

No. 18-__

IN THE
Supreme Court of the United States

RICHARD J BAKER,

Petitioner,

v.

MICROSOFT CORPORATION, UBISOFT, INC.,
NINTENDO OF AMERICA INC., ELECTRONIC
ARTS, INC., HARMONIX MUSIC SYSTEMS, INC.,
MAJESCO ENTERTAINMENT,

Respondents.

**Petition for a Writ of Certiorari to the
United States Court of Appeals
for The Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

RICHARD J BAKER

Pro Se Petitioner

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QUESTIONS PRESENTED

Article I, Section 8, Clause 8, of the United States Constitution grants Congress the power "To promote the progress of science and useful arts, by "*securing*" for limited times to authors and inventors the exclusive right to their respective writings and discoveries." US Patent holders when they give forth their discoveries petitioner believes form a binding contract agreement with the U.S. Government and judiciary to "secure" their private property against infringement. In proceedings today lower courts are not helping to secure for inventors their patents which seriously conflicts with the spirit of the Patent Act of 1790 (1 Stat. 109).

The questions presented are:

1. Whether under rights given by Congress and contained in U.S. Constitution. Article I Section 8. Clause 8 to all U.S. patent holders for disclosure of invention on even a scintilla of evidence being shown of genuine dispute all courts must forward when requested proceedings to the trier of fact "a trial" otherwise the promise to secure for all inventors their personal property invention is broken by the U.S. Government?

2. Should the U.S. Government compensate inventors when the judiciary have failed to help secure their issued patent, a promise contained in U.S. Constitution. Article I Section 8. Clause 8 is broken?

PARTIES TO THE PROCEEDING

All parties are listed in the caption. Majesco Entertainment has been listed as a respondent because they did not participate at the Circuit Court level but were listed as defendant.

RULE 29.6 STATEMENT

Petitioner, Richard J Baker, has no parent corporation or shares held by a publicly traded company.

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PETITION FOR WRIT OF CERTIORARI

Richard J Baker respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit and United States District Court for the Western District of Washington.

OPINIONS BELOW

1. The Judgment and Opinion, United States Court of Appeals for the Federal Circuit affirming to respondents in Case No. 17-2357 is reprinted at appendix..... App.1
2. The opinion, U.S. District Court United States District Court for the Western District of Washington at Seattle Granting Defendants' Motion For Summary Judgment (3rd January, 2017)..... App.12
3. The order of the United States Court of Appeals for the Federal Circuit Denying Petition for Panel Rehearing and Rehearing En Banc in Case No. 17-2357 is reprinted at App.34

JURISDICTION

The United States Court of Appeals for the Federal Circuit Court entered of judgment on April 9, 2018 is found at App.1 The United States Court of Appeals for the Federal Circuit Court denial of Petition for Panel Rehearing and Rehearing En Banc on June 8, 2018 is found at App.34. The United States District Court for the Western District of Washington at Seattle entry of early summary judgment to the Respondents on January 3, 2017 is found at App.12. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Fifth Amendment to the United States Constitution provides: No person shall ... be deprived of life, liberty, or property, without due process of law.

Section One of the Fourteenth Amendment to the United States Constitution provides: [N]or shall any State deprive any person of life, liberty, or property, without due process of law.

United States Constitution (Article I, Section 8, Clause 8) Patent Act of 1790 (1 Stat. 109)).

Breach of Contract and Broken Promises under Restatement (Second) of Contracts §71.

Promissory Estoppel under Restatement (Second) of Contracts § 90.

STATEMENT OF THE CASE**I. A CONTRACT FORMED BY PROMISE
AND ACCEPTANCE BETWEEN
INVENTOR AND U.S. GOVERNMENT
HAS NOW BEEN BROKEN. SHOULD U.S.
GOVERNMENT COMPENSATE?**

In 1991 petitioner invented a “new machine” that took video to a whole new level of performance, one which can teach people “personally” for the first time. It allows any expert to teach potentially tens of thousands of people per day around the world similar to face-to-face communications and “never” have to see anyone’s physical movement. Unheard of at the time. The invention works via capturing a persons movement using a camera, transmitting it to a computer database via a communications means, where it is analysed against an experts stored movement and new visual presentation made which shows person their movement against a preferred stored experts movement and audio instructional comments from the expert are generated to go with the split screen, superimposed visual presentation. By converging a number of known industries and adding his “unique algorithm” to a computer database a computer can “automatically” mass produce in near real-time personalised instructional video for people.

Petitioner is pioneer inventor of this technology and should have received broad coverage of where he could work the invention if he did not relinquish any elements during prosecution, which

he did not, explained at point III in his Corrected Brief Of Appellant, Document: #33 Page: 29 Filed: 10/25/2017. The invention unfortunately petitioner was to find out was way before its time, problems with motion capture, near real time video transmission, computer processing speed etcetera. About 12 years go by and PC Games Consoles come up to speed to make petitioner new machine around 2007, petitioner sues respondents for infringement 2015. Respondents have case moved to their home town on inconvenience and then ask for early summary judgment on narrow question **“can petitioner work his motion tracking camera and computer inside same room, in close proximity to parson having their motion captured”** where respondents systems work, when he mentioned in approved claims his motion capture camera is situated at a **“first location”** and computer is at a **“remote second location”** and both devices are only separated via a communications means? Petitioner provided many material facts in opposition to summary judgment that went against the other side’s case, all of which he still feels was good enough to send this case to trial but the District Court took onboard all the pleadings of respondents and awarded early summary judgment on 3rd January, 2017.

On valid material facts “disputes” being shown which added inferences of doubt to what respondents said occurred at prosecution it became not a law question for judge to decide and Judge Jones should have sent proceedings to trial, but he did not. Sticking to the same material facts but just

elaborating on them even more petitioner then filed Appeal in the Federal Circuit Case No 17-2357, Document No 33 on 25th October, 2017 but here again the Federal Circuit also decided wrongly to weight the disputes and affirmed to the respondents Document No 51-2, Filed: 9th April, 2018. Petitioner then further filed Petition For Panel Rehearing And Rehearing En Banc Document No 52 on 7th May, 2018, same material facts, valid disputes and rehearing was denied. Document No 54 on 8th June, 2018. One may think that two courts and three determinations on petitioners' pleadings the justices could not have got things wrong, but they **"clearly did"**, one can see this by what petitioner advises at point II "B" below. This case shows how on showing of "valid disputes" by a non-movant, cases **"must be"** sent to trier of fact, "trial" otherwise justice may not be served. Here lower court judiciary have not helped to "secure" for inventor a patent and if petitioner cannot now get hearing in this last court of justice a contract formed by "promise and acceptance" and payment of continual fees to keep patent, contract/agreement between inventor and U.S. Government valid has been broken. Should the U.S. Government then compensate inventors?

