

**ALERT**

## **Federal Circuit Patent Bulletin: *Vasudevan Software, Inc. v. MicroStrategy Inc.***

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April 6, 2015

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On April 3, 2015, in *Vasudevan Software, Inc. v. MicroStrategy Inc.*, the U.S. Court of Appeals for the Federal Circuit (Chen, Linn,\* Hughes) affirmed-in-part, reversed-in-part, and remanded the district court's summary judgment that MicroStrategy did not infringe U.S. Patents No. 6,877,006, No. 7,167,864, No. 7,720,861, and No. 8,082,268, which related to different features of an online analytical processing (OLAP) cube capable of collecting and processing "live" data from multiple incompatible databases. The Federal Circuit stated:

"Claim terms are generally given their plain and ordinary meanings to one of skill in the art when read in the context of the specification and prosecution history." However, patentees can act as their own lexicographers if they "clearly set forth a definition of the disputed claim term' other than its plain and ordinary meaning."

All of the asserted claims of the '006, '861 and '864 patents contain a limitation calling for "disparate databases." The district court examined the intrinsic record and, finding the prosecution history compelling, construed the phrase to mean databases having: (1) an absence of compatible keys; and (2) an absence of record ID columns of similar value; and (3) an absence of record ID columns of similar format in the schemas or structures that would otherwise enable linking data. . . .

[W]e conclude that while "disparate databases" may be considered "incompatible databases," the plain and ordinary meaning leaves open the question of how "disparate" or "incompatible" the databases may be. [N]owhere in the specification is there any description of what is meant by "disparate databases" in terms of how disparate or incompatible the databases must be. VSi argues in this appeal that its expert, Dr. McLeod, stated that databases may be incompatible if they merely have different schemas. . . . VSi also argues that its

construction is supported by its stipulation with IBM and Oracle, but the fact that a claim construction was agreed to in the context of a different litigation is of little relevance or probative value here. IBM and Oracle's accused products may have functioned in a manner for which the precise scope of the "disparate databases" limitation was immaterial. Moreover, because defendants "were not parties" to the IBM and Oracle stipulation, "they are not bound by it." . . .

Because the specification, the stipulation and the referenced marketing materials leave uncertain the full scope and meaning of the term "disparate databases," we turn next to the prosecution history, which was central to the district court's claim construction. [A]pplicant stated that the disparate nature "refers to" an absence of common keys or record ID columns of similar value or format. An applicant's use of the phrase "refers to" generally indicates an intention to define a term. [T]he prosecution history only provides one definition and this meaning does not conflict with the plain and ordinary meaning of the term. . . .

The conjunctive interpretation is also consistent with proper grammar, where the phrase "'not A, B, or C' means 'not A, not B, and not c.'" Thus, proper grammar supports the district court's conclusion that disparate databases-which, as explained in the prosecution history, means an "absence of [A] compatible keys or [B] record identifier(ID) columns of similar value or [C] format"-should be understood as [A] an absence of compatible keys; and [B] an absence of record ID columns of similar value; and [C] an absence of record ID columns of similar format. Taken on its own, the applicant's statement that "[t]his disparate nature extends, for example, to the type of database (e.g. Oracle, IBM DB2, Microsoft SQL Server or Object Databases) and the structure, schema, and nature of the database . . . " might be read to suggest that two databases can be disparate based solely on the vendor of the database. But those are only cited as examples and follow the preceding sentences, which make abundantly clear that it is the absence of compatible keys etc., not any particular difference among the databases of different manufacturers, that is essential. Such a reading also conflicts with the applicant's statement during reexamination that "the type of protocol used to connect to one or more databases does not imply anything about the disparateness of those databases." . . .

A specification must "contain a written description of the invention." The test for the sufficiency of the written description "is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." The written description requirement is not met if the specification merely describes a "desired result." . . . A party must prove invalidity for lack of written description by clear and convincing evidence. We conclude that, drawing all reasonable inferences in favor of VSi as the non-movant, there are genuine issues of material fact regarding whether the specification shows possession of the claimed invention.

The specification of the patents-in-suit describes dynamically "accessing a plurality of incompatible source databases," and in originally filed claim 11 recited accessing "databases [that] are incompatible." The fact that these portions of the specification do not speak in haec verba of accessing "disparate databases" does not eliminate as a genuine issue of material fact the existence of at least some discussion, and, therefore, possession, of the accessing of disparate databases, as claimed. The more telling question is whether the specification shows possession by the inventor of how accessing disparate databases is achieved. . . . Dr. Cárdenas's opinion, which was not challenged by any contrary expert testimony, at least raises a genuine issue of material fact regarding whether the patents-in-suit disclose how to access disparate databases. Accordingly, we reverse the district court's determination of summary judgment that the claims asserted against TIBCO are invalid for lack of written description support. . . .

A specification must "enable" a person of skill in the art to make and use the claimed invention. Enablement is a legal question based on underlying factual determinations. A claim is sufficiently enabled even if "a considerable amount of experimentation" is necessary, so long as the experimentation "is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." On the other hand, if "undue experimentation" is needed, the claims are invalid. In determining whether experimentation is undue, [there are] a number of factors to consider: "They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims." A party must prove invalidity for lack of enablement by clear and convincing evidence.

We conclude that there are genuine issues of material fact . . . which, taken together, preclude summary judgment of non-enablement. First, we find that the effort it took the inventor to reduce the invention to practice does not conclusively show a lack of enablement. The inventor testified that he developed a "commercial-grade software product." "Title 35 does not require that a patent disclosure enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment," so the time it took to make a commercial-grade embodiment is not, itself, determinative of non-enablement. VSi claims that the inventor could have developed a functional prototype with far less experimentation. This is buttressed by Dr. Cárdenas' opinion that the inventor's one man-year experimentation was not undue. And, as with written description, neither defendant provided contrary expert testimony.

Second, drawing all reasonable inferences in favor of VSi, we find that there is a genuine issue of material fact whether the '006 patent specification provides a reasonable amount of guidance. . . . While the question may be close, the existence of at least the above-noted genuine issues of material facts is sufficient to defeat summary judgment of invalidity. Accordingly, we reverse the district court's grants of summary judgment that the asserted claims are invalid for lack of enablement.