

DISCLOSURE

Definiteness

***Dow Chemical Co. v. Nova Chemicals Corp. (Canada)*, 803 F.3d 620 (Fed. Cir. Aug. 28, 2015)**

While reviewing the district court’s supplemental damages judgment, the Federal Circuit held that “the intervening change in the law of indefiniteness resulting from *Nautilus* provides an exception to the doctrine of law of the case or issue preclusion.”⁶⁹ It therefore reevaluated the indefiniteness of the claims *de novo* under the *Nautilus*⁷⁰ standard (even though it had earlier affirmed that the claims were definite), and ultimately held that the claims were indefinite.⁷¹

First, the court found that claim preclusion did not apply, because a claim for supplemental damages was separate from the claim for the period considered by the jury—the plaintiff must separately prove infringement during each period, and therefore the question of validity arises in each period.⁷²

Next, the court acknowledged that issue preclusion would normally prevent relitigation of issues that had been “resolved in a valid court determination essential to the prior judgement,” such as validity in this case.⁷³ Nevertheless, the court held that it was justified in departing from the law of the case because there had been an intervening change in law that satisfied three well-established conditions: (1) the governing law had indeed been altered, because the Supreme Court changed the standard for definiteness in *Nautilus*; (2) the validity decision sought to be reopened had applied the old law; and (3) the change in law compelled a different result under the facts of the case, as the court proceeded to find.⁷⁴

The claims at issue were directed to ethylene polymer compositions with “a slope of strain hardening coefficient greater than or equal to 1.3.”⁷⁵ The specification provides that the “slope of strain hardening coefficient” (“SHC”) is calculated as follows:

$$\text{SHC} = (\text{slope of strain hardening}) * (I_2)^{0.25}$$

I_2 is the melting index, and well known in the art,⁷⁶ but the plaintiffs complained that the patent does not teach where or how to measure the “slope of strain hardening.”⁷⁷ The patent indicated that the slope should be measured from the material’s tensile curve, but did not include the example Figure 1 that the specification describes.⁷⁸

⁶⁹ *Dow Chem. Co. v. Nova Chems. Corp. (Canada)*, 803 F.3d 620, 624 (Fed. Cir. 2015).

⁷⁰ *Nautilus, Inc. v. Biosig Instruments, Inc.*, 789 F.3d 1335 (2015).

⁷¹ *Dow Chem. Co.*, 803 F.3d at 624.

⁷² *Id.* at 626-27.

⁷³ *Id.* at 627 (emphasis omitted) (quoting *Taylor v. Sturgell*, 553 U.S. 880, 892 (2008)) (internal quotation mark omitted).

⁷⁴ *Id.* at 629-30.

⁷⁵ *Id.* at 624-25 (quoting U.S. Patent No. 5,847,053 col. 15 ll.56-57 (filed Apr. 11, 1997)).

⁷⁶ *Id.* at 631.

⁷⁷ *Id.*

⁷⁸ *Id.* at 633.

Dow's expert testified that a PHOSITA would know to measure the slope at its maximum value.⁷⁹ But the court explained that there are three distinct methods for calculating the slope known in the art—the 10% secant method, the final slope method, and the most linear method—and a fourth method developed by Dow's expert, which each give different results.⁸⁰ The patent did not provide any guidance as to which method to use, and was therefore indefinite.⁸¹ The court compared the case to *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*,⁸² also decided under the new *Nautilus* standard, in which it had held a patent indefinite for failing to specify which of three methods of calculating “molecular weight” to use. It held that “[t]he claims here are even more clearly indefinite than those in *Teva*” because Dow's expert's method “was not even an established method but rather one developed for this particular case.”⁸³

***Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. June 16, 2015) (en banc), superseding 770 F.3d 1371 (Fed. Cir. 2014)**

Superseding the previous panel decision, the *en banc* Federal Circuit affirmed the district court's judgment that “distributed learning control module” was an invalid means-plus-function term that lacked corresponding structure in the specification.⁸⁴

First, the court determined that it would review the district court's claim construction *de novo* under *Teva*,⁸⁵ because the lower court based its judgment solely on the intrinsic record.⁸⁶

Next, the court expressly overruled its prior precedent, which had held that the absence of the word “means” in a claim creates a “strong” presumption that § 112(f) does not apply which “is not readily overcome,” and that the court was “unwilling” to apply § 112(f) to such claims “without a showing that the limitation essentially is devoid of anything that can be construed as structure.”⁸⁷ The court stated that “such a heightened burden is unjustified” and had “the inappropriate practical effect of placing a thumb on what should otherwise be a balanced analytical scale.”⁸⁸ Rather, the court held that “[w]hen a claim term lacks the word ‘means,’ the presumption can be overcome and § 112 [f] will apply if the challenger demonstrates that the claim term fails to ‘recite

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.* at 634.

