No. 2011-1403

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

01 COMMUNIQUE LABORATORY, INC.,

Plaintiff-Appellant,

v.

LOGMEIN, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Eastern District of Virginia in case no. 10-CV-1007, Senior Judge Claude M. Hilton.

BRIEF FOR DEFENDANT-APPELLEE

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October 7, 2011

CERTIFICATE OF INTEREST

Counsel for Defendant-Appellee LogMeIn, Inc. certifies the following:

1. The full name of every party or amicus represented by me is:

LogMeIn, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

LogMeIn, Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

There is no such corporation.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this Court are:

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STATEMENT OF RELATED CASES

No appeal in this civil action was previously before this or any other court. Counsel for appellant identified *01 Communique Laboratory, Inc. v. Citrix Systems, Inc. and Citrix Online, LLC*, Case No: 1:06-cv-0253 (Lioi, J.), currently pending in the U.S. District Court for the Northern District of Ohio, as a related case under Federal Circuit Rule 47.5.

STATEMENT OF THE ISSUES

1. Did the district court correctly construe the asserted claims to require a single "location facility" "component" that "itself" performs four functions enumerated in the claims and does not merely assist "some other component" to perform those functions, when that is what the claims require and 01 expressly disclaimed any broader interpretation to save its claims during reexamination?

2. Did the district court correctly enter summary judgment of noninfringement, when LogMeIn's accused system indisputably does not have a single "location facility" component that itself performs all of the required location facility functions?

STATEMENT OF THE CASE

This appeal arises from a patent infringement suit commenced by 01 Communique Laboratory, Inc. ("01") against LogMeIn, Inc. ("LogMeIn") in the U.S. District Court for the Eastern District of Virginia. 01 accused LogMeIn of infringing U.S. Patent No. 6,928,479 ("the '479 patent"), titled "System Computer Product and Method for Providing a Private Communication Portal." The accused LogMeIn products were LogMeIn Free, Pro, Ignition, Join.Me, and IT Reach.

The '479 patent claims are directed to providing remote access to a personal computer from a remote computer over the internet via a "locator server computer." The locator server computer includes a software component called a "location facility." All of the asserted '479 patent claims require the location facility to perform four enumerated functions when establishing remote access to a personal computer.

The central issue on appeal is 01's attempt to broaden its claims in this litigation to cover remote access systems which (1) the claims do not cover and (2) 01 repeatedly disclaimed in a reexamination of the '479 patent to save its claims from rejection. Specifically, after the PTO twice rejected all of 01's asserted claims over the prior art, 01 represented to the PTO that the claimed "location facility" does not cover remote access systems in which the four enumerated location facility functions are distributed among different software programs

running on different computers. 01 made this disclaimer in at least three ways during the reexamination. *First*, to overcome prior art, 01 told the PTO that the claimed "location facility"—not "some other component"—must "*itself*" perform the location facility functions recited in the claims. *Second*, 01 distinguished a prior art reference on the ground that one of the four location facility functions was performed on a separate computer from the alleged location facility. *Third*, when the PTO rejected a proposed new claim in which one of the location facility functions was performed on a separate computer, 01 acquiesced to the rejection by canceling the claim. Based on 01's arguments and amendments, the PTO withdrew its rejections of the asserted claims. Thus, during the reexamination, 01 clearly and unambiguously disclaimed the construction of "location facility" that it has advanced in this litigation.

On appeal, and before the district court, 01 attempts to renege on its representations to the PTO and expand its claims by arguing that certain portions of the specification could support a broader construction of "location facility." This attempt is contrary to the evidence and this Court's precedent. *First*, the claims themselves and the prosecution history demonstrate that 01 never successfully claimed a remote access system in which the location facility functions are distributed among different software programs running on different computers. *Second*, 01 is wrong to argue that the specification discloses such a

system. *Third*, with regard to 01's prosecution disclaimers, this Court has repeatedly explained that claim language cannot, like a "nose of wax," be twisted one way to obtain or preserve the claim and another way to prove infringement. *See, e.g., Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995).

01's clear and repeated prosecution disclaimers are alone dispositive of this appeal. It is undisputed that LogMeIn's accused remote access system does *not* have a single component that performs all four of the functions of the claimed location facility. Indeed, during 01's attempt to obtain a preliminary injunction, 01 admitted to the district court that "*it is apparent that in LogMeIn's system the functionality of the locator server computer are [sic] distributed among two or more different devices*." A28239 (emphasis added). While 01 was incorrect in stating that LogMeIn's accused products perform each of the claimed location facility functions, 01 correctly conceded that there is no single component in any LogMeIn server that "itself" performs all of these functions. Accordingly, by 01's own admissions and its unambiguous representations to the PTO, the accused LogMeIn products cannot infringe as a matter of law.

On May 4, 2011, the district court issued its Memorandum Opinion adopting LogMeIn's construction of "location facility" and granting summary judgment of noninfringement. The district court explained that "[t]he LogMeIn system does

not contain any component that itself performs all the four functions required of the location facility under the Court's construction of the term." A2013. Before reaching its decision, the district court accepted multiple rounds of briefing and oral argument on claim construction and summary judgment. The district court's resulting summary judgment opinion correctly applies this Court's claim construction precedent and provides a detailed noninfringement analysis.

Accordingly, this Court should uphold the construction of "location facility" adopted by the district court and should affirm the district court's grant of summary judgment of noninfringement.

STATEMENT OF THE FACTS

A. The Parties

LogMeIn (pronounced "Log Me In") is one of the leading developers and providers of remote access solutions in the world. Since its founding in 2003, LogMeIn has grown to more than 400 employees and has achieved the second largest market share in remote access products. A27529; A27659-27660. Each day, tens of millions of computers are connected to LogMeIn's services, and there are tens of thousands of new downloads of LogMeIn's remote access software. LogMeIn was recently hailed in the *New York Times* for making remote access "quick, easy and cheap to use by shielding people from complex computer configuration work." A27426.

01 is a Canadian company that claims to sell a remote access product, called "I'm InTouch," that is purportedly covered by the '479 patent. A27152; A7004. However, 01 has admitted that its product "was not effective in capturing market share." A27320. Indeed, 01 has not made a profit in any year since it introduced its remote access product, including the years before the release of LogMeIn's accused products. A27153 (footnote 3). Having failed in the market, 01 has chosen to seek licensing fees through litigation. A27178; A27335.

01 learned of LogMeIn and its remote access products in 2004, but waited for more than five years to bring this infringement suit. A27990-27991. During this five-year delay, 01 never notified LogMeIn of the '479 patent and never suggested that LogMeIn infringed. A27159; 27528.

B. Background On Remote Access Technology

Remote access technology enables a user of a remote computer (such as a traveling laptop computer) to access and control a host computer (such as a home desktop computer) over a network, such as the Internet. A27183. Remote access technologies were developed and commercialized as early as 1969 (31 years before the '479 patent application was filed). *Id.* Since that time, numerous remote access systems have been developed to provide a variety of remote access capabilities. *See, e.g.*, A28144-28146. Today, all modern operating systems, such

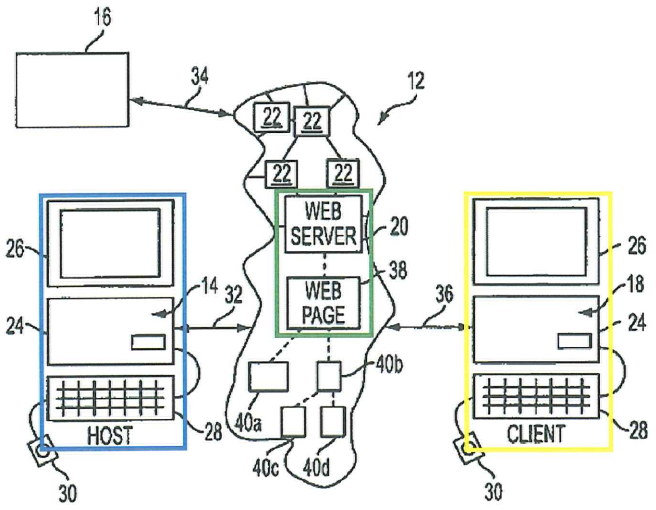
as Microsoft Windows, include some type of remote access solution by default. A9005.

One example of a prior art remote access system was described in U.S. Patent No. 7,130,888 ("the '888 Patent"), titled "Method and Apparatus for Controlling a Computer Over a TCP/IP Protocol Network." A27239. The '888 patent is directed to providing a "client" computer with remote access to a "host" computer through a website on an intermediary server computer. A27254. The '888 patent summarizes the invention as follows:

> The present invention permits virtually the entire functionality of a computer system to be made accessible to a wide area network such as the Internet. More particularly, the present invention permits a computer system to be run as a "virtual machine" through a web page provided at a web site on the World Wide Web (WWW).

Id.

As illustrated below in Figure 1 of the '888 Patent, the disclosed remote access system includes a "host" computer 14, a web server 20 that hosts a web page 38 for remotely accessing the host computer, and a "client" computer 18—all of which are connected to the Internet 12. A27254-27255.

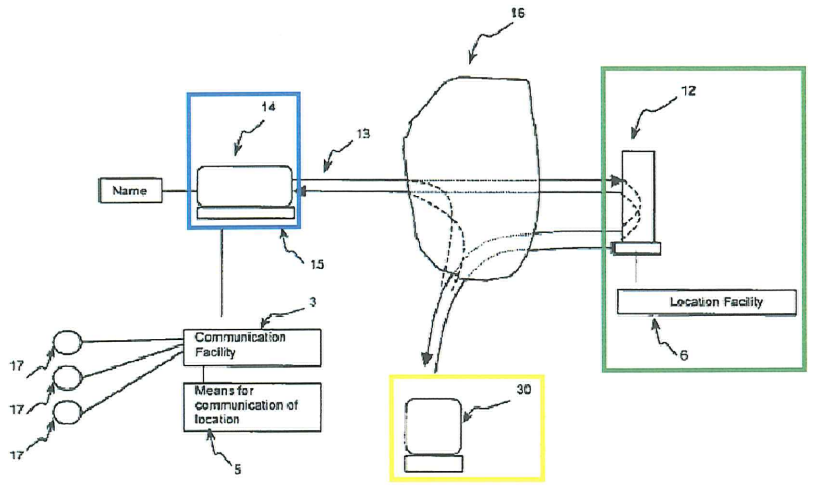


A27242. When a client computer 18 wishes to remotely access the host computer 14, the client navigates to the web page 38 and clicks a link to remotely access the host 14. A27258 (col. 11:33-46); A27244 (Fig. 3). The web server then, among other things, locates the host computer on the Internet and creates a communication session between the client and the host. A27254-27255 (col. 3:22-38; col. 4:66-5:4).

