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October 25, 2018

The Honorable Christopher J. Burke
United States District Court
For the District of Delaware
844 North King Street
Wilmington, DE 19801

VIA E-FILING

Re: *Techno View IP, Inc. v. Oculus VR, LLC et al.*,
C.A. No. 17-386 (CFC)(CJB)

Dear Judge Burke:

We write on behalf of Defendants in response to the Court’s direction in its October 18, 2018 Report and Recommendation for further letter briefing on the “with a processor” claim terms. (D.I. 85 at 20). Defendants do not contend that the “**with a processor**” claim terms invoke **step-plus-function** claiming under 35 U.S.C. § 112(6). Because “step-plus-function” analysis does not apply, Defendants have not performed such an analysis. Rather, the “with a processor” terms recite **means-plus-function** elements, as they recite physical (apparatus) components that invoke section 112(6) under *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015) (en banc).

TVIP’s arguments flow from the erroneous premise that method claims can only recite method steps. But method claims can (and often do) recite physical (apparatus) components that are used in carrying out the claimed method. For example, a claim could recite a method for building a house including a step of “driving nails using a hammer,” thus requiring a physical component (a hammer) for carrying out a step of the claimed method. That same hypothetical claim step could instead be written to recite “driving nails using a *means for hitting*,” thus claiming a physical component in means-plus-function form as part of a method step. Nothing in the patent laws precludes method claims from reciting physical components in means-plus-function format, and the “with a processor” claim terms are an example of this type of claiming.

It is therefore not surprising that both the Federal Circuit and district courts have found that **method claims** can recite **apparatus elements** that invoke means-plus-function treatment. See *On Demand Mach. Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1341 (Fed. Cir. 2006); *J & M Corp. v. Harley-Davidson, Inc.*, 269 F.3d 1360, 1364 n.1 (Fed. Cir. 2001). For example, the Federal Circuit in *On Demand* held that a clause in a method claim – “providing *means for* a customer to visually review said sales information” – was “in means-plus-function form pursuant to 35 U.S.C. § 112(6).” 442 F.3d at 1336, 1340-41 (emphasis added). In *J & M Corp.*, the Federal Circuit explained that a method claim “contains a nearly identical means-plus-function limitation” to the apparatus claims, and analyzed the method and apparatus claims together. 269 F.3d at 1364 n.1.

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This result is consistent with the plain language of 35 U.S.C. § 112, which makes clear that whether a claim is subject to “means-plus-function” treatment depends on the language of the particular claim element in question, regardless of the type of claim in which it is recited. See 35 U.S.C. § 112(6) (“An **element** in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof....”). Nothing in § 112(6) limits “means-plus-function” treatment to apparatus claims. The statute instead makes clear it applies when an “**element in a claim**” recites “a means ... for specifying a specified function without the recital of structure [or] material ... in support thereof,” and does not limit its applicability to particular types of claims. If Congress intended to limit “means-plus-function” treatment only to apparatus claims, it would have not written the statute to simply recite “an element *in a claim*,” which places no qualifications on the claim type.

Accordingly, a *method* claim that recites “using a **means for**” performing a function can invoke a means-plus-function analysis, as the Federal Circuit in *On Demand* and *J & M Corp.* confirmed. Conversely, an *apparatus* claim that recites a product “configured to perform a **step for**” performing a function, could invoke step-plus-function analysis. The bottom line is that the applicability of § 112(6) is determined on an element-by-element basis, based on the particular language of the *claim element* itself, without regard to the classification of the claim (e.g. apparatus, method, computer readable medium) in which the element is recited.

