UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Date October 18, 2017

Case No. and Title	**SACV 16-01790 JVS(AGRx): SPEX Technologies, Inc. v. Kingston Technology Corp., et al.** **SACV16-01799 JVS(AGRx): SPEX Technologies, Inc. v. Western Digital Corporation, et al** **SACV16-01800 JVS(AGRx): SPEX Technologies, Inc. v. Toshiba America Electronics Components Inc., et al** **CV16-07349 JVS(AGRx): SPEX Technologies, Inc. v. Apricorn**

Present: The Honorable	James V. Selna	
Karla J. Tunis		Not Present
Deputy Clerk		Court Reporter
Attorneys Present for Plaintiffs:		Attorneys Present for Defendants:
Not Present		Not Present

Proceedings: **(IN CHAMBERS)**
ORDER REGARDING CLAIM CONSTRUCTION

Plaintiff SPEX Technologies, Inc. ("SPEX" or "Plaintiff") and Defendants Toshiba America Electronic Components Inc., Toshiba America Information Systems, Inc., Toshiba Corporation, Western Digital Corporation, Western Digital Technologies, Inc., HGST, Inc., Imation Corporation, Kingston Technology Corporation, Kingston Digital Inc., Kingston Technology Company, Inc., Apricorn, Datalocker, Inc., and Data Locker International, LLC (together "Defendants") have submitted proposed claim constructions for terms contained in two of SPEX's patents. See, e.g., Docket Nos. 88, 92.[1] Both parties have submitted opening and responsive claim construction briefs. SPEX Op. Br., Docket No. 96; Defendants Op. Br., Docket No. 94; SPEX Resp. Br., Docket No. 100; Defendants Resp. Br., Docket No. 98.

The Court construes the claim terms identified below.

BACKGROUND

Two of SPEX's patents are currently at issue:

1. U.S. Pat. 6,088,802 ("the '802 patent"). Docket No. 96, Ex. 1.

[1]All docket citations are to Case No. 8:16-cv-01790 unless otherwise noted.

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2. U.S. Pat. 6,003,135 ("the '135 patent"). Id. Ex. 2.

The applications resulting in the '802 Patent and the '135 Patent were filed the same day: June 4, 1997. The two patents are not technically related. However, the patent applications were prosecuted in parallel. The patents also have overlapping figures and specification disclosures.

Both patents relate to devices that can communicate with host computing devices to provide various operations, including security operations. See '802 Patent at Abstract; '135 Patent at Abstract. The '802 Patent is titled "PERIPHERAL DEVICE WITH INTEGRATED SECURITY FUNCTIONALITY" and issued on July 11, 2000. The '135 Patent is titled "MODULAR SECURITY DEVICE" and issued on December 14, 1999. Both patents are now expired.

SPEX alleges that Defendants infringed Claims 1, 2, 6, 7, 11, 12, 23, 25, 38, and 39 of the '802 Patent. SPEX Op. Br. at 2. Claim 1 recites:

> 1. A peripheral device, comprising:
> security means for enabling one or more security operations to be performed on data;
> target means for enabling a defined interaction with a host computing device;
> means for enabling communication between the security means and the target means;
> means for enabling communication with a host computing device;
> means for operably connecting the security means and/or the target means to the host computing device in response to an instruction from the host computing device; and
> means for mediating communication of data between the host computing device and the target means so that the communicated data must first pass through the security means.

SPEX also alleges that Defendants infringed Claims 55–58 of the '135 Patent. SPEX Br. at 2. Claim 55 recites:

> 55. For use in a modular device adapted for communication with a host computing device, the modular device comprising a security module that is adapted to enable one or more security operations to be performed on data and a target module that is adapted to enable a defined interaction with the host computing device, a method comprising the steps of:
>
> receiving a request from the host computing device for information regarding the type of the modular device;
>
> providing the type of the target module to the host computing device in response to the request; and
>
> operably connecting the security module and/or the target module to the host computing device in response to an instruction from the host computing device.

