

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Norfolk Division

VIRGINIA INNOVATION
SCIENCES, INC.,

Plaintiff,

v.

Case No.: 2:12cv548

SAMSUNG ELECTRONICS CO.,
LTD., ET AL.,

Defendants.

OPINION AND ORDER

This matter is currently before the Court on a motion for summary judgment filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively "Samsung" or "Defendants"). ECF No. 134. The motion has been fully briefed and is therefore ripe for decision.

After examination of the briefs and the record, the Court determines that a hearing is unnecessary, as the facts and legal arguments are adequately presented, and the decisional process would not be aided significantly by oral argument. See Fed. R. Civ. P. 78(b); E.D. Va. Loc. Civ. R. 7(J). For the reasons that follow, Defendants' motion seeking summary judgment is **GRANTED**, in part, and **DENIED**, in part.

I. FACTUAL BACKGROUND

At issue in this case are five¹ patents: U.S. Patent No. 7,899,492 ("the '492 patent"), U.S. Patent No. 8,050,711 ("the '711 patent"), U.S. Patent No. 8,145,268 ("the '268 patent"), U.S. Patent No. 8,224,381 ("the '381 patent"), and U.S. Patent No. 8,135,398 ("the '398 patent"). All of the patents-in-suit claim priority to the '492 patent, which itself claimed priority to provisional application number 60/588,359, filed on July 16, 2004. The '711, '268, and '381 patents are continuations of the '492 patent and all four share a substantively identical specification ("the '492 specification"). U.S. Patent No. 7,957,733 ("the '733 patent"), which is not at issue in this case, was filed on May 22, 2007 as a continuation-in-part of the '492 patent. The '398 patent is a continuation from the '733 patent. The shared specification of the '733 and '398 patents ("the '398 specification") includes all of the '492 specification along with additional material. It is the addition of this new material which prevents the '398 patent from claiming priority back to the filing of the '492 patent and entitles it to the later priority date of May 22, 2007, the filing date of the '733 patent. Each of the patents-in-suit describes inventions intended to resolve the inconvenience and

¹ Previously, there were six patents at issue in this case. However, U.S. Patent No. 7,957,733 ("the '733 patent") is no longer asserted as infringed. Agreed Dismissal Order, ECF. No. 408.

impracticability of viewing multimedia content on the small screens of mobile terminals.

A. The '492 Patent Family

The '492, '711, '268, and '381 patents (collectively, "the '492 patent family") are each titled "Methods, Systems and Apparatus for Displaying Multimedia Information from Wireless Communication Networks." Their shared specification and respective claims are directed toward methods, systems, apparatuses, and computer-readable mediums that can be utilized to convert multimedia signals, appropriate for displaying content on a mobile terminal, into signals appropriate for display on an alternative display terminal.

B. The '398 Patent

The '398 patent is entitled "Methods and Apparatus for Multimedia Communications with Different User Terminals." Its specification and claims are directed toward methods, systems, apparatuses, computer programs, and computer-readable mediums for providing "multimedia content to and from various different devices" through the conversion and sending or routing of such content. E.g., '398 patent 1:47-49. As noted above, the '398 patent issued from a continuation of the '733 patent, which was itself a continuation-in-part of the '492 patent. Id. at 1:21-31. Thus, the '398 patent claims priority to the filing date of the '733 patent, May 22, 2007. However, it may claim priority

back to the filing date of the '492 patent for claims the subject matter of which flow directly from the '492 patent. Tech Licensing Corp. v. Videotek, Inc., 545 F.3d 1316, 1326 (Fed. Cir. 2008) ("In essence, [35 U.S.C. § 120] means that in a chain of continuing applications, a claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶ 1, including the written description requirement, with respect to that claim."); see also, Cordance Corp. v. Amazon.com, Inc., 658 F.3d 1330, 1334 (Fed. Cir. 2011).

II. PROCEDURAL HISTORY

In the instant patent infringement action, plaintiff Virginia Innovation Sciences, Inc. (hereinafter "Plaintiff" or "VIS") alleges that Defendants have directly, indirectly, and willfully infringed the patents-in-suit by making, using, offering for sale, selling, and/or importing a wide range of accused products, including smartphones, tablets, Blue-ray players, and hubs. Samsung denies VIS's claims of infringement and asserts several affirmative defenses, including invalidity of all patents-in-suit, prosecution history estoppel and other equitable doctrines. Additionally, Samsung asserts counterclaims seeking declarations of non-infringement and invalidity for each of the patents-in-suit.

The Court held its Markman hearing in this matter on June 11, 2013 and issued its Markman opinion on September 25, 2013. ECF No. 198. Since the Markman hearing, there have been numerous filings in this matter and several motions remain pending before the Court, in various stages of briefing. By Order of October 25, 2013, the Court joined for trial this matter and Virginia Innovation Sciences, Inc. v. Samsung Electronics Co., Ltd., et al., Case No. 2:13cv322. ECF No. 353. The trial of the two matters is now set for April 21, 2014. On November 15, 2013 the Court ruled on Defendants' Motion to Dismiss VIS's Claim for Willful Infringement; granting, in part, and denying, in part such motion. ECF No. 395. The Court found that the claim for willful infringement failed to state a plausible claim for relief with regard to willful infringement of the '711, '268, and '381 patents.

After first reciting the applicable standard of review, the Court will address the Defendants' Motion for Summary Judgment of Patent Invalidity and No Willful Infringement filed August 13, 2013 and the associated responses and briefs. ECF No. 134, 135, 144, 159, 163, and 168.

III. STANDARD OF REVIEW

A. Summary Judgment

The Federal Rules of Civil Procedure provide that a district court shall grant summary judgment in favor of a movant

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