UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No.	CV 10-04481-RGK (FFMx)		Date	July 15, 2011
Title	**KYE SYSTEMS AMERICA CORP. v. PRIMAX ELECTRONICS LTD.**			

Present: The Honorable	R. GARY KLAUSNER, UNITED STATES DISTRICT JUDGE	
Sharon L. Williams	Not Reported	N/A
Deputy Clerk	Court Reporter / Recorder	Tape No.

Attorneys Present for Plaintiffs:	Attorneys Present for Defendants:
Not Present	Not Present

Proceedings: **(IN CHAMBERS) Order Re: Defendant's Motion for Partial Summary Judgment as to Patent invalidity (DE 69)**

I.   INTRODUCTION

On June 17, 2010, Plaintiff KYE Systems America Corp. ("KYE") filed an action for patent infringement against Defendant Primax Electronics, Ltd. ("Primax"). On October 29, 2010, Primax filed its second amended counterclaim against KYE, seeking in part a declaration of invalidity of KYE's patent. Before the court is Primax's Motion for Partial Summary Judgment of Patent Invalidity. For the reasons provided below, Primax's motion is **denied**.

II.   FACTUAL BACKGROUND

KYE owns U.S. Patent No. 5,530,455 ("'455 patent"). The '455 patent relates to a computer mouse with a roller element for scrolling in computer application programs. The patent claims an input system that sends scrolling messages through a Windows operating system to cause scrolling on a video display. The '455 patent contains two independent claims, Claims 1 and 11, as well as several dependant claims. The claims limitation language does not vary materially between the two independent claims for the purpose of Primax's invalidity challenge. Thus, while the following discussion focuses on Claim 1 except where noted, each of the Court's holdings will apply to the challenge to Claim 11 as well.

Overall, Claim 1 claims a "computer input system" comprising a "multidimensional mouse," as well as the following:

means for scrolling a portion of the bitmapped memory on the video monitor about a predetermined first axis, the bitmapped memory being associated with an application program running on the computer having the video monitor with any portion of the bitmapped memory not appearing on the video monitor being in the memory of the computer, said means for scrolling controllable via conventional input devices and the

finger-operated turntable member wherein the speed, amount, and direction of rotation of the turntable member as determined by said electrical output signals, whereby non-displayed portions of the bitmapped memory may be displayed.

program means responsive to the electrical output signals from said turntable member for generating messages through the computer to the application program for scrolling the bitmapped memory on the video monitor.

'455 patent, col. 10, l. 57–col.11, l. 7. Primax now challenges the validity of the '455 patent, arguing it includes indefinite claims under 35 U.S.C. § 112.

III.   LEGAL STANDARD

Summary judgment is appropriate when there is no genuine issue of material fact for trial. Fed. R. Civ. P. 56(c). The party moving for summary judgment has the burden of establishing that the other party cannot establish a necessary element of its case, notwithstanding any factual disputes. *Novartis Corp. v. Ben Venue Laboratories, Inc.*, 271 F.3d 1043, 1046 (2001). So the moving party "has the initial responsibility of identifying the legal basis of its motion, and of pointing to those portions of the record that it believes demonstrate the absence of a genuine issue of material fact." *Id.* (citation omitted). If the moving party overcomes that burden, the burden will shift to the non-moving party to point to specific facts that create a genuine issue of material fact. *Id.*

IV.   DISCUSSION

As a patent is presumed valid, the burden of establishing invalidity of any of a patent's claims is borne by the party challenging validity. 35 U.S.C. § 282. Clear and convincing evidence must be presented by the challenging party for a court to declare the patent invalid. *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1157 (Fed Cir. 2004).

Invalidity is demonstrated where a claim is not amenable to construction. "If a claim is amenable to construction, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, the claim is not indefinite." *Aero Products Intern, Inc. v. Intex Recreation Corp.*, 466 F.3d 1000, 1015–16 (Fed. Cir. 2006) (quotation omitted).

To be valid, a patent's claims must meet the definiteness requirement of 35 U.S.C. § 112. The statute directs, "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." A patent is definite where the claims stated, when read in light of the specification as a whole, are sufficient to convey to one skilled in the art the scope of the invention claimed. *Mills Laboratories, Inc. v. Shandon, Inc.*, 887 F.2d 870, 875 (Fed. Cir. 1993). Here, the Court finds that one skilled in the art would be an individual with a degree in computer science or the equivalent, and 2-3 years experience as a computer programmer using the Windows operating system.

