

## Data Storage IP Case Aids In Untangling Similar Claim Terms

By **Kyle Ryman and Joel Thollander** (June 2, 2023, 4:34 PM EDT)

How open-endedly should courts construe open-ended terms like "including" during claim construction in patent suits?

Or, when numerous patents expressly provide a common definition for a particular term, should that extrinsic definition inform a similar term left undefined in a contemporaneous patent?

In the April 12 *Sequoia Technology LLC v. Dell Inc.* decision, the U.S. Court of Appeals for the Federal Circuit answered both questions.[1] This article explores the court's answers.

The *Sequoia* case presented a definitional gap: In the context of U.S. Patent No. 6,718,436, does "computer-readable recording medium storing instructions for executing a method" claim transitory media — like signals?

The '436 patent does not expressly say, leaving the term undefined. That could, and did, cause the patent owner problems.

The United States Patent and Trademark Office has warned for years that a similar term, computer readable medium, ordinarily claims both nontransitory media and transitory media absent language expressly limiting the claim to nontransitory media.[2] And the Federal Circuit has held that transitory media is not patent-eligible subject matter.[3]

The patent owner argued for the U.S. District Court for the District of Delaware's magistrate to construe "computer-readable recording medium" as not claiming ineligible transitory media. The '436 patent's specification describes its invention as using:

[A] computer readable medium including compact disc read only memory (CDROM), random access memory (RAM), floppy disk, hard disk, and magneto-optical disk.[4]

Because none of those examples are transitory media, the patent owner argued, "computer-readable medium" does not include transitory media in the context of the '436 patent.[5]

The magistrate rejected that argument. It noted that inclusion is open-ended under existing claim-construction jurisprudence. That means, reasoned the magistrate, that the listed examples do not



Kyle Ryman



Joel Thollander

themselves limit "computer-readable medium" to nontransitory media.

Further, the patent challenger's expert had opined that a person of ordinary skill in the art would have understood "computer-readable recording medium" as claiming transitory media, and had based his opinion on 34 contemporaneous patents and patent applications defining the term as claiming transitory media.

Relying on the patent challenger's expert evidence, the magistrate construed "computer-readable recording medium" as claiming ineligible transitory media.[6]

That could have been the end for the patent owner — but for the Federal Circuit. The U.S. District Court for the District of Delaware adopted its magistrate's report and recommendations without modification.[7]

But the Federal Circuit reversed. Writing for a unanimous panel, Judge Kara Farnandez Stoll held that "computer-readable recording medium" storing instructions do not claim transitory media in the context of the '436 patent.[8]

Judge Stoll explained that the word "including" is not so broad as the magistrate had reasoned. True, "including" is open-ended. But "the use of a term denoting a non-exhaustive list does not eviscerate our obligation to construe terms in the context of the entire patent." [9]

And that context was provided by the very excerpt from the specification that the magistrate had rejected as answering what "computer-readable medium" claimed.

Because all the examples the '436 patent lists for "computer-readable medium" are non-transitory hardware — CDROMs, RAM, floppy disks, hard disks and magneto-optical disks — that means "computer-readable medium" claims only nontransitory media in the context of the '436 patent.[10]

In other words, the kinds of examples that follow "computer-readable medium" limit its definition in the context of the '436 patent.

Judge Stoll further emphasized that a close review of the intrinsic evidence demonstrated that ineligible transitory media was not claimed. Looking at the actual claim language, Judge Stoll noted that the court was not construing "computer-readable medium," but a narrower term: "computer-readable recording medium storing instructions." [11]

The specification further explained that an object of the invention was providing "a computer-readable recording medium storing a program or data structure." [12]

The narrowing claim terms — "recording" and "storing" — plus the specification's stated object, providing a medium for storage, made it "hard to imagine," for Judge Stoll, "how the invention would be implemented as [non-transitory media]," which "do[es] not persist over time." [13]

Judge Stoll also explained why the magistrate "clearly erred" in using the patent challenger's expert testimony to fill the '436 patent's definitional gap. Context is key: "[E]xtrinsic evidence of what other inventors chose to do cannot surmount the intrinsic evidence of what the inventors chose here." [14]

The 34 contemporaneous patents and patent applications merely showed that other "inventors chose to

be their own lexicographers." [15] Their express definitions, used in the context of different inventions, do not control undefined terms in the context of the '436 patent.