II. THE LITIGATION THROUGH THE LOWER COURTS

A. The United States Court of Appeals for the Federal Circuit

Petitioner in this section finds it hard to even describe how on many genuine material facts,

disputes showed in his Reply Brief Document No 45, Filed: 27th November, 2017 and Petition For Panel Rehearing And Rehearing En Banc Document No 52 7th May, 2018 how this court could not see this case needed to go to trial considering to defeat summary judgment a non-moving party only has to show substantial evidence that a dispute of material facts exists, regardless of the strength of that evidence and even if the moving side can produce the testimony of "a dozen bishops", and the non-moving side only has the testimony of a known liar, "then summary judgment is not appropriate. Deciding on the relative credibility of a person is a question for the factfinder at trial.

B. Petitioners Specification Proves Judiciary Got It Seriously Wrong

One factor alone should have sent this case to trial. In his pleadings petitioner mentioned a number of times his U.S. Patent No. 5,486,001 "specifications" read on his image capturing device being "**not physically affixed**" or "**attached**" to the computer, see J.A. 51 at line 12. The significants of this statement is it tells a "**distance**" petitioners camera and computer can be away from one another "not physically affixed or attached together" can be a very "**minute**" distance and so it puts beyond any doubt petitioner could work his "remote" computer in a single room, in close proximity to motion capture camera, the exact territory respondents accused systems work and thus early summary judgment to the respondents by the judiciary was plainly wrong should not have been granted.

The specification is the single best guide to the meaning of a disputed term, and acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Statements made in a patent application hold greater weight than do statements made during prosecution since “[u]ltimately, the only meaning that matters in claim construction is the meaning **“in the context of the patent”**”. *Poly-America, L.P. v. API Industries, Inc.*, (16-1200, Fed. Cir. October 14, 2016), p. 10 (emphasis added).

A patentee can be his own “lexicographer” which is exactly what he told the Federal Circuit Document No 52 at page 6. This particular page also talks about camera and computer are not **“affixed”** and the terminology petitioner used to described where his camera and remote computer are located, first and second location was nothing new because it was a carry over from his originating application 1992 W092/2 1 4 1 2 PCT/AU92/00253, example see J.A. 321 Claim 4. No estoppel took place at patent prosecution.

C. The United States District Court for the Western District of Washington

On February 26, 2015, petitioner filed suit in the Eastern District of Texas Tyler Division, alleging respondents literally and via Doctrine Of Equivalents (DOE) 35 U.S.C. § 112 ¶ 6 and After-Arising Technology (AAT) infringed upon his issued U.S. Patent No. 5,486,001. Respondents moved on

August 11, 2015 to have case transferred to Western District of Washington on inconvenience because petitioner had no ties to the chosen forum Texas. Court granted request on March 17, 2016. In Seattle on June 17, 2016 respondents filed motion for early summary judgment of non-infringement. Case 2:16-cv-00396-RAJ Document No 130 that the court should consider.

Plaintiff's infringement theory is that storage, transmission, and/or comparison of visual image signals "locally" constitutes infringement of the "remote" location limitations, including pursuant to the doctrine of equivalents and after-arising technology. Defendants contend that statements made during prosecution of the patents-in-suit legally preclude and/or prohibit Plaintiff's infringement theory; Plaintiff disagrees. This is a narrow legal issue. Joint Status Report Document No 127 filed April 18, 2016.

D. District Court Support For Non-Movant Non-Existent

In the District Court petitioner presented his opposition of defendants motion for summary judgement, Document No 133 Filed July 9, 2016. The document shows many evidentiary claims as to why and how he was entitled to work his "new machine" anywhere. In particular it talks about what actually happened during patent prosecution which backs up no "clear and convincing" evidence

he ever relinquished the territory the respondents claim. J.A. 464-468. He mentioned and showed the district court a picture at J.A. 462 of how the respondents camera's are "separated" from computer via a "communications means" mentioned in his approved patent claims and how they use USB cable which is a modern "communications" means. The accused systems use a "peripheral" device camera which is "not physically affixed" to computer mentioned in petitioners approved patent specifications. J.A. 51, line 12. He mentioned to the district court there was no difference to way the accused systems operate and the invention. When they use a peripheral device camera not attached to computer it is in a first location with a remote computer in second location. On reading and seeing this information alone the district court should have by law supported the non-movant and helped to secure for inventor the patent, sent case to trial without even considering petitioner was a pioneer inventor and may have had AAT DOE rights as well but Judge Jones went against legal principals of early summary judgment and weighted up the evidence and wrongly determined (a) respondents camera and computer where "physically" connected. J.A. 15, line 3 which they are differently not plus (b) in regards petitioners two audio-visual transceivers they cannot be working in same room, which they can and stated at i. Construction of Claims 1, 10, and 18 of the '001 Patent

The Court construes the term "remote" in Claims 1, 10, and 18 of the '001 Patent to require "**more**" than physical separation at

the same location. The Court's construction is supported by the plain language of Claims 1, 10, and 18, the '001 Patent specification, and the prosecution history of the '001 Patent.

All petitioner was required to show at early summary judgment was a dispute of material facts exists, regardless of the strength of that evidence but Judge Jones decided to determine petitioner evidentiary claims normally reserved for jury and became decider of the evidentiary claims and award early summary judgment to the respondents which if then the Federal Circuit does not have time to do proper due diligence in regards the evidentiary claims and inventor cannot get hearing in this court means by just a district court saying at early summary judgment there must be "more", to disputes shown a case can basically be over even for a pioneer inventor and justice has certainly not been served when one can see by doing proper due diligence of petitioners patent specifications and keeping in mind he was allowed to be his own lexicographer he was clearly entitled to work his remote computer in the same territory as respondents systems. Under procedural due process clause found in both the Fifth and Fourteenth Amendments petitioner should have received hearing by impartial trier of fact.

REASONS FOR GRANTING THE WRIT

I. The case presents an issue of national importance, continuing judiciary support for inventors to help secure their U.S. Patents.

The framers of the 1790 Patent Act may have had very good intentions to protect inventors intellectual property but today inventors and people working within the patent industry are saying the judiciary in the United States over the last decade or so have passed laws which make it a lot easier for accused patent infringers to go free by example running across border to a non-patent friendly state, to the stage now where many believe a U.S. patent is not worth the effort, time and cost to receive and can easily be terminated by Agency not Category III court.

All inventors who have a U.S. patent look to the laws formed by this court to protect their valuable personal property which the Patent Act states should be “secured” but what good are this courts laws if the lower court judiciary and agency administration especially in computer related cases are not fully conversant with today’s computer technology compared to old, how terminology has changed over the years for particular computer parts but work same etcetera? What can happen is at early summary judgment bad decisions can be made and potential infringers can go free. The USPTO can also issue a patent again for the same subject matter, which this inventor believes actually has happened

to him with his instant patent. One of the only defences an inventor has left to judiciary making a bad decision is on a valid showing of genuine “disputes” calls for judiciary to forward case to trial. This is not happening as evidence by this case. Petitioner believes this court needs to make absolutely clear for the reasons given below at point III “A” and “B” that all cases in the lower courts which show even a mere scintilla of evidence and have requested must be sent to jury trial.

