

ALERT

Federal Circuit Patent Bulletin: *MobileMedia Ideas LLC v. Apple Inc.*

March 17, 2015

"[E]ven when a technique has been used to improve a device, and a skilled artisan would recognize that it could improve other devices in the same way, using that technique may not be obvious if its actual application is beyond his or her level of skill."

On March 17, 2015, in *MobileMedia Ideas LLC v. Apple Inc.*, the U.S. Court of Appeals for the Federal Circuit (Taranto, Bryson, Chen*) affirmed-in-part, reversed-in-part, vacated, and remanded the district court's judgment, inter alia, that Apple infringed U.S. Patents No. 6,427,078 (which related to devices with a camera unit, a data processing unit, a display, a user interface, a memory unit, and a cellular mobile phone unit) and No. 6,070,068, but not U.S. Patents No. 6,253,075 and No. RE 39,231, and that the '068 but not the '078 patent was invalid for obviousness. The Federal Circuit stated:

Apple contends that the district court erred by denying its JMOL motion that the '078 patent is invalid as obvious over two references: Japanese patent application publication no. H6-133081 (Kyocera) and U.S. Patent No. 5,550,646 (Lucent). Kyocera discloses a mobile phone with a built-in camera unit, a user interface, and a viewfinder display. The camera unit includes an image sensor that captures image data through a lens. Lucent discloses a portable phone with an integrated camera unit, a keypad interface, and an LCD display. . . .

The district court determined that there was no material dispute between the parties at trial that Kyocera and Lucent together disclose all the limitations of claim 73. The district court also found that the "jury implicitly chose to believe" the testimony of MobileMedia's expert instead of the testimony of Apple's expert regarding the alleged motivation to combine the two references. Therefore, the district court found that substantial evidence supported the jury's verdict that the '078 patent was not invalid, and denied Apple's JMOL motion.

On appeal, Apple argues that the combination of the Kyocera and Lucent references is merely the predictable use of prior art elements according to their established functions, and therefore would have been obvious. First, Apple contends that Lucent discloses a microprocessor that performs signal processing to "enhance presentability" of captured pictures, and that its expert testified that a skilled artisan would have recognized that modifying Kyocera with Lucent provides the benefit of improved picture quality. Second, Apple asserts that the Lucent microprocessor can be programmed to provide functionality similar to that of the Kyocera mobile phone, and that its expert testified that skilled artisans would have understood the cost advantages of using a programmable microprocessor for the relevant operations of the Kyocera mobile phone. Apple also notes that Lucent discloses a commercially-available, off-the-shelf microprocessor, and that its expert testified that disclosure of such an ordinary, commercially-available processor would have motivated those of skill in the art to try-and to expect success from using-the Lucent microprocessor with the Kyocera mobile phone.

A patent is invalid as obvious under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter would have been obvious at the time the invention was made to a person having ordinary skill in the art. Obviousness is a question of law based on underlying facts, [including] (i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of the invention, and (iv) any relevant objective considerations of nonobviousness. What a particular reference discloses is a question of fact, as is the question of whether there was a reason to combine certain references. . . .

The existence of a motivation to combine the Kyocera and Lucent references was contested by the parties at trial. Thus, while Apple may have presented some evidence to support its position that a skilled artisan would have been motivated to combine Kyocera with Lucent, this alone does not demonstrate that the jury's verdict was unsupported by substantial evidence. [E]ven when a technique has been used to improve a device, and a skilled artisan would recognize that it could improve other devices in the same way, using that technique may not be obvious if its actual application is beyond his or her level of skill. Here, MobileMedia's expert testified that integrating the Lucent microprocessor to control the camera of the Kyocera mobile phone in the manner required by the asserted claims would be beyond the technical ability of a skilled artisan. This provided the jury with a reasonable basis for finding that the claimed invention would not have been obvious to one of ordinary skill in the art at the relevant timeframe. Although Apple's expert offered a differing opinion, when there is conflicting testimony at trial, and the evidence overall does not make only one finding on the point reasonable, the jury is permitted to make credibility determinations and believe the witness it considers more trustworthy. Here, the jury credited the testimony of MobileMedia's expert over the testimony of Apple's expert. Where there is substantial evidence for a reasonable jury finding, it is not our function to second guess or reevaluate the weight given to that evidence. Thus, we agree with the district court that substantial evidence supports the jury's finding that one of skill in the art would not have been motivated to combine the Lucent and Kyocera references to arrive at the claimed invention. Consequently, the district court did not err by

denying Apple's motion for JMOL of invalidity. . . .

We review the district court's claim construction here de novo because it relied only on evidence intrinsic to the '078 patent. Under 35 U.S.C. § 112 ¶ 6, a means-plus-function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." A disclosed structure is a "corresponding structure" only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. . . . "[A] structure may perform two functions and that a function may be performed by two structures" is "irrelevant in the context of a § 112, paragraph 6 analysis without a clear link or association between the function or functions recited in the means-plus-function limitation and the structure or structures disclosed in the specification for carrying out those functions." . . . Correctly construed, no reasonable jury could conclude that Apple's accused products literally infringe the "means for processing and storing" limitation of claim 73. Literal infringement of a § 112 ¶ 6 limitation requires that the relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification. Here, the parties do not dispute that the camera module in Apple's accused iPhones has no internal memory for storing image data. Thus, the camera module of Apple's iPhones has no structure corresponding to the function of storing at least a portion of processed image information. . . . Therefore, we reverse the district court's judgment that Apple infringes claim 73 of the '078 patent.