

I. BACKGROUND

During prosecution, Claim 1 of U.S. Patent No. 6,959,293 (the “293 Patent”) was amended to overcome the patent examiner’s 35 U.S.C. § 102(b) rejection in view of U.S. Patent No. 5,359,533 (“Ric Ka”). Dkt. No. 175-3 at 19-20, 28. The Applicant also argued that “Ric Ka fails to teach or suggest the limitations as presently recited in claims 1 and 2. For example, Ric Ka fails to teach or suggest two or more histogram calculation units” *Id.* at 37-38.

Samsung filed a Motion to Establish Pre-Trial Procedure for Resolving Legal Issues Involving Doctrine of Equivalents, Including Prosecution History Estoppel. Dkt. No. 135. Samsung also filed an Unopposed Motion for Expedited Briefing on Samsung’s Motion to Establish Pre-Trial Procedure for Determination of Prosecution History Estoppel Issues. Dkt. No. 134. The Court granted the expedited briefing, which waived the reply and sur-reply. Dkt. No. 136.

IPT made express DOE arguments in Dr. Bovik’s claim charts and reports. *See generally* Dkt. No. 175-9, 175-10, 175-11. During oral argument to the Court Samsung asserted that “it was not and still is not clear to what extent, if at all, Plaintiffs intend to rely on the Doctrine of Equivalents.” It represented that the issue it sought to address was the effect of the patent applicant’s distinguishing Claim 1’s “requirement to have two histogram calculation units from previous art that relied on a single processor.” Dkt. No. 184-3 at 3-4.

Samsung’s PHE Brief addresses two PHE arguments that it anticipates from IPT. Dkt. No. 175 at 4. First, “that “a computer processor configured to execute” is the equivalent of the required “hardware” elements, especially the two or more specialized Histogram Calculation Units (HCUs)” (“PHE-1”). *Id.* Second, that “hardware transmitting image frame data, whereby each frame is associated with a time T, and each frame includes pixel data for the frame, with

each pixel corresponding to a position (x,y) or (i,j)” is the equivalent of the element “said digital signal . . . in this space” (“PHE-2”). *Id.* Samsung’s PHE Brief asserts both argument-based and amendment-based PHE.

II. LEGAL STANDARD

a. Prosecution History Estoppel

PHE, when applied to a DOE argument regarding an element, “bar[s] the application of the doctrine of equivalents to that element.” *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 33 (1997). As applied, PHE “places reasonable limits on the doctrine of equivalents” *Id.* at 34. PHE does so by “prevent[ing] a patentee from using the doctrine of equivalents to recapture subject matter surrendered from the literal scope of a claim during prosecution.” *Trading Technologies Intern., Inc. v. Open E Cry, LLC*, 728 F.3d 1309, 1322 (Fed. Cir. 2013).

The application of PHE is a matter of law. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359, 1367-68 (Fed. Cir. 2003). PHE comes in two forms: (1) amendment-based estoppel and (2) argument-based estoppel. *Conoco, Inc. v. Energy & Environmental Intern., L.C.*, 460 F.3d 1349, 1363-64 (Fed. Cir. 2006).

b. Amendment-Based Estoppel

Once the alleged infringer shows that a claim was amended, there is a presumption that the amendment is “a general disclaimer of the territory between the original claim and the amended claim.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002). The patent owner then bears “the burden of showing that the amendment does not surrender the particular equivalent in question.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002).

To meet this burden, “[t]he patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” *Festo Corp.* enumerated three ways a patentee may overcome the presumption: (1) “[t]he equivalent may have been unforeseeable at the time of the application;” (2) “the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question;” and (3) “or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.” *Id.* at 740-741.

c. Argument-Based Estoppel

Arguments made during the prosecution of a patent application are given the same weight as claim amendments. *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999). Argument-based history estoppel applies when there is a “clear and unmistakable surrender of subject matter” in the prosecution history. *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1363 (Fed. Cir. 2003), quoting *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1458 (Fed. Cir. 1998).

III. ANALYSIS

a. Amendment-Based Estoppel

Once the alleged infringer shows that a claim was amended, there is a presumption that the amendment is “a general disclaimer of the territory between the original claim and the amended claim.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002). Samsung requests the Court to find that IPT is barred by PHE from asserting (1) PHE-1 and (2) PHE-2. Dkt. No. 175 at 4.

The Court finds that, in both cases, PHE does not apply. While there is a presumption that the amendment is a general disclaimer of the territory between the original claim and the amended claim under *Festo*, these limitations do not implicate territory between the original claim and the amended claim. There is no presumption to rebut. Below is a comparison of the original Claim 1 and amended Claim 1.

<u>Original Claim 1</u>	<u>Amended Claim 1</u> (new material underlined, deleted material in strikethrough)
<p>1. A visual perception processor, comprising: a data bus; a time coincidences bus; and two or more histogram calculation units that receive the data DATA(A), DATA(B), . . . DATA(E) via the data bus and supply classification information to the single time coincidences bus.</p>	<p>1. (Currently Amended) A visual perception processor <u>for automatically detecting an event occurring in a multidimensional space (i,j) evolving over time with respect to at least one digitized parameter in the form of a digital signal on a data bus, said digital signal being in the form of a succession a_{ijT} of binary numbers associated with synchronization signals enabling to define a given instant (T) of the multidimensional space and the position (i,j) in this space, the visual perception processor comprising:</u></p> <p style="padding-left: 40px;">[[a]] <u>the data bus;</u> <u>a control unit</u> <u>a time coincidences bus carrying at least a time coincidence signal;</u> and</p> <p style="padding-left: 40px;"><u>at least two or more histogram calculation units for the treatment of the at least one parameter, that receive the data DATA(A), DATA(B), ... DATA(E) via the data bus and supply classification information to the single time coincidences bus</u></p> <p style="padding-left: 40px;"><u>the histogram calculation units being configured to form a histogram representative of the parameter as a function of a validation signal and to determine by classification a binary classification signal resulting from a comparison of the parameter and a selection criterion C, wherein the classification signal is sent to the time coincidences bus, and wherein the validation signal is produced from time coincidences signals from the time coincidence bus so that the calculation of the histogram depends on the classification signals carried by the time coincidence bus.</u></p>

Dkt. No. 175 at 5. Regarding PHE-1, the presence of the structural elements are the only parts of Claim 1 that were not amended. The amendment does implicate territory between the

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