C. The '479 Patent

The '479 patent, filed in 2000 (four years after the '888 patent), is directed to a system, method, or program for providing remote access to a "personal computer" from a "remote computer" through an "intermediary" "locator server computer." A4001 (Abstract); A4014-4015 ('479 Patent, col. 1:7-13). As illustrated below in Figure 1 of the '479 Patent, the disclosed remote access system includes a personal computer 14, a locator server computer 12, which includes a

"Location Facility" 6, and a remote computer 30—all of which are connected to the Internet 16.



A4002 ('479 Patent, Fig. 1 (blue, green, and yellow boxes added)).

In all of the asserted claims, the locator server computer must "includ[e] a location facility" for performing four enumerated functions. Claim 1 is representative:

> 1. A system for providing access to a personal computer having a location on the Internet defined by a dynamic IP address from a remote computer, the system comprising:
>
> (a) ***a personal computer*** linked to the Internet, its location on the Internet being defined by either (i) a dynamic public IP address (publicly addressable), or (ii) a dynamic LAN IP address (publicly un-addressable), the personal computer being further linked to a data communication facility, the data communication facility being adapted to create and send a communication that includes a then current dynamic public IP address (publicly addressable) or dynamic LAN IP address (publicly un-addressable) of the personal computer;
>
> (b) ***a locator server computer*** linked to the Internet, its location on the Internet being defined by a static IP address, and ***including a location facility for locating the personal computer***; and

(c) ***a remote computer*** linked to the Internet, the remote computer including a communication facility, the communication facility being operable to create a request for communication with the personal computer, and send the request for communication to the locator server computer;

wherein the data communication facility includes data corresponding to the static IP address of the locator server computer, thereby enabling the data communication facility to create and send on an intermittent basis one or more communications to the locator server computer that include the then current dynamic public IP address or dynamic LAN IP address of the personal computer; and

wherein the locator server computer is operable to act as an intermediary between the personal computer and the remote computer by creating one or more communication sessions there between, said **[1]** one or more communication sessions being created by ***the location facility***, in response to **[2]** receipt of the request for communication with the personal computer from the remote computer, **[3]** by determining the then current location of the personal computer and **[4]** creating a communication channel between the remote computer and the personal computer, the location facility being operable to create such communication channel whether the personal computer is linked to the Internet directly (with a publicly addressable) dynamic IP address or indirectly via an Internet gateway/proxy (with a publicly un-addressable dynamic LAN IP address).

A4018-4019 (claim 1 (emphasis and bracketed numerals added)).

Thus, all the asserted claims require that the location facility must perform the following four functions:

1. "creat[ing] one or more communication sessions" "between the personal computer and the remote computer";

2. "recei[ving] the request for communication with the personal computer from the remote computer";

3. "locating the personal computer" and "determining the then current location of the personal computer"; and

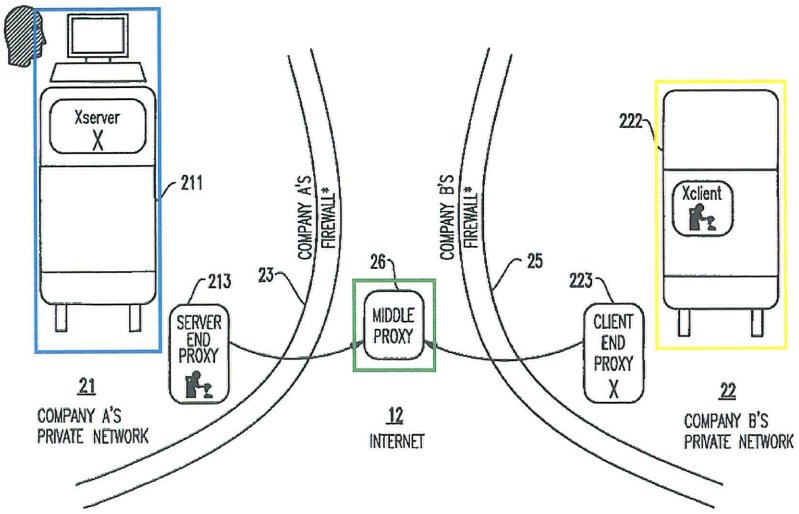
4. "creating a communication channel between the remote computer and the personal computer."

A4018-4019 ('479 Patent, claim 1); *see also* A4019-4020 ('479 Patent, independent claims 20, 21, 24, and 26).

D. The Reexamination Of The '479 Patent

In December 2007, a third party, Citrix Systems, Inc. ("Citrix"), which is also being sued for infringement by 01, requested an *inter partes* reexamination of the '479 patent. A27671. The PTO granted the reexamination request and rejected all of the asserted claims as unpatentable in light of the prior art. A27672-27673. Altogether, the PTO's rejections cited 12 different prior art references. *Id.*

For example, the PTO rejected claim 1 (among other claims) as anticipated by U.S. Patent No. 6,104,716 to Joseph M. Crichton et al. ("Crichton"). The remote access system in Crichton includes an Xserver (i.e., "personal computer"), Xclient (i.e., "remote computer"), and three components in between, called the Server End Proxy, the Middle Proxy, and the Client End Proxy:



Crichton, Fig. 4 (blue, green, and yellow boxes added).[1] In rejecting the asserted claims over Crichton, the PTO found that the middle proxy, itself, performed all the functions of the claimed location facility. *See* A18006.

01 responded to the PTO's rejections with arguments attempting to distinguish the prior art references and an amendment that added 54 proposed new claims. A27673. Among 01's proposed claims was the following proposed new claim that depended on claim 1 (among others):

> 49. (New) The system of claim 48, wherein the locator server computer is comprised of at least a first and second computer and wherein the *one or more communication sessions between the personal computer and the remote computer are facilitated through said second computer* comprising the locator server computer and wherein said *second computer does not also perform the operation of determining the then current location of the personal computer* in

[1] LogMeIn and 01 discussed the '479 patent reexamination proceedings regarding the Crichton reference before the district court (A21010-21011; A28283-28284), but the patent itself is not part of the record. For the Court's convenience, LogMeIn has included Crichton's Figure 4 here to illustrate the components of the Crichton system that were discussed before the district court.

response to the receipt of the request for communication with the personal computer.

A28119 (emphasis added). 01 explained that its new claim 49 was proposed to "clarify," "for purposes of the co-pending litigation [with Citrix]," that the claimed locator server computer can be a distributed assortment of different servers and facilities. A28109-28110. In particular, 01 explained that proposed new claim 49 was directed to a locator server computer in which one or more computers determine the location of the personal computer "while *a separate computer* performs the function of facilitating the one or more communication sessions between the personal computer and the remote computer." *Id.* (emphasis added).

Despite 01's arguments that the asserted claims were valid over the prior art, in its August 2009 Action Closing Prosecution ("August 2009 ACP"), the PTO maintained its rejections of all the asserted claims. A27674. The PTO's August 2009 ACP also rejected all of 01's proposed new claims, including proposed new claim 49 (quoted above). *Id.* In particular, the PTO rejected claim 49, among other proposed new claims, as failing to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1. A28151. The PTO explained that claim 49 "contain[ed] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention." *Id.*

The PTO's August 2009 ACP left 01 with one final opportunity to amend the claims or submit new arguments before all of the asserted claims were deemed unpatentable. *See* 37 C.F.R. § 1.951. In this last opportunity, 01 submitted a September 2009 Amendment that included new remarks in support of the originally-issued claims and attached a sworn declaration by an expert witness, Dr. Gregory R. Ganger. A18000-18016; A28247; A28250-28251; A28255-28256; A28269-28270. Through Dr. Ganger's declaration, 01 stated that a person of ordinary skill in the art would understand that the '479 patent claims, as issued, do not cover a remote access system in which more than one component performs the functions of the claimed location facility:

- "[O]ne of ordinary skill in the art would understand it [the claim language] to require that the location facility, *itself,* creates the communication channel."
- "One of ordinary skill in the art would not view this language … to be satisfied by an alleged location facility that is simply *used by some other component* that creates the communication channel."
- "One of ordinary skill in the art would not view the 'create' requirements of the '479 Patent claims to be satisfied if the location facility is only 'used' by *some other component* that itself creates the communication channel …."

- "One of ordinary skill in the art would also not view these 'create' requirements to be satisfied if the location facility only 'enables' or 'facilitates' *some other component* that creates the communication channel …."
- "Assisting *some other component* that creates the communication channel *is not the same* as creating the communication channel – the '479 Patent claims require the location facility to do the latter."

A18002-18003 (emphasis added).

Dr. Ganger and 01 also distinguished the prior art Crichton reference on the ground that the "middle proxy (i.e., location facility)" did not meet the requirement of "determining the then current location of the personal computer." *See* A18006-18007. 01 argued that the Middle Proxy could not be the claimed location facility because "some other component"—i.e., the Server End Proxy—"determine[s] the location of the appropriate personal computer when it needs to deliver communications to it." *Id.* Through these arguments, Dr. Ganger and 01 clearly and unambiguously represented that the location facility functions cannot be performed by more than one software component dispersed among separate computers. *Id.*

In addition, 01's September 2009 Amendment canceled all of its proposed new claims 47-100 (including claim 49 quoted above, which purported to claim a

system where the location facility functions were performed by separate computers). A28247; A28269-28270. 01 conceded that its cancellation of these claims rendered the issues raised by their rejection "moot." A28269.

