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Federal Circuit Patent Bulletin: *Gemalto S.A. v. HTC Corp.*

June 19, 2014

"[For prove infringement under the doctrine of equivalents, a] plaintiff must provide 'particularized testimony and linking argument to show the equivalents' are insubstantially different."

On June 19, 2014, in *Gemalto S.A. v. HTC Corp.*, the U.S. Court of Appeals for the Federal Circuit (Newman, Rader, Dyk*) affirmed the district court's summary judgment that HTC, Exedea, Google, Motorola Mobility, and Samsung did not infringe U.S. Patents No. 6,308,317, No. 7,117,485, and No. 7,818,727, which related to enabling resource-constrained devices to run applications written in high level programming languages (such as Java) by minimizing the computing resources that applications consumed during storage and execution. The Federal Circuit stated:

The district court granted summary judgment of non-infringement as to all asserted claims. The court found that the accused devices did not infringe literally because it was undisputed that they "store program instructions off-chip and access those off-chip instructions to run the accused applications." Because the devices could not literally infringe, the court found no indirect infringement of claim 3 of the '727 patent. With respect to infringement, Gemalto does not challenge the court's findings on literal or indirect infringement under the district court's construction....

A device that does not literally infringe a claim may infringe under the doctrine of equivalents. We have held that "a patentee may prove that a particular claim element is met under the doctrine of equivalents . . . by showing that 'the accused product performs substantially the same function in substantially the same way with substantially the same result' as claimed in the patent."

Gemalto contends that the accused devices infringe under the doctrine of equivalents when they temporarily load program instructions from off-chip memory into on-chip cache memory before execution. Because cache memory cannot store applications (or any content) when a device is turned off, the court concluded that cache memory is substantially different from permanent memory and not equivalent for infringement purposes. Gemalto admits that cache memory does not store program instructions when the accused devices are turned off, but argues that the difference between temporary on-chip storage and permanent on-chip storage is insubstantial or, alternatively, that the significance of this difference raises a genuine question of material fact. Gemalto's theory of infringement by equivalents hinges on its contention that on-chip cache memory is equivalent to on-chip memory permanently storing applications. According to Gemalto, applications are loaded into on-chip cache memory before execution 97% of the time, and the difference between 97% and 100% is insubstantial.

A plaintiff must provide "particularized testimony and linking argument to show the equivalents" are insubstantially different. "Generalized testimony as to the overall similarity between the claims and the accused infringer's product or process will not suffice." These requirements "assure that the fact-finder does not, 'under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.'" Gemalto has failed to provide particularized testimony and linking argument.

Gemalto provided no testimony asserting that the difference in functionality between cache memory and permanent memory is in fact insubstantial. Gemalto's expert testimony only addresses the difference between having 100% or 97% of program instructions stored onchip, not the underlying difference between temporary and permanent storage. The testimony does not address whether cache memory is equivalent to other types of memory that are capable of storing applications after a device is turned off. Absent any testimony suggesting that cache memory is equivalent to permanent memory, no reasonable fact finder could find that the two types of memory function in substantially the same way to achieve substantially similar results....

Moreover, the cache memory functionality that is the basis for Gemalto's theory was employed by microprocessor-based systems at the time of the invention. Gemalto has admitted that "'microprocessors in 1996 did have cache memory,'" and that these microprocessors ran Java applications before the 1996 priority date of the asserted patents. If cache memory were equivalent to the recited memory that stores an application and interpreter, Gemalto's claims would read on microprocessor systems that were widely used prior to its invention. The doctrine of equivalents cannot be applied to encompass the prior art as "this court has consistently limited the doctrine of equivalents to prevent its application to ensnare prior art." "Because prior art limits the exclusive right available to an inventor, it also limits the range of permissible equivalents of

a claim." Applying the doctrine of equivalents to cover cache memory used in the prior art is not permissible. We agree with the district court that the accused devices do not infringe under the doctrine of equivalents due to their use of cache memory.