

Keywords: opinion of counsel; willful infringement; withheld evidence

General: Substantial evidence supports jury's conclusion that defendant willfully infringed plaintiff's patent for multimedia data network, since record shows that at least one important technical document was not supplied to defendant's opinion counsel, since opinion letter cannot negate finding of willful infringement if best information was intentionally withheld from counsel during preparation of opinion, and since evidence therefore supports finding that defendant was not entitled to rely on counsel's opinion of non-infringement.

nCube Corp. v. SeaChange International Inc.
77 U.S.P.Q.2d 1481 (Fed. Cir. 2006)
Decided January 9, 2006

I. Facts

NCube sued SeaChange for patent infringement of U.S. Patent No. 5,805,804, which relates to a method and apparatus for scalable, high bandwidth storage, retrieval, and transportation of multimedia data on a network. In general, the claims relate to an upstream manager and a downstream manager that collectively handle client requests for various services on different networks. In the detailed description, the '804 patent describes a technique of superimposing logical addresses on top of physical addresses in the diverse links of the different networks, thereby facilitating communication between the different networks. However, independent claim 1 does not recite these addresses.

SeaChange sold a system for use in cable TV networks. The system works with a Scientific-Atlanta DNCS component that routes requests for service (e.g., start, stop, rewind, etc.) to a CM, which finds a free transmission channel, assigns the desired program to the free channel, and instructs the client to tune to that channel. However, the SeaChange system apparently does not superimpose logical addresses on top of physical addresses.

The district court interpreted the "upstream manager" of independent claim 1 as not requiring logical addresses. The district court held that SeaChange willfully infringed the '804 patent due to deliberate copying without investigating the '804 patent. The district court also found SeaChange's opinion of counsel to be ineffective to negate the finding of willfulness. Apparently, the opinion of counsel was obtained during the trial and without at least one important document held by SeaChange.

II. Issues

1. Should the "addresses" disclosed in the specification be read into the claim?
2. Is an opinion of counsel ineffective as a defense to willful infringement if evidence is not provided to the counsel?

III. Discussion

1. No. The present court agreed with the district court's interpretation of "Upstream Manager" as "a computer system component that (a) accepts messages from a client bound for services on a server; (b) routes messages from a client to services on a server; and (c) is distinct from the Downstream Manager." In the district court, SeaChange contended that the Upstream Manager must "(d) receive and route all messages from clients that are 'bound for' services, and (e) must do so using only logical, not physical, addresses, of both sender and receiver of a message." The present court agreed with the district court's refusal to adopt SeaChange's further limitations regarding *all* messages and *only logical* addresses. Independent claim 1 does not recite

these limitations, and the specification refers to these limitations with regard to *one embodiment*. Furthermore, the dependent claims 2, 4, 5, and 11 add limitations pertaining to the addressing. Thus, by claim differentiation, it would be redundant to interpret claim 1 as requiring these limitations. Finally, the court cited *Phillips* stating that it is improper to read a limitation into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.

2. Yes. SeaChange relied on an opinion of counsel asserting that SeaChange did not infringe the '804 patent. However, nCube asserted that the opinion was flawed because SeaChange manipulated the information given to counsel to ensure an opinion of non-infringement. The record shows that at least one important technical document was not supplied to SeaChange's opinion counsel. The present court found that if the best information is intentionally withheld from the opinion counsel, then the opinion (e.g., non-infringement) can no longer serve its purpose of negating a finding of willful infringement. As a result, the present court upheld the district court's finding of willfulness.