

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF GEORGIA  
ATLANTA DIVISION

BARCO, N.V. and BARCO, INC.,

Plaintiffs,

v.

EIZO CORPORATION and EIZO,  
INC.,

Defendants.

CIVIL ACTION FILE

NUMBER 1:11-cv-2964-TCB

**ORDER**

Currently before the Court is a motion by Defendants Eizo Corporation and Eizo, Inc. (collectively, “Eizo”) for partial summary judgment [90].

**I. Background**

This case concerns Plaintiffs Barco, N.V. and Barco, Inc.’s (collectively, “Barco”) U.S. Patent No. RE43,707 (“the ’707 Patent”) and its predecessor, U.S. Patent No. 7,639,849 (“the ’849 Patent”). The ’707 Patent describes a system and method for increasing visibility of a displayed image on electronic display devices.

On May 23, 2005, Barco filed U.S. Patent Application No. 11/134,522. The first claim of the application concerned a method of image processing and described “for each of a plurality of pixels of a display, obtaining a measure of a light-output response of at least a portion of the pixel at each of a plurality of driving levels.” [90-11] at 58. This method, referred to as the “Measurement Limitation,” is repeated throughout the patent application as part of multiple claims. After reciting the Measurement Limitation, the first claim went on to describe a process by which data from the output-measures would be collected and displayed. A later claim in the application concerned a method for storing the output-measures, and it too contained the Measurement Limitation:

33. An image processing apparatus comprising: an array of storage elements configured to store, for each of a plurality of pixels of a display, a measure of light-output response of at least a portion of the pixel at each of a plurality of driving levels . . . .

*Id.* at 62.

On February 13, 2009, the patent examiner rejected the application as obvious in view of prior art references, specifically U.S.

Patent No. 5,706,816 (“Mochizuki”) and U.S. Patent No. 5,621,821

(“Pearman”). The patent examiner stated:

Regarding claim 1, Mochizuki discloses a method of image processing, said method comprising: for each of a plurality of pixels of a display . . . obtaining a measure of a light-output response of at least a portion of the pixel at each of a plurality of driving levels.

. . .

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use [the methods described in claim 1] . . . because Pearman provides Mochizuki with an improved system.

[90-12] at 22–23. The patent examiner further stated that “[c]laim 33 is similarly analyzed as claim 1 above,” and thus rejected it for obviousness as well. *Id.* at 26.

On May 20, 2009, Barco responded to the patent examiner by arguing that the application was not obvious because Mochizuki did not disclose the Measurement Limitation. Specifically, Barco stated the following with regard to claim 1:

Claim 1 recites obtaining a measure of a light-output response of at least a portion of a pixel of a display at each of a plurality of driving levels.

While Mochizuki discloses a display . . . the reference fails to disclose obtaining a measure of a response of any pixel of the CRT at a plurality of driving levels. The portions of

Mochizuki that are cited in the Office Action describe light outputted at voxels of an ultrasound beam, rather than a response of pixels of the CRT . . . . Pearman also fails to disclose at least this feature of claim 1.

*Id.* at 59 (emphasis in original). Barco's response concerning claim 33 similarly focused on the limitation of obtaining light-output responses at a plurality of driving levels—in other words, the

Measurement Limitation:

Claim 33 recites an array of storage element configured to store, for each of a plurality of pixels of a display, a measure of a light-output response of at least a portion of the pixel at each of a plurality of driving levels. Mochizuki fails to disclose storage of a measure of a response of any pixel of the CRT at a plurality of driving levels. Pearman also fails to disclose such a feature.

*Id.* After receiving Barco's response, the patent examiner withdrew the obviousness objections and issued a notice of allowance, and the '849 Patent was issued on December 29, 2009.

On September 2, 2011, Barco filed this action, alleging that Eizo infringed certain claims of the '849 Patent [1]. On December 28, Barco filed a broadening reissue application, which sought to add additional claims to the '849 Patent. This case was stayed while the reissue application was pending [50].