Based on 01's September 2009 amendments and submissions, the PTO examiner issued a Right of Appeal Notice ("RAN") withdrawing the rejections of all of the asserted claims. A27666-27698. The examiner explained that he was confirming the claims based on 01's representations that the asserted claims were limited to a remote access system in which a single location facility component, itself, performs the location facility functions. A27696. The examiner stated that the asserted claims "are deemed patentable over the prior art of record as the prior art fails to teach or suggest that the location facility determines the then current location of the personal computer *and* creates a communication channel between the remote computer and the personal computer." *Id.* (emphasis added).

After the PTO issued its RAN, Citrix filed a notice of appeal to the Board of Patent Appeals and Interferences ("Board"). A28313. That appeal remains pending with the Board.

E. LogMeIn's Accused Products

LogMeIn's remote access products run on a complex architecture that is designed to allow tens of millions of people to remotely access their computers.

The following diagram from a publicly available LogMeIn "Security White Paper" illustrates—at a very simplified level—the LogMeIn system:

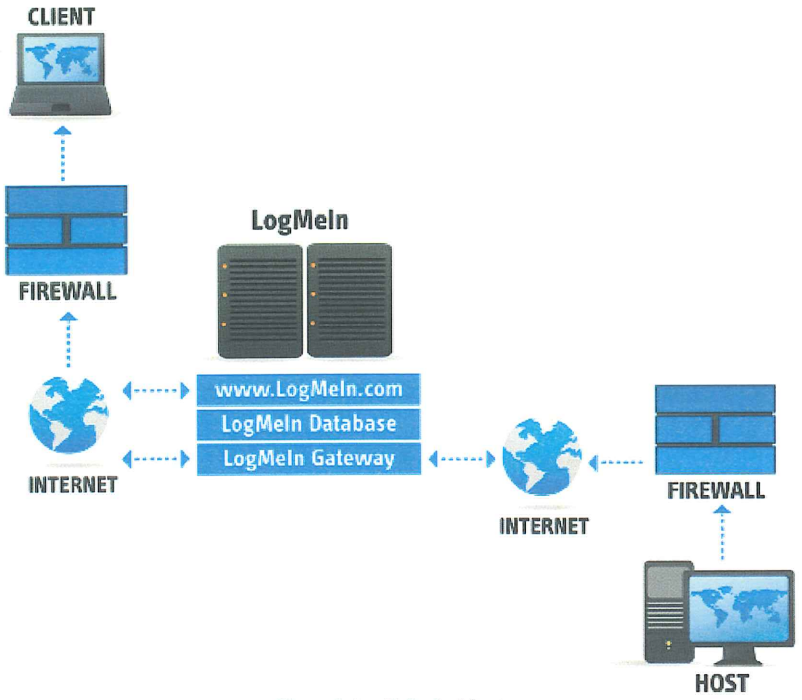


Figure 1. LogMeIn Architecture

As shown in the diagram above, LogMeIn's remote access architecture uses three separate and distinct types of servers:

www.LogMeIn.com	LogMeIn Database	LogMeIn Gateway
(1) LogMeIn Web Server	(2) LogMeIn Database Server	(3) LogMeIn Gateway Server

There are many critical differences between these types of servers. ***First***, the LogMeIn Web Servers, Gateway Servers, and Database Servers perform separate and distinct functions. The LogMeIn Web Servers authenticate and provide a web page interface (*i.e.*, www.LogMeIn.com) to remote users. A28208. The LogMeIn Database Servers execute logic for identifying and managing the

hosts and clients involved in the remote access services provided by LogMeIn. *Id.* The LogMeIn Gateway Servers maintain static connections to LogMeIn hosts and forward traffic between the host and the client. *Id.*

Second, the LogMeIn Web Servers, Gateway Servers, and Database Servers are separate physical machines that are located in different sites across the United States and in England. A28207-A28208. All told, LogMeIn's remote access service uses roughly 80 Web Servers, 30 Database Servers, and 90 Gateway Servers. *Id.* These servers are housed in four separate "data centers" in Virginia, Illinois, California, and England. *Id.*

Third, the LogMeIn Web Servers, Gateway Servers, and Database Servers each have different IP addresses. The Database Servers do not have a location on the Internet at all, as their IP addresses are private and non-routable, and they cannot be contacted directly. *Id.*

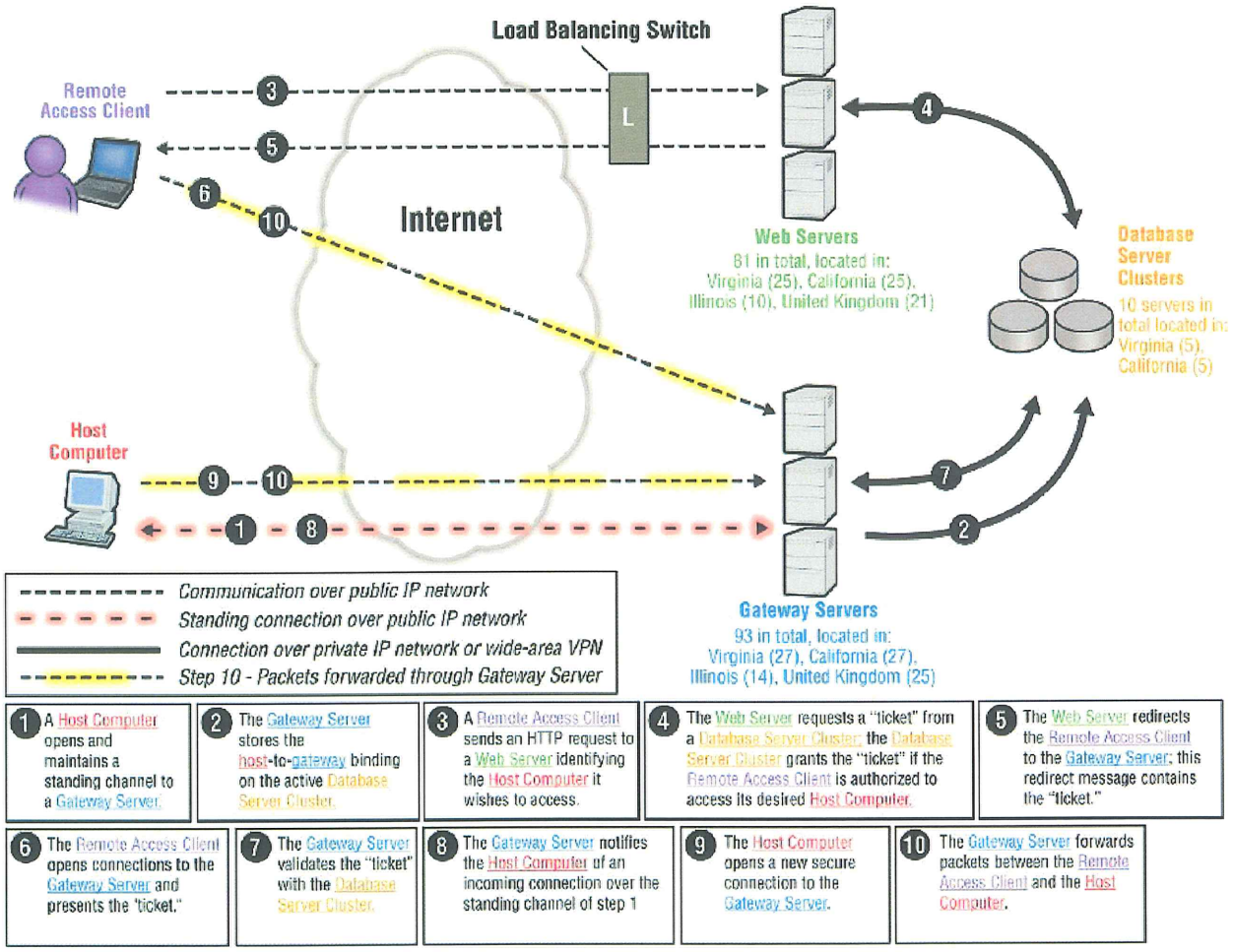
Fourth, the LogMeIn Web Servers, Gateway Servers, and Database Servers run separate and different software. A28207-28208. The Gateway Server software is a wholly proprietary application written in the C++ language. *Id.* The Database Server software is built using a commercial database platform using T/SQL. *Id.* The Web Server software uses primarily JavaScript and C# in Active Server Pages. *Id.*

Moreover, 01 has conceded to the district court that "*it is apparent that in LogMeIn's system the functionality of the locator server computer are [sic] distributed among two or more different devices.*" A28239 (emphasis added). Likewise, 01's expert witness, Dr. Grimshaw, admitted that the LogMeIn Web Servers, Gateway Servers, and Database Servers are "*three components*," not one. A28219-28220 (emphasis added). Dr. Grimshaw and 01's other expert witness, Dr. Jack Davidson, also admitted that no single LogMeIn server "itself" performs all the location facility functions required by the '479 patent. A28215; A28219-28225.

The use of separate and distinct types of server components is what allows LogMeIn's remote access system to support millions of users worldwide. A28207. A single remote access session using LogMeIn's system may, and often does, utilize servers from multiple, geographically distant "data center" sites. For example, a user may contact a Web Server in London, which will contact a Database Server in Ashburn, Virginia, and then may be directed to a Gateway Server in Chicago. In addition, two of LogMeIn's four data centers—those located in England and Illinois—are "satellite" data centers, meaning that they contain only Web Servers and Gateway Servers and do not contain Database Servers. Therefore, by necessity, the England and Illinois "satellite" data centers must

utilize a Database Server in either Virginia or California to perform remote access. A28207.

The following diagram illustrates and describes the series of steps taken by the various different servers in the LogMeIn system when providing remote access from a client computer to a host computer.



A26005.

01 has never disputed LogMeIn's description of the structure and operation of LogMeIn's accused products or the international multi-server system on which they are based. 01 Br. 32-33.

F. The District Court Proceedings

On January 23, 2011, LogMeIn moved for claim construction and summary judgment of noninfringement. LogMeIn requested that the district court construe "location facility" as a single component that itself performs all the location facility functions enumerated in the asserted claims. LogMeIn's request for summary judgment of noninfringement was based on the undisputed evidence that there is no component in LogMeIn's remote access system that performs all the required location facility functions.

