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NAVIGATING UNCERTAINTY— ADDRESSING PURELY FUNCTIONAL CLAIM LIMITATIONS IN A POST- *WILLIAMSON* WORLD WITH ONGOING PTAB CLIMATE CHANGE*

KENNETH DARBY** AND RICK BIENIUS***

INTRODUCTION

Patent litigants on both sides of the docket struggle with claim limitations that *do not* expressly recite “means for” language yet define the scope of the invention in terms of functionality rather than structure.¹ In the wake of *Williamson v. Citrix Online, LLC*,² tribunals have increasingly found that claim limitations reciting so-called nonce words overcome the

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1. The 1952 Patent Act recognized the Court’s struggle with functional limitations and generally sought to remedy that confusion with § 112, ¶ 6 as a venue for dealing with and recognizing functional limitations. It did so in response to *Halliburton Oil Well Cementing Co. v. Walker*. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1357 (Fed. Cir. 2015) (Reyna, J., concurring) (“[I]t is generally accepted that 112, para. 6 was passed in response to the Supreme Court’s decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).”); *Function Media, L.L.C. v. Google Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013) (“Section 112, paragraph 6, is intended to prevent . . . pure functional claiming” that “would allow the patentee to claim all possible means of achieving a function”) (quoting *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009)). The doctrine that has developed in the intervening 60 years, however, demonstrates that the Act did not put to rest a general discomfort with the scope and patentability of functional claiming. *See, e.g., Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016) (multiple opinions debating the extent to which functional claiming is lawful), *cert. denied*, 138 S. Ct. 469 (2017).

2. 792 F.3d 1339 (Fed. Cir. 2015).

legal presumption against § 112, ¶ 6 (or means-plus-function)³ treatment. Unsurprisingly, petitioner-defendants generally prefer narrow interpretations of such nonce-word claim limitations under § 112, ¶ 6 for purposes of establishing non-infringement and indefiniteness defenses in district court. Yet these same interpretations are often more difficult to address at the Patent Trial and Appeal Board (“PTAB”)—where infringement and indefiniteness are not at issue. Conversely, patent owners, for their part, are more apt to oppose narrowing § 112, ¶ 6 constructions in district court as plaintiffs, but would often like the PTAB to hold petitioners to their district court interpretations if doing so would mean a denial of institution. These conflicting forum-specific interests of the parties raise difficult issues, which panels tend to resolve *ad hoc*. Trends, guidelines, and the existing rules at the PTAB only expand the cloud of uncertainty.

This Article briefly discusses the *Williamson* decision, its legal and practical effect, and strategic considerations for petitioners and patent owners at the PTAB.⁴

THE FEDERAL CIRCUIT’S *EN BANC WILLIAMSON* DECISION AND THE RISE OF § 112, ¶ 6 INTERPRETATIONS FOR NONCE TERMS

The 1952 Patent Act incorporated § 112, ¶ 6 to provide a mechanism for facilitating purely functional claim limitations. Its promulgation was directly responsive to the Supreme Court’s holding in *Halliburton Oil Well Cementing Co. v. Walker*, which prohibited functional claiming.⁵ Pre-AIA § 112, ¶ 6 reintroduced a way to include purely functional limitations, but tethered such limitations to structure(s) recited in the specification (or equivalents thereof).⁶ Interpretation of claim elements as reciting purely functional language had, prior to *Williamson v. Citrix Online, LLC*, traditionally only been applied to claim recitations including the terms “means of” or “means for.”⁷ However, there was a growing body of law

3. The America Invents Act of 2011 redrafted the 112 statute such that the commonly recognized sixth paragraph of 35 U.S.C. § 112 is now reflected in the revised 112(f) subsection for patents with a priority date on or after March 16, 2013. 35 U.S.C. § 112(f). Except for direct quotes, AIA 35 U.S.C. § 112(f) and pre-AIA 35 U.S.C. § 112, ¶ 6 are collectively referred to herein as “§ 112, ¶ 6.”

4. Others have looked at these issues but have focused on different parts of the conflict. See generally Jonathan DeFosse & Jonathan Stroud, *Indefinitely, Maybe: Raising § 112(b) in Inter Partes Review*, 45 AIPLA Q.J. 351 (2018) (looking at denials of institution due to indefiniteness generally, and analyzing a handful of means-plus-function cases).