On October 2, 2012, the U.S. Patent and Trademark Office granted the reissue application, and issued a new patent—the '707 Patent. Barco surrendered the '849 Patent upon issuance of the '707 Patent. Thereafter Barco and Eizo engaged in multiple rounds of *inter partes* review and *ex parte* reexamination of the '707 Patent, with the '707 Patent ultimately emerging with 120 surviving claims. *See* [90-9] at 42–43.

With the litigation stay lifted, Barco filed an amended complaint based on the remaining claims in the '707 Patent [76]. Eizo now asserts in its motion for partial summary judgment that certain claims in the '707 Patent violate the “recapture rule” and are thus invalid as a matter of law.

## **II. Discussion**

### **A. Summary Judgment Standard**

Summary judgment is appropriate when “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” FED. R. CIV. P. 56(a). There is a “genuine” dispute as to a material fact if “the evidence is such that a reasonable jury could

return a verdict for the nonmoving party.” *FindWhat Investor Grp. v. FindWhat.com*, 658 F.3d 1282, 1307 (11th Cir. 2011) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). In making this determination, however, “a court may not weigh conflicting evidence or make credibility determinations of its own.” *Id.* Instead, the court must “view all of the evidence in the light most favorable to the nonmoving party and draw all reasonable inferences in that party’s favor.” *Id.*

“The moving party bears the initial burden of demonstrating the absence of a genuine dispute of material fact.” *Id.* (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986)). If the nonmoving party would have the burden of proof at trial, there are two ways for the moving party to satisfy this initial burden. *United States v. Four Parcels of Real Prop.*, 941 F.2d 1428, 1437-38 (11th Cir. 1991). The first is to produce “affirmative evidence demonstrating that the nonmoving party will be unable to prove its case at trial.” *Id.* at 1438 (citing *Celotex*, 477 U.S. at 324). The second is to show that “there is an absence of evidence to support the nonmoving party’s case.” *Id.* (quoting *Celotex*, 477 U.S. at 323).

If the moving party satisfies its burden by either method, the burden shifts to the nonmoving party to show that a genuine issue remains for trial. *Id.* At this point, the nonmoving party must “go beyond the pleadings,’ and by its own affidavits, or by ‘depositions, answers to interrogatories, and admissions on file,’ designate specific facts showing that there is a genuine issue for trial.” *Jeffery v. Sarasota White Sox, Inc.*, 64 F.3d 590, 593-94 (11th Cir. 1995) (quoting *Celotex*, 477 U.S. at 324).

### **B. The Recapture Rule**

The recapture rule deals with the “deliberate surrender of a claim to certain subject matter.” *Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1372–73 (Fed. Cir. 2006). The rule “prevents a patentee from regaining, through reissue, subject matter that was surrendered during prosecution of the original patent in an effort to obtain allowance of the original claims.” *Id.* at 1373 (citing *Pannu v. Storz Inst., Inc.*, 258 F.3d 1366, 1371 (Fed. Cir. 2001), and *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479–80 (Fed. Cir. 1998)). The recapture rule is applied in a three-step process:

(1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine 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.

*Medtronic*, 465 F.3d at 1373.

With regard to the first step, “[a] reissue claim that does not include a limitation present in the original patent [claim] is broader in that respect.” *Hester*, 142 F.3d at 1480.

In the second step, the Court must analyze whether subject matter was deliberately surrendered during the initial patent application. Ordinarily this can be done by comparing the original application with the patent that was ultimately issued. *See Pannu*, 258 F.3d at 1371. However, an amendment to the application is not necessary because “a surrender can occur through arguments alone.” *Hester*, 142 F.3d at 1482; *see also Medtronic*, 465 F.3d at 1373 (same). Moreover, just because the patent differs from the original application does not mean that subject matter was deliberately surrendered. “When we consider whether subject matter was ‘surrendered,’ we look at

whether there was a deliberate withdrawal or amendment in order to secure the patent.” *Medtronic*, 465 F.3d at 1375. In the context of surrender through argument, this means that the patentee “must clearly and unmistakably argue that his invention does not cover certain subject matter to overcome an examiner’s rejection based on prior art.” *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 602 F.3d 1306, 1314 (Fed. Cir. 2010); *see also Medtronic*, 465 F.3d at 1376. If the Court is satisfied that surrender occurred, it must next determine “whether the surrendered subject matter has crept back into the asserted reissue claims.” *Hester*, 142 F.3d at 1482.

