

Precedential Patent Case Decisions During January 2021

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I. Introduction

This paper abstracts what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Abstracts and New Points of Law

ABS GLOBAL, INC. v. Cytonome/St, LLC, 2019-2051 (Fed. Cir. 1/6/2021).

This is a decision on an appeal from PTAB case IPR2017-02097. The PTAB sustained the patentability of certain claims of a patent owned by Cytonome. ABS appealed. A majority of the Federal Circuit panel consisting of Judges Moore and Stoll dismissed the appeal, on the grounds of mootness. Judge Prost dissented-in-part.

By way of background, the majority decision held that a belated request for vacatur, forfeited. CJ Prost dissented from that holding.

Legal issue: Forfeiture on appeal, judicial discretion to deny a belated request for vacatur, when finding a dispute to be moot

The majority exercised its discretion to not vacate a portion of the PTAB's final decision, when the dispute was moot, because the request for vacatur was raised belatedly without an excuse for the delay.

Underlying this issue was the district court's grant of SJ of no infringement shortly after the PTAB final decision, and Cytonome's representation that it would not contest the district court's grant of SJ of no infringement. Consequently, ABS had no liability for patent infringement of the claims not found unpatentable in the IPR proceeding. However, ABS chose to appeal the PTAB decision that certain claims were not unpatentable.

In dissent, Judge Prost stated:

Time and again the Supreme Court has explained that vacatur is in order when the prevailing party below unilaterally moots an appeal. The Majority today departs from that established practice, concluding that dismissal is the proper course here. It is not. I respectfully dissent from Part III of the Majority's opinion. [ABS GLOBAL, INC. v. Cytonome/St, LLC, 2019-2051 (Fed. Cir. 1/6/2021)(CJ Prost, dissenting).]

The Majority disposes of this case on forfeiture, without considering "the conditions which have caused the case to become moot" as the Supreme Court instructs. *Id.* at 24. But even though ABS requested vacatur for the first time at oral argument, we "may nevertheless, in the exercise of [our] supervisory

appellate power, make such disposition of the case as justice requires.” Walling v. James V. Reuter, Inc., 321 U.S. 671, 676 (1944). Here it requires vacatur. [ABS Global, Inc. v. Cytonome/St, LLC, 2019-2051 (Fed. Cir. 1/6/2021)(CJ Prost, dissenting).]

Part III of the majority decision, dealing with mootness, reads:

Finally, we turn to an assertion ABS raised for the first time during oral argument: if we find this case moot, the proper disposition would include “vacat[ing] the challenged portions of the [Board’s] decision.” Oral Arg. at 7:48–8:03. We decline to do so. ABS did not timely request vacatur, despite ample opportunity to do so. This case became moot on February 21, 2020, when Cytonome filed the affidavit disclaiming any appeal of the Board’s decision. In its reply, filed nearly two months later, ABS asserted that its appeal was not moot but failed to argue in the alternative that vacatur of the decision below would be the appropriate remedy should we decide that its appeal was moot. Instead, ABS waited over seven months to raise vacatur, requesting it for the first time at oral argument. Even then, ABS did not develop its assertion or explain why vacatur would be the appropriate remedy either at oral argument or by seeking permission to file supplemental briefing. We conclude that ABS failed to preserve its argument and, accordingly, we exercise our discretion to find forfeiture and therefore deny its request. *See Henry v. Dep’t of Justice*, 157 F.3d 863, 865 (Fed. Cir. 1998) (“The government’s argument . . . was raised for the first time at oral argument and comes too late.” (citing *Sanders v. U.S. Postal Serv.*, 801 F.2d 1328, 1331–32 (Fed. Cir. 1986))); *Orion Sales, Inc. v. Emerson Radio Corp.*, 148 F.3d 840, 843 (7th Cir. 1998) (holding that appellant waived its request for vacatur by raising it for the first time at oral argument); *Radiant Global Logistics, Inc. v. Furstenau*, 951 F.3d 393, 397 (6th Cir. 2020) (per curiam) (“[V]acatur is an equitable remedy subject to the strictures of waiver and forfeiture.” (citing *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39–41 (1950))). [ABS Global, Inc. v. Cytonome/St, LLC, 2019-2051 (Fed. Cir. 1/6/2021)(CJ Prost, dissenting).]

