UNITED STATES DISTRICT COURT

DISTRICT OF NEVADA

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SILVER STATE INTELLECTUAL TECHNOLOGIES, INC., Plaintiff, v. GARMIN INTERNATIONAL INC. AND GARMIN USA, INC., Defendants.	2:11-CV-1578-PMP-PAL ORDER

Before the Court is Plaintiff Silver State Intellectual Technologies, Inc.'s ("Silver State") Consolidated Opening Claim Construction Brief[1] (Doc. #53), filed September 28, 2012. Defendants Garmin International, Inc. and Garmin USA, Inc. (collectively "Garmin") filed a Response (Doc. #54) on October 26, 2012. Silver State filed a Reply (Doc. #55) on November 9, 2012. The Court held a claim construction hearing on April 5, 2013. (Mins. of Proceedings (Doc. #74).)

I. BACKGROUND

Plaintiff Silver State owns the legal rights to United States Patent Nos. 6,525,768 (the '768 Patent), 6,529,824 (the '824 Patent), 7,702,455 (the '455 Patent), 7,522,992 (the '992 Patent), 7,593,812 (the '812 Patent), 7,739,039 (the '039 Patent), 7,650,234 (the '234

[1] The Court granted the parties' request that the claim construction in this case be coordinated with a related case, Silver State Intellectual Technologies, Inc. v. Tom Tom, Inc., Case No. 2:11-CV-01581-PMP-PAL (D. Nev.). (Order Granting Joint Mot. & Stip. to Transfer & Consolidate Related Cases (Doc. #46).) On March 19, 2013, pursuant to Silver State and Tom Tom, Inc.'s stipulation, the Court dismissed with prejudice Silver State's case against Tom Tom, Inc. (Order Granting Stip. to Dismiss with Prejudice (Doc. #82 in 2:11-CV-01581-PMP-PAL).) Therefore, this Order addresses only the claim construction issues pertinent to Silver State's patent infringement suit against Defendants Garmin International, Inc. and Garmin USA, Inc.

Patent), 7,343,165 (the '165 Patent), and 6,542,812 ('2812 Patent). Silver State's patents generally cover various navigation processes and devices.

The '824 Patent is the parent patent to the '455 Patent, and this patent family "comprises Personal Communications Devices (PCDs), and traditional computer systems with GPS engines, routers, and other application programs to request, process, and transmit tagged, GPS encoded information." (Decl. of Phillip Bennett in Support of Silver State's Consolidated Opening Claim Constr. Br. (Doc. #53-1) ["Bennett Decl."], Ex. A1 at col. 2, ll. 19-23.) The '768 Patent is part of another patent family that covers a PCD with a digital camera that transmits images and GPS information. (Id., Ex. A4 at col. 29-30.) The '992 Patent, the '812 Patent, the '234 Patent, and the '039 Patent are part of another patent family and generally cover navigation PCDs that store user preference information and suggest goods or service providers based on the user preference information. (Id., Ex. A6 at col. 13-16.)

Silver State filed a Complaint against Garmin, alleging Garmin sells navigation devices that infringe Silver State's patents. (Compl. for Patent Infringement (Doc. #1).) Garmin filed an Answer, asserting that it does not directly or indirectly infringe Silver State's Patents, as well as various other defenses. (Garmin's Answer to Silver State's Compl. for Patent Infringement and Countercl. (Doc. #21).) Garmin also asserted counterclaims seeking declarations that the asserted patent claims are invalid and that Garmin does not infringe any valid asserted patent claim. (Id.) Silver State filed an Answer to Garmin's counterclaims, denying that Garmin is entitled to a declaration of invalidity or non-infringement. (Pl.'s Reply to Countercls. of Garmin (Doc. #25).)

As required under Local Rule 16.1-15, the parties filed a Joint Claim Construction Chart providing the parties' agreed upon construction of some claim terms and each party's proposed construction of the disputed claim terms. (Jt. Claim Construction and Prehearing Statement Pursuant to LR 16.1-15 (Doc. #47), Ex. A.) Later, the Court granted

the parties' stipulation to dismiss all claims and counterclaims related to the '165 Patent. (Order Granting Stip. (Doc. #49).) The parties filed an Amended Joint Claim Construction Chart reflecting the dismissal and further compromise as to certain claim construction disputes. (Not. of Am. Jt. Claim Construction Chart (Doc. #52).) After the parties had briefed the disputed claim constructions that remained, the Court granted the parties' stipulation to dismiss all claims and counterclaims related to '2812 Patent. (Order Granting Stip. (Doc. #58).) The seven Silver State patents that remain in this case are the '768 Patent, the '824 Patent, the '455 Patent, the '992 Patent, the '812 Patent, the '039 Patent, and the '234 Patent. The claim terms disputed by the parties are reflected in the parties' Amended Disputed Claim Terms Summary Sheet. (Am. Disputed Claim Terms Summary Sheet (Doc. #73-1).)