Finally, in the third step, the Court must analyze whether additional limitations constrain the claims in such a way that the reissue claims do not truly recapture surrendered subject matter. This means that the additional limitations must relate to the surrendered subject matter, and must materially narrow the claim. *See Pannu*, 258 F.3d at 1372; *see also In re Mostafazadeh*, 643 F.3d 1353, 1361 (Fed. Cir. 2011) (“The limitation may be modified . . . so long as it continues to materially narrow the claim scope relative to the surrendered subject

matter such that the surrendered subject matter is not entirely or substantially recaptured.”).

“Determining whether the claims of a reissued patent violate [the recapture rule] is a question of law.” *Medtronic*, 465 F.3d at 1373.

**C. Claims 64–66, 68–76, 80, 91, 98–99, 117, 120, 122, and 128–129 of the ’707 Patent**

Eizo first argues that claims 64–66, 68–76, 80, 91, 98–99, 117, 120, 122, and 128–129 of the ’707 Patent violate the recapture rule because the Measurement Limitation is “completely absent” from those claims. [90-1] at 16. If those claims violate the recapture rule then they are invalid as a matter of law. *Hester*, 142 F.3d at 1484. In response, Barco argues only that no deliberate surrender of subject matter occurred during the patent application process, meaning the recapture rule is inapplicable. [96] at 12.

**1. ’707 Patent Claims Are Broader Than ’849 Patent**

With regard to the first step of the recapture rule analysis, it is plain that the claims identified by Eizo, all of which did not appear in the ’849 Patent, do not disclose the Measurement Limitation. *See* ’707

Patent, [90-9] at 20–39,<sup>1</sup> 42–43. These claims are all dependent, directly or indirectly, on claims 62 and 98. Claim 62 states:

62. An image processing apparatus comprising:  
an array of logic elements configured to generate a display signal based on a map and an image signal that represents at least one physical and tangible object,  
wherein the display signal is configured to cause a display to depict a display image of the at least one physical and tangible object, and  
wherein the map comprises correction data configured to produce a desired non-uniform light-output response.

*Id.* at 37. This contrasts with, for example, claims 58 and 60, where the mention of “data” or a “map” is accompanied by the familiar

Measurement Limitation:

58. A method of processing an image for a display, the display comprising a plurality of pixels, said method comprising: . . . a modified map . . . **wherein the modified map is based on a measure of light-output response of at least a portion of each pixel in at least a portion of the plurality of pixels at a plurality of driving levels.**

. . .

60. An image processing apparatus comprising: an array of storage elements configured to store, for each pixel in at least a portion of a plurality of pixels of a display, **data representative of a light-output response of at least a portion of the pixel at a plurality of driving levels . . .**

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<sup>1</sup> The particular claims in question can be found at the following internal page citations for the patent: 36:11-22, 36:26-63, 37:7-11, 37:45-46, and 38:5-19.

*Id.* (emphasis added). This omission is repeated in independent claim 98. *Id.* at 38.<sup>2</sup>

To be clear, the '707 Patent is not completely devoid of the Measurement Limitation. It appears in claims 1, 34, 36 and 37, which were all present in the '849 Patent, as well as in new claims 50, 58, and 60. *See id.* at 34–36. The fact that the Measurement Limitation appeared in some new claims, but not in claims 62 or 98, makes that omission stark. By omitting the Measurement Limitation, the claims in question could encapsulate the subject matter disclosed in Mochizuki, and are thus broader than the subject matter approved in the '849 Patent.

