wiley

ALERT

Federal Circuit Patent Bulletin: *Ancora Techs., Inc. v. Apple, Inc.*

March 4, 2014

"[A claim is not indefinite where] the claim language and the prosecution history leave no reasonable uncertainty about the boundaries of the terms at issue, even considering certain aspects of the specification that could engender confusion when read in isolation."

On March 3, 2014, in *Ancora Techs., Inc. v. Apple, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Rader, Taranto,* Chen) affirmed-in-part, reversed-in-part and remanded the district court's judgment that Apple did not infringe U.S. Patent No. 6,411,941, which related to the verification that a computer is running authorized software, and that the '941 patent was not invalid for indefiniteness under 35 U.S.C. § 112. The Federal Circuit stated:

A claim term should be given its ordinary meaning in the pertinent context, unless the patentee has made clear its adoption of a different definition or otherwise disclaimed that meaning. There is no reason in this case to depart from the term's ordinary meaning. Apple nowhere seriously disputes that the ordinary meaning of the word "program" in the computer context encompasses both operating systems and the applications that run on them (as well as other types of computer programs). And the district court explained that, although the term "program" may have many different meanings depending on the context, "to a computer programmer" a program is merely a "set of instructions" for a computer. That clear meaning governs here, we conclude, because there is nothing sufficient to displace it.

The claims themselves point against a narrowing of the term "program" to application programs. . . . Nothing in the specification clearly narrows the term "program." The general disclosure in the specification refers to the to-be-verified software as a "software program," "software," or a "program," without limiting the subject matter to particular types of programs. The only instances in which the specification discusses using the claimed invention to verify application programs are found in examples that the specification makes clear are not limiting. Such examples are "not sufficient to redefine the term . . . to have anything other than its plain and ordinary meaning." Thus, nothing in the specification would lead one of ordinary skill in the art to understand

that the claims use "program" in a sense narrower than its ordinary meaning. . . .

Under what is now 35 U.S.C. § 112(b), a claim must be "sufficiently definite to inform the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent." The Supreme Court currently is considering how to refine the formulations for applying the definiteness requirement. In this case, we think that we can reject the indefiniteness challenge without awaiting the Court's clarification. However other circumstances may be evaluated, it suffices to reject the challenge in this case that the claim language and the prosecution history leave no reasonable uncertainty about the boundaries of the terms at issue, even considering certain aspects of the specification that could engender confusion when read in isolation.

Most importantly, there is no dispute that the terms "volatile memory" and "non-volatile memory" have a meaning that is clear, settled, and objective in content. Both parties and the district court agreed that, as a general matter, "[t]o one of ordinary skill in the art, a volatile memory is memory whose data is not maintained when the power is removed and a non-volatile memory is memory whose data is maintained when the power is removed." That meaning leaves the relevant public with a firm understanding of the scope of the claim terms, unless something exceptional sufficiently supplants that understanding. Apple argues that the specification does so. We conclude otherwise.

Apple's argument rests on the fact that, three times, the specification uses language referring to a hard disk as an example of volatile memory. All sides agree that a hard disk maintains data when the power is removed and for that reason is not normally referred to as "volatile memory." Apple contends that because "a hard disk is a quintessential example of non-volatile memory" and "the specification does not explain how a hard disk can fall into the category of volatile memory . . . or what characteristics differentiate volatile from non-volatile memory . . . a person of ordinary skill would not know what falls within the scope of the claims."

We are not persuaded that Apple's conclusion is properly drawn from the passages on which it relies. To begin with, the terms at issue have so clear an ordinary meaning that a skilled artisan would not be looking for clarification in the specification. There is no facial ambiguity or obscurity in the claim term. Moreover, the specification nowhere purports to set out a definition for "volatile" or "non-volatile" memory, and nothing in it reads like a disclaimer of the clear ordinary meaning. Under our claim-construction law, a clear ordinary meaning is not properly overcome (and a relevant reader would not reasonably think it overcome) by a few passing references that do not amount to a redefinition or disclaimer.

In this case, moreover, a skilled artisan would appreciate that the passages at issue have a possible meaning that is not (what would be surprising) starkly irreconcilable with the clear meaning of "volatile" and "non-volatile" memory, which are the claim terms. (The claims do not mention a hard disk at all, and the only specific example of "volatile" memory set out in the claims is Random Access Memory (RAM), which all agree is "volatile" in the ordinary sense.) . . . This explanation for the otherwise-perplexing example of a hard disk as "volatile" memory finds support in the specification's statement that "the volatile memory is a RAM *e.g.* hard disk and/or internal memory of the computer." . . . For those reasons, under the demanding standards for displacing as clear an ordinary meaning as exists in this case, we doubt that an ordinarily skilled artisan could have a reasonable uncertainty about the governing scope of the claims – even before completing the claim-meaning inquiry by examining the prosecution history. And the inquiry must, in fact, continue: an ordinarily skilled artisan must consult the prosecution history to confirm the proper understanding of a claim term's meaning, especially if other aspects of the inquiry raise questions. And here, the prosecution history eliminates any reasonable basis for thinking that the patent has adopted a meaning different from the clear ordinary one.