⁸² 135 S. Ct. 831 (2015).

⁸³ *Dow Chems. Co.*, 803 F.3d at 635.

⁸⁴ *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1343 (Fed. Cir. 2015). Portions of the opinion not summarized here remain the panel's opinion; this section alone was considered by the *en banc* court and changed.

⁸⁵ *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015).

⁸⁶ *Williamson*, 792 F.3d at 1346.

⁸⁷ *Id.* at 1348-49 (emphasis omitted) (quoting *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004); *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir. 2012)) (internal quotation marks omitted).

⁸⁸ *Id.* at 1349.

sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’”⁸⁹

Turning to the claim limitation at hand—“distributed learning control module for receiving communications . . . for relaying the communications . . . and for coordinating the operation of the streaming data module”⁹⁰—the Federal Circuit agreed with the district court that it failed to recite sufficiently definite structure and therefore was subject to § 112(f).⁹¹ It was “in a format consistent with traditional mean-plus-function claim limitations,” merely “replac[ing] the term ‘means’ with the term ‘module’ and recit[ing] three functions performed.”⁹² The court agreed that “module” was a “well-known nonce word” which was “simply a generic description for software or hardware that performs a specified function,” and the prefix “distributed learning control” did not add any definite structure.⁹³ The court did not find enough detail in the claims or the specification to show “how the distributed learning control module, by its interaction with the other components in the distributed learning control server, is understood as the name for structure.”⁹⁴

Finally, having the determined that the claim limitation did invoke § 112(f), the court held that the claim was indefinite because the specification did not disclose adequate corresponding structure.⁹⁵ Because the claim was directed to software, the specification must “disclose an algorithm for performing the claimed function.”⁹⁶ The court found that the portions of the disclosure Williamson pointed to were either merely descriptions of the functions performed or descriptions of display interfaces.⁹⁷ The court refused to consider an expert declaration as evidence that the patent disclosed structure because the whole point of requiring the specification to adequately disclose structure is that extrinsic evidence should not be necessary to understand the scope of the patent.⁹⁸

Judge Reyna concurred with the majority’s opinion regarding the strength of the presumption in means-plus-function claiming, but felt that the majority “stop[ped] short of addressing other equally fundamental concerns about functional claiming.”⁹⁹ He opined that having a rigid presumption framework might not be appropriate given that the statute itself supplies “only one test.”¹⁰⁰ He also questioned whether it makes sense to have the presumption turn on the use of the word “means,” because the statute uses at least the word “step” in a similar way and the Supreme Court case which led to the passage of § 112(f) expressed a rationale applicable to all functional claiming, regardless of any specific language.¹⁰¹

⁸⁹ *Id.* (citing *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)).

⁹⁰ *Id.* at 1350.

⁹¹ *Id.* at 1351.

⁹² *Id.* at 1350.

⁹³ *Id.* at 1350-51.

⁹⁴ *Id.* at 1351.

⁹⁵ *Id.*

⁹⁶ *Id.* at 1352.

⁹⁷ *Id.* at 1352-54.

⁹⁸ *Id.* at 1354 (“The testimony of one of ordinary skill in the art cannot supplant the total absence of structure from the specification.”).

⁹⁹ *Id.* at 1356 (Reyna, J., concurring-in-part, dissenting-in-part, and providing additional comments).

¹⁰⁰ *Id.* at 1356-57.

¹⁰¹ *Id.* at 1356-57.

Judge Newman dissented, arguing that by disconnecting the presumption from the word “means,” the majority ignored the statutory text, introduced additional uncertainty into the patent system, and took away the patentee’s ability to choose whether or not to invoke § 112(f).¹⁰²

***Media Rights Technologies, Inc. v. Capital One Financial Corp.*, 800 F.3d 1366 (Fed. Cir. Sept. 4, 2015)**

The Federal Circuit held that the term “compliance mechanism” was a means-plus-function term and that the specification did not recite sufficient structure; therefore the patent was invalid for indefiniteness.¹⁰³

The patent at issue was “generally directed to methods, systems, and computer readable media related to the prevention of unauthorized recording of electronic media.”¹⁰⁴ The claims all include the term “compliance mechanism,” which “diverts incoming media content protected by law or agreement from being output by a system in order to stop the illegal copying or sharing of that content.”¹⁰⁵

