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“A” CAN COVER ONE AND MANY

By [Chang Yang](#)

[Salazar v. AT&T Mobility LLC et al.](#), Appeal No. 2021-2320; 2021-2376
(Fed. Cir., Apr. 5, 2023, [Stoll](#), Schall, and Stark, precedential)

- “A” component introduced in an open-ended claim means “one or more” components, unless the language of the claims themselves, the specification, or the prosecution history necessitates a different construction.
- 개방형 청구항에 도입된 "A" 구성요소는 청구항 자체의 언어, 명세서 또는 심사 이력에서 다른 해석이 필요하지 않는 한 "하나 또는 그 이상의" 구성요소를 의미합니다.
- 在开放式权利要求中引入的“一个”组件意味着“一个或多个”组件，除非权利要求本身的语言、说明书或审查历史需要不同的解释。
- オープン形式のクレームに導入された“1つの”構成要素は、クレームの文言自体、明細書、あるいは審査履歴がそれとは異なる解釈を必然とする場合を除き、“1つのあるいはそれ以上の”構成要素という意味である。
- Reference to a prior-recited component using the word “said” attributes any recited functions of “said” component to the same component.
- "Said"라는 단어를 사용하여 이전에 언급된 구성요소를 참조하면 "said"된 구성요소는 모두 동일한 구성요소를 의미합니다.
- 使用单词“所述”来引用一个先前叙述的组件，会将“所述”组件的任何叙述的功能都归于该同一组件。

- “前記” という語句を用いた先に記された構成要素の引用が、“前記” 構成要素の先に記されたいかなる機能を、その同一構成要素に起因させる。

Background:

Mr. Salazar owns US Patent No. 5,802,467 directed to a communications, command, control and sensing system for communicating with a plurality of external devices. In 2016, Mr. Salazar sued HTC Corp. (“HTC”) for patent infringement. A jury’s verdict found no infringement and did not decide whether the ‘467 patent was invalid. In 2019, Mr. Salazar sued AT&T, Sprint, T-Mobile and Verizon, asserting the same patent against the same HTC products. HTC intervened and asserted the accused products did not infringe. The district court severed HTC’s claims and stayed that portion of the case.

Holding:

The Federal Circuit affirmed the district court’s holding of noninfringement and agreed that the district court correctly interpreted the claim limitation “one microprocessor” to mean “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions.” The Federal Circuit held that AT&T waived its challenge to the jury’s verdict on anticipation by failing to move for judgement as a matter of law under Rule 50 of the Federal Rules of Civil Procedure.

Discussion:

One claim at issue recites “a microprocessor” that is capable of generating control signals. The claim also recites that “said microprocessor” performs functions of “creating,” “retrieving,” and “generating.” The Federal Circuit agreed with the district court’s conclusion that “a” means “one or more” in an open-ended claim including the transitional phrase “comprising,” based on a general rule of claim construction, except when the language of the claims themselves, the specification, or the prosecution history necessitates a departure from the rule. The Federal Circuit rejected Mr. Salazar’s argument that the claim language requires one or more microprocessors, but that no one microprocessor is required to perform each of the recited functions. In this case, while the claim term “a microprocessor” does not require there be only one microprocessor, the subsequent limitations referring to “said microprocessor” require that at least one microprocessor be capable of performing each of the recited functions.

Having found that AT&T did not infringe the asserted claims, the Federal Circuit did not reach AT&T’s cross-appeal on grounds of collateral estoppel and the *Kessler* doctrine.

COMMAND CODE IS NOT A COMMUNICATION METHOD

By Bobbie Wu

[*Roku, Inc. v. Universal Electronics, Inc.*](#), Appeal No. 22-1058

(Fed. Cir., March 31, 2023, Newman, Reyna, Stoll, precedential)

- A list, in a prior art reference, of command codes formatted to be transmitted via different communication methods was insufficient to render a claim reciting “a listing comprised of at least a first communication method and a second communication method different than the first communication method” unpatentable.
- 선행 기술 문헌에서 다른 통신 방법을 통해 전송되도록 구성된 명령 코드의 목록은 "적어도 제 1 통신 방법과 제 1 통신 방법과 다른 제 2 통신 방법으로 구성된 목록"을 포함하는 청구항을 특허받을 수 없게 만들기엔 충분하지 않습니다.