Simo Holdings Inc. v. Hong Kong Ucloudlink Network Technology Limited, 2019-2411 (Fed. Cir. 1/5/2021).

This is a decision on an appeal from the S.D.N.Y district court case 1:18-cv-05427-JSR. Simo is the patentee/plaintiff. The district court granted SJ of infringement. uCloudlink appealed. The Federal Circuit reversed, holding the claim not infringed.

The Federal Circuit’s decision to reverse, was based upon its ultimate conclusion that the phrase “non-local calls database,” appearing before the colon in the claim, was limiting. How the Federal Circuit came to this decision provides guidance on how the Federal Circuit construes irregularly formatted claims. This decision deserves some background information, before getting to the precedential points. By way of background, then....

The Federal Circuit noted that the district court resolved any factual disputes relating to

claim construction on the intrinsic record, and therefore concluded that claim construction in this case was purely a matter of law, reviewable de novo. As a practical matter, that makes this case instructive on pure matters of claim construction, and generally applicable to similar cases. The Federal Circuit stated:

Claim construction is a matter of law, with the district court’s construction reviewed de novo, when, as in this case, the issue is resolved based on only intrinsic evidence, not on factual bases such as extra-patent usage of technical terms. *See Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1327 (Fed. Cir. 2019). [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

The Federal Circuit restated that in such an intrinsic-evidence-only review, how it construed claims:

In such a case, “[w]e generally give words of a claim their ordinary meaning in the context of the claim and the whole patent document; the specification particularly, but also the prosecution history, informs the determination of claim meaning in context, including by resolving ambiguities; and even if the meaning is plain on the face of the claim language, the patentee can, by acting with sufficient clarity, disclaim such a plain meaning or prescribe a special definition.” *World Class Technology Corp. v. Ormco Corp.*, 769 F.3d 1120, 1123 (Fed. Cir. 2014). Whether preamble language is limiting is a claim-construction issue. *See Cochlear Bone Anchored Solutions AB v. Oticon Med. AB*, 958 F.3d 1348, 1354 (Fed. Cir. 2020). [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

The Federal Circuit explained the specification disclosure relevant to this case, stating:

Thus, in one embodiment, a wireless communication client uses authentication data already on a SIM card or stored in the client’s memory to connect to a local cellular network, which connects the client to the remote administration system for the purpose of retrieving information that will enable the client thereafter to become authenticated as a local device by a local network (not necessarily the same local network). *** Some embodiments, of particular relevance on appeal, have an additional feature—a “non-local calls database” in the wireless communication client that helps “greatly reduc[e] the cost of [some] call[s].” [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

The beginning portion and the colon of the claim at issue, read:

A wireless communication client or extension unit comprising a plurality

of memory, processors, programs, communication circuitry, authentication data stored on a subscribed identify module (SIM) card and/or in memory and **non-local calls database**, at least one of the plurality of programs stored in the memory comprises instructions executable by at least one of the plurality of processors for: [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021); emphasis in the original.]

The claim then continues with a series of paragraphs, each beginning with gerund, and each paragraph reciting functions of executable instructions of the programs.

Legal issue: 35 USC 112, claim construction of device claims reciting device structure after “comprising” but before a colon and reciting only gerund steps after the colon.

The Federal Circuit concluded that device structure recitations were limiting where the device structure is recited in a device claim after the word “comprising” but before a colon, *if the language after the “comprising” recitation is characterized as part of the body of the claim.*

The language at issue follows, rather than precedes, the word “comprising,” which is one of the transition words that typically mark the end of the preamble, with what follows constituting the body of the claim. *See, e.g., CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007); *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1371 (Fed. Cir. 2005). The placement of the language therefore suggests that it is part of the body of the claim, a characterization that, if accepted, would place its limiting character beyond dispute. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

Note: The Federal Circuit went on to address the parties arguments which characterized the language between the “comprising” and the colon as part of the preamble. However, an important point is that a party could have argued that the post-comprising language was part of the body of the claim, and therefore indisputably limiting.