5. See *supra* note 1.

6. 35 U.S.C. § 112, ¶ 6.

7. *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1297 (Fed. Cir. 2014) (“We have repeatedly characterized this presumption as ‘strong’ and ‘not readily overcome’ and, as such, have ‘seldom’ held

saying that “nonce words”—other structureless words in addition to “means”—can also sometimes invoke § 112, ¶ 6.⁸

On June 16, 2015, a majority opinion from the *en banc* Federal Circuit in *Williamson* abruptly abandoned the prior line of jurisprudence addressing the applicability of pre-AIA 35 U.S.C. § 112, ¶ 6.⁹ In the *Williamson* majority opinion, penned by Circuit Judge Linn,¹⁰ the court confirmed the traditional presumption against the application of § 112, ¶ 6 when a claim term lacks the word “means,” but questioned its more recent development of “a heightened bar to overcoming [this] presumption.”¹¹

The Federal Circuit has long held that absence of the word “means” creates a presumption against application of § 112, ¶ 6.¹² Several subsequent decisions characterized the presumption against construing non-“means” claims under § 112, ¶ 6 as a strong one and had applied it vigorously. Prior to *Williamson*, the court had expressed repeated skepticism that non-means terms would be construed under § 112, ¶ 6, repeatedly tightening the standard for doing so. For example, in *Lighting World, Inc. v. Birchwood Lighting, Inc.*, the court stated for the first time that the negative presumption “is a strong one that is not readily overcome.”¹³ In *Flo Healthcare Solutions, LLC v. Kappos*, the court went even further, stating that § 112, ¶ 6 would not be

that a limitation without recitation of “means” is a means-plus-function limitation.”) (internal citation omitted); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed. Cir. 2002); *see also* Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. § 112 ¶ 6, 65 Fed. Reg. 38510, 38514 (June 21, 2000).

8. *See, e.g.*, *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1354 (Fed. Cir. 2006) (holding that generic terms such as “mechanism,” “element,” “device,” and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word “means” because they “typically do not connote sufficiently definite structure” and therefore may invoke § 112, ¶ 6); *see also* *Welker Bearing Co., v. PHD, Inc.*, 550 F.3d 1090, 1096 (Fed. Cir. 2008); *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 704 (Fed. Cir. 1998); *Mas-Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1214–15 (Fed. Cir. 1998).

9. 792 F.3d 1339, 1357 (Fed. Cir. 2015). To be fair, *Williamson* followed on the heels of the 2008 *Aristocrat Technologies Australia Pty Ltd. v. International Game Technology* decision, which likewise used indefiniteness to cancel overbroad means-plus-function software patents. That decision led in part to the circuit split that caused the *en banc* court to take and resolve *Williamson*. *See* *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1337–38 (Fed. Cir. 2008).

10. Joined in the majority by Chief Judge Prost, Circuit Judges, Lourie, Dyk, Moore, O’Malley, Reyna, Wallach, Taranto, Chen, and Hughes.

11. *Id.* at 1349. The court likewise found that even traditionally claimed “means” limitations, if implemented by a general-purpose computer, must recite an algorithm in the specification to survive an indefiniteness challenge, though that part of the opinion is beyond the scope of this Article. *Id.* at 1352.

12. *Personalized Media*, 161 F.3d at 703–04 (“the failure to use the word ‘means’ creates a presumption that § 112, ¶ 6 does not apply. . .”).

13. 382 F.3d 1354, 1358 (Fed. Cir. 2004).

applied to a non-means claim term “without a showing that the limitation essentially is devoid of anything that can be construed as structure.”¹⁴

Sitting *en banc*, the *Williamson* court disagreed, finding that “such a heightened burden is unjustified,” and “ha[d] resulted in a proliferation of functional claiming untethered to § 112, ¶ 6 and free of the strictures set forth in the statute.”¹⁵ Expressly overruling *Lighting World* and its progeny, the court announced a return to the standard of the presumption that had been set forth in prior decisions—namely, “whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.”¹⁶ Under this more flexible standard, the *en banc* court explained, “[w]hen a claim term lacks the word ‘means,’ the presumption can be overcome and § 112, ¶ 6 will apply if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’”¹⁷