Primax argues that '455 patent is invalid as indefinite on two bases. First, Primax argues that the the patent's claims include means plus function limitations without adequately identifying corresponding structure in the specification in violation of 35 U.S.C. § 112. Second, Primax argues that the patent includes system claims that improperly include method claim elements. The Court finds that the challenged claims are not indefinite as a matter of law.

A. Construction of Means Plus Function Claims

As stated above, a claim that may be construed is a definite claim. 35 U.S.C. § 112, ¶ 6 allows claim limitations to "be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Construction of a means plus function claim term is a two step process; the function of the term must be identified and connected to sufficient structure.

First, a court must isolate the function claimed in the term. *AllVoice Computing PLC v. Nuance Commc'ns, Inc.*, 504 F.3d 1236, 1240 (Fed. Cir 2007). Care must be taken to neither improperly narrow the claimed function beyond the scope of the claim language, nor improperly broaden the function by ignoring the clear limitations contained in the same. *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003). Language that "merely states the result of the limitations in the claim," such as language introduced by a "whereby" clause, is not part of the function. *Id.* The function must also be separated from language relating characteristics or details of the function or its result. *See Gemstar-TV Guide Intern., Inc. v. International Trade Com'n*, 383 F.3d 1352, 1361 (Fed. Cir. 2004) (declining to limit function of displaying a grid by including claim language relating characteristics of the grid displayed).

Once the function is identified, the court must identify what structure disclosed in the specification performs the function. *AllVoice Computing*, 504 F.3d at 1240. For the claim to be definite, a person of ordinary skill in the art must be capable of recognizing the structure and associating it with the function claimed. *Id.*

When a function is implemented in software, identification of a general purpose computer, microchip, or software program will not suffice as description of its structure. *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, 184 F.3d 1328, 1333 (Fed. Cir. 2008). In addition, the specification must disclose an algorithm "such as a formula, prose, or flow chart" to describe how the software works to perform the claimed function. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 133, 1340 (Fed. Cir. 2008). However, disclosing a general algorithm provides sufficient structure, a patent is not required to disclose "a listing of source code or a highly detailed description of the algorithm." *Aristocrat*, 184 F.3d at 1338.

B. "Means for Scrolling" Limitation May Be Construed

As described below, the Court finds that the means for scrolling limitation may be construed, and thus is definite as a matter of law.

1. *Means for Scrolling Function*

The parties agree that the means for scrolling limitation is a means-plus-function term governed by 35 U.S.C. § 112 ¶ 6. However, the parties differ on breadth of the function claimed by the term. For Claim 1, Primax argues that the entire paragraph comprising the limitation describes the function:

> scrolling a portion of the bitmapped memory on the video monitor about a predetermined first axis, the bitmapped memory being associated with an application program running on a computer having the video monitor with any portion of the bitmapped memory not appearing on the video monitor being in the memory of the computer, said means for scrolling controllable via conventional input devices and the finger operated turnable member wherein the speed, amount, and direction of rotation of the turnable member as determined by said electrical output signals, whereby non-displayed portions of the

bitmapped memory may be displayed.

'455 patent, col. 10, l. 57–col. 11, l. 3. KYE, in turn, argues that only the initial portion of the language sets out the function: "scrolling a portion of the bitmapped memory on the video monitor about a predetermined first axis." The Court agrees. The additional language included qualifies terms used in the function described and characterizes the result of the function. Immediately following the functional language identified by KYE, the language characterizes the nature of the bitmapped memory being scrolled. This characterization is not part of the function claimed, but rather provides illumination of terminology used in the function. The language that follows, "said means for scrolling controllable via conventional input devices and the finger operated turntable member" contains a limitation, describing how the scrolling is controlled, but recites adequate structure via the terms "conventional input devices" and "turntable member" to perform the function of controlling the scrolling. Thus, this language is separate from the initial functional claim and not a component of its function. The next clause of the paragraph relates to this "means controllable" limitation and not the initial functional language, describing how the turntable member operates to control scrolling. The final clause is also not included in the function claimed. As in *Lockheed Martin*, the word "whereby" as the beginning of the clause signals that it describes the result of the function, which is not included as part of the function claimed. Thus, the Court accepts KYE's proposed function for the means for scrolling limitation.

The same basic dispute is repeated with regards to the means for scrolling limitation in Claim 11. Primax argues that the entire paragraph comprising the limitation is the function:

> scrolling an application program having a portion of the bitmapped memory displayed, said means for scrolling being controlled via positioning the cursor in the scroll bar and turning the turntable member whereby non-displayed portions of the bitmapped memory may be displayed at a scrolling rate proportional to the angular velocity of the turnable member.

