

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

NARISTE NETWORKS PTY. LTD.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

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No. 2:23-cv-00031-JRG-RSP

JURY TRIAL DEMANDED

**DEFENDANTS' RULE 12(b)(6) MOTION TO DISMISS UNDER 35 U.S.C. § 251 AND
THE RULE AGAINST RECAPTURE**

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I. INTRODUCTION

This case should be dismissed with prejudice because all claims of U.S. Reissue Patent No. 48,206 (“’206 patent”) are invalid as a matter of law under the reissue statute, 35 U.S.C. § 251, and its rule against recapture.

Plaintiff Nariste Networks Pty. Ltd. (“Nariste”) alleges that devices made and sold by Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) infringe the reissue claims of the ’206 patent. According to Nariste, the ’206 patent and its claims relate to using *either* the “position” of a mobile device *or* the “position error” of a mobile device to determine whether the device’s GPS module should be turned on or off. In other words, a mobile device can determine whether its GPS module should be on or off by using only the “position” of the device and without also using the “position error” of the device. But the subject matter of permitting the GPS’s on/off state to depend solely on “position” alone—without also requiring dependence on “position error”—was surrendered by Nariste during prosecution of the original patent and cannot be re-claimed under the rule against recapture.

The rule against recapture bars a patentee from broadening the scope of reissue claims to re-claim subject matter that was surrendered to overcome prior art during prosecution of the original patent. Here, the original patent from which the ’206 patent reissued was U.S. Patent No. 8,022,870 (“’870 patent”). When Nariste filed the application for the ’870 patent, its originally filed claims recited using radio “position” *alone* to determine the power-up phase of a device’s GPS module—much like the ’206 patent’s reissue claims. But after those originally filed claims were rejected, Nariste surrendered the subject matter of using position alone by amending the claims to require using both “position *and error*.” In its remarks, Nariste identified its addition of the “error” requirement to the claims as the basis for distinguishing prior art.

But with the ’206 patent’s reissue claims, as is apparent now from Nariste’s allegations,

Nariste sought to undo its surrender by reverting to the broader scope of its originally filed claims of the '870 patent where “position” alone was sufficient—a classic case of recapture. All of the '206 patent's claims are therefore invalid for violating § 251's rule against recapture.

II. FACTUAL BACKGROUND

Nariste's improper recapture of surrendered subject matter is evident from: the prosecution and claims of the original '870 patent; the prosecution of a related reissue application that Nariste abandoned; and the prosecution and claims of the '206 patent. Each is discussed in turn below.

A. The Original '870 Patent's Claims And Prosecution History

Nariste filed the application for the original '870 patent on February 11, 2008, as a U.S.-stage application of an international PCT application that Nariste first filed in Australia. Ex. A at 000229 (2008-02-11, Completion of Filing Reqs.).¹ As originally filed, the '870 patent's independent claims recited that the power-up phase of a GPS module depended on only “information on the radio *position* of the mobile device.” Ex. A at 000196-201 (2007-05-07 Appl. Prelim. Amend. at 6, 8, 11).²

The Examiner rejected the claims over prior art references U.S. Patent No. 5,592,173 (“Lau”), which disclosed powering up a GPS module based only on the “radio position” of the device, and U.S. Patent No. 6,584,331 (“Ranta”). Ex. A at 000264-65 (2010-05-19 OA at 3-4).

To distinguish the Lau reference, Nariste amended the claims so that the power-up phase of the GPS module depended on both “a current radio position *and* error.” Ex. A at 000286-91

¹ Samsung requests that the Court take judicial notice of the full histories of the original '870 patent, abandoned related reissue application, and reissue '206 patent, attached as Exhibits A, B, and C, respectively. *See Jenny Yoo Collection, Inc. v. Watters Designs, Inc.*, 2018 WL 3330025, at *5 n.8 (N.D. Tex. June 6, 2018) (taking judicial notice of prosecution history); *see also infra* Section III. For ease of reference, the file histories are stamped with Bates numbers in the bottom right corner with the form 00XXXX.