In opposing LogMeIn's motion for summary judgment, 01 argued for two alternative constructions of location facility. First, 01 argued for the construction of "location facility" that it previously proposed during a separate litigation with Citrix: "location facility is simply 'computer software associated with the locator server.'" A15027. Alternatively, 01 argued that "location facility" should be construed as "computer software associated with the locator server, which may comprise one or more computers." *Id.*

01's only response to the evidence of noninfringement under LogMeIn's proposed construction was to argue that "LogMeIn's proposed claim construction

is ambiguous as to the meaning of at least the terms 'component' and 'itself.'" A15013. In particular, 01 argued that the term "*component*" could mean "*pieces of software*" and that the phrase "location facility, *itself*" could mean "location facility, *including the pieces of software distributed over the locator server computers*." A15028 (emphasis added).

Following this initial round of briefing, LogMeIn filed a reply brief, and 01 filed a sur-reply brief. A1015.

On February 25, 2011, the district court held a hearing on LogMeIn's motion for claim construction and summary judgment and took the matter under advisement. A1015. After the hearing, LogMeIn submitted a supplemental brief in support of its construction of "location facility." A1018-1019. The brief addressed 01's acquiescence to the PTO's rejection of 01's proposed claim 49 during the reexamination. A28080-28084.

On March 25, 2011, the district court ordered the parties to submit additional briefing regarding the structure and operation of LogMeIn's accused remote access system. A1019. The parties submitted their briefing five days later. A1020. LogMeIn's brief provided a detailed description of the LogMeIn remote access system, as the district court had requested. A26001-26005. 01's brief, by contrast, continued to try to renege on 01's representations to the PTO. In particular, 01 argued "*there is no difference* between one server computer performing several

operations or many server computers *participating with each other* to perform the same operations." A22008 (emphasis added). 01's arguments were exactly the opposite of its prior representations to the PTO that "*[a]ssisting some other component* that creates the communication channel is *not the same* as creating the communication channel." A18002-18003.

On April 1, 2011, the district court held a final hearing on LogMeIn's summary judgment motion, giving 01 a final opportunity to oppose the motion. A1020. After hearing the arguments, the district court issued an oral order granting summary judgment in favor of LogMeIn and stated that a written summary judgment order would be forthcoming. *Id.*

On May 4, 2011, the district court issued its written order granting LogMeIn's motion for summary judgment of noninfringement and dismissing the case. A1020. The order was accompanied by an 18-page opinion addressing the parties' arguments on claim construction and noninfringement. A2001-2018. The district court held that the claimed "location facility" is a single "component" that "itself" performs all four of the location facility functions enumerated in the asserted claims. A2008. The district court explained that "[t]his construction is consistent with the claim language, the specification, and the prosecution history." A2008-2010. The district court also observed that this construction "is exactly and

narrowly what 01 told the PTO the location facility was, in an effort to avoid rejection based on the prior art." A2009.

Applying its construction of "location facility" the district court held that "LogMeIn cannot infringe the '479 patent as a matter of law." A2017. The district court explained that "01 admitted that LogMeIn's products function in precisely the manner that 01 told the PTO the '479 patent does not cover—that is, by distributing the functions of the 'location facility' among different devices." A2012-2013. The district court also explained the undisputed evidence regarding the structure and operation of LogMeIn's accused remote access system. A2013-2016. The district court concluded that "[b]ased on the undisputed evidence and 01's own admission in its Motion for Preliminary Injunction, nothing in LogMeIn's accused products is a location facility as required by all of 01's asserted claims." A2016. In addition, the district court held that 01 had waived any doctrine of equivalents argument and "is estopped from doing so by its arguments to the PTO in re-examination." *Id.*

SUMMARY OF THE ARGUMENT

1. The district court correctly construed the "location facility" requirement of the '479 patent claims as a single "component" that must "itself" perform all four of the location facility functions in the asserted claims. A2008. This construction of "location facility" is what 01 claimed and described in the

'479 patent, and it is the construction that 01 used when arguing to save the asserted claims from being rejected during the reexamination. In particular, the '479 patent does not claim or describe a remote access system in which the four location facility functions are distributed among different software programs running on different computers (i.e., computers with different IP addresses).

During the reexamination, 01 also repeatedly *disclaimed* a construction of location facility that would include multiple components distributed among different computers at different locations on the Internet. *First*, 01 made clear that the "location facility" is one "component" when it told the PTO that the claimed "location facility" "*itself*"—not "some *other component*"—must perform the location facility functions recited in the claims." *Second*, 01 distinguished the prior art Crichton reference on the ground that different location facility functions were performed by different software components on separate devices (i.e., the Middle Proxy and the Server End Proxy). *Third*, when the PTO rejected 01's proposed new claim 49, in which one of the location facility functions *was* performed on a separate computer, 01 acquiesced to the rejection by canceling the claim. Based on 01's arguments and amendments, the PTO withdrew its rejections. Thus, 01 clearly and unambiguously disclaimed the construction of "location facility" that it has advanced in this litigation.

01's claim construction arguments before the district court and on appeal seek to renege on its disclaimers to the PTO during reexamination and expand the scope of what it claimed and described in the '479 patent. 01 cannot now take back its disclaimers by arguing that its use of the phrase "some other component" was limited to "merely" "the personal computer or the remote computer." 01. Br. 24. 01 made no such qualification during the reexamination proceedings and, in fact, this qualification is directly contrary to 01's other arguments and amendments. In addition, 01 cannot rely on the disclosures in the '479 patent (which do not support its construction in any event), or on declarations submitted by its experts in this litigation, to take back its clear and unequivocal disclaimers.

Accordingly, this Court should affirm the district court's construction of "location facility."

2. The district court correctly held that, under the proper construction of "location facility," "LogMeIn cannot infringe the '479 patent as a matter of law." A2017. During the district court proceedings, 01 admitted that LogMeIn's products function in the manner that 01 told the PTO the '479 patent does not cover—that is, by distributing the functions of the "location facility" among different devices. A2012-2013. It is therefore undisputed that LogMeIn's accused remote access system does *not* have a single component that performs all four of

the functions of the claimed location facility, as required by all of the asserted claims.

01's infringement arguments on appeal simply ignore the district court's construction of "location facility." 01 does not even attempt to argue that a single component in LogMeIn's accused system itself performs all of the location facility functions. Instead, 01 seeks to render the district court's use of the terms "component" and "itself" meaningless—arguing that *different* software programs running on *different* computers with *different* IP addresses on *different* continents are "properly viewed" as a single "component." 01 Br. 32.

ARGUMENT

I. STANDARD OF REVIEW

Claim construction is a question of law that is reviewed *de novo*. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55 (Fed. Cir. 1998) (en banc).

This Court reviews issues not unique to patent law according to the law of the regional circuit where the district court sits—here, the Fourth Circuit. *MicroStrategy, Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1349 (Fed. Cir. 2005). The Fourth Circuit reviews a district court's ruling on summary judgment *de novo*. *Id.* (citing *Gallagher v. Reliance Standard Life Ins. Co.*, 305 F.3d 264, 268 (4th Cir. 2002)). "A moving party is entitled to summary judgment if the evidence shows that no genuine issue of material fact exists and the moving party

is entitled to judgment as a matter of law." *National City Bank of Indiana v. Turnbaugh*, 463 F.3d 325, 329 (4th Cir. 2006) (citing Fed. R. Civ. P. 56).

II. "LOCATION FACILITY" MUST BE CONSTRUED CONSISTENT WITH THE CLAIM LANGUAGE, SPECIFICATION, AND PROSECUTION HISTORY

Claim terms are generally given their "ordinary and customary meaning," defined as "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). Determining the ordinary and customary meaning of claim language requires that the Court look to the "intrinsic" evidence—that is, the claim language itself, the specification, and the prosecution history. *Id.* at 1314-17. In addition, extrinsic evidence, such as expert testimony, can be useful in construing claim terms. *Id.* at 1318. However, "conclusory, unsupported assertions by experts as to the definition of a claim term are not useful," particularly when such assertions are contrary to the intrinsic evidence. *Id.*

The specification is often the best guide to understanding claim terms. *Id.* at 1315. However, the prosecution history is also important because it shows how the PTO and the inventor understood the patent, and whether the inventor has disclaimed certain claim scope to obtain the patent. *Id.* at 1317. The prosecution history consists of "the complete record of the proceedings before the PTO," including the original prosecution and any subsequent PTO proceedings, such as a reexamination. *Id.*; *see also, e.g., American Piledriving Equip., Inc. v. Geoquip,*

Inc., 637 F.3d 1324, 1336 (Fed. Cir. 2011) (holding that patentee disclaimed claim scope on reexamination by arguing that certain claims should be allowed over the prior art because the claimed "integral" components were comprised of "one piece"); *Proctor & Gamble Co. v. Kraft Foods Global, Inc.*, 549 F.3d 842, 848 (Fed. Cir. 2008) (The district court can "monitor the [reexamination] proceedings...to ascertain whether [the court's] construction of any of the claims has been impacted."); *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1362 (Fed. Cir. 2007) (holding that argument to PTO on reexamination constituted disavowal of claim scope even though "no amendments were made").

Construing claims based upon the intrinsic evidence ensures that a patent claim cannot, like a "nose of wax," be twisted one way to obtain or preserve the claim and another way to prove infringement. *Southwall Techs.*, 54 F.3d at 1578.

III. THE DISTRICT COURT CORRECTLY CONSTRUED "LOCATION FACILITY"

As discussed above, the district court construed the term "location facility" as:

> a component of a locator server computer that *itself*: 1) creates communication sessions between a remote computer and a personal computer; 2) receives a request for communication with the personal computer from the remote computer; 3) locates the personal computer (and "determines the then [current] location of the personal computer"); *and* 4) creates a communication channel between a remote computer and the personal computer.

A2008 (emphasis added). This construction is supported by the claim language itself, the specification, and the prosecution history.