## **2. Barco Surrendered Subject Matter to Secure '849 Patent**

With regard to the second step of the recapture-rule analysis, Barco argues that it did not surrender any subject matter, but instead sought a reissuance because of an error by the patent examiner. In

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<sup>2</sup> Claim 98 was amended during the patent reexamination process, but the alterations did not include the addition of the Measurement Limitation or any similar limitation. *See id.* at 42.

support, Barco relies on one of the primary purposes cited for reissuing a patent: correcting the “inadvertence or mistake” of a patent attorney who does not fully comprehend the application. *See Medtronic*, 465 F.3d at 1372 (“[A]n attorney’s failure to appreciate the full scope of the invention is one of the most common sources of defects in patents,’ and is generally sufficient to justify reissuing a patent.”) (quoting *In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984)). Reissuance in such cases does not run afoul of the recapture rule because an attorney’s mistake does not constitute the deliberate surrender of subject matter. *Hester*, 142 F.3d at 1479–80. Barco takes this one step further by asserting that it was the patent examiner, rather than Barco’s patent attorney, who had a mistaken belief concerning the subject matter. This means that, according to Barco, the response did not constitute a surrender because it merely “pointed out to the Patent Examiner that he had misread the contents of two prior art references.” [96] at 2.

While inadvertence by a patent attorney can justify a reissuance—and thereby avoid the recapture rule—Barco gives no persuasive reason to extend this protection to inadvertence or mistake by the patent

examiner. In evaluating whether an applicant deliberately surrendered subject matter, it is the actions of the *applicant* that are relevant, and mistake or inadvertence by the patent examiner do not diminish the applicant's actions.

Moreover, the distinction that Barco attempts to portray is merely semantic.<sup>3</sup> Barco's initial application was denied, in part because the patent examiner believed that it covered material that was obvious in light of prior art, specifically Mochizuki and Pearman. Barco's response, regardless of how one characterizes the structure of the argument, conveyed to the patent examiner that the application was distinct from and narrower than Mochizuki and Pearman because of the presence of the Measurement Limitation. In other words, the clear message to the patent examiner was that the subject matter of Barco's application was constrained by the Measurement Limitation, and it was this constraint that would overcome the patent examiner's rejection. Thus, a surrender

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<sup>3</sup> See, e.g., [96] at 16 ("Barco did not argue that its invention did not cover Mochizuki; instead it pointed out that Mochizuki did not even disclose what the Examiner thought it did.").

occurred because there was a “deliberate withdrawal or amendment [by argument] in order to secure the patent.” *Medtronic*, 465 F.3d at 1375.<sup>4</sup>

By omitting the Measurement Limitation in the reissued claims, the surrendered subject matter has “crept back into the asserted reissue claims.” *Hester*, 142 F.3d at 1482.

### **3. Claims Are Not Otherwise Narrowed**

Finally, with regard to the third step of the recapture rule analysis, Barco points to no other ways in which the reissue claims were materially narrowed, and makes no argument—aside from the primary claim that no surrender occurred—that would make the recapture rule inapplicable. As the Court is not aware of any other ways the claims were narrowed, the third step of the recapture rule analysis does not save the claims at issue.

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<sup>4</sup> Barco seeks support from *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984), where the Federal Circuit declined to apply the recapture rule because there was no evidence that there “was in any sense an admission that the scope of [the] claim was not in fact patentable.” That case is distinguishable because the claim limitation in question was based on an attorney’s misunderstanding of the claim, and because approval of the application was not contingent on that limitation. Here, there is no alleged attorney error, and Barco’s arguments to the patent examiner were made for the purpose of overcoming the objection for obviousness.

Accordingly, claims 64–66, 68–76, 80, 91, 98–99, 117, 120, 122, and 128–129 of the ’707 Patent violate the recapture rule and are thus void as a matter of law.

#### **D. Claims 46 and 54 of the ’707 Patent**

Eizo argues that claims 46 and 54 of the ’707 Patent violate the recapture rule because the limitations in those claims are not as strict as the Measurement Limitation. [90-1] at 22. Barco responds that those claims are no broader than the claims in the ’849 Patent. [96] at 23.

