UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SUNGKYUNKWAN UNIVERSITY, RESEARCH AND BUSINESS FOUNDATION, Plaintiff, v. LMI TECHNOLOGIES (USA) INC., Defendant.	Case No. 16-cv-06966-VC **ORDER GRANTING MOTION TO DISMISS** Re: Dkt. Nos. 37, 45

A patent claim that recites a solution to a problem but not the means of achieving it is not drawn to patent-eligible subject matter. *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1244 (Fed. Cir. 2016); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016); *Vehicle Intelligence & Safety LLC v. Mercedes-Benz USA, LLC*, 635 F. App'x 914, 917 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 2390 (2016). It is drawn to an abstraction. Rather than disclose a concrete solution, it seeks to monopolize the very idea of a solution. *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014). Claim 1 of the '639 patent is this kind of claim. The claim's preamble recites the technological context of the invention and its end goal; the first element restates the technological context; and the second element restates the end goal. U.S. Patent No. 7,957,639 (issued June 7, 2011) cl. 1. The method of optimizing exposure on a structured-light 3D camera – the *how* that's nominally the subject of the claimed invention – is absent. *Cf. Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016), *cert. denied*, No. 16-1046, 2017 WL 844031 (U.S. Apr. 17, 2017).

The closest claim 1 comes to disclosing *how* the invention intends to optimize exposure is

its reference to two images generated by a structured-light camera. '639 patent, cl. 1 ("determining automatically an optimal exposure level of the structured light based 3D camera system using said two kinds of images"). But as the patent specification makes clear, the images aren't the subject of the invention – "patterned" images are an inherent part of the prior-art cameras, and "unpatterned" images are just ordinary images. *See id.* col. 1. And the claim's repeated reference to the steps involved in using a structured-light camera adds nothing of substance to the method that's actually being claimed here. *See id.* col. 9, ll. 52-60. Describing the function of the prior-art cameras situates the claimed invention in the technological environment in which it operates, but it doesn't explain the invention itself. *See Bilski v. Kappos*, 561 U.S. 593, 610 (2010).

The overall result is to place the full weight of patentability on the claim's use of the word "using." *See* '639 patent, cl. 1 ("determining automatically an optimal exposure level . . . using said two kinds of images"). But whatever method might be encompassed by the idea of "using" patterned and unpatterned images, claim 1 doesn't disclose it. And although the University calls for claim construction, it hasn't articulated – or even attempted to articulate, either in its briefing or at oral argument – a limiting construction that would rectify the problem its drafting has created. Opp. (Dkt. No. 42) at 5, 8, 17-18. By all appearances, then, the only effect of the word "using" is to disclose the starting point of a method the claim doesn't explain: "Using" two images, you get an optimal exposure. "Using" certain inputs, you get a certain result. This is not enough to make claim 1 concrete. *Cf. Papst Licensing GmbH & Co. KG v. Xilinx Inc.*, 193 F. Supp. 3d 1069, 1087 (N.D. Cal. 2016), *aff'd*, No. 2016-2323, 2017 WL 1337298 (Fed. Cir. Apr. 12, 2017). A claim cannot recite inputs and end result, then claim everything in between. *Cf. Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016).

It bears noting that the patent specification does teach the steps involved in optimizing exposure on a structured-light camera. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). But the claim at issue in this litigation doesn't claim these steps, and again, the University hasn't even tried to offer a limiting construction to somehow import the specification's

teachings into the asserted claim. *See Alice*, 134 S. Ct. at 2355. It's also doubtful that claim construction would make practical sense in any event. To the extent the University wishes to rely on the language of the specification, it isn't inviting construction of claim 1 so much as dismissal with leave to replead under a patent claim that actually recites the specification. Indeed, any other claim of the '639 patent would be well-suited to the task, as all other claims depend from claim 1 and recite, at some level, the method the specification teaches.

The University seems to suggest that claim construction is necessary to tee up an indefiniteness challenge. *See* Opp. at 17-18. But this begs the question. Although indefiniteness might be one vehicle for challenging claims of this kind, there's no reason to delay dismissal if claim overbreadth presents a patentability problem that a *Markman* hearing can't fix. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1349 (Fed. Cir. 2014).

Finally, at oral argument counsel for the University made vague reference to the fact that the '639 patent is translated from a Korean patent, as if to suggest that some concrete aspect of claim 1 was lost in translation. If that's true, it's difficult to understand how it helps the University, because it's the United States patent that the University is asserting.

The motion to dismiss is granted. If the University believes in good faith that it can assert some other claim of the '639 patent against LMI, it may file an amended complaint within 21 days of this ruling. If an amended complaint is not filed by that time, dismissal will be with prejudice. The parties' joint motion to stay deadlines is denied as moot.

IT IS SO ORDERED.

Dated: May 3, 2017

VINCE CHHABRIA
United States District Judge