- 在现有技术参考文献中，格式为通过不同通信方法传输的命令代码的列表不足以使描述“一个列表至少包括第一通信方法和不同于第一通信方法的第二通信方法”的权利要求不可授予专利。
- ある先行技術引例における、異なる通信方法を経由して送信されるようにフォーマットされた命令コードのリストが、「第1の通信方法およびその第1の通信方法とは異なる第2の通信方法の少なくとも1つを有するリスト化」を要件とするクレームが特許性がないとするには不十分である。

Background:

Roku filed an IPR against U.S. Patent No. 9,716,853 (“the ‘853 Patent”), owned by Universal Electronics, Inc. (“UE”). The ‘853 Patent relates to a universal control engine (“UCE”) that facilitates communication between a controlling device (*i.e.*, remote) and intended target applications (*e.g.*, TV, DVD player, *etc.*). Roku asserted that several claims of the ‘853 Patent are unpatentable as obvious in view of Chardon (U.S. Patent Pub. No. 2012/0249890). The PTAB determined that Roku had not shown that the challenged claims would have been obvious. Roku appealed to the Court of Appeals for the Federal Circuit, arguing that a person of ordinary skill in the art would consider Chardon’s disclosure of “a listing of remote command codes formatted for transmission via two different communication methods” to be “a listing comprised of at least a first communication method and a second communication method different than the first communication method,” as recited in the claims of the ‘853 Patent.

Holding:

The CAFC affirmed the PTAB’s final written decision that the ‘853 patent is not obvious in view of Chardon.

Discussion:

The UCE described in the ‘853 Patent can “receive commands from a controlling device” and “apply the optimum methodology to propagate the command functions to each intended target” according to “(1) a form of command/transmission to be used, and (2) a pointer to the required data value and formatting information for the specific command.” The ‘853 Patent mentions Consumer Electronic Control (CEC) commands and infrared (IR) commands as examples. The remote control system of Chardon uses target device identification data to generate a linked database (*e.g.*, a linked list) including sets of command codes (*i.e.*, instructions to perform a command) associated with specific communication protocols. This linked database includes at least two different sets of command codes (*i.e.*, CEC command codes and IR command codes).

The only issue raised on appeal was whether Chardon’s list of command codes formatted to be transmitted via different communication methods is a list of different communication methods as recited in the claims of the ‘853 Patent. The CAFC determined that the issue is a question of fact reviewed for support of substantial evidence.

The CAFC reasoned that the PTAB’s finding flowed from the specification of the ‘853 Patent and from UE’s expert testimony that one of ordinary skilled in the art would not have understood a “command code” to be a “communication method.” According to the testimony of UE’s expert, a command code is an instruction to perform a function, whereas a communication method is a medium or protocol for transmitting or receiving information. UE’s expert stated that Fig. 7 of the ‘853 Patent shows a matrix with cells comprising “identification of a form of command/transmission to be used (*e.g.*, CEC and IR),” and the matrix “expressly distinguishes between command codes and the communication methods (*e.g.*, CEC and IR) that are used to communicate the command codes.” The ‘853 Patent differentiates between the “form of command/transmission to be used” and the data value and formatting information for the specific command, which is stored elsewhere in memory. Accordingly, the CAFC

concluded that the record as a whole showed that “the factual dispute at hand was highly contested and closely decided,” and the PTAB’s finding was supported by substantial evidence.

INTRINSICALLY INCORRECT CLAIM CONSTRUCTION

By [David Cain](#)

[Sequoia Tech., LLC v. Dell, Inc.](#), Appeal No. 2021-2267
(Fed. Cir., April 12, 2023, Lourie, Dyk, and [Stoll](#), precedential)

- It is clear error to rely on extrinsic evidence for construction of a patent claim where the intrinsic record of the patent is conclusive.
- 특허의 내재적 증거가 의심의 여지없이 확실한 경우 특허 청구항 해석을 외재적 증거에 의존하는 것은 명백한 오류입니다.
- 在专利的内在记录是决定性的情况下，依赖外在证据来解释专利权利要求是明显的错误。
- 特許に内在する記録が疑う余地がない真実である場合、クレーム解釈のために外形的な証拠に依拠することは明らかな誤りである。
- All statements by inventors in the record of a patent are evidence of the meaning of terms in the claims of the patent.
- 특허 기록에 있는 발명가의 모든 진술은 특허 청구항에 있는 용어의 의미에 대한 증거입니다.
- 发明人在专利记录中的所有陈述都是该专利权利要求书中术语含义的证据。
- ある特許の記録における発明者のすべての発言が、その特許のクレーム中の用語の意味の証拠である。

Background:

Sequoia sued Dell, Red Hat, and IBM for infringement of claims 1-3 and 8 of U.S. Patent No. 6,718,436. The district court held claim 8 ineligible for patenting under 35 U.S.C. § 101 after construing the term “computer-readable medium” to include transitory media based on extrinsic evidence. The district court also held that the claims 1-3 and 8 are not infringed after construing the terms “logical volume” and “disk partition.”

Holding:

The Federal Circuit reversed the decision regarding the eligibility of claim 8 under § 101 and affirmed the holding of non-infringement because the district court’s construction of “logical volume” was not erroneous.