Applying this standard to the facts of the case, the *Williamson* court compared two sets of independent claims, one with the term “means” and one with the term “module,” and found the non-means claim term “distributed learning control *module*” deserved §112, ¶ 6 treatment, reasoning that the trigger term “means” had merely been replaced by another word—“module”—that was equally meaningless.¹⁸ The court went on to broadly suggest that such generic nonce words, like “module,” “mechanism,” “element,” and “device,” are in this context “reflect[ive] [of] nothing more than verbal constructs” that “typically do not connote sufficiently definition structure and therefore may invoke § 112, ¶ 6.”¹⁹ The court left the list of which types of words might be considered nonce words open, but also did not suggest that the listed words themselves were more likely than any others to overcome the presumption.

In the years following *Williamson*, Federal Circuit panels have reached similar conclusions, finding claim terms that replace the word “means” with a nonce word to be subject to interpretation under § 112, ¶ 6 when the presumption against such treatment, as restated under *Williamson*, was

14. 697 F.3d 1367, 1374 (Fed. Cir. 2012) (internal citation omitted).

15. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015).

16. *Id.* (citing *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996)).

17. *Id.* (quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)).

18. *Id.* at 1349–51 (emphasis added).

19. *Id.* at 1350 (citing *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1354 (Fed. Cir. 2006); U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2181 (9th ed. Rev. Aug. 2017, Jan. 2018)[hereinafter MPEP]).

overcome. For example, in *Media Rights Technologies, Inc. v. Capital One Financial Corp.*,²⁰ the term “compliance mechanism” was so construed, as was the term “symbol generator” in *Advanced Ground Information Systems v. Life360, Inc.*,²¹ and “cheque standby unit” in *Diebold Nixdorf, Inc. v. International Trade Commission*.²² *Williamson* thus opened the door to many more non-“means” terms being construed as means-plus-function limitations, albeit still with a presumption to overcome against doing so.

The trickle-down effect of *Williamson* at the district court and post-grant level has been significant. While a detailed statistical breakdown is beyond the scope of this Article, the authors have identified more than 100 district court cases and 60 post-grant PTAB cases addressing the negative presumption as restated in *Williamson*—far more of which found the presumption overcome than the cases that had addressed this question before *Williamson*.²³ Meanwhile, the PTAB is required by regulation to address the construction of means-plus-function claim limitations differently than for other claims, which has led to complex claim construction issues prior to institution that have roiled panels and surprised some practitioners.

Seeking consistent application of the § 112, ¶ 6 presumptions under *Williamson*, the United States Patent and Trademark Office (“USPTO”) recently promulgated official guidance entitled EXAMINING COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATIONS FOR COMPLIANCE WITH 35 U.S.C. 112 (“the Guidance”).²⁴ In this document, meant to guide patent examiners, the USPTO refers to a 3-prong analysis²⁵ set forth in the Manual of Patent Examining Procedure for addressing the applicability of § 112, ¶ 6.²⁶ Exemplary nonce words in the *Williamson* sense identified in the Guidance include “mechanism,” “module,” “device,” “unit,” “component,” “element,” “member,” “apparatus,” “machine,” and “system.”²⁷ While the

20. 800 F.3d 1366 (Fed. Cir. 2015).

21. 830 F.3d 1341 (Fed. Cir. 2016).

22. 899 F.3d 1291 (Fed. Cir. 2018).

23. This work was conducted by the authors using Lexis Advance and Docket Navigator research platforms.

24. 84 Fed. Reg. 57 (Jan. 7, 2019).

25. *Id.* at 58 (“At a high level, the 3-prong analysis includes evaluating whether: the claim limitation uses the term ‘means’ (or ‘step’) or a generic placeholder, the term is modified by functional language, and the term is not modified by sufficient structure, material or acts for performing the function.”).

26. *See id.* (citing MPEP § 2181(I)).

27. *Id.* at 59.

Guidance does not specifically mention PTAB trials, some have predicted that it will eventually play a significant role²⁸ in that setting.²⁹

THINKING THROUGH *WILLIAMSON* STRATEGIES AND TACTICS AT THE PTAB

In the wake of both *Williamson* and the new USPTO guidance, practitioners should anticipate treatment of claim terms as purely functional under § 112, ¶ 6 to increase and develop strategies for addressing such situations.