II. Further Reasons For Valid Disputes Going To Jury Trial

If aggrieved party has good evidence which could convince a jury in their favour there is good probability the other party may then consider settling before trial. By court ordering on a showing of disputed facts lower courts must send case to jury trial also helps take away the stigma inventors will not receive fair hearing in some U.S. states. A much fairer system for everyone petitioner believes having now experienced what can happen when judiciary say against valid disputes there must be “more” during early summary judgment a case is basically over on a word if appeal court justices also do not have the time to understand fully the workings of an invention.

III. Clearly inventors should have a valid claim to some sort of compensation under Restatement (Second) of Contracts §71 and Restatement (Second) of Contracts § 90 when there has been

**promise made by U.S. Government to
secure and no support is forthcoming
from judiciary during a proceeding.**

**A. Breach of Contract and Broken
Promises under Restatement (Second)
of Contracts §71**

Bargain Theory

(1) To constitute consideration, a performance or a return promise must be bargained for.

(2) A performance or return promise is bargained for if it is sought by the promisor in exchange for his promise and is given by the promisee in exchange for that promise.

(3) The performance may consist of
(a) an act other than a promise, or
(b) a forbearance, or
(c) the creation, modification, or
destruction of a legal relation.

(4) The performance or return promise may be given to the promisor or to some other person. It may be given by the promisee or by some other person.

Inventors when they hand over their inventive ideas to the U.S. Government via its agency USPTO expect from statements made in Article I Section 8. Clause 8 of U.S. Constitution that they may receive

a U.S. patent and help to “**secure**” protect it by the judiciary against infringement during life of the patent. U.S. Government via its agency USPTO in return expects to receive and usually does from inventor “best mode” of operation, plus ongoing monies to keep patent alive. Valid contract has then been formed between the parties via “promise in exchange for an action” and money and “one parties reliance on another’s promise”. Usually when such promises are broken in other industries it’s called stealing and there is recourse for an aggrieved individual or company to be compensated. If lower courts and this court do nothing to help secure for inventors their valid patents when genuine disputes are shown which should have sent proceeding to trier of fact then who compensates an inventor when promises are broken under Article I Section 8. Clause 8 of U.S. Constitution?

**B. Promissory Estoppel under
Restatement (Second) of Contracts
§ 90.**

The promissory estoppel doctrine allows an injured party to recover on a promise upon which he relied, and then suffered a loss as a result. There are five elements of promissory estoppel that must exist in order for the concept to be enforced. The five elements of promissory estoppel are listed below:

- **Legal Relationship** – Some form of legal relationship must exist, or be anticipated to exist, between the parties, such as a contractual relationship.

- **Promise** – It must be shown that a promise was made between the parties to the action that led the injured party to assume that some sort of action was to be taken. Such a promise must be reasonably reliable, or believable.
- **Reliance** – It must be shown that the injured party relied on the promise that was made, and took some action based on that promise.
- **Detriment** – The party that relied upon the promise must have suffered some sort of detriment or loss, which puts him in a worse position than when he started.
- **Unconscionability** – It must be shown that it was unfair for the promisor to break his promise to the promisee.

All the above five elements are present when a patent has been applied for and approved by U.S. Government via its agency USPTO and the lower courts unfairly do not help to “secure” for inventor their U.S. patent. The courts will not always force the promisor to honor his promise. The only time this is done is if “injustice” can be avoided only by “enforcement of the promise.” The remedy granted for breach may be limited as “**justice requires**”. Under summary judgment justice requires even a scintilla of evidence being shown of genuine dispute all courts must forward proceedings to the trier of fact “a trial” otherwise the promise to “secure” for all inventors their personal property discoveries contained in United States Constitution (Article I, Section 8, Clause 8) is broken by the U.S.

Government. Petitioner now ask this court in supervisory role to step in and rule more strongly on initial request for a jury trial and scintilla of evidence being shown of genuine dispute all lower courts must forward the proceedings to jury trial. To show all inventors that the spirit of the framers 1790 Patent Act to secure their patents is still alive and enforceable by this court if needed.

CONCLUSION

“The petition for a writ of certiorari should be granted”; “The judgment of the District Court should be reversed, new judge appointed.”

Respectfully submitted.

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APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RICHARD J. BAKER,
Plaintiff-Appellant

**MICROSOFT CORPORATION, UBISOFT, INC.,
NINTENDO OF AMERICA, INC., ELECTRONIC
ARTS INC, HARMONIX MUSIC SYSTEMS, INC.,**
Defendants-Appellees

MAJESCO ENTERTAINMENT,
Defendant

2017-2357

Appeal from the United States District Court for the
Western District of Washington in No. 2:16-cv-
00396- RAJ, Judge Richard A. Jones.

Decided: April 9, 2018

RICHARD J. BAKER, Mermaid Waters,
Queensland, Australia, pro se.

SONAL NARESH MEHTA, Durie Tangri LLP, San Francisco, CA, for defendants-appellees Microsoft Corporation, Electronic Arts Inc. Also represented by ADAM R. BRAUSA.

MICHELLE LYONS MARRIOTT, Erise IP, P.A., Overland Park, KS, for defendant-appellee Ubisoft, Inc. Also represented by ERIC ALLAN BURESH.

JONATHAN L. MCFARLAND, Perkins coie, LLP, Seattle, WA, for defendant-appellee Nintendo of America, Inc.

PATRICK JOSEPH COYNE, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC, for defendant-appellee Harmonix Music Systems, Inc. Also represented by LINDA JEAN THAYER, Boston, MA.

Before REYNA, WALLACH, and HUGHES,
Circuit Judges. REYNA, Circuit Judge.

Richard Baker appeals the United States District Court for the Western District of Washington's grant of summary judgment of noninfringement. We affirm.

1. BACKGROUND

I. The '001 Patent

Mr. Baker is the owner and inventor of U.S. Patent No. 5,486,001 ("the '001 Patent"), which is entitled "Personalized Instructional Aid." The '001 Patent describes an instructional aid intended to provide users with feedback on their body movements relating to a given activity, such as a golf swing. The '001 Patent claims a method and an apparatus generally comprising the steps of capturing an image signal of a user's movement in a first location; using a transceiver at the first location to send the captured signal over a communications network to a computer at a second location; comparing the captured signal with a pre-stored, preferred signal using the computer at the second location; generating and transmitting an instructional signal from the computer at the second location to the transceiver at the first location; and displaying the instructional signal back to the user at the first location.

Relevant to this appeal, during prosecution of the '001 Patent, the U.S. Patent and Trademark Office ("USPTO") rejected Mr. Baker's application as anticipated by U.S. Patent No. 5,184,295 ("Mann"). Specifically, the Examiner noted:

Mann discloses a method for providing an instructional aid for assisting a person to emulate a preferred movement. The method includes the steps of capturing and storing visual image signals

representative of a particular movement, comparing said captured image signals with stored image signals of a preferred movement, and generating further video image signals based on the original signals.

