outputs shaped commands. *Infra* Part IV.A.

executing each respective code element. Nevertheless, use of "a" in the "a processor" language of claim 9 contemplates multi-processor embodiments. A85-86. Even Compaq acknowledges the "general rule that 'a' means 'one or more'" in a patent claims. CPQ20-21. Although it posits a novel exception when plural nouns appear elsewhere in a claim, it never presented this argument during *Markman* or summary judgment proceedings. "The exceptions to this rule," moreover, "are extremely limited." *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342-43 (Fed. Cir. 2008). Nothing here compels applying this "extremely limited" exception in the novel way posited by Compaq, particularly considering the embodiment wherein seeks are controlled by "a separate controller dedicated to the disk drive." A132 (10:6-14); A5013; A5046. *See Harari v. Lee*, 656 F.3d 1331, 1341-42 (Fed. Cir. 2011) (cited at CPQ20-21) (citing specification re whether limited exception applied).

Third, Convolve never admitted that all asserted claims are the same with respect to the "commands" element. CPQ21. Convolve instead argued that the Seagate drives within Compaq computers satisfied the "output commands" element in the same way for each asserted claim. A2354-55. Indeed, the claims charts cited by Compaq identify *Seagate's drives* in Compaq's computers as "carrying out" the commands element. A4046-049 (cross-referencing A4028-32), A4090-94 (cross-referencing A4072-77); A4120-25. Compaq cites Convolve's summary

judgment opposition, but those papers again cite shaped commands in Seagate's drives. A2354. This was fully consistent with the 2005 construction, allowing shaped commands to "originate from within" the disk drive. A86. Compaq shows no error in that Order.

V. COMPAQ'S REHASHED "INVERSE RELATION" ARGUMENT SHOULD BE REJECTED

Compaq fully briefed its "inverse relation" argument in *Convolve I*. A5589-93, A5601-18; A5673-74. The record, however, was deemed "insufficient" to permit summary adjudication on appeal. A2032. On remand, the district court again declined to reach this argument. A24-25.

Back in this Court once again, Compaq rehashes the same "inverse relation" argument, with paragraphs and *whole pages* "cut and paste" from its 2012 brief:

2015 Brief	**2012 Brief**
CPQ10-12	A5590-93
CPQ25	A5601
CPQ26	A5603
CPQ26-28	A5604-07

Compaq does not "deserve[] an opportunity to go over the same ground twice, hoping that the passage of time or changes in the composition of the court will provide a more favorable result the second time." *Cent. Soya Co. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1580 (Fed. Cir. 1983). Law-of-the-case aside, Compaq's argument fails on the merits.

A. Compaq's Inverse Relation Argument Lacks Merit

The asserted claims do not require the "inverse relation" between seek time and seek acoustics to hold true for every seek. A149-50. Compaq reads this limitation into the claims by misreading the specification, reexamination file history, and Convolve's expert testimony. CPQ26-29.

Compaq cites the specification and Convolve's *Markman* brief (CPQ10-11, 26-27), but nothing therein *requires* the inverse relation to hold for all seeks. A3884-85. Indeed, the specification states that some seeks, already consisting of "good moves," will have no additional shaping; for these good moves, a setting change will have no effect on seek time/noise for the resulting seek. A137 (19:6-31), A139 (23:8-37); A3179. Compaq argues that these passages are irrelevant (CPQ29, n.4), but the specification remains "the single best guide to the meaning" of inverse relation. *Phillips*, 415 F.3d at 1315. Compaq's "all seeks" construction improperly excludes this embodiment. *Glaxo*, 376 F.3d at 1347.

Compaq's file history argument fares no better. CPQ11, 27-29. During reexamination, Convolve and its experts argued that Koizumi failed to *inherently* disclose a "inverse relation," which was not *necessarily present* or ensured. A4794-95; A4177-78 (¶ 39); CPQ27 (block-quoting description of Koizumi's "unpredictable" seek acoustic results). Specifically, Convolve argued that acoustic noise is variable because of "seek distance and the physics of the drive," and that,

"[b]ecause of this variability, Koizumi does not 'necessarily' reduce selected audible seek frequencies when he changes [modes]." A4794-95; A4811-12 (¶¶ 24-26). Both Convolve and its expert set-off, with quotation marks, the word "necessarily" (*id.*), a term-of-art from this Court's inherent anticipation precedents. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002).

