wiley

ALERT

Federal Circuit Patent Bulletin: *In re Papst Licensing Digital Camera Patent Litig.*

February 2, 2015

"[Following the U.S. Supreme Court mandate in Teva Pharm. U.S.A. Inc. v. Sandoz, Inc., in] this case, we review the district court's claim constructions de novo, because intrinsic evidence fully determines the proper constructions."

On February 2, 2015, in *In re Papst Licensing Digital Camera Patent Litig.*, the U.S. Court of Appeals for the Federal Circuit (Taranto,* Schall, Chen) vacated and remanded the district court's summary judgment that the defendants did not infringe U.S. Patents No. 6,470,399 and No. 6,895,449, which related to an interface device for transferring data between an input/output data device and a host computer. The Federal Circuit stated:

We review the grant of summary judgment of non-infringement de novo, applying the same standard used by the district court. The infringement inquiry, which asks if an accused device contains every claim limitation or its equivalent, depends on the proper construction of the claims. In this case, we review the district court's claim constructions de novo, because intrinsic evidence fully determines the proper constructions. As we have noted, the district court relied only on the intrinsic record, not on any testimony about skilled artisans' understandings of claim terms in the relevant field, and neither party challenges that approach. . . .

We reject the five constructions at issue. We do so following our familiar approach to claim construction. "We generally give words of a claim their ordinary meaning in the context of the claim and the whole patent document; the specification particularly, but also the prosecution history, informs the determination of claim meaning in context, including by resolving ambiguities; and even if the meaning is plain on the face of the claim language, the patentee can, by acting with sufficient clarity, disclaim such a plain meaning or prescribe a special definition." We apply, in particular, the principle that "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." . . .

Papst first challenges the district court's "memory card" summary judgment as relying on an improper construction of the term "interface device" found in the preamble of claims in both patents. . . . We hold that the term "interface device" is not limited to a "stand-alone device" in the district court's sense relied on for summary judgment: a device that is physically separate and apart from, and not permanently attached to, a data device (or a host computer). [T]he described advance over the prior art was the elimination of the need for special drivers to be placed on the host computer by instead having the host computer use a single, already-present, fast, reliable driver to communicate with the interface and, through it, with the data device, which need not be of a particular type. Nothing about that advance suggests exclusion of a permanent attachment of such an interface to the data device—a construction that is "unmoored from, rather than aligned with" what is described as the invention's advance. . . .

Papst also appeals the district court's construction of the phrase "second connecting device," which appears in both patents. The district court construed the term as "a physical plug or socket for permitting a user readily to attach and detach the interface device with a plurality of dissimilar data transmit/receive devices." . . . We conclude that the district court's construction of "second connecting device" is incorrect largely for reasons we have given for rejecting the "interface device" construction. . . .

The district court's construction of the phrase "data transmit/receive device" is challenged here as well. The district court construed the phrase to mean "a device that is capable of either (a) transmitting data to or (b) transmitting data to and receiving data from the host device when connected to the host device by the interface device." . . . We conclude that the data transmit/receive device recited in the preamble to the claims of the '399 and '449 patents need not be capable of communicating "when connected to the host device by the interface device." . . . Nothing about the ordinary meaning of "data transmit/receive device" suggests any temporal constraint on the transferring of data. As the words imply, a data transmit/receive device is a device that may transmit or receive data; those words offer no information about when data is transferred. To the extent that some claim language does suggest a temporal constraint, the focus is always on communications between the interface device and the host computer, not between the data device and the host computer. . . .

The next issue we discuss is the district court's construction of the phrase "virtual files" in the '399 patent and the phrase "simulating a virtual file system" in the '449 patent. The district court construed "virtual files" as "files that appear to be but are not physically stored; rather, they are constructed or derived from existing data when their contents are requested by an application program so that they appear to exist as files from the point of view of the host device." . . . Nothing in the claims or written description limits a "virtual file" to one whose content is stored off the interface device, though it includes such files. "Virtual" conveys some kind of as if action, one thing emulating another; the term was prominently used that way in the computer field at

the time of the inventions here. What is crucial is how the patent identifies the emulation. In the present context, the emulation does not turn on whether data in a "virtual file" is physically located in the interface device or a data device when the host seeks it. . . .

Finally, Papst appeals the district court's construction of the term "input/output device customary in a host device" in the '399 patent and the term "storage device customary in a host device" in the '449 patent. The district court construed the '399 term to be a "data input/output device that was normally present within the chassis of most commercially available computers at the time of the invention." . . . This language does not carry a plain, precise meaning of physical location inside the chassis. The phrase "customary in a host device" is not especially precise, and it seems to emphasize what is customary, not whether the unit is inside or outside the device. It contrasts with, for example, "customarily found in" or simply "input/output device in a host device"—which have a greater suggestion of location, though themselves perhaps not definitively so. . . . Even if we were to conclude that the phrase "customary in" conveys a physical location, therefore, the district court was wrong to conclude that the physical location must be inside a computer chassis.