

Keywords: claim construction, negative claim limitations

General: To anticipate a negative claim limitation, the prior art need not expressly exclude an element when the exclusion of the element can be proven by affirmative evidence showing that the prior art suggests or describes instances in which the element is optional or unnecessary.

WAG Acquisition, LLC v. WebPower, Inc.
781 F. App'x 1007 (Fed. Circuit 2019)
Decided August 26, 2019

I. **Facts**

WAG Acquisition, LLC, (WAG) owns a patent (U.S. Patent No. 8,122,141, “the ‘141 patent”) disclosing a buffering system for streaming media (e.g., audio/video) on the Internet. The ‘141 patent discloses utilizing a server-side buffer and a user-side buffer. In a first embodiment, the server-side buffer stores a certain amount of data elements that are sequentially numbered for transfer to the user when the user starts streaming. In this embodiment, the server keeps track of the last data element sent via a software “pointer” if an interruption occurs. In a second embodiment, instead of the server, the user computer keeps track of the highest data stored in the user-side buffer when an interruption occurs. The second embodiment does not utilize a pointer. Instead, utilizing standard data communication protocols (e.g., TCP), “the user computer transmits a request to the server to send one or more data elements, specifying the serial numbers of the data elements”, which are transferred to the user computer “as fast as the data connection between the user computer and the server will allow.”

Webpower sought inter partes review of the ‘141 patent. The Board instituted review of claims 10-23. In particular, with respect to claims 10, 11, and 13-18, the Board instituted the review on the ground that these claims were anticipated by U.S. Patent No. 6,389,473 (“the Carmel reference”). The Carmel reference discloses a method for streaming media to multiple computers, where content is divided into slices, each containing a segment of video and/or audio data. When a user connects to a data stream, the user computer receives an index file which enables the user to select where it wants to join the stream. In the event of lag caused by interruptions, the data transmission rate can be increased by altering the size of the slices, adjusting the compression level of the data, or opening additional links with the server to increase the overall data rate. Before the Board, the parties’ dispute centered on whether the Carmel reference discloses “instructions to cause the server to send media data elements to the user system responsive to said requests, at a rate more rapid than the rate at which said streaming media is played back by a user,” as recited in independent claim 10. WebPower argued that the Carmel reference discloses utilizing multiple links to

increase the overall data rate so that the data is sent at a rate generally equal to or faster than the playback rate. WAG argued that the data rate referenced in the Carmel reference relates to the overall data rate as opposed to the rate at which individual data slices are sent, as required in claim 10. However, the Board in constructing claim 10 did not find that the “rate” was limited to the rate at which data are sent individually. Thus, the Board found that the Carmel reference’s disclosure of an overall transmission rate across multiple links at faster than playback rate sufficient to disclose the limitation at issue.

In addition, the parties disputed whether the Carmel reference anticipates a negative limitation in dependent claim 15 that recites “said server does not maintain a pointer into a buffer established within said server, for each said user.” WAG argued that a server-side pointer was inherent in the Carmel reference. However, the Board found that features of Carmel (e.g., disclosure of client side control, a lack of specialized server software, and similar pointerless protocols as used in the ‘141 patent) met the negative claim limitation. The Board found all of the reviewed claims unpatentable. WAG appealed the Board’s decision with regard to claims 10-18 to the Federal Circuit.

II. Issue

1. Did the Board err in its claim construction of independent claim 10?
2. Did the Board err in its determination that the Carmel reference discloses the negative pointer limitation in claim 15?

III. Discussion

1. Yes. In constructing claim 10, the court utilized the plain language of the claim to find that the “rate” referred to the requested media data elements that are sent, not the overall rate at which data is transmitted from the server to the user computer. In particular, the court relied on the antecedent basis for “said requests” in an earlier claim element. In addition, the court found support in a portion of the specification of the ‘141 patent for the applied construction.
2. No. The court determined, based on substantial evidence, that a reasonable fact finder could find that the Carmel reference does not require use of a pointer for the reasons stated by the Board (i.e., disclosure of client side control, a lack of specialized server software, and similar pointerless protocols as used in the ‘141 patent). The court also noted that while the Carmel reference does not specify a pointer is not used, it also does not specify that a pointer must be used.

IV. Conclusion

The Federal Circuit vacated the decision and remanded the case for further proceedings in light of the Federal Circuit's claim construction.

V. Appendix

Take homes from WAG and IBM regarding negative claim limitations.

- 1) The presence of a negative claim limitation in a reference is not self-proving and it is also not proven merely by silence in reference.
- 2) Proof of the presence of a negative claim limitation in a reference may demonstrated as being expressly, impliedly or inherently disclosed in the reference.
- 3) A showing that the reference suggests that an element is optional or unnecessary may be used to prove that the negative claim limitation is present in the reference.
- 4) The determination of whether an element is optional or unnecessary is shown by reliance on the disclosure of the reference, including any teaching or suggestion of the exclusion of the element.
- 5) A showing that an element is inherent or otherwise necessary can be used to prove that a negative claim limitation is not disclosed in a reference.