

Allvoice Computing PLC v. Nuance Commc'ns, Inc.

No. 06-1440, Federal Circuit (Newman, Rader,* Gajarsa)

Because the claims represent "the subject matter which the applicant regards as his invention," subject matter outside the scope of the claims also falls outside the scope of the best mode requirement.

On October 12, 2007, the Federal Circuit reversed and remanded the district court's summary judgment that U.S. Patent No. 5,799,273, which related to voice recognition technology, was invalid under 35 U.S.C. § 112 for indefiniteness and failure to disclose the best mode. The Federal Circuit stated:

The definiteness requirement is set forth at 35 U.S.C. § 112 ¶ 2: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The test for definiteness asks whether one skilled in the art would understand the bounds of the claim when read in light of the specification.

[T]he district court proceeded to assess indefiniteness with an unduly narrow claim construction. This narrow reading of the "independent of" requirement in claims 61 and 67 led to a finding that the specification did not contain structure corresponding to that narrow claimed function. With a proper reading of the claim term, however, the specification does contain adequate structure. . . . Because neither the claim language nor the prosecution history requires more, the record shows that the district court erred in finding claims 61 and 67 indefinite on the basis of the "independent of" language.

The district court also found claims 61 and 67 indefinite for failure to set forth sufficient algorithmic structure associated with the contested means-plus-function clauses. [But] the specification contains sufficient algorithmic structure to give meaning to claims 61 and 67. Claim definiteness . . . depends on the skill level of a person of ordinary skill in the art. In software cases, therefore, algorithms in the specification need only disclose adequate defining structure to render the bounds of the claim understandable to one of ordinary skill in the art.

The district court held the '273 patent invalid for deliberate concealment of the best mode – a requirement of 35 U.S.C. § 112 ¶ 1 [which] provides that the specification of a patent "shall set forth the best mode contemplated by the inventor of carrying out his invention." This requirement ensures a patent applicant discloses the preferred embodiment of his invention. Only the claimed

invention is subject to the best mode requirement. Because the claims represent “the subject matter which the applicant regards as his invention,” subject matter outside the scope of the claims also falls outside the scope of the best mode requirement. To apply the best mode standard, a court must first “determine[] whether, at the time the patent application was filed, the inventor had a best mode of practicing the claimed invention.” This determination turns on the inventor’s own subjective beliefs. “[T]he second part of the analysis [asks] . . . has the inventor ‘concealed’ his preferred mode from the ‘public’?”

Nuance alleged, and the district court agreed, that some functions of WordExpress, one of Allvoice’s commercial products, constituted an undisclosed best mode for claim 73. In reaching this judgment, the district court assumed that claim 73 required maintaining or updating link data during the editing process. Based on this assumption, the district court held that the best mode for maintaining links after text editing included the “Selrange macro” (“the macro”), Microsoft Windows “hooks,” and the disabling of certain features of Microsoft Word. . . .

Unlike claims 1, 15, 28, and others in the ‘273 patent, claim 73 does not include “updating” link data, “maintaining” link data after editing, or “monitoring” changes to text. Because “forming link data” does not include monitoring changes or updating link data, a method to perform those unclaimed functions falls outside the scope of claim 73. The macro considered by the district court does nothing more than monitor the changes to a document, to eventually facilitate the updating of link data. Claim 73 does not include these features. Thus, the macro cannot be a best mode for claim 73. Because the alleged best mode does not fall within the scope of claim 73, this court need not consider whether the inventors of the ‘273 patent actually believed the macro was their best mode of practicing the invention or whether they deliberately concealed that subject matter.

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