Strategy Considerations for Petitioners

In post-grant proceedings, the petitioner carries the ultimate burden of persuasion to establish unpatentability by a preponderance of the evidence.³⁰ This burden never shifts to the patent owner, though in limited circumstances the burden of production may shift between the parties.³¹ The PTAB's rules require the petition to identify "[h]ow the challenged claim is to be construed" and "[h]ow the construed claim is unpatentable,"³² but PTAB practice and Federal Circuit cases urge the PTAB only to construe claims necessary to resolve the issues before it.³³ The rules, however, require the PTAB to address claim construction for means-plus-function limitations differently than for other limitations: "Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. § 112(f), the construction of the claim must identify the

28. See, e.g., *Zscaler, Inc. v. Symantec Corp.*, No. IPR2018-00916, Paper 21 at 19 (P.T.A.B. Feb. 14, 2019) (patent owner citing the USPTO Guidance in support of arguments that certain non-means claim terms are deserving of § 112, ¶ 6 treatment); *Am. Express Co. v. Signature Sys., LLC*, No. CBM2018-00035, Paper 18 at 3 (P.T.A.B. Jan. 18, 2019) (the PTAB reminding the parties to consult the Guidance in connection with the filing of a motion to amend).

29. Uniform application of the *Williamson* presumptions across the USPTO as a whole is consistent with Director Andrei Iancu's press release addressing the Guidance. See Press Release, United States Patent and Trademark Office, U.S. Patent and Trademark Office announces revised Guidance for determining subject matter eligibility (Jan. 4, 2019) (on file with authors).

30. See *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378–80 (Fed. Cir. 2015) (citing 35 U.S.C. § 316(e)).

31. *Id.*

32. 37 C.F.R. § 42.104(b)(3)–(4).

33. "Only those terms which are in controversy need be construed, and only to the extent necessary to resolve the controversy." *Unified Pats. Inc v. Uniloc Lux. S.A.*, No. IPR2017-02148, Paper 9 at 6 (P.T.A.B. Apr. 17, 2018) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.”³⁴

Owning both to the statutory burden of persuasion and to the regulatory requirements for construing these limitations, a petitioner may be forced to take a position, in the petition, on whether a non-means term including a nonce word should be interpreted under § 112, ¶ 6 based on *Williamson* or instead given its plain meaning in view of the specification.³⁵ If the former, the petition potentially must identify the corresponding structure and demonstrate its presence in the prior art to prevail.³⁶

This may be easier said than done. For example, the specification may, in the petitioner’s view, not provide corresponding structure, rendering the claim indefinite, and potentially leading to a denial of institution in *inter partes* review (“IPR”) proceedings, which are limited to anticipation and obviousness grounds.³⁷ This issue can be particularly problematic in the context of computer-implemented inventions, where the corresponding structure in many instances must include a specific algorithm.³⁸ And even where the specification provides the corresponding structure, the petitioner may struggle to fit its prior art to the § 112, ¶ 6 interpretation. This too could lead to denial of institution or, worse, to a final written decision finding the claims not proven unpatentable. As for the opposite tactic of arguing *against* a § 112, ¶ 6 interpretation, petitioners may find this option unpalatable for

34. *Unified Pats. Inc v. Uniloc Lux. S.A.*, No. IPR2017-02148, Paper 9 at 6-7 (P.T.A.B. Apr. 17, 2018) (citing 37 C.F.R. § 42.104(b)(3)).

35. In many instances, it is appropriate for a petitioner to initially rely on the negative *Williamson* presumption against a § 112, ¶ 6 interpretation of a non-means term without express discussion in the petition. *See, e.g.*, *Toro Co. v. MTD Prods. Inc.*, No. IPR2016-00194, Paper 13 at 11–12 (P.T.A.B. May 13, 2016) (rejecting the notion that petitioners have a duty under 37 C.F.R. § 42.104(b) to address non-means terms under *Williamson* where claim language does not simply substitute a nonce word for the word “means” and is not clearly lacking in structure); *Adlens USA Inc. v. Superfocus Holdings LLC*, No. IPR2015-01821, Paper 40 at 28 (P.T.A.B. Dec. 27, 2016) (“Under the circumstances of this case, Petitioner was entitled to rely on the rebuttable presumption under *Williamson*.”). Nonetheless, most practitioners would be prudent to address the issue upfront rather than risk a one-sided response from a patent owner prior to institution.