J.A. 149.

Mr. Baker amended the application, adding language requiring certain functions to occur at different "locations." Claim 1 of the '001 Patent was amended, with the amended terms underlined, as follows:

A method for providing an instructional aid for assisting a person to emulate a preferred movement, said method comprising:

capturing and storing initial visual image signals representative of a particular movement at a first location,

storing preferred image signals representative of a selected preferred movement at a second location remote from said first location in a data base of a computer,

transmitting said captured and stored visual image signals from said first location to said computer at said second location,

comparing said captured and stored
image signals with stored preferred
image signals in said data base of said
computer.

regenerating further visual secondary
image signals based on said initial
image signals of said particular
movement adjusted to emulate said
stored preferred image signals of said
selected movement in said computer,
and

transmitting said regenerated signals
from said computer at said remote
second location to said first location and
stored in image presentation means
which permits viewing thereof with
dialogue relating to said regenerated
visual secondary image signals.

J. A. 90—91 (emphases added). Pending claim 17 (issued claim 10) was similarly amended, and pending claim 25 (issued claim 18) contained originally-filed language requiring a means for transmission "to a remote location." J.A. 93, 95—96. Following these amendments, and in light of Mr. Baker's supporting remarks, the USPTO allowed Mr. Baker's claims and issued the '001 Patent.

II. The Accused Products

Mr. Baker brought the underlying
infringement suit against Microsoft Corporation,

Electronic Arts Inc., Harmonix Music Systems, Inc., Majesco Entertainment Co., Ubisoft, Inc., and Nintendo of America, Inc. (collectively, "Appellees"). As relevant here, the purportedly infringing products are video games that incorporate an image capturing device, i.e., a camera, connected to a gaming console or personal computer. Mr. Baker contends that the accused cameras constitute a "first location," while the gaming consoles or personal computers constitute a "second location," and therefore, Appellees' products infringe the '001 Patent when combined.

Relying on the claim amendments during prosecution of the '001 Patent, Appellees moved for summary judgment of noninfringement of the asserted claims. The district court granted summary judgment for Appellees concluding that Appellees' products do not infringe the '001 Patent either literally or under the doctrine of equivalents. Subsequently, the district court denied Mr. Baker's motion for reconsideration.

On appeal, Mr. Baker seeks to reverse the district court's grant of summary judgment of noninfringement. We have jurisdiction under 28 U.S.C. S 1295(a) (2012).

DISCUSSION

We review summary judgment decisions by applying the law of the regional circuit, here the Ninth Circuit. See *Lexion Med. , LLC v. Northgate Techs., Inc.*, 641 F.3d 1352, 1358 (Fed. Cir. 2011).

The Ninth Circuit reviews "the district court's grant of summary judgment de novo." *Goodman v. Staples The Office Superstore, LLC*, 644 F.3d 817, 822 (9th Cir. 2011). Summary judgment is appropriate when, viewing the evidence in the light most favourable to the nonmoving party, there is "no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *Zetwick v. Cty. of Yolo*, 850 F.3d 436, 440 (9th Cir. 2017) (citations omitted).

I. Claim Construction

The district court construed the term "remote" in claims 1, 10, and 18 of the '001 Patent as requiring "more than physical separation at the same location." *Baker v. Microsoft corp.*, No. C16-396RAJ, 2017 WL 44517, at *4-5 (W.D. Wash. Jan. 3, 2017). Mr. Baker argues that the district court erred in its claim construction because the intrinsic record does not limit the term "remote" to mean that the separate locations cannot be in the same room. For the reasons discussed below, we agree with the district court's construction.

The '001 Patent's specification describes two components of the first location as an "image capturing device" and an "audio-visual signal transceiver." The specification explains that at the first location, the image capturing device may either be "discrete" from the signal transceiver, or the two components "may be one in the same." '001 Patent, col. 6, II. 5—9. The district court therefore reasoned that the use of the term "discrete" to describe

physically separated components at the same location indicates that the term "remote" must require something more than mere physical separation. Baker, 2017 WL 44517, at *4-5.

The district court also noted that during prosecution, Mr. Baker overcame the Mann prior art reference and achieved patentability by adding the limitation of two separate locations to his pending claims. *Id.* at *5. Thus, the district court concluded that Mr. Baker "disavowed the interpretation of 'remote' he now seeks to use when he amended [the claims]." *Id.*

"Statements made during prosecution may also affect the scope of the claims. Specifically, a patentee may limit the meaning of a claim term by making a clear and unmistakable disavowal of scope during prosecution." *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008) (citations and internal quotations omitted). Mann discloses all the features of the '001

Patent but does not impose the '001 Patent's requirements incorporating separate, remote devices. See J.A. 151; 256—58. Rather, Mann's specification indicates that the invention's functions are performed by a peripheral camera connected to a single, capable computer. J.A. 243 ("The computer utilized by the applicants in the practice of this invention is a model VAX 11/750, manufactured by Digital Equipment Corporation.").

In his remarks accompanying the proposed amendments, Mr. Baker argued that Mann did not anticipate the amended claims because "[n]owhere in Mann is there a teaching that the computer system is located remotely from the teaching station as is emphasized in Applicant's disclosure." J.A. 99. Mr. Baker further argued that "[t]ransmittance to a separate location for analysis and feedback is critical in Applicant's invention, because the programming can be efficiently performed at the remote computer station." *Id.*

Mr. Baker made these amendments to distinguish the '001 Patent over Mann. We agree with the district court that Mr. Baker clearly and unmistakably disavowed any portion of his claim scope which combines the claimed features of the '001 Patent's remote computers into a single location or a single computer-like device, as disclosed in Mann.

Lastly, for the reasons discussed by the district court, we agree that the word "remote" in claim 18 carries the same meaning as it conveys in claims 1 and 10. See Baker, 2017 WL 44517, at *4.

II. Infringement

Before the district court, both parties stipulated to the fact that, at all relevant times, the cameras of Appellees' products are "located in the same room, and in close proximity to," the game consoles or personal computers. J. A. 451—52. Based on its claim construction that remote data bases

cannot be located in a single location, the district court determined that Appellees' accused products do not literally infringe the '001 Patent because all components of the accused products, when combined, are located in the same room. *Id.* at *6—7.

We agree that Appellees' accused products do not literally infringe the '001 Patent. Rather than incorporating two remote, computer-like devices (plus a peripheral camera) as required by the claims, we observe—and Mr. Baker appears to concede¹ — that the accused products only employ a single game console or personal computer in conjunction with a peripheral camera. As explained, Mr. Baker clearly and unmistakably disclaimed such a system during prosecution. Thus, we agree with the district court's conclusion that the accused products do not literally infringe each limitation of claim 1, 10, or 18 of the '001 Patent. See *Advanced Steel Recovery, LLC v. X-Body Equip., Inc.*, 808 F.3d 1313, 1319 (Fed. Cir. 2015); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995) ("To establish literal infringement, every limitation set forth in a claim must be found in an accused product, exactly.").

