

No.

**IN THE SUPREME COURT OF
THE UNITED STATES**

HO KEUNG TSE,
Petitioner,

v.

**GOOGLE INC., SAMSUNG
TELECOMMUNICATIONS
AMERICA LLC, HTC AMERICA,
INC., AND BLOCKBUSTER, LLC.,**
Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The district court granted summary judgment of invalidity of most claims of US patent 6,665,797 (“‘797 patent”) under 35 U.S.C. § 112, for lack of written description support in the originally filed patent application for the “No Charge” negative limitations^{1,2} in the invalidated claims (“Summary Judgment”).

However, evidences found in the Summary Judgment show that the district court actually granted it without even having a look at the originally filed claims, which it should, to check if there is any “No Charge” limitation therein. Tse respectfully submits, they do have languages explicitly precluding payment.

As such, the Summary Judgment itself is nothing but *a no opinion judgment*, at least in respect to the

¹ A term used by Tse to refer to the claim language for specifying the invention causes no payment, when permitting software use, which comes directly from the languages of the claims, with no need for construction.

Note that Google et al. argued “Mr. Tse now... arguing for a ‘narrow’ construction of the no-charge limitation”, but *without raising a counter proposal*, refer to their Appellees’ Brief, case 14-1222, dkt. 25, p.20, last line-p.21, first line. As such, they failed to dispute it.

² The “No Charge” claim limitations are readable on A71-72, highlighted in yellow.

Note that the citations to A __ refer to pages in the Joint Appendix for the appeal to the Federal Circuit, case 14-1222, *Tse v Google et al.*, Dkt. 30.

QUESTION PRESENTED— Continued

originally filed claims.

And thereafter, a Federal Circuit panel affirmed the summary judgment, *with no opinion*, by virtue of Fed. Cir. Rule 36, and then the Federal Circuit denied a combined petition for panel rehearing and rehearing en banc, *again with no opinion*.

This is an issue of first impression, the question is:

Regardless of the decision below being made is right or not, whether the Federal Circuit should use its Rule 36 power to issue a no opinion affirmance order, when there is an omission in the opinion of the court below which is so critical that the use of Rule 36 power would result in a serious violation of the Fifth Amendment to the United States Constitution³, which guarantees “No person shall ... be deprived of life, liberty, or property, without due process of law” and, the requirements of due process includes, “Requirement that the tribunal prepare *written findings of fact and reasons* for its decision.” (emphasis added) A well-regarded article, “Some Kind of Hearing”, by late Judge Henry Friendly.

³ For information, even though Tse is now staying in Hong Kong, to take care of his 81 years old father, he is a U.S. permanent resident card holder, and just in 2014, he honestly paid the U.S. Gov. IRS Individual Income Tax USD 15,813. Even though it may be a very small amount to many people, should Tse be entitled to constitutional rights, just as every U.S. citizen ?

Tse will provide all evidences he has, should the Court needs them.

PARTIES TO THE PROCEEDING

Petitioner pro se :

Ho Keung, TSE. (“Tse”)

Respondents:

Google, Inc., Samsung Telecommunications America, L.L.C., and HTC America, Inc. in Fed. Cir. case 14-1222 and Blockbuster, LLC. in another Fed. Cir. companion case 14-1223 (“Google et al.”).
Sup. Ct. Rule 12.4.

TABLE OF CONTENTS

QUESTION PRESENTED.....	i
PARTIES TO THE PROCEEDING.....	iii
TABLE OF AUTHORITIES.....	vii
PETITION FOR A WRIT OF CERTIORARI.....	1
OPINIONS BELOW.....	1
JURISDICTION.....	1
CONSTITUTIONAL AND STATUTORY PROVISIONS.....	2
STATEMENT OF THE CASE.....	4
1. Tse’s 6,665,797 Patent (“797 patent”)...	4
2. The Spirit Of The Invention, And Its Support in The Original Description And Claim 1.....	4
3. Procedural Background.....	5
a. Filing Suits In Texas.....	5
i. <i>Tse v Google et al.</i>	5
ii. <i>Tse v Blockbuster, LLC</i>	6
b. Both Cases Transferred To And Related in California.....	6
c. The Joint Summary Judgment Motion	6
d. The Companion Appeals Before the Federal Circuit.....	7

TABLE OF CONTENTS- Cont'd

REASONS FOR GRANTING THE PETITION....	8
1. The District Court Have Never Taken A Look At The Originally Filed Claims....	8
2. Google et al. Evaded Tse’s Argument Relying on Originally Filed Claim 12 in CIP.....	11
a. Google et al.’ Comment on originally filed Claim 1.....	11
b. Google et Al. Didn’t Argue “No Charge” Limitation Of Claim 12 At All, Leaving It To Become An Undisputed Fact.....	13
CONCLUSION.....	16

APPENDIX

APPENDIX A: The United States Court of Appeals for the Federal Circuit’s No-Opinion Affirmance Order on Summary Judgment, case 14-1222, <i>Tse v Google et al.</i> , Dated July 16, 2014..	1a
---	----

(identical to the affirmance order in another
companion case 14-1223 , *Tse v Blockbuster
LLC.*)

APPENDIX B: The Summary Judgment of United States District Court for the Northern District of California, case 3: 13-cv-00 194-SI, <i>Tse v Google et al.</i> , Dated Dec 11, 2013.....	4a
---	----

(identical to the Summary Judgment in another
related case 3:13-cv-1204-SI , *Tse v Blockbuster
LLC.*)

TABLE OF CONTENTS- Cont'd

APPENDIX C: The United States Court Of Appeals for the Federal Circuit's Order for Denying a Request for Rehearing, case 14-1222, Dated July 16, 2014..... 21a

(identical to the Order for Denying in another companion case 14-1223)

TABLE OF AUTHORITIES

FEDERAL COURT CASES	Page
<i>Univ. of Rochester v. G D. Searle & Co.</i> 358 F.3d 916 (Fed. Cir. 2002).....	7
<i>In re Koller,</i> 613 F.2d 819, 204 USPQ 702 (CCPA 1980)...	9
SUPREME COURT CASES	Page
<i>Davis v. Scherer</i> , 468 U.S. 192 (1984).....	11
<i>Logan v. Zimmerman Brush Co.</i> , 455 U.S. 422 (1982).....	11
<i>Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank</i> , 527 U.S. 627 (1999).....	11
STATUTES	Page
35 U.S.C. §112.....	i,3,8
28 U.S.C. § 1338(a).....	1
28 U.S.C. § 1295(a)(1).....	2
28 U.S.C. § 1254(1).....	2
35 U.S.C. § 261.....	2,11
RULES	Page
Federal Circuit Rule 36.....	ii,2
Sup. Ct. Rule 12.4.....	iii
Fed.R.Civ.Proc. Rule 56.....	3,18

