KRATZ, QUINTOS & HANSON, LLP – IP Newsletter

***ZEROCLICK, LLC V. APPLE INC.*: A USEFUL CASE TO RELY ON AGAINST AN EXAMINER'S REJECTION UNDER 35 U.S.C §112(f) OR PRE-AIA 35 U.S.C §112, ¶ 6 OF CLAIMS THAT DO NOT USE "MEANS-PLUS-FUNCTION" LANGUAGE**

By: Mel R. Quintos

Zeroclick, LLC sued Apple Inc. in the U.S. District Court for the Northern District of California alleging that Apple Inc. infringed claims 2 and 52 of its U.S. Patent No. 7,818,691 (the ҁ691 patent) and claim 19 of its U.S. Patent No. 8,549,443 (the ҁ443 patent). The district court found Zeroclickøs asserted claims invalid reasoning that the claims recited õmeans-plus-functionö terms for which the specifications do not disclose sufficient structure, and thus failed to meet 35 U.S.C. § 112, ¶ 6 requirements.

Zeroclick appealed to the U.S. Court of Appeals for the Federal Circuit, and argued that the district court erred in interpreting the relevant claim terms as means-plus-function limitations. On June 1, 2018, the Federal Circuit decided the case of *Zeroclick, LLC v. Apple Inc.*

Zeroclickøs patents are õrelated to modifications to graphical user interfaces of devices such as computers and mobile phones, modifications that allow the interfaces to be controlled using pre-defined pointer or touch movements instead of mouse clicks.ö The relevant language in claim 2 of the ҁ691 patent recites a õprogram that can operate the movement of the pointer.ö Claim 52 of the ҁ691 patent is a õmethod of operating a graphical user interface,ö as described in claim 2.

The relevant language in claim 19 of the ҁ443 patent is as follows:

> the user interface code being configured to detect one or more locations touched by a movement of the userøs finger on the screen without requiring the exertion of pressure and determine therefrom a selection operation.

Preliminarily, the Federal Circuit set forth its ruling as follows:

> Neither of the [claim] limitations at issue uses the word õmeans.ö Presumptively, therefore, § 112, ¶ 6 does not apply to the limitations. Apple argued that the limitations must be construed under § 112, ¶ 6 [that requires the õmeansö language to have structural support from the specifications], but provided no evidentiary support for that position. Accordingly, Apple failed to carry its burden, and the presumption against the application of § 112, ¶ 6 to the disputed limitations remained unrebutted.

More particularly, the Federal Circuit noted that the district court favored Apple Inc.øs position based on õconclusoryö reasoning, õbut pointed to no record evident that supports its ultimate conclusion regarding whether § 112, ¶ 6 applies to the asserted claims.ö The Federal Circuit held that for the following three reasons, the district court <u>erred</u> in treating the terms:

> õprogramö and õuser interface codeö as nonce words, which can operate as substitutes for õmeansö and presumptively bring the disputed claim limitations within the ambit of § 112, ¶ 6.

First, "the mere fact that the disputed limitations incorporate functional language does <u>not</u> automatically convert the words into means for performing such functions." Emphasis added. Citing *Greenberg v. Ethicon Endo-Surgery, Inc.,* 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996), the Federal Circuit stated that: "[m]any devices take their names from the functions they perform. The examples are innumerable, such as 'filter,' 'brake,' 'clamp,' 'screwdriver,' or 'lock.'" [See also the Manual of Patent Examining Procedure (M.P.E.P.) §2181(I)(A), which cites the same examples and states that 35 U.S.C. §112, ¶ 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 of the structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function."]

Second, the Federal Circuit held that:

a person of ordinary skill in the art could reasonably discern from the claim language that the words "program," * * * and "user interface code" * * * are used not as generic terms or black box recitations of structure or abstractions, but rather as <u>specific references to conventional graphical user interface programs or code, existing in prior art at the time of the inventions</u>. [Emphasis added.]

The Federal Circuit went on to discuss the distinctions "between the graphical user interfaces in the prior art and the improvement to such interfaces in the claimed invention," and that Apple Inc. failed to produce evidence, intrinsic or extrinsic, that rebuts the above suggestion that the claim language defines benefits "over the well accepted conventional methodology." In other words, from their contexts, the claim terms are to be defined merely from their plain and ordinary meaning, and <u>cannot</u> therefore be substituted with the term "means."

Third, "the district court made no pertinent finding that compels the conclusion that a conventional graphical user interface program or code is used in common parlance as substitute for 'means.'"

The district court therefore <u>erred</u> in concluding that the claim terms "program" and "user interface" recited means-plus-function language, and Apple Inc. failed to rebut the presumptions against the application of [35 U.S.C. §112, ¶ 6] to Zeroclick's claims. Zeroclick's claims are therefore to be rendered valid.

<u>**Decision:**</u> Vacated and Remanded