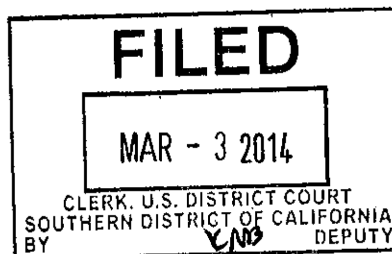

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

PACING TECHNOLOGIES, LLC, Plaintiff, vs. GARMIN INTERNATIONAL, INC; and GARMIN USA, INC., Defendants.	CASE NO. 12-CV-1067-BEN (WMC) **SEALED ORDER:** **(1) GRANTING MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT; AND** **(2) DENYING AS MOOT MOTION FOR SUMMARY JUDGMENT OF INVALIDITY** [Docket Nos. 144, 147]

Before this Court are two motions for summary judgement filed by Defendants Garmin International, Inc. and Garmin USA, Inc. (collectively, "Garmin"). In the first motion, Garmin moves for summary judgment of noninfringment. (Docket No. 144). If the Court does not find that Garmin's products are noninfringing, Garmin requests that this Court find that the asserted patent is invalid based upon prior art. (Docket No. 147). For the reasons stated below, this Court **GRANTS** summary judgment of noninfringement. The Court therefore **DENIES AS MOOT** the motion for summary judgment of invalidity in the alternative.

I. BACKGROUND

A. The Patent and Procedural History

On January 24, 2012, the U.S. Patent Office approved an application for a

"System and Method for Pacing Repetitive Motion Activities," and assigned U.S. Patent No. 8,101,843 (the '843 Patent). (U.S. Patent No. 8,101,843, Am. Compl. Ex. A (filed Nov. 1, 2010) [hereinafter '843 Patent]). The '843 patent lists William D. Turner as the inventor, and Plaintiff Pacing Technologies, LLC ("Pacing") as the assignee. ('843 Patent, at [73], [75]).

As described in the abstract of the '843 Patent, the patent discloses "a system and method that allows users to customize audible and visible signals, such as music or video, to maintain a pre-determined or specified pace or to achieve a new pace in repetitive motion activities such as, but not limited to, running, walking, swimming, cycling, aerobics, and the like." ('843 Patent, at [57]).

Claim 25 of the patent asserts:

> A repetitive motion pacing system for pacing a user comprising:
>
> a website adapted to allowing the user to pre-select from a set of user-selectable activity types an activity they wish to perform and entering one or more target tempo or target pace values corresponding to the activity;
>
> a data storage and playback device; and
>
> a communications device adapted to transferring data related to the pre-selected activity or the target tempo or the target pace values between the web site and the data storage and playback device.

('843 Patent, at 19:27-37).

Pacing has produced an iPhone application covered by the patent entitled "PaceDJ," which it describes as "designed to help runners, walkers and cyclists synchronize their pace with the tempo of songs." (Am. Compl. ¶ 14). Garmin produces accused products, including fitness watches.

Pacing filed suit against Garmin on May 1, 2012, alleging infringement of the '843 patent. (Docket No. 1). Pacing's Amended Complaint was filed on July 26, 2012. (Docket No. 21). This Court issued a Claim Construction Order on October 15, 2013. (Docket No. 135). Pacing's final infringement contentions assert that certain Garmin devices infringe independent claim 25 of the '843 patent, and dependent claims 26-28 and 32-33 of the '843 patent. (Resp. to Statement of Undisputed Facts ¶ A.2). Garmin

filed the motions for summary judgment on December 9, 2013.

B. The Accused Products

Pacing alleges that systems using certain GPS fitness products sold by Garmin infringe its patent. (*Id.* ¶ A.1). Two features of those products are relevant to the noninfringement summary judgment motion.[1]

First, Pacing alleges infringement based, in part, upon the fact that the fitness devices can be used to present steps of a workout program. Specifically, the system allows a user to go onto a website and enter information about the type of workout they want to do. The user can create a step in the workout program by setting a type (ex: warm-up) and a duration (ex: minutes or distance). They can also enter a target value or goal for the step (ex: strides per minute or heart rate). For example, a user might program a 30-second warmup at 40 strides per minute, followed by a one-minute interval at 50-70 strides per minute, etc.

This program can then be downloaded onto a fitness device, such as a watch. When the user begins the workout, the watch will display the type of step (ex: warm-up), the duration, and the target on the watch. The watch can count down the duration remaining, display the user's actual pace, and present a message indicating if the user is in the target range. For instance, the screen can display to the user the fact that a 30-second warm-up step was programmed, that the target is 40 strides per minute, and count down thirty seconds. It can tell the user what their pace is, and whether this is in the desired range. After that step is done, it proceeds to the next programmed step.