Legal issue: 35 USC 112, claim construction, preamble reciting structure of device claim, and only functional limitations in the body of the claim.

The Federal Circuit held that “where the body identifies nothing but functional properties of the claimed apparatus... the listed structural requirements [in the preamble] must be understood as part of the claimed invention.”

The Federal Circuit when on to address the construction of the pre-colon language, assuming arguendo it was part of the preamble, since that is how the parties presented the issue. The Federal Circuit held that a list of device elements in the preamble of a device claim were limiting, when the body of the device claim recites only functional limitations. The Federal Circuit continued:

... The parties, however, have treated the language at issue as part of the preamble, treating only the succeeding six paragraphs as the body of the claim.

But even under that characterization, we conclude, the language at issue is limiting. [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

Claim 8 is not a method claim but an apparatus claim. Its subject matter is a “wireless communications client or extension unit.” As the district court pointed out, the “preamble” contains the only language in the claim that identifies physical components of the claimed physical device—beginning with “a plurality of memory, processors, programs, communication circuitry, authentication data stored on a subscribed identify module (SIM) card and/or in memory and non-local calls database.” “The body of the claim provides no information whatsoever about the structure of the invention; the body simply describes the actions taken by the invention. It is the preamble that supplies the necessary structure.” *Summary Judgment Opinion*, 376 F. Supp. 3d at 381. [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

SIMO cites no authority holding a preamble not limiting in this situation, where the body identifies nothing but functional properties of the claimed apparatus. Our precedent explains why the preamble in this situation is limiting. In supplying the only structure for the claimed apparatus, the preamble language supplies “essential structure,” and the body does not define “a structurally complete invention”—which are two key reasons for preamble language to be deemed limiting. *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 809 (Fed. Cir. 2002) (internal quotation marks omitted). In addition, the opening language of the preamble—“a wireless communication client or extension unit”—provides an antecedent basis for terms in the body of the claim—“the wireless communication client or the extension unit,” in the claim’s first and last phrase, ’689 patent, col. 25, lines 11–13, 38–40 (emphasis added). “We have repeatedly held a preamble limiting when it serves as antecedent basis for a term appearing in the body of a claim.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019); *see also, e.g., Bio-Rad Labs., Inc. v. 10X Genomics Inc.*, 967 F.3d 1353, 1371 (Fed. Cir. 2020) (body’s reliance on preamble for antecedent basis “is a strong indication that the preamble acts as a necessary component of the claimed invention” (internal quotation marks omitted)). [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

SIMO concedes that part of the preamble is limiting but argues that some components in the group of listed structures, including the non-local calls database, should not be deemed limiting, because they are “unnecessary to perform the” functions specified after the preamble. SIMO Response Br. at 24. We decline to parse the preamble in that way where, as here, the preamble supplies the only structure of the claimed device and the disputed language does

not merely identify an intended use or functional property but is “intertwined with the rest of the preamble,” *Bio-Rad*, 967 F.3d at 1371, and supplies structure noted in the specification as among the inventive advances. In the circumstances present here, which are unlike those of the cases to which SIMO points for its parsing suggestion, the listed structural requirements must be understood as part of the claimed invention. [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

Legal issue: 35 USC 112, claim construction, applicability of a modifier preceding a series, to each member of the series.

The Federal Circuit expanded its prior *SuperGuide* precedent to hold that a prepositive modifier to a series presumptively applies to each member of the series, and that this presumption has particular force when the term joining the items in a series is “and.”

