

2019-1212, -1456

United States Court of Appeals for the Federal Circuit

MIRA ADVANCED TECHNOLOGY SYSTEMS, INC.,

Appellant,

v.

MICROSOFT CORPORATION,

Appellee

**Appeals from the United States Patent and Trademark Office, Patent Trial
and Appeal Board in Nos. IPR2017-01052 and IPR2017-01411**

**APPELLANT'S COMBINED PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

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March 12, 2020

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STATEMENT OF COUNSEL UNDER FEDERAL CIRCUIT RULE 35(B)(2)

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the precedents of this Court: *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc); and *In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

Dated: March 12, 2020

/s/ Jundong Ma _____
Jundong Ma

INTRODUCTION

This case has only one single issue, namely, whether the key claim term “contact list” is properly construed by the Board.

ARGUMENT

- I. **The court should grant panel rehearing or en banc review because the Panel, in affirming the judgment below, overlooked that the board’s proposed claim construction of the key claim term “contact list” results from an *arbitrary* and *capricious* approach that is *completely contrary to the precedents of this Court*, a lapse which is outcome dispositive.**

One claim construction principle fundamental to correct construction is that the specification “is the single best guide the meaning of a disputed term.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (internal quotes

omitted). This principle has no less vitality under the BRI, as claims cannot be construed in a manner “divorced from the specification and the record evidence.” *Microsoft Corp.*, 789 F.3d at 1298 (quoting *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)).

Since the specification is the “single best guide” in resolving the meaning of a disputed claim term, “[t]he correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification.” *In re Smith Int’l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017). Rather, a correct construction is one “that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is consistent with the specification.” *Id.* (citation and internal quotation marks omitted).

When these principles are applied here, the specification, which is the single best guide, both make clear that a “contact list” is a common feature requiring a user interface functionality necessary for a user (to, e.g., view or save contact information of a “contact list entry” that can be selected and activated).

As will be demonstrated below, the Board’s construction of the key term “contact list”, however, results from an arbitrary and capricious approach that is completely *contrary to*, and therefore runs afoul, the precedents of this Court. As a result of this contrary approach, the Board’s construction of “contact list” does not *correspond with what and how the inventor describes his invention in the specification* under the jurisprudence of *Phillips* and *In Re Smith*, the Board found that references disclosing only a basic database table (Matsumoto) or phonebook storage (Sony) satisfy the “contact list” feature. Based on this erroneous construction, the Board found that it would have been a *simple design choice* to modify Sony’s phonebook 2, in view of Matsumoto, to include an additional data field, and incorrectly ruled in favor of Microsoft on the issue of obviousness.

A. The precedents of this Court *requires* that (1) the specification is the *Single Best Guide* for construing a claim term, and (2) a reasonable construction of claim term under the BRI standard must *correspond with* the intention of the inventor, and accordingly, “contact list” should be construed as a common feature *requiring* a user interface.

The specification makes it clear that the claimed “contact list” requires user interface functionality under the jurisprudence of *Phillips* and *In Re Smith*. To the extent there is any ambiguity in the claim language, the specification—which is the “single best guide”—compels the conclusion that the term “contact list” requires

user interface functionality. First, the specification explains that a “contact list is a common feature in most modern communication devices.” Appx141, 1:6-7 (emphasis added). The specification further explains that such a “contact list” is provided with well-known and popular email clients such as Hotmail, outlook, gmail etc.” An email client—including these popular email clients *whose name alone provides wealth of information (including specific user interface information) to those skilled in the art* —requires user interface functionality. As shown in Figure 4 of the ’657 patent, the Gmail email application indisputably has user interface.

The patents also refer to “means to enable [a] user to enter and save contact information,” “means to attach [a] memo,” “means . . . to remind,” “means . . . to activate,” and “means . . . to display.” Appx141, 1:17-20, 1:24-25, 2:14-17, 2:50-52. In each instance, the “means” refer to user interface functionality as required by the “contact list” itself. The specification thus shows the inventor’s reliance on common, well-known software clients like Hotmail, Outlook, and Gmail. This use conveys to the skilled artisan with reasonable clarity as to the user interface functionality of their respective “contact lists,” and therefore as to the user interface functionality of a “contact

list” referred to in the patents, even when no additional disclosure about them is included. Cf. *Vas-Cath Inc. v. Marhurkar*, 935 F.2d 1555, 1566 (Fed. Cir. 1991) (“Consideration of what the drawings conveyed to persons of ordinary skill is essential.”).

