

EXHIBIT 7

DECLARATION OF MELODY DRUMMOND HANSEN IN SUPPORT OF DEFENDANT'S
RESPONSIVE CLAIM CONSTRUCTION BRIEF

Case No. 5:15-CV-02008-EJD

proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under [35 U.S.C. 103](#) should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

The first approach is recommended from an examination standpoint because it avoids piecemeal examination in the event that the examiner's [35 U.S.C. 112](#), second paragraph rejection is not affirmed, and may give applicant a better appreciation for relevant prior art if the claims are redrafted to avoid the [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph rejection.

2174 Relationship Between the Requirements of 35 U.S.C. 112(a) and (b) or Pre-AIA 35 U.S.C. 112, First and Second Paragraphs [R-11.2013]

The requirements of [35 U.S.C. 112\(a\)](#) and [\(b\)](#) or the first and second paragraphs of [pre-AIA 35 U.S.C. 112](#) are separate and distinct. If a description or the enabling disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact alone does not render the claim imprecise or indefinite or otherwise not in compliance with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph; rather, the claim is based on an insufficient disclosure ([35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph) and should be rejected on that ground. *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). If the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In *Mayhew*, the examiner argued that the only mode of operation of the process disclosed in the specification involved the use of a cooling zone at a particular location in the processing cycle. The claims were rejected because they failed to specify either a cooling step or the location of the step in the process. The court was convinced that

the cooling bath and its location were essential, and held that claims which failed to recite the use of a cooling zone, specifically located, were not supported by an enabling disclosure ([35 U.S.C. 112](#), first paragraph).

In addition, if a claim is amended to include an invention that is not described in the application as filed, a rejection of that claim under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as being directed to subject matter that is not described in the specification as filed may be appropriate. *In re Simon*, 302 F.2d 737, 133 USPQ 524 (CCPA 1962). In *Simon*, which involved a reissue application containing claims to a reaction product of a composition, applicant presented claims to a reaction product of a composition comprising the subcombination A+B+C, whereas the original claims and description of the invention were directed to a composition comprising the combination A+B+C+D+E. The court found no significant support for the argument that ingredients D+E were not essential to the claimed reaction product and concluded that claims directed to the reaction product of a subcombination A+B+C were not described ([35 U.S.C. 112](#), first paragraph) in the application as filed. See also *In re Panagrossi*, 277 F.2d 181, 125 USPQ 410 (CCPA 1960).

2175 -2180 [Reserved]

2181 Identifying and Interpreting a 35 U.S.C. 112(f) or Pre-AIA 35 U.S.C. 112, Sixth Paragraph Limitation [R-07.2015]

This section sets forth guidelines for the examination of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, “means or step plus function” limitations in a claim. These guidelines are based on the Office’s current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit’s predecessor courts. These guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law.

The Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), held that a “means-or-step-plus-function” limitation should be interpreted as follows:

Per our holding, the “broadest reasonable interpretation” that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Therefore, the broadest reasonable interpretation of a claim limitation that invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is the structure, material or act described in the specification as performing the entire claimed function and equivalents to the disclosed structure, material or act. As a result, [section 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph, limitations will, in some cases, be afforded a more narrow interpretation than a limitation that is not crafted in “means plus function” format.

I. DETERMINING WHETHER A CLAIM LIMITATION INVOKES 35 U.S.C. 112(f) or PRE-AIA 35 U.S.C. 112, SIXTH PARAGRAPH

The USPTO must apply [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that [35 U.S.C. 112](#), sixth paragraph “merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation”). The Federal Circuit has held that applicants (and reexamination patentees) before the USPTO have the opportunity and the obligation to define their inventions precisely during proceedings before the USPTO. See *In re Morris*, 127 F.3d 1048, 1056–57, 44 USPQ2d 1023, 1029–30 (Fed. Cir. 1997) ([35 U.S.C. 112](#), second paragraph places the burden of precise claim drafting on the applicant); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed.

Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the USPTO); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (patentee who had a clear opportunity to negotiate broader claims during prosecution but did not do so, may not seek to expand the claims through the doctrine of equivalents, for it is the patentee, not the public, who must bear the cost of failure to seek protection for this foreseeable alteration of its claimed structure).