Discussion:

The Federal Circuit reviewed the district court result for clear error. Regarding “computer-readable medium,” the Federal Circuit looked to the specification and the claims. Noting that the claim does not actually recite “computer-readable medium,” the reviewing court agreed with Sequoia that the recited “computer-readable recording medium storing instructions,” would not be understood by the

person of ordinary skill in the art as including transitory media such as signals or carrier waves, since such media do not persist over time. Other elements of claim 8, such as reference to a “physical storage space” and “storing metadata to the disk partitions” demonstrate that claim 8 is directed to non-transient storage media.

The Federal Circuit rejected Red Hat’s argument that the phrase “computer-readable medium” has been held to include transitory media, and that the specification of the ‘436 patent does not indicate otherwise, explaining that the claim does not actually recite “computer-readable medium.” The reviewing court emphasized that claims cannot be removed from context during construction, that claim 8 is actually narrower than the phrase Red Hat challenges, and that the intrinsic evidence is conclusive. In the extrinsic evidence relied upon by Red Hat’s expert, a collection of other patents, the inventors chose to define CRM to include transitory media, but that does not necessarily show what the inventors of the ‘436 patent intended. Because a patentee can be her own lexicographer, it was error for the district court to construe claim 8 based on extrinsic evidence.

Regarding “disk partitions” and “logical volume”, the Federal Circuit again considered the intrinsic evidence, the specification, the claims and the prosecution history. The reviewing court agreed with the district court that the invention recited in the claims of the ‘436 patent do not allocate less than an entire disk partition to a logical volume. Noting that the claims specifically recite, “creating the logical volume by gathering disk partitions,” and that the specification describes this as a preferred embodiment, the Federal Circuit rejected Sequoia’s argument that, because the claims do not include the word “whole” in front of “disk partition,” they must cover logical volumes constructed from portions of disk partitions. Noting that the specification and prosecution history generally support the district court’s construction, and that the phrase “used or not used,” referring to an extent allocation table, does not clearly support any particular construction of “logical volume,” the Federal Circuit affirmed the district court’s construction of “logical volume” and “disk partition,” and the non-infringement result.

CASE DISMISSED WITHOUT LEAVE TO AMEND

By James Paige

Sanderling Management Ltd. v. Snap Inc., Appeal No. 2021-2173

(Fed. Cir., April 12, 2023, Chen, Cunningham, and Stark, precedential)

- Dismissal of a patent infringement claim under Rule 12(b)(6) for claiming patent ineligible subject matter under 35 U.S.C. § 101 may be without leave to amend the complaint where any proposed amendment would not change the outcome.
- 35 U.S.C. § 101에 따라 특허 부적격 주제를 주장한다는 이유로 규정 12(b)(6)에 따른 특허 침해 청구 기각은 제안된 수정안이 결과를 바꾸지 않는 경우 신청서 수정에 대한 허가없이 진행될 수 있습니다.
- 根据规则 12(b)(6) 驳回在 35 USC § 101 规定下不符合专利资格主题的专利侵权索赔，若任何拟议的修改都不会改变结果，则可不予准许修改投诉。
- 特許法 101 条下で特許適格性を欠く主題であるとして規則12条(b)(6)項に基づく特許侵害請求の却下を受け、いかなる補正案も結果には変更が生じないと記すよう、無許可で訴状を補正してもよい。

Background:

Sanderling Management Ltd. (“Sanderling”) brought an action against Snap Inc. (“Snap”) in the Northern District of Illinois (later transferred to the Central District of California) alleging infringement

of U.S. Patent Nos. 9,355,412 (the “412 patent”), 9,639,866 (the “866 patent”), and 10,108,986 (the “986 patent”) directed to methods of using distribution rules to load digital image branding functions to users when certain conditions are met. The district court dismissed the case under Rule 12(b)(6) with prejudice, holding that the asserted claims are not eligible for patenting under 35 U.S.C. § 101.

Holding:

The district court did not err in holding the claims patent ineligible and dismissing the case without formal claim construction or leave to amend the complaint.

Discussion:

The Federal Circuit held that the asserted claims are directed to the abstract idea of providing information based on meeting a condition, and that even the particular variety of information being provided is abstract. The reviewing court rejected Sanderling’s argument that the claims were evaluated at too high a level of abstraction, finding the recited steps too generic. The reviewing court also rejected criticism of the district court for dismissing the case without formal claim construction, finding that the asserted claims would be ineligible for patenting under all possible construction, and that Sanderling failed to present the district court with any proposed constructions of disputed terms and failed to timely identify any relevant fact disputes prior to the district court’s ruling on the 12(b)(6) motion. The Federal Circuit concluded that the asserted claims are directed to an abstract idea, and that the only possible inventive concept in the claims, using a “distribution rule” to route information is conventional and routine. Finally, reviewing Sanderling’s proposed amendment to the complaint, the Federal Circuit held the amended complaint would have been futile and affirmed the district court’s dismissal without leave to amend.

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