The district court also concluded that prosecution history estoppel barred Mr. Baker from

¹ Mr. Baker's infringement argument requires identifying a peripheral camera as a first location and a PC or game console as a second location remote from the peripheral camera. See, e.g., Appellant's Br. 42 ("Again, Appellees [sic] use of a peripheral device camera puts them on working [sic] camera and computer in two separate locations mentioned in the ['001 patent.").

pursuing his infringement claim under the doctrine of equivalents. See Baker, 2017 WL 44517, at *7—8. For the same reasons discussed in the district court's order, we agree.

CONCLUSION

We have considered Mr. Baker's remaining arguments and find them unconvincing. Accordingly, we affirm the district court's grant of summary judgment in favor of Appellees.

AFFIRMED

Costs

No costs.

APPENDIX B

HONORABLE RICHARD A. JONES

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

Case No. C16-396RAJ

RICHARD J. BAKER,
Plaintiff,

MICROSOFT CORPORATION, et al.,

Defendants.

ORDER GRANTING DEFENDANTS '
MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

This matter comes before the Court on Defendants Microsoft Corporation, Electronic Arts Inc., Harmonix Music Systems, Inc., Majesco Entertainment Co., Ubisoft Inc., and Nintendo of America Inc.'s (collectively "Defendants") Motion for Summary Judgment. Dkt. # 130. Plaintiff Richard Baker ("Mr. Baker") alleges that Defendants' products infringe United States Patent No. 5,486,001 (the "'001 Patent"), a patent issued to him

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in 1996. Dkt. #44 at 3-4. Defendants contend they are entitled to summary judgment because the accused products do not come within the scope of Mr. Baker's patent. Dkt. #130 at 16-21. Mr. Baker disputes Defendants' interpretation of the '001 Patent and argues that Defendants' products, when combined, literally infringe upon the '001 Patent. Dkt. #133 at 22. Alternatively, Mr. Baker argues that the doctrine of equivalents applies and warrants a finding of infringement. Dkts. #129 at 15 and #133 at 24-26. The Court, having reviewed the record before it, GRANTS Defendants' motion.

II. BACKGROUND

In 1992 Richard Baker filed a patent application, Application No. 146,016, with the United States Patent and Trademark Office ("USPTO"). Dkts. #131, Ex. 3 at 2, and #133 at 8- 9. The application described a personalized instructional aid that captured visual images representative of a person's movement, stored those visual images, compared those visual images to exemplary movements stored in a database, and then generated adjusted visual images to help an user emulate the exemplary movement. Dkt. #131, Ex. 4 at 23-27. Application No. 146,016 was rejected. *Id.*, Ex. 5.

Besides failing for indefiniteness under 35 U.S.C. 1 12, the USPTO rejected Mr. Baker's proposed claims because they were anticipated by United States Patent No. 5,184,295 (the "Mann Patent"), and because several claims were obvious

when the Mann Patent was combined with other prior art. *Id.* at 5-8. In its 35 U.S.C 102(a) and (e) rejections, the Patent Examiner concluded that the Mann Patent "includes the steps of capturing and storing visual image signals representative of a particular movement, comparing said captured image signals with stored image signals of a preferred movement, and generating further video image signals based on the original signals." *Id.* at 4.

Following the USPTO's initial rejection, Mr. Baker amended his patent application. Dkt. #131, Ex. 1. Mr. Baker amended his proposed patent claims by adding limitations indicating that the image capturing device of his personalized instructional aid was to be located "at a first location," while the place for storage, comparison, and generation of further video image signals was to occur "at a second location remote from said first location in a data base of a computer . *Id.* at 9-14. To support his amendments, Mr. Baker argued that the "separation or remoteness" between the location of the '001 Patent's image capturing device and the location of the computer system (where the comparison and analysis of the captured image signals takes place) precluded anticipation by the Mann Patent and other prior art. *Id.* at 18-19. Mr. Baker explained, "[n]owhere in Mann is there a teaching that the computer system is located remotely from the teaching station as is emphasized in Applicant's disclosure, wherein the primary images are formed in one location for instruction such as a studio or an aircraft." *Id.* at 18. The '001 Patent's transmittance of captured images "to a separate location for

analysis and feedback" was considered "critical in Applicant's invention, because the programming can be efficiently performed at the remote computer station." *Id.*

Following Mr. Baker's amendments, the USPTO allowed Mr. Baker's claims; the '001 Patent issued on January 23, 1996. Dkt. #131, Ex. 3. The '001 Patent includes method and apparatus claims, and it expired on January 23, 2013. Dkts. #44 at 4 and #131, Ex. 3 at 10-11.

After the '001 Patent issued, Mr. Baker filed a Continuation-in-Part Patent application ("CIP Patent"). Dkt. #131, Ex. 6. The CIP Patent sought to expand the '001 Patent by allowing a computer, which the '001 Patent places at a second location remote from an image capturing device, to be located at the same location, or adjacent to, the image capturing device called for in the '001 Patent. Dkts. #131, Ex. 6 at 5, 21 and Dkt. #131, Ex. 3 at 10-11. All sixteen CIP Patent claims were not patentable due to prior art references and the CIP patent was rejected. Dkt. #131, Ex. 7 at 7.

Mr. Baker now accuses Defendants of infringing claims 1-5, 10-15, and 18-20 of the '001 Patent. Dkts. #44 at 3-16 and #129 at 2. Claims 1, 10, and 18 are independent claims. Dkt. #131, Ex. 3 at 10-11. Claims 1 and 10 require "capturing" and "storing" visual image signals at a "first location." *Id.* at 10. The captured visual images are then transmitted to a "second location remote from the first location" where those images are stored. *Id.*

Claim 1 8 requires a means for "visually scanning, sensing and capturing visual and informational data signals representative of a particular target," a means for "storing said representative visual and informational data signals," and a means for "transmitting said representative visual and information data signals to a remote location." *Id.* at II. Claim I is a method claim, while Claims 10 and 18 are apparatus claims. *Id.* at 10-11.

Mr. Baker accuses these two product groups of infringement: (1) Microsoft's Kinect sensor and games that can be played on the Xbox 360 with the Kinect sensor; and (2) the Your Shape game and associated camera, as played on Nintendo's Wii console or a personal computer ("PC"). See Dkt. #132 '13. The cameras associated with these two groups are connected to their respective game consoles with a physical cable. *Id.* 7, 13, 17, 19.

Mr. Baker contends that combined use of the accused products infringes the '001 Patent claims. Dkt. #44 at 4. According to Mr. Baker, images are formed by the accused cameras, thereby satisfying the "capturing and storing initial visual image signals . at a first location" requirement of the '001 Patent claims. Dkt. #129 at 14-15. The "first location" required by the asserted claims is located where the "real world person is who wants personalized audio-visual advice or an object[.]" *Id.* at 15. Mr. Baker then accuses the Xbox360 console, the Nintendo Wii console, and PCs of "storing preferred image signals representative of a selected

preferred movement at a second location remote from said first location in a data base of a computer." *Id.* at 15. In his infringement contentions, Mr. Baker alleges that the accused cameras are at the "first location," while the Xbox 360 console, the Nintendo Wii console, and the PCs are the "second location remote from said first location." *Id.* at 14-15.

