

Keywords: enablement; scope of claims

General: The Federal Circuit continues to reinforce the requirement that the full scope of a claim be enabled for the claim to be valid under the first paragraph of 35 U.S.C. § 112. If a disclosure does not enable a device that is covered by a claim, an infringement action asserting that claim will likely result in its invalidation for lack of enablement.

David H. Sitrick v. Dreamworks, LLC

No. 07-1174r (Fed. Cir. 2008)

Decided February 1, 2008

I. Facts

An individual inventor, David Sitrick (Sitrick) sued Dreamworks, LLC, and eight other movie studios, (Dreamworks) in the District Court for the Northern District of Illinois. In the suit, Sitrick alleged that Dreamworks' "Re-voice Studio" software infringed claims 54 and 56 of U.S. Patent No. 5,553,864 (the '864 patent) and claims 1, 20, 49, 58, 62, 64, and 69 of U.S. Patent No. 6,425,825 (the '825 patent). On Dreamworks' motion, the case was transferred to the Central District of California. Dreamworks moved for claim construction and a summary judgment of invalidity for lack of enablement. A Special Master recommended denying the motion, as neither side had presented evidence of the ordinary skill in the art. The district court decided not to follow the recommendation and granted summary judgment for Dreamworks, finding that all asserted claims of the '864 patent and the '825 patent were invalid for lack of enablement as to movies.

The district court found that both patents are fundamentally based on a unit called an "Intercept Adapter Interface System (IAIS)," which is described as intercepting address signals coming from a video game system that are sent to a game card or storage card. The address signals identify unique graphic elements that correspond to an image in a video game. The intercepted address signals may then be used to replace the original video game image with a user generated image, allowing, for example, a graphic image of the user to be an apparent part of the game. Based on the disclosure, the defendants moved that the claims should be limited to video games, excluding the allegedly infringing devices. Even though no specific apparatus was disclosed that could be used to perform the same character replacement function for movies as for video games, Sitrick argued that the claims did encompass movies and convinced the court to deny the defendant's motion. Thus, the court found that the allegedly infringed claims do encompass substitutions of graphical elements in movies.

However, the district court found that "movies do not employ discrete address . . . signals or any other means for requesting separate image segments." Accordingly, the court agreed with Dreamworks' expert that the disclosure related to video games did not enable the use of the IAIS to substitute user images for images in a movie. Further, the court found that the '864 patent failed to enable modeling a voice for reproduction by a voice synthesizer, as in claim 54 of the '864 patent.

For these reasons, the district court concluded that Sitrick had not raised any genuine issues of material fact regarding enablement of the substitution of images in movies or the modeling of a voice for reproduction by a synthesizer. The court held that all of the contested claims of both patents were invalid for lack of enablement and granted Dreamworks' motion for summary judgment. Sitrick appealed the summary judgment to the Federal Circuit.

II. Issue

Must the full scope of a claim be enabled for the claim to be considered valid?

III. Discussion

Yes. The Federal Circuit explicitly stated “the full scope of the claimed invention must be enabled,” citing the recent decision in *Auto Techs Int’l, Inc. v. BMW of N. Am.*, 510 F.3d 1274 (Fed. Cir. 2007). The court framed this as a policy decision based on the tradeoff between public knowledge and the scope of the claims. The court stated that enabling the full scope of each claim is “part of the *quid pro quo* of the patent bargain.” *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). The court indicated that a patentee using broad claims must ensure that the claims are fully enabled, stating that “the scope of the claims must be less than or equal to the scope of enablement.”

In the present applications, the scope of the claims was construed to include both movies and video games. Sitrick agreed with this construction, but argued that the district court erred by not allowing the teachings on video games to provide enablement for the full scope of the claims. However, the Federal Circuit disagreed, stating that since the claims cover both video games and movies, the patent must enable both embodiments.

The court held that Dreamworks showed with clear and convincing evidence that one of ordinary skill in the art could not have used the disclosure of the ‘864 patent or the ‘825 patent to substitute a user generated image for an image in a movie. Specifically, no information in either patent disclosed how the IAIS would function for this purpose, as the addresses intercepted by the IAIS are not relevant to movies.

Sitrick argued that the testimony of his expert raised a general question of material fact, but the court disagreed. The district court had stated that the testimony was conclusory, unsupported by factual information, and not presented by a person skilled in the art of movie making. The Federal Circuit agreed, noting that conclusory expert testimony cannot raise triable issues of material fact. With respect to claim 54 of the ‘864 patent, the Federal Circuit also agreed with the district court’s conclusion that the claim was not enabled, noting that no evidence was presented to contradict Dreamworks’ assertion that no modeling of a voice, required for the synthesizer, was disclosed.

On a final, and, apparently, somewhat desperate note, Sitrick argued that the transfer of the case from the Northern District of Illinois to the Central District of California was improper. The Federal Circuit noted that Sitrick had argued the case for three years in the Central District of California, after the transfer, without raising this issue. Furthermore, during those three years Sitrick filed multiple amended complaints acknowledging that venue was proper in the Central District of California. Accordingly, the court held that he had waived the right to complain about the transfer.

For the reasons discussed above, the court upheld the findings of the district court in all respects, stating that claims 54 and 56 of the ‘864 patent and all asserted claims of the ‘825 patent were not enabled. Accordingly, the court declined to consider any other issues, such as infringement.

IV. Conclusion

Overreaching in claim scope and claim interpretation should be avoided. In this case, although the asserted claims arguably covered the infringing device, that embodiment was not enabled by the disclosure. Accordingly, the Federal Circuit invalidated all asserted claims.