If a claim limitation recites a term and associated functional language, the examiner should determine whether the claim limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. The claim limitation is presumed to invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph when it explicitly uses the term “means” or “step” and includes functional language. That presumption is overcome when the limitation further includes the structure necessary to perform the recited function.

TriMed, Inc. v. Stryker Corp., 514 F.3d 1256, 1259-60, 85 USPQ2d 1787, 1789 (Fed. Cir. 2008) (“Sufficient structure exists when the claim language specifies the exact structure that performs the function in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.”); see also *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376, 65 USPQ2d 1865, 1874 (Fed. Cir. 2003).

By contrast, a claim limitation that does not use the term “means” or “step” will trigger the rebuttable presumption that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph does not apply. See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1310, 75 USPQ2d 1321, 1324 (Fed. Cir. 2005) (*en banc*); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369, 62 USPQ2d 1658, 1664 (Fed. Cir. 2002); *Personalized Media Commc’ns, LLC v. ITC*, 161 F.3d 696, 703-04, 48 USPQ2d 1880, 1886–87 (Fed. Cir. 1998). The presumption is overcome when “the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339,

1348, 115 USPQ2d 1105, 1111 (Fed. Cir. 2015) (*en banc*) (quoting *Watts v. XL Systems, Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000); see also *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704 (Fed. Cir. 1998). Instead of using "means" or "step" in such cases, a substitute term acts as a generic placeholder for the term "means" and would not be recognized by one of ordinary skill in the art as being sufficiently definite structure for performing the claimed function. "The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Williamson*, 792 F.3d at 1349, 115 USPQ2d at 1111; see also *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996).

Accordingly, examiners will apply [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph to a claim limitation if it meets the following 3-prong analysis:

(A) the claim limitation uses the term "means" or "step" or a term used as a substitute for "means" that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;

(B) the term "means" or "step" or the generic placeholder is modified by functional language, typically, but not always linked by the transition word "for" (e.g., "means for") or another linking word or phrase, such as "configured to" or "so that"; and

(C) the term "means" or "step" or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

A. The Claim Limitation Uses the Term "Means" or "Step" or a Generic Placeholder (A Term That Is Simply A Substitute for "Means")

With respect to the first prong of this analysis, a claim element that does not include the term "means" or "step" triggers a rebuttable presumption that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, does not apply. When the claim limitation does not use the term "means," examiners should determine whether the presumption that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6 does

not apply is overcome. The presumption may be overcome if the claim limitation uses a generic placeholder (a term that is simply a substitute for the term "means"). The following is a list of non-structural generic placeholders that may invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6: "mechanism for," "module for," "device for," "unit for," "component for," "element for," "member for," "apparatus for," "machine for," or "system for." *Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1096, 89 USPQ2d 1289, 1293-94 (Fed. Cir. 2008); *Massachusetts Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1354, 80 USPQ2d 1225, 1228 (Fed. Cir. 2006); *Personalized Media*, 161 F.3d at 704, 48 USPQ2d at 1886-87; *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1214-1215, 48 USPQ2d 1010, 1017 (Fed. Cir. 1998). This list is not exhaustive, and other generic placeholders may invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6.

However, [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6 will not apply if persons of ordinary skill in the art reading the specification understand the term to have a sufficiently definite meaning as the name for the structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function (e.g., "filters," "brakes," "clamp," "screwdriver," and "locks"). *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1372-73, 66 USPQ2d 1444, 1451-52 (Fed. Cir. 2003); *CCS Fitness*, 288 F.3d at 1369, 62 USPQ2d at 1664; *Watts v. XL Sys. Inc.*, 232 F.3d 877, 880-81, 56 USPQ2d 1836, 1839 (Fed. Cir. 2000); *Personalized Media*, 161 F.3d at 704, 48 USPQ2d at 1888; *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996) ("Many devices take their names from the functions they perform.") The term is not required to denote a specific structure or a precise physical structure to avoid the application of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6. See *Watts*, 232 F.3d at 880, 56 USPQ2d at 1838; *Inventio AG v. Thyssenkrupp Elevator Americas Corp.*, 649 F.3d 1350, 99 USPQ2d 1112 (Fed. Cir. 2011) (holding that the claim terms "modernizing device" and "computing unit" when read in light of the specification connoted sufficient, definite structure to one of skill in the art to preclude application of 35 U.S.C. 112, sixth