A. The District Court's Construction Of "Location Facility" Is Supported By The Claim Language

The district court's construction of "location facility" is supported by the claim language. The claims of the '479 patent require that the location facility be a component that is "included" in "a locator server computer linked to the internet, its location on the internet being defined by a static IP address." A4018-4019 ('479 Patent, col. 10:51-54 (emphasis added)). The claims themselves also specify that the location facility must perform multiple functions:

1. "creat[ing] one or more communication sessions" "between the remote computer and the personal computer";
2. "recei[ving] the request for communication with the personal computer from the remote computer";
3. "locating the personal computer" (and "determining the then current location of the personal computer"); and
4. "creating a communication channel between the remote computer and the personal computer."

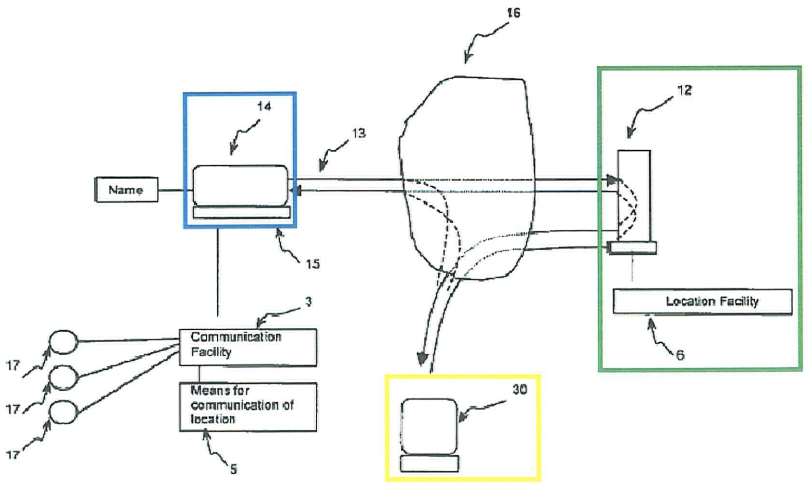
A4018-4019 ('479 Patent, col. 10:51-54, 11:1-15). Accordingly, the district court's construction is correct in explaining that each of these functions must be performed by the claimed location facility itself. Indeed, 01 admits that these limitations "are explicitly set out" in the claim. 01 Br. 29.

There is not a single claim in the '479 patent where the required functions of the location facility are distributed among different locator server computers (i.e., among computers with different IP addresses). Rather, all the asserted claims require that "a locator server computer" must include "a location facility" that performs all four of the enumerated location facility functions. A4018 ('479 patent, col. 10:51-54). Although this Court has held that the word "a" in claims generally means "one or more," this general rule does not apply when the claims, specification, or prosecution history "shows that the term was used in its singular sense." *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1359 (Fed Cir. 2005). Here, claim 1 demonstrates that claimed location facility must be a single component of a single locator server computer with "*its* location on the Internet being defined by a static IP address." A4018 ('479 patent, col. 10:51-53). The singular status of the locator server computer and its location facility is further confirmed by the requirement that the claimed data communication facility include "data corresponding to *the* static IP address of *the* locator server computer" and "send ... communications to *the* locator server computer." *Id.* ('479 patent, col. 10:61-67). In short, because "its" and "the" are singular terms, the claimed "location facility" must be a software component that is included within a single locator server computer.

Moreover, even if the asserted claims were read (incorrectly) to recite "one or more" locator server computers "including" location facilities, the claims still would require *at least one* locator server computer including *at least one* location facility that performs *all* four of the location facility functions. *See SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 886 (Fed. Cir. 2004) ("one or more" means "at least one of"). Nothing in the claims suggests that using the term "a" allows "a location facility" to be *divided and distributed* among different facilities on different server computers, such that no one facility performs all the required "location facility" functions.

B. The District Court's Construction Of "Location Facility" Is Supported By The Specification

The district court's construction is also supported by the specification. For example, Figures 1-3 of the patent each show the location facility 6 as a single component of a single locator server computer 12:



A4002 ('479 Patent, Fig. 1 (blue, green, and yellow boxes added)). The specification also explains that the locator server computer 12 "is provided with a server computer program" that includes a "Location Facility 6 ... for providing remote access to said Private Server 14 [i.e., the "personal computer" of the asserted claims]." A4016 ('479 Patent, col. 5:45-53). Thus, the specification describes the claimed location facility as a single computer program that itself performs all of the location facility functions enumerated in the claims.

Contrary to 01's arguments (01 Br. 22-23), the specification does not describe any embodiment in which the location facility is comprised of multiple different computer programs distributed across multiple different server computers. To the contrary, the written description *criticizes* prior art "multi-program solutions" (i.e., more-than-one-computer-program solutions) for remote access on the grounds that multi-program solutions are "*cumbersome*" and "*overly complex.*" A4014 ('479 Patent, col. 1:22-29 (emphasis added)). The written description also distinguishes the claimed invention from prior art "single program" solutions that do not provide "full remote access,"[2]—i.e., single programs that do not provide all the functionality of the claimed location facility.

[2] The patent defines "full remote access" as "the receipt of messages at any location on any type of communication device, with remote access to functions of the message management system." A4014 ('479 Patent, col. 1:41-46).

01 relies on three statements in the specification as allegedly contrary to the district court's construction, but they are not. *See* 01 Br. 22-23.

First, 01 relies on the statement that "server computer 12 may comprise one or more computers, as is well known." A4016 ('479 Patent, col. 5:24-25). This statement says nothing about the meaning of "location facility." In particular, it does not describe a location facility that is comprised of multiple different computer programs distributed across multiple different server computers.

Second, 01 relies on the discussion of a "communication portal" in the Background of the Invention. The background discussion of "communication portal" states:

> Also, by "portal" what is meant is generally understood as a means for facilitating communications from point A to point B. More than one interconnected computer or process may co-operate to provide a single portal. For example, a first computer or process comprising the "portal" may provide means for locating B *at least once*. Thereafter, communication between A and B may be *facilitated* through a second computer or process independent of the first computer or process.

A4014 ('479 Patent, col. 2:39-46 (emphasis added)). Nothing in this "portal" example provides a definition of the *claimed* "locator server computer." Nor does it provide any discussion of the claimed "location facility." Nor does it discuss *any* of the specific functions required to be performed by the claimed location facility, namely: (1) "creating one ore more communication sessions" "between the personal computer and the remote computer," (2) "recei[ving] a request for

communication with the personal computer from the remote computer," (3) "determining the then current location of the personal computer," or (4) "creating a communication channel between the remote computer and the personal computer." A4018-4019 ('479 Patent, claim 1)

Rather, the portal example discusses distributing on different computers two functions—(1) "locating [a computer] at least once" and (2) "facilitat[ing] "communication" between computers—that are *not the claimed "location facility" functions*. The prosecution history makes this clear. 01 repeatedly argued that "locating [a computer] at least once" is not the same as "determining the then current location" of the computer. For example, 01 distinguished a prior art reference, called "NAT P2P," on the basis that it determined the location of the personal computer once, but had no mechanism for determining the "current" location of the personal computer:

> In the systems of the NAT P2P references, the addressed/well-known server (the alleged locator server) remembers the first IP address [i.e., location] it receives for each host/peer (including the alleged personal computer), *rather than any more "current" location information*...

A18015 (¶ 44 (emphasis added)). 01 also distinguished the Crichton reference on the same basis, arguing that Crichton does not teach "allowing the middle proxy (the alleged location facility) to 'determine the <u>then current</u> location of the personal computer.'" A18007-18008 (¶ 20 (emphasis in original)).

Also, 01 repeatedly argued during the reexamination that "facilitating" communication (one of the functions of the "portal" in the Background) is not the same thing as "creating" a communication channel (one of the functions of the "location facility" in the claims). *See, e.g.*, A18003 ("One of ordinary skill in the art would also not view these '*create*' requirements to be satisfied if the location facility only 'enables' or '*facilitates*' some other component that creates the communication channel." (emphasis added)).

Accordingly, nothing in the Background of the Invention's "portal" example is contrary to the district court's construction of "location facility."

Third, 01 relies on the specification's statement that "a number of computer program facilities ... described in the invention" can be combined or subdivided:

> In particular, a number of computer program facilities are described in this invention as separate facilities for the sake of describing the invention. However, it should be understood that such facilities can be combined with other facilities comprising the present invention, or such facilities can be sub-divided into separate facilities.

A4018 ('479 Patent, col. 10:11-16). This statement does not specify *which* of the numerous different facilities mentioned in the patent can be combined or subdivided. Indeed, there are at least *thirteen* different facilities discussed in the patent. A number of these facilities are related—such as a voice message facility, fax facility, and email facility—and several claims identify certain facilities as sub-components of other facilities. *See, e.g.*, A4029 ('479 patent, claim 13 ("A system

as claimed in claim 12, wherein said private messaging and contact facility includes a unified messaging facility and a contact information facility, each being linked to the database.")). By contrast, the specification never describes, and not a single claim involves, a location facility that is combined with or divided into separate facilities. Nor does the specification ever describe the "location facility" being combined or sub-divided into separate facilities. Accordingly, the district court correctly rejected 01's attempt to rely on this statement for its construction of "location facility."

Finally, whatever the specification *describes*, no system with a divided or distributed location facility is *claimed*, and embodiments disclosed in the specification but not claimed are deemed dedicated to the public. *See, e.g., Johnson & Johnston Assocs., Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054 (Fed. Cir. 2002) ("[W]hen a patent drafter discloses but declines to claim subject matter, as in this case, this action dedicates that unclaimed subject matter to the public."). 01 is therefore wrong to suggest that if a feature is described in the specification it must be covered by the claims.

C. The District Court's Construction Of "Location Facility" Is Supported By The Prosecution History

1. During The Reexamination, 01 Disclaimed The Construction It Seeks On Appeal

The doctrine of prosecution history disclaimer "precludes patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution." *SanDisk Corp. v. Memorex Prod., Inc.*, 415 F.3d 1278, 1286 (Fed. Cir. 2005). Thus, a claim should not be construed to cover claim scope that the patentee "clearly and unambiguously" disclaimed during prosecution. *Voda v. Cordis Corp.*, 536 F.3d 1311, 1321 (Fed. Cir. 2008). This doctrine "protects the public's reliance on definitive statements made during prosecution." *Elbex Video, Ltd. v. Sensormatic Elec. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007).