Though the claim did not recite the word “means,” the court nevertheless held that the claims, “read in light of the specification, only recite[d] function without reciting sufficient structure for performing that function.”¹⁰⁶ The parties did not dispute that “‘compliance mechanism’ has no commonly understood meaning and is not generally viewed by one skilled in the art to connote a particular structure.”¹⁰⁷ The court found that “the claims simply state that the ‘compliance mechanism’ can perform various functions,” and that “review of the intrinsic record does not change this conclusion.”¹⁰⁸ The court distinguished its opinion in *Inventio AG v. Thyssenkrupp Elevator Americas Corp.*,¹⁰⁹ where it had held that “modernizing device” did not invoke § 112(f), on the grounds that the patent in *Inventio* had disclosed that the “‘modernizing device’ and its internal components *operated* as a circuit,” which circuit was sufficient structure.¹¹⁰ The

¹⁰² *Id.* at 1358 (Newman, J., dissenting).

¹⁰³ *Media Rights Techs. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1368 (Fed. Cir. 2015).

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 1368-69. Claim 1 is representative and reads as follows:

A method of preventing unauthorized recording of electronic media comprising:

[1] Activating a *compliance mechanism* in response to receiving media content by a client system, said *compliance mechanism* coupled to said client system, said client system having a media content presentation application operable thereon and coupled to said *compliance mechanism*;

[2] Controlling a data output pathway of said client system with said *compliance mechanism* by diverting a commonly used data pathway of said media player application to a controlled data pathway monitored by said *compliance mechanism*; and

[3] Directing said media content to a *custom media device* coupled to said *compliance mechanism* via said data output path, for selectively restricting output of said media content.”

Id. (quoting U.S. Patent No. 7,316,033 col. 36 ll. 19-34 (filed Dec. 18, 2002)).

¹⁰⁶ *Id.* at 1372.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ 649 F.3d 1350 (Fed. Cir. 2011).

¹¹⁰ *Media Rights*, 800 F.3d at 1373.

court found the structure here “far less detailed than in *Inventio*.”¹¹¹ Thus, the court affirmed the district court’s conclusion that “compliance mechanism” was a means-plus-function limitation.

Having concluded that “compliance mechanism” was a means-plus-function term, the court attempted to “construe the disputed claim term by identifying the corresponding structure, material, or acts described in the specification to which the claim term will be limited.”¹¹² The court noted that the patent must disclose corresponding structure for each of the four functions performed by the “compliance mechanism”: “controlling data output by diverting a data pathway; monitoring the controlled data pathway; managing an output path by diverting a data pathway; and stopping the play of media content.” Because the functions are “computer-implemented,” the court required that “the specification disclose an algorithm for performing the claimed functions.”¹¹³

The court found that the disclosed algorithm for performing both the “controlling data output” and “managing data output” functions, according to unrebutted expert testimony, “only returns various error messages.”¹¹⁴ Furthermore, mere disclosure that there exists a “set of rules” that the “copyright compliance mechanism” applies in order to monitor a data pathway, without any “detail about the rules themselves or how the ‘copyright compliance mechanism’ determines whether the rules are being enforced,” was not sufficient structure to limit the monitoring function.¹¹⁵ Thus, the court held that the patent was indefinite.¹¹⁶

Written Description

***Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. Sept. 4, 2015)**

In this appeal from an *inter partes* review, the Federal Circuit affirmed the Patent Office’s determination that the prior art patent did not relate back to its provisional application, and so was not entitled to the provisional filing date.¹¹⁷ Therefore, the respondent’s patent was not anticipated and not invalid.¹¹⁸

Petitioner Dynamic requested an *inter partes* review of National Graphics’s patent on the ground that it was anticipated by the Raymond patent.¹¹⁹ But the Raymond patent, filed on May 5, 2000, is only prior art to the National Graphics patent, reduced to practice on March 28, 2000, if it can take advantage of its provisional filing date of February 15, 2000.¹²⁰ The Patent Office concluded that Dynamic had not carried its burden to show by

¹¹¹ *Id.*

¹¹² *Id.* at 1374 (quoting *Robert Bosch, LLC v. Snap-on Inc.*, 769 F.3d 1094, 1097 (Fed. Cir. 2014)) (internal quotation marks omitted).

¹¹³ *Id.*

¹¹⁴ *Id.* at 1375.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1381-82 (Fed. Cir. 2015).

¹¹⁸ *Id.* at 1382.

¹¹⁹ *Id.* at 1377.

¹²⁰ *Id.*