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District Court Applies Absolute Intervening Rights to Method Claims

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Plaintiff Vocalife LLC ("Vocalife") sued defendants Amazon.com, Inc. and Amazon.com, LLC (collectively, "Amazon") for infringement of United States Patent No. RE47,049 (the "'049 Patent"). During the prosecution of the reissue application which resulted in the '049 Patent, Vocalife amended two of the asserted independent claims to include the following limitation: "wherein said sound source localization unit, said adaptive beamforming unit, and said noise reduction unit are integrated in a digital processor" (the "DSP Limitation"). The DSP Limitation was not present in any of the claims of the original patent.

Amazon moved for partial summary judgement seeking to preclude liability based on intervening rights. Specifically, Amazon sought to preclude liability for (1) acts performed prior to grant of the reissued '049 Patent pursuant to 35 U.S.C. § 252; and (2) products that were made, purchased, offered for sale, used or imported prior to the issuance of the reissued patent. Although Vocalife initially argued that its amendments did not substantively change the scope of the claims, it abandoned that response at the hearing, focusing on two alternate lines of attack. First, Vocalife argued that the defense of absolute intervening rights does not apply to method claims. Second, Vocalife argued that Amazon did not carry its burden to identify which of its products were subject to intervening rights.

In maintaining that absolute intervening rights are reserved only for products that infringe product claims and do not apply to method claims, Vocalife argued that the "plain language of Section 252 establishes absolute intervening rights for 'anything patented' as long as 'the specific things' were made, used, offered for sale, sold or imported before reissue. And because "specific things" implicates only tangible articles, method claims are excluded."

The District Court disagreed. Because no Federal Circuit precedent squarely addresses the issue, the District Court turned to an opinion issued by Judge Bryson sitting by designation in *Sonos, Inc. v. D&M Holdings, Inc*. 287 F. Supp. 3d 533 (D. Del. 2017). *Sonos* held that absolute intervening rights could apply to method claims, reasoning that "[t]he statutory protection offered by absolute intervening rights does not depend on whether the claims at issue are apparatus or method claims," but rather "absolute intervening rights extend only to those 'specific' things in existence before the reissuance or reexamination . . . ." *Id* at 539. That is, *Sonos* focused on the "nature of the product or activity in question" to evaluate whether absolute intervening right apply, not on whether the claim is an apparatus or method claim. The District Court found further guidance in *Infinity Comp. Products, Inc. v. Toshiba America Business Solutions, Inc.*, No. 12-6796, 2019 WL 920197 (E.D. Penn. Feb. 22, 2019). In that case, the District Court relied on the Federal Circuit's interchangeable use of the words "product" and "accused product" with Section 252's use of the phrase "specific things made" to extend intervening rights to method claims. *Id* at *10.

Finally, the District Court looked to the plain meaning of Section 252, examining the language of both absolute and equitable intervening rights. While noting that process claims are only specifically referenced in the section addressing equitable intervening rights, the court explained this "does not preclude a 'specific thing' which practices a claimed method from being protected by absolute intervening rights so long as the 'specific thing' was in existence prior to the asserted patents reissuance." As a result, the District Court concluded that products infringing a method claim can be a "specific thing" within a meaning of Section 252.

Regarding Vocalife's second argument that Amazon did not identify the "specific things" such as a hardware product, software release or combination of the two that would be protected by such rights, the District Court again sided with Amazon. In reaching this conclusion, the District Court noted that Vocalife's damages expert was able to specifically identify products made before the issuance of the '049 Patent and those produced after that date. Moreover, it was Vocalife's contention that the accused products infringe at the point of manufacture. Thus, products protected by Amazon's intervening rights could be identified by their date of manufacture.

Practice tip: While the Federal Circuit has not addressed whether absolute intervening rights apply to method claims and there appears to be some split within the District Courts, this decision provides valuable guidance for practitioners. Patent owners seeking a reissue may not be able to avoid a defense of intervening rights by formatting claims as method claims,

and should therefore focus on claim scope over form. In a similar vein, defendants seeking to assert a defense of intervening rights to a method claim should confirm the record contains sufficient evidence to show which products are affected.

Vocalife LLC v. Amazon.com, Inc., No. 2:19-CV-00123-JRG (E.D. Tex. Aug. 14, 2020) (J., Gilstrap)

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