During the reexamination of the '479 patent, 01 confirmed that the claims do not cover, and clearly and unambiguously disclaimed, having more than one component perform the functions of the claimed location facility. *See* Facts Section D, *supra*. Indeed, 01 and Dr. Ganger repeatedly represented that "the location facility, *itself*, creates the communication channel" and that the "create" requirement is not satisfied if alleged the location facility "only 'enables' or 'facilitates' *some other component* that creates the communication channel." A18002-18003 (emphasis added).

01's disclaimer is also demonstrated by other arguments it made to distinguish the prior art during the reexamination. For example, 01 distinguished the Crichton reference on the ground that it did not disclose a "location facility" that performed all four of the required location facility functions. *See* A18006-18007. In particular, 01 asserted that the "middle proxy (i.e., location facility)" of Crichton did not perform the location facility function of "determining the then current location of the personal computer." *Id.* Instead, 01 argued that "some other component"—i.e., the Server End Proxy—"determines the location of the appropriate personal computer when it needs to deliver communications to it." *Id.* Thus, 01 argued that Crichton's Middle Proxy did not perform all four of the required location facility functions, because one of the functions was performed by Crichton's Server End Proxy.

This argument to distinguish Crichton directly contradicts 01's claim construction position on appeal. Indeed, if the location facility could be subdivided into components distributed among different computers, as 01 now contends, then the Middle Proxy and the Server End Proxy of Crichton would simply be two parts of one "location facility." However, 01 argued just the opposite to the PTO. 01 argued that, because the Middle Proxy and the Server End

Proxy were separate components and each performed at least one of the claimed functions, Crichton did not disclose the claimed "location facility."[3]

2. 01's Prosecution Disclaimer Is Directly Covered By This Court's Prosecution Disclaimer Precedent

01's prosecution disclaimer in this case is directly analogous to the disclaimer this court found in *Elkay Manufacturing Co. v. Ebco Manufacturing Co.*, 192 F.3d 973 (Fed. Cir. 1999). In *Elkay*, the disputed claim limitation was "an upstanding feed tube ... to provide a hygienic flow path for delivering liquid from ... and for admitting air ... into said container." *Id.* at 977. Thus, the claimed "upstanding feed tube" had to perform two separate functions: (1) delivering liquid and (2) admitting air. *Id.* The parties disputed whether the "upstanding feed tube" is "limited to a single feed tube with a single flow path for liquid and air." *Id.* The court held, in that case, that the plain meaning of the claim limitation was "not necessarily limited to a single feed tube with a single flow path." *Id.* The court also held that the specification in that case imposed no such limitation, even though the only disclosed embodiment had a single feed tube for both liquid and air. *Id.* The court explained that this embodiment was not limiting

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[3] Although 01 made other arguments to distinguish Crichton, 01 nevertheless clearly and unambiguously disclaimed a sub-divided location facility distributed on multiple computers. *See Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1377-79 (Fed. Cir. 2008) ("[T]he applicants distinguished their invention from the prior art in multiple ways. Nonetheless a disavowal, if clear and unambiguous, can lie in a single distinction among many.").

because the specification "expressly states" that this was only the preferred embodiment. *Id.* at 978.

Nevertheless, the Court held that, during prosecution, the patentee had given up a construction of the feed tube limitation "that could include an apparatus with separate flow paths for liquid and air." *Id.* In particular, the court observed that, during prosecution of the patent, the examiner rejected the asserted claim as obvious based on two prior art references. *Id.* One of the prior art references, referred to as "Krug," disclosed "a beer dispensing apparatus with two separate feed tubes, one for pressurized air and one for beer." *Id.* The court noted that "Elkay responded to this rejection by distinguishing Krug on the ground that, inter alia, Elkay claimed "*a* flow path ... for delivering liquid .. and for admitting air," whereas "Krug teaches the use of separate liquid and air feeding tubes." *Id.* at 978-79 (emphasis in original). Accordingly, the court concluded that "when Elkay made this argument it necessarily relinquished a construction of its claim language that could include separate feed tubes." *Id.* at 979.

This case is like *Elkay*. Before the PTO, 01 overcame prior art rejections by arguing that the prior art did not disclose a single location facility that performed all four of the required functions, just as Elkay overcame a prior art rejection by arguing that the prior art did not disclose a single feed tube for performing the required functions of conveying both liquid and air. Accordingly, just as Elkay's

disclaimer "necessarily relinquished" a construction of "an upstanding feed tube" that could include separate feed tubes, 01's disclaimer also necessarily relinquished a construction of "location facility" that could include separate facilities.

3. 01 Acquiesced To The PTO's Rejection Of A Proposed Claim Directed To The Construction 01 Seeks On Appeal

It is well established that allowed patent claims "must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." *Omega Eng'g, Inc, v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (quoting *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940)); *see also TorPharm, Inc. v. Ranbaxy Pharms., Inc.*, 336 F.3d 1322, 1330 (Fed. Cir. 2003) ("[I]n ascertaining the scope of an issued patent, the public is entitled to equate an inventor's acquiescence to the examiner's narrow view of patentable subject matter with abandonment of the rest.").

During reexamination of the '479 patent, 01 acquiesced to the PTO's rejection of a claim that covered the construction of "location facility" that 01 has sought in this litigation. In particular, 01 acquiesced to the PTO's rejection of its proposed new claim 49:

> 49. (New) The system of claim 48, wherein the locator server computer is comprised of at least a first and second computer and wherein the *one or more communication sessions between the personal computer and the remote computer are facilitated through said second computer* comprising the locator server computer and

> wherein said *second computer does not also perform the operation of determining the then current location of the personal computer* in response to the receipt of the request for communication with the personal computer.

A28119 (emphasis added). 01 explained that claim 49 was directed to a system in which "one or more computers can perform the function of determining the location of the personal computer while *a separate computer performs the function of facilitating the one or more communication sessions*." A28109 (emphasis added). 01 told the PTO that it was proposing claim 49 to "clarify" that claimed location facility functions can be distributed among different computers. *Id.*

The PTO rejected claim 49, among other proposed new claims, as failing to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1. The PTO explained that claim 49 "contain[ed] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention." A28151.

In response to the PTO's rejection, 01 cancelled claim 49. A28247. 01 proposed no amendment to claim 49, nor did 01 attempt to substitute any claim directed to the same subject matter, nor did 01 appeal the rejection. A28269-28270. Instead, 01 conceded that its cancellation of proposed claim 49 rendered the issues raised by the rejection "moot." A28269. Because 37 C.F.R. § 1.951 only allows one amendment following a PTO Action Closing Prosecution, 01's

decision to cancel claim 49 means that the claim has been abandoned and that 01 acquiesced to the examiner's rejection.

01's prosecution disclaimer through acquiescence in this case is analogous to the acquiescence this Court found in *J&M Corp. v. Harley-Davidson, Inc.*, 269 F.3d 1360 (Fed. Cir. 2001). In *J&M Corp.*, the court held that the "prosecution history conclusively establishes that the single clamp structure of the accused devices cannot be equivalent to the dual clamp embodiment disclosed in the [patent-in-suit's] specification." *Id.* at 1367. The court explained that in a reissue proceeding for the patent-in-suit, the patentee sought new claims directed to "a single clamp embodiment of its invention." *Id.* at 1368. The examiner rejected the new claims, however, because the concept of such an embodiment had not been disclosed in the original patent." *Id.* In response to the examiner's written description rejections, the patentee "acquiesced, canceling the claims." *Id.* Because of the patentee's acquiescence to the written description rejection, the court held that "the scope of the claims cannot include a single-clamp embodiment." *Id.*

Here, as in *J&M Corp.*, 01 has acquiesced to the PTO's written description rejection of its proposed new claim 49. As a result, 01's acquiescence bars 01 from seeking a construction of "location facility" that would cover the abandoned claim 49. 01's acquiescence to the rejection of claim 49 precludes a construction

where the location facility functions can be distributed among different facilities on different computers.

D. 01 Cannot Now Expand The Limited Scope Of Its Claims By Reneging On Its Representations To The PTO In Reexamination

On appeal, 01 attempts to renege on the clear and unambiguous disclaimers that it made to save the asserted claims of the '479 patent during reexamination. It is well established, however, that 01 is barred from seeking a claim construction that is contrary to its prosecution disclaimers.

1. 01's Statements To The PTO Regarding The "Location Facility" Were The Key To Saving The '479 Patent Claims

Contrary to 01's attempts to minimize their significance (01 Br. 24), the disclaimers that 01 and its expert Dr. Ganger made to the PTO about the claimed "location facility" were the key to convincing the PTO that the claims were patentable over the prior art in the reexamination. In the PTO's Right of Appeal Notice, the PTO stated, the "declaration [of Dr. Ganger] filed on 19th of September 2009 is sufficient to overcome the rejections" of all the asserted claims. A27674. Until this declaration by Dr. Ganger, all of the claims now asserted against LogMeIn had been rejected in two separate office actions as unpatentable in view of multiple prior art references. *Id.* After 01 made the disclaimers, the PTO cited the location facility and its functions as key to overcoming all eleven prior grounds of rejection. A27677-27689. The PTO explained that the asserted

claims "are deemed patentable over the prior art of record as the prior art fails to teach or suggest that the location facility determines the then current location of the personal computer *and* creates a communication channel between the remote computer and the personal computer." A27696 (emphasis added). Having maintained the patentability of its claims through representations about the narrow scope of the claimed location facility, 01 cannot now take back these disclaimers.

2. 01's Present Attempts to "Qualify" Its Clear Disclaimers Are Contrary To The Prosecution History

During the reexamination, 01's expert stated unequivocally to the PTO that:

> One of ordinary skill in the art would not view this language, and particularly its repeated use of forms of "create," to be satisfied by an alleged location facility that is simply used by *some other component* that creates the communication channel – rather, one of ordinary skill in the art would understand it to require that the location facility, *itself*, create the communication channel.