The claims on appeal recite “a saved contact list having one or more contact list entries.” The “contact list entry” includes fields that are “configured to retrieve” contact information and “configured to attach memo data inputted by the user.” Appx141, 2:64-67; Appx142, 3:1-5, 4:1-6 (’892 patent, claims 1, 6) (emphasis added); Appx150, 3:10- 17 (emphasis added) (’657 patent, claim 1). In other words, the “contact list entry” is itself a feature “configured to” perform functions (i.e., retrieving, attaching) that are user interface functions. Likewise, step (c) of each of the claims requires “activating” the contact list entry, which in step (d) causes the attached memo data to be displayed.

The Board itself construed “activating” as “selecting or opening a contact list entry.” Appx7; Appx72. The words “selecting or opening” refer to actions performed by a user with respect to a “contact list entry.”

Selecting or opening a contact list both plainly require user interface functionality.

Accordingly, under the jurisprudence of *Phillips* and *In Re Smith*, the claimed “contact list” shall be construed as a common feature *requiring* user interface functionality.

B. The Panel overlooked that the Board’s proposed construction of the key claim term “contact list” results from an *arbitrary* and *capricious* approach that is *completely contrary to what are required by the precedents of this court*.

The Board’s constructions of “contact list”—as nothing more than “a list stored in memory”— results form an *arbitrary* and *capricious* approach that is *completely contrary to what are required* under the jurisprudence of *Phillips* and *In Re Smith*. Although the construction of a claim term starts with the claim, the specification is nonetheless the *single best guide* for construing a disputed claim term under the *Phillips* jurisprudence. However, the Board almost entirely uses and relies on the claim language to construe the key term “contact list”. And the specification is merely used as a source *secondary to the specification* to confirm, but with pre-occupied bias, the construction construed from the claim language is indeed compatible with the specification by *cherry-picking* portions of the description and

putting an impermissible “spin” of the cherry-picked portion favorable to the forgone construction.

Specifically, from the claim language ‘saved contact list’, the Board interprets “contact list” as nothing more than “a list stored in memory.” This interpretation rests on its erroneous assumption that the modifier “saved” means that a “contact list” is merely a saved list or data structure that cannot require user interface functionality, which, as Mira explains, is completely unfounded as a “saved” contact list does not preclude from having a user interface. Appx8- 31; Appx15. It appears that erroneous assumption is partly due to that the Board uses its own prior knowledge of what a “saved” list may be.

Next, the Board goes to the specification, cherry-picking portions of the specification, and putting an impermissible “spin” of the cherry-picked portion favorable to the forgone construction. For example, the Board interprets Figure. 1 of both patents as supporting its construction, whereas as articulated by Mira, Figure. 1 only disclose an underlying database structure of “contact list” without more, and not a “contact list” itself.

Then, the Board dissects each and every piece of Mira’s evidence (of showing that specification *requires* a user interface under the *Phillips* and *In Re Smith*

jurisprudence), concluding that those pieces of evidence individually simply “is untenable as being incompatible with the claim language ‘saved contact list.’”. With this conclusory statement, the Board rejects Mira’s proposed claim construction.

This approach of the Board, which is apparently overlooked by the Panel, is nothing short of using the claim language as the single best guide while using the specification as a guide secondary to the claim language, which is contrary to *Phillips*. As a result, the Board’s construction by definition does NOT “correspond with” the intention of the inventor as to the meaning of “contact list”, which is contrary to *In Re Smith*.

Accordingly, the Board’s approach is arbitrary and capricious, and therefore its construction resulting from this approach shall be rejected.

C. The judgment below is *entirely* premised on the incorrect construction and the key claim term “contact list”, and accordingly should fall with the reversal of the claim construction error.

As Mira articulated, the judgment below is *entirely* premised on the incorrect construction and the key claim term “contact list”, and accordingly should fall with the reversal of the claim construction error. Accordingly, reversal of this claim construction error will do justice to Mira in the public interest.

CONCLUSION

Accordingly, Mira's request for rehearing or en banc hearing should be granted.

Respectfully submitted,

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