In *SuperGuide Corporation v. DirecTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004), we recognized that, as a matter of ordinary and customary meaning, a phrase grammatically comparable to “a plurality of” at the start of a list of items joined together by “and” applied to each item in the list, not to the list considered as a whole. The phrase in *SuperGuide* was “at least one of”—followed by “a desired program start time, a desired program end time, a desired program service, and a desired program type.” *Id.* at 884 (emphasis added). The court, after noting that “at least one” means “one or more,” concluded that the use of “and” in the list meant that there had to be one or more of each item. *Id.* at 886. The court explained that, because the list uses “and” rather than “or,” the phrase is properly understood as if “of” or “at least one of” appears before each item, i.e., to require at least one of a desired program start time, at least one of a desired program end time, at least one of a desired program service, and at least one of a desired program type. *Id.* (relying on William Strunk, Jr. & E.B. White, *The Elements of Style* 27 (4th ed. 2000) (“an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term”)); *see also Joao v. Sleepy Hollow Bank*, 348 F. Supp. 2d 120, 124 (S.D.N.Y. 2004) (making the same point about the grammatical rule for “at least one of”). [4] [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

Our holding in *SuperGuide* reflects a more general grammatical principle applicable to a modifier coming before a series. “When there is a straightforward, parallel construction that involves all nouns or verbs in a series, a prepositive or postpositive modifier normally applies to the entire series.” Antonin Scalia & Bryan A. Garner, *Reading Law: The Interpretation of Legal Texts* § 19, 147 (2012). As *SuperGuide* makes clear, the principle has particular force when the term joining the items in a series is “and.” [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

The *SuperGuide* principle applies to “a plurality of” in claim 8. The phrase “a plurality of” means “at least two of.” See *August Technology Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1286 (Fed. Cir. 2011) (“A plurality of wafers means more than one physically distinct wafer.”); *ResQNet.com, Inc. v. Lansa, Inc.*, 346 F.3d 1374, 1382 (Fed. Cir. 2003) (“plurality” means “at least two”). If “at least one of” requires one or more of each item in a conjunctive list, “a plurality of” requires two or more of each item in a conjunctive list—such as claim 8’s list joined by “and.” [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

35 USC 112, claim construction, applicability of a modifier coming before a series to a member of the series lacking a preceding article.

The Federal Circuit held that lack of an article preceding a member of a series strengthens the presumption that a modifier coming before the series applies to that member of the series.

Although context can affect the force of the more general form of the grammatical canon, see Scalia & Garner, *Reading Law* § 19, at 150, here context cements the canon’s applicability in its particular *SuperGuide* form. Two aspects of the context have that effect. First, there is no article preceding “non-local calls database.” If the series modifier did not apply to all members of the group, a relevant artisan would expect an “a” before “non-local calls database” (and perhaps “memory”). [5] That is because “[t]he typical way in which syntax would suggest no carryover modification is that a determiner (a, the, some, etc.) will be repeated before” one of the items in the list. Scalia & Garner, *Reading Law* § 19, at 148. There is no such article negating the applicability of “a plurality of” to each list item. [*Simo Holdings Inc. v. Hong Kong Ucloudlink*, 2019-2411 (Fed. Cir. 1/5/2021).]

35 USC 112, claim construction, applicability of a modifier coming before a series, to a member of the series, effect of subsequent reference using the modifier.

The Federal Circuit held that subsequent reference to a member of a series using the series modifier was decisive in concluding that the modifier applied to every member of the series.

Second, and what in our view is decisive, the words that come immediately after the list make clear that the “a plurality of” phrase applies to the individual items in the list, just as the *SuperGuide* canon indicates. Thus, after “non-local calls database,” claim 8 continues: “at least one of the plurality of programs stored in the memory comprises instructions executable by at least one of the plurality of processors for:” ’689 patent, col. 25, lines 8–10 (emphases added). The expression “the plurality,” used in the two highlighted phrases, means that, in the preceding phrase requiring “a plurality of” memory, processors, programs, circuitry, certain data, and non-local calls database, there already is

required a plurality of programs and a plurality of processors. The phrase “the plurality of” establishes that the earlier “a plurality of” does apply individually to at least some items in the list that follow “a plurality of,” as the canon indicates. SIMO has suggested no grammatical basis for reading a phrase like “a plurality of” to apply to some but not other items in the list. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