A18002-18003. In this appeal, however, 01 contends that Dr. Ganger's comments "merely explained that the location facility running on the locator server—*as distinct from the software facilities running on one of the other components of the system, namely the personal computer or the remote computer*—creates the communication channel." 01 Br. 24 (emphasis added). Thus, on appeal, 01 seeks to read its use of the phrase "some other component" as limited to "merely" "the personal computer or the remote computer." This after-the-fact qualification appears nowhere in 01's disclaimers to the PTO.

Contrary to 01's attempts in litigation to qualify or limit its broad and unqualified disclaimers in prosecution, the public is entitled to rely on what 01 actually said to the PTO, not what 01 wishes it had said, or what it now believes it could have said to distinguish the prior art. *See Cybor Corp.*, 138 F.3d at 1457 (The "relevant inquiry [in determining the scope of a prosecution disclaimer] is whether a competitor would reasonably believe that the applicant had surrendered the relevant subject matter."); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1208 (Fed. Cir. 1992) ("Other players in the marketplace are entitled to rely on the record made in the Patent Office in determining the meaning and scope of the patent.").

In addition, 01 is wrong to assert that "Dr. Ganger's comments did not say or suggest that the locator server must be limited to one physical computer." 01 Br. 24. As discussed above in Section III.C.1, in the very same declaration that Dr. Ganger made the above disclaimers, he also distinguished the Crichton reference on the ground that the functions of the location facility were distributed among at least two different computers. A18006-18007. Specifically, Dr. Ganger argued:

> [A]ll claims require that the location facility (part of the locator server) create communication sessions "by determining the then current location of the personal computer." But, in the Crichton references, the middle proxy (the alleged location facility) communicates with, and knows location information for only the end proxies.... *The middle proxy (i.e., location facility) only determines the location of the server end proxy, and the server end proxy*

> *determines the location of the appropriate personal computer when it needs to deliver communications to it.*

Id. (emphasis added)). Thus, Dr. Ganger argued that the Middle Proxy could not be the claimed location facility because "some other component"—the Server End Proxy computer—performed the location facility function of determining the then current location of the personal computer. *Id.* Dr. Ganger also made clear that the Server End Proxy is not the personal computer when he argued that the middle proxy only knows the current location of the "end proxies," i.e., *not* the personal computer. *Id.* Accordingly, Dr. Ganger's arguments to distinguish Crichton flatly contradict 01's current assertion that "some other component" means only the personal computer or the remote computer (01. Br 24).

Lastly, even if 01 were correct (and it is not) that 01 and Dr. Ganger only intended to disclaim what was necessary to distinguish the prior art, 01 would still be bound by the disclaimers it actually made. As this Court has explained:

> there is no principle of patent law that the scope of a surrender of subject matter during prosecution is limited to what is absolutely necessary to avoid a prior art reference that was the basis for an examiner's rejection ... and we have not allowed [patentees] to assert that claims should be interpreted as if they had surrendered only what they had to.

Norian Corp. v. Stryker Corp., 432 F.3d 1356, 1361-62 (Fed. Cir. 2005).

3. 01 Cannot Now "Take Back" Its Clear Disclaimers By Citing Disclosures In The Specification

01 refers to the patent's written description—not the claims—to support its argument that "the functionality of the location facility software can be sub-divided into several pieces of software and that the locator server on which the location facility runs can comprise several physical computers." 01 Br. 25.

However, as discussed in Section II.B above, the specification never states that the "location facility" itself can be subdivided. Rather, the specification states that "*a number of computer program facilities* described in this invention as separate facilities ... can be combined with other facilities comprising the present invention, or such facilities can be sub-divided into separate facilities." A4018 ('479 Patent, col. 10:10-16). There are *thirteen* different "facilities" described in the patent. If the patentee intended all of them to be combined or subdivided, then the specification should have used the term "all" not merely "a number."

In any case, the prosecution history makes clear that not all of the disclosed "facilities" can be subdivided and distributed among different computers. As already discussed, 01's prosecution disclaimers and acquiescence regarding the location facility demonstrate that the location facility must be a single facility on a single computer. *See* Sections III.C, D.1 & D.2, *supra*. However, these are not the only disclaimers of a "distributed" "facility" in the reexamination. For example, 01 also disclaimed a construction of "data communication facility" that would

cover a facility subdivided and distributed on more than one computer. A18007. Specifically, 01 argued that the claimed data communication facility could not be on any computer other than the personal computer. *Id.* 01 explained that if the data communication facility was on a different computer than the personal computer, then it would not be able to send the "then current" address of the personal computer to the locator server computer, as required by the asserted claims. *Id.*

And, in any event, 01 cannot rely on statements in the specification to "take back" what it disclaimed in prosecution. *See Computer Docking Station Corp.*, 519 F.3d at 1377-79 ("[T]he specification of the [patent-in-suit] does not provide an express definition of 'portable computer' that would override or make the distinctions in the prosecution history ambiguous.").

4. 01 Cannot Now "Take Back" Its Clear Disclaimers Through Expert Declarations In Litigation

01 is also wrong that extrinsic evidence in the form of additional declarations from hired expert witnesses in litigation—namely, Dr. Ganger and 01's other expert, Dr. Andrew Grimshaw—can be used to overcome the clear disclaimers that 01 and Dr. Ganger made during the reexamination of the '479 patent. 01 Br. 25. Specifically, 01 now has Dr. Ganger and Dr. Grimshaw say that, when the '479 patent was filed, one of ordinary skill in the art would have understood that the location facility functions *can* be "distributed over a number of

computers." *Id.* However, as already discussed, Dr. Ganger and 01 repeatedly represented precisely the opposite to the PTO when distinguishing the asserted claims over the prior art. *See* Sections III.C, D.1 & D.2, *supra*. 01's reliance on after-the-fact extrinsic evidence in litigation is inappropriate and should be rejected. *See Southwall Techs.*, 54 F.3d at 1578 ("Evidence extrinsic to the patent and prosecution history, such as expert testimony, cannot be relied on to change the meaning of the claims when that meaning is made clear by those documents.").[4]

5. 01 Is Wrong That It Was "Unnecessary" For the District Court To Construe "Location Facility" As a "Component" That "Itself" Performs The Four Enumerated Functions

01 concedes that the claimed "location facility" must perform all four functions recited in the district court's claim construction. 01 Br. 28-29. However, 01 then argues that including those limitations in the construction of location facility is "redundant and unnecessary, as those limitations are explicitly set out elsewhere in the claim." *Id.*

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[4] In addition, 01's attempt to rely on the deposition testimony of LogMeIn's expert Dr. Samrat Bhattacharjee, is misplaced. *See* 01 Br. 25. Dr. Bhattacharjee never stated that the claimed "location facility" can be distributed on more than one computer, as 01 appears to suggest. *See id.* In any event, just as it cannot rely on the expert testimony of its own experts to renege on its prosecution disclaimers, 01 also cannot rely on Dr. Bhattacharjee's testimony. *See Southwall Techs.*, 54 F.3d at 1578.

To the contrary, the district court's construction is neither redundant nor unnecessary. As this Court has explained, "[c]laim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008).

Here, the district court's construction properly accounts for 01's prosecution disclaimers by explaining that the location facility must be "a component" of the locator server computer that "itself" performs all four of the location facility functions. Although the location facility functions are recited elsewhere in the claim, including them in the construction is "necessary to explain what the patentee covered by the claims"—and what the patentee represented to the PTO is *not* covered by the claims. In particular, the district court's construction properly precludes 01 from asserting that its asserted claims cover systems in which the location facility functions are distributed among different software components on different computers.[5]

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[5] On appeal, 01 suggests that if this Court adopts 01's claim construction, it can grant 01 summary judgment of infringement. 01 Br. 27-28, 37. This suggestion is both baseless and beyond the scope of this appeal. Not only did 01 fail to move for summary judgment before the district court, it has offered no substantial evidence of infringement even under its own construction. Indeed, 01 fails to provides *any* explanation for its assertion that LogMeIn's Web Servers, Database Servers, and Gateway Servers collectively perform each of the four required location facility

IV. THE DISTRICT COURT CORRECTLY GRANTED SUMMARY JUDGMENT OF NONINFRINGEMENT

A. 01 Has Conceded That LogMeIn's Web Servers, Database Servers, And Gateway Servers Are Separate Components

During 01's attempt to obtain a preliminary injunction, 01 admitted that "it is apparent that in LogMeIn's system the functionality of the locator server computer are [sic] distributed among two or more different devices." A28239. While 01 was incorrect in stating that LogMeIn's accused products perform each of the claimed location facility functions, 01 correctly conceded that there is no single component in any LogMeIn server that itself performs all of these functions. Accordingly, by 01's own admissions, the accused LogMeIn products cannot infringe.

In addition, 01's own experts—having reviewed LogMeIn's technical documents and the source code for the accused products—agree that no single server component in LogMeIn's system *itself* performs the four location facility functions. For example, Dr. Andrew Grimshaw, one of 01's two infringement experts, conceded that the LogMeIn servers are at least three separate "components." A28219 ("the LogMeIn locator server *components* (gateway, database, and web servers) in question" (emphasis added)); A28220 ("I view all

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functions. 01 Br. 32-33. Accordingly, 01 has no basis to suggest that this Court can grant summary judgment that the accused products infringe the asserted claims.

three components [of the LogMeIn architecture] as part of one larger facility (system)." (emphasis added)).

Consistent with 01's own admissions, the undisputed evidence produced by LogMeIn also shows that LogMeIn's Web Servers, Database Servers, and Gateway Servers are separate and distinct components. *First*, the LogMeIn Web Servers, Gateway Servers, and Database Servers perform separate and distinct functions. *See* Facts Section E, *supra*. *Second*, the LogMeIn Web Servers, Gateway Servers, and Database Servers, are separate physical machines that are located at different sites across the United States and in England. *Id.* *Third*, the LogMeIn Web Servers, Gateway Servers, and Database Servers have different IP addresses. *Id.* *Fourth*, the LogMeIn Web Servers, Gateway Servers, and Database Servers run on separate and different software. *Id.* 01 never challenges any of these facts, nor could it.