Second, Pacing raises allegations concerning the "virtual partner" feature. This feature uses two icons, one representing the user, and other representing someone running at the target rate. The virtual partner is programmed to look like it is running

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[1]Except as otherwise noted, the description of capabilities is drawn from Pacing's Final Infringement Contentions, Garmin's Statement of Undisputed Facts, Pacing's Responses to Defendant's Statement of Undisputed Facts, and repeated representations made in the briefing and at oral argument. At no point did Pacing point to a factual dispute regarding the operation of the devices. Instead, the parties dispute whether the admitted features infringe the patent.

or cycling, but the animation is the same regardless of the target rate. (Fyfe Expert Report, Wu Decl., Ex. 3 ¶¶ 59-63). The user can enter a target rate. The virtual partner feature then presents a visual representation of the user's current pace/speed compared to the goal pace/speed. If the user's pace/speed is faster than that rate, the user's icon is in front. If he or she is behind, the virtual partner icon is in front.

II. MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT

A. Legal Standard

"After claim construction, the next step in an infringement analysis is comparing the properly construed claims with the allegedly infringing devices." *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330 (Fed. Cir. 2001). Literal infringement occurs only "when every limitation recited in the claim appears in the accused device, i.e., when the properly construed claim reads on the accused device exactly." *Id.* at 1331 (internal quotation marks omitted).

If literal infringement is absent, the patentee may seek infringement under the doctrine of equivalents, but it may not use the doctrine to vitiate claim terms. *See Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005). The essential inquiry underlying the doctrine of equivalents is whether the accused product or process contains each element either as claimed or as an equivalent to the element. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997). The test for whether an element in the alleged infringer's product or process is equivalent to a claimed element is whether the differences between the two are insubstantial to one of ordinary skill in the art. *Amgen Inc. v. F. Hoffman-La Roche, Ltd.*, 580 F.3d 1340, 1382 (Fed. Cir. 2009).

Garmin's summary judgment burden "may be discharged by 'showing'—that is, pointing out to the district court—that there is an absence of evidence to support the non-moving party's case." *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). Summary judgment will not lie if there is a genuine dispute about a material fact, such that a "reasonable jury could return a verdict for the nonmoving party." *Anderson v.*

Liberty Lobby, Inc., 477 U.S. 242, 248 (1986).

A determination of noninfringement, either literal or under the doctrine of equivalents, is a question of fact. *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1312 (Fed. Cir. 2009). Summary judgment of noninfringement is appropriate if, after resolving reasonable factual inferences in favor of the patentee, this Court concludes that no reasonable jury could find infringement. *See id.*

B. Discussion

The parties dispute whether or not the Garmin watches are "playback devices," as the term is used in the '843 Patent and construed by this Court's Claim Construction Order. The parties do not raise factual disputes about the functioning of the features in question. Rather, they dispute whether the features fall within the patent, as interpreted by this Court as a matter of law.

Essentially, the parties are asking this Court to engage in additional claim construction to determine whether the patent may be construed to cover the accused features. Pacing presented modified infringement contentions after this Court issued the Claim Construction Order. The contentions raised new issues that had not previously been presented to this Court, and which accordingly were not specifically addressed in the Claim Construction Order.

I. "Playback device" as Construed by this Court

This Court has construed the term "playback device" to mean a "device capable of playing audio, video, or a visible signal." (Claim Const. Order at 10).

The Court addressed what it meant to "play" something. The Court specifically rejected the idea that a device could simply present or display stored information. The Court stated that presenting information for an instant, or presenting an image that does not disappear, does not "play" the image. Something that is "played" in this sense has multiple components, like multiple images or beats. The Court rejected a construction that would cover a watch that displays the time. The Court said that something that

displayed the time or repeated back the information entered would not "play" the information.

The Court rejected the argument that the device must play back prerecorded audio or visual material. As used in the claim and specifications, the data storage and playback device generates output in response to user-provided inputs. The information is played "back" in the sense that the output is based on information that was input into the system. The Court found that it was not necessary to narrowly read the patent to require that the files be pre-existing, rather than created from input. As an example, the Court said that a system that took in information and generated a series of light pulses would be "playing" the information.

ii. Displaying the Workout

Pacing argues that by displaying the workout steps in succession, Garmin's watches "play" the workout. They point out that the watch displays each step, can do a countdown, and "play" information about when each step is complete. (Opp'n to MSJ of Noninfringement (Opp'n) at 5). Pacing argues that the fitness watches do not just repeat back the information, and instead present aspects that did not exist when the information was entered or displayed on the user's computer. (*Id.* at 4-5). Pacing points out that the fitness watches have to read a data file and determine that the duration of a step has elapsed. (*Id.* at 5, 10). It argues that, unlike a watch that changes the display after a certain number of seconds, these watches use user-provided information to know when to change the display and play the next step. (*Id.* at 11).

Garmin contends that this feature simply repeats back or displays the information entered, like a watch displaying the time. (MSJ of Noninfringement (Mot.) at 7). They argue that displaying the information for a certain duration is like the watch displaying a time for a minute, then displaying the next time. (*Id.* at 8).

iii. Virtual Partner

Pacing first argues that the legs or wheels of the icons move. (Opp'n at 11). Garmin emphasizes that the virtual partner icon's animated rate of motion is the same

regardless of the target speed set by the user. (Mot. at 10).