² Unless otherwise indicated, throughout this brief, “***bold italicized text*** within quotation marks” is emphasis added to the original quotation.

(2010-11-07 Appl. Resp. at 2, 4, 7). In its remarks accompanying the amendment, Nariste emphasized that Lau did not teach using both “current position” and “error.” Ex. A at 000301-02 (2010-11-07 Appl. Resp. at 17, 18). Nariste specifically distinguished Lau for not disclosing or suggesting the claimed invention’s use of “**location error** (location accuracy) as determined from the wireless network to provide GPS power savings”:

Neither the Lau et al. reference nor the Ranta reference, whether considered either alone or in any permissible combination (if any) would disclose or suggest the claimed invention, which uses **location error** (location accuracy) as determined from the wireless network to provide GPS power savings. By virtue of the features of the claimed invention, superior outcomes in power savings can be produced relative to the Lau et al and Ranta references.

Id. at 000301 (2010-11-07 Appl. Resp. at 17). Nariste added that Lau did “not disclose using position information, or more particularly, **position error**, as determined by the wireless networks as one of the inputs to control the GPS power supply”:

The Lau et al reference does not disclose using position information, or **more particularly, position error**, as determined by the wireless network as one of the inputs to control the GPS power supply. The use of position error as determined by a wireless network as an input leads to a much enhanced power savings.

Id. at 000302 (2010-11-07 Appl. Resp. at 18).

On September 20, 2011, the ’870 patent issued, with all claims reciting that the GPS’s on/off state depends on both “a current radio position **and error**.” Claim 1 below is representative:

1. A method of acquiring GPS on a mobile wireless communication device for a wireless communications network, said mobile device possessing wireless communications capability for said wireless network and an embedded GPS module for GPS capability, said method comprising:

setting a current value of a period of a power-up phase of said GPS **dependent on a current radio position and error** of said mobile device in the wireless network determined from the wireless network and adaptive predictions of when said GPS should be powered on to meet specifications on positioning accuracy and GPS acquisition time.

Id.

B. Nariste Abandoned A Related Reissue Application Due To Recapture

On November 29, 2016, Nariste filed reissue application number 15/364,195 (the “’195 Reissue Application”), as a continuation of another earlier reissue of the ’870 patent. The initially filed claims of the ’195 Reissue Application recited a GPS power-up state that depended on only “a radio position.” Ex. B at 000533-35 (2016-11-29 at cls. 37, 43, 49). For example, claim 37 recited “when said embedded satellite positioning system module should be powered on being dependant [*sic*] on a radio *position* of said mobile wireless communication device,” where an “embedded satellite position system module” could be a GPS module. *Id.*

The Examiner rejected the claims for violating the rule against recapture under § 251. Ex. B at 000632-33 (2018-05-25 OA at 15-16). In particular, the Examiner identified the dependency of the GPS module’s on/off state on “position” alone—without also requiring dependency on “position error”—as subject matter that Nariste had surrendered during prosecution of the ’870 patent and that could not be re-claimed:

Applicant specifically argued during original prosecution that led to the ’870 patent that the prior art fails to disclose amongst others the claimed “position error.” *By omitting the requirement of a “position error” in determining when said embedded satellite position system should be turned on, applicant is attempting to recapture subject matter surrendered during original prosecution* [See MPEP § 1412.02].

Id. at 000633 (2018-05-25 OA at 16).

Nariste never responded to the Examiner’s recapture rejection. Instead, Nariste abandoned the ’195 Reissue Application. Ex. B at 000680 (2019-04-22 Notice of Abandonment).

C. The Reissue ’206 Patent’s Prosecution History

On December 12, 2016, Nariste filed the reissue application for the ’206 patent. After initial amendments, Nariste again submitted claims reciting that the GPS’s on/off state depended only on “position,” with claim 37, for example, reciting: “when said embedded satellite positioning

system module should be powered on being dependant [*sic*] on a ***position***.” Ex. C at 000844-45 (2017-12-17 Appl. Resp. at cls. 37, 43, 49).