36. *See Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 582 F.3d 1288, 1299 (Fed. Cir. 2009) (“[A] challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure—or an equivalent—was present in the prior art.”).

37. *See, e.g.*, *Micron Tech., Inc. v. Innovative Memory Sys., Inc.*, No. IPR2016-00324, Paper 11 at 6–10 (P.T.A.B. June 13, 2016); *Samsung Elecs. Co., Ltd. v. Huawei Techs., Co., Ltd.*, No. IPR2017-01483, Paper 17 at 8–11, 35 (P.T.A.B. Dec. 5, 2017); *Nikon Corp. v. ASML Neth. B.V. et al.*, No. IPR2018-00220, Paper 8 at 9–16 (P.T.A.B. June 4, 2018). The reasoning is that, if the claims are too indefinite to construe, then they could not be properly adjudged on 102 and 103 grounds.

38. *See Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008); *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999).

other reasons. For example, it may foreclose (or at least undermine) a non-infringement or indefiniteness defense in co-pending district court proceedings.

These difficulties may tempt petitioners to avoid specific constructions of non-means claim terms altogether. But, this may also lead them astray. For example, the PTAB has occasionally performed the *Williamson* analysis *sua sponte* and determined not to institute a trial, either because the petitioner did not construe the claim and map the prior art to the corresponding structure,³⁹ or because the claim term was indefinite for lack of corresponding structure in the specification.⁴⁰ In other cases, the PTAB has faulted petitioners for pursuing § 112, ¶ 6 interpretations in district court under *Williamson* and not advancing the same at the PTAB.⁴¹ This issue is all the more important now that the PTAB has adopted a *Phillips* construction standard to promote consistency between the forums.⁴² So, where it may have been once appropriate (if risky) to rely on the tenet that a broadest reasonable interpretation must necessarily encompass a patent owner's infringement allegations as justification for advancing inconsistent claim construction positions, that distinction no longer exists.⁴³

39. See, e.g., *HP Inc. v. Memjet Tech. Ltd.*, No. IPR2016-00356, Paper 7 at 7–11 (P.T.A.B. June 16, 2016).

40. See, e.g., *Apple Inc. v. Immersion Corp.*, No. IPR2016-01372, Paper 7 at 13–20 (P.T.A.B. Jan. 11, 2017).

41. See, e.g., *Orthopediatrics Corp. v. K2M, Inc.*, No. IPR2018-01547, Paper 9 at 6–11 (P.T.A.B. Feb. 22, 2019) (“Because of the unique circumstances of this proceeding, where Petitioner advocated for a different claim construction in the related district court litigation, we determine that construction of the claim terms in dispute is necessary for the resolution of issues before us. Lacking such claim construction, the Petition fails to comply with 37 C.F.R. § 42.104(b)(3).”); *Infinera Corp. v. Core Optical Techs., LLC*, No. IPR2018-01259, Paper 9 at 9–14 (P.T.A.B. Jan. 14, 2019); *ZTE Corp. v. Maxell, Ltd.*, No. IPR2018-00241, Paper 9 at 9 (P.T.A.B. July 2, 2018) (denying institution) (“both parties and the district court agreed in the district court litigation that [these terms] should be treated as means-plus-function limitations under § 112, sixth paragraph. Yet Petitioner here does not argue that the limitations should be construed in the manner permitted under § 112, sixth paragraph, instead proposing a ‘broadest reasonable interpretation’ . . . Petitioner does not explain why it has abandoned its position that the terms are means-plus-function limitations. . . . Under these particular circumstances, we conclude that the Petition fails to provide the requisite claim construction analysis. . . .”).

42. See *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51340, 51340–59 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42) (“[T]he amended rules will encourage parties to take a consistent position with respect to claim constructions in their patentability and infringement arguments, to ensure that whatever decision issues, regardless of forum, is reflective of the ‘correct’ construction.”).

