

Keywords: Claim construction, Disclaimer of claim scope, Indefiniteness, Apparatus claims with functional language

General: Disparaging comments about some techniques in the specification may be interpreted as a disclaimer of claim scope during claim construction. Functional language in an apparatus claim that is not directed to the capabilities of the apparatus may render a claim indefinite.

UltimatePointer, L.L.C. v. Nintendo Co., Ltd. And Nintendo of America Inc.
No. 2015-1297 (Fed. Cir. March 1, 2016)

I. Facts

UltraPointer owns the ‘729 patent, directed to a handheld device (similar to a laser pointer) that allows a user to control the position of a cursor on a projected screen. Claim 1 of the ‘729 recites:

1. An apparatus for controlling a feature on a computer generated image, the apparatus comprising:

a handheld device including:

an image sensor, said image sensor generating data related to the distance between a first point and a second point, the first point having a predetermined relation to the computer generated image and the second point having a predetermined relation to a handheld enclosure; and

a processor coupled to said handheld device to receive said generated data related to the distance between a first point and a second point and programmed to use the distance between the first point and the second point to control the feature on the image.

The specification of the ‘729 patent describes two types of pointing devices: direct pointing devices and indirect pointing devices. Direct pointing devices are devices in which the physical point of aim coincides with the item at which the device is pointed (e.g., a laser pointer, a stylus, or a finger on a touch screen). In contrast, indirect pointing devices are devices in which the object of pointing bears an indirect relationship to the physical point-of-aim of the pointing device (e.g., a computer mouse or track ball). The specification of the ‘729 patent expresses a preference¹ for direct pointing devices because indirect pointing devices are “less natural to human operators.” Each of the disclosed embodiments is a direct pointing device. However, the claims do not distinguish between direct and indirect pointing devices, and are drafted broadly enough to include both direct and indirect pointing devices.

UltraPointer sued Nintendo in the Eastern District of Texas for infringement by the Wii system. Nintendo of America, based in Redmond, Washington, moved to transfer the case to the Western District of Washington. The motion was denied. Nintendo petitioned for a writ

¹ “It needs no argument that direct-pointing systems are more natural to humans, allowing faster and more accurate pointing actions.”

of mandamus. While the petition for mandamus was pending, the claim construction took place in the Texas district court.

The Wii system includes a console, a remote, and a sensor bar that sits above or below a television and emits infrared light. The remote detects the infrared light emitted by the sensor bar and transmits information regarding the light to the console, which displays corresponding images on the television. Because activity on the television takes place based on the spatial relationship between the remote and the sensor bar, the parties agreed that the Wii remote was an indirect pointing device.

During claim construction, the Texas district court construed “handheld device” to be limited to a direct pointing type device because the specification of the ‘729 patent made clear that the invention was a direct pointing device. Following claim construction, the writ of mandamus was granted and the case was transferred to the Washington district court. Because the parties agreed that the Wii remote was an indirect pointing device, and thus not a “handheld device” as the claims had been construed, the Washington district court granted summary judgment of non-infringement.

In a separate opinion, issued on the same day, the Washington district court concluded that the claim limitation “a handheld device including: an image sensor, said image sensor generating data...” was indefinite because it was unclear if the claim, which recited both an apparatus and a method step, was directed to an apparatus or a method.

II. Issues

- A. Did the Texas district court err in construing the term “handheld device” to be limited to direct pointing devices?
- B. Did the Washington district court err granting summary judgment finding noninfringement?
- C. Did the Washington district court err in finding claims 1, 3, 5, and 6 indefinite?

III. Discussion

- A. No. The panel agreed that the Texas district court correctly construed the term “handheld device” to include only direct pointing devices. Though claims terms are generally given their ordinary meaning, claims are construed in light of the specification. Repeated derogatory statements can indicate that the criticized technologies were not intended to be within the scope of the claims.

UltimatePointer argued that the embodiments discussed in the specification should not be used to restrict broad claim language. UltimatePointer further argued that claim scope can only be disclaimed by explicitly defining relevant claim terms in the specification. Nintendo argued that “handheld device” was properly construed as limited to direct pointing devices because direct pointing “is intertwined with every facet of the ‘729 patent” and the patent repeatedly extolls direct pointing and disparages indirect pointing.

The panel agreed with Nintendo that by emphasizing that the invention is a direct pointing system (indeed, the title of the patent is “Easily-Deployable Interactive Direct Pointing System”), and emphasizing how direct pointing is superior to indirect pointing, it is clear that a “handheld device” was intended to be a direct pointing device. When the specification conflicts with the plain meaning of a claim term, the specification prevails. An explicit definition of a claim term is not required.

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- B. No. The panel agreed that given the proper claim construction, the Washington district court properly granted summary judgment of noninfringement. Because the Wii remote is an indirect pointing device, it does not meet the definition of a “handheld device” adopted during claim construction.
- C. Yes. The panel found that the Washington district court erred in finding claims 1, 3, 5, and 6 of the ‘729 patent invalid as indefinite under 35 U.S.C. § 112. A single claim covering both an apparatus and a method of use of that apparatus is indefinite under 35 U.S.C. § 112 because it is unclear whether infringement occurs when one creates an infringing system, or when a user actually uses the system in an infringing manner. However, apparatus claims are not necessarily indefinite for using functional language. If the claim is clearly limited to an apparatus *capable* of performing the recited functions, it is not indefinite.

UltimatePointer argued that the claim merely recited a handheld device *capable* of performing the recited functions. Nintendo argued that the claims do not clearly tie the functional language to the device’s capability, and are therefore indefinite.

The panel found that the functional language of the disputed claims does indeed recite the *capability* of the handheld device. The panel found that the “data generating” limitations only require that the handheld device be capable of generating data, and not that the data actually be generated by the user. Here, the functionality is not divorced from the recited structure. Therefore, the claims do not reflect an attempt to claim both an apparatus and a method, but rather an apparatus with particular capabilities.

IV. Conclusion and Practical Implications

Be very careful in criticizing other techniques or technologies (prior art or otherwise) when drafting applications, especially in the background section. These statements may be used later to narrow the scope of the broad claims you worked so hard to obtain in prosecution. This is especially true given the tendency of inventors to disparage every possible solution to a problem but their own.

When drafting apparatus claims with functional language, be careful not to recite functionality that is “divorced from the recited structure.” Functional language should be limited to the capabilities of the apparatus.