Defendants' motion for summary judgment is now before the Court.

III. SUMMARY JUDGMENT STANDARD

Summary judgment is appropriate where "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986). When ruling on summary judgment, courts do not weigh evidence to determine the truth of the matter, but "only determine whether there is a genuine issue for trial." *Crane v. Conoco, Inc.*, 41 F.3d 547, 549 (9th Cir. 1994) (citing *Fed. Deposit Ins. corp. v. O'Melveny & Meyers*, 969 F.2d 744, 747 (9th Cir. 1992), *rev'd on other grounds*, 512 U.S. 79 (1994)). Material facts are those which might affect the outcome of the suit under governing law. *Anderson*, 477 U.S. at 248.

Courts must draw all reasonable inferences in favor of the non-moving party. See *O'Melveny & Meyers*, 969 F.2d at 747. However, the nonmoving party must make a "sufficient showing on an essential element of her case with respect to which

she has the burden of proof" to survive summary judgment. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Further, "[t]he mere existence of a scintilla of evidence in support of the plaintiffs position will be insufficient; there must be evidence on which the jury could reasonably find for the plaintiff." *Anderson*, 477 U.S. at 252.

IV. DISCUSSION

Defendants seek summary judgment on three grounds. First, Defendants contend that Mr. Baker cannot prove their products literally infringe the '001 Patent. Dkt. #130 at 16-18. Defendants also contend that Mr. Baker's patent prosecution amendments and arguments preclude Mr. Baker's attempt to establish infringement under the doctrine of equivalents. *Id.* at 18-20. Finally, Defendants argue that Mr. Baker cannot rely on an "after-arising" theory to rely on the doctrine of equivalents. *Id.* at 20-21.

In response, Mr. Baker contends the accused products infringe the '001 Patent because a computer located in the same room as an image capturing device satisfies '001 Patent limitations which require that a computer be located at a "second location" that is "remote" from the "first location" in which an image capturing device is located. See Dkt. #129 at 2-3.

The Court agrees with Defendants and addresses each of the parties' arguments in turn.

A. Literal Infringement

Defendants contend their accused products do not literally infringe the '001 Patent because those products do not satisfy '001 Patent claim limitations which require that images captured in one location be transmitted to a "second location remote from the first location." Dkt. #130 at 16-17. According to Defendants, a "first location" and "second location remote from said first location" cannot be in the same room. *Id.* at 16-18. Because Defendants' accused products are within the same room, Defendants argue that their products do not literally infringe Claims 1, 10, and 18 of the '001 Patent. *Id.* Mr. Baker disagrees and argues that a computer located in the same room as the image-capturing device required by the '001 Patent can be considered "remote." Dkt. #133 at 19-23. In support of his argument, Mr. Baker relies on the prior construction of the term "remote location" in an unrelated patent. *Id.*

The Court agrees that Defendants' accused products do not literally infringe Claims 1, 10, and 18 of the '001 Patent. Determining whether literal infringement has occurred is a two- step process. *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1581-82 (Fed. Cir. 1996). Courts must first determine the scope and meaning of a patent by properly construing its claims. *Id.* Once a patent's claims are construed, the Court must determine whether the accused products infringe the asserted claims. *Id.* Construction of Claims 1, 10, and 18, followed by a comparison of the construed claims

with the accused products, support finding that Defendants' accused products do not literally infringe '001 Patent Claims 1, 10, and 18.¹

i. Construction of Claims 1, 10, and 18 of the '001 Patent

The Court construes the term "remote" in Claims 1, 10, and 18 of the '001 Patent to require more than physical separation at the same location. The Court's construction is supported by the plain language of Claims 1, 10, and 18, the '001 Patent specification, and the prosecution history of the '001 Patent.

The limitation language of Claims 1, 10, and 18 indicates the existence of two separate locations. Claim 1 requires "capturing and storing initial visual image signals representative of a particular movement at a first location." Dkt. #131, Ex. 3 at 10. A separate limitation in Claim 1 then requires a computer database "at a second location remote from said first location," where "preferred image signals representative of a particular movement" are stored. *Id.* The separation between the "first" and "second" locations (which is required by four of the six limitations of Claim 1) is underscored by the inclusion of the word "remote," which indicates that

¹ *Because independent claims 1, 10, and 18 are not literally infringed, dependent claims 2-5, 11-15, and 19-20 are likewise not infringed. See Kim v. ConAgra Foods, Inc., 465 F.3d 1312, 1316 n. 1 (Fed. Cir. 2006) (dependent claims not infringed where court found noninfringement of corresponding independent claims).*

the first and second locations are not in the same room.

Claim 10 similarly delineates between the capturing of visual image signals of a particular movement "at a first location," followed by the storage and comparison of the captured visual image signals "at a second location remote from said first location." *Id.* Claim 10 further requires a "means for regenerating further visual image signals of said particular movement," which are "adjusted in accordance with said selected preferred movement" to allow an user to emulate the selected preferred movement "at said first location." *Id.* The separation between the "first" and "second" location is evidenced by the limitation in Claim 10 which indicates that a user can emulate the selected preferred movement "at said first location," while the captured visual image signals are compared at "said second location." This limitation indicates that the "first" and "second" location limitations refer to separate, distinct locations. Consequently, although Mr. Baker now argues that the "first" and "second" locations can be in the same room, the language evidenced by the limitations in Claim 10 indicates otherwise.

Claim 18, like Claims I and 10, also contains a limitation which requires that captured information be transmitted "to a remote location." Dkt. #131, Ex. 3 at II. Like the meaning of "remote" in Claims I and 10, the Coun construes the term "remote" in Claim 18 to require more than mere physical separation at the same location. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) ("Because claim terms

are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.").