43. See *Ex parte Schulhauser*, Appeal No. 2013-007847, slip op. at 9, 2016 Pat. App. LEXIS 2437, *12 (P.T.A.B. Apr. 28, 2016) (precedential); *but see*, *ZTE Corp. v. Maxell, Ltd.*, No. IPR2018-00241, Paper 9 at 9 (P.T.A.B. July 2, 2018) (questioning whether “a broadest reasonable interpretation must ‘include’ a construction once proffered by Patent Owner in the district court litigation” in all circumstances); *InfoBionic, Inc. v. Braemer Mfg., LLC*, No. IPR2015-01704, Paper 11 at 6 (P.T.A.B. Feb. 16, 2016) (“We also do not find persuasive Petitioner’s argument, based on extrinsic evidence, that

The perils of seeking review of non-means claim terms possibly subject to § 112, ¶ 6 treatment under *Williamson* are many. Petitioners should, therefore, identify any such terms early on and develop a strategy that accounts for potential outcomes at the PTAB and in any district court proceedings well before the petition is drafted.

There are several strategies a petitioner could employ. For example, if the prior art will not adequately address the challenged claims under a § 112, ¶ 6 construction, or if the underlying specification lacks corresponding structure, then the petitioner could forego an IPR challenge. This is particularly apt when a § 112, ¶ 6 construction is necessary to support an essential non-infringement or indefiniteness defense in a co-pending district court proceeding, as it relieves the petitioner from having to play both sides of the *Williamson* issue. Moreover, under the PTAB's new all-or-nothing institution procedure in view of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018),⁴⁴ removing claims from the petition that are vulnerable to denial can serve to protect other unaffected claims—or at least prevent those claims from being found not unpatentable in a final written decision.⁴⁵ When a petitioner does not view a § 112, ¶ 6 construction as mission-critical to a district court defense, it may be advisable to affirmatively argue and present evidence that preempts a rebuttal of the negative *Williamson* presumption. Several petitioners have done so and earned institution.⁴⁶

If the prior art clearly demonstrates unpatentability—even under a § 112, ¶ 6 construction—then the petitioner could include at least one ground directed to such a construction. It is permissible (and generally prudent) to

Patent Owner's position in related litigations should influence our determination of the proper construction in this forum."); see also *Mentor Graphics Corp. v. Synopsys, Inc.*, No. IPR2014-00287, Paper 17 at 3 (P.T.A.B. Aug. 1, 2014) (finding patent owner's preliminary infringement contentions irrelevant to claims at trial except for their "alleged inconsistency with arguments made" by the patent owner before the PTAB).

44. See *Guidance on the Impact of SAS on AIA Trial Proceedings*, U.S. PAT. TRADEMARK OFF. (April 26, 2018), https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20%28april_26%2C_2018%29.pdf.

45. *Nikon Corp. v. ASML Neth. B.V. et al.*, No. IPR2018-00220, Paper 8 at 18 (P.T.A.B. June 4, 2018) ("[I]f we were to institute a trial on claim 14 and its dependents, we also would have to institute on the challenged means-plus-function claims. . . The result of institution would be a trial in which Petitioner contends that the majority of the challenged claims are not amenable to construction.").

46. See, e.g., *Apple Inc. v. Evolved Wireless LLC*, No. IPR2016-01208, Paper 7 at 10, 23–24 (P.T.A.B. Dec. 21, 2016); *Unified Pats. Inc. v. Sound View Innovations, LLC*, No. IPR2018-00096, Paper 11 at 15–16, 36 (P.T.A.B. Apr. 18, 2018); *Apple Inc. v. Uniloc Lux. S.A.*, No. IPR2018-00389, Paper 7 at 7–9, 24–25 (P.T.A.B. June 27, 2018).

advance multiple grounds or arguments based on potential alternative constructions.⁴⁷

If the prior art is defensible but significantly weaker when applied against a § 112, ¶ 6 construction,⁴⁸ or if there is some uncertainty as to whether the negative *Williamson* presumption can be overcome, then the petitioner could forego an express construction, while mapping the prior art to structures recited in the specification element-by-element. This approach is complex and may be vulnerable to an attack by the patent owner for failing to construe the claim properly, or fully map the prior art to the corresponding structure (or its equivalents). There is, however, a sufficient factual predicate regarding the corresponding structure in the petition for the petitioner to leverage in a reply brief,⁴⁹ or a request for rehearing.⁵⁰ This strategy is perhaps most likely to succeed when a petition is filed well before any claim construction briefing in co-pending district court proceedings, thus preventing or at least defusing any critiques from the patent owner about the petitioner taking inconsistent positions.

