

Federal Circuit Patent Bulletin: *Atlas IP, LLC v. St. Jude Medical, Inc.*

October 29, 2015

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On October 29, 2015, in *Atlas IP, LLC v. St. Jude Medical, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Moore, Reyna, Taranto*) vacated and remanded the district court's summary judgment that St. Jude did not infringe U.S. Patent No. 5,371,734, which related to a protocol for controlling wireless network communications between a hub and remotes. The Federal Circuit stated:

The district court . . . construed the highlighted language in clause [c] to mean "the hub transmitting to the remotes information necessary to know in advance the starting time and duration of the communication cycle and of each of two or more predeterminable intervals during each communication cycle." Then, on St. Jude's motion for summary judgment, the court went beyond that construction. The court held that its "in advance" requirement meant that the information specifying "when the communication cycle starts and its duration . . . must be transmitted in advance of the very communication cycle at issue." That is, it construed the "transmitting" limitation to require not just that specified information be transmitted to remotes before the remotes begin transmitting in that cycle, . . . but that "the hub transmits to the remotes information necessary to know the starting time and duration of the communication cycle in advance of that communication cycle." Atlas agreed that there was no infringement "under this interpretation of 'in advance.'" The district court therefore granted St. Jude summary judgment of non-infringement and entered a final judgment.

[We hold] that the claim language at issue does not require that the cycle's starting time and duration be communicated to the remotes even earlier, i.e., before the communication cycle begins. The district court's contrary conclusion, adopting St. Jude's argument, rests at bottom on the notion that, unless that information is sent before the start of the cycle, the remotes would not be awake to receive the hub-sent information about the cycle. But the patent does not support that premise or, therefore, the district court's construction.

Nothing in the claim language requires that the hub transmit information to the remotes about the starting time of the communication cycle before the start of the communication cycle. The claims recite that the hub establishes repeating communication cycles and then transmits information to the remotes to establish the communication cycle and its intervals. The claims also state that the remotes power off their transmitters and receivers for times outside the relevant interval. Nowhere do the claims indicate that the starting time of the

communication cycle is communicated in advance of that cycle.

Similarly, the claims do not require that the duration of the communication cycle be sent in advance of the communication cycle, and nothing in the intrinsic record dictates that result. Other claim language positively suggests, if it does not necessitate, that information about the duration may be sent during the communication cycle. Clause [g] of claim 14 itself recites that “the hub transmit[s] a frame containing information describing the length of the communication cycle prior to the end of the communication cycle whose length is established.” Claim 33, which also contains the transmitting clause [c], states that “the hub transmit[s] a frame containing information to establish a first interval in the communication cycle during which the information establishing the communication cycle . . . is transmitted.” . . .

St. Jude therefore rests its argument ultimately on the repeated assertion, which persuaded the district court, that the claimed invention, in order to function, requires at least the starting-time information (perhaps also the duration information) to be sent to the remotes before the cycle begins. Unless the hub did so, St. Jude argues, the remotes could not know to power on their receivers for the start of the cycle and so would not receive the scheduling information (allotting reception and transmission intervals) sent from the hub in the first part of the cycle. As a legal matter, of course, “a construction that renders the claimed invention inoperable should be viewed with extreme skepticism.” But that principle does not decide this case. St. Jude has not shown that the district court’s construction must be adopted in order to avoid inoperability.

[N]either the specification nor operability requires sending the remotes the starting time or duration of an upcoming communication cycle before the cycle commences. In fact, the specification explicitly contemplates the remotes functioning by knowing “approximately when to expect frames transmitted from the hub.” St. Jude has not explained why it is insufficient for the remotes to know roughly “when to expect” an upcoming cycle to begin, not its exact starting time, and why that information cannot be supplied by providing a cycle’s starting time and duration during a given cycle. In particular, St. Jude has not explained why that information would not suffice to allow the remotes to have their receivers on for whenever the next cycle actually starts. By default the remotes turn on their receivers when they first power on and await a signal from the hub. They will therefore receive a “first” cycle’s scheduling-information frame, which can communicate the starting time (which has already passed) and duration for that particular cycle. If the cycles “repeat[] on a continuous basis,” the receipt of that information would seem to allow the remotes to have their receivers on when the next cycle begins, and thus receive the next-cycle scheduling information. St. Jude has not shown otherwise. . . .

We conclude that the district court erred in construing the “transmitting” limitation to require that the starting time and duration of a communication cycle be sent in advance of the communication cycle. Because there is no ruling about infringement under any other claim construction, we vacate the summary judgment of non-infringement and remand for further proceedings.