Because Koizumi did not *explicitly* disclose an "inverse relation," it could do so *inherently* only if the "inverse relation" was always and necessarily present, "not merely probably or possibly present." *Trintec*, 295 F.3d at 1295. Convolve merely showed how Koizumi's "[o]ccasional results are not inherent," *Mehl/Biophile Int'l v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999), but did not argue that the "inverse relation" must hold for all seeks. *Lucent Techs. v. Gateway, Inc.*, 525 F.3d 1200, 1211-12 (Fed. Cir. 2008) (no disclaimer where patentee characterizes prior art to distinguish claimed subject matter and "d[id] not constrain the definition" of claim term).

The EDTX court reviewed the reexamination file history and rejected an "all seek lengths" construction. A3179-80; CPQ34. Compaq's only response is that the experienced EDTX judge was "mistaken" about how to read file history. CPQ34. Moreover, even after Compaq first raised its construction in 2009 (A2596 (¶¶ 346-350)), Seagate's expert maintained that *one seek length* suffices to show the inverse relation. A5735 (¶ 18). Obviously he did not "reasonably believe that

[Convolve] had surrendered" claim scope during reexamination. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1457 (Fed. Cir. 1998).

Convolve's inherency arguments during reexamination thus did not disavow claim scope. At most, the file history is ambiguous and cannot constitute "a clear disavowal of claim scope." *AquaTex Indus., Inc. v. Techniche Solutions*, 419 F.3d 1374, 1381 (Fed. Cir. 2005).

Compaq's argument regarding Convolve's *litigation* experts is grossly misleading. Compaq claims they used the term "inherent"—not as a term-of-art—but colloquially "to mean that the inverse relationship must hold for every seek." CPQ33. Compaq, however, omitted from its Appendix submission the "Legal standard" section of those experts' report, explaining inherent anticipation. *Compare* CPQ12 (citing A4189-94), *with* A5088-89; A3373; *see* A5103, A5106 (rebutting inherency arguments). Compaq similarly crops Dr. Souri's transcript. CPQ33 (citing A4184-85 (Tr. 268-69)). But just three pages later, Dr. Souri directs *the same counsel who signed Compaq's brief* to the "legal standard" for inherent anticipation in his rebuttal report. A5267 (Tr. 272-73); A3374-80.

B. <u>All Accused Products Show The "Inverse Relation"</u>

Compaq does not dispute that all accused products meet the "inverse relation" for at least certain seek operations. A2349-50.

ATA drives: Convolve cited expert opinion (A2600-02 (¶¶ 369-380); A2447-49 (¶¶ 201-209)), witness testimony (A2603-04 (¶¶ 385-86)), and Compaq records showing that "Quiet Seek" drives in Compaq computers have the inverse relation (A2573-74 (¶ 260), A2602-03 (¶¶ 381-384)). Compaq ***required*** drives to have this inverse relation. A2608-10 (¶¶ 402-413).

SCSI drives: Convolve cited Seagate records (A2604-05 (¶¶ 387-94)) and expert opinion showing the inverse relation in accused SCSI drives (A2605-07 (¶¶ 395-99); A2449-52 (¶¶ 210-11)).

Appellees' "part-time infringement is nonetheless infringement." *SunTiger, Inc. v. Scientific Res. Funding Grp.*, 189 F.3d 1327, 1336 (Fed. Cir. 1999). Summary judgment on the "inverse relation" element should be denied.

CONCLUSION

For these reasons, summary judgment should be vacated, Compaq's alternative argument should be rejected, and the case should be remanded for a prompt jury trial.

Dated: May 1, 2015

Respectfully submitted,

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United States Court of Appeals for the Federal Circuit

CERTIFICATE OF SERVICE

2014-1732

I, Natasha S. Johnson, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

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On **May 1, 2015**, Counsel for Appellant has authorized me to electronically file the foregoing **Reply Brief of Plaintiff-Appellant** with the Clerk of Court using the CM/ECF System, which will send notice of such filing to the following registered CM/ECF users:

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