'455 patent, col. 12, ll. 30–36. KYE argues that the function is limited to the opening clause, "scrolling an application program having a portion of the bitmapped memory displayed." *Id.* at col. 12, ll. 30–31. Applying the same reasoning as the Claim 1 discussion above, the Court rejects Primax's proposed function, and accepts KYE's construction of the term's function.

2. *Means for Scrolling Corresponding Structure*

The parties disagree regarding the corresponding structure for the means for scrolling term. According to KYE, the corresponding structure is "Microsoft Windows 3.1 and newer versions" ("Windows"). On the other hand, Primax contends the term lacks corresponding structure and is thus indefinite. Primax argues that (1) Windows and the disclosed algorithms are insufficient structure to perform the scrolling function described; (2) the '455 patent cannot incorporate the prior art Windows by reference to provide structure for the function; (3) it is improper for the structure to include versions of Windows that do not yet exist; and (4) the structure disclosed is not clearly linked to the function because KYE has advanced inconsistent proposed structures in other litigation. As discussed below, the Court does not find these arguments persuasive.

In the first place, Primax argues that Windows is insufficient structure to perform the scrolling function. Primax notes that the scrolling limitations involve an application program.[1] According to Primax, the application, rather than Windows itself, performs the scrolling function. Thus, the structure disclosed in the patent is sufficient only to send a request for scrolling to the application, which falls short of the scrolling function claimed by failing to encompass how the application receives and implements the request.

As an initial matter, the Court notes that while the '455 patent discloses Windows as implementing scrolling after receiving messages from the mouse, the specification does not stop there. The specification includes an algorithm describing how Windows receives and processes signals from the input system claimed to produce scrolling. This algorithm is related in several parts of the specification. Figure 7 of the '455 patent provides a flow chart representation of how data from the mouse input is sent to elements of the Windows operating system by the mouse driver and how the operating system in turn sends commands to cause scrolling to occur in application programs. The specification also includes a narrative description of the process. '455 patent, col. 4, ll. 18–67. Included elsewhere in the specification is a description of several scrolling actions that application windows perform, the associated Windows commands that cause them to occur, and what inputs from the mouse device trigger those commands. *Id.* at col. 5, l. 27–col. 6. l. 67.

To the extent that Primax's argument suggests that the computer input system claimed includes the application program mentioned in the patent, this is incorrect. The invention claimed is an input system for scrolling bitmapped memory on a computer monitor. That memory is associated with an application program running on the computer system, and indeed, the input system functions by causing windows scroll commands to be sent to such a program. However, that does not imply that the associated application program forms part of the input system claimed. The application merely responds to the input system. The input system relies on standard protocols recognized by applications running in Windows by which Windows sends scrolling commands. The process by which Windows and an application program communicate to facilitate scrolling is well known in the prior art, and none of the claims of the '455 patent propose novel processes at this point of communication. That is, the input system claimed proposes a novel way of sending messages to Windows that the operating system will interpret and send along as scroll commands well known in the prior art.

Primax is correct in recognizing that the means for scrolling term claims the function of video scrolling, and not just the function of sending a scroll message via Windows. However, this does not suggest that the term is indefinite. The algorithm disclosed in the patent's specification does not merely describe how the input system sends a message to the Windows system, but goes on to describe how Windows accepts and processes such a message, and sends a corresponding command for scrolling to an application running on the operating system. According to the specification, these commands are delivered through a standard protocol that applications running within Windows are programmed to recognize and implement. *Id.* at col. 3, ll. 29–33. In one case, the specification describes how an application would implement a specific scroll function, "WM_VSCROLL (vertical scroll) or equivalent messages [are] recognized by the Windows kernel. These messages are sent to queue 75 which communicates with Windows kernel 76 affecting the topmost or active window on the screen and the document will scroll one line for each WM_VSCROLL message." *Id.* at col. 5, l. 32–col. 6, l. 2. Following this example, the specification produces a table listing various types of scrolling applications may perform and the Windows commands used to generate these results. *Id.* at col. 6, l. 38. Thus, one with ordinary skill in the art would understand the specification to provide adequate structure to perform

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[1]In Claim 11, the function identifies an application program as the object to be scrolled. In Claim 1, the object identified is bitmapped memory, but subsequent language in the claim characterizes the bitmapped memory as associated with an application program.

the stated function, especially in light of the algorithm provided to characterize how this structure, the Windows 3.1 operating system and equivalents, is able to perform the function. Given the variety of application programs that run in the Windows environment, it is unclear what detail Primax demands the patent include on "how" scrolling occurs through these application other than what was provided, the identification of a command protocol between Windows and applications running within it and a list of particular scrolling commands that applications using this protocol recognize.