TABLE OF AUTHORITIES- Cont'd

OTHER AUTHORITIES	Page
Fifth Amendment to the United States Constitution.....	ii, 2, 11
A well-regarded article, “Some Kind of Hearing”, by late Judge Henry Friendly.....	ii
Seventh Amendment to the United States Constitution.....	18

PETITION FOR A WRIT OF CERTIORARI

Petitioner pro se Ho Keung, TSE respectfully submits this petition for a writ of certiorari to review the no opinion judgment of a panel of the United States Court of Appeals for the Federal Circuit entered in the two companion cases 14-1222, *Tse v Google et al.* and 14-1223, *Tse v Blockbuster, LLC.*, on July 16, 2014.

OPINIONS BELOW

The district court's Summary Judgment is reproduced in the appendix to the petition (App.) at 4a- 20a.

The Federal Circuit panel's no opinion affirmation order is reproduced in the App. at 1a- 3a.

The Federal Circuit's no opinion order on denying a combined petition for panel rehearing and rehearing en banc is reproduced at the 21a-23a.

Tse now has no information as to whether the opinions are reported and will immediately inform the Court if he get such information.

JURISDICTION

This petition arises from a patent-infringement action. The trial court, i.e., the United States District Court for the Northern District of California, had subject-matter jurisdiction under 28 U.S.C. § 1338(a). The trial court entered a final judgment, refer to A12^{4,5}. The appellate court, i.e., the Federal Circuit,

⁴ Note that the citations to A __ refer to pages in the Joint Appendix for the appeal to the Federal Circuit, case 14-1222, *Tse v Google et al.*, Dkt. 30.

had jurisdiction under 28 U.S.C. § 1295(a)(1).

The Federal Circuit panel entered judgment on July 16, 2014. App. 1a- 3a. Tse filed a combined petition for panel rehearing and rehearing en banc. The Federal Circuit denied the combined petition on September 15, 2014, 21a-23a. Accordingly, this Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS

The Fifth Amendment to the Constitution provides in relevant part as follows:

“No person shall ... be deprived of ...property, without due process of law”

The federal patent statute 35 U.S.C. § 261 provides in relevant part as follows:

“Subject to the provisions of this title, patents shall have the attributes of personal property.”

Federal Circuit Rule 36. Entry of Judgment – Judgment of Affirmance Without Opinion :

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

⁵ Pls. also refer to case 3:13-cv-00194-SI, *Tse v Google et al.*, Dkt. 118, “Order Re: Plaintiff’s Request For Clarification”, p.2, ¶1, last two lines, “Accordingly, none of the defendants’ counterclaims remain pending, and the judgments in the two related action are final.” It is not submitted in the Joint Appendix.

- (a) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (b) the evidence supporting the jury's verdict is sufficient;
- (c) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
- (e) a judgment or decision has been entered without an error of law.

The Federal Rules of Civil Procedure, Rule 56. "Summary Judgment", section a, provides in relevant part as follows:

"The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law."

35 U.S.C. §112 provides, in relevant part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out his invention.

STATEMENT OF THE CASE

1. Tse's 6,665,797 Patent (“ ‘797 patent”)

On December 1, 1995, Tse filed a parent application (“Parent application”), and abandoned it in July 2003. A15-31.

And also, Tse filed a continuation-in-part application (“CIP application”), A32-50, on July 9, 1998, which matured into the ‘797 patent on Dec 16, 2003. A60-73.

2. The Spirit Of The Invention, And Its Support in The Original Description And Claim 1

Before the advent of the present invention, purchased software was protected by means of a piece of specific hardware, such as a dongle, which is not practical for Internet sales.

The invention of ‘797 patent is directed to using “a positive determination of existence of a payment program, or a valid account”; as a precondition for permitting protected software to be used— without causing a payment to be made with the program/account, which is the “No Charge” claim limitations at issue here.

This is the spirit of the present invention and is supported by the CIP application, for e.g., A34, ¶2, last 5 lines, “The AS sub-program is for using ...the existence of the EI sub-program...as preconditions for authorising those software products ...to be used”, and claim 1 which requires “existence of ...identity software is being determined without a .. [payment-related] operation” (A45, ¶5, last 3 lines, also herein below, p.11, Reason 2a, “Google et al.’

Comment on originally filed Claim 1”).

Note that EI sub-program in the description is for making payment and corresponding to “identity software” in claim 1.

This may well be a demonstration of how straightforward to tell the “No Charge” claim limitations of the ‘797 patent should be supported by the CIP application. However, the following story of how the claims were being invalidated is unnecessarily convoluted and very disappointing.

3. Procedural Background

a. Filing Suits In Texas

i. *Tse v Google et al.*

In May, 2012, Tse filed suit with the United States District Court for the Eastern District of Texas, alleging respondent Google, Inc.’s Internet virtual store, “Android Market” (since Oct 2008), later renamed as “Google Play” (since March 2012), infringed on the ‘797 patent, for using the patented invention in its digital rights management (“DRM”) software and/or hardware, to protect sold application programs, commonly known as “Apps”.

Tse also alleged respondents Samsung Telecommunications America, L.L.C., and HTC America, Inc. of contributory infringement, for selling Android Device products with Google, Inc.’s infringing DRM software and/or hardware installed therein.

Tse sought both injunctive and monetary relief, and demanded for *a jury trial*.

ii. *Tse v Blockbuster, LLC.*

In May, 2012, Mr. Tse also filed suit with the United States District Court for the Eastern District of Texas, alleging respondent Blockbuster, LLC. infringed on the ‘797 patent.