The Examiner rejected claims 37 and 49 as improperly attempting to recapture the surrendered subject matter of the GPS’s on/off state depending on “position” alone. Ex. C at 000910-13 (2019-09-30 OA at 8-11). Specifically, the Examiner noted that the ’870 patent’s claim language requiring “current radio position ***and error*** of said mobile device” was missing, even though Nariste had added that language to overcome prior art rejections during the prosecution of the ’870 patent. *Id.*

Nariste responded to the Examiner’s recapture rejection by amending the ’206 patent claims to add the language: “at least one of a current radio position and error of said mobile device.” Ex. C at 000950 (2019-12-30 Appl. Resp. at 7 (remarks)), 000953-54 (2019-12-30 Appl. Resp. at 10 (amended claims)). The Examiner withdrew the recapture rejection without explanation and allowed the claims without disclosing any reasoning. Ex. C at 000973 (2020-04-01 OA at 8). The ’206 patent issued on September 15, 2020.

D. The ’206 Patent’s Reissue Claims

Nariste alleges that Samsung infringes at least claim 37 of the ’206 patent, which is reproduced below, with the key claim language relevant to the issue of recapture emphasized:

37. A method of acquiring a position on a mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said method comprising:

determining when said embedded GPS module should be powered on, said embedded GPS module then being powered on,

said when said embedded GPS module should be powered on being dependent on ***at least one of a current radio position and a position error*** of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

Id.

Independent claims 40 and 43 similarly recite “being dependent on at least one of a current radio position and a position error of said mobile device.” *Id.*

In correspondence sent on April 6, 2023, Samsung requested that Nariste dismiss its lawsuit because the ’206 patent’s claims violate the rule against recapture, as argued in this Motion. Ex. D (2023-04-06 Liang Ltr.). In a response letter, Nariste refused to dismiss its case, arguing steps 2 and 3 of the three-step recapture test were not violated. Ex. E (2023-04-18 Alavi Ltr.).

III. LEGAL STANDARDS

“To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

A court ruling on a Rule 12(b)(6) motion may rely on the complaint, its proper attachments, “documents incorporated into the complaint by reference, and matters of which a court may take judicial notice.” *Dorsey v. Portfolio Equities, Inc.*, 540 F.3d 333, 338 (5th Cir. 2008) (citations omitted). Courts may take judicial notice of government records, such as patent prosecution history, when resolving a Rule 12(b)(6) motion. *See Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1008 n.2 (Fed. Cir. 2018) (“[o]n a motion for judgment on the pleadings, however, the court may consider ‘matters of public record,’” such as “[p]rosecution histories”); *Uniloc USA, Inc. v. ADP, LLC*, 772 F. App’x 890, 898 n.3 (Fed. Cir. 2019) (“[t]he prosecution history is part of the intrinsic record of the patent” and “is thus subject to judicial notice and may be considered in our de novo review of the district court’s” ruling on a motion to dismiss).

According to the rule against recapture under § 251, a patentee may not recapture “through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997). “Under this rule, claims that are

broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible.” *Id.* (cleaned up). “Whether the claims of a reissue patent violate” the recapture rule under “35 U.S.C. § 251, and thus are invalid, is a question of law.” *In re Mostafazadeh*, 643 F.3d 1353, 1358 (Fed. Cir. 2011). Courts evaluate whether the rule against recapture is violated using a three-step test:

- (1) “whether . . . the reissue claims are broader in scope than the original patent claims”;
- (2) “whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution”; and
- (3) “whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.”

Greenliant Sys. Inc. v. Xicor LLC, 692 F.3d 1261, 1267 (Fed. Cir. 2012) (quotations and citations omitted). Under this inquiry, at the motion to dismiss stage, courts may consider a patent family’s entire prosecution history as part of the public, intrinsic record of the asserted reissue patent. *In re McDonald*, 43 F.4th 1340, 1347 (Fed. Cir. 2022).

