

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

LEON STAMBLER,)
)
 Plaintiff,)
)
 v.) Civil Action No. 01-065-SLR
)
 RSA SECURITY, INC.,)
 VERISIGN, INC.,)
 OMNISKY CORPORATION,)
)
 Defendants.)

Douglas E. Whitney, Esquire, Maryellen Noreika, Esquire, J.D. Pirnot, Esquire and Philip Bangle, Esquire of Morris, Nichols, Arsht & Tunnell, Wilmington, Delaware. Counsel for Plaintiff. Of Counsel: David S. Shrager, Esquire of Shrager Spivey & Sachs, Philadelphia, Pennsylvania.

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Steven J. Balick, Esquire and John G. Day, Esquire of Ashby & Geddes, Wilmington, Delaware. Of Counsel: Thomas W. Winland, Esquire, Vincent P. Kovalick, Esquire and Matthew DelGiorno, Esquire of Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P., Washington, D.C. Counsel for Defendant VeriSign, Inc.

MEMORANDUM OPINION

Dated: February 20, 2003
Wilmington, Delaware

ROBINSON, Chief Judge

I. INTRODUCTION

On February 2, 2001, plaintiff Leon Stambler ("Stambler") filed this action against defendants RSA Security, Inc. ("RSA Security"), Verisign, Inc. ("Verisign") and Omnisky Corporation ("Omnisky") alleging infringement of certain claims of United States Patent Nos. 5,793,302 (the "'302 patent"), 5,936,541 (the "'541 patent") and 5,974,148 (the "'148 patent) (collectively, the "Stambler patents"). (D.I. 1)

The court has jurisdiction over this matter pursuant to 28 U.S.C. §§ 1331, 1338(a) and 2201(a). Currently before the court is: (1) defendant Verisign's motion for reconsideration of the court's orders denying Verisign's motion for summary judgment of non-infringement of claim 12 of the '302 patent and denying defendants' motion for summary judgment of non-infringement of claim 27 of the '541 patent; (2) defendant Verisign's motion for leave to file a reply brief; and (3) defendant RSA's motion for separate trials. (D.I. 400, 406, 357) For the following reasons, the court shall grant in part and deny in part the motion for reconsideration, deny the motion for leave as moot, and grant the motion for separate trials.

II. BACKGROUND

The Stambler patents, each entitled "Method for Securing Information Relevant to a Transaction," generally relate to a method of authenticating a transaction, document or party to the transaction using known encryption techniques. (D.I. 293, 294, 295) The patented methods enable parties to a transaction to assure the identity of an absent party and the accuracy of information involved in the transaction. (Id.) The patented methods thus provide for secure transactions and prevent fraud. (Id.)

III. DISCUSSION

A. Motion for Reconsideration

On January 29, 2003 the court granted defendants' motions for summary judgment of literal non-infringement of claim 12 of the '302 patent and claim 27 of the '541 patent. (D.I. 372, 375) The court also denied defendants' motions for summary judgement of non-infringement under the doctrine of equivalents for the same claims. Defendants have filed this motion for reconsideration based on the assertion that plaintiff's expert has not advocated a position under the doctrine of equivalents with respect to the claim limitations the court found not literally present in the accused products and services. Thus, according to defendants, plaintiff will be unable to present any

evidence at trial to support a claim of infringement under the doctrine of equivalents.

Plaintiff has agreed that "[b]ased upon the court's claim construction rulings, Mr. Stambler will not present evidence at trial of infringement of claim 12 of the '302 patent." (D.I. 403 at 1) Thus, defendants' motion with respect to claim 12 is granted. Plaintiff is precluded from offering any evidence of infringement under the doctrine of equivalents with respect to claim 12 of the '302 patent.

As to claim 27 of the '541 patent, plaintiff asserts that the expert's report provides a basis for an assertion of infringement under the doctrine of equivalents. The court's opinion stated:

In SSL . . . the digital signature is created only when the certificate is issued and not afterward (i.e., the VAN is only created at the time the credential is issued). Thus, the digital signature (VAN) is created only once - when the digital certificate (credential) is issued, which is prior to the steps in the claimed method. Because the claim requires the digital signature (VAN) to also be created after the certificate (credential) is issued, no reasonable jury could conclude that SSL literally infringes claim 27.

(D.I. 375 at 7)

Plaintiff argues that "[i]t is not the 'previously issued' limitation, however, but rather the 'creating the VAN by coding credential information . . .' limitation in step one of the claim that is literally absent from the accused SSL process under the court's construction." (D.I. 403 at 2) The court agrees. The

key to the court's opinion was that the VAN (or an equivalent) must be created twice to infringe claim 27 - once prior to the recited steps of the claim and again in step one of the claim. Plaintiff's expert provided a theory with respect to an equivalent of the VAN being created after the certificate (credential) issues. Thus, defendants' motion for reconsideration with respect to claim 27 of the '541 patent is denied.

B. Motion for Separate Trials

Defendants have filed a motion for separate trials - one trial as to each defendant. The court finds that in this case (a case with complex technology and numerous accused products as to each defendant) separate trials is appropriate to avoid jury confusion.

The trial, however, shall proceed in three parts. Trial one will cover infringement and damages with respect to defendant RSA. Trial two will cover infringement and damages with respect to defendant Verisign. Trial three will cover validity of the Stambler patents.

The total allotted trial time for **all three** trials will be seventy (70) hours. Unless the parties are able to agree on how to appropriately divide the 70 hours between each trial, the court suggests 24 hours for trial one (12 per side), 24 hours for trial two (12 per side) and 22 hours for trial three (11 per

side). The parties are ordered to appear on **Monday, February 24, 2003 at 8:30 a.m.** in order to discuss any open issues.

V. CONCLUSION

For the reasons stated, the court shall grant in part and deny in part defendants' motion for reconsideration. The court shall also grant defendants' motion for separate trials. An appropriate order shall issue.

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 Defendants.)

O R D E R

At Wilmington, this 20th of February, 2003, consistent with
the opinion issued this same day;

IT IS ORDERED that:

1. Defendants' motion for reconsideration of the court's
orders denying Verisign's motion for summary judgment of non-
infringement of claim 12 of the '302 patent and denying
defendants' motion for summary judgment of non-infringement of
claim 27 of the '541 patent (D.I. 400) is granted with respect to
claim 12 of the '302 patent and denied with respect to claim 27
of the '541 patent.

2. Defendants' motion for leave to file a reply brief
(D.I. 406) is denied as moot.

3. Defendants' motion for separate trials (D.I. 357) is granted. The parties are ordered to appear on **Monday, February 24, 2003 at 8:30 a.m.** to address any open issues.

Sue L. Robinson
United States District Judge