

## Federal Circuit Patent Bulletin: *Profectus Tech. LLC v. Huawei Techs. Co.*

May 27, 2016

*"[Where the proper claim construction requires] a standalone inherent feature in the device[, it] is not enough that the [accused] feature . . . could potentially [perform the same function as the claimed feature]."*

On May 26, 2016, in *Profectus Tech. LLC v. Huawei Techs. Co.*, the U.S. Court of Appeals for the Federal Circuit (Moore, Reyna,\* Wallach) affirmed the district court's summary judgment that the defendants did not infringe U.S. Patent No. 6,975,308, which related to a mountable digital picture frame for displaying digital images. The Federal Circuit stated:

The words of a claim are generally given their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art at the time of the invention. Claim language must be viewed in light of the specification, which is the "single best guide to the meaning of a disputed term." [W]e first look to the actual words of the claims and then read them in view of the specification. Although courts are permitted to consider extrinsic evidence (e.g., expert testimony, dictionaries, treatises), such evidence is generally of less significance than the intrinsic record. Extrinsic evidence may not be used "to contradict claim meaning that is unambiguous in light of the intrinsic evidence." "The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction."

When read in view of the specification, the claims do not permit the expansive construction proposed by Profectus. The term "mountable" is a modifying word in the claims: "mountable picture display" (claims 1, 13, 22, 29, 31); "mountable picture frame" (claims 1, 22, 29); "wall mountable" (claims 6, 13, 22, 31); "desk top mountable" (claims 6, 22). Absent from the claims are words that embrace broader meaning, such as "capable of," "adapted to," or "configured to." The claim language is tailored to, characterizes, and delimits the claimed "picture frame" and "picture display."

The specification confirms the district court's understanding that being mountable requires having a feature for mounting. In every embodiment disclosed in the specification, the picture display or frame includes a feature for mounting the device to a wall or on a tabletop. . . . The specification does not disclose a bare embodiment in which the picture display or picture frame lacks a feature for mounting. By noting that the picture display or frame must have some intrinsic mounting feature, the district court correctly recognized,

consistent with the claim language and specification, that the picture display or frame must include something that may be used for mounting the device. We agree with the district court that Profectus's dictionary definition does not inform the analysis. We see no reason to depart from the intrinsic record.

Profectus maintains that requiring a mounting feature reads in a preferred embodiment. We disagree. Profectus fails to pinpoint in the intrinsic record where the patent contemplates a situation where no mounting features exist. The district court's construction does not preclude the use of external components or accessories; the construction requires merely that a feature exist with the claimed picture display or picture frame for mounting. Such a construction does not read out the adjoining claim terms and still requires the mountable object to be digital picture displays or digital picture frames. The district court did not improperly limit the scope of the invention through claim construction. . . .

The infringement inquiry asks if an accused device contains every claim limitation or its equivalent. . . . We agree with the district court that under the proper construction, there exists no genuine dispute of material fact that the communication ports and the cited physical characteristics of the accused devices do not meet the "mountable" limitations. The district court properly concluded that the communication ports are features for power, data, and communication, and not inherent features for mounting. That an external component can utilize a communication port to help prop an accused device does not convert the port into an inherent feature for mounting. Indeed, there is no evidence that, standing alone, the communication ports make the accused devices mountable for viewing, as, for example, set out in Figure 4 of the patent. As the brochures and un rebutted expert testimony showed, the docking station has a design that works to support the accused devices, and that solely connecting the docking station to the communication port does not provide adequate support.

Conversely, there is no evidence that the communication ports are developed as inherent features for mounting the devices on a wall or tabletop. To conclude otherwise could render any digital display device susceptible to infringement to the extent an external object can be used to grasp onto any feature of the device that is not related to mounting. . . . Under the court's construction, the feature must be a standalone inherent feature in the device. It is not enough that the feature is "just a feature that could potentially render the frame or display capable of being mounted." Here, no reasonable jury could find that because the communication port is incidentally capable of being used in conjunction with an external docking port to prop a device on a tabletop, the "mountable" limitation is met.

Although certain intrinsic physical features may combine to aid in mounting with external components, as the district court found, those features must be for mounting to meet the claim limitations. Hence, while the accused devices are capable of mounting by exploiting the communication ports and being easy to prop up due to their size and weight, we conclude that those characteristics do not make the accused devices mountable as claimed and fail to raise a genuine dispute of material fact as to whether features for mounting (or their equivalents) are present within the accused devices. There is no genuine dispute of fact that the accused devices were conceived apart from external accessories like docking stations: the docking stations were designed to work with the accused devices (not that the devices were designed to have features for mounting to the docking stations). Unrebutted testimony showed that the shape of the accused devices had

little to do with the ability to mount the devices on docking stations. Rather, if the accused devices remained upright, it is because the docking stations created an environment to prevent featureless devices from toppling over.