IV. ARGUMENT: THE ASSERTED REISSUE CLAIMS ARE INVALID UNDER § 251 FOR RECAPTURING SURRENDERED SUBJECT MATTER

All asserted ’206 patent claims are invalid because they violate the rule against recapture under the Federal Circuit’s three-step test. As detailed below, at step 1, the ’206 reissue claims, as alleged by Nariste, broaden the original ’870 patent claims by permitting the on/off state of a device’s GPS module to depend solely on the device’s “position” alone, without also depending on position “error.” At step 2, this broadening is improper because Nariste surrendered dependency on “position” alone during prosecution of the ’870 patent to overcome prior art rejections, by adding an additional dependency on position “error.” At step 3, the ’206 patent’s reissue claims have no other limitations that materially narrowed the claims to avoid recapture of the surrendered subject matter of “position” alone.

A. Recapture Step 1: The Reissue Claims Are Broader Than The Original Patent Claims By Permitting Dependency On “Position” Alone Without Also Requiring Dependency On Position “Error”

The first step of the recapture test is to “determine whether and in what ‘aspect’ the reissue claims are broader than the [original] patent claims.” *Mostafazadeh*, 643 F.3d at 1358 (quotations omitted). Step 1 is met here because the ’206 patent’s reissue claims, as alleged by Nariste, are broader than the issued claims of the original ’870 patent with respect to whether a GPS module’s on/off state can depend on “position” alone, without also depending on position “error.”

All of the independent claims of the ’206 patent recite “when said embedded GPS module should be powered on being dependent on *at least one of a current radio position and a position error* of said mobile device.” ’206 patent cls. 37, 40, 43. Under Nariste’s allegations, “*at least one of a current radio position and a position error*” is a disjunctive phrase, meaning that either “current radio position” or “position error” is sufficient to satisfy the claim. Further, courts have construed similar phrases with syntax “at least one of . . . and . . .” in the disjunctive. *See, e.g., Micropairing Techs. LLC v. Toyota Motor Mfg. Tex. Inc.*, 2022 WL 62540, at *19-20 (W.D. Tex. Jan. 5, 2022) (“[T]he Court construes the term ‘at least one of . . . and . . .’ as disjunctive. . . . [T]he patentee used the term to indicate alternatives.”); *Uniloc USA, Inc. v. Samsung Elecs. Am., Inc.*, 2019 WL 1614724, at *7-8 (E.D. Tex. Apr. 15, 2019) (construing “at least one of a transmitter and receiver configured to at least one of transmit and receive” having at least one transceiver or having at least one receiver, but not having both); *3rd Eye Surveillance, LLC v. U.S.*, 140 Fed. Cl. 39, 68, 70 (Fed. Cl. 2018) (construing “based on at least one of the additional information and imagery data . . . in the disjunctive, i.e., one or more additional information, one or more imagery data, or one or more of both”). Thus, in the reissue claims, the GPS module’s power-on state can depend on *either* one of “a current radio position” *or* “a position error.”

By contrast, the issued claims of the original ’870 patent recite those same dependencies

in the conjunctive, requiring that the GPS's power-up state depend on *both* "current radio position" *and* "position error." See '870 patent cl. 1 ("setting a current value of a period of a power-up phase of said GPS dependent on a *current radio position and error* of said mobile device"); cl. 12 (same); cl. 23 (same). Thus, the '206 patent's reissue claims' disjunctive recitation of either "current radio position" or "position error" is broader and more permissive than the '870 patent claims' conjunctive requirement of both "current radio position" and "position error."

In correspondence preceding this Motion, Nariste did not dispute that step 1 is met. See Ex. E. In particular, Nariste did not dispute that the reissue '206 patent claims recite "position" and "error" disjunctively and are therefore broader than the original '870 patent claims that recite those dependencies conjunctively. See Ex. D at 2. Step 1 is satisfied.