II. CLAIM CONSTRUCTION LEGAL STANDARDS

"The purpose of claim construction is to determine the meaning and scope of the patent claims that the plaintiff alleges have been infringed." Every Penny Counts, Inc. v. Am. Express Co., 563 F.3d 1378, 1381 (Fed. Cir. 2009). "When the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute." O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., 521 F.3d 1351, 1360 (Fed. Cir. 2008); Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996) (finding patent claim construction is a question of law for the court). "To ascertain the scope and meaning of the asserted claims, [courts] look to the words of the claims themselves, the specification, the prosecution history, and, if necessary, any relevant extrinsic evidence."[2] 01 Communique Lab., Inc. v. LogMeIn, Inc., 687 F.3d 1292, 1295-96 (Fed. Cir. 2012) (quotation omitted).

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[2] The parties do not cite the prosecution history to support their proposed claim constructions. Therefore, the Court considers only the claim language, the specification, and any pertinent extrinsic evidence.

The Court must begin by examining the claim language. Acumed LLC v. Stryker Corp., 483 F.3d 800, 805 (Fed. Cir. 2007); Every Penny Counts, 563 F.3d at 1381 ("The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." (quotation omitted)). "The words of a claim are generally given their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." Function Media, L.L.C. v. Google, Inc., 708 F.3d 1310, 1320 (Fed. Cir. 2013) (quotation omitted). Considering how a person of ordinary skill in the art would understand a claim term "is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art." Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).

"While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms." ACTV, Inc. v. Walt Disney Co., 346 F.3d 1082, 1088 (Fed. Cir. 2003); Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1557 (Fed. Cir. 1995) (stating courts "must give meaning to all the words in [the] claims"). Both asserted and unasserted claims of the patent can add meaning to a disputed claim term, as claim terms normally are used consistently throughout the patent. Phillips, 415 F.3d at 1314. Additionally, where the patents at issue "derive from the same parent application and share many common terms, [the court] must interpret the claims consistently across all asserted patents." NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1293 (Fed. Cir. 2005). If the claim language is clear on its face, then consideration of the other intrinsic evidence is limited "to determining if a deviation from the clear language of the claims is specified." Interactive Gift Exp., Inc. v. Compuserve Inc., 256 F.3d 1323, 1331 (Fed. Cir. 2001).

Furthermore, "claims must be read in view of the specification[] of which they are a part." Phillips, 415 F.3d at 1315 (quotation omitted). The specification can offer "practically incontrovertible directions about claim meaning." Abbott Labs. v. Sandoz, Inc., 566 F.3d 1282, 1288 (Fed. Cir. 2009). For example, the patentee may act as its own "lexicographer" and give a specialized definition of a claim term either explicitly or implicitly, in which case the specification acts as a dictionary for the patent. Id.; Phillips, 415 F.3d at 1321. "Likewise, inventors and applicants may intentionally disclaim, or disavow, subject matter that would otherwise fall within the scope of the claim." Abbott Labs., 566 F.3d at 1288.

"When consulting the specification to clarify the meaning of claim terms, courts must take care not to import limitations into the claims from the specification." Id. "[A]lthough the specification may well indicate that certain embodiments are preferred, particular embodiments appearing in the specification will not be read into claims when the claim language is broader than such embodiments." Tate Access Floors, Inc. v. Maxcess Techs., Inc., 222 F.3d 958, 966 (Fed. Cir. 2000) (quotation omitted). "By the same token, the claims cannot enlarge what is patented beyond what the inventor has described as the invention." Abbott Labs., 566 F.3d at 1288 (quotation omitted).

If the claim language is not clear after reviewing all intrinsic evidence, then the Court may refer to extrinsic evidence such as expert testimony, inventor testimony, dictionaries, learned treatises, and prior art not cited in the prosecution history. Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc., 206 F.3d 1408, 1414 (Fed. Cir. 2000). "Relying on extrinsic evidence to construe a claim is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence. Such instances will rarely, if ever, occur." Interactive Gift Exp., 256 F.3d at 1332 (internal quotation omitted).

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