

**FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING SEPTEMBER 29, 2023**

**WSOU Investments, LLC v. Google, LLC, No. 2022-1066, 2022-1067 (September 25, 2023) (nonprecedential); Patent Nos. 7,304,563 and 8,238,681**

**Key point(s):**

- In determining whether sufficient structure exists for a limitation subject to 35 U.S.C. § 112, ¶ 6, a skilled artisan's knowledge is to be used as a lens for interpretation rather than a gap filler of the specification's disclosure.
- Courts will not redraft claims to contradict their plain language to avoid a nonsensical result.

**Facts/Background:** WSOU sued Google, alleging infringement of 15 patents, including the '563 patent and the '681 patent. The '563 patent relates to a mobile communication terminal with alarm clock functionality. The '681 patent relates to an autofocus feature in a digital camera. The district court issued a single claim construction order that covered all 15 patents, and based on the district court's constructions, the parties stipulated to final judgments of invalidity for indefiniteness for claims 1 and 16 of the '563 patent and claims 1, 9, 16, and 24 of the '681 patent. Regarding the '563 patent, the district court determined that the "alerting unit" limitation of claim 1 and the "issuing means for issuing an alert" limitation of claim 16 were subject to 35 U.S.C. § 112, ¶ 6, and that the specification failed to disclose sufficient structure corresponding to the claimed functions. Regarding the '681 patent, the district court determined that the phrase "second part in between the first part and the second part," which is present in each of claims 1, 9, 16, and 24, was indefinite because it was nonsensical. WSOU appealed.

**Holding:** Affirmed.

Regarding the '563 patent, WSOU first argued the district court erred in determining that the "alerting unit" limitation of claim 1 was subject to 35 U.S.C. § 112, ¶ 6. The Federal Circuit agreed with the district court that, although the limitation does not include the term "means", (1) "unit" serves as a placeholder for almost anything that can perform a function, (2) the surrounding language in the claim is purely functional and without structure, and (3) the specification does not ascribe any structure to "alerting unit." Regarding the "issuing means" limitation of claim 16, WSOU argued that interpretation of what is disclosed in the specification must be made in the light of knowledge of one skilled in the art. However, the Federal Circuit opined that WSOU improperly attempted to use a skilled artisan's knowledge as a gap filler rather than as lens for interpretation.

Regarding the '681 patent, WSOU argued the specification and prosecution history imparted a plain and ordinary meaning of "second part in between [the boundary of] the first part and [the outer boundary of] the second part." The Federal Circuit agreed with the district court that nothing in the record supported WSOU's "boundary" interpretation. The Federal Circuit declined to redraft the claim limitation to include WSOU's additional "boundary" language.

**Masimo Corporation v. Sotera Wireless, Inc., No. 2022-1415 (September 28, 2023)**  
**(nonprecedential); Patent No. RE47,218**

**Key point(s):**

- Disclosure of a narrow embodiment in the specification will not be read into the claim to contradict the plain language of the claim and what a POSITA would believe the claim to mean in view of the specification.

**Facts/Background:** The '218 patent, assigned to Masimo, is directed to an adaptive alarm system for use in combination with pulse oximetry sensors in a variety of medical applications. Sotera petitioned for inter partes review of the '218 patent. The Board issued its Decision determining all challenged claims unpatentable as obvious over the combination of U.S. Patent No. 7,079,035, U.S. Patent No. 6,597,933, and PCT Publication WO 2009/093159 under 35 USC § 103. Masimo appealed.

**Holding:** Affirmed.

Masimo first argued that the Board erred in construing “trigger a second alarm based on ... exceeding the second alarm threshold,” to mean that crossing the second alarm threshold is a “condition precedent” to the trigger of an alarm but need not actually trigger the alarm. The Federal Circuit agreed with the Board that the plain meaning of “based on” and “threshold” are both broad and do not exclude the use of additional alarm thresholds or other conditions to trigger an alarm. The Federal Circuit also agreed with the Board that disclosure of an embodiment in the specification that does not include any additional thresholds or conditions for triggering an alarm does not support reading such a limitation into the claim.

Masimo also argued that the Board erred in construing “predetermined” to mean the formulaic calculation of a value instead of a fixed value. The Federal Circuit agreed with the Board that it is clear from the specification that the alarm threshold is adaptive and that the adaptive features of the specification would not be possible absent construing “predetermined” to involve a calculation.

Masimo further argued that the Board abused its discretion in considering an argument Sotera made at the Oral Hearing after briefing had concluded. The Federal Circuit agreed with the Board that Sotera clarified its position to the Board at the Oral Hearing in response to direct questioning by the Board about the meaning of a limitation after neither Sotera nor Masimo addressed the Institution Decision’s preliminary reading of the Petition on this issue, and thus, it was not a new argument. Further, the Federal Circuit noted that because the argument was raised in the Petition and the initial decision made a preliminary finding, Masimo was properly noticed as to the issue.

Finally, Masimo argued that the Board’s grounds for determining obviousness were not supported by substantial evidence. Masimo offered several assertions in its arguments, but the Federal Circuit held that the Board’s determinations were supported by substantial evidence.