POOR GRAMMAR KILLED THE PATENT

Vasudevan v. MicroStrategy (14-1094 (Fed. Cir. 2015))
Vasudevan v TIBCO (14-1096 (Fed. Cir. 2015))

Justen Fauth
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Introduction

- Current legal standards (claim construction, written description, and enablement)
- Procedural history
- Federal Circuit's (FC's) ruling
- Points to remember

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Main Topics

- ***Non-infringement*** resulting from narrow definition of claim terms including "*disparate digital databases*."
- ***Summary Judgment*** based on ***invalidity*** of the claims due to ***lack of enablement*** and ***written description***.

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Parties

- Vasudevan Software (VSi) (Winston-Salem, N.C.): software design
- MicroStrategy (Tysons Corner, VA): business intelligence (BI), mobile software, and cloud-based services
- TIBCO (Palo Alto, CA): infrastructure and business intelligence software

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Claim Construction

- Terms are given their plain and ordinary meaning
- Standardized dictionary definitions

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Claim Terms

The meaning of "***disparate digital databases***" as indicated in VSi's response to the § 103 Rejection based on Jones in the Non-Final Office Action:

- The disparate nature of the … databases refers to an ***absence*** of
  - compatible keys ***or***
  - record identifier (ID) columns ***or***
  - [a] format in the schemas or structures of the database.

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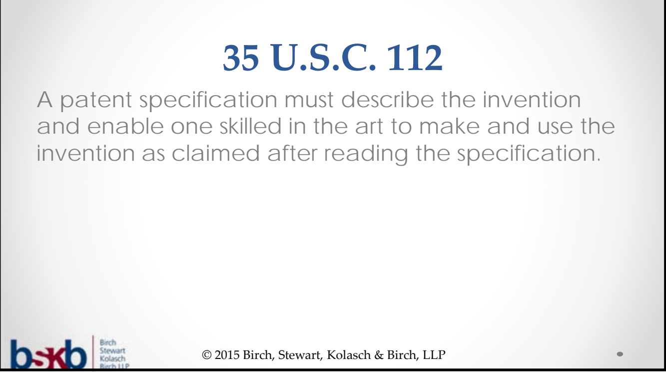

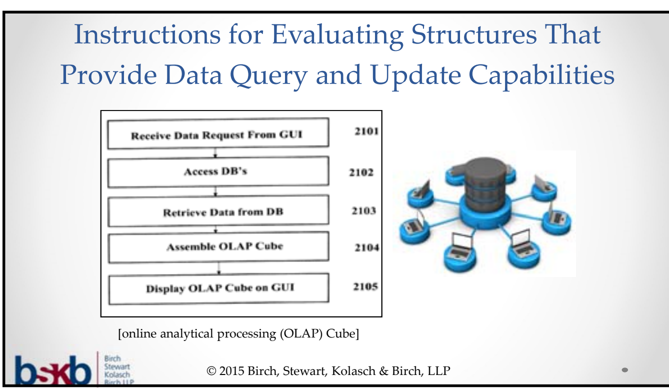

Instructions for Evaluating Structures That Provide Data Query and Update Capabilities

- The OLAP view of data (i.e., an OLAP cube) is assembled at run time by accessing a plurality of incompatible source databases.
- Also, for the first time, the user may directly update, add, or remove source databases directly from the user's GUI display of the OLAP cube, which also updates the OLAP cube.
- The present invention can be used to more easily track common problems and detected defects and trends between multiple structures grouped into generic classes (e.g., different aircraft models including the Boeing 737 and the McDonnell Douglas DC 10).
- This is distinct from the prior art, which may build a single static OLAP data cube in the design phase of the information system, then access it in response to user queries.

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Claimed Invention (U.S. Patent No. 6,877,006)

2. A data storage medium containing instructions programmed to perform a method, the method comprising:

a. receiving with a computer a data retrieval request …,

b. **in response to the retrieval request, accessing with a, [*sic*] computer a plurality of** ***disparate digital databases*** **and retrieving with a computer requested data from such databases**,

c. **assembling with a computer an OLAP cube** …,

d. displaying the OLAP cube to the user using the GUI,

e. accepting through the GUI a dynamic on demand user update …,

f. accessing an affected constituent database … and dynamically updating that database …, and

g. **dynamically on demand updating the assembled OLAP cube** with the specific data update.