B. Recapture Step 2: Dependency On "Position" Alone Was Surrendered During Prosecution Of The Original '870 Patent To Overcome Prior Art

Step 2 requires that the Court, in "determin[ing] whether an applicant surrendered particular subject matter, . . . look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998). "A surrender can occur by argument as well as by amendment." *Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1373 (Fed. Cir. 2006). As discussed, the '206 patent reissue claims' disjunctive recitation of "current radio position" or "position error" permits the GPS module's on/off state to depend on "position" *alone* under Nariste's reading of the claims. Nariste, however, surrendered this broadened scope during prosecution of the original '870 patent.

Specifically, during prosecution of the '870 patent, the Examiner rejected the originally filed claims as invalid based on prior art reference Lau, which disclosed powering up the GPS depending on only the "radio position" of a mobile device. Ex. A at 000264-65 (2010-05-19 OA at 3-4). To overcome that rejection, Nariste amended the claims' recitation of the GPS module's

on/off state from depending only on “information on the radio *position*,” to depending on both “a current position *and error*.” Ex. A at 000286-91 (2010-11-07 Appl. Resp. at 2, 4, 7). In accompanying remarks, Nariste emphasized the addition of “and error” as distinguishing Lau because the reference did not disclose using “location *error* (location accuracy) as determined from the wireless network to provide GPS power savings.” Ex. A at 000301 (2010-11-07 Appl. Resp. at 17). Nariste elaborated that Lau did “not disclose using position information, or more particularly, position *error*, as determined by the wireless networks as one of the inputs to control the GPS power supply.” Ex. A at 000302 (2010-11-07 Appl. Resp. at 18). By adding the additional dependency on position “error,” Nariste surrendered the broader recitation of the GPS module’s on/off state depending on “position” alone.

In the parties’ correspondence, Nariste disagreed with the scope of surrender during the ’870 patent’s prosecution. Ex. E at 1-2. Nariste argued that, in amending the originally filed claims’ language from “dependent on information on the radio position” to “dependent on a current radio position and error,” Nariste surrendered “information on the radio position”—not dependency on “position” alone. *Id.* Nariste’s characterization of what it surrendered is incorrect.

First, Nariste’s characterization contradicts its own remarks made during the ’870 patent’s prosecution, which confirm that its basis for arguing that the amendment overcame the prior art rejection was the addition of a dependency on position “error.” During prosecution, Nariste repeatedly identified its addition of the position “error” limitation as distinguishing Lau because that reference disclosed making a determination based on “position” alone. Ex. A at 000301-02 (2010-11-07 Appl. Resp. at 17-18). At no point during prosecution did Nariste ever suggest that its amendment of the prior language “information on the radio position” to “current radio position” somehow distinguished Lau or any other prior art reference, or even that this particular amendment

narrowed the claim language. To the contrary, the prosecution history evidences the opposite—the Examiner rejected the claims because Lau disclosed determining whether to power on GPS based on position alone (Ex. A at 000264-65 (2010-05-19 OA at 3-4)), so Nariste responded by amending the claims to add position “error” to overcome Lau and obtain allowance of the claims. Ex. A at 000301-03 (2010-11-07 Appl. Resp. at 17-19).

Second, Nariste’s characterization ignores that for the related, abandoned ’195 Reissue Application, the Examiner specifically found that dependency on “position” alone—without also requiring dependency on position “error”—violated the recapture rule. The originally filed claims of the ’195 Reissue Application recited a GPS power-up state dependent on only “a radio position.” Ex. B at 000533-35 (2016-11-29 Reissue Appl. cls. 37, 43, 49). But the Examiner rejected those claims because they violated § 251’s rule against recapture. Ex. B at 000632-33 (2018-05-25 OA at 15-16). In rejecting the claims, the Examiner explained that having “position” alone without also having “position error” was surrendered in the original prosecution:

Applicant specifically argued during original prosecution that led to the ‘870 patent that the prior art fails to disclose amongst others the claimed “position error.” *By omitting the requirement of a “position error” in determining when said embedded satellite position system should be turned on, applicant is attempting to recapture subject matter surrendered during original prosecution* [See MPEP § 1412.02].

