

GEMALTO S.A. v. HTC CORPORATION, Appeal No. 2013-1397 (Fed. Cir. June 19, 2014).
Before Newman, Rader, and Dyk. Appealed from E.D. Tex. (Judge Davis).

Background:

Gemalto sued HTC for infringing claims of its three related patents. The asserted claims of two of Gemalto's patents are directed to an integrated circuit card (IC card) and some claims of Gemalto's third patent are directed to a programmable device operatively coupled with a memory, all of which allow resource-constrained devices to run software applications written in high level programming languages. Gemalto's patents require that a converted high level programming language and a corresponding interpreter be stored on the IC card or the memory of the programmable device (on-chip memory). HTC contended that it did not infringe because the accused smart phones relied on off-chip memory to run high level programming languages.

After construing that Gemalto's claims require "a single semiconductor substrate... that includes... all program memory," the district court granted summary judgment of non-infringement in favor of HTC, concluding that the accused products did not infringe because the applications were stored in off-chip memory of the accused products. Gemalto appealed.

Issue/Holding:

Did the district court err in holding that HTC did not infringe Gemalto's patents? No, affirmed.

Discussion:

On appeal, Gemalto argued that the IC card should be able to access applications stored in off-chip memory and thus, HTC's devices infringed on the claims. The Federal Circuit disagreed. The Federal Circuit found that the specification and the prosecution history of Gemalto's patents precluded such an interpretation of Gemalto's claims because the specification demonstrated that external memory storage of high level programming language was a defining feature of the prior art, and that Gemalto's patented inventions were designed to eliminate the need for such external storage. With respect to the prosecution history, the Federal Circuit found that to overcome prior art Gemalto repeatedly argued that a critical distinction between its invention and the prior art is the ability to "squeeze" an application onto the IC card without the need for accessing external memory. Thus, the Federal Circuit held that "the claims cannot be of broader scope than the invention that is set forth in the specification."

Additionally, although claims of one of Gemalto's patents recite a programmable device and a memory but not an IC card, the Federal Circuit held that "[w]hen multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation." Thus, the representations by Gemalto in the prosecution history of the patents with claims directed to the IC card were imputed onto the Gemalto's patent having claims directed to the programmable device coupled with the memory.

For the reasons stated above, the Federal Circuit agreed with the district court's claim interpretation and thus, the judgment of the district court was affirmed.