The cases cited in the Report and Recommendation do not change this result. Nothing in *O.I. Corp. v. Tekmar Co. Inc.*, 115 F.3d 1576 (Fed. Cir. 1997), suggests that a method claim cannot recite a physical element that invokes **means-plus-function** treatment. *O.I. Corp.* merely explains how § 112(6) applies with respect to **step-plus-function** limitations. *Id.* at 1583. The case did not address, let alone hold, that **means-plus-function** analysis can never be applied to an element recited a method claim. Here, because the recited “**processor**” is a physical component – not a step – step-plus-function analysis does not apply to that claim element and *O.I. Corp.* is thus not relevant. *Id.* at 1583.¹

Similarly, the Federal Circuit in *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022 (Fed. Cir. 2002), was not concerned with whether a method claim could recite a physical component implicating means-plus-function treatment. Just like *O.I. Corp.*, *Epcon Gas* addressed the narrow question of whether a particular element in a method claim was in “step-plus-function” form. *Id.* at 1028. As such, the assertion in *Epcon Gas* that Section 112(6) is implicated for a method claim “only when steps plus function without acts are present,” does nothing more than articulate when a **step-plus-function** analysis may be appropriate. The court in *Epcon Gas* did not address whether means-plus-function analysis could apply to method claims.

Other district courts have observed that the Federal Circuit has never held that physical (apparatus) elements recited in method claims cannot invoke means-plus-function treatment. For

¹ The Federal Circuit in *O.I. Corp.* found that the method claims did not invoke section § 112(6), while the apparatus claims did. But in *O.I. Corp.*, the apparatus claims explicitly used “means” language, while the “parallel” method claims did not. *Id.* at 1583-84.

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example, the Northern District of California has explicitly found that “*O.I. Corporation* does not hold that the use of ‘means’ in a method claim falls outside of § 112 ¶ 6.” *Network Appliance Inc. v. Sun Microsystems Inc.*, No. C-07-06053 EDL, 2008 WL 4193049, at *17 (N.D. Cal. Sept. 10, 2008). In *Network Appliance*, an asserted method claim required the use of a “non-volatile storage means,” which the court found was written in means-plus-function format under § 112(6). *Id.* at *16-17. *Network Appliance* further cited to *On Demand* and *J & M Corp.* to confirm that *O.I. Corp.* did not have the broad holding suggested by TVIP here. *Id.* at *17.

Nor did *Williamson* hold that method claims cannot invoke means-plus-function treatment. Rather, in dicta, *Williamson* summarized past case law that led to the heightened burden that *Williamson* overturned. *Williamson*, 792 F.3d at 1349. In particular, *Williamson* cites to *Masco Corp. v. U.S.*, 303 F.3d 1316, 1327 (Fed. Cir. 2002), which, much like *O.I. Corp.* and *Epcon Gas*, deals solely with an analysis as to whether a specific claim is subject to step-plus-function treatment. *Williamson*, 792 F.3d. at 1349.

Because Federal Circuit and district court cases have found that method claims may recite physical elements subject to means-plus-function treatment, it follows that *Williamson* applies to method claims directed to software implemented inventions that recite nonce words such as “processor.” The Federal Circuit has done just that, finding that a claimed “compliance mechanism” in a method claim triggered § 112(6). *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1373-74 (Fed. Cir. 2015). There was no need for the Federal Circuit in *Media Rights* to address any distinction between method and apparatus claims because the “compliance mechanism” element clearly triggered § 112(6). District courts have also applied § 112(6) to apparatus elements of method claims post-*Williamson*. See *Viatech Techs., Inc. v. Microsoft Corp.*, No. 14-1226-RGA, 2016 WL 3398025, at *2-3, 10 (D. Del. Jun. 14, 2016) (holding term “license monitor and control mechanism,” found in apparatus claim 1 and method claim 28, subject to construction under § 112(6)); *Twin Peaks Software Inc. v. IBM Corp.*, No. 14-cv-03933-JST, 2016 WL 1409748, at *11 (N.D. Cal. Apr. 11, 2016) (holding “mechanism for managing” term found in method claim to be a means-plus-function term). As explained previously, this result is correct under the plain language of the statute, which makes clear that application of § 112(6) is based on the element without regard to the broader classification of the claim (e.g. apparatus, method) in which the element is recited. See 35 U.S.C. § 112(6) (“An **element** in a claim for a combination may be expressed as a means or step for performing a specified function....”).

In conclusion, Defendants respectfully submit that the claimed “**with a processor**” element invokes § 112(6), consistent with both the plain language of the statute and Federal Circuit and district court precedent. Defendants respectfully request that the Court adopt their position that the “with a processor” terms be construed to be subject to § 112(6).

Respectfully,

/s/ Karen Jacobs

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