Id. at 000633 (2018-05-25 OA at 16).

Tellingly, Nariste never disputed or even responded to the Examiner’s finding. Rather, Nariste abandoned the ’195 Reissue Application—tacitly conceding to the Examiner’s description of the matter surrendered and resulting recapture violation. Thus, step 2 is met here because Nariste surrendered the subject matter of a GPS’s on/off state being dependent on “position” alone.

C. Recapture Step 3: The Reissue Claims Are Not Narrowed With Respect To The Surrendered Subject Matter Of Dependency On Position Alone

Step 3 requires that the Court determine whether the ’206 patent’s reissue claims are

materially narrowed in another respect so as to avoid recapture of the surrendered subject matter. Under the third step, the rule against recapture is not violated “if the reissue claims ‘materially narrow’ the claims relative to the original [application] claims such that full or substantial recapture of the subject matter surrendered during prosecution is avoided.” *In re Gen. Elec. Co.*, 789 F. App’x 857, 859 (Fed. Cir. 2019) (quoting *Mostafazadeh*, 643 F.3d at 1358). In situations where “the reissue claim is broader [than the original claims] in some aspects, but narrower in others,” the recapture rule bars the reissue claim only “if [it] is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection.” *Clement*, 131 F.3d at 1470. Put differently, “the recapture rule is violated when a limitation added during prosecution [of the original patent] is ***eliminated entirely***, even if other [unrelated] narrowing limitations are added to the claim.” *Mostafazadeh*, 643 F.3d at 1361.

Compared to the original ’870 patent’s issued claims, the ’206 patent reissue claims are not narrower in any respect that avoids recapture of the surrendered subject matter—i.e., the GPS’s on/off state depending on “position” alone. Instead, and as explained for step 1, by reciting that the GPS’s on/off state is based on either one of “current radio position” or “position error” in the alternative, the reissue claims permit the on/off state to depend on “position” alone. There is no other limitation in the reissue claims that adds another dependency on position “error” so as to avoid recapture. The additional dependency on position “error” is a limitation that Nariste added during prosecution of the ’870 patent, but then “eliminated entirely” in the ’206 patent’s reissue claims, resulting in improper recapture. *See Mostafazadeh*, 643 F.3d at 1361.

In the parties’ correspondence, Nariste made two counterarguments about step 3, neither having merit. First, Nariste simply repeated its argument related to step 2 that the subject matter surrendered during the ’870 patent’s prosecution was “information on the radio position,” and

contended that this also meant that step 3 was not satisfied. Ex. E at 2. In particular, Nariste argued that it is immaterial whether the '206 patent reissue claims permit dependency on “position” alone because that was not the surrendered subject matter and, at step 3, “[t]he narrowing must . . . relate to the surrendered subject matter.” *Id.* (emphasis original). But as discussed for step 2, Nariste’s characterization of its surrender as “information on the radio position” is plainly wrong as it: (1) contradicts Nariste’s own remarks to the PTO during the '870 patent’s prosecution where it identified its claim amendments adding dependency on position “error” as distinguishing prior art; and (2) is belied by Nariste’s decision to abandon the '195 Reissue Application in the face of a recapture rejection made after it tried to obtain reissue claims that recited only “position” without also reciting position “error.” *See supra* Section II.B. Thus, the premise for Nariste’s first counterargument at step 3—that its surrender was “information on the radio position”—is simply false.