##### **1. Claim 46**

Claim 46 of the ’707 Patent is dependent on claim 41, which states, “[a] method of image processing, the method comprising: for each of a plurality of groups of pixels of a display, obtaining corresponding data representative of a light-output response of the group of pixels at each of plurality of driving levels . . . .” [90-9] at 36. Eizo contends that this language is broader than the Measurement Limitation because it substitutes “obtaining **corresponding data representative** of a light-output response” for the previous language of “obtaining **a measure** of a light-output response.” [90-1] at 22 (emphasis added). According to

Eizo, this broadened the claim because data representative of a light-output response “could be obtained using quantitative calculations or estimates rather than direct measurement of the light output response.”

*Id.* at 23.

The Court is not convinced that Eizo had carried its burden of demonstrating that claim 46 is broader than the claims of the '849 Patent. Nearly all of the elements of the Measurement Limitation are present, including that the light-output response would be measured at each of a plurality of driving levels for each pixel. This was the crucial distinction that distinguished the '849 Patent from Mochizuki during the original patent application: Mochizuki “describe[d] light outputted at voxels of an ultrasound beam, rather than a response of pixels of the CRT.” [90-12] at 59 (emphasis in original). The limitations present in claim 41 preserve this distinction. Given that the pivotal elements of the Measurement Limitation remain, and that the modification is quite minor, Eizo’s speculation about what claim 46 could entail, without additional evidence, does not carry the burden necessary for summary judgment.

## 2. Claim 54

Claim 54 of the '707 Patent is dependent on claim 53, which states:

A method of processing an image for a display, the display comprising a plurality of pixels, said method comprising: modifying a map . . . wherein the map is based on a measure of a light-output response of at least a portion of each pixel in at least a portion of the plurality of pixels at each of a plurality of driving levels . . . .

[90-9] at 37. Eizo argues that this language is broader than the Measurement Limitation because it substitutes “at least a portion of each pixel **in at least a portion** of the plurality of pixels” for the previous language of “for **each of a plurality of pixels** of a display.”

[90-1] at 23 (emphasis added). According to Eizo, the Measurement Limitation required measurement of each pixel, whereas claim 53 now requires measurement of only a plurality of those pixels. *Id.*

The Court disagrees with Eizo’s reading of the claim language. When the language is read in full, the requirement to measure “each pixel” within a portion of the plurality of pixels is not materially different from requiring measurement of “each of a plurality of pixels.” Under both limitations, fewer than all of the pixels in the display are

measured, and there is insufficient evidence for the Court to conclude that claim 53 is materially broader than the claims of the '849 Patent.

Moreover, even if there were a material difference in the proportion of pixels measured, such a difference would not be materially related to the subject matter surrendered. Barco argued to the patent examiner that Mochizuki “fail[ed] to disclose obtaining a measure of a response of **any pixel** of the CRT at a plurality of driving levels” and that Mochizuki instead described “light outputted at voxels of an ultrasound beam, rather than a response of pixels of the CRT.” [90-12] at 59 (emphasis altered). This distinction was not based on the exact proportion of pixels measured, and thus any broadening would not be materially related to the surrendered subject matter.

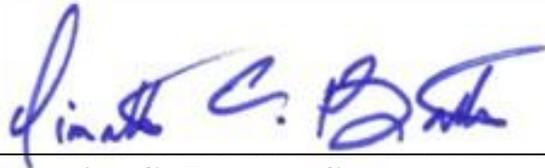
Finally, Eizo argues that the claim is broader because it describes a map that is “based on” a measure of a light-output response rather than requiring “obtaining” a measure of a light-output response. Again, the Court is not persuaded by this argument. The rest of claim 53 describes exactly how the light-output response is measured, and it aligns perfectly with the Measurement Limitation. There is no material

difference based on the language used, meaning Eizo has failed to carry its burden for summary judgment.

### **III. Conclusion**

For the foregoing reasons, Eizo's motion for partial summary judgment [90] is granted with regard to claims 64–66, 68–76, 80, 91, 98–99, 117, 120, 122, and 128–129 of the '707 Patent, but is denied with regard to claims 46 and 54 of the '707 Patent.

IT IS SO ORDERED this 22nd day of November, 2016.

A handwritten signature in blue ink, appearing to read "Timothy C. Batten, Sr.", written over a horizontal line.

Timothy C. Batten, Sr.  
United States District Judge