Next, Primax argues that KYE's disclosure of Windows as the corresponding structure fails because a bare reference to prior art does not suffice to show corresponding structure for a means-plus-function claim. Primax correctly cites Federal Circuit authority to support its contention. *See Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1317 (Fed. Cir. 2010). In this case, however, the '455 patent not only identifies the prior art Windows operating system as structure, it also discloses an algorithm describing how the system operates to produce the claimed function. In light of the disclosed algorithm, the patent does not rely on merely the mention of prior art to provide structure and thus the holding of *Pressure Products* does not apply. *See Simplification LLC v. Block Financial Corp.*, 593 F. Supp. 2d 700, 717–18 (D. Del. 2009) (holding that reference to prior art software does not provide sufficient structure because no corresponding algorithm was disclosed).

Primax also claims that a structure not only including Microsoft Windows 3.1 but also "newer versions" that had not been released at the time the patent took effect is "a conceptual absurdity." Primax argues that KYE cannot rely on future operating systems of "unknowable design" as structure for a functional claim. Primax cites no law to support this argument. In the first place, the Court finds that even if the '455 patent had only disclosed Windows 3.1 as structure and not mentioned future versions, those future versions would be included under the functional claim to the degree they operated as equivalents to perform the means for scrolling function. *See Micro Chemical, Inc. v. Great Plains Chemical Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999). As outlined above, the Windows structure disclosed is supported by an algorithm describing how it performs the function claimed. The court finds that to the degree that the performance of the claimed function by subsequent versions of Windows may be described by the algorithm disclosed, the patent properly identifies those versions as structure to perform the claimed function.

Finally, Primax contends that the means for scrolling function is not clearly linked to Windows as a corresponding structure because KYE has previously argued that this function was performed by a different structure in prior litigation. Primax has failed to cite any authority for the proposition that no clear linkage exists between a claimed function and its corresponding structure if a party seeking to uphold the patent has advanced different structures in separate actions. Without such authority to rely on, the Court will not look outside the instant case to demand parties' arguments before the Court conform to those made in other proceedings.

In sum, the Court finds that the '455 patent, in identifying Microsoft Windows 3.1 and later versions and relating the associated algorithm, recites sufficient structure for one with ordinary skill in the art to associate it with the function claimed by the means for scrolling limitations in Claims 1 and 11. Primax has failed to present clear and convincing evidence that these claims are indefinite under 35 U.S.C. § 112, ¶ 6.

C.   "Program Means" Limitation May Be Construed

As described below, the Court finds that the program means limitation may be construed, and thus is definite as a matter of law.

1.   *Program Means as Means-Plus-Function Term*

In the first place, KYE argues that the "program means" term is not a means plus function term, but rather, sufficient structure to perform the function is disclosed in the Claim by the word "program." Where the word "means" appears in a claim limitation, there is a presumption that it recites a means-plus-function limitation. *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 703 (Fed. Cir. 1998). This presumption may be overcome if the claim itself relates sufficient structure to perform the recited function without reference to the specification. *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259 (Fed. Cir. 2008).

Here, the Court finds that KYE has failed to overcome the presumption that "program means" is a means-plus-function limitation. The word "program" itself is insufficient to relate sufficient structure to perform the function of "generating messages through the computer to the application program for scrolling the bitmapped memory on the video monitor." Rather, sufficient structure is found only by reference to the specification which discloses mouse driver software that is capable of sending the signals described. *See Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1096 (Fed. Cir. 2008) (finding "mechanism for moving" a means-plus-function claim because the term "mechanism" would have to be qualified with some attributes of the claimed mechanism for it to recite sufficient structure).

2.   *Program Means Function*

The Court finds that the function associated with the program means limitation is "generating messages through the computer to the application program for scrolling the bitmapped memory on the video monitor."[2] Removing any of this language would impermissibly broaden the function of the claim. Indeed, neither KYE nor Primax argues for a more broadly defined function.

3.   *Program Means Structure*

The Court finds that the corresponding structure to the "generating messages. . ." function is the mouse driver software 57, event decoder 63, and message generator 69. The following language in the specification corresponds with the claimed function: "the eight-bit packet [of data generated by the mouse] enters the mouse driver software 57 which interprets the data and splits into two portions. . . the adata portion 55 containing roller and side button information is sent to the event decoder. . . . Decoder 63 is connected to a message generator 69 which is a memory device producing messages recognized by Windows in respect to decoded events." '455 patent, col. 4, ll.18-30, 33, 48-53. This corresponding structure is advanced by KYE as well as Primax's expert witness Robert Dezmelyk.[3] As program means limitations of Claim 1 and 11 can be construed as means plus function limitations, and the corresponding structure appears in the specification, Primax has failed to demonstrate by clear and convincing evidence that these claims are indefinite under 35 U.S.C. § 112, ¶ 6.

