

Keywords: 35 U.S.C. § 112, 6th paragraph; indefiniteness

General: The Fed. Circuit affirms the District Court’s application of 35 U.S.C. § 112, 6th paragraph, despite an absence of ‘means’, and determines the claims to be indefinite due to a lack of sufficient structure in the disclosure.

Media Rights Technologies, Inc. v Capital One Financial Corporation
No. 1:12-cv-00476-AJT-TRJ (Fed. Cir. 2015)

I. Facts

Media Rights Technologies, Inc. (“Media Rights”) owns U.S. Patent No. 7,316,033 (“the ‘033 patent”), which is directed toward a system for preventing the unauthorized recording of electronic media. Claim 1 of the patent is reproduced below.

1. A method of preventing unauthorized recording of electronic media comprising:
activating a *compliance mechanism* in response to receiving media content by a client system, said *compliance mechanism* coupled to said client system, said client system having a media content presentation application operable thereon and coupled to said *compliance mechanism*;
controlling a data output path of said client system with said *compliance mechanism* by diverting a commonly used data pathway of said media player application to a controlled data pathway monitored by said *compliance mechanism*; and
directing said media content to a custom media device coupled to said *compliance mechanism* via said data output path, for selectively restricting output of said media content.

In 2013, Media Rights filed suit against Capital One Financial Cooperation (“Capital One”), alleging infringement of the patent. During the *Markman* hearing, Capital One contended that “compliance mechanism” was a means-plus-function term that should invoke 35 U.S.C. § 112, 6th paragraph. The District Court agreed and further concluded that the specification lacked sufficient structure to support this means-plus-function recitation that is present in each of the claims. Accordingly, the District Court ruled the claims of the ‘033 patent invalid for indefiniteness, and Media Rights subsequently appealed.

II. Issues

- 1) Did the District Court err in invoking 35 U.S.C. § 112, 6th paragraph?
- 2) Did the District Court err in determining that the claims were indefinite?

III. Discussion

- 1) No. The Courts have determined that a claim term that does not use the word ‘means’ will trigger the rebuttable presumption that 35 U.S.C. § 112, 6th paragraph, does not apply. However, this presumption against the application of 35 U.S.C. § 112, 6th paragraph, can be overcome “if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function’” *Williamson*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (en banc).

Media Rights acknowledged that “compliance mechanism” was not a term of ordinary skill in the art. The plaintiff instead attempted to argue that the situation was similar to that of *Inventio AG v. Thyssenkrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1357 (Fed. Cir. 2011), in which the claim term “modernizing device” was determined not to invoke 35 U.S.C. § 112, 6th paragraph. However, in *Inventio*, the Court determined that the “modernizing device” recited in the claims was merely a

substitute term for an electrical circuit whose interconnections and operation were well-documented in the specification. Therefore, the term in question was determined to connote sufficient structure, and therefore was determined not to be a means-plus-function term.

In contrast with *Inventio*, the Court determined that the term “compliance mechanism” of the ‘033 patent was not a substitute term for an electrical circuit, or anything else that might connote structure. The Court reasoned that the terms “compliance” and “mechanism” alone do not connote any particular structure. The specification disclosed that the recited “compliance mechanism” could include “one or more coder/decoders, one or more agent programs, and one or more skins, but not instructions, a user ID generator, system hooks, a wave shim, or a custom media device driver.” However, the specification of the ‘033 patent focused on how the “compliance mechanism” is connected to and interacts with various parts of the system. As such, the “compliance mechanism” is described in an almost entirely functional manner, and what little structure presented was indicated as not being required for the operation of the system. As such, since the claim term “compliance mechanism” appears to be devoid of structure, the District Court was correct to apply 35 U.S.C. § 112, 6th paragraph, despite an absence of a ‘means’ claim term.

2) No. Once a claim term has been identified as a means-plus-function term, then the Court “attempt[s] to construe the disputed claim term by identifying the ‘corresponding structure, material, or acts described in the specification’ to which the claim term will be limited.” *Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1097 (Fed. Cir. 2008). One key point is that where there are multiple claimed functions, the written description must disclose adequate corresponding structure to perform all of the claimed functions. The parties agreed that the claims at issue recite four functions of the “compliance mechanism”: controlling data output by diverting a data pathway; monitoring the controlled data pathway; managing an output path by diverting a data pathway; and stopping the play of media content. The Court determined that the specification at least failed to disclose an operative algorithm for both the “controlling data output” and “managing output path” functions, which both require diverting a data pathway. Additionally, the Court determined that the specification did not disclose sufficient structure for the “monitoring” function, whereby the “compliance mechanism” is to ensure there is no unauthorized recording of electronic media based on a set of rules. In particular, the written description included no details regarding these rules or how the “compliance mechanism” determines whether the rules are being enforced. As such, the District Court was correct in finding that the written description was insufficient to support the means-plus-function term “compliance mechanism,” and, therefore, was correct in determining the claims to be indefinite.

IV. Conclusion

Avoid using the term “means” unless attempting to invoke 35 U.S.C. § 112, 6th paragraph, but be aware that you may still inadvertently create a means-plus-function term when the written description lacks sufficient structure for the claim term to merely be a substitute for the intended structural feature. If there are multiple claimed functions, the written description must disclose adequate corresponding structure to perform all of the claimed functions.

IV. Quote

Because these functions are computer-implemented functions, moreover, the structure disclosed in the specification must be more than a general purpose computer or microprocessor. *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (citing *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999)). Instead, we require that the specification disclose an algorithm for performing the claimed function. See *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008). The algorithm may be expressed as a mathematical formula, in prose, as a flow chart, or in any other manner that provides sufficient structure. *Noah*, 675 F.3d at 1312 (citing *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323,1340 (Fed. Cir. 2008)).