Another strategy is to argue preemptively that it would be improper for the PTAB to consider a § 112, ¶ 6 construction of non-means terms absent an evidence-based challenge from the patent owner that overcomes the negative *Williamson* presumption. Such an argument flows from the Federal Circuit's traditional view that the presumptions concerning application of § 112, ¶ 6 are rebuttable by intrinsic and extrinsic evidence⁵¹ advanced by a "challenger" in the form of a party in the case.⁵² This strategy does not hide

47. A petitioner can, of course, identify and address more than one possible construction. *See, e.g., Intel Corp. v. Qualcomm Inc.*, No. IPR2018-01326, Paper 8 at 11 (P.T.A.B. Jan. 15, 2019) ("If a petitioner is concerned that the Board may not adopt what it believes to be the proper claim construction, the petitioner may offer alternative constructions and demonstrate unpatentability under each construction."). Indeed, as most arguments need support in the petition, it is likely prudent to address the most likely alternative constructions prematurely.

48. This is often the case, as § 112, ¶ 6 constructions inject additional structural limitations (or their equivalents) not found explicitly in the claims.

49. Institution of Inter Partes Review, 37 C.F.R. § 42.108(c) (2016) ("A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.").

50. *See, e.g., Adlens USA, Inc. v. Superfocus Holdings LLC*, No. IPR2015-01821, Paper 40 at 27–29 (P.T.A.B. Nov. 22, 2016).

51. *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 704 (Fed. Cir. 1998) ("These [§ 112, ¶ 6] presumptions can be rebutted if the evidence intrinsic to the patent and any relevant extrinsic evidence so warrant.").

52. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (citing *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)); *see also Inventio AG v. ThyssenKrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1356–57 (Fed. Cir. 2011); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) ("[T]he Board must base its decision on arguments that were advanced by a party. . .").

from the fact that the petitioner is seeking a § 112, ¶ 6 interpretation in district court as part of a defense,⁵³ which undercuts any arguments from the patent owner that petitioner is taking inconsistent positions or has failed to construe the claims.⁵⁴ In this scenario, the patent owner may be unlikely to accept the petitioner's invitation to argue in favor of a § 112, ¶ 6 construction if it would undermine their infringement read in district court by narrowing the claims. This strategy was successfully employed, for example, in *WhatsApp Inc. v. TriPlay Communications Ltd.*, where the petition was instituted after presenting plain-meaning interpretations, despite the petitioner having argued for § 112, ¶ 6 constructions in its opening claim construction brief in district court several months earlier.⁵⁵ There, the broadest reasonable claim construction standard applied, but the PTAB instituted the case based on the patent owner not presenting sufficient evidence to overcome the presumption against such a construction before the PTAB.

53. A petitioner may even state outright that review is requested based on the patent owner's district court constructions. *See, e.g.*, *W. Dig. Corp. v. SPEX Techs., Inc.*, IPR2018-00084, Paper 14 at 11 (P.T.A.B. Apr. 25, 2018) ("We agree with Petitioner that 37 C.F.R. § 104(b)(3) does not require Petitioner to express its subjective agreement regarding correctness of its proffered claim constructions or to take ownership of those constructions. . . . Petitioner's statement that its Petition 'is based on the claim constructions urged by Patent Owner' in related District Court litigation... suffices to identify claim constructions Petitioner is adopting for purposes of the requested review in compliance with § 104(b)(3).") (emphasis in original); *VTech Commc'ns, Inc. v. Spherix Inc.*, No. IPR2014-01431, Paper 50 at 18 (P.T.A.B. Feb. 3, 2016) ("It was reasonable for [petitioner] to treat these claim elements in dispute as non-means-plus-function limitations at the time of filing the Petition because. . . the patent owner and drafter of the claims[] maintained that these claim elements are not means-plus-function limitations in the district court proceeding."). *But see*, *Toyota Motor Corp. v. Blitzsafe Tex., LLC*, IPR2016-00422, Paper 12 at 26 (P.T.A.B. July 6, 2016) ("Petitioner does not take ownership of the. . . constructions by indicating, in some way, that it agrees with, proposes, or adopts the construction. . . .").