Tse sought both injunctive and monetary relief, and demanded for *a jury trial*.

b. Both Cases Transferred To And Related in California

Both cases were later transferred to United States District Court for the Northern District of California, as moved by defendants, case # : 3:13-cv-00194-SI, *Tse v Google et al.* and 3:13-cv-1204-SI , *Tse v Blockbuster LLC.*; and then related before Judge Susan Y. Illston.

c. The Joint Summary Judgment Motion

In July 2013, the district court permitted a summary judgment motion to be filed jointly by all defendants in both related cases, on the issue of the “No Charge” claim limitations of the ‘797 patent lacks written description in the originally filed CIP application, under 35 U.S.C. § 112.

In Dec 2013, the district court granted the Summary Judgment identically for both cases.

d. The Companion Appeals Before the Federal Circuit

Tse appealed the identical Summary Judgments of both cases to the Federal Circuit, Fed. Cir. case 2014-1222, *Tse v Google et al.* Dkt. 17 and case 2014-1223, *Tse v Blockbuster*, Dkt. 9.

Given that the summary judgment motions filed in the underlying cases were briefed, argued, and decided identically in the district court, these separately docketed appeals were deemed companion cases and assigned to a single Fed. Cir. merits panel for decision. (Case 2014-1222, Dkt. 18.)

Defendants accordingly filed identical joint Appellees' briefs, case 2014-1222, Dkt. 25, in each of the companion cases, with citations to Tse's Appeal brief filed in the Google appeal only⁶.

Consequently, Tse filed identical reply briefs in both appeals. Case 2014-1222, Dkt. 33.

The Federal Circuit panel issued identical judgment of affirmance with no opinion in July 2014, under FED. CIR. R. 36. App. 1a- 3a, for both appeals, presumably after a *de novo* review⁷, as it has to.

⁶ Note that there are some slight differences between Tse's briefs filed in Google appeal and the Blockbuster appeal.

⁷ “[The Federal Circuit] reviews a district court’s grant of summary *judgment de novo*, reapplying the appropriate standard applicable before the district court.” *Univ. of Rochester v. G. D. Searle & Co.* 358 F.3d 916, 919-20 (Fed. Cir. 2002).(emphasis added)

Then, Tse filed two combined petitions for panel rehearing and rehearing en banc (case: 14-1222 Dkt: 37, case: 14-1223 Dkt: 24), both was identically denied by the Federal Circuit with no opinion, on September 15, 2014, App. 21a- 23a.

REASONS FOR GRANTING THE PETITION

1. The District Court Have Never Taken A Look At The Originally Filed Claims

Referring to the district’s Summary Judgment, A7: 24-26, App. 14a, ¶2, “Although the 1998 [CIP] application purports to be a continuation-in-part of the parent, in fact, it contains mostly *cosmetic changes* from the 1995 [Parent] application. See Decl. Ex. B⁸ (line-by-line comparison of the ‘448 [Parent] application and ‘276 [CIP] application.)” (emphasis added).

Note that in identifying the Parent and CIP applications, the district court first used their filing years 1995 and 1998 and then their application serial numbers ‘448 and ‘276, respectively.

Then, the district court incorrectly concluded, A7: 26-27, App. 14a, ¶2, last 2 lines-15a, line 1, that, “As such, [the CIP application] *too* fails to provide support sufficient to satisfy the written description requirement in 35 U.S.C. § 112.” (emphasis added).

Apparently, this conclusion is totally relying upon its finding of “*cosmetic changes*” and its another

⁸ It is an exhibit (A51-59) to the Summary Judgment motion.

erroneous adjudication⁹ in the Summary Judgment, A6, 7, App. 12a, ¶2- 14a, ¶1, that the Parent application fails to provide support for the “No Charge” claim limitations, under the sub-title “1. 1995 Parent Application”.

But the claims of the Parent application (A25-30, totally 21 claims) and that of the CIP application (A45-50, totally 15 claims), are two sets of completely different claims. They are by no means “*cosmetic changes*”.

Should the district court do have taken a look at the claims of both the Parent and CIP applications, as it should ¹⁰, it would have known.

⁹ Pls. refer to Tse’s Appeal Brief, Fed. Cir. Case No. 2014-1222, Dkt. 17.

Note that Google et al. advanced a deceptive theory that “No Charge” claim limitations were later added by an amendment dated April 2, 2001 (A6, line 26, App. 13a, last para., line 3) to the CIP application, which should be useless and of no probative value, as the claims in the amendment, in particular claims 1 (A84), 12 (A85), are “*second* time amended”, and these three words appear immediately after the claim number, in the first lines of the claims, in parentheses.

Because no party had submitted the first amendment, therefore should the district did have taken a look at the second time amended claims, it would certainly know it have to look into the original filed claims instead, as no evidence is a better evidence than the original filed claims themselves, to prove they have “No Charge” limitations, or alternatively, have any language which would preclude payment.

¹⁰ *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980), “original claims constitute their own description”.

And, despite Tse didn’t have to, he did inform the district

As to the Decl. Ex.B (A51-59), which was so much relied upon by the district court, provides merely a line-by-line comparison of *the descriptions* of the ‘448 Parent application and ‘276 CIP application, *it covers no claim* of both applications at all. Again, the district court didn’t even know.

Among all facts ignored, the most important ones would be, independent claims 1, 12 (A49) of the CIP application do have “No Charge” limitation, and the “No Charge” limitation of claim 12 was actually undisputed by Google et al., for which detail will be discussed in Reason 2 herein below.

As to the Parent application, its claims do not have such limitations.

This should be by no means an appropriate situation for the Federal Circuit to issue a rule 36 *no-opinion affirmance*, but despite Tse did inform the Federal Circuit panel of the “No Charge” limitation of claims 1, 12 in his Appeal Brief (case: 14-1222 Dkt: 17), argument 2, pp.17-21, “The Original CIP Application has ‘No-Charge’ Limitations in Claims” and Tse did attempt to draw the Federal Circuit’s attention to this problem in the Summary Judgment in his combined petition for panel rehearing and

court that the original filed claims 1, 12 of CIP contained the “No Charge” limitations, by a notice, case: 3: 13-cv-00 194-SI, Dkt.108, two days after the district court received a copy of the CIP application from Google’s counsel, which was submitted belatedly, that is, after all the briefings, and was in pursuant to the district court’s request in a hearing of the Summary Judgment.