paragraph). The following are examples of structural terms that have been found **not** to invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6: “circuit,” “detent mechanism,” “digital detector,” “reciprocating member,” “connector assembly,” “perforation,” “sealingly connected joints,” and “eyeglass hanger member.” See *Mass. Inst. of Tech.*, 462 F.3d at 1355-1356, 80 USPQ2d at 1332 (the court found the recitation of “aesthetic correction circuitry” sufficient to avoid [pre-AIA 35 U.S.C. 112](#), paragraph 6, treatment because the term circuit, combined with a description of the function of the circuit, connoted sufficient structure to one of ordinary skill in the art.); *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1321, 72 USPQ2d 1065, 1071 (Fed. Cir. 2004); *Apex*, 325 F.3d at 1373, 66 USPQ2d at 1452; *Greenberg*, 91 F.3d at 1583-84, 39 USPQ2d at 1786; *Personalized Media*, 161 F.3d at 704-05, 39 USPQ2d at 1786; *CCS Fitness*, 288 F.3d at 1369-70, 62 USPQ2d at 1664-65; *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996); *Watts*, 232 F.3d at 881, 56 USPQ2d at 1839; *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1318-19, 50 USPQ2d 1161, 1166-67 (Fed. Cir. 1999).

For a term to be considered a substitute for “means,” and lack sufficient structure for performing the function, it must serve as a generic placeholder and thus not limit the scope of the claim to any specific manner or structure for performing the claimed function. It is important to remember that there are no absolutes in the determination of terms used as a substitute for “means” that serve as generic placeholders. The examiner must carefully consider the term in light of the specification and the commonly accepted meaning in the technological art. Every application will turn on its own facts.

If the examiner has not interpreted a claim limitation as invoking [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph and an applicant wishes to have the claim limitation treated under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, applicant must either: (A) amend the claim to include the phrase “means” or “step”; or (B) rebut the presumption that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph does not apply by showing that the claim limitation is written as a function to be performed and does not recite

sufficient structure, material, or acts to perform that function. See *Watts*, 232 F.3d at 881, 56 USPQ2d at 1839 (Fed. Cir. 2000) (Claim limitations were held not to invoke [35 U.S.C. 112](#), sixth paragraph, because the absence of the term “means” raised the presumption that the limitations were not in means-plus-function form and the applicant did not rebut that presumption.); see also *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002) (“[W]here a method claim does not contain the term ‘step[s] for,’ a limitation of that claim cannot be construed as a step-plus-function limitation without a showing that the limitation contains no act.”).

Some of the following examples illustrate situations where the term “means” or “step” was not used but either the Board or courts nevertheless determined that the claim limitation fell within the scope of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. Note that the examples are fact specific and should not be applied as *per se* rules. See *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356, 50 USPQ2d 1372, 1374-75 (Fed. Cir. 1999) (“ink delivery means positioned on ...” invokes [35 U.S.C. 112](#), sixth paragraph since the phrase “ink delivery means” is equivalent to “means for ink delivery”); *Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Rader, J., concurring) (“Claim elements without express step-plus-function language may nevertheless fall within [Section 112](#), Para. 6 if they merely claim the underlying function without recitation of acts for performing that function.... In general terms, the ‘underlying function’ of a method claim element corresponds to *what* that element ultimately accomplishes in relationship to what the other elements of the claim and the claim as a whole accomplish. ‘Acts,’ on the other hand, correspond to *how* the function is accomplished.... If the claim element uses the phrase ‘step for,’ then [Section 112](#), Para. 6 is presumed to apply.... On the other hand, the term ‘step’ alone and the phrase ‘steps of’ tend to show that [Section 112](#), Para. 6 does not govern that limitation.”); *Personalized Media*, 161 F.3d at 703-04, 48 USPQ2d at 1886-87 (Fed. Cir. 1998); *Mas-Hamilton*, 156 F.3d at 1213, 48 USPQ2d at 1016 (Fed. Cir. 1998) (“lever moving element for moving the lever” and “movable link member for

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