

PTAB Strategies and Insights

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The PTAB Strategies and Insights newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

Kind Regards,

[Jason D. Eisenberg](#)
Editor

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By: [Randy Montgomery](#) and [Jason D. Eisenberg](#)

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This commendable effort, as described by the acting Director, “is another example of the USPTO’s commitment to level the playing field for all inventors and provide equitable access to all aspects of our world-class innovation ecosystem...We don’t want the cost of legal services to be a barrier to pursuing a patent for anyone. We are excited to partner with the PTAB Bar Association on this program, which will benefit inventors, practitioners, and the entire patent community.”

Similar programs are available through various law school clinics. Our firm has worked with the [Cardozo Patent Diversity Project](#) as an example. Their goal is “to increase the number of U.S. patents issued to women and inventors of color.”

The USPTO encourages the patent bar to consider signing up for each *pro bono* program to give back to deserving entrepreneurs during all phases of the patent and trademark processes.

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The Federal Circuit issued two cases this week providing more clarity to when a functional claim feature should be considered a de facto means-plus-function claim that requires structural detail to meet the indefiniteness standard.

The first was a precedential decision, [Dyfan LLC v Target Corp.](#), Case No. 2021-1725, and the second was a non-precedential decision, [VDPP LLC v Vizio Inc.](#), Case No. 2021-2040.

In *Dyfan*, Judge Stoll writing for the Court (Lourie, Dyk, and Stoll) was reviewing a western district of Texas court's holding of indefiniteness under 35 U.S.C. § 112, 2nd paragraph, for lack of sufficient structure based on the District Court finding the claims de facto 35 U.S.C. § 112, 6th paragraph, format. The Court reversed and remanded finding the claims should not have been converted to means-plus-function claims.

Representative claim 15 and disputed terms (emphasis in original) are:

15. A system, comprising:
 - a building . . . including:
 - a first broadcast short-range communications unit. . .
 - a second broadcast short-range communications unit. . .
 - code configured to be executed by at least one of the plurality of mobile devices, the code, when executed, configured to:
 - cause display, via a display of the at least one mobile device, of an option for causing first visual information and second visual information to be output via the at least one mobile device . . .
 - receive an indication of a receipt, from the first broadcast short-range communications unit and via the first wireless communications protocol, of the one or more first broadcast messages including the at least one first value,
 - in response to the indication of the receipt, from the first

broadcast short-range communications unit and via the first wireless communication protocol, of the one or more first broadcast messages including the at least one first value: cause to be sent, from the at least one mobile device and via a second wireless communications protocol and an Internet Protocol over the Internet at least in part, at least one first message . . .

at least one server that is configured to communicate with the at least one mobile device via the Internet . . .

said code, when executed, further configured to:

receive, from the at least one server and via the second wireless communications protocol, the first response message including the first location-relevant information,

in response to the receipt, from the at least one server and via the second wireless communications protocol and the Internet Protocol over the Internet at least in part, of the first response message including the first location-relevant information: cause to be output, via the at least one mobile device, the first visual information based on the first location-relevant information,

receive, from the at least one server and via the second wireless communications protocol, the second response message including the second location-relevant information,

after the first visual information is caused to be output based on the first location-relevant information; after the at least one mobile device is moved in the building; and in response to the receipt, from the at least one server and via the second wireless communications protocol, of the second response message including the second location-relevant information: cause to be output, via the at least one mobile device, the second visual information based on the second location-relevant information;

wherein the system is configured such that the first visual information is automatically caused to be output without requiring communication of the at least one first message with the first broadcast short-range communications unit after the receipt of the indication of the receipt of the one or more first broadcast messages, and the second visual information is automatically caused to be output without requiring communication of the at least one second message with the second broadcast short-range communications unit after the receipt of the indication of the receipt of the one or more second broadcast messages.

In *VDPP*, Judge Lourie writing for the Court (Newman, Lourie, and Taranto) was reviewing a central district of California court's holding of indefiniteness under 35 U.S.C. § 112(b) for lack of supporting structure based on the District Court finding the claims de facto 35 U.S.C. § 112(f), format. The Court reversed and remanded finding the claims should not have been converted to means-plus-function claims.

Representative claim 1 at issue and disputed terms (emphasis in original) are:

1. An apparatus comprising:
 - a **storage** adapted to:
 - store one or more image frames;
 - and
 - a **processor** adapted to:
 - obtain a first image frame from a first video stream;
 - expand the first image frame to generate a modified image frame, wherein the modified image frame is different from the first image frame;
 - generate a bridge frame, wherein the bridge frame is a non-solid color, wherein the bridge frame is different from the first image frame and different from the modified image frame;
 - blend the modified image frame with the bridge frame to generate a blended modified image frame; and
 - display the blended modified image frame.

Both panels found indefiniteness and whether a claim is means-plus-function are legal issues reviewed de novo, the latter relying on *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346 (Fed. Cir. 2015). The Court explained, absent explicit "means" language, a presumption forbids conversion to means claim but "claims are nevertheless subject to § 112 ¶ 6 when the limitation in question has 'no commonly understood meaning and is not generally viewed by one skilled in the art to connote a particular structure.'" *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1372 (Fed. Cir. 2015)." *Dyfan*, at 10.

Dyfan

For the code/application claim features, the *Dyfan* panel relied on patent owner un rebutted expert testimony that the disputed terms connote a class of structure to a POSA. *Dyfan*, at 13. Here, the Court also relied on *Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1007 (Fed. Cir. 2018)(concluding that the disputed terms are used “not as generic terms or black box recitations of structure or abstractions, but rather as specific references to conventional . . . code, existing in prior art at the time of the inventions.”))

For the system claim feature, the *Dyfan* panel stated an abstract “system” term can be a nonce term, but then the panel carefully crawled through the lengthy claim features and found “the ‘system’ limitation in the wherein clause derives antecedent basis from the ‘system’ recited in the preamble, which the claim states comprises ‘a building’ having ‘a first broadcast short-range communications unit,’ ‘a second broadcast short-range communications unit,’ ‘code’ executed by at least one ‘mobile device,’ and ‘at least one server.’ ... Each of these limitations recited in the claims are structural components of the “system.” *Dyfan*, at 17.

VDPP

VDPP cites to *Dyfan* for several points, and thus follows from *Dyfan*.

The Court was evaluating the “processor” and “storage” features. The Court first pointed out rebutting the presumption requires the challenger to provide at least some evidence that a POSA would not have understood the limitations to recite sufficiently definite structure. *VDPP*, at 6. Yet Vizio provided none, such that the district court’s analysis was erroneous. The Court next pointed out the district court overlooked intrinsic evidence showing the challenged terms connote structure to a POSA. *Id.*, at 7. Thus, “processor” and “storage” are not merely black boxes performing functions. *Id.*

Finally, the Court emphasized challenger’s arguments on appeal went to step (2) of the Section 112(f) analysis, of whether there is sufficient structure, and not step (1), whether the claim terms is a de facto means claim.

A key takeaway from these cases is indicated by the *Dyfan* panel – the absence of the word “means” in a claim does not suggest courts should bypass the presumption that a claim does not invoke § 112 ¶ 6/112(f) or relieve courts of their duty to evaluate whether that presumption has been overcome.

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