LEGAL STANDARD

I. General Claim Construction Principles

Claim construction is "exclusively within the province of the court." Markman v. W. Instruments, Inc., 517 U.S. 370, 372 (1996). Such construction "must begin and remain centered on" the claim language itself. Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1331 (Fed. Cir. 2001). But extrinsic evidence may also be consulted "if needed to assist in determining the meaning or scope of technical terms in the claims." Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed. Cir. 1995).

In construing the claim language, the Court begins with the principle that "the words of a claim are generally given their ordinary and customary meaning." Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal quotation marks omitted). This ordinary and customary meaning "is the meaning that the [claim] term would have to a person of ordinary skill in the art in question at the time of the invention,

i.e., as of the effective filing date of the patent application." Id. at 1313. "[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Id.

"In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words. In such circumstances general purpose dictionaries may be helpful." Id. at 1314 (internal citation omitted). In other cases, "determining the ordinary and customary meaning of the claim requires examination of terms that have a particular meaning in a field of art." Id. Then "the court looks to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean." Id. (internal quotation marks omitted). These sources include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." Id. (internal quotation marks omitted).

But it is improper to read limitations from the specification into the claim. Callicrate v. Wadsworth Mfg., Inc., 427 F.3d 1361, 1368 (Fed. Cir. 2005) ("[I]f we once begin to include elements not mentioned in the claim, in order to limit such claim . . . we should never know where to stop.") (quoting Phillips, 415 F.3d at 1312). A court does "not import limitations into claims from examples or embodiments appearing only in a patent's written description, *even when a specification describes very specific embodiments of the invention* or even describes only a single embodiment, unless the specification makes clear that 'the patentee . . . intends for the claims and the embodiments in the specification to be strictly coextensive.'" JVW Enters., Inc. v. Interact Accessories, Inc., 424 F.3d 1324, 1335 (Fed. Cir. 2005) (internal citations omitted) (italics added).

II. Means Plus Function Claims

Under 35 U.S.C. § 112(6),[2] means-plus-function claiming occurs when an element in a claim is a "means or step for performing a specified function without the recital of structure, material, or acts in support thereof . . . ." In that case, "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Id. This provision allows "patentees to express a claim limitation by reciting a function to be performed rather than by reciting structure for performing that function . . . ." Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1347 (Fed. Cir. 2015) (en banc). At the same time, it constrains "how such a limitation is to be construed, namely, by restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof." Id.

The failure to use the term "means" creates a rebuttable presumption that § 112(6) does not apply. See Advanced Ground Info. Sys., Inc. v. Life360, Inc., 830 F.3d 1341, 1347 (Fed. Cir. 2016). To overcome this presumption a challenger must show "that the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function." Id. (quoting Williamson, 792 F.3d at 1348). The challenger must establish § 112(6)'s applicability by a preponderance of the evidence. Skky, Inc. v. MindGeek, s.a.r.l., 859 F.3d 1014, 1019 (Fed. Cir. 2017).

Once a court concludes that a term is subject to § 112(6), it follows a two-step process. Williamson, 792 F.3d at 1351. "First, the court must determine the claimed function. Second, the court must identify the corresponding structure in the written description of the patent that performs the function." Noah Sys., Inc. v. Intuit Inc., 675 F.3d 1302, 1311 (Fed. Cir. 2012) (internal citations omitted). "Where there are multiple claimed functions . . . the patentee must disclose adequate corresponding structure to perform all of the claimed functions. If the patentee fails to disclose adequate corresponding structure, the claim is indefinite." Williamson, 792 F.3d at 1351.

[2] § 112(6) was renamed as § 112(f) by the America Invents Act, Pub. L. No. 112–29 ("AIA"), which took effect on September 16, 2012. Because the inventors here applied for the patents-in-suit before the act's passage, § 112(6) applies here.

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