B. 01 Has Conceded That No Single Component In LogMeIn's System "Itself" Performs All The "Location Facility" Functions

1. The LogMeIn Web Server Cannot Satisfy The "Location Facility" Element

The LogMeIn Web Server is the component in the LogMeIn system that authenticates users and provides front end web pages for managing user data. A28208. Nowhere does 01 or either of its experts contend that a LogMeIn Web Server itself: (1) "creat[es] one or more communication sessions" "between the

remote computer and the personal computer"; (2) "locat[es] the personal computer" and "determin[es] the then current location of the personal computer"; or (3) "creat[es] a communication channel between the remote computer and the personal computer." A4018-4019 ('479 Patent, claim 1). At best, 01's experts allege that the LogMeIn Web Server receives a request for communication from the client and works *in combination with a LogMeIn Gateway Server* to create a communication channel. A28212; A28215; A28221-28222. Although LogMeIn disputes this assertion, even assuming it is true for the purposes of this appeal, the LogMeIn Web Server cannot be the "location facility" because 01 concedes that the LogMeIn Web Server does not itself perform three of the four location facility functions.

2. The LogMeIn Database Server Also Cannot Satisfy The "Location Facility" Element

LogMeIn's Database Server is the component in the LogMeIn system that executes logic for identifying and managing the hosts and clients involved in the remote access services provided by LogMeIn. A28208. Nowhere does 01 or either of its experts contend that a LogMeIn Database Server itself: (1) "creat[es] one or more communication sessions" "between the remote computer and the personal computer"; (2) "recei[ves] the request for communication with the personal computer from the remote computer"; or (3) "creat[es] a communication channel between the remote computer and the personal computer." A4018-4019

('479 Patent, claim 1). At best, 01 has contended that the LogMeIn Database Server is the component in the LogMeIn system that locates personal (host) computers. A28213. Although LogMeIn disputes this assertion, even assuming it is true for the purposes of this appeal, the LogMeIn Database Server cannot be the "location facility," because 01 concedes that the Database Server does not itself perform three of the four location facility functions.

3. The LogMeIn Gateway Server Also Cannot Satisfy the "Location Facility" Element

The LogMeIn Gateway Server is the component in the LogMeIn system that maintains static connections to LogMeIn hosts and forwards traffic between the host and the client. A28208. Nowhere does 01 or either of its experts contend that the LogMeIn Gateway Server itself: (1) "recei[ves] the request for communication with the personal computer from the remote computer"; or (2) "locat[es] the personal computer" and "determin[es] the then current location of the personal computer." A4018-4019 ('479 Patent, claim 1). Rather, 01's experts only contend that the LogMeIn Gateway Server is the component that, in combination with a LogMeIn Web Server, "creates the channel and session between the host computer [i.e., remote computer] and the client computer [i.e., personal computer]." A28225; *see also* A28215; A27811. Although LogMeIn disputes this assertion, even assuming it is true, there is no dispute that the Gateway Server does not perform the other two location facility functions—that is, the Gateway Server does

not (1) "recei[ve] the request for communication with the personal computer from the remote computer"; or (2) "locat[e] the personal computer" and "determin[e] the then current location of the personal computer." A4018-4019 ('479 Patent, claim 1). Therefore, the LogMeIn Gateway Server also cannot be a "location facility," because 01 concedes that the Gateway Server does not itself perform two of the four location facility functions.

C. 01 Has Conceded That No Component In LogMeIn's Accused Products Itself Creates A Communication Channel

On appeal, 01 argues that the district court's analysis of the prosecution history "could apply at most to function four, 'creating a communication channel.'" 01 Br. 29. Even if 01 were correct (and the prosecution history demonstrates clearly that it is not), 01 has conceded that no component in LogMeIn's accused products itself creates a communication channel.

For example, one of 01's two infringement experts, Dr. Jack Davidson, argued that the function of "creating a communication channel" is performed by a combination of the LogMeIn Gateway Server and the LogMeIn Web Server—thus conceding that neither server *itself* creates the communication channel:

> More significantly, *in order to construct a communications channel from the client to the host, the LogMeIn Web Server and Gateway Server must actively direct the process so that an end-to-end channel is created* that is secure and is still scalable to a large customer base.

A28215 (emphasis added).

Therefore, even accepting 01's (incorrect) reading of the prosecution history (01 Br. 29), 01's expert witnesses concede that LogMeIn does not have a location facility component that *itself* creates the required communication channel.

D. 01 Cannot Show Infringement By Comparing Its Asserted '479 Patent Claims Against A LogMeIn Patent

01 purports to characterize the LogMeIn system by comparing its asserted '479 patent against LogMeIn's U.S. Patent No. 7,558, 862 ("the '862 patent"). As an initial matter, on page 35 of 01's brief, 01 has modified Figure 2 of the '862 patent to further its arguments. Specifically, 01 has inserted labels (i.e., "Remote Computer," "Locator Server Including Location Facility," and "Personal Computer") as well as coloring (blue, green, and yellow) that do not appear in the '862 patent.

In any case, there is no substantial evidence that the '862 patent describes the architecture of LogMeIn's accused products. The '862 patent describes an embodiment of the remote access invention that is claimed in the patent, but does not purport to describe the remote access system of LogMeIn's accused products. For example, the described embodiment in the '862 patent has only a single "gateway" "component," "often a server," that facilitates remote access between two computers. A10007 ('862 Patent, col. 1:62-67). This is indisputably a different architecture than the accused products, as shown by the undisputed

evidence that LogMeIn's accused products include separate Web Servers, Database Servers, and Gateway Servers. A26005.

In any event, it is well established under this Court's precedent that the determination of infringement requires that the "properly construed claims are compared *to the allegedly infringing device.*" *Cybor Corp.*, 138 F.3d at 1454 (emphasis added). Thus, 01's comparison of the asserted '479 patent claims with LogMeIn's '862 patent has no bearing on whether LogMeIn's *accused products* infringe the '479 patent.

E. 01's Infringement Allegations Are Directly Contrary To The District Court's Claim Construction And The Prosecution History

Despite arguing on appeal that there could be infringement even under the district court's claim construction, 01's infringement arguments simply ignore the construction or attempt to render it meaningless. Notwithstanding that the district court correctly construed "location facility" as "a *component* of the locator server that *itself*" performs all four location facility functions, 01 does not even attempt to argue that a single component in LogMeIn's accused system itself performs all of these functions. Instead, 01 argues that separate software programs running on LogMeIn's separate Web Servers, Database Servers, or Gateway Servers are "properly viewed as *sub*components" of a collective "location facility" that is distributed across two continents. 01 Br. 32 (emphasis added). 01 thus seeks to render the district court's use of the terms "component" and "itself" meaningless—

arguing that *different* software programs running on *different* computers with *different* IP addresses on *different* continents are "properly viewed" as a single "component."

01's infringement arguments also ignore the prosecution history. Contrary to 01's arguments, the terms "component" and "itself" *do* have a specific meaning in the context of the '479 patent—the meaning 01 gave those terms during the reexamination. 01 argued that different computers could not be considered the same "component" when distinguishing the prior art Crichton reference. *See* Sections III.C.1 & III.D.2, *supra*. Thus, 01's use of the word "component" during the prosecution cannot be read to cover more than one computer. Likewise, 01 argued that a "component" does not perform a location facility function "itself" if it merely assists "some other component" in performing that function. Thus, 01's use of the term "*itself*" cannot be read to cover a group of computers "*themselves*" collectively performing the required location facility functions.

F. 01 Has Waived Any Doctrine of Equivalents Argument

As the district court correctly held, "01 has not properly articulated [a doctrine of equivalents] claim in this case" and "is estopped from doing so by its arguments to the PTO in re-examination." A2016-2017. 01 also has failed to make or preserve any doctrine of equivalents argument on appeal. Despite arguing in its brief that the LogMeIn system "operates in the same way" as the claimed

system, and that the LogMeIn system "functions as if it were one large computer" (01 Br. 34-35), 01 never appealed or briefed the district court's ruling regarding doctrine of equivalents, never provided particularized testimony or linking argument as this Court's precedent requires, and is estopped from asserting that what it disclaimed during prosecution is now "equivalent." *See Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 1382 (Fed Cir. 2007) (To prove infringement under the doctrine of equivalents, "the patentee must present particularized evidence and linking argument as to the insubstantiality of the differences between the claimed invention and the accused device, or with respect to the function, way, result test." (quotations omitted)).

CONCLUSION

For the foregoing reasons, this Court should affirm the district court's summary judgment of noninfringement.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Arthur W. Coviello, hereby certify that two (2) true and correct copies of the foregoing BRIEF FOR DEFENDANT-APPELLEE were served this 7th day of October 2011, by Federal Express Overnight Mail upon the following counsel:

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CERTIFICATE OF COMPLIANCE WITH RULE 32(a)

I, Arthur W. Coviello, counsel for Defendant-Appellee LogMeIn, Inc., certify that the foregoing brief complies with the type-volume limitation set forth in Fed. R. App. P. 32(a)(7)(B). Specifically, this brief contains 13,152 words (excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii)) as determined by the word count feature of the word processing program used to create this brief. I further certify that the foregoing brief complies with the typeface requirements set forth in Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6). Specifically, this brief has been prepared using a proportionately spaced typeface using Microsoft 2000, in 14-point Times New Roman font.

Dated: October 7, 2011

Arthur W. Coviello /kmd

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No. 2011-1403

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

01 COMMUNIQUE LABORATORY, INC.,

Plaintiff-Appellant,

v.

LOGMEIN, INC.,

Defendant-Appellee.

DECLARATION OF AUTHORITY

In accordance with Federal Circuit Rule 47.3(d) and pursuant to 28 U.S.C. § 1746, I, Russell M. Davis, hereby declare that Arthur W. Coviello has authorized me to sign the Brief for Defendant-Appellee and accompanying Certificate of Interest and Certificate of Compliance in the above-captioned matter.

October 7, 2011

Respectfully submitted,

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