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Federal Circuit Patent Bulletin: In re *Affinity Labs of Texas, LLC*

May 8, 2017

"[E]ach of the five steps of method claim . . . are offset by semicolons. This punctuation choice strongly indicates that each step is separate and distinct."

On May 5, 2017, in *In re Affinity Labs of Texas, LLC*, the U.S. Court of Appeals for the Federal Circuit (Taranto, Chen,* Stoll) affirmed the U.S. Patent and Trademark Office Patent Trial and Appeal Board decision in the inter partes reexamination of U.S. Patent No. 7,440,772, which related to an audio download method whereby content (e.g., a music file) is made available for download to different devices (e.g., an mp3 player and a personal computer). The Federal Circuit stated:

In particular, the '772 patent discloses a graphical user interface that allows a user to search for and select audio files and to also select multiple destination devices to which the selected audio files will be sent. According to Affinity, one of the key features of the '772 patent is the so-called dual download feature, whereby a user makes a single request to download content via the user interface of a first device and the selected content is downloaded to the first device in a format suitable to that device and also to a second device in a format suitable to that second device. . . .

The parties agree that the dual download feature is embodied in the last three claim elements of claim 4, beginning with "in response to receiving the request." Central to the parties' dispute, however, is whether the "in response to" language modifies only the immediately following "making . . . available" step or also modifies (and thus triggers) the two following "sending" steps. During reexamination, the Examiner found that "[t]he claim merely requires that the selectable

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content be ‘made available’ to both devices in response to the request, but it does not require that the content can be sent to both devices in response to the request.” In other words, the Examiner explained, “the two claimed ‘sending’ steps are not specified as being ‘in response to receiving the request.’” The Board explicitly adopted the Examiner’s construction and found that “one of the downloads may be made following a subsequent request.” So construed, the Board concluded that all claims are unpatentable as obvious over the asserted prior art. . . .

During reexamination, the Board must construe claims giving them their broadest reasonable interpretation consistent with the specification. We review the Board’s ultimate construction de novo and any underlying factual determinations for substantial evidence. When findings of fact extrinsic to the patent are not at issue, as here, we review de novo the Board’s determination of the broadest reasonable interpretation of the claims.

We have considered Affinity’s argument and disagree with its narrow interpretation of the dual download feature. The plain language of claim 4 does not require the selected content to be sent to the two devices in response to the same request found in the preceding “making . . . available” step. We note that each of the five steps of method claim 4—including the three steps of the so-called dual download feature—are offset by semicolons. This punctuation choice strongly indicates that each step is separate and distinct. It would, therefore, be reasonable to conclude the fourth and fifth steps—the sending steps—are not tied to the “making . . . available” step and not performed “in response to” the same request found in the “making . . . available” step, as Affinity suggests.

Moreover, claim 4 uses the transition “comprising,” indicating that the claimed method is open-ended and allows for additional steps. This language choice signals that the breadth of claim 4 allows for additional steps interleaved between the recited steps. Therefore, it was reasonable for the Board to conclude that claim 4 does not prohibit additional, intervening steps, between the “making . . . available” step and the “sending” steps—such as an additional request to send the requested content to a specific device.

In addition, we disagree with Affinity that the specification supports only its understanding of the claim. The passage on which Affinity relies refers to “selecting” destination devices for possible downloads and provides only that, in one contemplated embodiment, the requested information “may be communicated to more than one destination device.” Moreover, the passage concludes that the format of the download “may match or conform to the selected destination device(s).” This passage is indeed consistent with the notion that the selected content may be downloaded to multiple destination devices in the format appropriate to each device. However, it is hardly a command that the requested content must be simultaneously and automatically downloaded to all selected destination devices based on a single request, without any subsequent action by the user. The specification elsewhere in fact contemplates embodiments to the contrary: “In another embodiment, homepage 401 may allow a user to select when to download the information to an electronic device.” Thus, the specification also supports the reasonableness of the Board’s construction.

We conclude that the Board’s claim construction is correct, particularly under the broadest reasonable interpretation rule. Affinity concedes that if this court affirms the Board’s claim construction, the challenged claims would be unpatentable based on the grounds asserted in the reexamination.