54. In executing this strategy, the petitioner should carefully avoid disparagement of any of the patent owner's district court constructions that are adopted for purposes of review at the PTAB. While subjective agreement is not required, affirmative disagreement may lead to denial of institution. *See, e.g.*, *Hologic, Inc. v. Enzo Life Scis., Inc.*, No. IPR2018-00019, Paper 17 at 8–9 (P.T.A.B. Apr. 18, 2018) (denying institution where petitioner disparaged patent owner's *Phillips* constructions, and yet requested IPR based on those same constructions under the same standard); *see also* *Hologic, Inc. v. Enzo Life Scis., Inc.*, No. IPR2018-00019, Paper 21 at 7 (P.T.A.B. Nov. 28, 2018); *see also* *CareFusion Corp. v. Baxter Int'l Inc.*, IPR2016-01456, Paper 9 at 6–10 (P.T.A.B. Feb. 6, 2017).

55. *WhatsApp Inc. v. TriPlay Comm. Ltd.*, No. IPR2016-00718, Paper 1 at 11–13 (P.T.A.B. Mar. 6, 2016) ("Petitioner does not believe that construction of the terms 'access block' and 'media block' (collectively, 'the 'block' terms') is necessary for purposes of this IPR proceeding."); *see also id.* at 11 n.2 ("The Petitioner reserves its right to contend that these claim terms fail the definiteness requirements of 35 U.S.C. § 112, but understands that the indefiniteness issue is currently outside the scope of IPR."); *see also* *WhatsApp Inc. v. TriPlay Comm. Ltd.*, No. IPR2016-00718, Paper 17 at 2, 7 (P.T.A.B. Sept. 8, 2016) (instituting review and concluding that "no claim terms require express construction on this record and for purposes of this decision.").

Strategy Considerations for Patent Owners

A few strategies based on the state of means-plus-function claim construction under *Williamson* may also be available to patent owners. While patent owners do not carry the burden of persuasion—and need not even file a response of any kind to prevail⁵⁶—strategic thinking and early action as to potential non-means § 112, ¶ 6 claim terms can pay dividends. For example, inconsistencies between a petitioner’s PTAB and district court constructions can be leveraged to argue for denial of institution. Or if a §112, ¶ 6 construction is not detrimental to its infringement case, a patent owner may advance such a construction to argue for denial of institution in view of petitioner’s failure to construe a key claim term,⁵⁷ or to undermine petitioner’s prior art analysis. On the other hand, a patent owner might affirmatively argue against application of § 112, ¶ 6 to secure a plain meaning construction that is more favorable for infringement purposes. District courts may be more likely to consider claim construction rulings from the PTAB now that both forums are operating under the same claim construction standard.⁵⁸

CONCLUSION

As with almost any argument, the facts and context of the case will heavily influence decision-making for all parties. But with early identification of potential § 112, ¶ 6 issues implicated by *Williamson*, petitioners can increase their chances of success, maintain consistency across district court, ITC, and PTAB proceedings, and avoid costly blunders.

56. *Magnum*, 829 F.3d at 1376 n.1 (“[T]he institution of an IPR does not by itself translate to a conclusion of unpatentability and the patent owner is not required to use its opportunity under the regulations to file a patent owner response. . .”).

57. *Cf.* *ZTE Corp. v. Maxell, Ltd.*, No. IPR2018-00241, Paper 9 at 7–8 (P.T.A.B. July 2, 2018); *Becton, Dickinson and Co. v. Baxter Int’l, Inc.*, No. IPR2018-01741, Paper 8 at 9–18 (P.T.A.B. March 18, 2019). This approach was also attempted, albeit unsuccessfully, in *Nokia of Am. Corp. v. Blackberry Ltd.*, No. IPR2018-00635, Paper 9 at 8–12 (P.T.A.B. Sept. 10, 2018).

58. *See, e.g.*, Order on Claim Construction at 11–12, *Scripps Res. Inst. v. Illumina, Inc.*, No. 3-16-cv-00661 (S.D. Cal. Mar. 17, 2016) (agreeing with the PTAB’s construction in part because it was based on the application of *Phillips* principles).