No party has submitted the district court a copy of the same before this, a procedural defect on the part of movants Google et al. themselves.

rehearing en banc (case: 14-1222, Dkt: 37), pp.4-5, argument 1, part a, “The district court has never taken a look at CIP’s originally filed claims” ; the Federal Circuit panel affirmed the Summary Judgment with no opinion, App. 1a, 2a, and then the Federal Circuit *denied* the combined petition, again with *no opinion*,¹¹ App. 21a- 23a.

2. Google et al. Evaded Tse’s Argument on Originally Filed Claim 12 in CIP ¹²

In their Appellees’ Brief, Google et al. tried to confuse the Federal Court with claims 1 and 12 as both requiring the same “No Charge” limitation.

a. Google et al.’ Comment on originally filed Claim 1

Here below is a copy of claim 1 (A45), with its “No Charge” limitation in *italics* :

¹¹ The Fifth Amendment requires due process of law before a federal agency or court deprives a person of a property right. *Davis v. Scherer*, 468 U.S. 192, 202 (1984). The Due Process Clause protects a civil litigant who seeks recourse in the courts as a plaintiff attempting to redress a grievance. *Logan v. Zimmerman Brush Co.*, 455 U.S. 422, 429 (1982). [T]he Due Process Clause grants the aggrieved party the opportunity to present his case and have its merits fairly judged. *Id.* at 433.

“Patents ... have long been considered a species of property.” *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 642 (1999). The federal patent statute provides that a patent has the attributes of personal property. 35 U.S.C. § 261.

¹² The argument is merely a few statements to force Google et al. to make a response and draw the court’s attention to claim 12’s “No Charge” limitation, because there is nothing to be argued at all.

Authorising software, stored in a device or existing physically on a medium, for use on a computer, to protect other commercial computer software by discouraging a rightful or an authorised user thereof from enabling or allowing other person(s) to use said software desired to be protected or a duplication copy thereof; said computer conforming to or compatible with an existing standard so that any software conforming to or compatible with said standard can be used thereon and without modification thereof;

said authorising software being for, when executed, 1) permitting use of said software desired to be protected on said computer; 2) determining the existence of identity software in a memory means under control of said computer;

said identity software being for use on a said standard computer to provide identity information of said rightful or authorised user ;

said identity information being for to be authenticated by a remote computing means in order for enabling operation(s) for which said rightful or authorised user has to be responsible, to be performed; and *the existence of said identity software in a memory means under control of said computer is being determined without a said operation being performed by said remote computer;*

wherein use of said software desired to

be protected on said computer will not be permitted if said identity software is determined as being not existing in a memory means under control of said computer; and said authorising software and said identity software being computer software conforming to or compatible with said existing standard.

Note that the underlined “operation(s) for which said rightful or authorised user has to be responsible”, stands for payment operation or the like.

Google et al. frivolously argued “This payment-free EI check is irrelevant to whether a charge (e.g. pay-per-use or metered usage) ¹³ is required for access or use” (Appellees’ Brief, case 14-1222, Dkt. 25, p.19, ¶1).

Note that “EI” is a program in the description for making payment, corresponding to “identity software” in claim 1.

Whether their argument on claim 1 makes any sense is not important, as Google et al. have actually abandoned their argument against claim 12.

b. Google et Al. Didn’t Argue “No Charge” Limitation Of Claim 12 At All

Despite being told by the title of argument 2 , part a, in Tse’s Appeal Brief, case: 14-1222 Dkt: 17, p.17-19, “Claim 12 [of original filed CIP] requires

¹³ On the contrary, claim 7 (A47) of CIP application, recites “purchased commercial computer software” (emphasis added), in its preamble, line 3.

identity software to be enabled by a password, but not used for payment, when permitting software use”, they unbelievably mischaracterized claim 12 as requiring “*identity software’s identity check*”, as claim 1 does, in their argument at p.19, ¶3, “[t]his does not preclude charging separate from the *identity software’s identity check*, such as by the AS, for access to protected”¹⁴ (verbatim, emphasis added).

This time, Google et al. used back the original claim language “identity software”, not the “EI” which is a program in the description, corresponding to the claim language “identity software”, and used by them in their argument on claim 1. An unnecessary confusion.

And, their argument is nothing but a red herring, as it has nothing to do with claim 12’s language “*said identity software is not being used*”, and nowhere in their Appellees’ Brief, they contested the same.

The following is a copy of claim 12 (A49), with the “No Charging” limitation in *italics* :

Protection software, stored in a device or existing physically on a medium and being computer software conforming to or compatible with an existing standard, for use on a computer, to protect other commercial computer software by discouraging a rightful or an authorised user thereof from enabling or allowing other person(s) to use said

¹⁴ Ironically, Google et al. did correctly quote the language of “No Charge” limitation of claim 12 in their Appellees’ Brief, p.19, ¶2.

software desired to be protected or a duplication copy thereof;

said computer conforming to or compatible with said existing standard so that any software conforming to or compatible with said standard can be used thereon and without modification thereof;

said protection software comprising :

identity software for, with protection against used by unauthorised user, providing identity information of said rightful or authorised user;

said identity information being for to be authenticated by a remote computing means in order for enabling operation(s) for which said rightful or authorised user has to be responsible, to be performed;

authorising software for, when executed, permitting use of said software desired to be protected on said computer;

wherein use of said software desired to be protected will not be permitted if said protected identity software is not being caused to be usable by a predetermined password or non-machine generated password entered by user ; and said identity software is not being used to provide said identity information for to be authenticated by said remote computing means, in permitting use of said software desired to be protected.

Note that the underlined “operation(s) for which said rightful or authorised user has to be responsible”, stands for payment operation or the like.

Note also that when one embodiment disclosed permitting software use without causing payment, one with ordinary skill in the art would know the other embodiments would similarly require no payment.¹⁵

CONCLUSION

Tse respectfully submits, invalidating a patent without a reason at all is not a matter of small moment. People need to know why, especially those invested a lot of money and time on patents, otherwise its repercussions may take years to die down. And historically, individual inventors did contribute a lot to the development of economics, and create a lot of job opportunities.

