

Honorable Robert J. Bryan

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7 UNITED STATES DISTRICT COURT
8 WESTERN DISTRICT OF WASHINGTON
9 AT TACOMA

10 WACOM CO., LTD. and WACOM
11 TECHNOLOGY CORPORATION,
12 Plaintiffs,

13 v.

14 HANVON CORPORATION and
15 HANWANG TECHNOLOGY CO., LTD.,
16 Defendants.

Case No. CV 06-5701 RJB

**PLAINTIFFS' MOTION FOR
RECONSIDERATION OF PATENT
CLAIM CONSTRUCTION ORDER**

**NOTE ON MOTIONS CALENDAR:
JANUARY 2, 2008**

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1 **I. THE ORDER IS TAINTED BY A MANIFEST AND PERVASIVE ERROR**

2 The Court’s construction of the fifteen disputed means-plus-function claim elements is
3 tainted by a manifest and pervasive error of law, and therefore should be reconsidered.

4 The Patent Claim Construction Order (Dkt. No. 111) (“Order”) begins by correctly
5 identifying the set of issues that must be addressed when construing a disputed patent claim
6 element. (Order at Section II. A. (“Claim Construction Law”).) But when it comes to the
7 means-plus-function claim elements, the Order does not address these claim construction issues.
8 Instead, it wrongly puts the patent invalidity cart before the claim construction horse by
9 assuming that Wacom had the burden of proving that its patent claims would be valid (*viz.*,
10 novel, non-obvious and enabled) if the Court construed these claim elements in the manner
11 urged by Wacom. Finding that Wacom failed to meet this supposed burden, it then adopts—
12 with no other analysis—Defendants’ proposed constructions of these claim elements.

13 This assumption—that Wacom had a burden of proving the claims valid under its
14 proposed constructions—is wrong on multiple counts. First, the *en banc* Federal Circuit has
15 rejected it, ruling that the “doctrine of construing claims to preserve their validity ... has no
16 applicability” except where the claim is ambiguous even after applying all of the tools of claim
17 construction. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327, 1328 (Fed. Cir. 2005) (*en banc*)
18 (citation omitted). Instead, a trial court must interpret the claims using the *Phillips* claim
19 construction principles and let the validity chips fall where they may. *See, e.g., Liebel-*
20 *Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371 (Fed. Cir. 2007) (on first appeal, Federal Circuit
21 declined to construe claims narrowly to preserve their validity; on second appeal, Federal
22 Circuit held invalid claims that had been given a broad construction in the earlier appeal).

23 Second, even if validity were properly considered at this stage—which it is not—it
24 would be legal error to put the burden of proof on the patent owner. Patents are presumed valid
25 by statute. 35 U.S.C. § 282. And the challenger’s burden of proof carries a heightened “clear
26 and convincing evidence” standard. *See Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*,

1 492 F.3d 1350, 1355 (Fed. Cir. 2007). It is never correct to require the patent owner to prove
2 validity, be it enablement, or novelty, or non-obviousness.

3 Third, pre-judging validity issues outside the procedural safeguards of Fed. R. Civ. P. 56
4 invades the fact-finding role of the Jury and oversteps the Court-Jury demarcation line
5 reconfirmed by the Supreme Court when it permitted trial courts to interpret patent claims.
6 *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384 (1996) (the trial court
7 may not rule on matters *in pais*, such as comparing one invention to another.)

8 The Order conflates claim construction with patent validity—two entirely different
9 exercises in patent law. That this is a manifest error, not even Defendants could deny. Surely,
10 no other post-*Phillips* patent claim construction has rested on the patent owner’s failure to show
11 novelty, non-obviousness, and/or enablement under its proposed construction.