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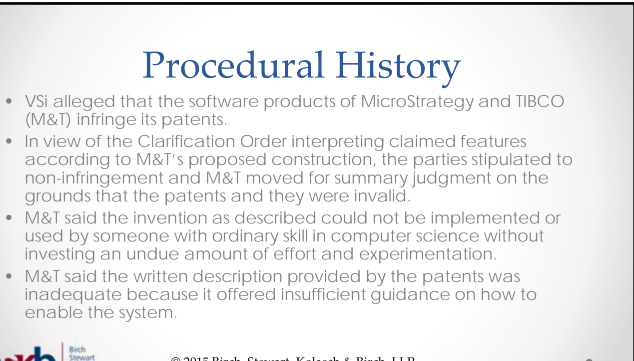

Procedural History

- U.S. District Judge Richard Seeborg granted motions for summary judgment from both MicroStrategy and TIBCO.
- District Court (DC) found that patent holder Mark Vasudevan struggled to make the system described by the four patents-in-suit and VSi's claims provided design instructions that would lead to a finished product that didn't work.
- VSi appealed the DC's clarification order and the DC's grant of summary judgment.

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Lower Court's Reasoning

- Claim language is construed using standardized dictionary definitions where the claims have no specialized meaning.
- Patentees should be bound by representations and actions that were taken to obtain the patent.

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Lower Court's Reasoning

The DC's interpretation was based on VSi's explanation to the PTO:

> The disparate nature of the above databases refers to an absence of compatible keys ***or*** record identifier (ID) columns of similar value ***or*** [a] format in the schemas or structures of the database that would otherwise enable linking data within the constituent databases [emphasis added].

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Lower Court's Reasoning

The DC explained that a database would only be disparate if it had:

1) an absence of compatible keys; ***and***
2) an absence of record ID columns of similar value; ***and***
3) an absence of a similar format in the schemas or structures that would otherwise enable linking data.

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Lower Court's Reasoning

- The DC stated that the FC has consistently interpreted the word '***or***' to mean that the items in the sequence are alternatives to each other.
- The DC referenced a basic rule of logic known as **De Morgan's law**:

  not (p or q) = (not p) and (not q).

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Lower Court's Reasoning

- The DC considered VSi's argument that the prior art reference Jones cited by the PTO in the Office Action does not disclose a plurality of disparate digital databases and relies on common keys that relate the data between the different tables and databases.
- However, the DC determined that VSi's representation regarding the meaning of "disparate digital databases" was a "clear" and "unmistakable" definition.

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Lower Court's Reasoning

- VSi's patents lacked adequate written description support
  - VSi did not have possession of a means of accessing "disparate databases" at the time of filing.
  - The testimony by VSi's expert, Dr. Cárdenas, indicating that the specification teaches how to implement a system that can access disparate databases was "conclusory."
- VSi's claims were not enabled
  - The inventor did not have a working example of the "disparate databases" feature.
  - It took the inventor three calendar years from the time of filing to build a functioning embodiment of the invention.

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FC's Ruling

- The FC affirmed the DC's claim construction and judgment of noninfringement.
- The FC reversed the DC's grants of summary judgments of invalidity and remanded.

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Legal Issues

I. Claim construction
II. Invalidity (written description)
III. Invalidity (enablement)

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Legal Issue I – Claim Construction

- Claim terms are generally given their plain and ordinary meanings.
- However, patentees can act as their own lexicographers.
- The import of extrinsic evidence was reviewed *de novo*.

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Legal Issue II – Invalidity (Written Description)

- The disclosure of the application relied upon must reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.
- Whether a patent claim is supported by an adequate written description is a question of fact.
- The summary judgment decisions were reviewed *de novo*.

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Legal Issue III – Invalidity (Enablement)

- A specification must "enable" a person of skill in the art to make and use the claimed invention.
- Enablement is a legal question based on underlying factual determinations.
- A claim is sufficiently enabled so long as experimentation is merely routine.
- In determining whether experimentation is undue, *Wands* lists a number of factors to consider.