And, the “No Charge” limitation of claim 12 as discussed above is merely one out of a number of arguments or actually facts undisputed or unable to be disputed, by the Summary Judgment movants Google et al. In his Reply Br. (case 14-1222, Dkt. 33), Tse attempted to draw the Federal Circuit’s attention to those Appeal Brief arguments¹⁶ evaded by Google

¹⁵ See Tse’s argument 8, “One embodiment is Enough, For Support of ‘No Charge’ Claim limitations”, submitted in the Appeal Brief, case: 14-1222 Dkt: 17, pp.37-38.

And, Google et al. vaguely comment “the ‘797 Patent’s concept” is “tangential”, in their Appellees’ Brief, P.31, second para. from bottom.

¹⁶ The evaded arguments are 2a, 3a, 7-11.

et al.; and should there be any inaccuracies in Tse’s such allegations, Google et al.’ highest-paid-in-the-world attorneys should have sought leave to file a surreply to clarify, which would have no chance of not being granted. But they did nothing, this speaks volume.

In sum, Google et al. has done nothing to prove their case, and the district court even repeatedly asserted that it didn’t know whether the invention would cause any payment in permitting software use or not¹⁷, yet it nevertheless granted the Summary Judgment, depriving Tse’s rights to a jury trial, as

¹⁷ Referring to the Summary Judgment, A7: 16-18, App. 14a, lines 19-22, “there is nothing in the original disclosure that would convey that access to the protected software though the AS subprogram *would not – or would*, for that matter ... require a payment” (emphasis added).

Also A9:20-23, App. 17a, ¶2, last 6 lines, “The fact that payment is not mentioned here, without more, does not imply that payment is necessarily not required, particularly in the face of language elsewhere in the parent application disclosing that payment *would or could be* part of the EI sub-program process.” (emphasis added).

The fact behind is, with the simple and well-defined structure of the invention in the disclosure, the district court could merely argue a payment might be added, and was unable to specify what kind of payment it is or how it happens. So were Google et al, when the case was before the district court.

Tse respectfully submits, without further detail thereof, the allegedly existing payment that the different parties have been arguing about, including the district court, Tse and Google et al., may actually be completely different things, for detail, pls. refer to case: 14-1222, Dkt: 17, Tse’s Appeal Brief, p.24, argument 4, “Defendants’ Baseless Allegation of Payment, Even if looking in their favor, is at best a Genuine Issue of Material Fact”.

guaranteed by the Seventh Amendment. This is not the law¹⁸, but the Federal Circuit let it happen without a word.

For all the foregoing reasons, Mr. Tse respectfully requests that this Court grants the petition for a writ of certiorari.

Dated: Nov. 26, 2014

Respectfully submitted,

Ho Keung TSE
Petitioner Pro Se

¹⁸ The Federal Rules of Civil Procedure, Rule 56. “Summary Judgment”, section a, “The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.”

And, the law gives the benefit of the doubt as to whether a material issue of facts exists to the non moving parties, not the movants.

APPENDIX

APPENDIX TABLE OF CONTENTS

APPENDIX A: The United States Court of Appeals for the Federal Circuit’s No-Opinion Affirmance Order on Summary Judgment, case 14-1222, <i>Tse v Google et al.</i> , Dated July 16, 2014.....	1a
(identical to the affirmance order in another companion case 14-1223 , <i>Tse v Blockbuster LLC.</i>)	
APPENDIX B: The Summary Judgment of United States District Court for the Northern District of California, case 3: 13-cv-00 194-SI, <i>Tse v Google et al.</i> , Dated Dec 11, 2013.....	4a
(identical to the Summary Judgment in another related case 3:13-cv-1204-SI , <i>Tse v Blockbuster LLC.</i>)	
APPENDIX C: The United States Court Of Appeals for the Federal Circuit’s Order for Denying a Request for Rehearing, case 14-1222, Dated July 16, 2014.....	21a
(identical to the Order for Denying in another companion case 14-1223)	

APPENDIX A

The United States Court of Appeals for the Federal
Circuit's No-Opinion Affirmance Order on Summary
Judgment, case 14-1222, Dated July 16, 2014
(identical to the affirmance order
in another companion case 14-1223)

PER CURIAM (PROST, *Chief Judge*, LINN and
HUGHES, *Circuit Judges*)

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

HO KEUNG TSE,
Plaintiff-Appellant,

v.

**GOOGLE INC., SAMSUNG
TELECOMMUNICATIONS AMERICA LLC,
HTC AMERICA, INC., AND BLOCKBUSTER,
INC.,**
Defendants-Appellees.

2014-1222

Appeals from the United States District Court for the Northern District of California in No. 13-cv-00194, Judge Susan Y. Illston.

JUDGMENT

HO KEUNG, TSE, of Cheung Sha, Hong Kong,
pro se.

STEPHANIE P. SKAFF, Farella Braun + Martel LLP, of San Francisco, California, for Google, Inc. With her on the brief were DEEPAK GUPTA; BIJAL VAKIL and ERIC KRAUSE, White & Case LLP, of Palo Alto, California, for Samsung Telecommunications America, LLC; JERRY R. SELINGER, Patterson & Sheridan, LLP, of Dallas,

Texas for HTC America, Inc.; and SCOTT LLEWELLYN, Morrison & Foerster LLP, of Denver, Colorado, for Blockbuster, LLC.

THIS CAUSE having been heard and considered, it is ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, LINN and HUGHES, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

July 16, 2014
Date

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court

APPENDIX B

The Summary Judgment of United States
District Court for the Northern District of California,
case 3:13-cv-00194-SI, *Tse v Google et al.*, Dated Dec
11, 2013

(identical to the Summary Judgment in another
related case 3:13-cv-1204-SI, *Tse v Blockbuster LLC*.)

HON. SUSAN ILLSTON

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF
CALIFORNIA

HO KEUNG TSE,
Plaintiff Pro Se,

vs.

GOOGLE, INC. ET AL.,
Defendants.

No. C 13-0194 SI

GRANTING DEFENDANTS'
MOTION FOR SUMMARY
JUDGMENT

TSE, HO KEUNG,
Plaintiff Pro Se,

vs.

BLOCKBUSTER L.L.C.
Defendant.

No. C 13-1204 SI

Defendants in these related patent infringement actions have filed a motion for summary judgment of invalidity based on a lack of written description under 35 U.S.C. § 112. Pro se plaintiff has filed an opposition, to which defendants have replied. The Court heard argument on the motion on September 6, 2013. Having considered the parties' positions, and for good cause shown, the Court GRANTS defendants' motion for summary judgment, for the reasons set forth below.