Nor do their express definitions of "computer-readable recording medium" establish the plain and ordinary meaning of the '436 patent's actual claim term: "computer-readable recording medium" for storing. [16]

But what about the USPTO's warning that computer readable medium ordinarily claims both nontransitory media and transitory media absent language expressly limiting the claim to nontransitory media?

Judge Stoll explained that the USPTO had merely provided the "broadest reasonable interpretation" of the term, which is not the standard courts use in construing claims during claim construction. [17] — the Federal Circuit's 2005 en banc decision in *Phillips v. AWH Corp.* outlines a narrower standard. [18]

In the context of the '436 patent, explained Judge Stoll, the "intrinsic record [alone] ... demonstrates that the term computer-readable recording medium storing instructions (or the like) does not reasonably include transitory media." [19]

Despite Judge Stoll's treatment of the extrinsic evidence in *Sequoia*, the decision does not close the door to it entirely during claim construction.

*Sequoia* came out the way it did because Judge Stoll read the intrinsic record as answering whether "computer-readable recording medium" for storing claimed ineligible transitory media, while the magistrate did not. But what if the intrinsic record had not answered the question?

*Sequoia* could have come out differently. The extrinsic evidence was one-sided in the patent challenger's favor, as Judge Stoll pointed out in a footnote. [20] And nothing in the panel's decision in *Sequoia* purports to overrule the Federal Circuit's en banc decision in *Phillips* — nor could it.

Indeed, *Phillips* explains that extrinsic evidence like "expert testimony" can be useful "to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field." [21]

And while *Sequoia* is a recent decision, the Federal Circuit has already reaffirmed in a closely related context — determining an invention's intended purpose — that it can be "appropriate to consider extrinsic evidence, particularly when it does not contradict the patents themselves." [22]

Suffice to say, extrinsic evidence remains relevant during claim construction post-*Sequoia* — just not when it contradicts the intrinsic record. To that end, *Sequoia* demonstrates the importance of closely analyzing the intrinsic record to fill definitional gaps during claim construction.

Open-ended terms may be limited by the common character of their listed examples. And the express definition of a term in one patent does not inform the same, undefined term in another — let alone a similar, undefined term.

---

*Kyle Ryman is an associate and Joel Thollander is a principal at McKool Smith.*

*The opinions expressed are those of the author(s) and do not necessarily reflect the views of their*

*employer, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.*

[1] (Panel Decision), No. 21-2263, slip op. (Fed. Cir. Apr. 12, 2023).

[2] Subject Matter Eligibility of Computer Readable Media, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

[3] *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007).

[4] *Sequoia Tech. LLC v. Dell Inc.* (Report & Recommendation), No. 18-1127-LPS-CJB, 2020 WL 5835129, at \*14 (D. Del. Oct. 1, 2020).

[5] *Id.*

[6] *Id.* at \*14-15.

[7] *Sequoia Tech. LLC v. Dell Inc.* (Final Judgment), No. 18-1127-LPS-CJB, 2021 WL 3878937, at \*1-2 (D. Del. Aug. 16, 2021).

[8] Panel Decision, slip op. at 14.

[9] *Id.* at 11.

[10] *Id.* at 10-11.

[11] *Id.* at 10.

[12] *Id.* at 11.

[13] *Id.* at 10-11.

[14] *Id.* at 13.

[15] *Id.* at 12.

[16] *Id.*

[17] *Id.* at 13–14.

[18] See 415 F.3d 1303, 1311–1319 (Fed. Cir. 2005) (en banc).

[19] Panel Decision, slip op. at 14.

[20] *Id.* at 13 n.3.

[21] 415 F.3d at 1318.

[22] *Medtronic Inc. v. Teleflex Innovations S.À.R.L.*, No. 21-2356, slip op. at 6-7 (Fed. Cir. May 24, 2023).