Pacing also argues that the feature requires user input and displays output by showing the relative positions of the virtual partner and an icon representing the user by comparing the goal and the actual pace. (Opp'n at 11-12). Pacing argues that this means that this output is based upon information used in the system. (*Id.*)

iv. Garmin's Devices Do Not Play Back the Relevant Information Within the Scope of the Patent

The independent claim asserted is directed to a "repetitive motion pacing system for pacing a user." (Claim 25). This Court has construed the preamble as limiting, and found that it requires that the system could actually be used for pacing. The term was construed to mean "a system for providing a sensible output for setting the pace or rate of movement of a user in performing a repetitive motion activity." (Claim Const. Order at 15-16). It was in this context that the Court interpreted "playback device."

In earlier arguments to this Court, the parties discussed the use of playback devices to help a user set his or her pace during a repetitive motion activity, such as running. For instance, the device might play a song with a certain beat or present a series of light flashes to help the user match his or her repetitions to a target pace or rate. The point of the '843 Patent is a system capable of pacing a user and helping a user match a certain pace. A user is supposed to go to a website to enter target information or make selections that generate certain targets, transfer information, and have pace information played back to the user in such a way that the user can use it to set his or her pace. What was being "played" by the device was the target pace information, because the point of the claim was that the device would generate a sensible output from the transferred pace information to help the user to perform the activity at the desired rate.

a. Playing the Steps of a Program Does Not Make the Accused Products "Playback Devices"

Pacing now seeks to apply the construction of "playback device" to a different

situation. It attempts to read the patent to cover a device that presents the steps of a program, where the exact output is affected by the target pace (ex: displaying a message saying the user is below pace by comparing actual pace to the target), but which is not actually "playing" the pace itself.

Separated from context, this Court's discussion about "playing" and "back" in its construction of "playback device" might allow the term to be stretched to cover a device that "plays" a program of workout steps. However, in the context of this patent, for a device to be a "playback device" within the meaning of the patent, it must not only play information back, it must play back a certain kind of information. Although Pacing found it notable that this Court did not specify whether the output could include the user-provided inputs, this aspect of a "playback device" was not addressed at length in the Claim Construction Order because it was not necessary at the time. It is obvious from the circumstances that a device that merely plays back a program does not fit within the patent. To be a playback device as envisioned in the patent, the device must play back the pace information.

b. The Relevant Information Is Not "Played" When the Workout Is Displayed

The pace information is presented by the accused products when the workout is displayed, but it is not "played" within the meaning of the patent. The devices repeat back or display the pace input or selections, and may state a succession of targets, but they do not "play" the target tempo or pace information. It does not "play" that information as audio, video, or visible signals. Using the information to generate a momentary message or beep to let the user know they are not moving at the desired pace similarly does not "play" the pace.

c. The Virtual Partner Feature Does Not "Play" the Relevant Information

Similarly, the virtual partner feature does not make Garmin products "playback devices." Although the animated virtual partner moves, it does so at a constant rate

unrelated to user input. This animation alone does not play back the information. The relative position of the figures does change based upon a combination of user inputs and real-time information. However, this is merely an animated version of a notification that the user is not on his or her set pace. Although this might be a blunt instrument to allow the user to adjust their speed up or down, it does not allow the user to set their activity to a specific rate. The feature uses the inputs, but it does not actually "play" the pace target.

v. Conclusion

Pacing asserts that there are factual disputes about whether the accused devices merely repeat back user input. (Opp'n at 4). However, Pacing presented no factual disputes about what information is entered into the system or what information is presented to the user, and how. The undisputed facts about the operation of the watches permit this Court to conclude as a matter of law that the watches cannot be "playback devices" within the meaning of the patent.

As the accused Garmin products are not "playback devices" within the meaning of the patent, Pacing cannot show that each element of the patent has been met. There has been no showing that the devices are infringing under the doctrine of equivalents. Cursory statements that a device infringes under the doctrine of equivalents because there are insubstantial differences will not withstand summary judgment. *See Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1365-66 (Fed. Cir. 2007). Furthermore, it is apparent to this Court that the differences between the Garmin devices and the claimed elements are not "insubstantial to one of ordinary skill in the art." *See Amgen, Inc.*, 580 F.3d at 1382. Indeed, expansion of the patent to include the Garmin devices would fundamentally alter the patent.

The Motion for Summary Judgment of Noninfringement is therefore **GRANTED.**

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III. MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

As this Court has granted Garmin's Motion for Summary Judgment based on infringement, the Motion for Summary Judgment of Invalidity is **DENIED AS MOOT**.

IT IS SO ORDERED.

Date: 3/3, 2014

HON. ROGER T. BENITEZ
United States District Judge