BACKGROUND

Plaintiff filed Application No. 08/587,448 (“ ‘448

application” or “parent application”) on December 1, 1995. Plaintiff subsequently filed Application No. 09/112,276 (“‘276 application” or “CIP application”) on July 9, 1998, claiming priority as a continuation-in-part to the ‘448 application.

Plaintiff eventually discontinued his prosecution of the parent ‘448 application. However, on December 16, 2003, United States Patent 6,665,797 B1 (‘797 Patent) issued based on the ‘276 application. The ‘797 Patent is the only patent at issue in these two lawsuits.

The ‘797 Patent teaches a method for protecting software against unauthorized use. Skaff Decl., Ex. A, ‘797 Patent, at 2:33-38. Whereas prior authentication software methods required use of hardware comprising decryption keys, the ‘797 Patent’s method does not require external hardware. *Id.* at 1:14-29. Instead, it teaches an authentication method involving software that performs authentication via a central program, without any external decryption hardware. *Id.* The central program includes three subprograms: (1) a sub-program for providing encrypted identity information (the “EI sub-program”); (2) a sub-program for authenticating a computer (the “AC sub-program”); and (3) a sub-program for authorizing the access or use of protected software (the “AS sub-program”). *Id.* at 2:40-46. The central program verifies the user’s identity information on the computer by using the EI sub-program. It then optionally authenticates a computer as being an authorized computer by using the AC sub-program. *Id.* at 2:33-5:30. Depending on the result of these checks, the AS sub-program permits access or use of the protected software by either sending an encrypted command to the software

to permit it to run or by decrypting the software to allow access. *Id.*

The ‘797 Patent’s disclosure teaches that the EI sub-program can be used to obtain goods and services on a user’s account “for payment therefor [sic] involved.” ‘797 Patent, 1:46-51. Because the central program containing the AS sub-program (required for accessing protected software) also contains the EI sub-program that can be used to make purchases on the user’s account, the user is purportedly deterred from providing unauthorized access to the central program to others.

On April 2, 2001, plaintiff filed an amendment to the ‘276 application. *See* Skaff Decl. Ex. C. In particular, plaintiff responded to the patent examiner’s prior art objection by adding a limitation that access to the protected software be provided without a payment or charge. Whereas the prior art required a billing operation to take place, plaintiff contended that his method required no such operation. In December 2003, the ‘797 Patent issued and the claims in dispute in this lawsuit – claims 1-5, 13, 16, 17, 20, and 23-26 – all contain some variation of the “no-charge” amendment.

In 2005, plaintiff filed an action for infringement of the ‘797 Patent against Apple Computer, Inc., and others, in the United States District Court for the District of Maryland. That action was transferred to this district. *See Ho Keung Tse v. Apple Inc.*, Case No. 4:06-cv-6573-SBA (N.D. Cal.). On July 24, 2007, the defendants in that action initiated an ex parte reexamination proceeding of the ‘797 Patent. During the reexamination process, the patent examiner rejected all but one of the claims under

reexamination as being invalid over the prior art. The examiner found, as part of a determination of the applicable priority date with respect to several claims, that there was no support in the original 1995 parent application for the claim limitation requiring that access to the protected software be provided without an e-commerce transaction taking place (the “no-charge” limitation). As such, the examiner found that the claims with the no-charge limitation were not entitled to priority back to the 1995 ‘448 application.

Plaintiff appealed the examiner’s findings to the Board of Patent Appeals (“BPAI”). The BPAI confirmed the examiner’s finding of a lack of written description support in the parent application for the no-charge limitation and, as such, upheld the finding of invalidity for those claims on the basis of prior art. *See* Skaff Decl. Ex. F (BPAI opinion, 1/11/2011). Plaintiff requested reconsideration and also requested a rehearing with an expanded BPAI panel. The BPAI affirmed its earlier decision and denied the rehearing with an expanded panel. *See* Skaff Decl. Ex. G. (BPAI opinion, 5/26/2011). After the appeal, plaintiff further amended claim language and renumbered several claims. A reexamination certificate reflecting the surviving claims was issued in August of 2012. *See* Docket No. 36.

On May 30, 2012, plaintiff filed two separate lawsuits in the Eastern District of Texas alleging infringement of the ‘797 Patent. The first such suit was against defendants Google, Inc., Samsung Telecommunications America, LLC, and HTC America, Inc.; the second was against defendant Blockbuster, L.L.C. Both actions were transferred to this District and the cases have been related for

pre-trial purposes.

Defendants Google, Samsung, HTC, and Blockbuster collectively have filed a motion for summary judgment. The sole basis for that motion is that plaintiff's no-charge amendment renders the patent invalid because it lacks any written basis in either the parent or CIP application. Just as the BPAI found the no-charge limitation lacked written support for purposes of affixing a priority date, defendants urge that the lack of written support for that limitation in either the parent or CIP application renders the patent invalid under 35 U.S.C. § 112.

LEGAL STANDARD

Summary judgment is proper if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The moving party, however, has no burden to disprove matters on which the non-moving party will have the burden of proof at trial. The moving party need only demonstrate to the Court that there is an absence of evidence to support the non-moving party's case. *Id.* at 325.

Once the moving party has met its burden, the burden shifts to the non-moving party to "set out 'specific facts showing a genuine issue for trial.'" *Id.* at 324 (quoting then Fed. R. Civ. P. 56(e)). To carry this burden, the non-moving party must "do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita Elec.*

Indus. Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). “The mere existence of a scintilla of evidence . . . will be insufficient; there must be evidence on which the jury could reasonably find for the [non-moving party].” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986).

In deciding a summary judgment motion, the Court must view the evidence in the light most favorable to the non-moving party and draw all justifiable inferences in its favor. *Id.* at 255. “Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge . . . ruling on a motion for summary judgment.” *Id.* However, conclusory, speculative testimony in affidavits and moving papers is insufficient to raise genuine issues of fact and defeat summary judgment. *Thornhill Publ’g Co., Inc. v. GTE Corp.*, 594 F.2d 730, 738 (9th Cir. 1979).