Patent '001 's specification further indicates that the term "remote" refers to more than the physical separation of an image capturing device and a computer at the same location. In its "Summary of the Invention" section, the '001 Patent indicates that the computer where visual images of preferred movements are stored "is most preferably located at a remote location so as to be accessible from a number of different locations." Dkt. #131, Ex. 3 at 6. Using "remote" in this section envisions more than just physical separation within the same room, as is evidenced by the distinction between the "remote location" and the "number of different locations" from which the computer database can be reached. The "Detailed Description of the Preferred Embodiments" similarly describes a separation between where a user's movements are captured, and where a computer is located. See *id.* at 7-9. For instance, this part of the specification indicates that "[w]here recording of movements takes place, bio-informational data, may also be transmitted or collected." *Id.* at 7. As an alternative to collecting bio-information data "[w]here recording of movements takes place," the '001 Patent specification indicates that bio-mechanical signals "may also be obtained by various scanning, editing and digital techniques, used within a remote computer data base once the signal has been received by the remote data base..... *Id.* The distinction between the location

where movements are recorded and where bio-mechanical signals are received by the "remote computer data base," further demonstrates that the term "remote" requires more than physical separation at the same location. That "remote" simply indicates physical separation between devices is further belied by the specification's description of the audio-visual signal transceiver required by the '001 Patent. *Id.*

The specification's use of the term "discrete" to describe the separation of units within the same room indicates that "remote" data bases cannot be within the same room as a user. The specification describes the image capturing device as "a unit discrete from the audio-visual signal transceiver and adapted to be connected thereto." *Id.* Alternatively, the image capturing device and audio-visual transceiver "may be one and the same, so that the image capturing device also incorporates a unit for transmission and reception of signals to and from remote data bases." *Id.* That "remote" requires more than physical separation between devices is also supported by a section in the specification which explains that the computer required by the '001 Patent is programmed to accept signals "from remote locations, associated with the audio-visual transceiver." That the locations associated with the audio-visual transceiver are "remote" implies those locations are separate and distinct from the "remote" locations where the computers are located. *Id.* at 8.

Patent prosecution history also confirms Mr. Baker's desire to differentiate his claims from prior

art, which allowed placing an image capturing device and a computer database in the same location, by adding two separate locations. See Dkt. #131, Ex. 1 at 18 and Ex. I I at 2-3, 29-31. Patentees "may limit the meaning of a claim term by making a clear and unmistakable disavowal of scope during prosecution." *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008). When patentees "clearly characterize[e] the invention in a way to try to overcome rejections based on prior art," a disavowal of claim scope occurs. *Id.* Here, Mr. Baker disavowed the interpretation of "remote" he now seeks to use when he amended Claims I and 10 to include the "second location remote to the first location" language. See Dkt. #131, Ex. 1 at 9-12. To support this amendment, Mr. Baker argued that the "basic issue" distinguishing his patent from a prior art reference was "the separation or remoteness of the two basic components" of the '001 Patent. *Id.* at 18. Mr. Baker emphasized that while the images captured by the patent's image capturing device "are formed in one location for instruction such as a studio or an aircraft," the "[t]ransmittance to a separate location for analysis and feedback is critical . *Id.* This distinction between locales was deemed "critical," and Mr. Baker's arguments to support this distinction indicates that the term "remote" to distinguish between the two required locations requires more than just physical separation of the image capturing device and computer required by the '001 Patent.²

² *Rejection of Mr. Baker's CIP Patent also supports the finding*
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Mr. Baker's reliance on a prior construction of the term "remote location" in an unrelated patent does not dissuade the Court from reaching its construction of the term "remote." A term construed a certain way in one patent "need not have the same meaning when used in an entirely separate patent, particularly one involving different technology." *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1318 (Fed. Cir. 2005). This is because, "the manner in which the term is used in the patent may dictate a definition that differs from the definition that would be given to the same term in a different patent with a different specification or prosecution history." *Id.* Here, Mr. Baker cites *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294 (Fed. Cir. 2003), to argue that a "remote" location encompasses a setup where the computer required by the '001 Patent is located in the same room as the required image capturing device. Dkt. #133 at 23.

In *Brookhill*, the Federal Circuit considered a district court's construction of the term "remote location" as it was used in a patent that disclosed systems and methods for performing robotic surgery. 334 F.3d at 1296. The patent at issue included limitations which required the transmission of video signals "to a remote location beyond a range of direct

that "remote" refers to more than physical separation at the same location. The CIP Patent sought to expand the '001 Patent to allow a computer to be located at the same location, or adjacent to, the image capturing device called for in the '001 Patent. Dkt. #131, Ex. 6 at 5, 21 and Ex. 3 at 10-11. The USPTO rejected the CIP Patent due to prior art references.

manual contact." *Id.* Given the surrounding text of the claims in question, the other claims, the written description, and the prosecution history, the Federal Circuit determined that "remote location" did not only mean "a location outside the operating room." *Id.* at 1297, 1300-1302. The Federal Circuit reasoned that a "remote location" could include a location within an operating room because the patent's written description and prosecution history "fail[ed] to express a manifest exclusion or restriction limiting the claim term." *Id.* at 1301.

Here, the Court does not construe the term "remote" to include locations within the same room as the image capturing device required by the '001 Patent. As previously explained, the context in which the term "remote" is used in the '001 Patent, the '001 Patent specification, and the prosecution history all indicate that this term should not be read as broadly as the term was read in *Brookhill*.

ii. Claims 1, 10, and 18 of the '001 Patent Are Not Literally Infringed

Literal infringement exists when each of a patent's claim limitations are found in the accused products. *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1345 (Fed. Cir. 2002). Patentees thus must prove that accused devices contain each limitation of the allegedly infringed claims. E.g., *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). "If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law." *Id.* Consequently,

upon finding the absence of one limitation courts need not address whether any other limitations are absent. See *Fin Control Sys. Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1320 ("Because we find that the accused OAM systems fail to meet the 'lateral' and 'side' limitations of claim 13, we need not consider additional noninfringement arguments made by OAM."). To determine if literal infringement of claims expressed in means-plus-function language is present, "the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claimed function for that structure." *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (emphasis in original).

Defendants' accused products do not literally infringe Claim 1 of the '001 Patent. Here, the accused products, contrary to the limitations required by Claim 1, do not require the capturing of visual images "at a first location," followed by the subsequent storage of those images "at a second location remote from said first location." The Kinect Sensor and the USB camera are in the same room as the computer (in this case the accused game consoles and PCs) that stores, analyzes, and generates subsequent visual images. The accused game consoles and PCs are thus not located "at a second location remote from said first location." By design, the Kinect Sensor and USB camera are physically connected to the accused game consoles and PCs. Defendants' accused products likewise do not literally infringe the claim limitation which requires "transmitting said captured and stored visual image

signals from said first location to said computer at said second location."

Claim 10 of the '001 Patent is also not literally infringed. Here, a Claim 10 limitation requires a "means for storing said captured visual image signals at a second location remote from said first location." The claimed function in this limitation requires storing of captured visual image signals at a second location remote from the first location. Here, Defendants' accused products are within the same room and the storage of signals "at a second location remote from said first location" does not occur. Because identity of function between the accused products and this Claim 10 limitation is lacking, literal infringement cannot be found.

Independent Claim 18 is likewise not literally infringed. Claim 18 requires a "means for transmitting said representative visual and informational data signals to a remote location." The '001 Patent's specification describes the corresponding structure to this recited means as an audio-visual transceiver that "may take the form of a portable signal unit or a personal computer." Dkt. #131, Ex. 3 at 7. The function claimed is the transmitting of the visual and informational data signals "to a remote location." The identical function of this Claim 18 limitation is not found in the accused products because those products are all within the same room as a user, and they do not transmit signals to a "remote" location. Because no identity of function exists between the accused

products and this Claim 18 limitation, literal infringement cannot be found.