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[2]This is the function in Claim 1. Claim 11 includes slightly different language, and accordingly, its function is "generating messages through the computer to the application program for scrolling the bitmapped memory on the video display." This difference is not material to any of the Court's holdings.

[3]Primax contends that Plaintiff's expert advanced an inconsistent corresponding structure, claiming that the mouse driver and a windows program provided structure for the function. The court does not agree with this interpretation of the expert's statement. In the first place, the expert's formulation of the structure is not inconsistent for not including the event decoder 63 and message generator 69, as it is not clear from the specification that these are not components of the mouse driver software. Furthermore, a close reading of the expert's statement of corresponding structure indicates that he did not identify "[a] windows program" as corresponding structure, but rather that this term is meant to denote the "application program" receiving messages for scrolling identified in the function.

D. '455 Patent Does Not Combine System and Method Claims

Primax argues that Claims 1 and 11 in the '455 patent include limitations that combine system and method claims, rendering the claims indefinite under Federal Circuit authority. *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1379 (Fed. Cir. 2005). In *IPXL Holdings*, the court held a claim invalid as indefinite because it claimed both an apparatus and a method for using the apparatus. *IPXL Holdings*, 430 F.3d at 1383–84. The challenged patent claimed a system for executing electronic financial transactions, which would display previously stored personal transaction-information allowing a user to make transactions quickly, without re-inputting the information. *Id.* at 1379. Claim 25 of the patent was dependant to apparatus claim 2, it reads "[t]he system of claim 2 [including an input means] . . . and the user uses the input means to either change the predicted transaction information or accept the displayed transaction type and transaction parameters." *Id.* at 1384. Since this language claimed a method of use, the court reasoned that the scope of the protection claimed by claim 25 was indefinite; it was ambiguous whether infringement would occur by performance of the method claimed. *Id.*

In the wake of *IPXL Holdings*, several district courts were presented with indefiniteness challenges to patents citing the decision. As noted in one case, most courts have rejected these arguments, finding that patents challenged merely included functional limitations cast in "active language" in their apparatus claims. *Ricoh Co., Ltd. v. Katun Corp.*, 486 F. Supp. 2d 395, 402 (D. N.J. 2007). Such language describing the capability of an apparatus through a functional limitation is proper, even if this capability is only understood with reference to an activity a user of the apparatus performs. These subsequent holdings do not conflict with *IPXL Holdings*, where the challenged limitation could only be understood as claiming an action performed by a person as a method step, rather than describing a functional limitation of the independent system claim it was associated with.

Here, Claims 1 and 11 claim a "computer input system" and related components and capabilities. Primax contends that the claims include limitations reciting methods of using the system. The challenged language states: "generating electrical output signals having an extent proportional to the angular velocity of the turnable member"[4] and "said means for scrolling being controlled via positioning the cursor in the scroll bar and turning the turnable member." '455 patent, col. 10, ll. 54–56; col. 12, ll. 32–33. Primax notes that the mouse would only generate the signals, position the cursor, or turn the turnable member with human input. Thus, Primax argues the language describes method steps as in *IPXL Holdings*.

KYE argues that the claims only recite an input system, that no methods for using that system are claimed. The Court agrees. KYE characterizes the challenged language as functional claims used to express functionalities the claimed device must have to fall within the patent. The challenged language may state this functionality in active terms, but KYE contends that when viewed in context of Claim 1 or 11, the challenged language creates no ambiguity. The Court agrees that no reasonable reading of the claims at issue would leave the reader unsure whether the '455 patent would be infringed by a mouse device of similar functionality or by an user turning a jog wheel or positioning a cursor on such a mouse. Thus it is clear that the claim does not intend to include a method of use of the mouse device within its limitations, but uses the challenged language to clarify the capabilities of the input system. In contrast, the *IPXL Holdings* patent claimed an input system, and then listed a particular use of that system as a dependant claim, denoted by the language "the user uses the input means. . . ." *IPXL Holdings*, 430 F.3d at 1384. As the Court finds that Claims 1 and 11 do not combine system and method limitations,

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[4]Claim 11 includes the similar language "generating electrical rotational signals. . . ." The court's analysis of the Claim 1 language applies to the Claim 11 language as well. '455 patent, col. 12, ll. 27–28.

Primax's argument fails.

V. <u>**CONCLUSION**</u>

 For the foregoing reasons, the Court **denies** Primax's Motion for Partial Summary Judgment of Patent Invalidity.

 IT IS SO ORDERED.

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