

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

M2M SOLUTIONS LLC,

Plaintiff,

v.

SIERRA WIRELESS AMERICA, INC. and
SIERRA WIRELESS, INC.,

Defendants.

Civil Action No. 12-30-RGA

MEMORANDUM OPINION

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ANDREWS, U.S. DISTRICT JUDGE:

Presently before the Court are two summary judgment motions: Defendants' Motion for Summary Judgment of Invalidity (D.I. 181) and Defendants' Motion for Summary Judgment of Non-Infringement (D.I. 185). The motions are fully briefed. (D.I. 182, 186, 205, 207, 216, 217).¹ For the reasons that follow, I will deny both motions in their entirety.

I. BACKGROUND

On January 13, 2012, Plaintiff M2M Solutions LLC filed five related patent infringement actions asserting infringement of U.S. Patent Nos. 8,094,010 ("the '010 patent") and 7,583,197 ("the '197 patent"). The Court held a *Markman* hearing, after which it invalidated the '197 patent and construed several claim terms in the '010 patent. (D.I. 92). Subsequently, in a Memorandum Order deciding multiple defendants' joint motion for reconsideration of the Court's claim construction order, the Court addressed certain indefiniteness arguments that Defendants raise again in their current invalidity motion. (D.I. 215). The Court also issued a Memorandum Opinion on summary judgment motions in Plaintiff's related case against Telit (the "Telit SJ opinion"), which is relevant to certain issues raised here. (C.A. No. 12-33-RGA, D.I. 247).

The '010 patent claims a "programmable communicator device" that is capable of receiving transmissions, authenticating them using a particular form of coded number authentication, and storing numbers from authenticated transmissions in a list of permitted callers. ('010 patent, abstract & claim 1). The patent further contemplates a device that is remotely programmable and that allows for remote data monitoring, "which can be used to relay

¹ Unless otherwise specifically noted, all references to the docket refer to Civil Action No. 12-30-RGA.

information about the status of a remote piece of technical equipment such as a vending machine.” (*Id.* col. 3, ll. 43–47; *id.* col. 4, ll. 3–7; *id.* col. 7, ll. 24–30).

II. LEGAL STANDARD

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” FED. R. CIV. P. 56(a). The moving party has the initial burden of proving the absence of a genuinely disputed material fact relative to the claims in question. *Celotex Corp. v. Catrett*, 477 U.S. 317, 330 (1986). Material facts are those “that could affect the outcome” of the proceeding, and “a dispute about a material fact is ‘genuine’ if the evidence is sufficient to permit a reasonable jury to return a verdict for the nonmoving party.” *Lamont v. New Jersey*, 637 F.3d 177, 181 (3d Cir. 2011) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The burden on the moving party may be discharged by pointing out to the district court that there is an absence of evidence supporting the non-moving party’s case. *Celotex*, 477 U.S. at 323.

The burden then shifts to the non-movant to demonstrate the existence of a genuine issue for trial. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586–87 (1986); *Williams v. Borough of West Chester, Pa.*, 891 F.2d 458, 460–61 (3d Cir. 1989). A non-moving party asserting that a fact is genuinely disputed must support such an assertion by: “(A) citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations . . . , admissions, interrogatory answers, or other materials; or (B) showing that the materials cited [by the opposing party] do not establish the absence . . . of a genuine dispute” FED. R. CIV. P. 56(c)(1).

When determining whether a genuine issue of material fact exists, the court must view the evidence in the light most favorable to the non-moving party and draw all reasonable

inferences in that party's favor. *Scott v. Harris*, 550 U.S. 372, 380 (2007); *Wishkin v. Potter*, 476 F.3d 180, 184 (3d Cir. 2007). A dispute is "genuine" only if the evidence is such that a reasonable jury could return a verdict for the non-moving party. *Anderson*, 477 U.S. at 247–49. If the non-moving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. *See Celotex Corp.*, 477 U.S. at 322.

III. DISCUSSION

A. Defendants' Motion for Summary Judgment of Invalidity (D.I. 181)

Defendants' Motion for Summary Judgment of Invalidity raises three issues. First, Defendants argue that the '010 patent is invalid for failure to meet the written description and enablement requirements of 35 U.S.C. § 112. (D.I. 182 at 7–11). Second, Defendants argue that the '010 patent is invalid as indefinite because the processing module claim limitation is an improper hybrid claim, claiming both an apparatus and method steps. (*Id.* at 11–14). Third, Defendants argue that the '010 patent is invalid for containing means-plus-function claim terms without sufficient corresponding structure. (*Id.* at 14–19).

1. Written Description and Enablement

The written description requirement contained in 35 U.S.C. § 112, ¶ 1 requires that the specification "clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." *Ariad Pharm., Inc., v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (alteration in original) (internal quotation marks omitted). "In other words, the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* The written description inquiry is a question of fact. *See id.* Although

it is a question of fact, “[c]ompliance 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). “A party must prove invalidity for lack of written description by clear and convincing evidence.” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015).

The enablement requirement, considered a separate and distinct requirement contained in 35 U.S.C. § 112, ¶ 1, assesses whether “one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Because the enablement inquiry takes into account what is known to one skilled in the art, the Federal Circuit has “repeatedly explained that a patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.” *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1156 (Fed. Cir. 2004). “Enablement is a legal question based on underlying factual determinations.” *Vasudevan*, 782 F.3d at 684. Factors considered in assessing the enablement requirement include:

- (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988). “A party must prove invalidity for lack of enablement by clear and convincing evidence.” *Vasudevan*, 782 F.3d at 684.

Defendants argue that the “programmable interface” limitation does not meet the written description and enablement requirements. Defendants essentially make their written description and enablement arguments simultaneously, and do not meaningfully differentiate between the two requirements. (D.I. 182 at 7–11). Accordingly, I consider them jointly here. First, relying

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