To be sure, the mix of plural, singular, and mixed-use forms of words in the list following “a plurality of” (“memory,” “processors,” “programs,” “circuitry,” “data,” “database”) leaves the phrase “a bit of a mess grammatically.” *Summary Judgment Opinion*, 376 F. Supp. 3d at 382; *see also id.* at 380 (“[T]he preamble is not a model of grammatical correctness.”). But given the collective character of the singular-form words, the extent of the divergence from standard American English, at least as used in patents, is not entirely clear. [6] In any event, such irregularities would exist “no matter what reading is assigned to” the preamble. *Id.* at 382. The textual sloppiness—which SIMO had the obligation as the patent drafter to avoid—provides no significant textual counterweight to what we conclude are the decisive textual considerations already discussed that favor uCloudlink’s narrower reading of “a plurality of” as applying to each item in the list following that phrase. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

35 USC 112, claim construction, determination whether construction would contradict the specification.

While not precedential, the Federal Circuit reviewed and explained why it rejected the district court’s reasoning why requiring a “non-local calls database,” for infringement would contradict the specification.

The district court’s contrary conclusion hinged, not on anything about claim 8’s text, but on its view of this court’s statement in *Oatey* about the role of the specification and, relatedly, its view that uCloudlink’s reading “would contradict the specification.” *Id.* at 381. We reject these rationales. In *Oatey*, after we stated that “[w]e normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification,” we explained the important qualifiers: “At leas[t] where claims can reasonably [be] interpreted to include a specific embodiment, it is incorrect to construe the claims to exclude that embodiment, absent probative evidence [to] the contrary.” 514 F.3d at 1276,1277 (emphases added). *** Beginning shortly after *Oatey* was decided, we have repeatedly reiterated that very caution. *See, e.g., PSN Illinois, LLC v. Ivoclar Vivadent, Inc.*, 525 F.3d 1159, 1166 (Fed. Cir. 2008) (explaining that *Oatey* is not even “applicable” where a contrary construction covers a preferred embodiment and, in any event, that “*Oatey* is not a panacea, requiring all claims to cover all embodiments. *** In this case, the language of the claim itself makes clear that,

contrary to SIMO’s contention, claim 8 does not cover specification embodiments that lack a non-local calls database. *** This case does not present the issue of a construction that would exclude a preferred embodiment from a claim. That consequence affects the “careful weighing of the strengths of competing implicatures” that is required for language interpretation generally. Geoffrey P. Miller, *Pragmatics and the Maxims of Interpretation*, 1990 Wis. L. Rev. 1179, 1220 (1990). *** Nor does this case involve a situation in which adopting a narrow construction of the claim at issue leaves other disclosed embodiments entirely unclaimed—though we have hardly treated such a consequence, even when it exists, as overcoming strong textual indicators of a particular claim’s narrow meaning. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

For the foregoing reasons, uCloudlink’s construction of claim 8 would not “contradict the specification.” *Summary Judgment Opinion*, 376 F. Supp. 3d at 381. It simply leaves out some alternative embodiments of what SIMO’s specification describes as inventive, while capturing one embodiment expressly described. *See* ’689 patent, col. 3, lines 25–30; col. 15, lines 19–21; col. 15, line 56, through col. 16, line 6; *see also id.*, figs. 5A & 5B. Even requiring a plurality of non-local calls databases does not contradict the specification. The reference to “a non-local calls database” would ordinarily be understood to encompass one or more such databases. *See SanDisk Corp. v. Kingston Technology Co., Inc.*, 695 F.3d 1348, 1360–61 (Fed. Cir. 2012) (general rule is that “a” means one or more, unless context limits the meaning to just one); *Baldwin Graphic Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342–43 (Fed. Cir. 2008) (same). And, notably, in its brief in this court, SIMO has made no showing, or even a developed argument, that having more than one non-local calls database would be “utter nonsense,” *Joao*, 348 F. Supp. 2d at 124. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]

In sum, we conclude, contrary to the district court’s conclusion, that “a plurality of memory, processors, programs, communication circuitry, authentication data stored on a subscribed identify module (SIM) card and/or in memory and non-local calls database” requires “a plurality of” each component in the list, including “non-local calls database.” The district court’s grant of summary judgment to SIMO based on its claim construction must be reversed. [Simo Holdings Inc. v. Hong Kong Ucloudlink, 2019-2411 (Fed. Cir. 1/5/2021).]