12 This manifest error was by no means peripheral. In at least 23 separate statements, the
13 Order relies on this legally faulty basis to justify its construction of a means-plus-function
14 element. (Order at 8:16-17, 8:24-26, 8:27-9:2, 9:2-5, 9:6-11, 9:16-17, 10:14-15, 12:9-12, 16:6-
15 7, 17:27-18:2, 19:1-2, 19:17-18, 20:10-17, 21:3-6, 21:15-16, 22:13-14, 24:25-25:2, 25:10-11,
16 26:1-2, 26:19-20, 29:6-7, 30:6-7, 31:4-5). For example (emphases added):

17 Plaintiffs, however, have failed to establish that claim 1 is both
18 novel and non-obvious without the structural limitations disclosed
19 in the simplest embodiment of the invention, the first embodiment.
See ‘553 Patent, Figure 1. (*Id.* at 8:24-26)

20 Plaintiffs have failed to show that that hypothetical embodiment is
21 enabled by the specification. See *Wang Labs, Inc. v. America*
22 *Online, Inc.*, 197 F.3d 1377, 1381-1383 (Fed. Cir. 1999). (*Id.* at
23 8:27-9:2)

24 The evidence does not support the proposition that whatever that
25 structure may be, that structure is both novel and non-obvious in
26 light of the prior art and is enabled by this specification. Therefore,
in general, the Court should adopt Defendants’ proposed
constructions, which are consistent with Judge Stotler’s
constructions, for the means-plus-function limitations in this patent.
(*Id.* at 9:6-11)

1 Similar to the ‘553 Patent, Plaintiffs have failed to show that their
2 proposed constructions for these means-plus function limitations
3 both overcome the prior art and are enabled by the specification.
4 Therefore, the Court should adopt Defendants’ proposed
5 constructions for these means-plus-function limitations. (*Id.* at
6 17:27-18:2)

7 As discussed above, the Court should adopt Defendants’ proposed
8 construction [for a means-plus-function limitation]. (*Id.* at 9:16-17,
9 and at 10:14-15, and at 16:6-7, and at 19:1-2, and at 19:17-18, and
10 at 21:15-16, and at 22:13-14, and at 25:10-11, and at 26:1-2, and at
11 29:6-7, and at 30:6-7, and at 31:4-5.)

12 Wacom respectfully requests a fresh start: a full reconsideration of these fifteen means-
13 plus-function elements untainted by any consideration of patent invalidity.¹

14 **II. FOR EXAMPLE, THE ORDER’S CONSTRUCTION OF “ELECTRIC**
15 **WAVE GENERATING MEANS FOR SENDING AN ELECTRIC WAVE**
16 **TO SAID TUNING CIRCUIT,” SUFFERS FROM THIS LEGAL ERROR**

17 This error completely sidetracks the Order. Because of it, the Order does not decide any
18 of the questions that a court must resolve to properly construe these means-plus-function claim
19 elements. This absence of analysis is illustrated by the claim element “electric wave generating
20 means for sending an electric wave to said tuning circuit,” as explained below.

21 In discussing other claim terms, the Order correctly recognizes that “an electric wave
22 [is] created by a current whose magnitude changes over time.” (Order at 6:14). An inducing
23 loop coil carrying a fluctuating current creates an electric wave that in turn induces a change in
24 current in another coil. (*Id.* at 6:1-14). This scientific truth is confirmed by the text of the ‘553
25 Patent: “an electric wave is generated by the loop coil” (‘553 Pat. at 2:26, *see also id.* at
26 Abstract, 2:14-16, 5:60-61, and 6:37) (emphases added).

¹ In accord with Local Rule 7(h)’s admonition that motions for reconsideration are disfavored and limited to instances of “manifest” error, Wacom does not in this motion seek reconsideration of other claim constructions with which it disagrees. Wacom does not waive its position with respect to any such constructions.

1 In support of its proposed construction of the claim element “electric wave generating
2 means for sending an electric wave to said tuning circuit,” Wacom relied on this same scientific
3 principle of induction and these same statements in the ‘553 Patent showing that the structure
4 that actually performs the recited function of generating an electric wave and sending it to the
5 tuning circuit is a loop coil carrying fluctuating current. Stated otherwise, if a tuning circuit
6 could ask a question of Michael Faraday, and ask “what generated and sent me this electric
7 wave”?; Faraday’s answer would be: “a loop coil carrying a fluctuating current.”