DISCUSSION

The core dispute is whether the no-charge limitation as it exists in claims 1-5, 13, 16, 17, 20, and 23-26 is supported by the parent ‘448 application or the continuation-in-part ‘276 application. Having considered the evidence in the light most favorable to plaintiff, the Court concludes that there is no genuine dispute that neither the parent nor the CIP application supports this limitation. Accordingly, defendants are entitled to summary judgment because these claims are invalid pursuant to 35 U.S.C. § 112.

It is well established that a patent is presumed valid, and “the burden of persuasion to the contrary is and remains on the party asserting invalidity.”

Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1573 (Fed.Cir.1985). To be valid, however, 35 U.S.C. § 112 requires that every patent contain a written description of the invention. The purpose of this requirement is to “ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date.” *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001). “The test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharms, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). While the written description requirement does not require that the original disclosure provide *in haec verba* support for the claimed subject matter at issue, *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996), the original disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

“When the applicant adds a claim or otherwise amends his specification after the original filing date . . .the new claims or other added material must find support in the original specification.” *TurboCare*, 264 F.3d at 1118. “The fundamental inquiry is whether the material added by amendment was inherently contained in the original application.” *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1352 (Fed. Cir. 2000). “[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon ‘reasonably conveys to the

artisan that the inventor had possession at that time of the later claimed subject matter.’” *Vas-Cath*, 935 F.2d at 1563 (quoting *Ralston Purina Co.*, 772 F.2d at 1575).

1. 1995 Parent Application.

Defendants urge that deference to the BPAI’s findings requires this Court now to invalidate the claims at issue in these lawsuits under 35 U.S.C § 112. In particular, the BPAI found that two claims containing the no-charge limitation lack support in the ‘448 application and therefore are not entitled to the 1995 priority date:

the disclosure of the ‘448 parent application does not reasonably convey to one of ordinary skill in the art that the Appellant had possession of . . . “access to said software desired to be protected is being provided without causing a said [electronic commerce] operation being performed . . .”

Skaff Decl. Ex. F (BPAI opinion, 1/11/2011, at 35). While the BPAI’s finding that the no-charge claims are not entitled to 1995 priority date is entitled to deference, see *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1303-05 (Fed. Cir. 2008), it does not automatically follow that those claims must be invalidated for failing the § 112 written description requirement. That the BPAI found a lack of written description for the narrow purpose of determining a priority date does not excuse this Court from undertaking its own invalidity analysis on summary judgment. In defendants’ view, every BPAI priority date dispute could result in an invalid patent. However, this cannot be squared with the Federal Circuit’s narrow holding and reasoning as to why BPAI’s priority date findings are entitled to deference. See *PowerOasis*, 522 F.3d at 1303-05.

The Court need not pause long on this issue, however, because in this case, the Court agrees with the BPAI's reasoning. Having conducted an independent review of the evidence, the Court concludes that the no-charge claims at issue here lack written support in the parent '448 application. Defendants challenge the validity of all claims allegedly infringed – claims 1-5, 13, 16, 17, 20, and 23-26 – because each contains or is dependent on a claim that contains the limitation that access to software through the AS sub-program (called the “ES Program” in the parent application) be provided “without causing a said [electronic commerce] operation being performed.” *See, e.g.*, ‘797 Patent at 1:18-21; 10:41-45.

This limitation was added during the patent prosecution process to overcome a prior art objection. According to the amendment dated April 2, 2001, it was alleged that “Wiedemer (4,796,181)” prior art was “directed to a billing system for computer software” in which protected software was provided only after a billing operation took place. Skaff Decl. Ex. C (Docket No. 98-1 at 42). Plaintiff contended that in his system, “identity means/software/information” was used only “for enabling operation(s) for which rightful user(s) of the software desired to be protected.” (emphasis original). *Id.* Thus plaintiff added the language, “wherein access to said software desire to be protected is being provided without causing said operation [an electronic commerce transaction] being performed,” in order to explain that his invention does not require payment to access the protected software. *Id.* at 42-43. However, nowhere in the amendment does plaintiff explain its written basis, in either the parent or the CIP application.

The '448 parent application discusses payment only in the context of the encrypted identity information program (the "EI sub-program" as described in the '797 Patent) and only in the context of affirmatively causing a payment to be made. According to the parent application, "the central program causes the EI program to execute for providing an encrypted identity of the user" and "the central computer may use the encryption result, if it being correct, from the EI program as a user authori[z]ation for payment to be made, from a user account for obtaining network services of software products or the like." Skaff Decl. Ex. E, '448 Application, at 4-5. However, there is nothing in the original disclosure which conveys with reasonable clarity to one skilled in the art that the EI program would *not*, upon a correct encryption result, use the "authorization for payment to be made." Moreover, there is nothing in the original disclosure that would convey that access to the protected software though the AS subprogram would not – or would, for that matter – require a payment. Payment as discussed in the parent application is associated only with validating a user's identity in the EI sub-program, not with access or non-access to software in the AS sub-program. Accordingly, the Court finds that the amendment and the subsequent no-charge claims at issue here lack a written basis in the parent application.

2. The 1998 CIP Application.

Although the 1998 application purports to be a continuation-in-part of the parent, in fact, it contains mostly cosmetic changes from the 1995 application. *See* Decl. Ex. B (line-by-line comparison of the '448 application and '276 application). As such, it too fails to provide support sufficient to satisfy the written

description requirement in 35 U.S.C. § 112.

Like the parent application, the ‘276 application discusses payment *only* in the context of the EI sub-program:

The EI sub-program is for providing identity information (an encrypted identity) of its rightful owner for accessing a network central computer to obtain services or software products or alike in which a secure operation on a user account of that owner for payment therfor [sic] involved.

. . . the central computer may use the encryption result received from the EI subprogram, if it being correct, as a user authorisation [sic] for payment to be made, from a user account for obtaining services or software products or the like.

Skaff Suppl. Decl. Ex. 1, at 1-2, 4. As with the parent application, the disclosure of payment using the EI sub-program does not support the limitation of not charging for access to the protected software using the AS sub-program. In fact, as in the parent application, there is no mention in the ‘276 application of charging or not charging with respect to the AS sub-program.