In summary, because Defendants' accused products do not contain each limitation of Claims 1, 10, and 18, the Court does not find literal infringement of those claims.

B. Infringement Under the Doctrine of Equivalents

Prosecution history estoppel bars Mr. Baker from relying on the doctrine of equivalents to demonstrate infringement. Under the doctrine of equivalents, a product or process that does not literally infringe a patent claim may nonetheless infringe if the elements of the accused product or process are equivalent to the claimed elements of a patent. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). Plaintiffs alleging infringement must demonstrate that an accused product meets all of a patent claim's limitations. See *id.* at 29 ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole."). However, when a patentee narrows their claims to distinguish them from prior art, prosecution history estoppel may apply. *Biagro v. W. Sales, Inc. v. Grow More Inc.*, 423 F.3d 1296, 1305 (Fed. Cir. 2005). The narrowing of a claim in response to a patent application rejection thus estops a patentee from using the doctrine of equivalents to recapture matter

surrendered between the original and amended claims. *Festo corp. v. Shoketsu Kinzoku 1<000 Kabushiki co., Ltd.*, 344 F.3d 1359, 1366-67 (Fed. Cir. 2003).

Here, Mr. Baker disclaimed the alleged equivalents during prosecution when the "second location remote from the first location" limitation language was added to Claims I and 10. Before Mr. Baker amended his patent application, the USPTO cited the Mann Reference, and other prior art, to reject Mr. Baker's application. Following this rejection, Mr. Baker's patent application was amended and the "second location remote from the first location" language was added to limitations in Claims I and 10. Because the "second location remote from the first location" language was added by Mr. Baker to overcome prior art rejections cited by the USPTO, Mr. Baker cannot now argue that the accused products' performance of the alleged claim steps in a single location is the equivalent of limitations amended to require two, separate locations.

Mr. Baker's arguments to support his amendments also demonstrate the applicability of prosecution history estoppel. To support his patent amendments, Mr. Baker emphasized the need for two separate locations in the '001 Patent. Dkt. #131, Ex.1 at 18-19. This emphasis on two separate locations forecloses Mr. Baker's current attempt to demonstrate infringement under the doctrine of equivalents.

The Court is also not persuaded by Mr. Baker's attempt to rely on prosecution history estoppel's unforeseeability exception to apply the doctrine of equivalents. Dkt. #133 at 23-24. Plaintiffs can rebut the presumption that an amendment disclaims matter surrendered between original and amended claims if they can demonstrate that an equivalent was unforeseeable at the time of their patent application. *Festo Corp. v. Shoketsu Kinzoku Kogvo Kabushiki Co., Ltd.*, 535 U.S. 722, 740-41 (2002)). Here, Mr. Baker contends that he could not have foreseen the possibility that subsequent technologies would evolve to where a personal computer, as opposed to a remote computer, could possess the properties to execute his patent claims. Dkt. #133 at 23-24. The Court is not persuaded by this argument. Prior art, specifically the Mann Patent, disclosed the steps of capturing, storing, comparing, and generating image signals of a preferred movement at a single location. Dkt. #131, Ex. 5 at 4 and Ex. II at 2-3, 29-31. Consequently, Mr. Baker is estopped from arguing that the accused products, which are all in the same room as a user, infringe under the doctrine of equivalents.

C. "After-Arising" Technologies

Finally, Defendants contend that Mr. Baker's reliance on an "after-arising" theory to argue for applying the doctrine of equivalents is misplaced. Dkt. #130 at 20-21. The doctrine of equivalents allows patent owners to cover after-arising technologies that are not foreseeable as available technology when a patent application is filed. See

Siemens Med. Solutions USA, Inc. v. Saint-Gobain Ceramics & Plastics, Inc., 647 F.3d 1373, 1376 (Rader, J., concurring) ("In other words, '[t]he applicant is charged with surrender of foreseeable equivalents known before the amendment, not equivalents known after the amendment.' Thus, the doctrine of equivalents allows patent owners to cover after-arising technology.") (quoting Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki co., Ltd., 493 F.3d 1368, 1380 (Fed. Cir. 2007)). However, if a patent owner fails to claim an equivalent that is foreseeable as available technology, that subject matter enters the public domain. *Id.*

According to Defendants, the claim limitations they rely on to support summary judgment do not specify the kind, nor the speed, of the computer required by the '001 Patent; instead, these claim limitations merely require a computer at a "second location remote from the first location." Dkt. #130 at 20-21. Because the prosecution history estoppel analysis requires a court to address the claim limitations allegedly infringed by an accused product's equivalent limitation, Defendants argue that the Court is limited to considering whether the equivalence asserted by Mr. Baker is an after-arising technology. *Id.* at 21. Mr. Baker disagrees, but merely lists several of Defendants' accused products which allegedly were not developed until after Mr. Baker filed his patent application; Mr. Baker argues these products work in conjunction to infringe on claim limitations found in the '001 Patent. Dkt. #133 at 25-26.

The Court agrees that Defendants' accused products are not after-arising technologies encompassed by the '001 Patent's "remote" location limitations of Claims 1, 10, and 18. Here, Mr. Baker argues that a computer in the same room as an image capturing device can be considered "remote." Dkt. #133 at 19-23. Because this claim limitation does not specify the type of computer used, or the speed of that computer's transmissions, the only relevant question in determining whether an "after-arising" theory allows application of the doctrine of equivalents is whether placing an image capturing device and a computer in the same room is an "after-arising" technology. Given prior art references which allowed for performing similar claims in the same location, the Court finds that the "after-arising" theory does not allow application of the doctrine of equivalents.

V. CONCLUSION

Having reviewed the Defendants' motion for summary judgment, Mr. Baker's response in opposition thereto, and Defendants' reply, along with all supporting declarations, exhibits, and the remainder of the record, the Court GRANTS Defendants' motion for summary judgment.

DATED this 3rd of January, 2017.

The Honorable Richard A. Jones
United States District Judge

APPENDIX C

United States Court of Appeals
for the Federal Circuit

RICHARD J. BAKER,
Plaintiff-Appellant

v.

**MICROSOFT CORPORATION, UBISOFT, INC.,
NINTENDO OF AMERICA, INC.,
ELECTRONICARTS INC, HARMONIX MUSIC
SYSTEMS, INC.,**
Defendants-Appellees

MAJESCO ENTERTAINMENT,
Defendant

2017-2357

Appeal from the United States District Court
for the Western District of Washington in No. 2:16-
cv-00396-RAJ, Judge Richard A. Jones.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before PROST, Chief Judge, NEWMAN, LOURIE,
DYK, MOORE, O'MALLEY, REYNA, WALLACH,
TARANTO, CHEN, and HUGHES, Circuit Judges*.

PER CURIAM.

ORDER

Appellant Richard J. Baker filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT Is ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on
June 15, 2018.

FOR THE COURT

June 8 2018
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

* Circuit Judge Stoll did not participate.