8 Had the Claim Construction Order followed the legal principles it laid out in Section II.
9 A., it would have asked (and answered) this same question. But it does not. Despite earlier
10 having recognized that a loop coil carrying a fluctuating current generates an electric wave, the
11 Order does not acknowledge that same scientific truth when construing this means-plus-
12 function element. (*See* Order at 10:10-11:2). Instead, the Order merely defers to its previous
13 (and erroneous) discussion about Wacom’s failure to prove patent validity and on that (faulty)
14 basis alone it adopts Defendants’ entire proposed construction without addressing any of
15 Wacom’s or Professor Sun’s criticisms of that construction. (Order at 10:11-11:2).

16 For example, at the *Markman* hearing, Wacom emphasized the critical distinction
17 between a first structure that actually performs a claim-recited function (e.g., emitting light)
18 versus a second, necessary structure that enables the first structure to so operate (e.g., an
19 electrical outlet). *See Asyst Techs. v. Empak, Inc.*, 268 F.3d 1364, 1371 (Fed. Cir. 2001) (“The
20 corresponding structure to a function set forth in a means-plus-function limitation must actually
21 perform the recited function, not merely enable the pertinent structure to operate as intended.”)
22 (emphasis added).² But the Order does not address this issue. Rather, it includes, for example,
23 a “connecting switching circuit” as part of the structure, without finding—as it must under
24 *Asyst*—that this circuit actually generates an electric wave and sends it to a tuning circuit.

25
26 ² Judge Stotler’s Opinion—on which the Order relies—was issued before *Phillips* and
Asyst were decided, and is contrary to both of these controlling rulings.

1 Indeed, from the following statement about another means-plus-function element, it appears
2 likely that the Order does precisely what the *Asyst* Court warns against: “the structure identified
3 in the specification that is necessary to accomplish the stated function is:” (Order at 15:20-
4 21) (emphasis added). “Necessary to” is the same as saying “enables to operate,” which is the
5 wrong test. The electrical outlet is “necessary to” a light bulb filament emitting light, but the
6 outlet itself does not (one hopes) emit light. Again, the correct test is whether a proposed
7 structure actually performs the recited function, not whether it allows or enables another
8 structure to perform that recited function.

9 Another of the points argued by Wacom on this claim element—but not addressed by
10 the Order—is that Defendants’ proposed “structure” of “a single loop coil ... that is used for
11 both transmitting and receiving” (emphasis added) improperly embeds into the alleged
12 “structure” a function extraneous to this claim element. The only function recited in this claim
13 element is that of generating and sending an electric wave. This function says and requires
14 nothing at all about the different function of receiving an electric wave from the tuning circuit.
15 Therefore, any construction of this claim element that adds an extraneous “receiving” function
16 (or requires some particular structure to perform that extraneous “receiving” function) violates
17 the rule acknowledged in Section II. A. of the Order: “A court may not import functional
18 limitations that are not recited in the claim, or structural limitations from the written description
19 that are unnecessary to perform the claimed function. *Micro Chem., Inc. v. Great Plains Chem.*
20 *Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999).” (Order at 3:23-25).

21 The Order approaches all of the disputed means-plus-function claim elements in the
22 same way. For each, the Order simply refers back to its (erroneous) “not proven valid”
23 conclusion and provides no other analysis. For example, without any analysis under the *Asyst*
24 rule of law, the Order consistently adopts structures that Professor Sun explained do not
25 perform the claim-recited functions. As another example, the Order does not address or decide
26 whether the file history of the ‘553 Patent affects the meaning of terms in other patents, yet the

1 construction of the other patents refers back to the Court's analysis of the '553 Patent. There is
2 no basis in law for applying the file history for one patent to an unrelated patent that is being
3 construed.

4 **III. CONCLUSION**

5 Motions for reconsideration are disfavored for good reason. But if this Court takes a full
6 and fresh look at all of the parties' arguments on these means-plus-function claim elements,
7 applies the claim construction law it correctly summarized in Section II. A. of the Order, and
8 leaves for later any concerns about the validity of patents, Wacom is convinced that it will issue
9 very different constructions of these claim elements.

10
11 DATED: December 31, 2007

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1 CERTIFICATE OF SERVICE

2 The undersigned hereby certifies that on December 31, 2007, a true copy of the
3 foregoing **PLAINTIFFS' MOTION FOR RECONSIDERATION OF PATENT CLAIM**
4 **CONSTRUCTION ORDER** was filed with the Clerk of Court using the CM/ECF system,
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