

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

TRACBEAM L.L.C.,

Plaintiff,

vs.

AT&T INC. ET AL.,

Defendants.

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CASE NO. 6:11-CV-96

MEMORANDUM OPINION AND ORDER

Before the Court are the following motions:

- Defendants AT&T Inc. and AT&T Mobility L.L.C.’s (“AT&T”) Motion for Summary Judgment of Invalidity¹ (Docket No. 444);
- AT&T’s Motion for Partial Summary Judgment of Non-Infringement (Docket No. 445);
- AT&T’s Motion to Exclude the Expert Opinions of Robert Mills (Docket No. 446);
- AT&T’s Motion to Exclude Dr. Rose’s Opinions on Claim 25 (Docket No. 447);
- AT&T’s Motion for Summary Judgment of No Willful Infringement (Docket No. 448);
- Plaintiff TracBeam L.L.C.’s (“TracBeam”) Motion for Leave to Rely Upon Supplemental Expert Reports (Docket No. 452); and
- AT&T’s Motion for Continuance (Docket No. 509).

¹ In its response brief, Plaintiff TracBeam L.L.C. requests the Court grant summary judgment in its favor and find the original application fully discloses and supports asserted claims 25 and 162 of U.S. Patent No. 7.764.231.

BACKGROUND

The Court heard oral arguments for these motions on October 18, 2013 and October 24, 2013. Having considered the parties' written submissions and oral argument, the Court **DENIES** AT&T's Motion for Summary Judgment of Invalidity (Docket No. 444); **GRANTS IN PART** and **DENIES IN PART** AT&T's Motion for Partial Summary Judgment of Non-Infringement (Docket No. 445); **GRANTS IN PART** and **DENIES IN PART** AT&T's Motion to Exclude Dr. Rose's Opinions on Claim 25 (Docket No. 447); **GRANTS** AT&T's Motion for Summary Judgment of No Willful Infringement (Docket No. 448); **GRANTS** TracBeam's Motion for Leave to Rely Upon Supplemental Expert Reports (Docket No. 452); and **GRANTS IN PART** and **DENIES IN PART** AT&T's Motion for Continuance (Docket No. 509).

AT&T'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

TracBeam sued a number of cell-phone related defendants in February 2011, including AT&T, for infringement of claims 25 and 162 ("asserted claims") of U.S. Patent No. 7,764,231 ("the '231 Patent"). The technology is directed to using multiple location techniques to pinpoint a geographic location. AT&T asserts claims 25 and 162 fail the written description requirement of 35 U.S.C. § 112, ¶ 1, and moves for summary judgment of invalidity. In response, TracBeam requests that the Court grant summary judgment in its favor and hold the claims do meet the written description requirement.

APPLICABLE LAW

Federal Rule of Civil Procedure 56(a) provides for summary judgment when "there is no genuine dispute as to any material fact." A dispute about a material fact is genuine if "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). When the summary judgment

movants demonstrate the absence of a genuine dispute over any material fact, the burden shifts to the non-movant to show there is a genuine factual issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323–24 (1986). Mere conclusory allegations are not competent summary judgment evidence, and thus are insufficient to defeat a motion for summary judgment. *Eason v. Thaler*, 73 F.3d 1322, 1325 (5th Cir. 1996). A court must draw all reasonable inferences in favor of the non-moving party. *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1378 (Fed. Cir. 2007).

The written description requirement found in 35 U.S.C. §112, ¶ 1 prevents an applicant from later asserting that he invented that which he did not. *Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1330 (Fed. Cir. 2003). To “guard[] against the inventor’s overreaching,” the written description requirement “insist[s] that [the inventor] recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991). This means that all of the limitations must appear in the specification. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. *Id.* Rather, the application itself must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. *Id.*

Compliance with the written description requirement is assessed with respect to the application as filed, not the specification as issued. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). New claims or other added material must find support in the original specification. *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. GE*, 264 F.3d 1111, 1118 (Fed. Cir. 2001). Thus, as a matter of law, the written description requirement cannot be met by new matter added during prosecution. *See Ariad*, 598 F.3d at

1336. Compliance with the written description requirement is amenable to summary judgment in cases where no reasonable fact finder could return a verdict for the non-moving party. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed. Cir. 2008).

ANALYSIS

AT&T argues the asserted claims require a mobile station receiving satellite signals but the original specification does not provide support for a mobile station (e.g., a cell phone) receiving satellite signals. The parties agree the asserted claims require a mobile station that receives satellite signals and that the original specification discloses a mobile *base* station that receives satellite stations. However, AT&T's argues the disclosure a mobile base station receiving satellite signals is insufficient to meet the written description requirement.

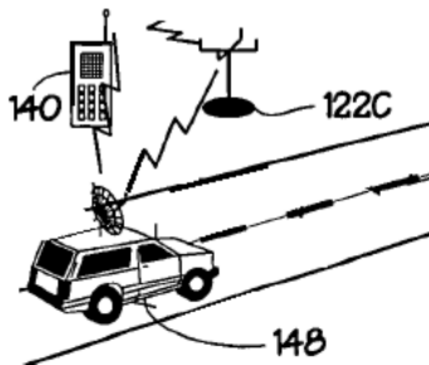
TracBeam counters the written description requirement is met by one of two theories. First, TracBeam argues the specification discloses a mobile station receiving satellite signals because it discloses an embodiment of a mobile *base* station that contains both a mobile station and a GPS receiver. The mobile base station receives satellite (GPS) signals via its GPS receiver. TracBeam contends this embodiment therefore "discloses the receipt of satellite signals *at a mobile station.*" Docket No. 490 at 2 (emphasis added).

However, the asserted claims are not satisfied by the receipt of satellite signals *at* the mobile station. The claims require the mobile station itself to receive the satellite signals. The specification describes a mobile base station containing a satellite (GPS) receiver and a mobile station as separate and distinct components. Docket No. 444 at 12; U.S. Patent Application No. 09/194,367 at 17–18 (filed Nov. 24, 1998). While it may be an obvious variation to move the GPS receiver from the mobile base station to the mobile station, obvious variations do not satisfy the written description requirement. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed.

Circ. 1997) (“[I]t is not sufficient for purposes of the written description requirement of 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”).

TracBeam’s second theory, however, presents a genuine question of fact. TracBeam asserts the written description requirement is satisfied because the originally-filed specification’s disclosure of a mobile base station meets all the limitations of the Court’s construction of the claim term “mobile station.”² The Court construed mobile station as “a mobile wireless device that is at least a transmitting device and may include a receiving device.” Docket No. 352 at 4. Conversely, AT&T argues a mobile base station is not a “wireless device.” Docket No. 479 at 1.

AT&T argues the specification clearly delineates between a mobile base station and a mobile station. According to AT&T, the specification generally describes a mobile station as a



mobile phone and a mobile base station as “a part of the network infrastructure that receives and processes wireless communications from the mobile station.” Docket No. 444 at 1. For example, Fig. 4, reproduced to the left, illustrates how the patentee used the terms mobile station (140) and mobile base station (148). ‘231 Patent, Fig. 4.

TracBeam contends that mobile base stations and mobile stations are not limited to the Fig. 4 embodiment. Rather, the original specification discloses a mobile base station is a piece of equipment for wireless communication that transmits and receives signals. TracBeam asserts this meets the limitations of (1) a wireless device that (2) at least transmits, and (3) may include a

² The Court did not construe the term “mobile base station.” Moreover, “mobile base station” does not appear in claim 25 or 162.

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