



## PTAB Upholds Validity of Claim over Prior Art Despite A District Court Finding the Claim Invalid as Indefinite

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By: Brock F. Wilson, Rubén H. Muñoz

In reaching its final decision on validity, the PTAB first reconsidered two of its previous claim constructions. The PTAB had initially determined, pre-*Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015), that the claim limitations “proficiency sensing module” and “mode control module” were not means-plus-function limitations because of the strong presumption that claim limitations that do not use the phrase “means for” are not subject to 35 U.S.C § 112 ¶ 6. The *Williamson* decision, however, abrogated this presumption and, instead, directed courts to determine “whether the words of the claim are understood by persons of ordinary skill in the art to have sufficiently definite meaning as the name for structure.” If the words of the claim do not connote structure, then 35 U.S.C § 112 ¶ 6 applies. Following the *Williamson* decision and additional briefing from the parties, the PTAB found that neither of the disputed limitations, or the remainder of the claim, connoted structure for the modules to a person of ordinary skill, despite the claim reciting inputs and outputs to each module at a “very high level.” Thus, the PTAB reversed its previous decision, ruling that the limitations were means-plus-function limitations subject to 35 U.S.C § 112 ¶ 6.

The PTAB then found that the prior art did not anticipate the challenged claim, because petitioner had not identified any structure in the specification of the patent that corresponded to the two module limitations and, “as a result,” could not identify similar anticipatory structure in the asserted prior art references. The PTAB reached this finding despite knowing that a district court had found the claim indefinite, because the specification failed to disclose sufficient structural support for one of the module limitations, which

suggests that petitioner had not pointed to any corresponding structure in the specification because such structure did not exist.

This case highlights the restrictions on the scope of *inter partes* review, which does not allow petitioners to argue for, or the PTAB to consider, invalidity based on indefiniteness.

*Ubisoft, Inc., v. Guitar Apprentice, Inc.*, IPR 2015-00298, Paper 25 (PTAB April 1, 2016).

## Categories

Patent Trial & Appeal Board

Unpatentability

35 U.S.C § 112 ¶ 6

Technology

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