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Wands Factors

(1) The quantity of experimentation necessary.
(2) The amount of direction or guidance presented.
(3) The presence or absence of working examples .
(4) The nature of the invention.
(5) The state of the prior art.
(6) The relative skill of those in the art.
(7) The predictability or unpredictability of the art.
(8) The breadth of the claims.

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Vsi's Arguments: Issue I

- The plain and ordinary meaning of "disparate databases" is simply "incompatible databases having different schemas" (***disjunctive interpretation***).
- VSi also contended that its position is consistent with and fully supported by a ***stipulation*** it entered into with IBM and Oracle in a prior litigation involving these same patents are simply those with different schemas.
- VSi then relied on its expert's, Dr. McLeod's, testimony during which he stated that "disparate databases" are simply "incompatible databases having different schemas."

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FC Rejected

- The FC stated that, while "disparate databases" may be considered "incompatible databases," the ***plain and ordinary meaning*** leaves open the question of how "disparate" or "incompatible" the databases may be.
- Extrinsic evidence is of ***little relevance or probative value*** because IBM and Oracle's accused products may have functioned in a manner for which the precise scope of the "disparate databases" limitation was immaterial, and the defendants were not parties to the IBM and Oracle stipulation.
- The prosecution history confirms that the applicant was ***defining*** "disparate databases" when he stated (emphasis added) "[t]he disparate nature of the above databases ***refers to*** an absence of compatible keys or record identifier (ID) columns … or [a] format in the schemas or structures of the database. . ." to distinguish over Jones (***conjunctive interpretation***).

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Vsi's Arguments: Issue II

- VSi contended that a genuine issue of material fact exists because the specification describes accessing "incompatible databases," which, VSi claims, is equivalent to disparate databases.
- VSi also relied on its expert, Dr. Cárdenas, stating that the specification provides support because it teaches how to implement a system that can access disparate databases.

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FC Agreed

- Drawing all reasonable inferences in favor of VSi as the non-movant, the FC determined based on the testimony of Dr. Cárdenas that there are genuine issues of material fact regarding whether the specification shows possession of the claimed invention.
- The specification of the patents-in-suit describes dynamically "***accessing*** a plurality of ***incompatible*** source ***databases***."
- The FC reversed the DC's determination of summary judgment that the claims asserted against TIBCO are invalid for lack of written description support.

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VSi's Arguments: Issue III

- VSi argued that many of the DC's factual findings are genuinely disputed.
- The inventor developed a "commercial-grade software product."
- VSi indicated that the inventor could have developed a functional prototype with far less experimentation.
- Dr. Cárdenas, VSi's expert, stated that the inventor's one man-year experimentation was not undue.

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FC Agreed

- The FC noted that a claim is sufficiently enabled even if "a considerable amount of experimentation" is necessary, so long as the experimentation "is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed."
- The FC concluded that there are genuine issues of material fact relating to several of the *Wands* factors, which, taken together, preclude summary judgment of non-enablement.

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Was the FC Right?

- Affirming the DC's claim construction was probably correct due to VSi's statements during prosecution.
- Reversing the DC's summary judgment decisions was controversial. It is unclear why VSi was unable to convince the DC that the asserted claims are enabled and have sufficient written description support.

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Take-Aways

- Pay close attention to grammar in the claims and other portions of the prosecution history.
- Take precautions while making arguments for overcoming prior art to not detrimentally impact the scope of the claimed invention.

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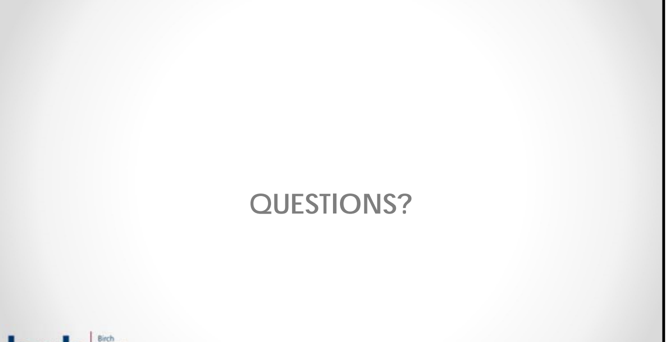

QUESTIONS?

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THANK YOU

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