There is no support for the 2001 amendment that added the no-charge limitation to the claims at issue in this motion. As such, the Court finds that ‘797 Patent fails the written description requirement because its disclosure does not “describe an invention . . . in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention . . . with all its claimed limitations.” *Lockwood v. American Airlines*,

107 F.3d 1565, 1572 (Fed. Cir. 1997).

3. Implied Limitations.

Plaintiff does not dispute that the no-charge limitation is not expressly provided for in either the parent or the CIP application. Instead, plaintiff argues that the no-charge limitation is inherent or implicit in the embodiments disclosed in the specification. The Court disagrees.

In order for a disclosure to be inherent, “the missing descriptive matter must *necessarily* be present in the [original] application’s specification such that one skilled in the art would recognize such a disclosure.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) (emphasis added). The Federal Circuit has said that vague references or obvious variants of that which is disclosed in the specification are insufficient. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997). Moreover, “[w]hile the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification.” *Id.* at 1572.

Here, none of the embodiments contains any discussion of whether an electronic commerce transaction takes place when providing access to protected software in the AS sub-program, much less explicitly disclose or inherently require not charging in connection with such access. The embodiments discussed in the specification illustrate different configurations of the system’s three sub-programs: (1) the “EI sub-program” for providing encrypted identity information; (2) the “AC sub-program” for authenticating a computer; and (3) the “AS

sub-program” for authorizing access or use of protected software. The first embodiment discloses that the three sub-programs are contained within the central program. In the second embodiment, the AC sub-program is removed and the AS sub-program and EI sub-program are separate programs on the same computer. The third embodiment discloses the same configuration as the second embodiment, except that the AS and EI sub-program use the same encryption algorithm, “thereby preventing the AS sub-program from unauthorised [sic] copying. ‘797 Patent at 2:22-24.

Plaintiff contends that the first embodiment’s initialization process of the AC sub-program “implicitly disclos[es]” that the “first embodiment requires no payment.” Docket No. 101 at 10. The process involves the following steps: the EI sub-program is used to send identity information to the central computer; the AC sub-program then requests an encrypted command from the central computer; if the EI information is correct, the central computer will send an encrypted comment to the AC subprogram to begin initialization. This generic series of steps implies nothing, one way or the other, about not-charging for access. The inclusion of a no-charge limitation is not “necessary” to the invention; the invention would function just the same without the limitation. *See Tronzo*, 156 F.3d at 1159. The fact that payment is not mentioned here, without more, does not imply that payment is *necessarily* not required, particularly in the face of language elsewhere in the parent application disclosing that payment would or could be part of the EI sub-program process. *Id.*

The second and third embodiments are similarly

silent as to non-payment for software access in the AS sub-program. The second embodiment differs from the first embodiment's disclosure only in that the AS and EI sub-programs are independent programs. But the functioning of those subprograms does not change; i.e., the EI sub-program continues to contemplate payment as part of its process and the AS sub-program makes no mention of payment. The third embodiment discloses an AS sub-program with the same encryption algorithm as the EI sub-program. In plaintiff's view, this embodiment therefore discloses "an EI sub-program equivalent but without its payment capability, i.e., the AS sub-program." Docket No. 101 at 6. The Court disagrees. That these sub-programs are similar or equivalent in terms of the encryption algorithm says nothing about whether they have similar or different payment requirements or whether that requirement is "necessarily" part of the invention. *Tronzo*, 156 F.3d at 1159. There is nothing inherent or implied in the algorithm equivalence to add any support for the no-charge limitation at issue.

Relying on *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344 (Fed. Cir. 2012), plaintiff also argues that because the no-charge limitation is a negative limitation that narrowed his claims, the limitation is necessarily supported by the original application regardless of what the specification discloses. Plaintiff's reliance on *Santarus* is misplaced. While *Santarus* instructs that patent applicants are entitled to narrow their claims by amendment, the Federal Circuit still required support for the narrowed limitation in the original specification. *Id.* at 1350-51. In *Santarus*, the negative limitation at issue – the exclusion of the compound sucralfate – was adequately supported because the excluded

compound was already described in the specification as a less advantageous alternative and its disadvantages were listed. *Id.* 1351. By contrast, here plaintiff's relevant applications and specification fail to disclose anything supporting or discouraging a no-charge limitation. Accordingly, even assuming the no-charge limitation was merely a narrowing limitation, there is no written support of the kind the Federal Circuit approved in *Santarus* to support plaintiff's proposed narrowing.

In sum, the Court finds no support for the no-charge limitation in either the parent or CIP application, and finds that the limitation is neither inherent in the specification nor is it a permissive narrowing. As such, claims 1-5, 13, 16, 17, 20, and 23-26 are invalid for lack of written description. *See Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346 (Fed. Cir. 2000) (compliance with the written description requirement requires that the original application describe the invention claimed in the patent resulting from that application); *Gentry Gallery, Inc. v. Berklinc Corp.*, 134 F.3d 1473, 1479-80 (Fed. Cir. 1998) (invalidating amended claims not supported by the original application).

CONCLUSION

For the foregoing reasons, defendants' motion for summary judgment of invalidity based on lack of written description under 35 U.S.C. § 112 is GRANTED.

IT IS SO ORDERED.

Dated: December 11, 2013

/s/ SUSAN ILLSTON
SUSAN ILLSTON
United States District Judge

APPENDIX C

The United States Court Of Appeals for the Federal Circuit's Order for Denying a Request for Rehearing, case 14-1222, Dated July 16, 2014.

(identical to the Order for Denying in another companion case 14-1223)

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

HO KEUNG TSE,
Plaintiff-Appellant,

v.

**GOOGLE INC., SAMSUNG
TELECOMMUNICATIONS AMERICA LLC, HTC
AMERICA, INC., AND BLOCKBUSTER, INC.,**
Defendants-Appellees.

2014-1222

Appeals from the United States District Court for the
Northern District of California in No.
3:13-cv-00194-SI, Judge Susan Y. Illston.

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

Before PROST, *Chief Judge*, NEWMAN, LOURIE,
LINN, ¹DYK, MOORE, O'MALLEY, REYNA,
WALLACH, TARANTO, CHEN and HUGHES,
Circuit Judges.
PER CURIAM.

ORDER

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

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on September 22, 2014.

September 15, 2014

Date

FOR THE COURT

/s/ Daniel E. O'Toole

Daniel E. O'Toole

Clerk of Court

1 Circuit Judge Linn participated only in the decision on the petition for panel rehearing.