Second, Nariste argued that the '206 patent claims “were materially narrowed in other respects” because they include another limitation—“said embedded GPS module then being powered on”—absent from the claims of the '870 patent. Ex. E at 2. Nariste’s argument, however, misunderstands the step 3 legal test. The step 3 test is not whether the reissue claims are narrower in *any* “other respects” compared to the original claims. Rather, recapture is avoided under step 3 only if the reissue claims include limitations that provide a “*material* narrowing.” In this context, “material” does not mean any substantive change or narrowing in claim scope. Rather, it means that the narrowing is related to the surrendered subject matter in such a way that *avoids recapture* of that subject matter. *Gen. Elec. Co.*, 789 F. App’x at 859-60 (citing *Mostafazadeh*, 643 F.3d at 1359). The Federal Circuit has found the “material narrowing” requirement not met in three decisions that are illustrative:

- In *In re Mostafazadeh*, the broadened and surrendered aspect of claims pertaining to semiconductor packages was the circular shape of the package’s “attachment pads.” And at step 3, the Federal Circuit found that the recapture rule barred the reissue claims because their added limitations on the structure of a separate “bus bar” component of the package were “unrelated to the surrendered subject matter” of a “circular attachment pad.” 643 F.3d at 1356-58, 1361.
- In *Mentor Corp. v. Coloplast, Inc.*, the broadened and surrendered aspect of claims pertaining to condom catheters was the requirement for a “transfer of adhesive from the outer to the inner layer,” and at step 3, the Federal Circuit found that the recapture rule barred the reissue claims because their added limitations on the catheter’s material “lack[ed] the requirement of transfer of adhesive from the outer to the inner layer” and thus did “not narrow the claims in any material respect compared with their broadening.” 998 F.2d 992, 995-96 (Fed. Cir. 1993).
- In *Pannu v. Storz Instruments, Inc.*, the broadened and surrendered aspect of claims pertaining to lenses was the circular shape of the “haptic” component of the lens, and at step 3, the Federal Circuit found that the recapture rule barred the reissue claims because their added limitations concerning the position and dimensions of a separate component of the lens, the “snag resistant means,” were “not related to the shape of the haptics.” 258 F.3d 1366, 1371-72 (Fed. Cir. 2001).

Here, to find a “material narrowing” to avoid recapture at step 3, the reissue claims must include a limitation that avoids having the GPS’s on/off state depend solely on “position” and instead requires that the on/off state also depend on position “error.” But there is no such limitation, and Nariste identified none in its correspondence. Rather, Nariste identified only

a narrowing between the reissue '206 patent claims and the original '870 patent claims, namely, the additional language of “said embedded GPS module then being powered on.” But this language in no way requires that position “error” also be used to determine when the GPS module is powered on and, thus, it fails to avoid recapture of surrendered subject matter. Accordingly, the claim language identified by Nariste is “unrelated to the surrendered subject matter and thus insufficient to avoid recapture” at step 3. *Mostafazadeh*, 643 F.3d at 1361.

D. The Examiner Clearly Erred In Allowing The '206 Patent Reissue Claims

In opposition, Nariste may note that the Examiner withdrew its recapture rejection during prosecution of the '206 patent's claims following Nariste's amendment of “dependant [*sic*] on a *position*” to “dependent on *at least one of a current radio position and a position error.*” See Ex. C at 000973 (2020-04-01 OA at 8). But the Examiner gave no explanation or reasoning for the withdrawal. *Id.* The Examiner may have interpreted the “at least one of . . .” clause as conjunctive, requiring *both* “current radio position” and “position error” and thus avoiding recapture of “position” alone. Nariste, however, does not appear to be adopting that interpretation based on its correspondence and Complaint. Thus, the Examiner's withdrawal of a recapture rejection was in error under Nariste's interpretation of the claims and is irrelevant to the outcome of this Motion.³

V. CONCLUSION

For the reasons above, Nariste's Complaint based on the '206 patent's reissue claims should be dismissed with prejudice because all of the patent's claims are invalid under § 251 for violating the rule against recapture.

³ In addition, there was no overlap in Examiners between the '206 patent prosecution and the prosecution of the '195 Reissue Application, where the claims were rejected for violating the recapture rule by omitting position “error” and Nariste then abandoned the application.

Dated: May 5, 2023

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