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Federal Circuit Patent Bulletin: *MasterMine Software, Inc. v. Microsoft Corp.*

November 20, 2017

"[Where] the claims merely use permissible functional language to describe the capabilities of the claimed system, it is clear that infringement occurs when one makes, uses, offers to sell, or sells the claimed system."

On October 30, 2017, in *MasterMine Software, Inc. v. Microsoft Corp.*, the U.S. Court of Appeals for the Federal Circuit (Newman, O'Malley, Stoll*) affirmed-in-part, reversed-in-part, and remanded the district court's judgment that Microsoft did not infringe U.S. Patents No. 7,945,850 and No. 8,429,518, which related to methods and systems that allow a user to easily mine and report data maintained by a customer relationship management (CRM) application, and that the asserted claims were invalid for indefiniteness under 35 U.S.C. § 112. The Federal Circuit stated:

Claim construction seeks to ascribe the "ordinary and customary meaning" to claim terms as a person of ordinary skill in the art would have understood them at the time of invention. "[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms." In addition, "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." But "[w]hile we read claims in view of the specification, of which they are a part, we do not read limitations from the embodiments in the specification into the claims."

MasterMine argues that the district court improperly construed the term "pivot table," which it proposes should be construed as a "computer software object [or structure] defining an interactive table

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that can show the same data from a list or a database in more than one arrangement. In other words, MasterMine contends that the district court's construction is incorrect because it excludes tables that do not display data. According to MasterMine, its proposed construction is consistent with the patents' specification and "fits easily when read into the claims." We disagree.

First, the claim language supports the district court's construction. Each time the claims recite the generation of a pivot table, they further recite within the same limitation that the generated pivot table contains data or presents data. . . . The patents' identical specification further supports the district court's construction. [T]he specification explains that the purpose of pivot tables in the context of the invention is to display data that can be viewed, summarized, and manipulated by users, and such user action is available upon the generation of the pivot tables. This understanding comports with the district court's construction—tables containing data "that can be rotated and filtered to summarize or view the data in different ways." Finally, the prosecution history of the patents provides additional support for the district court's construction. During prosecution of a related parent patent, the applicant, in an attempt to overcome prior art rejections, distinguished a prior art reference, referred to as Conlon, and emphasized that a pivot table is created when filled with data . . . . We agree with the district court, which found that this statement demonstrates a "represent[ation] to the PTO that a pivot table is 'create[d]' when the user selects fields by dragging and dropping them into the spreadsheet—i.e., when the user populates the table." We further agree with the district court, however, that this statement is not "so clear as to show reasonable clarity and deliberateness, and so unmistakable as to be unambiguous evidence of disclaimer." Nevertheless, this explanation presented by the inventor during patent examination is relevant to claim construction, "for the role of claim construction is to 'capture the scope of the actual invention' that is disclosed, described, and patented." Thus, while this statement does not amount to disclaimer, it does, at a minimum, further support the district court's construction. . . .

MasterMine also challenges the district court's determination that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness. Pursuant to 35 U.S.C. § 112, ¶ 2, a patent specification must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Supreme Court has held this definiteness provision "to require that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." "Indefiniteness is a question of law that we review de novo, subject to a determination of underlying facts." . . .

Here, the district court determined that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness for introducing method elements into system claims. We disagree. In our view, these claims are simply apparatus claims with proper functional language. . . . [Our precedent has been] concerned that claiming both an apparatus and a method of using the apparatus within a single claim can make it "unclear whether infringement . . . occurs when one creates a[n infringing] system, or whether infringement occurs when the user actually uses [the system in an infringing manner]." The claims at issue here do not pose this problem. Because the claims merely use permissible functional language to describe the capabilities of the claimed system, it is clear that infringement occurs when one makes, uses, offers to sell,

or sells the claimed system. Accordingly, because these claims inform those skilled in the art about the scope of the invention with reasonable certainty, we reverse the district court's determination that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid as indefinite.